§ S. 1957

Be it enacted by the Senate and House of Representatives of the United States of America in Congress assembled. That paragraph (1) of subsection (a) of section 1 of the Act entitled "An Act to provide for the registration and protection of trade--marks used in commerce, to carry out the provisions of international conventions, and for other purposes", approved July 5, 1946 (60 Stat. 427), is amended by adding after the semicolon at the end of said paragraph the following: "And provided further. That, in the case of

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every application for the registration of a mark wherein the claim of ownership and the right to registration are based upon use by a related company under section 5 hereof, the applicant shall acknowledge such use and shall indicate the nature of the relationship;".

SEC. 2. Subsection (d) of section 2 of such Act is amended by striking the language beginning with word "purchasers", first appearance, and ending with the word "herewith" at the end of said subsection and inserting in lieu thereof the following: "Provided. That when the Commissioner or a court on appeal determines that confusion, mistake or deception is not likely to result from the continued use by more than one person of the same or similar marks under conditions and limitations as to the mode or place of use of the marks or the goods or services in connection with which such marks are used, concurrent registrations may be granted to such persons when they have become entitled to use such marks as a result of their concurrent lawful use in commerce prior to (i) the earliest of the filing dates of the applications pending under this Act; or (ii) the application filing date of a registration granted under this Act; or (iii) the effective date of this Act in the case of registrations previously granted under the Act of March 3, 1881, or February 20, 1905, and continuing in full force and effect on that date; or (iv) the effective date of this Act in the case of

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applications under the Act of February 20, 1905, pending at the time this Act becomes effective. Concurrent registrations may also be granted by the Commissioner when a court of competent jurisdiction has finally determined that more than one person is entitled to use the same or similar marks in commerce. In the grant of concurrent registrations, the Commissioner shall prescribe such conditions and limitations of the grant as to the mode or place of use of the mark or the goods or services in connection with which such mark is registered to the respective persons. Concurrent registrations may be ordered by a court in an action under the provisions of section 21 hereof, under such conditions and limitations as the court considers proper in accordance herewith."

SEC. 3. Subsection (d) of section 7 of such Act is amended by striking the words "herein provided" following the word "fee"; by striking the words "in whole or" following the word "disclaimed"; by striking the words "when so amended" following the word "registration" in the proviso: by striking the words "as amended" following the word "mark" in the proviso: and by inserting the word "prescribed" before the word "fee" and the words "if any" following the word "fee".

SEC. 4. Section 9 of such Act is amended by striking the entire section and inserting in lieu thereof the following:

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"(a) 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 or showing that its nonuse in commerce is due to special circumstances which excuse such nonuse and is not due to any intention to abandon the mark 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.
"(b) The Commissioner shall notify any registrant who files the above--prescribed affidavit of his acceptance or refusal thereof and, if a refusal, the reasons therefor.
"(c) An applicant for renewal not domiciled in the United States shall be subject to and comply with the provisions of section 1 (d) hereof."

SEC. 5. Section 10 of such Act is amended by changing the colon following the word "conducted" to a period and striking the words "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 mis--

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represent the source of the goods or services in connection with which the mark is used."

SEC. 6. Subsection (a) of section 12 of such Act is amended by changing the period at the end thereof to a colon and inserting after the colon the following: "Provided. That in the case of every applicant claiming concurrent use, or in the case of an application to be placed in an interference, as provided for in section 16of this Act, the mark, if otherwise registerable, shall be published subject to the determination of the rights of the parties to such proceedings."
Subsection (c) of section 12 of such Act is amended by striking therefrom the words "setting forth those goods stated in the registration on which said" and inserting in lieu thereof the words "stating that the".
Section 12 of such Act is further amended by adding a new subsection (d) as follows:
"(d) The Commissioner shall maintain a public search file containing reproductions of all marks for which applications for registration have been filed and are pending. Promptly upon the filing of an application for registration of a mark, a reproduction of said mark shall be filed in the search file together with the name of the applicant, the date of filing of the application, the goods or services and class for which registration is sought, the name and address

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of the applicant's attorney; and the Commissioner shall furnish such information to subscribers."
SEC. 7. Section 14 of such Act is amended by striking said section in its entirety and inserting in lieu thereof the following:
"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, file a verified petition to cancel said registration stating the grounds therefor--
"(a) before the registered mark shall have acquired an incontestable status as provided by section
15 of this Act; or

"(b) at any time if the registered mark has been abandoned or its registration was obtained fraudulently or contrary to the provisions of section 4 or 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 is being used by, or with the permission of, the registrant so as to misrepresent the source of the goods or services in connection with which the mark is used; or
"(c) at any time in the case of a certification mark

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on the ground that the registrant does not control, or is not able legitimately to exercise control over, the use of such mark."

