

Union Calendar No. 427

103D CONGRESS
2D SESSION

H. R. 2129

[Report No. 103-780]

A BILL

To amend the Trademark Act of 1946 to provide for the registration and protection of trademarks used in commerce, in order to carry out provisions of certain international conventions, and for other purposes.

OCTOBER 3, 1994

Reported with an amendment, committed to the Committee of the Whole House on the State of the Union, and ordered to be printed

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2^D SESSION**H. R. 2129****[Report No. 103-780]**

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IN THE HOUSE OF REPRESENTATIVES

MAY 17, 1993

Mr. HUGHES (for himself and Mr. MOORHEAD) introduced the following bill;
which was referred to the Committee on the Judiciary

OCTOBER 3, 1994

Reported with an amendment, committed to the Committee of the Whole
House on the State of the Union, and ordered to be printed

[Strike out all after the enacting clause and insert the part printed in italic]

[For text of introduced bill, see copy of bill as introduced on May 17, 1993]

A BILL

To amend the Trademark Act of 1946 to provide for the registration and protection of trademarks used in commerce, in order to carry out provisions of certain international conventions, and for other purposes.

1 *Be it enacted by the Senate and House of Representa-*
2 *tives of the United States of America in Congress assembled,*

1 **SECTION 1. SHORT TITLE.**

2 *This Act may be cited as the “Madrid Protocol Imple-*
3 *mentation Act”.*

4 **SEC. 2. PROVISIONS TO IMPLEMENT THE PROTOCOL RE-**
5 **LATING TO THE MADRID AGREEMENT CON-**
6 **CERNING THE INTERNATIONAL REGISTRA-**
7 **TION OF MARKS.**

8 *The Act entitled “An Act to provide for the registration*
9 *and protection of trade-marks used in commerce, to carry*
10 *out the provisions of certain international conventions, and*
11 *for other purposes”, approved July 5, 1946, as amended (15*
12 *U.S.C. 1051 and following) (commonly referred to as the*
13 *“Trademark Act of 1946”) is amended by adding after sec-*
14 *tion 51 the following new title:*

15 *“TITLE XII—THE MADRID PROTOCOL*

16 **“SEC. 60. DEFINITIONS.**

17 *“For purposes of this title:*

18 *“(1) MADRID PROTOCOL.—The term ‘Madrid*
19 *Protocol’ means the Protocol Relating to the Madrid*
20 *Agreement Concerning the International Registration*
21 *of Marks, adopted at Madrid, Spain, on June 27,*
22 *1989.*

23 *“(2) BASIC APPLICATION.—The term ‘basic ap-*
24 *plication’ means the application for the registration*
25 *of a mark that has been filed with an Office of a Con-*
26 *tracting Party and that constitutes the basis for an*

1 *application for the international registration of that*
2 *mark.*

3 “(3) *BASIC REGISTRATION.*—*The term ‘basic reg-*
4 *istration’ means the registration of a mark that has*
5 *been granted by an Office of a Contracting Party and*
6 *that constitutes the basis for an application for the*
7 *international registration of that mark.*

8 “(4) *CONTRACTING PARTY.*—*The term ‘Contract-*
9 *ing Party’ means any country or inter-governmental*
10 *organization that is a party to the Madrid Protocol.*

11 “(5) *DATE OF RECORDAL.*—*The term ‘date of*
12 *recordal’ means the date on which a request for exten-*
13 *sion of protection that is filed after an international*
14 *registration is granted is recorded on the Inter-*
15 *national Register.*

16 “(6) *DECLARATION OF BONA FIDE INTENTION TO*
17 *USE THE MARK IN COMMERCE.*—*The term ‘declara-*
18 *tion of bona fide intention to use the mark in com-*
19 *merce’ means a declaration that is signed by the ap-*
20 *plicant for, or holder of, an international registration*
21 *who is seeking extension of protection of a mark to the*
22 *United States and that contains a statement that—*

23 “(A) *the applicant or holder has a bona fide*
24 *intention to use the mark in commerce,*

1 “(B) the person making the declaration be-
2 lieves himself or herself, or the firm, corporation,
3 or association in whose behalf he or she makes
4 the declaration, to be entitled to use the mark in
5 commerce, and

6 “(C) no other person, firm, corporation, or
7 association, to the best of his or her knowledge
8 and belief, has the right to use such mark in
9 commerce either in the identical form of the
10 mark or in such near resemblance to the mark
11 as to be likely, when used on or in connection
12 with the goods of such other person, firm, cor-
13 poration, or association, to cause confusion, or to
14 cause mistake, or to deceive.

