

Calendar No. 474

105TH CONGRESS
2^D SESSION**S. 2193**

To implement the provisions of the Trademark Law Treaty.

IN THE SENATE OF THE UNITED STATES

JUNE 18, 1998

Mr. HATCH (for himself and Mr. LEAHY) introduced the following bill; which was read twice and referred to the Committee on the Judiciary

JULY 16, 1998

Reported by Mr. HATCH, without amendment

A BILL

To implement the provisions of the Trademark Law Treaty.

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

3 **SECTION 1. SHORT TITLE.**

4 This Act may be cited as the “Trademark Law Trea-
5 ty Implementation Act”.

6 **SEC. 2. REFERENCE TO THE TRADEMARK ACT OF 1946.**

7 For purposes of this Act, the Act entitled “An Act
8 to provide for the registration and protection of trade-
9 marks used in commerce, to carry out the provisions of

1 certain international conventions, and for other purposes”,
2 approved July 5, 1946 (15 U.S.C. 1051 et seq.), shall be
3 referred to as the “Trademark Act of 1946”.

4 **SEC. 3. APPLICATION FOR REGISTRATION; VERIFICATION.**

5 (a) APPLICATION FOR USE OF TRADEMARK.—Sec-
6 tion 1(a) of the Trademark Act of 1946 (15 U.S.C.
7 1051(a)) is amended to read as follows:

8 “SECTION 1. (a)(1) The owner of a trademark used
9 in commerce may request registration of its trademark on
10 the principal register hereby established by paying the pre-
11 scribed fee and filing in the Patent and Trademark Office
12 an application and a verified statement, in such form as
13 may be prescribed by the Commissioner, and such number
14 of specimens or facsimiles of the mark as used as may
15 be required by the Commissioner.

16 “(2) The application shall include specification of the
17 applicant’s domicile and citizenship, the date of the appli-
18 cant’s first use of the mark, the date of the applicant’s
19 first use of the mark in commerce, the goods in connection
20 with which the mark is used, and a drawing of the mark.

21 “(3) The statement shall be verified by the applicant
22 and specify that—

23 “(A) the person making the verification believes
24 that he or she, or the juristic person in whose behalf

1 he or she makes the verification, to be the owner of
2 the mark sought to be registered;

3 “(B) to the best of the verifier’s knowledge and
4 belief, the facts recited in the application are accu-
5 rate;

6 “(C) the mark is in use in commerce; and

7 “(D) to the best of the verifier’s knowledge and
8 belief, no other person has the right to use such
9 mark in commerce either in the identical form there-
10 of or in such near resemblance thereto as to be like-
11 ly, when used on or in connection with the goods of
12 such other person, to cause confusion, or to cause
13 mistake, or to deceive, except that, in the case of
14 every application claiming concurrent use, the appli-
15 cant shall—

16 “(i) state exceptions to the claim of exclu-
17 sive use; and

18 “(ii) shall specify, to the extent of the ver-
19 ifier’s knowledge—

20 “(I) any concurrent use by others;

21 “(II) the goods on or in connection
22 with which and the areas in which each
23 concurrent use exists;

24 “(III) the periods of each use; and

1 “(IV) the goods and area for which
2 the applicant desires registration.

3 “(4) The applicant shall comply with such rules or
4 regulations as may be prescribed by the Commissioner.
5 The Commissioner shall promulgate rules prescribing the
6 requirements for the application and for obtaining a filing
7 date herein.”.

8 (b) APPLICATION FOR BONA FIDE INTENTION TO
9 USE TRADEMARK.—Subsection (b) of section 1 of the
10 Trademark Act of 1946 (15 U.S.C. 1051(b)) is amended
11 to read as follows:

12 “(b)(1) A person who has a bona fide intention,
13 under circumstances showing the good faith of such per-
14 son, to use a trademark in commerce may request reg-
15 istration of its trademark on the principal register hereby
16 established by paying the prescribed fee and filing in the
17 Patent and Trademark Office an application and a verified
18 statement, in such form as may be prescribed by the Com-
19 missioner.

20 “(2) The application shall include specification of the
21 applicant’s domicile and citizenship, the goods in connec-
22 tion with which the applicant has a bona fide intention
23 to use the mark, and a drawing of the mark.

24 “(3) The statement shall be verified by the applicant
25 and specify—

1 “(A) that the person making the verification be-
2 lieves that he or she, or the juristic person in whose
3 behalf he or she makes the verification, to be enti-
4 tled to use the mark in commerce;

5 “(B) the applicant’s bona fide intention to use
6 the mark in commerce;

7 “(C) that, to the best of the verifier’s knowl-
8 edge and belief, the facts recited in the application
9 are accurate; and

10 “(D) that, to the best of the verifier’s knowl-
11 edge and belief, no other person has the right to use
12 such mark in commerce either in the identical form
13 thereof or in such near resemblance thereto as to be
14 likely, when used on or in connection with the goods
15 of such other person, to cause confusion, or to cause
16 mistake, or to deceive.

