

§ 1064. Cancellation of registration

A petition to cancel a registration of a mark, stating the grounds relied upon, may, upon payment of the prescribed fee, be filed as follows by any person who believes that he is or will be damaged, including as a result of a likelihood of dilution by blurring or dilution by tarnishment under section 1125(c) of this title, by the registration of a mark on the principal register established by this chapter, or under the Act of March 3, 1881, or the Act of February 20, 1905:

(1) Within five years from the date of the registration of the mark under this chapter.

(2) Within five years from the date of publication under section 1062(c) of this title of a mark registered under the Act of March 3, 1881, or the Act of February 20, 1905.

(3) At any time if the registered mark becomes the generic name for the goods or services, or a portion thereof, for which it is registered, or is functional, or has been abandoned, or its registration was obtained fraudulently or contrary to the provisions of section 1054 of this title or of subsection (a), (b), or (c) of section 1052 of this title for a registration under this chapter, or contrary to similar prohibitory provisions of such prior Acts for a registration under such Acts, or if the registered mark is being used by, or with the permission of, the registrant so as to misrepresent the source of the goods or services on or in connection with which the mark is used. If the registered mark becomes the generic name for less than all of the goods or services for which it is registered, a petition to cancel the registration for only those goods or services may be filed. A registered mark shall not be deemed to be the generic name of goods or services solely because such mark is also used as a name of or to identify a unique product or service. The primary significance of the registered mark to the relevant public rather than purchaser motivation shall be the test for determining whether the registered mark has become the generic name of goods or services on or in connection with which it has been used.

(4) At any time if the mark is registered under the Act of March 3, 1881, or the Act of February 20, 1905, and has not been published under the provisions of subsection (c) of section 1062 of this title.

(5) At any time in the case of a certification mark on the ground that the registrant (A) does not control, or is not able legitimately to exercise control over, the use of such mark, or (B) engages in the production or marketing of any goods or services to which the certification mark is applied, or (C) permits the use of the certification mark for purposes other than to certify, or (D) discriminately refuses to certify or to continue to certify the goods or services of any person who maintains the standards or conditions which such mark certifies.

(6) At any time after the 3-year period following the date of registration, if the registered mark has never been used in commerce on or in connection with some or all of the goods or services recited in the registration:

Provided, That the Federal Trade Commission may apply to cancel on the grounds specified in paragraphs (3) and (5) of this section any mark registered on the principal register established by this chapter, and the prescribed fee shall not be required. Nothing in paragraph (5) shall be deemed to prohibit the registrant from using its certification mark in advertising or promoting recognition of the certification program or of the goods or services meeting the certification standards of the registrant. Such uses of the certification mark shall not be grounds for cancellation under paragraph (5), so long as the registrant does not itself produce, manufacture, or sell any of the certified goods or services to which its identical certification mark is applied. Nothing in paragraph (6) shall be construed to limit the timing applicable to any other ground for cancellation. A registration under section 1126(e) or 1141f of this title shall not be cancelled pursuant to paragraph (6) if the registrant demonstrates that any nonuse is due to special circumstances that excuse such nonuse.

(July 5, 1946, ch. 540, title I, §14, 60 Stat. 433; Pub. L. 87-772, §9, Oct. 9, 1962, 76 Stat. 771; Pub. L. 97-247, §9(b), Aug. 27, 1982, 96 Stat. 320; Pub. L. 98-620, title I, §102, Nov. 8, 1984, 98 Stat. 3335; Pub. L. 100-667, title I, §115, Nov. 16, 1988, 102 Stat. 3940; Pub. L. 105-330, title II, §201(a)(4), title III, §301, Oct. 30, 1998, 112 Stat. 3070; Pub. L. 106-43, §2(c), Aug. 5, 1999, 113 Stat. 218; Pub. L. 109-312, §3(c), Oct. 6, 2006, 120 Stat. 1732; Pub. L. 116-260, div. Q, title II, §225(b), Dec. 27, 2020, 134 Stat. 2204.)