15 “(7) *EXTENSION OF PROTECTION.*—The term ‘ex-
16 tension of protection’ means the protection resulting
17 from an international registration that extends to a
18 Contracting Party at the request of the holder of the
19 international registration, in accordance with the
20 Madrid Protocol.

21 “(8) *HOLDER OF AN INTERNATIONAL REGISTRA-*
22 *TION.*—A ‘holder’ of an international registration is
23 the natural or juristic person in whose name the
24 international registration is recorded on the Inter-
25 national Register.

1 “(9) *INTERNATIONAL APPLICATION*.—The term
2 ‘international application’ means an application for
3 international registration that is filed under the Ma-
4 drid Protocol.

5 “(10) *INTERNATIONAL BUREAU*.—The term
6 ‘International Bureau’ means the International Bu-
7 reau of the World Intellectual Property Organization.

8 “(11) *INTERNATIONAL REGISTER*.—The term
9 ‘International Register’ means the official collection of
10 such data concerning international registrations
11 maintained by the International Bureau that the Ma-
12 drid Protocol or its implementing regulations require
13 or permit to be recorded, regardless of the medium
14 which contains such data.

15 “(12) *INTERNATIONAL REGISTRATION*.—The term
16 ‘international registration’ means the registration of
17 a mark granted under the Madrid Protocol.

18 “(13) *INTERNATIONAL REGISTRATION DATE*.—
19 The term ‘international registration date’ means the
20 date assigned to the international registration by the
21 International Bureau.

22 “(14) *NOTIFICATION OF REFUSAL*.—The term
23 ‘notification of refusal’ means the notice sent by an
24 Office of a Contracting Party to the International

1 Bureau declaring that an extension of protection can-
2 not be granted.

3 “(15) OFFICE OF A CONTRACTING PARTY.—The
4 term ‘Office of a Contracting Party’ means—

5 “(A) the office, or governmental entity, of a
6 Contracting Party that is responsible for the reg-
7 istration of marks, or

8 “(B) the common office, or governmental en-
9 tity, of more than 1 Contracting Party that is
10 responsible for the registration of marks and is
11 so recognized by the International Bureau.

12 “(16) OFFICE OF ORIGIN.—The term ‘office of or-
13 igin’ means the Office of a Contracting Party with
14 which a basic application was filed or by which a
15 basic registration was granted.

16 “(17) OPPOSITION PERIOD.—The term ‘opposi-
17 tion period’ means the time allowed for filing an op-
18 position in the Patent and Trademark Office, includ-
19 ing any extension of time granted under section 13.

20 **“SEC. 61. INTERNATIONAL APPLICATIONS BASED ON UNIT-**
21 **ED STATES APPLICATIONS OR REGISTRA-**
22 **TIONS.**

23 “The owner of a basic application pending before the
24 Patent and Trademark Office, or the owner of a basic reg-

1 *istration granted by the Patent and Trademark Office,*
2 *who—*

3 *“(1) is a national of the United States,*

4 *“(2) is domiciled in the United States, or*

5 *“(3) has a real and effective industrial or com-*
6 *mmercial establishment in the United States,*

7 *may file an international application by submitting to the*
8 *Patent and Trademark Office a written application in such*
9 *form, together with such fees, as may be prescribed by the*
10 *Commissioner.*

