§ H.R. 5461

TITLE I----THE PRINCIPAL REGISTER

SECTION 1. The owner of a trade--mark used in commerce may register his trade--mark under this Act on the principal register hereby established:
(a) By filing in the Patent Office--
(1) a written application, in such form as may be prescribed by the Commissioner, verified by the applicant, or by a member of the firm or an officer of the

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corporation or association applying, specifying applicant's domicile and citizenship, the date of applicant's first use of the mark, the date of applicant's first use of the mark in commerce, the goods in connection with which the mark is used and the mode or manner in which the mark is used in connection with such goods, and including a statement to the effect that the person making the verification believes himself, or the firm, corporation, or association in whose behalf he makes the verification, to be the owner of the mark sought to be registered, that the mark is in use in commerce, and that no other person, firm, corporation, or association, to the best of his knowledge and belief, has the right to use such mark in the United States either in the identical form thereof or in such near resemblance thereto as might be calculated to deceive: Provided. That in the case of every application claiming concurrent use the applicant shall state exceptions to his claim of exclusive use, in which he shall specify, to the extent of his knowledge, any concurrent use by others, the goods or services in connection with which and the areas in which each concurrent use exists, the periods of each use, and the goods and area for which the applicant desires registration;
(2) a drawing of the marks; and

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(3) such number of specimens or facsimiles of the mark as actually used as may be required by the Commissioner.
(b) By paying into the Patent Office the filing fee.
(c) By complying with such rules or regulations, not inconsistent with law, as may be prescribed by the Commissioner.
(d) If the applicant is not domiciled in the United States he shall designate by a written document filed in the Patent Office the name and address of some person resident in the United States on whom may be served notices or process in proceedings affecting the mark. Such notices or process may be served upon the person so designated by leaving a copy thereof at the address specified in the last designation so filed.

If the person so designated cannot be found at the address given in the last designation, such notice or process may be served upon the Commissioner.

MARKS REGISTRABLE ON THE PRINCIPAL REGISTER

SEC. 2. No trade--mark by which the goods of the applicant may be distinguished from the goods of others shall be refused registration on the principal register on account of its nature unless it--
(a) Consists of or comprises immoral, deceptive, or scandalous matter; or matter which may disparage or falsely suggest a connection with persons, living or dead, institutions,

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beliefs, or national symbols, or bring them into contempt, or disrepute.
(b) Consists of or comprises the flag or coat of arms or other insignia of the United States, or of any State or municipality, or of any foreign nation, or any simulation thereof.
(c) Consists of or comprises a name, portrait, or signature identifying a particular living individual except by his written consent.
(d) Consists of or comprises a mark which so resembles a mark registered in the Patent Office or a mark or trade name previously used in the United States by another and not abandoned, as to be likely, when applied to the goods of the applicant, to cause confusion or mistake or to deceive purchasers: Provided. That the Commissioner may register as concurrent registrations the same or similar marks to more than one registrant when they have become entitled to use such marks as a result of their concurrent lawful use thereof in commerce prior to any of the filing dates of the applications involved and the Commissioner or a court on appeal determines that confusion or mistake or deceit of purchasers is not likely to result from the continued use of said marks under conditions and limitations as to the mode or place of use or the goods in connection with which such registrations may be granted which conditions and limitations shall be prescribed in the grant of the concurrent regis--

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trations thereof; and concurrent registrations may be similarly granted by the Commissioner with such conditions and limitations when a court has finally determined that more than one person is entitled to use the same or similar marks in commerce. The Commissioner shall give not less than thirty days' written notice to all applicants, registrants, and users specified by any of the parties concerned of any application for concurrent registration and of the time and place of the hearings thereon. When the Commissioner decides to grant a concurrent registration the proposed registration shall be published in the Official Gazette of the Patent Office and the application shall be subject to opposition as hereinafter provided for other applications to register marks. Concurrent registrations may be ordered by a court in an action under the provisions of section 4915, Revised Statutes, under such conditions and limitations as the court considers proper in accordance herewith.
(e) Consists of a mark which, (1) when applied to the goods of the applicant is merely descriptive of them, or (2) when applied to the goods of the applicant is primarily geographically descriptive of them, except as indications of regional origin may be registrable under section 4 hereof, or (3) is primarily merely a surname.
(f) Except as expressly excluded in paragraphs (a), (b), (c), and (d) of this section, nothing herein shall

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prevent the registration of a mark used by the applicant which has become distinctive of the applicant's goods in commerce. The Commissioner may accept as prima facie evidence that the

mark has become distinctive, as applied to the applicant's goods in commerce, proof of substantially exclusive and continuous use thereof as a mark by the applicant in commerce for the five years next preceding the date of the filing of the application for its registration.

SERVICE MARKS REGISTRABLE

SEC. 3. Subject to the provisions relating to the registration of trade--marks, so far as they are applicable, service marks used in commerce shall be registrable, in the same manner and with the same effect as are trade--marks, and when registered they shall be entitled to the protection provided herein in the case of trade--marks. The Commissioner may establish a separate register for such service marks. Applications and procedure under this section shall conform as nearly as practicable to those prescribed for the registration of trade--marks.

COLLECTIVE, CERTIFICATION, AND ASSOCIATION MARKS REGISTRABLE

SEC. 4. Subject to the provisions relating to the registration of trade--marks, so far as they are applicable, collective, certification, and association marks, including indications of regional origin used in commerce, shall be registrable

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under this Act, in the same manner and with the same effect as are trade--marks, by persons, and nations, States, municipalities, and the like, exercising legitimate control over the use of the marks sought to be registered, even though not possessing an industrial or commercial establishment, and when registered they shall be entitled to the protection provided herein in the case of trade--marks. Applications and procedure under this section shall conform as nearly as practicable to those prescribed for the registration of trade-marks.

USE BY RELATED COMPANIES

SEC. 5. Where a registered mark or a mark sought to be registered is or may be used by related companies such use shall inure to the benefit of the registrant or applicant for registration, and such use shall not affect the validity of such mark or of its registration, provided such mark is not used in such manner as to deceive the public.

