

91ST CONGRESS
1ST SESSION

H. R. 14050

IN THE HOUSE OF REPRESENTATIVES

SEPTEMBER 29, 1969

MR. KASTENMEIER introduced the following bill, which was 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 "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 application,
2 in such form as may be prescribed by the Commissioner,
3 verified by the applicant, or by a member of the firm or an
4 officer of the corporation or association applying—

5 “(1) specifying applicant’s domicile and citizen-
6 ship, the date of applicant’s first use of the mark, the
7 date of applicant’s first use of the mark in commerce, the
8 goods in connection with which the mark is used, and the
9 mode or manner in which the mark is used in connection
10 with such goods, and including a statement to the effect
11 that the person making the verification believes himself,
12 or the firm, corporation, or association in whose behalf
13 he makes the verification, to be the owner of the mark
14 sought to be registered, that the mark is in use in com-
15 merce, and that no other person, firm, corporation, or
16 association, to the best of his knowledge and belief, has
17 the right to use such mark in commerce either in the
18 identical form thereof or in such near resemblance thereto
19 as 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 in the case of every application
22 claiming concurrent use the applicant shall state excep-
23 tions to his claim of exclusive use, in which he shall
24 specify, to the extent of his knowledge, any concurrent
25 use by others, the goods in connection with which and

1 the areas in which each concurrent use exists, the periods
2 of each use, and the goods and area for which the ap-
3 plicant desires registration, or

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

1 of applicant's first use of the mark in commerce, those of
2 the goods specified in the applicant in connection with
3 which the mark is used and the mode or manner in
4 which the mark is used in connection with such goods,
5 and any registration issuing on an application filed under
6 this section 1 (a) (2) shall specify only the goods recited
7 in such statement as the latter is accepted by the Com-
8 missioner. Such statement may be filed at any time after
9 the application has been filed, and must be filed before
10 the end of six months following the date of publication
11 of the mark for opposition, unless sooner required as
12 provided in sections 13 and 16 of this Act, and the fail-
13 ure to file such verified statement of use prior to the
14 expiration of the specified period shall be deemed to be
15 an abandonment of the application. In exceptional cir-
16 cumstances, the time for filing such verified statement of
17 use may be extended by the Commissioner. The Com-
18 missioner shall notify any applicant who files such state-
19 ment of his acceptance or refusal thereof and, if a refusal,
20 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 leav-
10 ing with him or mailing to him a copy thereof at the address
11 specified in the last designation so filed. If the person so
12 designated cannot be found at the address given in the last
13 designation, such notice or process may be served upon the
14 Commissioner.”

15 SEC. 2. (a) The first sentence of section 10 of such Act
16 is amended by changing the period at the end thereof to a
17 colon and adding the following proviso: “*Provided*, That no
18 application to register filed under section 1 (a) (2) of this
19 Act shall be assignable prior to the date the applicant orig-
20 inally filing the application has filed the verified state-
21 ment of use prescribed in section 1 (a) (2) of this Act; ex-
22 cept to a successor to the entire business of the original appli-
23 cant for registration, which successor may file the verified
24 statement of use.”

1 (b) The second paragraph of section 10 of such Act is
2 amended by striking out "1 (d)" and inserting in lieu there-
3 of "1 (e)".

4 SEC. 3. Subsection (a) of section 12 of such Act is
5 amended to read as follows:

6 " (a) (1) Upon the filing of an application for registra-
7 tion under section 1 (a) (1) of this Act and payment of
8 the fee herein provided, the Commissioner shall promptly
9 cause to be published, in the Official Gazette of the Patent
10 Office, the mark, a statement of the goods as specified in
11 the application, the name and address of the applicant, the
12 date of first use claimed by the applicant, and the filing
13 date of the application *Provided*, The Commissioner may
14 refuse to publish hereunder any mark which consists of or
15 comprises obviously immoral or scandalous matter, or simi-
16 lar matter obviously unfit for publication, in which event
17 he shall notify the applicant of his refusal and the reasons
18 therefor. The Commissioner shall refer the application for
19 registration of the mark so published to the examiner in
20 charge of the registration of marks, who shall cause an ex-
21 amination to be made and, if on such examination it shall
22 appear that the applicant is entitled to registration, the Com-
23 missioner shall cause the mark to be published for opposi-
24 tion in the Official Gazette of the Patent Office, and the
25 Commissioner shall include in the publication for opposition

1 the date of initial publication hereunder: *Provided further*,
2 That in the case of an applicant claiming concurrent use,
3 or in the case of an application to be placed in an intel-
4 ference as provided for in section 16 of this Act, the mark,
5 if otherwise registrable, may be published subject to the de-
6 termination of the rights of the parties to such proceedings.