11 **“SEC. 62. CERTIFICATION OF THE INTERNATIONAL APPLI-**
12 **CATION.**

13 *“Upon the filing of an application for international*
14 *registration and payment of the prescribed fees, the Com-*
15 *missioner shall examine the international application for*
16 *the purpose of certifying that the information contained in*
17 *the international application corresponds to the informa-*
18 *tion contained in the basic application or basic registration*
19 *at the time of the certification. Upon examination and cer-*
20 *tification of the international application, the Commis-*
21 *sioner shall transmit the international application to the*
22 *International Bureau.*

1 **“SEC. 63. RESTRICTION, ABANDONMENT, CANCELLATION,**
2 **OR EXPIRATION OF A BASIC APPLICATION OR**
3 **BASIC REGISTRATION.**

4 *“With respect to an international application trans-*
5 *mitted to the International Bureau under section 62, the*
6 *Commissioner shall notify the International Bureau when-*
7 *ever the basic application or basic registration which is the*
8 *basis for the international application has been restricted,*
9 *abandoned, or cancelled, or has expired, with respect to*
10 *some or all of the goods and services listed in the inter-*
11 *national registration—*

12 *“(1) within 5 years after the international reg-*
13 *istration date; or*

14 *“(2) more than 5 years after the international*
15 *registration date if the restriction, abandonment, or*
16 *cancellation of the basic application or basic registra-*
17 *tion resulted from an action that began before the end*
18 *of that 5-year period.*

19 **“SEC. 64. REQUEST FOR EXTENSION OF PROTECTION SUB-**
20 **SEQUENT TO INTERNATIONAL REGISTRA-**
21 **TION.**

22 *“The holder of an international registration that is*
23 *based upon a basic application filed with the Patent and*
24 *Trademark Office or a basic registration granted by the*
25 *Patent and Trademark Office may request an extension of*

1 *protection of its international registration by filing such*
2 *a request—*

3 *“(1) directly with the International Bureau, or*

4 *“(2) with the Patent and Trademark Office for*
5 *transmittal to the International Bureau, if the request*
6 *is in such form, and contains such transmittal fee, as*
7 *may be prescribed by the Commissioner.*

8 **“SEC. 65. EXTENSION OF PROTECTION OF AN INTER-**
9 **NATIONAL REGISTRATION TO THE UNITED**
10 **STATES UNDER THE MADRID PROTOCOL.**

11 *“(a) IN GENERAL.—Subject to the provisions of section*
12 *68, the holder of an international registration shall be enti-*
13 *tled to the benefits of extension of protection of that inter-*
14 *national registration to the United States to the extent nec-*
15 *essary to give effect to any provision of the Madrid Protocol.*

16 *“(b) IF UNITED STATES IS OFFICE OF ORIGIN.—An*
17 *extension of protection resulting from an international reg-*
18 *istration of a mark shall not apply to the United States*
19 *if the Patent and Trademark Office is the office of origin*
20 *with respect to that mark.*

21 **“SEC. 66. EFFECT OF FILING A REQUEST FOR EXTENSION**
22 **OF PROTECTION OF AN INTERNATIONAL REG-**
23 **ISTRATION TO THE UNITED STATES.**

24 *“(a) REQUIREMENT FOR REQUEST FOR EXTENSION OF*
25 *PROTECTION.—A request for extension of protection of an*

1 *international registration to the United States that the*
2 *International Bureau transmits to the Patent and Trade-*
3 *mark Office shall be deemed to be properly filed in the Unit-*
4 *ed States if such request, when received by the International*
5 *Bureau, has attached to it a declaration of bona fide inten-*
6 *tion to use the mark in commerce that is verified by the*
7 *applicant for, or holder of, the international registration.*

8 “(b) *EFFECT OF PROPER FILING.*—*Unless extension of*
9 *protection is refused under section 68, the proper filing of*
10 *the request for extension of protection under subsection (a)*
11 *shall constitute constructive use of the mark, conferring the*
12 *same rights as those specified in section 7(c), as of the earli-*
13 *est of the following:*

14 “(1) *The international registration date, if the*
15 *request for extension of protection was filed in the*
16 *international application.*

