

88TH CONGRESS
2D SESSION

S. 2786

IN THE SENATE OF THE UNITED STATES

APRIL 29 (legislative day, MARCH 30), 1964

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

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 conven-
6 tions, and for other purposes", approved July 5, 1946 (60
7 Stat. 427), as amended, is amended to read as follows:

8 "SEC. 1. The owner of a trademark used in commerce

1 may register his trademark under this Act on the principal
2 register hereby established:

3 “(a) By filing in the Patent Office a written applica-
4 tion, in such form as may be prescribed by the Commis-
5 sioner, verified by the applicant, or by a member of the firm
6 or an officer of the corporation or association applying:

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

1 in which he shall specify, to the extent of his knowledge,
2 any concurrent use by others, the goods in connection
3 with which and the areas in which each concurrent use
4 exists, the periods of each use, and the goods and area
5 for which the applicant desires registration; or

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

1 merce by the applicant, the date of applicant's first use
2 of the mark and the date of applicant's first use of the
3 mark in commerce, the goods in connection with which
4 the mark is used and the mode or manner in which the
5 mark is used in connection with such goods.

6 “(b) By filing in the Patent Office a drawing of the
7 mark, and such number of specimens or facsimiles of the
8 mark as actually used as may be required by the Com-
9 missioner.

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

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

14 “(e) If the applicant is not domiciled in the United
15 States he shall designate by a written document filed in the
16 Patent Office the name and address of some person resident in
17 the United States on whom may be served notices or process
18 in proceedings affecting the mark. Such notices or process
19 may be served upon the person so designated by leaving with
20 him or mailing to him a copy thereof at the address specified
21 in the last designation so filed. If the person so designated
22 cannot be found at the address given in the last designation,

1 such notice or process may be served upon the Commis-
2 sioner.”

3 SEC. 2. The last sentence of subsection (a) of section 7
4 of such Act is amended to read as follows: “The registration
5 shall reproduce the mark, and state that the mark is regis-
6 tered on the principal register under this Act, the date of
7 the first use of the mark, the date of the first use of the
8 mark in commerce, the particular goods or services for which
9 it is registered, the number and date of the registration, the
10 term thereof, the date on which the application for registra-
11 tion was received in the Patent Office, any conditions and
12 limitations that may be imposed in the registration and, in the
13 case of a registration based upon an application filed under
14 section 1 (a) (2) of this Act, the date of first publication
15 of the mark by the Patent Office.”

16 SEC. 3. (a) The first sentence of section 10 of such Act
17 is amended by changing the period at the end thereto to a
18 colon and adding the following proviso: “*Provided*, That
19 no rights arising out of an application to register filed under
20 section 1 (a) (2) of this Act shall be assignable unless prior
21 to the date of any such assignment the applicant originally

1 filing the application has filed the verified statement of use
2 prescribed in section 1 (a) (2) of this Act.”.

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

6 SEC. 4. Subsection (a) of section 12 of such Act is
7 amended to read as follows:

8 “(a) (1) Upon the filing of an application for registra-
9 tion under section 1 (a) (1) of this Act and payment of the
10 fee herein provided, the Commissioner shall refer the appli-
11 cation to the examiner in charge of the registration of marks,
12 who shall cause an examination to be made and, if on such
13 examination it shall appear that the applicant is entitled
14 to registration, the Commissioner shall cause the mark to
15 be published for opposition in the Official Gazette of the
16 Patent Office: *Provided*, That in the case of an applicant
17 claiming concurrent use, or in the case of an application to
18 be placed in an interference as provided for in section 16 of
19 this Act, the mark, if otherwise registrable, may be published
20 subject to the determination of the rights of the parties to
21 such proceedings.

22 “(2) Upon the filing of an application for registration
23 under section 1 (a) (2) of this Act and payment of the fee
24 herein provided, the Commissioner shall promptly cause to
25 be published, in the Official Gazette of the Patent Office, the

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

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

1 of an application filed under section 1 (a) (2) of this Act in
2 which the prescribed verified statement of use has not been
3 filed, the Commissioner shall give the applicant ninety days
4 within which to file such verified statement of use, and the
5 failure to file such verified statement of use within such
6 ninety-day period shall be deemed to be an abandonment of
7 the application. For good cause shown, the times for filing
8 opposition and such verified statement of use may be extended
9 by the Commissioner, who shall notify the parties.”

10 SEC. 6. Section 26 of such Act is amended by inserting
11 “1 (a) (2),” after the word “sections”; and inserting “(1),
12 12 (a) (2),” after “12 (a)”.

13 SEC. 7. Section 31 of such Act is amended by striking
14 out “On filing each original application for registration of a
15 mark in each class on either the principal or the supple-
16 mental register, \$25;” and inserting in lieu thereof “On filing
17 each original application under section 1 (a) (1) hereof for
18 registration of a mark in each class on either the principal
19 or the supplemental register, \$25; on filing each original
20 application under section 1 (a) (2) hereof for registration of
21 a mark in each class on the principal register, \$50;”.

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

24 “(c) For the purposes of this Act, an applicant filing
25 an application under section 1 (a) (2) of this Act, or a

1 registrant of a registration resulting from such an applica-
2 tion, shall be accorded priority as against any other person
3 except one who—

4 “(1) prior to the initial publication of the mark
5 under section 12 (a) (2) of this Act has commenced use
6 of, and has not abandoned, a mark or trade name which
7 so resembles the mark of said applicant or registrant as
8 to be likely, when applied to the goods of said other
9 person, to cause confusion, to cause mistake, or to de-
10 ceive, or

11 “(2) previously has filed an application under sec-
12 tion 1 (a) (2) of this Act, for registration of a mark
13 which so resembles the mark of the said applicant or
14 said registrant as to be likely, when applied to the goods
15 recited by the prior applicant, to cause confusion, to
16 cause mistake, or to deceive: *Provided*, That the first
17 filed application is followed by the verified statement
18 of use prescribed in section 1 (a) (2) of this Act, or

19 “(3) has acquired a right of priority pursuant to
20 section 44 (d) based on a foreign application filed prior
21 to the filing of said application under section 1 (a) (2)
22 of this Act.

23 “(d) In the case of a mark published under section
24 12 (a) (2) of this Act against which no opposition has been
25 filed or interference declared, the Commissioner shall reg-

1 ister the mark and issue a certificate of registration provided
2 that the verified statement of use prescribed in section 1 (a)
3 (2) of this Act has been filed; and the failure to file such
4 verified statement of use prior to the expiration of six months
5 from the date of publication for opposition shall be deemed
6 to be an abandonment of the application. For good cause
7 shown, the time for filing such verified statement of use may
8 be extended by the Commissioner.”

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By **MI DIRKSEN**

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Read twice and referred to the Committee on the
Judiciary