SEC. 8. Section 15 of such Act is amended by striking therefrom "(c) and (d)" following the word "subsections and inserting in lieu thereof "(b) and (c)", and by striking therefrom the semicolon and the word "and" following the word "hereof" at the end of paragraph numbered (3) and inserting a period in lieu thereof; and by striking therefrom paragraph numbered (4) in its entirety.

SEC. 9. Section 16 of such Act is amended by striking therefrom the word "purchasers" following the word "deceive".

SEC. 10. Section 17 of such Act is amended by changing the period at the end thereof to a comma and inserting after the comma the following: "and so far as practicable, all inter partes proceedings involving rights of registration of a mark shall be consolidated for the purposes of the taking of testimony and final hearing."

SEC. 11. Section 18 of such Act is amended by striking therefrom the word "such" following the initial work "In" and inserting in lieu thereof the words "any of the" and by inserting the words "referred to in section 17 hereof," following the word "proceedings", first appearance.

SEC. 12. Section 21 of such Act is amended by striking

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said section in its entirety and inserting in lieu thereof the following:
"(a) Any applicant for registration of a mark, party to an interference proceeding, party to an opposition proceeding, party to an application to register as a lawful concurrent user, party to a cancellation proceeding, or any registrant who has filed an affidavit as provided in section 8 or 9, who is dissatisfied with the decision of the Commissioner, may appeal to the United States Court of Customs and Patent Appeals: Provided. That such appeal shall be dismissed by said Court of Customs and Patent Appeals if any adverse party to the proceeding other than the Commission shall within twenty days after the appellant shall have filed notice of appeal, according to section 21 (b) hereof file notice with the Commissioner that he elects to have all further proceedings conducted as provided in section 21 (e) hereof. Thereupon the appellant shall have thirty days thereafter within which to file a complaint in a civil action under said section 21 (e), in default of which the decision appealed from shall govern the further proceedings in the case.
"(b) When an appeal is taken to the United States Court of Customs and Patent Appeals, the appellant shall give notice thereof to the Commissioner, and file in the Pat--

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ent Office, within such time as the Commissioner shall appoint, his reasons of appeal specifically set forth in writing.

"(c) The court shall, before hearing such appeal, give notice to the Commissioner of the time and place of the hearing, and on receiving such notice the Commissioner shall give notice of such time and place, in such manner as the court may prescribe, to all parties who appear to be interested therein. The appellant shall file with the court certified copies of all the original papers and evidence in the case, and the Commissioner shall furnish the court with the grounds of his decision, fully set forth in writing, touching all the points involved by the reasons of appeal.
"(d) The court, on petition, shall hear and determine such appeals and revise the decision appealed from in a summary way on the evidence produced before the Commissioner at such early and convenient time as the court may appoint; and the revision shall be confined to the points set forth in the reasons of appeal, except that the court may consider other grounds of record on due notice to the parties. After bearing the case, the court shall return to the Commissioner a certificate of its proceedings and decision, which shall be entered of record in the Patent Office and shall

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govern the further proceedings in the case; but no opinion or decision of the court in any such case shall preclude any interested person from contesting the validity of such trade--mark registration in any court wherein the same may be called in question.
"(e) Whenever a person authorized by section 21 (a) hereof to appeal to the United States Court of Customs and Patent Appeals is dissatisfied with the decision of the Commissioner, said person, unless appeal has been taken to said Court of Customs and Patent Appeals, and such appeal is pending or has been decided, in which case no action may be brought under this section, may have remedy by a civil action if the complaint is filed within six months after the Commissioner's decision and due notice thereof given to all other parties to the proceeding in the Patent Office: and the court having cognizance thereof, on notice to adverse parties and other due proceedings had, may order, among other things, the registration of a mark, the cancellation(in whole or in part) or restriction of any registration, the restoration of canceled registrations, and other rectifications of the register with respect to the registration of any party to the action, as the rights of the parties may be established in the proceeding. Judgments and orders shall be certified by the court to the Commissioner, who shall make appropriate entry upon