Editorial Notes

REFERENCES IN TEXT

Acts March 3, 1881 and February 20, 1905, referred to in opening par. and pars. (2) and (4), are acts Mar. 3, 1881, ch. 138, 21 Stat. 502 and Feb. 20, 1905, ch. 592, 33 Stat. 724, which were repealed insofar as inconsistent with this chapter by act July 5, 1946, ch. 540, §46(a), 60 Stat. 444. Act Feb. 20, 1905, was classified to sections 81 to 109 of this title.

PRIOR PROVISIONS

Act Feb. 20, 1905, ch. 592, §13, 33 Stat. 728.

AMENDMENTS

2020—Pub. L. 116-260, §225(b)(3), in concluding proviso, inserted “Nothing in paragraph (6) shall be construed to limit the timing applicable to any other ground for cancellation. A registration under section 1126(e) or 1141f of this title shall not be cancelled pursuant to paragraph (6) if the registrant demonstrates that any nonuse is due to special circumstances that excuse such nonuse.” after “identical certification mark is applied.”

Par. (6). Pub. L. 116-260, §225(b)(1), (2), added par. (6). 2006—Pub. L. 109-312 substituted “, including as a result of a likelihood of dilution by blurring or dilution by tarnishment under section 1125(c) of this title,” for “, including as a result of dilution under section 1125(c) of this title,” in introductory provisions.

1999—Pub. L. 106-43 inserted “, including as a result of dilution under section 1125(c) of this title,” after “damaged” in introductory provisions.

1998—Pub. L. 105-330, §301, inserted at end “Nothing in paragraph (5) shall be deemed to prohibit the registrant from using its certification mark in advertising or promoting recognition of the certification program or of the goods or services meeting the certification standards of the registrant. Such uses of the certifi-

cation mark shall not be grounds for cancellation under paragraph (5), so long as the registrant does not itself produce, manufacture, or sell any of the certified goods or services to which its identical certification mark is applied.”

Par. (3). Pub. L. 105-330, §201(a)(4), inserted “or is functional,” before “or has been abandoned”.

1988—Pub. L. 100-667, §115(1), (7), in introductory provisions, inserted “as follows” and substituted “1905:” for “1905—”, and in concluding proviso substituted “paragraphs (3) and (5)” for “subsections (c) and (e)”.

Par. (1). Pub. L. 100-667, §115(2), substituted “(1) Within” for “(a) within” and “chapter.” for “chapter; or”.

Par. (2). Pub. L. 100-667, §115(3), substituted “(2) Within” for “(b) within”, and “1905.” for “1905; or”.

Par. (3). Pub. L. 100-667, §115(4), substituted “(3)” for “(c)” and amended text generally. Prior to amendment, text read as follows: “at any time if the registered mark becomes the common descriptive name of an article or substance, or has been abandoned, or its registration was obtained fraudulently or contrary to the provisions of section 1054 of this title or of subsections (a), (b), or (c) of section 1052 of this title for a registration hereunder, or contrary to similar prohibitory provisions of said prior Acts for a registration thereunder, or if the registered mark is being used by, or with the permission of, the registrant so as to misrepresent the source of the goods or services in connection with which the mark is used. A registered mark shall not be deemed to be the common descriptive name of goods or services solely because such mark is also used as a name of or to identify a unique product or service. The primary significance of the registered mark to the relevant public rather than purchaser motivation shall be the test for determining whether the registered mark has become the common descriptive name of goods or services in connection with which it has been used; or”.

Par. (4). Pub. L. 100-667, §115(5), substituted “(4) At” for “(d) at”, and “title.” for “title; or”.

Par. (5). Pub. L. 100-667, §115(6), substituted “(5) At” for “(e) at” and redesignated former pars. (1) to (4) as subpars. (A) to (D), respectively.

1984—Par. (c). Pub. L. 98-620 inserted provision that a registered mark shall not be deemed to be the common descriptive name of goods or services solely because such mark is also used as a name of or to identify a unique product or service, and that the primary significance of the registered mark to the relevant public rather than purchaser motivation shall be the test for determining whether the registered mark has become the common descriptive name of goods or services in connection with which it has been used.

1982—Pub. L. 97-247 struck out “verified” before “petition to cancel” in provision preceding par. (a).