7 “(2) Upon the filing of an application for registration
8 under section 1 (a) (2) of this Act and payment of the fee
9 herein provided, the Commissioner shall promptly cause to
10 be published, in the Official Gazette of the Patent Office, the
11 mark, a statement of the goods as specified in the applica-
12 tion, the name and address of the applicant, and the filing
13 date of the application: *Provided*, The Commissioner may
14 refuse to publish hereunder any mark which consists of or
15 comprises obviously immoral or scandalous matter, or similar
16 matter obviously unfit for publication, in which event he
17 shall notify the applicant of his refusal and the reasons there-
18 for. The Commissioner shall refer the application for regis-
19 tration of the mark so published to the examiner in charge
20 of the registration of marks, who shall cause an examination
21 to be made, and if on such examination it shall appear that
22 the applicant would be entitled to registration upon the filing
23 of the verified statement of use prescribed in section 1 (a) (2)
24 of this Act, the Commissioner shall cause the mark to be
25 published for opposition in the Official Gazette of the Patent

1 Office. The Commissioner shall include in the publication for
2 opposition the date of filing of the application for registration
3 hereunder, and in the event such verified statement of use
4 has been duly filed, the Commissioner shall also include a
5 statement of the goods for which the mark is in use, the date
6 of applicant's first use of the mark, and the date of appli-
7 cant's first use of the mark in commerce."

8 SEC. 4. The first two sentences of section 13 of such Act
9 are amended to read as follows: "Any person who believes
10 that he would be damaged by the registration of a mark
11 upon the principal register may, upon payment of the re-
12 quired fee, file a verified opposition in the Patent Office, stat-
13 ing the grounds therefor, within thirty days after the publi-
14 cation for opposition under subsection (a) of section 12 of
15 this Act of the mark sought to be registered: *Provided*, That
16 in the case of an opposition against an application filed under
17 section 1 (a) (2) of this Act in which the prescribed verified
18 statement of use has not been filed, the Commissioner shall
19 give the applicant ninety days within which to file such
20 verified statement of use. For good cause shown, the time
21 for filing, an opposition may be extended by the Commis-
22 sioner, who shall notify the parties."

23 SEC. 5. The first sentence of section 16 of such Act is
24 amended to read as follows: "Whenever application is made
25 for the registration of a mark which so resembles a mark

1 previously registered by another, or for the registration of
2 which another has previously made application, as to be
3 likely when applied to the goods or when used in connection
4 with the services of the applicant to cause confusion or mis-
5 take or to deceive, the Commissioner may declare that an
6 interference exists *Provided*, That in the case of an inter-
7 ference involving an applicant under section 1 (a) (2) of
8 this Act, in which the prescribed verified statement of use
9 has not been filed, the Commission shall give the applicant
10 ninety days within which to file such verified statement of
11 use.”

12 SEC. 6. Section 26 of such Act is amended by inserting
13 “1 (a) (2),” after the word “sections”, and inserting “(1),
14 12 (a) (2),” after “12 (a)”.

15 SEC. 7. Section 31 of such Act is amended by striking
16 out “On filing each original application for registration of
17 a mark in each class, \$35.” and inserting in lieu thereof “On
18 filing each original application under section 1 (a) (1)
19 hereof for registration of a mark in each class on either the
20 principal or the supplemental register, \$50, on filing each
21 original application under section 1 (a) (2) hereof or regis-
22 tration of a mark in each class on the principal register,
23 \$100 ”

24 SEC. 8. Section 33 of such Act is amended by adding the
25 following new subsection:

1 “(c) For the purpose of this Act, an application filed
2 under the provisions of section 1 (a) (2), or registration re-
3 sulting from such application, shall be accorded the same force
4 and effect as if the applicant or registrant had commenced use
5 of the mark in commerce on the goods specified in the state-
6 ment of use on the date of filing of the application.”

7 SEC. 9. These amendments to the Act shall become effec-
8 tive ninety days after their enactment.

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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

By **MI KASILNMLIER**

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