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105TH CONGRESS
2D SESSION

S. 2193

AN ACT

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,*

1 **TITLE I—TRADEMARK LAW**
2 **TREATY IMPLEMENTATION**

3 **SEC. 101. SHORT TITLE.**

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

6 **SEC. 102. REFERENCE TO THE TRADEMARK ACT OF 1946.**

7 For purposes of this title, 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
10 certain international conventions, and for other purposes”,
11 approved July 5, 1946 (15 U.S.C. 1051 et seq.), shall be
12 referred to as the “Trademark Act of 1946”.

13 **SEC. 103. APPLICATION FOR REGISTRATION; VERIFICA-**
14 **TION.**

15 (a) APPLICATION FOR USE OF TRADEMARK.—Sec-
16 tion 1(a) of the Trademark Act of 1946 (15 U.S.C.
17 1051(a)) is amended to read as follows:

18 “SECTION 1. (a)(1) The owner of a trademark used
19 in commerce may request registration of its trademark on
20 the principal register hereby established by paying the pre-
21 scribed fee and filing in the Patent and Trademark Office
22 an application and a verified statement, in such form as
23 may be prescribed by the Commissioner, and such number
24 of specimens or facsimiles of the mark as used as may
25 be required by the Commissioner.

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

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

8 “(A) the person making the verification believes
9 that he or she, or the juristic person in whose behalf
10 he or she makes the verification, to be the owner of
11 the mark sought to be registered;

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

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

16 “(D) to the best of the verifier’s knowledge and
17 belief, no other person has the right to use such
18 mark in commerce either in the identical form there-
19 of or in such near resemblance thereto as to be like-
20 ly, when used on or in connection with the goods of
21 such other person, to cause confusion, or to cause
22 mistake, or to deceive, except that, in the case of
23 every application claiming concurrent use, the appli-
24 cant shall—

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

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

5 “(I) any concurrent use by others;

6 “(II) the goods on or in connection
7 with which and the areas in which each
8 concurrent use exists;

9 “(III) the periods of each use; and

10 “(IV) the goods and area for which
11 the applicant desires registration.

12 “(4) The applicant shall comply with such rules or
13 regulations as may be prescribed by the Commissioner.
14 The Commissioner shall promulgate rules prescribing the
15 requirements for the application and for obtaining a filing
16 date herein.”.

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

21 “(b)(1) A person who has a bona fide intention,
22 under circumstances showing the good faith of such per-
23 son, to use a trademark in commerce may request reg-
24 istration of its trademark on the principal register hereby
25 established by paying the prescribed fee and filing in the

1 Patent and Trademark Office an application and a verified
2 statement, in such form as may be prescribed by the Com-
3 missioner.

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

8 “(3) The statement shall be verified by the applicant
9 and specify—

10 “(A) that the person making the verification be-
11 lieves that he or she, or the juristic person in whose
12 behalf he or she makes the verification, to be enti-
13 tled to use the mark in commerce;

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

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

19 “(D) that, to the best of the verifier’s knowl-
20 edge and belief, no other person has the right to use
21 such mark in commerce either in the identical form
22 thereof or in such near resemblance thereto as to be
23 likely, when used on or in connection with the goods
24 of such other person, to cause confusion, or to cause
25 mistake, or to deceive.

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

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

9 (c) CONSEQUENCE OF DELAYS.—Paragraph (4) of
10 section 1(d) of the Trademark Act of 1946 (15 U.S.C.
11 1051(d)(4)) is amended to read as follows:

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

20 **SEC. 104. REVIVAL OF ABANDONED APPLICATION.**

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

1 **SEC. 105. DURATION OF REGISTRATION; CANCELLATION;**
2 **AFFIDAVIT OF CONTINUED USE; NOTICE OF**
3 **COMMISSIONER'S ACTION.**

4 Section 8 of the Trademark Act of 1946 (15 U.S.C.
5 1058) is amended to read as follows:

6 “DURATION

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

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

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

18 “(3) For all registrations, at the end of each
19 successive 10-year period following the date of reg-
20 istration.

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

25 “(1) an affidavit setting forth those goods or
26 services recited in the registration on or in connec-

1 tion with which the mark is in use in commerce and
2 such number of specimens or facsimiles showing cur-
3 rent use of the mark as may be required by the
4 Commissioner; or

5 “(2) an affidavit setting forth those goods or
6 services recited in the registration on or in connec-
7 tion with which the mark is not in use in commerce
8 and showing that any such nonuse is due to special
9 circumstances which excuse such nonuse and is not
10 due to any intention to abandon the mark.