DISCLAIMERS

SEC. 6. The Commissioner shall require unregistrable matter to be disclaimed, but such disclaimer shall not prejudice or affect the applicant's or owner's rights then existing of thereafter arising in the disclaimed matter, nor shall such disclaimer prejudice or affect the applicant's or owner's rights of registration on another application of later date if the disclaimed matter has become distinctive of the applicant's or owner's goods or services.

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CERTIFICATE

SEC. 7.(a) Certificates of registration of marks registered upon the principal register shall be issued in the name of the United States of America, under the seal of the Patent Office, and shall either be signed by the Commissioner or have his name printed thereon and attested by an assistant commissioner or by one of the law examiners duly designated by the Commissioner, and a record thereof, together with printed copies of the drawing and statement of the applicant, shall be kept in books for that purpose. The certificate shall reproduce the drawing of the mark, contain the statement of the applicant and state that the mark is registered on the principal register under this Act, the date of the first use of the mark, the date of the first use of the mark in commerce, the particular goods or services for which it is registered, the number and date of the registration, the term thereof, the date on which the application for registration was received in the Patent Office, and any conditions and limitations that may be imposed in the grant of the registration.
(b) A certificate of registration of a mark upon the principal register provided by this Act shall be prima facie evidence of the validity of the registration, registrant's ownership of the mark, and of registrant's exclusive right to use the mark in commerce in connection with the goods or serv-

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ices specified in the certificate, subject to any conditions and limitations stated therein.
(c) A certificate of registration of a mark may be issued to the assignee of the applicant, but the assignment must first be recorded in the Patent Office. In case of change of ownership the Commissioner shall, at the request of the owner and upon a proper showing and the payment of the fee herein provided, issue to such assignee a new certificate of registration of the said mark in the name of such assignee, and for the unexpired part of the original period.
(d) At any time, upon application of the registrant and payment of the fee herein provided, the Commissioner may permit any registration in the Patent Office to be surrendered, canceled, or for good cause to be amended, and he may permit any registered mark to be disclaimed in whole or in part: Provided. That the registration when so amended shall still contain registrable matter and the mark shall still be registrable as a whole, and that such amendment or disclaimer does not involve such changes in the registration as to require republication of the mark. The Commissioner shall make appropriate entry upon the records of the Patent Office and upon the certificate of registration or, if said certificate is lost or destroyed, upon a certified copy thereof.
(e) Copies of any records, books, papers, or drawings

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belonging to the Patent Office relating to marks, and copies of certificates of registration, when authenticated by the seal of the Patent Office and certified by the Commissioner, or in his name by a chief of division duly designated by the Commissioner, shall be evidence in all cases wherein the originals would be evidence; and any person making application therefor and paying the fee required by law shall have such copies.
(f) Whenever a material mistake in a registration, incurred through the fault of the Patent Office, is clearly disclosed by the records of the Office a statement of the fact and nature of such mistake, signed by the Commissioner and sealed with the seal of the Patent Office, shall be issued without charge and recorded and a printed copy thereof shall be attached to each printed copy of the registration certificate and such corrected certificate shall thereafter have the same effect as if the same had been originally issued in such corrected form, or in the discretion of the Commissioner a new certificate may be issued without charge. All certificates of correction

heretofore issued in accordance with the rules of the Patent Office and the registrations to which they are attached shall have the same force and effect as if such certificates and their issue had been specifically authorized by statute.
(g) Whenever a mistake has been made in a registra-

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tion and a showing has been made that such mistake occurred in good faith through the fault of the applicant, the Commissioner is authorized to issue a certificate of correction or in his discretion, a new certificate upon the payment of the required fee: Provided. That the correction does not involve such changes in the registration as to require republication of the mark.

DURATION

SEC. 8. (a) Each certificate of registration shall remain in force for twenty years: Provided. That the registration of any make under the provisions of this Act shall be canceled by the Commissioner at the end of six years following its date, unless within one year next preceding the expiration of such six years the registrant shall file in the Patent Office an affidavit showing that said mark is still in use or showing that its nonuse is due to special circumstances which excuse such nonuse and is not due to any intention to abandon the mark. Special notice of the requirement for such affidavit shall be attached to each certificate of registration.
(b) Any registration published under the provisions of subsection (c) of section 12 of this Act shall be canceled by the Commissioner at the end of six years after the date of such publication unless within one year next preceding the expiration of such six years the registrant shall file in the Patent Office an affidavit showing that said mark is still in

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use or showing that its nonuse is due to special circumstances which excuse such nonuse and is not due to any intention to abandon the mark.
(c) The Commissioner shall notify any registrant who files either of the above--prescribed affidavits of his action thereon and of the grounds therefor.

RENEWAL

SEC. 9. Each registration may be renewed for periods of twenty years from the end of the expiring period upon the filing of an application therefor accompanied by an affidavit by the registrant stating that the mark is still in use in commerce and the payment of the renewal fee required by this Act; and such application may be made at any time within six months before the expiration of the period for which the certificate of registration was issued or renewed, or it may be made within three months after such expiration on payment of the additional fee herein provided.
An applicant for renewal not domiciled in the United States shall be subject to and comply with the provisions of section 1 (d) hereof.

ASSIGNMENT

SEC. 10. A registered mark or a mark for which application has been filed shall be assignable with the goodwill of the business in which the mark is used, or with that part of the goodwill of the business connected with the use of

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and symbolized by the mark, and in any such assignment it shall not be necessary to include the goodwill of the business connected with the use of and symbolized by any other mark used in the business or by the name or style under which the business is conducted: Provided. That any assigned registration may be canceled at any time if the registered mark is being used by, or with the permission of, the assignee so as to misrepresent the source of the goods or services in connection with which the mark is used. Assignments shall be by instruments in writing duly executed. Acknowledgment shall be prima facie evidence of the execution of an assignment and when recorded in the Patent Office the record shall be prima facie evidence of execution. An assignment shall be void as against any subsequent purchaser for a valuable consideration without notice, unless it is recorded in the Patent Office within three months after the date thereof or prior to such subsequent purchase. The Commissioner shall keep a record of such assignments submitted to him for recording.
An assignee not domiciled in the United States shall be subject to and comply with the provisions of section 1 (d) hereof.