17 “(2) *The date of recordal of the request for exten-*
18 *sion of protection, if the request for extension of pro-*
19 *tection was made after the international registration*
20 *date.*

21 “(3) *The date of priority claimed pursuant to*
22 *section 67.*

1 **“SEC. 67. RIGHT OF PRIORITY FOR REQUEST FOR EXTEN-**
2 **SION OF PROTECTION TO THE UNITED**
3 **STATES.**

4 *“The holder of an international registration with an*
5 *extension of protection to the United States shall be entitled*
6 *to claim a date of priority based on the right of priority*
7 *within the meaning of Article 4 of the Paris Convention*
8 *for the Protection of Industrial Property if—*

9 *“(1) the international registration contained a*
10 *claim of such priority; and*

11 *“(2)(A) the international application contained*
12 *a request for extension of protection to the United*
13 *States, or*

14 *“(B) the date of recordal of the request for exten-*
15 *sion of protection to the United States is not later*
16 *than 6 months after the date of the first regular na-*
17 *tional filing (within the meaning of Article 4(A)(3)*
18 *of the Paris Convention for the Protection of Indus-*
19 *trial Property) or a subsequent application (within*
20 *the meaning of Article 4(C)(4) of the Paris Conven-*
21 *tion).*

22 **“SEC. 68. EXAMINATION OF AND OPPOSITION TO REQUEST**
23 **FOR EXTENSION OF PROTECTION; NOTIFICA-**
24 **TION OF REFUSAL.**

25 *“(a) EXAMINATION AND OPPOSITION.—(1) A request*
26 *for extension of protection described in section 66(a) shall*

1 *be examined as an application for registration on the Prin-*
2 *icipal Register under this Act, and if on such examination*
3 *it appears that the applicant is entitled to extension of pro-*
4 *tection under this title, the Commissioner shall cause the*
5 *mark to be published in the Official Gazette of the Patent*
6 *and Trademark Office.*

7 “(2) *Subject to the provisions of subsection (c), a re-*
8 *quest for extension of protection under this title shall be*
9 *subject to opposition under section 13. Unless successfully*
10 *opposed, the request for extension of protection shall not be*
11 *refused.*

12 “(3) *Extension of protection shall not be refused under*
13 *this section on the ground that the mark has not been used*
14 *in commerce.*

15 “(4) *Extension of protection shall be refused under this*
16 *section to any mark not registrable on the Principal Reg-*
17 *ister.*

18 “(b) *NOTIFICATION OF REFUSAL.—If, a request for ex-*
19 *ension of protection is refused under subsection (a), the*
20 *Commissioner shall declare in a notification of refusal (as*
21 *provided in subsection (c)) that the extension of protection*
22 *cannot be granted, together with a statement of all grounds*
23 *on which the refusal was based.*

24 “(c) *NOTICE TO INTERNATIONAL BUREAU.—(1) With-*
25 *in 18 months after the date on which the International Bu-*

1 *reau transmits to the Patent and Trademark Office a notifi-*
2 *cation of a request for extension of protection, the Commis-*
3 *sioner shall transmit to the International Bureau any of*
4 *the following that applies to such request:*

5 “(A) A notification of refusal based on an exam-
6 ination of the request for extension of protection.

7 “(B) A notification of refusal based on the filing
8 of an opposition to the request.

9 “(C) A notification of the possibility that an op-
10 position to the request may be filed after the end of
11 that 18-month period.

12 “(2) If the Commissioner has sent a notification of the
13 possibility of opposition under paragraph (1)(C), the Com-
14 missioner shall, if applicable, transmit to the International
15 Bureau a notification of refusal on the basis of the opposi-
16 tion, together with a statement of all the grounds for the
17 opposition, within 7 months after the beginning of the oppo-
18 sition period or within 1 month after the end of the opposi-
19 tion period, whichever is earlier.