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

17 “(2) If any submission filed under this section is defi-
18 cient, the deficiency may be corrected after the statutory
19 time period and within the time prescribed after notifica-
20 tion of the deficiency. Such submission is required to be
21 accompanied by a surcharge prescribed by the Commis-
22 sioner.

23 “(d) Special notice of the requirement for affidavits
24 under this section shall be attached to each certificate of
25 registration and notice of publication under section 12(c).

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

5 “(f) If the registrant is not domiciled in the United
6 States, the registrant shall designate by a written docu-
7 ment filed in the Patent and Trademark Office the name
8 and address of some person resident in the United States
9 on whom may be served notices or process in proceedings
10 affecting the mark. Such notices or process may be served
11 upon the person so designated by leaving with that person
12 or mailing to that person a copy thereof at the address
13 specified in the last designation so filed. If the person so
14 designated cannot be found at the address given in the
15 last designation, such notice or process may be served
16 upon the Commissioner.”.

17 **SEC. 106. RENEWAL OF REGISTRATION.**

18 Section 9 of the Trademark Act of 1946 (15 U.S.C.
19 1059) is amended to read as follows:

20 “RENEWAL OF REGISTRATION

21 “SEC. 9. (a) Subject to the provisions of section 8,
22 each registration may be renewed for periods of 10 years
23 at the end of each successive 10-year period following the
24 date of registration upon payment of the prescribed fee
25 and the filing of a written application, in such form as
26 may be prescribed by the Commissioner. Such application

1 may be made at any time within 1 year before the end
2 of each successive 10-year period for which the registra-
3 tion was issued or renewed, or it may be made within a
4 grace period of 6 months after the end of each successive
5 10-year period, upon payment of a fee and surcharge pre-
6 scribed therefor. If any application filed under this section
7 is deficient, the deficiency may be corrected within the
8 time prescribed after notification of the deficiency, upon
9 payment of a surcharge prescribed therefor.

10 “(b) If the Commissioner refuses to renew the reg-
11 istration, the Commissioner shall notify the registrant of
12 the Commissioner’s refusal and the reasons therefor.

13 “(c) If the registrant is not domiciled in the United
14 States, the registrant shall designate by a written docu-
15 ment filed in the Patent and Trademark Office the name
16 and address of some person resident in the United States
17 on whom may be served notices or process in proceedings
18 affecting the mark. Such notices or process may be served
19 upon the person so designated by leaving with that person
20 or mailing to that person a copy thereof at the address
21 specified in the last designation so filed. If the person so
22 designated cannot be found at the address given in the
23 last designation, such notice or process may be served
24 upon the Commissioner.”.

1 SEC. 107. RECORDING ASSIGNMENT OF MARK.

2 Section 10 of the Trademark Act of 1946 (15 U.S.C.
3 1060) is amended to read as follows:

4 “ASSIGNMENT

5 “SEC. 10. (a) A registered mark or a mark for which
6 an application to register has been filed shall be assignable
7 with the good will of the business in which the mark is
8 used, or with that part of the good will of the business
9 connected with the use of and symbolized by the mark.
10 Notwithstanding the preceding sentence, no application to
11 register a mark under section 1(b) shall be assignable
12 prior to the filing of an amendment under section 1(c)
13 to bring the application into conformity with section 1(a)
14 or the filing of the verified statement of use under section
15 1(d), except for an assignment to a successor to the busi-
16 ness of the applicant, or portion thereof, to which the
17 mark pertains, if that business is ongoing and existing.
18 In any assignment authorized by this section, it shall not
19 be necessary to include the good will of the business con-
20 nected with the use of and symbolized by any other mark
21 used in the business or by the name or style under which
22 the business is conducted. Assignments shall be by instru-
23 ments in writing duly executed. Acknowledgment shall be
24 prima facie evidence of the execution of an assignment,
25 and when the prescribed information reporting the assign-
26 ment is recorded in the Patent and Trademark Office, the

1 record shall be prima facie evidence of execution. An as-
2 signment shall be void against any subsequent purchaser
3 for valuable consideration without notice, unless the pre-
4 scribed information reporting the assignment is recorded
5 in the Patent and Trademark Office within 3 months after
6 the date of the subsequent purchase or prior to the subse-
7 quent purchase. The Patent and Trademark Office shall
8 maintain a record of information on assignments, in such
9 form as may be prescribed by the Commissioner.