ACKNOWLEDGMENTS AND VERIFICATIONS

SEC. 11. Acknowledgments and verifications required hereunder may be made before any person with the United

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States authorized by law to administer oaths, or, when made in a foreign country, before any diplomatic or consular officer of the United States or before any official authorized to administer oaths in the foreign country concerned whose authority shall be proved by a certificate of a diplomatic or consular officer of the United States, and shall be valid if they comply with the laws of the State or country where made.

PUBLICATION

SEC. 12. (a) Upon the filing of an application for registration and payment of the fee herein provided, the Commissioner shall refer the application to the examiner in charge of the registration of marks, who shall cause an examination to be made and, if on such examination it shall appear that the applicant is entitled to registration, the Commissioner shall cause the mark to be published in the Official Gazette of the Patent Office.
(b) If the applicant is found not entitled to registration, the examiner shall advise the applicant thereof and of the reasons therefor. The applicant shall have a period of six months in which to reply or amend his application, which shall then be re--examined. This procedure may be repeated until (1) the examiner finally refuses registration of the mark or (2) the applicant fails for a period of six months to reply or amend or appeal, whereupon the application shall be deemed to have been abandoned, unless it can be shown

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that the delay in replying was unavoidable, whereupon such time may be extended.
(c) A registrant of a mark registered under the provisions of the Act of March 3, 1881, or the Act of February 20, 1905, may upon the payment of the prescribed fee file with the Commissioner a statement that said mark is in use and that the registrant claims the benefits of this Act for said mark. The Commissioner shall promptly publish said statement with a reproduction of said mark in the Official Gazette, and notify the registrant of such publication and of the requirement for the affidavit of use or nonuse as provided for in subsection (b) of section B of this Act.

OPPOSITION

SEC. 13. Any person who believes that he would be damaged by the registration of a mark upon the principal register may, upon payment of the required fee, file a verified notice of opposition in the Patent Office stating the grounds therefor within thirty days after the publication under subsection (a) of section 12 of this Act of the mark sought to be registered. For good cause shown, the time for filing notice of opposition may be extended by the Commissioner, who shall notify the applicant. An unverified opposition may be filed by a duly authorized attorney, but such opposition shall be null and void unless verified by the opposer within a reasonable time after such filing.

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CANCELATION

SEC. 14. Any person who believes that he is or will be damaged by the registration of a mark on the principal register established by this Act, or under the Act of March 3, 1881, or the Act of February 20, 1905, may upon the payment of the prescribed fee apply to cancel said registration-
(a) within five years from the date of the registration of the mark under this Act; or
(b) within five years from the date of the publication under section 12 (c) hereof of a mark registered under the Act of March 3, 1881, or the Act of February 20, 1905; or
(c) at any time if the registered mark has been abandoned or its registration was obtained fraudulently or contrary to the provisions of subsections (a), (b), or (c) of section 2 of this Act for a registration hereunder, or contrary to similar prohibitory provisions of said prior Acts for a registration thereunder, or if the registered mark has been assigned and is being used by, or with the permission of, the assignee so as to misrepresent the source of the goods or services in connection with which the mark is used, or if the mark was registered under the Act of March 3, 1881, or the Act of February 20, 1905, and has not been published under the provisions of subsection (c) of section 12 of this Act.

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SEC. 15. Upon the filing with the Commissioner within one year after the expiration of any period of five consecutive years of proof that a mark registered on the principal register hereunder has been in continuous use during such five consecutive years and is still in use in commerce.
The right of the registrant to use such registered mark in commerce shall be incontestable.

Except on a ground for which application to cancel may be filed at any time under subsection (c) of section 14 of this Act.
And except to the extent, if any, to which such use of the registered mark infringes a valid right acquired under the law of any State or Territory by continuous use of a mark or trade name extending from a date prior to the date of the publication under this Act of the mark for which incontestability is claimed.
The incontestable right above provided for with reference to a mark registered under this Act shall apply to a mark registered under the Act of March 3, 1881, or the Act of February 20, 1905, upon the filing with the Commissioner within one year after the expiration of any period of five consecutive years after the date of publication of a mark under the provisions of subsection (c) of section 12 of this Act of proof that such mark has been in continuous use during such five consecutive years and is still in use in commerce.

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INTERFERENCE

SEC. 16. Whenever application is made for the registration of a mark which so resembles a mark previously registered by another, or for the registration of which another has previously made application, as to be likely when applied to the goods or when used in connection with the services of the applicant to cause confusion or mistake or to deceive purchasers, the Commissioner may declare that an interference exists. No interference shall be declared between an application and the registration of a mark the right to the use of which has become incontestable.

SEC. 17. In every case of interference, opposition to registration, application to register as an honest concurrent user, or application to cancel the registration of a mark, the Commissioner shall give notice to all parties and shall direct the examiner in charge of interferences to determine and decide the respective rights of registration.

SEC. 18. In such proceedings the examiner may refuse to register the opposed mark, may cancel or restrict the registration of a registered mark, or may refuse to register any or all of several interfering marks, or may register the mark or marks for the person or persons entitled thereto, as the rights of the parties hereunder may be established in the proceedings provided that in the case of the registration of any mark based on concurrent use, the examiner shall deter--

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mine and fix the conditions and limitations provided for in subsection (d) of section 2 of this Act.

SEC. 19. In all inter partes proceedings the equitable principles of laches, estoppel, and acquiescence, where applicable may be considered and applied. The provisions of this section shall also govern proceedings heretofore begun in the Patent Office and not finally determined.

SEC. 20. An appeal may be taken to the Commissioner in person from any final decision of the examiner in charge of interferences or of the registration of marks upon the payment of the prescribed fees.

SEC. 21. Any applicant for registration of a mark, party to an interference proceeding, party to an opposition proceeding, party to an application to register as an honest concurrent user, or party to a cancelation proceeding, who is dissatisfied with the decision of the Commissioner may appeal to the United States Court of Customs and Patent Appeals or may proceed under section 4915, Revised Statutes, as in the case of applicants for patents, under the same conditions, rules, and procedure as are prescribed in the case of patent appeals or proceedings so far as they are applicable.

REGISTRATION IS NOTICE

SEC. 22. Registration of a mark on the principal register provided by this Act or under the Act of March 3, 1881.

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of the Act of February 20, 1905, shall be constructive notice of the registrant's claim of ownership thereof.