1962—Pub. L. 87-772 inserted provisions which require a verified petition to cancel a registration, redesignated par. (d) as (e), added par. (d) which is composed of provisions formerly part of par. (c), and in said par. (c), substituted “registrant” for “assignee”, and struck out “on which the patent has expired” before “or has been abandoned”, and “has been assigned and” before “is being used by”.

Statutory Notes and Related Subsidiaries

EFFECTIVE DATE OF 2020 AMENDMENT

Pub. L. 116-260, div. Q, title II, §225(g), Dec. 27, 2020, 134 Stat. 2208, provided that: “The amendments made by this section [enacting sections 1066a and 1066b of this title and amending this section and sections 1065, 1070, 1071, and 1094 of this title] shall take effect upon the expiration of the 1-year period beginning on the date of enactment of this Act [Dec. 27, 2020], and shall apply to any mark registered before, on, or after that effective date.”

EFFECTIVE DATE OF 1999 AMENDMENT

Amendment by Pub. L. 106-43 effective Aug. 5, 1999, and applicable only to any application for registration

filed on or after Jan. 16, 1996, see section 2(e) of Pub. L. 106-43, set out as a note under section 1052 of this title.

EFFECTIVE DATE OF 1998 AMENDMENT

Amendment by section 201(a)(4) of Pub. L. 105-330 effective Oct. 30, 1998, and applicable only to any civil action filed or proceeding before the United States Patent and Trademark Office commenced on or after such date relating to the registration of a mark, see section 201(b) of Pub. L. 105-330, set out as a note under section 1051 of this title.

EFFECTIVE DATE OF 1988 AMENDMENT

Amendment by Pub. L. 100-667 effective one year after Nov. 16, 1988, see section 136 of Pub. L. 100-667, set out as a note under section 1051 of this title.

EFFECTIVE DATE OF 1982 AMENDMENT

Amendment by Pub. L. 97-247 effective six months after Aug. 27, 1982, see section 17(c) of Pub. L. 97-247, set out as a note under section 294 of Title 35, Patents.

FINALITY OF JUDGMENTS PRIOR TO NOVEMBER 8, 1984

Pub. L. 98-620, title I, §104, Nov. 8, 1984, 98 Stat. 3336, provided that: “Nothing in this title [amending this section and section 1127 of this title and enacting provisions set out as a note under section 1051 of this title] shall be construed to provide a basis for reopening of any final judgment entered prior to the date of enactment of this title [Nov. 8, 1984].”

REPEAL AND EFFECT ON EXISTING RIGHTS

Repeal of inconsistent provisions, effect of this chapter on pending proceedings and existing registrations and rights under prior acts, see notes set out under section 1051 of this title.

RESTRICTION ON USE OF FUNDS TO CANCEL REGISTRATION OF TRADEMARKS

For provisions restricting the use of funds authorized to be appropriated to carry out section 41 et seq. of this title for fiscal year 1980, 1981, or 1982, for the purpose of taking any action under this section with respect to the cancellation of the registration of any mark on the ground that such mark has become the common descriptive name of an article or substance, see section 18 of Pub. L. 96-252, set out as a note under section 57c of this title.

Executive Documents

TRANSFER OF FUNCTIONS

For transfer of functions of Federal Trade Commission, with certain exceptions, to Chairman of such Commission, see Reorg. Plan No. 8 of 1950, §1, eff. May 24, 1950, 15 F.R. 3175, 64 Stat. 1264, set out under section 41 of this title.

§ 1065. Incontestability of right to use mark under certain conditions

Except on a ground for which application to cancel may be filed at any time under paragraphs (3), (5), and (6) of section 1064 of this title, and except to the extent, if any, to which the use of a mark registered on the principal register infringes a valid right acquired under the law of any State or Territory by use of a mark or trade name continuing from a date prior to the date of registration under this chapter of such registered mark, the right of the owner to use such registered mark in commerce for the goods or services on or in connection with which such registered mark has been in continuous use for five consecutive years subsequent to the date of such registration and is still in use in commerce, shall be incontestable: *Provided, That—*