

# S. 1568

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## IN THE SENATE OF THE UNITED STATES

MARCH 17, 1969

MR. DIRKSEN introduced the following bill, which was read twice and referred to the Committee on the Judiciary

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## A BILL

To amend the Act entitled "An Act to provide for the registration and protection of trademarks used in commerce, to carry out the provisions of international conventions, and for other purposes", approved July 5, 1946, as amended.

1 *Be it enacted by the Senate and House of Representa-*

2 *tives of the United States of America in Congress assembled,*

3 That section 1 of the Act entitled "An Act to provide for

4 the registration and protection of trademarks used in com-

5 merce, to carry out the provisions of international con-

6 ventions, and for other purposes", approved July 5, 1946

7 (60 Stat. 427), as amended, is amended to read as follows:

8 "SECTION 1. The owner of a trademark used in com-

9 merce may register his trademark under this Act on the

10 principal register hereby established:

1       “(a) By filing in the Patent Office a written appli-  
2 cation, in such form as may be prescribed by the Com-  
3 missioner, verified by the applicant, or by a member of  
4 the firm or an officer of the corporation or association  
5 applying—

6           “(1) specifying applicant’s domicile and citizen-  
7 ship, the date of applicant’s first use of the mark,  
8 the date of applicant’s first use of the mark in commerce,  
9 the goods in connection with which the mark is used, and  
10 the mode or manner in which the mark is used in connec-  
11 tion with such goods, and including a statement to the ef-  
12 fect that the person making the verification believes him-  
13 self, or the firm, corporation, or association in whose  
14 behalf he makes the verification, to be the owner of the  
15 mark sought to be registered, that the mark is in use in  
16 commerce, and that no other person, firm, corporation, or  
17 association, to the best of his knowledge and belief,  
18 has the right to use such mark in commerce either in the  
19 identical form thereof or in such near resemblance thereto  
20 as to be likely, when applied to the goods of such  
21 other person, to cause confusion, or to cause mistake, or  
22 to deceive: *Provided*, That in the case of every appli-  
23 cation claiming concurrent use the applicant shall state  
24 exceptions to his claim of exclusive use, in which he shall  
25 specify, to the extent of his knowledge, any concurrent

1 use by others, the goods in connection with which and  
2 the areas in which each concurrent use exists, the periods  
3 of each use, and the goods and area for which the appli-  
4 cant desires registration; or

5 “ (2) specifying applicant’s domicile and citizenship,  
6 applicant’s intent to use the mark in commerce, the  
7 goods in connection with which the mark is intended  
8 to be used and the mode or manner in which the mark  
9 is intended to be used in connection with such goods,  
10 and including a statement to the effect that the person  
11 making the verification believes himself, or the firm,  
12 corporation, or association in whose behalf he makes  
13 the verification, to be entitled to use the mark sought  
14 to be registered, and that no other person, firm, cor-  
15 poration or association, to the best of his knowledge  
16 and belief, is using such mark in commerce either in the  
17 identical form thereof or in such near resemblance thereto  
18 as to be likely, when applied to the goods of such other  
19 person, to cause confusion, or to cause mistake, or to de-  
20 ceive: *Provided*, That no registration shall issue until the  
21 applicant has filed in the Patent Office, together with the  
22 specimens or facsimiles of the mark as actually used, as  
23 required by section 1 (b) of this Act, a verified statement  
24 of use setting forth that the mark is in use in commerce  
25 by the applicant. the date of applicant’s first use of the

1 mark and the date of applicant's first use of the mark in  
2 commerce, those of the goods specified in the application  
3 in connection with which the mark is used and the mode  
4 or manner in which the mark is used in connection with  
5 such goods, and any registration issuing on an applica-  
6 tion filed under this section 1 (a) (2) shall specify only  
7 the goods recited in such statement as the latter is ac-  
8 cepted by the Commissioner. Such statement may be  
9 filed at any time after the application has been filed, and  
10 must be filed before the end of six months following the  
11 date of publication of the mark for opposition, unless  
12 sooner required as provided in sections 13 and 16 of  
13 this Act, and the failure to file such verified statement  
14 of use prior to the expiration of the specified period shall  
15 be deemed to be an abandonment of the application  
16 For good cause shown, the time for filing such verified  
17 statement of use may be extended by the Commissioner.  
18 The Commissioner shall notify any applicant who files  
19 such statement of his acceptance or refusal thereof and,  
20 if a refusal, the reasons therefor.