TITLE II----THE SUPPLEMENTAL REGISTER

SEC. 23. In addition to the principal register, the Com--missioner shall keep a continuation of the register provided in paragraph (b) of section 1 of the Act of March 19, 1920, entitled "An Act to give effect to certain provisions of the convention for the protection of trade--marks and commercial names, made and signed in the city of Buenos Aires, in the Argentine Republic, August 20, 1910, and for other purposes", to be called the supplemental register. All marks capable of distinguishing applicant's goods or services and not registrable on the principal register herein provided, except those declared to be unregistrable under paragraphs (a), (b),(c), and (d) of section 2 of this Act, which have been in lawful use in commerce by the proprietor thereof, upon or in connection with any goods or services for the year proceding the filing of the application maybe registered on the supplemental register upon payment of the prescribed fee and compliance with the provisions of section 1 so far as they are applicable.
Upon the filing of an application for registration on the supplemental register and payment of the fee herein provided the Commissioner shall refer the application to the examiner in charge of the registration of marks, who shall

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cause an examination to be made and if on such examination it shall appear that the applicant is entitled to registration, the registration shall be granted. If the applicant is found not entitled to registration the provisions of subsection (b) of section 12 of this Act shall apply.
For the purposes of registration on the supplemental register, a mark may consist of any trade--mark, symbol, label, package, configuration of goods, name, word, slogan, phrase, surname, geographical name, numeral, or device or any combination of any of the foregoing, but such mark must be capable of distinguishing the applicant's goods or services.
Upon a proper showing by the applicant that he has begun the lawful use of his mark in foreign commerce and that he requires domestic registration as a basis for foreign protection of his mark,

the Commissioner may waive the requirement of a full year's use and may grant registration forthwith.

CANCELATION

SEC. 24. Marks for the supplemental register shall not be published for or be subject to opposition, but shall be published on registration in the Official Gazette of the Patent Office. Whenever any person believes that he is or will be damaged by a registration of a mark on this register, he may at any time apply to the Commissioner to cancel the registration thereof. The Commissioner shall refer such application

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to the examiner in charge of interferences, who shall give notice thereof to the registrant. If it is found after a hearing before the examiner that the registrant was not entitled to register the mark at the time of his application for registration thereof, or that the mark is not used by the registrant or has been abandoned, the registration shall be canceled by the Commissioner.

SEC. 25. The certificates of registration for marks registered on the supplemental register shall be conspicuously different from certificates issued for marks registered on the principal register.

GENERAL PROVISIONS

SEC. 26. The provisions of this Act shall govern so far as applicable registrations on the supplemental register
as well as those on the principal register, but applications for and registrations on the supplemental register shall not be subject to or receive the advantages of sections 2(e), 2(f), 7(b), 12(a), 13 to 18, inclusive, 22, 33,and 42 of this Act.

SEC. 27. Registration of a mark on the supplemental register, or under the Act of March 19, 1920, shall not preclude registration by the registrant on the principal register established by this Act.

SEC. 28. Registration on the supplemental register or

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under the Act of March 19, 1920, shall not be filed in the Department of the Treasury or be used to stop importations.

TITLE III----NOTICE OF REGISTRATION

SEC. 29. Notwithstanding the provisions of section 22 hereof, a registrant of a mark registered under the Act of March 3, 1881, or the Act of February 20, 1905, or on the principal register established by this Act, shall give notice that his mark is registered by displaying with the mark as used the words "Registered in U.S. Patent Office" or "Reg. U.S. Pat. Off." or "Registered Trade Mark" or the letter R enclosed within a circle, thus, R, or T.M.R. in an ellipse thus, T.M.R.; and in any suit for infringement under this Act by such a registrant failing so to mark

goods bearing the registered mark, or by a registrant under the Act of March19, 1920, or by the registrant of a mark on the supplemental register provided by this Act no profits and no damages shall be recovered under the provisions of this Act unless the defendant had actual notice of the registration: Provided, however. That the foregoing requirement as to notice shall be deemed fulfilled in respect to a registered mark used in connection with goods or services of foreign origin if the mark as used is accompanied by the notice of registration used in the country of origin of the goods or services to denote registration there.

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TITLE IV----CLASSIFICATION

SEC. 30. The Commissioner shall establish a classification of goods and services, for convenience of Patent Office administration, but not to limit or extend the applicant's rights. The applicant may register his mark in one application for any or all of the goods or services included in one class, upon or in connection with which he is actually using the mark. The Commissioner may issue a single certificate for one mark registered in a plurality of classes upon payment of a fee equalling the sum of the fees for each registration in each class.

TITLE V----FEES AND CHARGES

SEC. 31. The following fees shall be paid to the Patent Office under this Act:
On filing each original application for registration of a mark in each class in either the principal or the supplemental register, $15; on filing each application for renewal in each class, $15; and on filing each application for renewal in each class after expiration of the registration, an additional fee of $5; on filing notice of claim of benefits of this Act for a mark to be published under section 12 (c) hereof, 55; on filing notice of opposition or application for cancelation, $10; on appeal from an examiner in charge of the registration of marks to the Commissioner, $20; on appeal from an examiner in charge of interferences to the Commissioner,$20; for issuance of a new certificate of registration following change of ownership of a mark or correction of a registrant's mistake, $10; for certificate of correction of registrant's mistake, $10; for filing in each class each application communicated to the United States from the International Bureau, Habana, $15; for filing and transmitting application in each class to the International Bureau, Habana, including certificate, $10; for manuscript copies, for every one hundred words or fraction thereof, 10 cents; for comparing other copies, 5cents for every one hundred words or fraction thereof; for certifying in any case, additional, 75 cents; for each additional registration or application which may be included under a single certificate, 25 cents additional; for each additional registration or application included, or involved in one writing where more than one is so included or involved, additional 50 cents; for filing disclaimer, amendment, surrender, or cancelation after registration, $10.
For abstracts of title: For the search, one hour or less, and certificate, $3; each additional hour or fraction thereof, $1.50; for each brief from the digest of assignments of two hundred words or less, 50 cents; each additional one hundred words or fraction thereof, 10 cents.
For certificate that trade--mark has not been registered----search and certificate (for deposit in foreign countries only), $3.