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the records of the Patent Office and who shall be controlled thereby.
"The Commissioner shall not be made party to an inter partes proceeding under this subsection, but he shall be notified of the filing of the complaint by the clerk of the court in which it is filed, and the Commissioner shall have the right to intervene in the action.
"In all cases where there is no adverse party, a copy of the complaint shall be served on the Commissioner; and all the expenses of the proceedings shall be paid by the party bringing them, whether the final decision is in his favor or not. In all suits brought hereunder where there are adverse parties, the record in the Patent Office shall be admitted, in whole or in part, on motion of any party, subject to such terms and conditions as to cost, expenses, and the further cross--examination of the witnesses as the court may impose, without prejudice, however, to the right of any party to take further testimony. The testimony and exhibits, or parts thereof, of the record in the Patent Office, when admitted, shall have the same force and effect as if originally taken and produced in the suit.

"Upon the filing of a complaint in the District Court of the United States for the District of Columbia, wherein remedy is sought under section 21 (e) hereof without seek--

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ing other remedy, if it shall appear that there is an adverse party residing in a foreign country, or adverse parties residing in a plurality of districts not embraced within the same State, the court shall have jurisdiction thereof and writs shall, unless the adverse party or parties voluntarily make appearance, be issued against all of the adverse parties with the force and effect and in the manner set forth in section 1392 of title 28, United States Code: Provided. That writs issue against parties residing in foreign countries pursuant to this section may be served by publication or otherwise as the court shall direct."

SEC. 13. Section 23 of such Act is amended by striking from the last paragraph thereof the words "has begun the lawful use of his mark in foreign commerce and that he."

SEC. 14. Section 24 of such Act is amended by inserting in the second sentence thereof, following the word "time", first appearance, the following; "upon payment of the prescribed fee and the filing of a verified petition setting forth the grounds upon which he is damaged,".

SEC. 15. Section 26 of such Act is amended by inserting the words "the proviso of section 2 (d)."following the words "advantages of", and the numeral "6", following the letter "(f),".

SEC. 16. Section 29 of such Act is amended by inserting the words "on or in connection with the goods or serv--

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ices" following the word "used"; by striking the words "mark goods bearing the registered mark" and inserting in lieu thereof the words "give such notice of registration".

SEC. 17. Section 30 of such Act is amended by adding at the beginning of the third sentence thereof the words "On request of the applicant," and changing the initial letter of the word "The" in the said sentence to a lower--case letter; by striking the word "registered" following the word "mark" in said sentence; by adding a period after the word "classes": and by striking the words "upon payment of a fee equaling the sum of the fees for each registration in each class."

SEC. 18. Section 31 of such Act is amended by striking the words "surrender, or cancellation" in the first paragraph thereof; by striking the comma following the word "disclaimer" in said paragraph and inserting in lieu of such comma the word "or".

SEC. 19. Section 32(1) of such Act is amended by striking said section in its entirety and inserting in lieu thereof the following:
"Any person who shall, without the consent of the registrant-
"(a) use in commerce any reproduction, counterfeit, copy, or colorable imitation of a registered mark in connection with the sale, offering for sale, distribution, or advertising of any goods or services on or in con-

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nection with which such use is likely to deceive, or to cause confusion, or to cause mistake; or

"(b) reproduce, counterfeit, copy, or colorably imitate a registered mark and apply such reproduction, counterfeit, copy, or colorable imitation to labels, signs, prints, packages, wrappers, receptacles, or advertisements intended to be used in commerce upon or in connection with the sale, offering for sale, distribution, or advertising of any goods or services; or
"(c) employ a registered mark in commerce otherwise than as a trade or service mark in such manner as to be likely to cause the mark to lose its significance as a mark.
shall be liable in a civil action by the registrant for the remedies hereinafter provided. Under subsection (b)hereof, the registrant shall not be entitled to recover profits or damages unless the acts have been committed with knowledge that such imitation is intended to be used to deceive, or to cause confusion, or to cause mistake. Under subsection (c) hereof, the registrant shall not be entitled to recover profits or damages."