21 “(b) By filing in the Patent Office a drawing of the  
22 mark, and such number of specimens or facsimiles of the  
23 mark as actually used as may be required by the Commis-  
24 sioner.

25 “(c) By paying into the Patent Office the filing fee

1       “(d) By complying with such rules or regulations, not  
2 inconsistent with law, as may be prescribed by the Com-  
3 missioner.

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

15       SEC 2 The last sentence of subsection (a) of section 7  
16 of such Act is amended to read as follows: “The registration  
17 shall reproduce the mark, and state that the mark is regis-  
18 tered on the principal register under this Act, the date of the  
19 first use of the mark, the date of the first use of the mark in  
20 commerce, the particular goods or services for which it is  
21 registered, the number and date of the registration, the term  
22 thereof, the date on which the application for registration  
23 was received in the Patent Office, any conditions and limita-  
24 tions that may be imposed in the registration and, in the case

1 of a registration based upon an application filed under sec-  
2 tion 1 (a) (2) of this Act, the date of first publication of the  
3 mark by the Patent Office.”

4 SEC 3. (a) The first sentence of section 10 of such  
5 Act is amended by changing the period at the end there-  
6 of to a colon and adding the following proviso “*Provided,*  
7 That no rights arising out of an application to register filed  
8 under section 1 (a) (2) of this Act shall be assignable unless  
9 prior to the date of any such assignment the applicant origi-  
10 nally filing the application has filed the verified statement  
11 of use prescribed in section 1 (a) (2) of this Act.”

12 (b) The second paragraph of section 10 of such Act is  
13 amended by striking out “1 (d)” and inserting in lieu thereof  
14 “1 (e)”.

15 SEC. 4. Subsection (a) of section 12 of such Act is  
16 amended to read as follows

17 “(a) (1) Upon the filing of an application for registra-  
18 tion under section 1 (a) (1) of this Act and payment of  
19 the fee herein provided, the Commissioner shall promptly  
20 cause to be published, in the Official Gazette of the Patent  
21 Office, the mark, a statement of the goods as specified in the  
22 application, the name and address of the applicant, the date  
23 of first use claimed by the applicant, and the filing date of  
24 the application. *Provided,* The Commissioner may refuse to  
25 publish hereunder any mark which consists of or comprises

1 immoral or scandalous matter, in which event he shall notify  
2 the applicant of his refusal and the reasons therefor. The  
3 Commissioner shall refer the application for registration of  
4 the mark so published to the examiner in charge of the regis-  
5 tration of marks, who shall cause an examination to be made  
6 and, if on such examination it shall appear that the applicant  
7 is entitled to registration, the Commissioner shall cause the  
8 mark to be published for opposition in the Official Gazette of  
9 the Patent Office, and the Commissioner shall include in the  
10 publication for opposition the date of initial publication here-  
11 under. *Provided further*, That in the case of an applicant  
12 claiming concurrent use, or in the case of an application to  
13 be placed in an interference as provided for in section 16 of  
14 this Act, the mark, if otherwise registrable, may be published  
15 subject to the determination of the rights of the parties to  
16 such proceedings.

17 “(2) Upon the filing of an application for registration  
18 under section 1 (a) (2) of this Act and payment of the fee  
19 herein provided, the Commissioner shall promptly cause to  
20 be published, in the Official Gazette of the Patent Office, the  
21 mark, a statement of the goods as specified in the application  
22 the name and address of the applicant, and the filing date of  
23 the application. *Provided*, The Commissioner may refuse to  
24 publish hereunder any mark which consists of or comprises  
25 immoral or scandalous matter, in which event he shall notify

1 the applicant of his refusal and the reasons therefor. The  
2 Commissioner shall refer the application for registration of  
3 the mark so published to the examiner in charge of the regis-  
4 tration of marks, who shall cause an examination to be made  
5 and, if on such examination it shall appear that the applicant  
6 would be entitled to registration upon the filing of the verified  
7 statement of use prescribed in section 1 (a) (2) of this Act,  
8 the Commissioner shall cause the mark to be published for  
9 opposition in the Official Gazette of the Patent Office. The  
10 Commissioner shall include in the publication for opposition  
11 the date of initial publication hereunder, and in the event  
12 such verified statement of use has been duly filed, the Com-  
13 missioner shall also include a statement of the goods for  
14 which the mark is in use, the date of applicant's first use of  
15 the mark, and the date of applicant's first use of the mark  
16 in commerce."