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For title reports required for office use, $1.For a single printed copy of statement and drawing, 10 cents; if certified, for the grant, additional 50 cents; for the certificate, 50 cents; if renewed, for copy of certificate of renewal, additional 50 cents. For photographic copies of records, per page 20 cents; if certified, for the certificate, additional 50 cents. For photographic copies of drawings, per sheet, 20 cents. For recording every assignment, or other paper not exceeding six pages, $3; for each additional two pages or less, $1. The Commissioner shall refund fees paid by mistake or in excess.

TITLE VI----REMEDIES

SEC. 32. (1) Any person who shall, in commerce, (a) use, without the consent of the registrant, any reproduction, counterfeit, copy, or colorable imitation of any registered mark in connection with the sale, offering for sale, or advertising of any goods or services of such a character that such use is likely to cause confusion or mistake or to deceive purchasers; or (b) use any such reproduction, counterfeit, copy, or colorable imitation falsely to indicate the source of such goods or services: or (c) reproduce, counterfeit, copy, or colorably imitate any such mark and apply such reproduction, counterfeit, copy, or colorable imitation to labels, signs.

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prints, packages, wrappers, receptacles, or advertisements intended to be used upon or in connection with the sale in commerce of such goods or services with actual notice of the registrant's claim of ownership of such mark and with knowledge that such reproduction, counterfeit, copy, or colorable imitation is intended to be used without the consent of the registrant, shall be liable to a civil action by the registrant for any or all of the remedies hereinafter provided.
(2) If goods bearing a registered mark have been put on the market by or with the authority of the registrant of a registered mark or in any package or other container bearing said mark and a notice that the goods may be resold only unaltered or in the original package or container and said goods or any part thereof have, without the authority of the registrant, been transferred to another package or container or been in anyway altered, any person who shall, in commerce, make any use of or reference to said registered mark upon or in connection with the sale or advertising of such transferred or altered goods shall be liable to a civil action by the registrant for any or all of the remedies hereinafter provided.
SEC. 33. (a) Any certificate of registration issued under the Act of March 3, 1881, or the Act of February20, 1905, or of a mark registered on the principal register provided by this Act and owned by the plaintiff shall be admissible in

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evidence and shall be prima facie evidence of registrant's exclusive right to use the registered mark in commerce on the goods or services specified in the certificate subject to any conditions or limitations stated therein, but shall not preclude the defendant from proving any legal or equitable defense which would have been available to him if the plaintiff's mark had not been registered.
(b) If the right to use the registered mark has become incontestable under section 15 hereof, the certificate shall be conclusive evidence of the registrant's exclusive right to use the registered

mark in commerce on or in connection with the goods or services specified in the certificate subject to any conditions or limitations stated therein except when one of the following defenses is established:
(1) That the registration was obtained fraudulently; or
(2) That the mark has been abandoned by the registrant; or
(3) That the registered mark has been assigned and is being used, by or with the permission of the assignee, so as to misrepresent the source of the goods or services in connection with which the mark is used; or
(4) That the use by the defendant of the term or device charged to be an infringement is not a use as a trade or service mark and in a manner not likely to deceive the public, of the defendant's individual name in his own business, or of the

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individual name of anyone in privity with the defendant who uses his own name in his own business, or of a term or device which is merely descriptive of and necessary truthfully to describe to users the goods or services of the defendant, or of a term or device which is primarily descriptive of their geographic origin; or
(5) That the mark whose use by the defendant is charged as an infringement has been continuously used by the defendant or those in privity with him from a date prior to the publication of the registered mark under subsection (a) or (c) of section 12 of this Act: Provided however. That this defense shall apply only for the area in which such continuous prior use is proved.

SEC. 34. The several courts vested with jurisdiction of civil actions arising under this Act shall have power to grant injunctions, according to the principles of equity and upon such terms as the court may deem reasonable, to prevent the violation of any right of the registrant of a mark registered in the Patent Office. Any such injunction may include a provision directing the defendant to file with the court and serve on the plaintiff within thirty days after the service on the defendant of such injunction, or such extended period as the court may direct, a report in writing under oath setting forth in detail the manner and form in which the defendant has complied with the injunction. Any such injunction

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granted upon hearing, after notice to the defendant, by any district court of the United States, may be served on the parties against whom such injunction is granted anywhere in the United States where they may be found, and shall be operative and may be enforced by proceedings to punish for contempt, or otherwise, by the court by which such injunction was granted, or by any other United States district court in whose jurisdiction the defendant may be found.
The said courts shall have jurisdiction to enforce said injunction, as herein provided, as fully as if the injunction had been granted by the district court in which it is sought to be enforced. The clerk of the court or judge granting the injunction shall, when required to do so by the court before which application to enforce said injunction is made, transfer without delay to said court a certified copy of all papers on file in his office upon which said injunction was granted; and it shall be the duty of the clerks of such courts within one month after the filing of any action, suit, or proceeding arising under the provisions of this Act to give notice thereof in writing to the Commissioner setting forth in order so far as known the names and addresses of the litigants and

the designating number or numbers of the registration or registrations upon which the action, suit, or proceeding has been brought, and in the event any other registration be subsequently included in the action, suit, or proceeding by amendment, answer, or

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other pleading, the clerk shall give like notice thereof to the Commissioner, and within one month after the decision is rendered, appeal taken or a decree issued the clerk of the court shall give notice thereof to the Commissioner, and it shall be the duty of the Commissioner on receipt of such notice forthwith to endorse the same upon the file wrapper of the said registration or registrations and to incorporate the same as a part of the contents of said file wrapper; and for each notice required and furnished to the Commissioner in compliance herewith a fee of 50 cents shall be taxed by the clerk as costs of suit.

SEC. 35. Whenever the plaintiff shall have established his right to relief in any civil action arising under this Act, he shall be entitled (subject to the provisions of section 29) to recover (1) defendant's profits, (2) any damages sustained by the plaintiff, and (3) the costs of the action. The court shall assess such profits and damages or cause the same to be assessed under its direction. In assessing profits the plaintiff shall be required to prove defendant's sales, only; defendant must prove all elements of cost or deduction claimed. In assessing damages the court may enter judgment, according to the circumstances of the case, for any sum above the amount found as actual damages not exceeding three times such amount. If the court shall find that the amount of the recovery based on profits is either inade-

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quate or excessive the court may in its discretion enter judgment for such sum as the court shall find to be just, according to the circumstances of the case. Such sum in either of the above circumstances shall constitute compensation and not a penalty.