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

21 **SEC. 108. INTERNATIONAL CONVENTIONS; COPY OF FOR-**
22 **EIGN REGISTRATION.**

23 Section 44 of the Trademark Act of 1946 (15 U.S.C.
24 1126) is amended—

25 (1) in subsection (d)—

1 (A) by striking “23, or 44(e) of this Act”
2 and inserting “or 23 of this Act or under sub-
3 section (e) of this section”; and

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

7 (2) in subsection (e), by striking the second
8 sentence and inserting the following: “Such appli-
9 cant shall submit, within such time period as may be
10 prescribed by the Commissioner, a certification or a
11 certified copy of the registration in the country of
12 origin of the applicant.”.

13 **SEC. 109. TRANSITION PROVISIONS.**

14 (a) **REGISTRATIONS IN 20-YEAR TERM.**—The provi-
15 sions of section 8 of the Trademark Act of 1946, as
16 amended by section 105 of this Act, shall apply to a reg-
17 istration for trademark issued or renewed for a 20-year
18 term, if the expiration date of the registration is on or
19 after the effective date of this Act.

20 (b) **APPLICATIONS FOR REGISTRATION.**—This title
21 and the amendments made by this title shall apply to any
22 application for registration of a trademark pending on, or
23 filed on or after, the effective date of this Act.

24 (c) **AFFIDAVITS.**—The provisions of section 8 of the
25 Trademark Act of 1946, as amended by section 105 of

1 this Act, shall apply to the filing of an affidavit if the sixth
 2 or tenth anniversary of the registration, or the sixth anni-
 3 versary of publication of the registration under section
 4 12(c) of the Trademark Act of 1946, for which the affida-
 5 vit is filed is on or after the effective date of this Act.

6 (d) RENEWAL APPLICATIONS.—The amendment
 7 made by section 106 shall apply to the filing of an applica-
 8 tion for renewal of a registration if the expiration date
 9 of the registration for which the renewal application is
 10 filed is on or after the effective date of this Act.

11 **SEC. 110. EFFECTIVE DATE.**

12 This title and the amendments made by this title
 13 shall take effect—

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

16 (2) upon the entry into force of the Trademark
 17 Law Treaty with respect to the United States,
 18 whichever occurs first.

19 **TITLE II—TECHNICAL**
 20 **CORRECTIONS**

21 **SEC. 201. TECHNICAL CORRECTIONS TO TRADEMARK ACT**
 22 **OF 1946.**

23 (a) IN GENERAL.—The Act entitled “An Act to pro-
 24 vide for the registration and protection of trademarks used
 25 in commerce, to carry out the provisions of certain inter-

1 national conventions, and for other purposes”, approved
2 July 5, 1946 (15 U.S.C. 1051 et seq.) (commonly referred
3 to as the Trademark Act of 1946), is amended as follows:

4 (1) Section 1(d)(1) (15 U.S.C. 1051(d)(1)) is
5 amended—

6 (A) by inserting “and,” after “specifying
7 the date of the applicant’s first use of the mark
8 in commerce”; and

9 (B) by striking “and, the mode or manner
10 in which the mark is used on or in connection
11 with such goods or services”.

12 (2) Section 2 (15 U.S.C. 1052) is amended—

13 (A) in subsection (e)—

14 (i) in paragraph (3) by striking “or”
15 after “them,”; and

16 (ii) by inserting before the period at
17 the end the following: “, or (5) comprises
18 any matter that, as a whole, is functional”;
19 and

20 (B) in subsection (f), by striking “para-
21 graphs (a), (b), (c), (d), and (e)(3)” and insert-
22 ing “subsections (a), (b), (c), (d), (e)(3), and
23 (e)(5)”.

1 (3) Section 7(a) (15 U.S.C. 1057(a)) is amend-
2 ed in the first sentence by striking the second period
3 at the end.

4 (4) Section 14(3) (15 U.S.C. 1064(3)) is
5 amended by inserting “or is functional,” before “or
6 has been abandoned”.

7 (5) Section 23(c) (15 U.S.C. 1091(c)) is
8 amended by striking “or device” and inserting “, de-
9 vice, any matter that as a whole is not functional,”.

10 (6) Section 26 (15 U.S.C. 1094) is amended by
11 striking “7(c),” and inserting “, 7(c),”.

12 (7) Section 31 (15 U.S.C. 1113) is amended—

13 (A) by striking—

14 “§ 31. Fees”;

15 and

16 (B) by striking “(a)” and inserting “SEC.
17 31. (a)”.

18 (8) Section 32(1) (15 U.S.C. 1114(1)) is
19 amended by striking “As used in this subsection”
20 and inserting “As used in this paragraph”.

21 (9) Section 33(b) (15 U.S.C. 1115(b)) is
22 amended—

23 (A) by redesignating paragraph (8) as
24 paragraph (9); and

1 (B) by inserting after paragraph (7) the
2 following:

3 “(8) That the mark is functional; or”.