17       SEC 5. The first two sentences of section 13 of such Act  
18 are amended to read as follows: "Any person who believes  
19 that he would be damaged by the registration of a mark upon  
20 the principal register may, upon payment of the required  
21 fee, file a verified opposition in the Patent Office, stating  
22 the grounds therefor, within thirty days after the publication  
23 for opposition under subsection (a) of section 12 of this Act  
24 of the mark sought to be registered: *Provided*, That in the  
25 case of an opposition against an application filed under sec-

1 tion 1 (a) (2) of this Act in which the prescribed verified  
2 statement of use has not been filed, the Commissioner shall  
3 give the applicant ninety days within which to file such veri-  
4 fied statement of use. For good cause shown, the times for  
5 filing opposition and such verified statement of use may be  
6 extended by the Commissioner, who shall notify the parties.”

7 SEC. 6. The first sentence of section 16 of such Act is  
8 amended to read as follows: “Whenever application is made  
9 for the registration of a mark which so resembles a mark  
10 previously registered by another, or for the registration of  
11 which another has previously made application, as to be  
12 likely when applied to the goods or when used in connection  
13 with the services of the applicant to cause confusion or mis-  
14 take or to deceive, the Commissioner may declare that an  
15 interference exists *Provided*, That in the case of an inter-  
16 ference involving an applicant under section 1 (a) (2) of  
17 this Act. in which the prescribed verified statement of use  
18 has not been filed, the Commissioner shall give the applicant  
19 ninety days within which to file such verified statement of  
20 use.”

21 SEC 7. Section 26 of such Act is amended by inserting  
22 “1 (a) (2),” after the word “sections”, and inserting “(1),  
23 12 (a) (2),” after “12 (a)”.

24 SEC 8 Section 31 of such Act is amended by striking  
25 out “On filing each original application for registration of a

1 mark in each class on either the principal or the supplemental  
2 register, \$25,' and inserting in lieu thereof "On filing each  
3 original application under section 1 (a) (1) hereof for regis-  
4 tration of a mark in each class on either the principal or the  
5 supplemental register, \$35, on filing each original applica-  
6 tion under section 1 (a) (2) hereof for registration of a mark  
7 in each class on the principal register, \$70,".

8 SEC. 9. Section 33 of such Act is amended by adding the  
9 following new subsections:

10 " (c) For the purposes of this Act, an applicant filing  
11 an application under section 1 (a) (2) of this Act, or a reg-  
12 istrant of a registration resulting from such an application,  
13 shall be accorded priority as against any other person except  
14 one who—

15 " (1) prior to the initial publication of the mark  
16 under section 12 (a) (2) of this Act has commenced  
17 use of, and has not abandoned, a mark or trade name  
18 which so resembles the mark of said applicant or regis-  
19 trant as to be likely, when applied to the goods of said  
20 other person, to cause confusion, to cause mistake, or to  
21 deceive, or

22 " (2) previously has filed an application under sec-  
23 tion 1 (a) (2) of this Act, for registration of a mark  
24 which so resembles the mark of the said applicant or said  
25 registrant as to be likely, when applied to the goods

1 recited by the prior applicant, to cause confusion, to  
2 cause mistake, or to deceive: *Provided*, That the first  
3 filed application is followed by the verified statement of  
4 use prescribed in section 1 (a) (2) of this Act, or

5 “(3) has acquired a right of priority pursuant to  
6 section 44 (d) based on a foreign application filed prior  
7 to the filing of said application under section 1 (a) (2)  
8 of this Act.”

9 SEC. 10. These amendments to the Act shall become  
10 effective ninety days after their enactment.

91st CONGRESS  
1st Session

S. 1568

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**A BILL**

To amend the Act entitled "An Act to provide for the registration and protection of trademarks used in commerce, to carry out the provisions of international conventions, and for other purposes", approved July 5, 1946, as amended

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By **MI DIRKSEN**

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Read twice and referred to the Committee on the  
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