SEC. 36. In any action arising under this Act, in which the plaintiff shall have established his right to relief, the court may order that all labels, signs, prints, packages, wrappers, receptacles, and advertisements in the possession of the defendant, bearing the mark of the plaintiff or any reproduction, counterfeit, copy, or colorable imitation thereof, and all plates, molds, matrices, and other means of making the same, shall be delivered up and destroyed.

SEC. 37. In any action involving a registered mark the court may determine the right to registration, order the cancelation of registrations, in whole or in part, restore canceled registrations, and otherwise rectify the register with respect to the registrations of any party to the action. Decrees and orders shall be certified by the court to the Commissioner, who shall make appropriate entry upon the records of the Patent Office, and shall be controlled thereby.

SEC. 38. Any person who shall procure registration in the Patent Office of a mark by a false or fraudulent declaration or representation, oral or in writing, or by any false

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means, shall be liable in a civil action by any person injured thereby for any damages sustained in consequence thereof.

SEC. 39. The district and territorial courts of the United States shall have original jurisdiction, and the circuit courts of appeal of the United States shall have appellate jurisdiction, of all actions arising under this Act, without regard to the amount in controversy or to diversity or lack of diversity of the citizenship of the parties.

SEC. 40. Writs of certiorari may be granted by the Supreme Court of the United States for the review of cases arising under this Act in the same manner as provided for in cases under the patent laws.

SEC. 41. The Commissioner shall make rules and regulations, not inconsistent with law, for the conduct of proceedings in the Patent Office under this Act.

TITLE VII----IMPORTATION FORBIDDEN OF GOODS BEARING INFRINGING MARKS OR NAMES

SEC. 42. (a) Any goods, whatever may be their source or origin, which shall bear any mark registered under the Act of March 3, 1881, or the Act of February 20, 1905, or on the principal register provided by this Act,
or any infringement of a mark so registered shall not be imported into the United States or admitted to entry at any customhouse of the United States unless the written consent of the registrant to such importation or entry be first had and obtained

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or unless such offending mark be removed or obliterated; and, if brought into the United States in violation of the provisions of this section, any person selling, offering for sale, or dealing in such merchandise shall be amenable, at the suit of the registrant, to the liabilities for infringement provided in this Act and, in addition, be required to export or destroy such goods or to remove or obliterate such infringing mark therefrom, and such goods shall be subject to seizure and forfeiture for violation of the customs laws: Provided. That in order to aid the officers of customs in enforcing this paragraph, the registrant of the mark shall deposit in the Department of the Treasury a facsimile of the registration certificate, under such regulations as the Secretary of the Treasury shall prescribe.
(b) Any goods, whatever may be their source or origin, which shall bear the trade or commercial name or a simulation thereof of any domestic manufacturer or trader, or of any manufacturer or trader located in any foreign country which by treaty, convention, or law affords similar privileges to citizens of the United States, shall not be imported into the United States or admitted to entry at any customhouse of the United States unless the written consent of such manufacturer or trader to such importation or entry be first had and obtained, or unless such offending name be removed or obliterated, and if brought into the United States in violation of

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the provisions of this section, any person may be enjoined from selling, offering for sale, dealing in, or advertising such goods and in addition be required to export or destroy such goods or to remove or obliterate such name therefrom, and the goods shall be subject to seizure and forfeiture for violation of the custom laws: Provided. That in order to aid the officers of customs

in enforcing this paragraph, such domestic or foreign manufacturer or trader shall deposit in the Department of the Treasury a facsimile of his trade or commercial name, under such regulations as the Secretary of the Treasury shall prescribe.
(c) The owner, importer, or consignee of goods refused entry or seized under paragraph (a) or (b) of this section may have relief against the registrant, manufacturer, or trader by a summary proceeding in any United States court of original jurisdiction, in the district where such goods are held or where such registrant, manufacturer, or trader or a designated representative is an inhabitant or may be found, or, if the registrant is a foreigner and no designation of a representative has been filed, then in the District of Columbia, and after such notice and upon such proceedings as the court may direct the court may determine whether the plaintiff for any reason has the right to import such goods under the trade or commercial name or mark which they bear.
(d) A decree or order of such court for the plaintiff,

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upon being certified to the collector of the port where the goods are held, shall be warrant to such collector to release the goods from arrest or seizure or forfeiture under this section.
(e) An order or decree for either party, whether inter--locutory or final, shall be appealable within thirty days, and the court making such order or decree may, in its discretion, suspend the operation thereof pending appeal.

TITLE VIII----FALSE DESIGNATIONS OF ORIGIN AND FALSE DESCRIPTIONS FORBIDDEN

SEC. 43. (a) Any person who shall affix, apply, or annex, or use in connection with any goods or services, or any container or containers for goods, a false designation of origin, or any false description or representation, including words or other symbols tending falsely to describe or represent the same, and shall cause such goods or services to enter into commerce, and any person who shall with knowledge of the falsity of such designation of origin or description or representation cause or procure the same to be transported or used in commerce or deliver the same to any carrier to be transported or used, shall be liable to a civil action by any person doing business in the locality falsely indicated as that of origin or in the region in which said locality is situated, or by any person who believes that he is or is likely to be damaged by the use of any such false description or representation.
(b) Any goods marked or labeled in contravention of the provisions of this section shall not be imported into the United States or admitted to entry at any customhouse of the United States. The owner, importer, or consignee of goods refused entry at any customhouse under this section may have any recourse by protestor appeal that is given under the customs revenue laws or may have the remedy given by this Act in cases involving goods refused entry or seized.