4 (10) Section 39(a) (15 U.S.C. 1121(a)) is
5 amended by striking “circuit courts” and inserting
6 “courts”.

7 (11) Section 42 (15 U.S.C. 1124) is amended
8 by striking “the any domestic” and inserting “any
9 domestic”.

10 (12) The Act is amended by striking “trade-
11 mark” each place it appears in the text and the title
12 and inserting “trademark”.

13 (b) EFFECTIVE DATE.—The amendments made by
14 this section shall take effect on the date of enactment of
15 this Act, and shall apply only to any civil action filed or
16 proceeding before the United States Patent and Trade-
17 mark Office commenced on or after such date relating to
18 the registration of a mark.

19 **TITLE III—MISCELLANEOUS**
20 **PROVISIONS**

21 **SEC. 301. USE OF CERTIFICATION MARKS FOR ADVERTIS-**
22 **ING OR PROMOTIONAL PURPOSES.**

23 Section 14 of the Act entitled “An Act to provide for
24 the registration and protection of trademarks used in com-
25 merce, to carry out the provisions of certain international

1 conventions, and for other purposes”, approved July 5,
 2 1946 (15 U.S.C. 1064) (commonly referred to as the
 3 Trademark Act of 1946) is amended by adding at the end
 4 the following: “Nothing in paragraph (5) shall be deemed
 5 to prohibit the registrant from using its certification mark
 6 in advertising or promoting recognition of the certification
 7 program or of the goods or services meeting the certifi-
 8 cation standards of the registrant. Such uses of the certifi-
 9 cation mark shall not be grounds for cancellation under
 10 paragraph (5), so long as the registrant does not itself
 11 produce, manufacture, or sell any of the certified goods
 12 or services to which its identical certification mark is ap-
 13 plied.”.

14 **SEC. 302. OFFICIAL INSIGNIA OF NATIVE INDIAN TRIBES.**

15 (a) IN GENERAL.—The Commissioner of Patents and
 16 Trademarks shall study the issues surrounding the protec-
 17 tion of the official insignia of federally and State recog-
 18 nized Native American tribes. The study shall address at
 19 least the following issues:

20 (1) The impact on Native American tribes,
 21 trademark owners, the Patent and Trademark Of-
 22 fice, any other interested party, or the international
 23 legal obligations of the United States, of any change
 24 in law or policy with respect to—

1 (A) the prohibition of the Federal registra-
2 tion of trademarks identical to the official insig-
3 nia of Native American tribes;

4 (B) the prohibition of any new use of the
5 official insignia of Native American tribes; and

6 (C) appropriate defenses, including fair
7 use, to any claims of infringement.

8 (2) The means for establishing and maintaining
9 a listing of the official insignia of federally or State
10 recognized Native American tribes.

11 (3) An acceptable definition of the term “offi-
12 cial insignia” with respect to a federally or State
13 recognized Native American tribe.

14 (4) The administrative feasibility, including the
15 cost, of changing the current law or policy to—

16 (A) prohibit the registration, or prohibit
17 any new uses of the official insignia of State or
18 federally recognized Native American tribes; or

19 (B) otherwise give additional protection to
20 the official insignia of federally and State rec-
21 ognized Native American tribes.

22 (5) A determination of whether such protection
23 should be offered prospectively or retrospectively and
24 the impact of such protection.

1 (6) Any statutory changes that would be nec-
2 essary in order to provide such protection.

3 (7) Any other factors which may be relevant.

4 (b) COMMENT AND REPORT.—

5 (1) COMMENT.—Not later than 60 days after
6 the date of enactment of this Act, the Commissioner
7 shall initiate a request for public comment on the
8 issues identified and studied by the Commissioner
9 under subsection (a) and invite comment on any ad-
10 ditional issues that are not included in such request.
11 During the course of the public comment period, the
12 Commissioner shall use any appropriate additional
13 measures, including field hearings, to obtain as wide
14 a range of views as possible from Native American
15 tribes, trademark owners, and other interested par-
16 ties.

17 (2) REPORT.—Not later than September 30,
18 1999, the Commissioner of Patents and Trademarks
19 shall complete the study under this section and sub-
20 mit a report including the findings and conclusions
21 of the study to the chairman of the Committee on
22 the Judiciary of the Senate and the chairman of the

1 Committee on the Judiciary of the House of Rep-
2 resentatives.

Passed the Senate September 17, 1998.

Attest:

Secretary.

105TH CONGRESS
2D SESSION
S. 2193

AN ACT

To implement the provisions of the Trademark Law Treaty.

9