20 “(3) If a notification of refusal of a request for exten-
21 sion of protection is transmitted under paragraph (1) or
22 (2), no grounds for refusal of such request other than those
23 set forth in such notification may be transmitted to the
24 International Bureau by the Commissioner after the expira-

1 *tion of the time periods set forth in paragraph (1) or (2),*
2 *as the case may be.*

3 “(4) *If a notification specified in paragraph (1) or (2)*
4 *is not sent to the International Bureau within the time pe-*
5 *riod set forth in such paragraph, with respect to a request*
6 *for extension of protection, the request for extension of pro-*
7 *tection shall not be refused and the Commissioner shall issue*
8 *a certificate of extension of protection pursuant to the re-*
9 *quest.*

10 “(d) *DESIGNATION OF AGENT FOR SERVICE OF PROC-*
11 *ESS.—In responding to a notification of refusal with re-*
12 *spect to a mark, the holder of the international registration*
13 *of the mark shall designate, by a written document filed*
14 *in the Patent and Trademark Office, the name and address*
15 *of a person resident in the United States on whom may*
16 *be served notices or process in proceedings affecting the*
17 *mark. Such notices or process may be served upon the per-*
18 *son so designated by leaving with that person, or mailing*
19 *to that person, a copy thereof at the address specified in*
20 *the last designation so filed. If the person so designated can-*
21 *not be found at the address given in the last designation,*
22 *such notice or process may be served upon the Commis-*
23 *sioner.*

1 **“SEC. 69. EFFECT OF EXTENSION OF PROTECTION.**

2 “(a) *ISSUANCE OF EXTENSION OF PROTECTION.*—Un-
3 less a request for extension of protection is refused under
4 section 68, the Commissioner shall issue a certificate of ex-
5 tension of protection pursuant to the request and shall cause
6 notice of such certificate of extension of protection to be pub-
7 lished in the Official Gazette of the Patent and Trademark
8 Office.

9 “(b) *EFFECT OF EXTENSION OF PROTECTION.*—From
10 the date on which a certificate of extension of protection
11 is issued under subsection (a)—

12 “(1) such extension of protection shall have the
13 same effect and validity as a registration on the Prin-
14 cipal Register, and

15 “(2) the holder of the international registration
16 shall have the same rights and remedies as the owner
17 of a registration on the Principal Register.

18 **“SEC. 70. DEPENDENCE OF EXTENSION OF PROTECTION TO**
19 **THE UNITED STATES ON THE UNDERLYING**
20 **INTERNATIONAL REGISTRATION.**

21 “(a) *EFFECT OF CANCELLATION OF INTERNATIONAL*
22 *REGISTRATION.*—If the International Bureau notifies the
23 Patent and Trademark Office of the cancellation of an
24 international registration with respect to some or all of the
25 goods and services listed in the international registration,
26 the Commissioner shall cancel any extension of protection

1 *to the United States with respect to such goods and services*
2 *as of the date on which the international registration was*
3 *cancelled.*

4 “(b) *EFFECT OF FAILURE TO RENEW INTERNATIONAL*
5 *REGISTRATION.—If the International Bureau does not*
6 *renew an international registration, the corresponding ex-*
7 *tension of protection to the United States shall cease to be*
8 *valid as of the date of the expiration of the international*
9 *registration.*

10 “(c) *TRANSFORMATION OF AN EXTENSION OF PROTEC-*
11 *TION INTO A UNITED STATES APPLICATION.—The holder*
12 *of an international registration cancelled in whole or in*
13 *part by the International Bureau at the request of the office*
14 *of origin, under Article 6(4) of the Madrid Protocol, may*
15 *file an application, under section 1 or 44 of this Act, for*
16 *the registration of the same mark for any of the goods and*
17 *services to which the cancellation applies that were covered*
18 *by an extension of protection to the United States based*
19 *on that international registration. Such an application*
20 *shall be treated as if it had been filed on the international*
21 *registration date or the date of recordal of the request for*
22 *extension of protection with the International Bureau,*
23 *whichever date applies, and, if the extension of protection*
24 *enjoyed priority under section 67 of this title, shall enjoy*
25 *the same priority. Such an application shall be entitled to*