TITLE IX----INTERNATIONAL CONVENTIONS

SEC. 44. (a) The Commissioner shall keep a register of all marks communicated to him by the international bureaus provided for by the Conventions for the Protection of Industrial Property, trade--marks, trade and commercial names, and the repression of unfair competition to which the United States is or may become a party, and upon the payment of the fees required by such

conventions and the fees herein prescribed may place the marks so communicated upon such register. This register shall show a facsimile of the mark or trade or commercial name; the name, citizenship, and address of the registrant; the number, date, and place of the first registration of the mark, including the dates on which application for such registration was filed and granted

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and the term of such registration; a list of goods or services to which the mark is applied as shown by the registration in the country of origin, and such other data as may be useful concerning the mark. This register shall be a continuation of the register provided in section (a) of the Act of March 19, 1920.
(b) Persons who are nationals of, domiciled in, or have a bona fide and effective business or commercial establishment in any foreign country, which is a party to (1) the International Convention for the Protection of Industrial Property, signed at Paris on March 20, 1883; or (2) the General Inter--American Convention for trade--mark and Commercial Protection signed at Washington on February 20, 1929; or (3) any other convention or treaty relating to trade--marks, trade or commercial names, or the repression of unfair competition to which the United States is a party, shall be entitled to the benefits and subject to the provisions of this Act to the extent and under the conditions essential to give effect to any such conventions and treaties so long as the United States shall continue to be a party thereto, except as provided in the following paragraphs of this section.
(c) No registration of a mark in the United States by a person described in paragraph (b) of this section shall be perfected until such mark has been registered in the country of origin of the applicant, when such country makes the

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same requirement of nationals or residents of the United States unless the applicant alleges use in commerce.
For the purposes of this section, the country of origin of the applicant is the country in which he has a bona fide and effective industrial or commercial establishment and, in the case of associations, the country in which the association has its domicile or its principal office.
(d) An application for registration of a mark under sections 1, 2, 3, 4, or 23 of this Act filed by a person de--scribed in paragraph (b) of this section who has previously duly filed an application for registration of the same mark in one of the countries described in paragraph (b) shall be accorded the same force and effect as would be accorded to the same application of filed in the United States on the same date on which the application was first filed in such foreign country: Provided. That--
(1) the application in the United States is filed within six months from the date on which the application was first filed in the foreign country;
(2) the application conforms as nearly as practicable to the requirements of this Act, but use in commerce need not be alleged:
(3) the rights acquired by third parties before the date of the filing of the first application in the foreign country shall in no way be affected by a registration

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obtained on an application filed under this subsection (d):

(4) nothing in this subsection (d) shall entitle the foreign applicant to sue for infringement of his mark prior to the date on which his mark was registered in this country unless the registration is based on use in commerce.
(e) A mark duly registered in the country of origin of the foreign applicant may be registered on the principal register if eligible, otherwise on the supplemental register herein provided. The application therefor shall be accompanied by a certified copy of the application for or registration in the country of origin of the applicant.
(f) The registration of a mark obtained under the provisions of paragraphs (c), (d), and (e) of this section by a person described in paragraph (b) shall be independent of the registration in the country of origin and the duration, validity, or transfer in the United States of such registration shall be governed by the provisions of this Act.
(g) Trade names or commercial names of person described in paragraph (b) of this section shall be protected without the obligation of filing or registration whether or not they form parts of marks.
(h) Any person designated in paragraph (b) of this

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section as entitled to the benefits and subject to the provisions of this Act shall be entitled to effective protection against unfair competition, and the remedies provided herein against infringement of trade--marks shall be available so far as they may be appropriate in repressing acts of unfair competition.
(i) Citizens or residents of the United States shall have the same benefits as are granted by this section to persons described in paragraph (b) hereof.

TITLE X----CONSTRUCTION AND DEFINITIONS

SEC. 45. In the construction of this Act, unless the contrary is plainly apparent from the context- The United States includes and embraces all territory which is under its jurisdiction and control. The word "commerce" means all commerce which may lawfully be regulated by Congress. The term "principal register" refers to the register provided for by sections 1 to 22 hereof, and the term "supplemental register" refers to the register provided for by sections 23 to 28 hereof. The term "person" and any other word or term used to designate the applicant or other entitled to a benefit or privilege or rendered liable under the provisions of this Act includes a juristic person as well as a natural person. The term

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"juristic person" includes a firm, corporation, union, association, or other organization capable of suing and being sued in a court of law.
The terms "applicant" and "registrant" embrace the legal representatives and successors and assigns of such applicant or registrant.
The term "Commissioner" means the Commissioner of Patents.
The term "related company" means any person who is controlled by the registrant or applicant for registration in respect to the nature and quality of the goods or services in connection with which the mark is used.
The terms "trade name" and "commercial name" include individual names and surnames, firm names and trade names used by manufacturers, industrialists, merchants, agriculturists, and

others to identify their businesses, vocations, or occupations; the names or titles lawfully adopted and used by persons, firms, associations, corporations, companies, unions, and any manufacturing, industrial, commercial, agricultural, or other organizations engaged in trade or commerce and capable of suing and being sued in a court of law.
The term "trade--mark" includes any word, name, symbol, or device or any combination thereof adopted and used by a manufacturer or merchant to identify his goods and distinguish them from those manufactured or sold by others.

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The term "service mark" means a mark used in the sale or advertising of services to identify the services of one person and distinguish them from the services of others and includes without limitation the marks, names, symbols, titles, designations, slogans, character names, and other distinctive features of radio or other advertising used in commerce.
The term "collective mark" means a mark lawfully used by two or more persons.
The term "certification mark" means a mark indicating that the goods or service for which it is registered are certified by the registrant as to regional or other origin, material, mode of manufacture, quality, accuracy, or other characteristic.
The term "association mark" means a certification mark registered by an association.
The terms "collective mark", "certification mark" and "association mark" mean also marks over the use of which the registrant exercises legitimate control, but such marks may not be registered by persons who make or sell, or who have made or sold, the goods or services in connection with which such marks are used or registered.
The term "mark" includes any trade--mark, service mark, collective mark, certification mark, and association mark entitled to registration under this Act whether registered or not.
For the purposes of this Act a mark shall be deemed

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to be used in commerce (a) on goods when it is placed in any manner on the goods or their containers or the displays associated therewith or on the tags or labels affixed thereto and the goods are sold or transported in commerce and (b) on services when used or displayed in the sale or advertising of services in commerce.
A mark shall be deemed to be "abandoned"--
(a) When its use has been discontinued with intent not to resume. Intent not to resume may be inferred from circumstances. Discontinuance of use for two years shall be prima facie abandonment.
(b) When any course of conduct including omissions as well as acts of the registrant causes the mark to lose its significance as an indication of origin.
The term "colorable imitation" includes any mark which so resembles a registered mark as to be likely to cause confusion or mistake or to deceive purchasers.
The term "registered mark" means a mark registered in the United States Patent Office under this Act or under the Act of March 3, 1881, or the Act of February 20, 1905, or the Act of March 19, 1920. The phrase "marks registered in the Patent Office" means registered marks.
A "counterfeit" is a spurious mark which is identical with, or substantially indistinguishable from, a registered mark.