SEC. 20. Subsection (b) of section 32 (2) of such Act is amended by striking the word "published" and inserting in lieu thereof the word "publisher".

SEC. 21. Subsection (b) of section 33 of such Act is

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amended by striking therefrom the word "certificate", second appearance, following the word "the" and inserting in lieu thereof "affidavit filed under the provisions of said section 15".
Paragraph (3) of subsection (b) of section 33 of such Act is amended by striking therefrom the words "has been assigned and" following the word "mark", first appearance; by striking therefrom ", by or with the permission of the assignee," following the word "used", first appearance, and inserting in lieu thereof the words "by the registrant or by a person in privity with the registrant".
Paragraph (5) of subsection (b) of section 33 of such Act is amended by striking therefrom the word "the" following the words "date prior to" and inserting in lieu thereof the words "registration of the mark under this Act or"; and by striking therefrom "(a) or" following the word "subsection".
Paragraph (6) of subsection (b) of section 33 of such Act is amended by striking therefrom "(a) or" following the word "subsection", first appearance; by striking therefrom the words "only where the said mark has been published pursuant to subsection (c) of section 12 and shall apply" following the word "apply" in the proviso; by striking the words "the date of" following the words "prior to" in the said proviso and inserting in lieu thereof "such registration or

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such"; by striking therefrom the words "subsection (a) or (c) of" following the word "under" in said proviso: and by inserting the words "registration under this Act or" following the words "prior to the", first appearance.
Paragraph (7) of subsection (b) of section 33 of such Act is amended by striking said paragraph in its
entirely.

SEC. 22. Section 35 of such Act is amended by striking therefrom "31 (1) (b)" and inserting in lieu thereof "32".

SEC. 23. Section 42 of such Act is amended by striking therefrom the initial word "That" and by capitalizing the then initial word "No"; by striking the word "the" following the words

"simulate the name of"; by striking the words "manufacture, or" following the word "domestic", first appearance, by striking the word "trade.", each appearance: by striking the words "in accordance with the provisions of this Act" following the word "registered", first appearance, and inserting in lieu thereof the words "on the principal register, or under the Act of March 3, 1881, or under the Act of February 20, 1905,": and by striking therefrom the words, "issued in accordance with the provisions of this Act," and inserting in lieu thereof the words "on the principal register, or under the Act of March 3, 1881, or under the Act of February 20, 1905,".

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SEC. 24. Subsection (b) of section 44 of such Act is amended by inserting the words "by treaty or law affords similar privileges to citizens and residents of the United States, or which" following the word "which", first appearance.
Subsection (e) of section 44 of such Act is amended by striking from the second sentence thereof the words "application for or" following the words "copy of the".

SEC. 25. Section 45 of such Act is amended in the following particulars:
The ninth paragraph thereof is amended by inserting a comma between the words "commercial" and "agricultural".
The thirteenth paragraph thereof is amended by striking the paragraph in its entirety and inserting in lieu thereof "The term "collective mark" means a mark used by the members of a cooperative, an association, or other collective group or organization, to identify the goods or services of such members and distinguish them from the goods or services of another, or to indicate membership in a union, an association, or other organization."
The fifteenth paragraph thereof is amended by changing the period at the end of said paragraph to a comma and adding the words "or the person rendering the service is engaged in commerce". The seventeenth paragraph thereof is amended by deleting the word "purchasers" at the end thereof. The final paragraph thereof is amended by striking therefrom the word "commence" and inserting in lieu
thereof the word "commerce".

[The following material is extracted from the Congressional Record Volume 97 beginning at page 9468]

REGISTRATION AND PROTECTION OF TRADE--MARKS USED IN COMMERCE

Mr. WILEY. Mr. President, I introduce for appropriate reference a bill to amend the act entitled "An act to provide for the registration and protection of trade--marks used in commerce, to carry out the provisions of international conventions and for other purposes, approved July 5, 1946. I ask unanimous consent that an explanatory statement of the bill be printed in the RECORD.