1 *the benefits conferred by this subsection only if the applica-*
2 *tion is filed not later than 3 months after the date on which*
3 *the international registration was canceled, in whole or in*
4 *part, and only if the application complies with all the re-*
5 *quirements of this Act which apply to any application filed*
6 *pursuant to section 1 or 44.*

7 ***“SEC. 71. AFFIDAVITS AND FEES.***

8 *“(a) REQUIRED AFFIDAVITS AND FEES.—An extension*
9 *of protection for which a certificate of extension of protec-*
10 *tion has been issued under section 69 shall remain in force*
11 *for the term of the international registration upon which*
12 *it is based, except that the extension of protection of any*
13 *mark shall be cancelled by the Commissioner—*

14 *“(1) at the end of the 6-year period beginning on*
15 *the date on which the certificate of extension of pro-*
16 *tection was issued by the Commissioner, unless within*
17 *the 1-year period preceding the expiration of that 6-*
18 *year period the holder of the international registra-*
19 *tion files in the Patent and Trademark Office an affi-*
20 *davit under subsection (b) together with a fee pre-*
21 *scribed by the Commissioner; and*

22 *“(2) at the end of the 10-year period beginning*
23 *on the date on which the certificate of extension of*
24 *protection was issued by the Commissioner, and at*
25 *the end of each 10-year period thereafter, unless—*

1 “(A) within the 6-month period preceding
2 the expiration of such 10-year period the holder
3 of the international registration files in the Pat-
4 ent and Trademark Office an affidavit under
5 subsection (b) together with a fee prescribed by
6 the Commissioner; or

7 “(B) within 3 months after the expiration
8 of such 10-year period, the holder of the inter-
9 national registration files in the Patent and
10 Trademark Office an affidavit under subsection
11 (b) together with the fee described in subpara-
12 graph (A) and an additional fee prescribed by
13 the Commissioner.

14 “(b) CONTENTS OF AFFIDAVIT.—The affidavit referred
15 to in subsection (a) shall set forth those goods or services
16 recited in the extension of protection on or in connection
17 with which the mark is in use in commerce and the holder
18 of the international registration shall attach to the affidavit
19 a specimen or facsimile showing the current use of the mark
20 in commerce, or shall set forth that any nonuse is due to
21 special circumstances which excuse such nonuse and is not
22 due to any intention to abandon the mark. Special notice
23 of the requirement for such affidavit shall be attached to
24 each certificate of extension of protection.

1 **“SEC. 72. ASSIGNMENT OF AN EXTENSION OF PROTECTION.**

2 *“An extension of protection may be assigned, together*
3 *with the goodwill associated with the mark, only to a person*
4 *who is a national of, is domiciled in, or has a bona fide*
5 *and effective industrial or commercial establishment either*
6 *in a country that is a Contracting Party or in a country*
7 *that is a member of an intergovernmental organization that*
8 *is a Contracting Party.*

9 **“SEC. 73. INCONTESTABILITY.**

10 *“The period of continuous use prescribed under section*
11 *15 for a mark covered by an extension of protection issued*
12 *under this title may begin no earlier than the date on which*
13 *the Commissioner issues the certificate of the extension of*
14 *protection under section 69, except as provided in section*
15 *74.*

16 **“SEC. 74. RIGHTS OF EXTENSION OF PROTECTION.**

17 *“An extension of protection shall convey the same*
18 *rights as an existing registration for the same mark, if—*

19 *“(1) the extension of protection and the existing*
20 *registration are owned by the same person;*

21 *“(2) the goods and services listed in the existing*
22 *registration are also listed in the extension of protec-*
23 *tion; and*

24 *“(3) the certificate of extension of protection is*
25 *issued after the date of the existing registration.”.*

1 **SEC. 3. EFFECTIVE DATE.**

2 *Subject to the satisfactory resolution of the issues relat-*
3 *ing to voting rights of member nations under the Madrid*
4 *Protocol, this Act shall take effect on the date on which the*
5 *Madrid Protocol enters into force with respect to the United*
6 *States.*

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