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Words used in the singular include the plural and vice versa.
The intent of this Act is to regulate commerce within the control of Congress by making actionable the deceptive and misleading use of marks in such commerce; to protect registered marks used in such commerce from interference by State or territorial legislation; to protect persons engaged in such commerce against unfair competition; to prevent fraud and deception in such commerce by the use of reproductions, copies, counterfeits, or colorable imitations of registered marks; and to provide rights and remedies stipulated by treaties and conventions respecting trade--marks, trade names, and unfair competition entered into between the United States and foreign nations.

TITLE XI----REPEAL OF PREVIOUS ACTS

SEC. 46. (a) This Act shall be in force and take effect sixty days from its enactment, but except as otherwise herein specifically provided shall not affect any suit, proceeding, or appeal then pending. All Acts and parts of Acts inconsistent herewith are hereby repealed effective sixty days from the enactment hereof, including the following, namely: The Act of Congress approved March 3, 1881, entitled "An Act to authorize the registration of trade marks and protect the same"; the Act approved August 5, 1882, entitled "An Act relating to the registration of trade marks";

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the Act of February 20, 1905 (U.S.C., title 15,secs. 81 to 109, inclusive), entitled "An Act to authorize the registration of trade marks used in commerce with foreign nations or among the several States or with Indian tribes, and to protect the same", and the amendments thereto by the Acts of May 4, 1906 (U.S.C., title 15,secs. 131 and 132; 34 Stat. 169), March 2, 1907 (34 Stat. 1251, 1252), February 18, 1909 (35 Stat. 627,628), February 18, 1911 (36 Stat. 918), March 3, 1911 (36 Stat. 1167), January 8, 1913 (37 Stat. 649), June7, 1924 (43 Stat. 647), March 4, 1925 (43 Stat. 1268, 1269), April 11, 1930 (46 Stat. 155); June 10, 1938 (Public, Numbered 586, Seventy--fifth Congress, ch. 332, third session); the Act of March 19, 1920 (U.S.C., title 15, secs. 121 to 128, inclusive), entitled "An Act to give effect to certain provisions of the convention for the protection of trade marks and commercial names made and signed in the city of Buenos Aires, in the Argentine Republic, August 20, 1910, and for other purposes"; and the amendments thereto, including Act June 10, 1938 (Public, Numbered 586, Seventy--fifth Congress, ch. 332, third session); and section 526 of the Tariff Act of 1930 (U.S.C., title 19, sec. 1526), provided that this repeal shall not affect the validity of registrations granted or applied for under said Acts prior to the effective

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date of this Act, or rights or remedies thereunder except as provided in sections 8, 12, 14, 15, and 47 of this Act.

(b) Registrations now existing under the Act of March 3, 1831, or the Act of February 20, 1905, shall continue in full force and effect for the unexpired term thereof and may be renewed under the provisions of section 9 of this Act. Such registrations and the renewals thereof shall be subject to and shall be entitled to the benefits of the provisions of this Act to the same extent and with the same force and effect as though registered on the principal register established by this

Act except as limited in sections 8, 12, 14, and 15of this Act. Marks registered under the "ten--year proviso" of section 5 of the Act of February 20, 1905, as amended, shall be deemed to have become distinctive of the registrant's goods in commerce under paragraph (f) of section 2 of this Act and may be renewed under section 9 hereof as marks coming within said paragraph.

Registrations now existing under the Act of March 19, 1920, shall expire six months after the effective date of this Act, or twenty years from the dates of their registrations, whichever date is later. Such registrations shall be subject to and entitled to the benefits of the provisions of this Act relating to marks registered on the supplemental register established by this Act, and may not be renewed unless

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renewal is required to support foreign registrations. In that event renewal may be effected under the provisions of section 9 of this Act.
Marks registered under previous Acts may, if eligible, also be registered under this Act.

SEC. 47. (a) All applications for registrations pending in the Office of the Commissioner at the effective date of this Act may be amended, if practicable, to bring them under the provisions of this Act. The prosecution of such applications so amended and the grant of registrations thereon shall be proceeded with in accordance with the provisions of this Act. If such amendments are not made, the prosecution of said applications shall be proceeded with and registrations thereon granted in accordance with the Acts under which said applications were filed, and said Acts are hereby continued in force to this extent and for this purpose only, notwithstanding the foregoing general repeal thereof.
(b) In any case in which an appeal is pending before the United States Court of Customs and Patent Appeals or any United States Circuit Court of Appeals at the effective date of this Act, the court, if it be of the opinion that the provisions of this Act are applicable to the subject matter of the appeal, may apply such provision or may remand the case to the Commissioner or to the district court for the taking of additional evidence or a new trial or for reconsidera--tion of the decision on the record as made, as the appellate court may deem proper.

SEC. 48. Section 4 of the Act of January 5, 1905 (U.S.C., title 36, sec. 4) as amended, entitled "An Act to incorporate the National Red Cross", and section 7 of the Act of June 15, 1916 (U.S.C., title 36, sec. 27), entitled "An Act to incorporate the Boy Scouts of America, and for other purposes", and the Act of June 20, 1936 (U.S.C., title 22, sec. 248), entitled "An Act to prohibit the commercial use of the coat of arms of the Swiss Confederation", are not repealed or affected by this Act.

SEC. 49. Nothing herein shall adversely affect the rights or the enforcement of rights in marks acquired in good faith prior to the passage of this Act.

SEC. 50. If any provision of this Act or the application of such provision to any person or circumstance is held invalid, the remainder of the Act and the application of such provision to other persons or circumstances shall not be affected thereby.

IN THE HOUSE OF REPRESENTATIVES

JANUARY 6, 1943

Mr. LANHAM introduced the following bill; which was referred to the Committee on Patents

A BILL

To provide for the registration and protection of trade--marks used in commerce, to carry out the provisions of certain international conventions, and for other purposes.

Be it enacted by the Senate and House of Representatives of the United States of America in Congress assembled.