17 Except for applications filed pursuant to section 44, no
18 mark shall be registered until the applicant has met the
19 requirements of subsections (c) and (d) of this section.

20 “(4) The applicant shall comply with such rules or
21 regulations as may be prescribed by the Commissioner.
22 The Commissioner shall promulgate rules prescribing the
23 requirements for the application and for obtaining a filing
24 date herein.”.

1 (c) CONSEQUENCE OF DELAYS.—Paragraph (4) of
2 section 1(d) of the Trademark Act of 1946 (15 U.S.C.
3 1051(d)(4)) is amended to read as follows:

4 “(4) The failure to timely file a verified statement
5 of use under paragraph (1) or an extension request under
6 paragraph (2) shall result in abandonment of the applica-
7 tion, unless it can be shown to the satisfaction of the Com-
8 missioner that the delay in responding was unintentional,
9 in which case the time for filing may be extended, but for
10 a period not to exceed the period specified in paragraphs
11 (1) and (2) for filing a statement of use.”.

12 **SEC. 4. REVIVAL OF ABANDONED APPLICATION.**

13 Section 12(b) of the Trademark Act of 1946 (15
14 U.S.C. 1062(b)) is amended in the last sentence by strik-
15 ing “unavoidable” and by inserting “unintentional”.

16 **SEC. 5. DURATION OF REGISTRATION; CANCELLATION; AF-
17 FIDAVIT OF CONTINUED USE; NOTICE OF
18 COMMISSIONER’S ACTION.**

19 Section 8 of the Trademark Act of 1946 (15 U.S.C.
20 1058) is amended to read as follows:

21 “DURATION

22 “SEC. 8. (a) Each registration shall remain in force
23 for 10 years, except that the registration of any mark shall
24 be canceled by the Commissioner for failure to comply
25 with the provisions of subsection (b) of this section, upon
26 the expiration of the following time periods, as applicable:

1 “(1) For registrations issued pursuant to the
2 provisions of this Act, at the end of 6 years follow-
3 ing the date of registration.

4 “(2) For registrations published under the pro-
5 visions of section 12(c), at the end of 6 years follow-
6 ing the date of publication under such section.

7 “(3) For all registrations, at the end of each
8 successive 10-year period following the date of reg-
9 istration.

10 “(b) During the 1-year period immediately preceding
11 the end of the applicable time period set forth in sub-
12 section (a), the owner of the registration shall pay the pre-
13 scribed fee and file in the Patent and Trademark Office—

14 “(1) an affidavit setting forth those goods or
15 services recited in the registration on or in connec-
16 tion with which the mark is in use in commerce and
17 such number of specimens or facsimiles showing cur-
18 rent use of the mark as may be required by the
19 Commissioner; or

20 “(2) an affidavit setting forth those goods or
21 services recited in the registration on or in connec-
22 tion with which the mark is not in use in commerce
23 and showing that any such nonuse is due to special
24 circumstances which excuse such nonuse and is not
25 due to any intention to abandon the mark.

1 “(c)(1) The owner of the registration may make the
2 submissions required under this section within a grace pe-
3 riod of 6 months after the end of the applicable time pe-
4 riod set forth in subsection (a). Such submission is re-
5 quired to be accompanied by a surcharge prescribed by
6 the Commissioner.

7 “(2) If any submission filed under this section is defi-
8 cient, the deficiency may be corrected after the statutory
9 time period and within the time prescribed after notifica-
10 tion of the deficiency. Such submission is required to be
11 accompanied by a surcharge prescribed by the Commis-
12 sioner.

13 “(d) Special notice of the requirement for affidavits
14 under this section shall be attached to each certificate of
15 registration and notice of publication under section 12(e).

16 “(e) The Commissioner shall notify any owner who
17 files 1 of the affidavits required by this section of the Com-
18 missioner’s acceptance or refusal thereof and, in the case
19 of a refusal, the reasons therefor.

20 “(f) If the registrant is not domiciled in the United
21 States, the registrant shall designate by a written docu-
22 ment filed in the Patent and Trademark Office the name
23 and address of some person resident in the United States
24 on whom may be served notices or process in proceedings
25 affecting the mark. Such notices or process may be served

1 upon the person so designated by leaving with that person
2 or mailing to that person a copy thereof at the address
3 specified in the last designation so filed. If the person so
4 designated cannot be found at the address given in the
5 last designation, such notice or process may be served
6 upon the Commissioner.”.

