

90TH CONGRESS
1ST SESSION

S. 1858

IN THE SENATE OF THE UNITED STATES

MAY 24, 1967

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

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

1 merce may register his trademark under this Act on the
2 principal 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 Commissioner,
5 verified by the applicant, or by a member of the firm or
6 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 the
11 mode or manner in which the mark is used in connection
12 with such goods, and including a statement to the effect
13 that the person making the verification believes himself,
14 or the firm, corporation, or association in whose behalf
15 he makes the verification, to be the owner of the mark
16 sought to be registered, that the mark is in use in com-
17 merce, and that no other person, firm, corporation, or
18 association, to the best of his knowledge and belief, has
19 the right to use such mark in commerce either in the
20 identical form thereof or in such near resemblance there-
21 to as to be likely, when applied to the goods of such
22 other person, to cause confusion, or to cause mistake, or
23 to deceive. *Provided*, That in the case of every applica-
24 tion claiming concurrent use the applicant shall state
25 exceptions to his claim of exclusive use, in which he shall

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

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

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

23 " (b) By filing in the Patent Office a drawing of the
24 mark, and such number of specimens or facsimiles of the

1 mark as actually used as may be required by the Commis-
2 sioner.

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

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

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

18 SEC. 2. The last sentence of subsection (a) of section 7
19 of such Act is amended to read as follows: “The registration
20 shall reproduce the mark, and state that the mark is regis-
21 tered on the principal register under this Act, the date of the
22 first use of the mark, the date of the first use of the mark in
23 commerce, the particular goods or services for which it is

1 registered, the number and date of the registration, the term
2 thereof, the date on which the application for registration
3 was received in the Patent Office, any conditions and limita-
4 tions that may be imposed in the registration and, in the case
5 of a registration based upon an application filed under sec-
6 tion 1 (a) (2) of this Act, the date of first publication of the
7 mark by the Patent Office.”

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

16 (b) The second paragraph of section 10 of such Act is
17 amended by striking out “1 (d)” and inserting in lieu thereof
18 “1 (e)”.

19 SEC 4 Subsection (a) of section 12 of such Act is
20 amended to read as follows

21 “(a) (1) Upon the filing of an application for registra-
22 tion under section 1 (a) (1) of this Act and payment of
23 the fee herein provided, the Commissioner shall refer the
24 application to the examiner in charge of the registration
25 of marks, who shall cause an examination to be made and,

1 if on such examination it shall appear that the applicant
2 is entitled to registration, the Commissioner shall cause the
3 mark to be published for opposition in the Official Gazette
4 of the Patent Office. *Provided*, That in the case of an
5 applicant claiming concurrent use, or in the case of an ap-
6 plication to be placed in an interference as provided for
7 in section 16 of this Act, the mark, if otherwise registrable,
8 may be published subject to the determination of the rights
9 of the parties to such proceedings.

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

1 the Commissioner shall cause the mark to be published for
2 opposition in the Official Gazette of the Patent Office. The
3 Commissioner shall include in the publication for opposition
4 the date of initial publication hereunder, and in the event
5 such verified statement of use has been duly filed, the Com-
6 missioner shall also include a statement of the goods for
7 which the mark is in use, the date of applicant's first use of
8 the mark, and the date of applicant's first use of the mark in
9 commerce."

10 SEC. 5. The first two sentences of section 13 of such Act
11 are amended to read as follows: "Any person who believes
12 that he would be damaged by the registration of a mark upon
13 the principal register may, upon payment of the required
14 fee, file a verified opposition in the Patent Office, stating
15 the grounds therefor, within thirty days after the publication
16 for opposition under subsection (a) of section 12 of this Act
17 of the mark sought to be registered: *Provided*, That in the
18 case of an opposition against an application filed under sec-
19 tion 1 (a) (2) of this Act in which the prescribed verified
20 statement of use has not been filed, the Commissioner shall
21 give the applicant ninety days within which to file such veri-
22 fied statement of use."

23 SEC. 6. The first sentence of section 16 of such Act is
24 amended to read as follows: "Whenever application is made

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

13 SEC. 7. Section 26 of such Act is amended by inserting
14 “1 (a) (2),” after the word “sections”; and inserting “(1),
15 12 (a) (2),” after “12 (a)”.

16 SEC. 8. Section 31 of such Act is amended by striking
17 out “On filing each original application for registration of a
18 mark in each class on either the principal or the supplemental
19 register, \$25;” and inserting in lieu thereof “On filing each
20 original application under section 1 (a) (1) hereof for regis-
21 tration of a mark in each class on either the principal or the
22 supplemental register, \$25; on filing each original applica-
23 tion under section 1 (a) (2) hereof for registration of a mark
24 in each class on the principal register, \$50;”.

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

3 “(c) For the purposes of this Act, an applicant filing
4 an application under section 1 (a) (2) of this Act, or a reg-
5 istiant of a registration resulting from such an application,
6 shall be accorded priority as against any other person except
7 one who—

8 “(1) prior to the initial publication of the mark
9 under section 12 (a) (2) of this Act has commenced
10 use of, and has not abandoned, a mark or trade name
11 which so resembles the mark of said applicant or regis-
12 tiant as to be likely, when applied to the goods of said
13 other person, to cause confusion, to cause mistake, or to
14 deceive, or

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

23 “(3) has acquired a right of priority pursuant to
24 section 44 (d) based on a foreign application filed prior

1 to the filing of said application under section 1 (a) (2)
2 of this Act.”

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

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