The VICE PRESIDENT. The bill will be received and appropriately referred, and, without objection, the explanatory statement will be printed in the RECORD. The bill (S. 1957) to amend the act entitled "An act to provide for the registration and protection of trade--marks used in commerce, to carry out the provisions of international conventions, and for other purposes," approved July 5, 1946, introduced by Mr. WILEY, was read twice by its title, and referred to the Committee on the Judiciary.
The explanatory statement is as follows:

STATEMENT BY SENATOR WILEY

On July 5, 1946, the trade--mark law of the United States was completely revised by Public Law 489, Seventy--ninth Congress, chapter 540, second session. According to the committee report which accompanied the bill at the time of its passage by Congress, the accomplishment of five basic things was intended, viz:

1. To put all existing trade--made statutes in a single piece of legislation.
2. To carry out by statute our international commitments to the end that American traders in foreign countries may secure the protection to their marks to which they are entitled.
3. To modernize the trade--mark statutes so that they will conform to legitimate present--day business practice.
4. To remedy constructions of the present acts which have in several instances obscured and perverted
their original purpose.
5. Generally to simplify trade--mark practice, to secure trade--mark owners in the good will which they have built up, and to protect the public from imposition by the use of counterfeit and imitated marks and false trade descriptions.

The law became effective on July 5, 1947, 1 year after its enactment, and during the almost 4 years of its operation some defects in substance and some defects in administration have become apparent. About 2 years ago, authorized representatives of some 26 legal and trade associations and representatives of the Patent Office formed a coordinating committee to study the effects of the law and to recommend such amendments as were agreed to be desirable. (A list of the organizations is enclosed.) Agreement has now been reached and a bill has been drafted to amend Public Law 489, Seventy--ninth Congress, second session, so that the broad basic purposes outlined by the congressional committees at the time of passage of the act may be more readily realized.

As is generally the case when Federal laws are completely revised, compromises were affected, and errors in draftsmanship crept in without any intent of changing the effect of the provisions. Four years of experience under the revised law have led trade--mark owners and their lawyers alike to agree upon amendatory provisions which will result in clarification, simplified administration, and substantive changes consonant with present day commercial practices and the Lents of our jurisprudence.

Although it is probable that some individuals may disagree with some provisions of the amendatory bill, generally speaking it represents the assent of the legal and trade associations participating in the discussions.

Substantively, the amendatory bill will make possible concurrent registration of all marks which are in lawful use in commerce. The legislative history of the act demonstrates clearly that the appropriate provisions of the act had such a purpose, but because of language difficulties a different interpretation has resulted.

The amendatory bill will prevent loss of rights in registrations where use has been temporarily discontinued due to materials shortages, war, or other acts over which the registrant has no control.

The bill will place all registrants on an equal footing, whether they be original registrants or assignees. It is clear from the legislative history that there was no intention to differentiate between registrants, but certain language was included inadvertently which accomplished this result in a literal interpretation of certain of the act's provisions.

The section dealing with cancellation will, by the bill, be clarified both substantively and procedurally. The period within which cancellation proceedings may be brought is tied to another section dealing with incontestability, thereby relieving the anomalous situation where incontestable rights have not been acquired, and yet one who deems himself damaged by a

registration is estopped from seeking its cancellation. Reference to a cancellation proceeding by an administration agency outside the Patent Office is to be eliminated by the bill.
The bill will provide a right of action against improper references to registered marks, if such references are likely to cause a mark to lose its significance. Under the present provisions of the act, any course of conduct of a registrant, including acts of omission as well as commission, which causes a mark to lose its significance may result in a holding that the mark has been abandoned. There is, however, no provision for a right of action to stop deliberate attempts by third persons which would have the result of causing the mark to lose its significance. It is this responsibility without recourse which the bill intends to correct.

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The bill will eliminate the inequitable defense in an infringement proceeding of past or present violation of the antitrust laws, since both public and private remedies for antitrust violations lie under other acts and do not properly form a part of a trade--mark act.
The balance of the bill deals generally with simplification of procedure, both in the Patent Office and the courts, clarification of obvious language errors which obscure the intent and purpose of the act, and correction of typographical errors.
[97 Cong. Rec. 9468--69 (1951).]

83d Congress. 1st Session

IN THE SENATE OF THE UNITED STATES JULY 31 (legislative day, JULY 27). 1953

Mr. WILEY 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 trade--marks used in commerce, to carry out the provisions of international conventions, and for other purposes", approved July 5, 1946.