7 **SEC. 6. RENEWAL OF REGISTRATION.**

8 Section 9 of the Trademark Act of 1946 (15 U.S.C.
9 1059) is amended to read as follows:

10 “RENEWAL OF REGISTRATION

11 “SEC. 9. (a) Subject to the provisions of section 8,
12 each registration may be renewed for periods of 10 years
13 at the end of each successive 10-year period following the
14 date of registration upon payment of the prescribed fee
15 and the filing of a written application, in such form as
16 may be prescribed by the Commissioner. Such application
17 may be made at any time within 1 year before the end
18 of each successive 10-year period for which the registra-
19 tion was issued or renewed, or it may be made within a
20 grace period of 6 months after the end of each successive
21 10-year period, upon payment of a fee and surcharge pre-
22 scribed therefor. If any application filed under this section
23 is deficient, the deficiency may be corrected within the
24 time prescribed after notification of the deficiency, upon
25 payment of a surcharge prescribed therefor.

1 prior to the filing of an amendment under section 1(c)
2 to bring the application into conformity with section 1(a)
3 or the filing of the verified statement of use under section
4 1(d), except for an assignment to a successor to the busi-
5 ness of the applicant, or portion thereof, to which the
6 mark pertains, if that business is ongoing and existing.
7 In any assignment authorized by this section, it shall not
8 be necessary to include the good will of the business con-
9 nected with the use of and symbolized by any other mark
10 used in the business or by the name or style under which
11 the business is conducted. Assignments shall be by instru-
12 ments in writing duly executed. Acknowledgment shall be
13 prima facie evidence of the execution of an assignment,
14 and when the prescribed information reporting the assign-
15 ment is recorded in the Patent and Trademark Office, the
16 record shall be prima facie evidence of execution. An as-
17 signment shall be void against any subsequent purchaser
18 for valuable consideration without notice, unless the pre-
19 scribed information reporting the assignment is recorded
20 in the Patent and Trademark Office within 3 months after
21 the date of the subsequent purchase or prior to the subse-
22 quent purchase. The Patent and Trademark Office shall
23 maintain a record of information on assignments, in such
24 form as may be prescribed by the Commissioner.

1 “(b) An assignee not domiciled in the United States
 2 shall designate by a written document filed in the Patent
 3 and Trademark Office the name and address of some per-
 4 son resident in the United States on whom may be served
 5 notices or process in proceedings affecting the mark. Such
 6 notices or process may be served upon the person so des-
 7 ignated by leaving with that person or mailing to that per-
 8 son a copy thereof at the address specified in the last des-
 9 ignation so filed. If the person so designated cannot be
 10 found at the address given in the last designation, such
 11 notice or process may be served upon the Commissioner.”.

12 **SEC. 8. INTERNATIONAL CONVENTIONS; COPY OF FOREIGN**
 13 **REGISTRATION.**

14 Section 44 of the Trademark Act of 1946 (15 U.S.C.
 15 1126) is amended—

16 (1) in subsection (d)—

17 (A) by striking “23, or 44(e) of this Act”
 18 and inserting “or 23 of this Act or under sub-
 19 section (e) of this section”; and

20 (B) in paragraphs (3) and (4) by striking
 21 “this subsection (d)” and inserting “this sub-
 22 section”; and

23 (2) in subsection (e), by striking the second
 24 sentence and inserting the following: “Such appli-
 25 cant shall submit, within such time period as may be

1 prescribed by the Commissioner, a certification or a
2 certified copy of the registration in the country of
3 origin of the applicant.”.

4 **SEC. 9. TRANSITION PROVISIONS.**

5 (a) **REGISTRATIONS IN 20-YEAR TERM.**—The provi-
6 sions of section 8 of the Trademark Act of 1946, as
7 amended by section 5 of this Act, shall apply to a registra-
8 tion for trademark issued or renewed for a 20-year term,
9 if the expiration date of the registration is on or after the
10 effective date of this Act.

11 (b) **APPLICATIONS FOR REGISTRATION.**—This Act
12 and the amendments made by this Act shall apply to any
13 application for registration of a trademark pending on, or
14 filed on or after, the effective date of this Act.

15 (c) **AFFIDAVITS.**—The provisions of section 8 of the
16 Trademark Act of 1946, as amended by section 5 of this
17 Act, shall apply to the filing of an affidavit if the sixth
18 or tenth anniversary of the registration, or the sixth anni-
19 versary of publication of the registration under section
20 12(c) of the Trademark Act of 1946, for which the affida-
21 vit is filed is on or after the effective date of this Act.

22 (d) **RENEWAL APPLICATIONS.**—The amendment
23 made by section 6 shall apply to the filing of an applica-
24 tion for renewal of a registration if the expiration date

1 of the registration for which the renewal application is
2 filed is on or after the effective date of this Act.

3 **SEC. 10. EFFECTIVE DATE.**

4 This Act and the amendments made by this Act shall
5 take effect—

6 (1) on the date that is 1 year after the date of
7 the enactment of this Act, or

8 (2) upon the entry into force of the Trademark
9 Law Treaty with respect to the United States,

10 whichever occurs first.

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