Public Law 100-667 100th Congress

An Act

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 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,

TITLE I TRADEMARK LAW REVISION

SEC. 101 SHORT TITLE
This title may be cited as the "Trademark Law Revision Act of 1988".

SEC. 102 REFERENCE TO THE TRADEMARK ACT OF 1946
Except as otherwise expressly provided, whenever in this title an amendment is expressed in terms of an amendment to a section or other provision, the reference shall be considered to be made to a section or other provision of the Act entitled "An Act to provide for the registration and protection of trademarks used in commerce, to carry out the provisions of certain international conventions, and for other purposes", approved July 5, 1946 (15 U.S.C. 1051 and following) (commonly referred to as the "Trademark Act of 1946").

SEC. 103 APPLICATION TO REGISTER TRADEMARKS
Section 1 (15 U.S.C. 1051) is amended--
(1) in the matter before subsection (a), by striking out "may register his" and inserting in lieu thereof "may apply to register his or her";
(2) by redesignating paragraphs (1), (2), and (3) of subsection (a) as subparagraphs (A), (B), and (C), respectively;
(3) by redesignating subsections (a), (b), and (c) as paragraphs (1), (2), and (3), respectively;
(4) by inserting "(a)" after "Section1.";
(5) in subsection (a)(1)(A), as redesignated by this section--
(A) by striking out "applied to" and inserting in lieu thereof "used on or in connection with"; and
(B) by striking out "goods in connection" and inserting in lieu thereof "goods on or in connection";
(6) in subsection (a)(1)(C), as redesignated by this section, by striking out "actually";
(7) in subsection (a)(2), as redesignated by this section, by striking out "filing" and inserting in lieu thereof "prescribed";
(8) by redesignating subsection (d) as subsection (e); and
(9) by inserting before subsection (e), as redesignated by paragraph (8) of this section, the following:
"(b) A person who has a bona fide intention, under circumstances showing the good faith of such person, to use a trademark in commerce may apply to register the trademark under this Act on the principal register hereby established:
"(1) By filing in the Patent and Trademark Office--
"(A) 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 corporation or association applying, specifying applicant's domicile and citizenship, applicant's bona fide intention to use the mark in commerce, the goods on or in connection with which the applicant has a bona fide intention to use the mark and the mode or manner in which the mark is intended to be used on or in connection with such goods, including a statement to the effect that the person making the verification believes himself or herself, or the firm, corporation, or association in whose behalf he or she makes the verification, to be entitled to use the mark in commerce, and that no other person, firm, corporation, or association, to the

best of his or her knowledge and belief, has the right to use such mark in commerce either in the identical form of the mark or in such near resemblance to the mark as to be likely, when used on or in connection with the goods of such other person, to cause confusion, or to cause mistake, or to deceive; however, except for applications filed pursuant to section 44, no mark shall be registered until the applicant has met the requirements of subsection (d) of this section; and
"(B) a drawing of the mark.
"(2) By paying in the Patent and Trademark Office the prescribed fee.
"(3) By complying with such rules or regulations, not inconsistent with law, as may be prescribed by the Commissioner.
"(c) At any time during examination of an application filed under subsection (b), an applicant who has made use of the mark in commerce may claim the benefits of such use for purposes of this Act, by amending his or her application to bring it into conformity with the requirements of subsection (a).
"(d)(1) Within six months after the date on which the notice of allowance with respect to a mark is issued under section 13(b)(2) to an applicant under subsection (b) of this section, the applicant shall file in the Patent and Trademark Office, together with such number of specimens or facsimiles of the mark as used in commerce as may be required by the Commissioner and payment of the prescribed fee, a verified statement that the mark is in use in commerce and specifying the date of the applicant's first use of the mark in commerce, those goods or services specified in the notice of allowance on or in connection with which the mark is used in commerce, and the mode or manner in which the mark is used on or in connection with such goods or services. Subject to examination and acceptance of the statement of use, the mark shall be registered in the Patent and Trademark Office, a certificate of registration shall be issued for those goods or services recited in the statement of use for which the mark is entitled to registration, and notice of registration shall be published in the Official Gazette of the Patent and Trademark Office. Such examination may include an examination of the factors set forth in subsections (a) through (e) of section 2. The notice of registration shall specify the goods or services for which the mark is registered.
"(2) The Commissioner shall extend, for one additional 6--month period, the time for filing the statement of use under paragraph (1), upon written request of the applicant before the expiration of the 6--month period provided in paragraph (1). In addition to an extension under the preceding sentence, the Commissioner may, upon a showing of good cause by the applicant, further extend the time for filing the statement of use under paragraph (1) for periods aggregating not more than 24 months, pursuant to written request of the applicant made before the expiration of the last extension granted under this paragraph. Any request for an extension under this paragraph shall be accompanied by a verified statement that the applicant has a continued bona fide intention to use the mark in commerce and specifying those goods or services identified in the notice of allowance on or in connection with which the applicant has a continued bona fide intention to use the mark in commerce. Any req uest for an extension under this paragraph shall be accompanied by payment of the prescribed fee. The Commissioner shall issue regulations setting forth guidelines for determining what constitutes good cause for purposes of this paragraph.
"(3) The Commissioner shall notify any applicant who files a statement of use of the acceptance or refusal thereof and, if the statement of use is refused, the reasons for the refusal. An applicant may amend the statement of use.
"(4) The failure to timely file a verified statement of use under this subsection shall result in abandonment of the application.".

SEC. 104 TRADEMARKS REGISTRABLE ON PRINCIPAL REGISTER
Section 2 (15 U.S.C. 1052) is amended--
(1) by amending subsection (d) to read as follows:
"(d) Consists of or comprises a mark which so resembles a mark registered in the Patent and Trademark Office, or a mark or trade name previously used in the United States by another and not abandoned, as to be likely, when used on or in connection with the goods of the applicant, to cause confusion, or to cause mistake, or to deceive: Provided, That if the Commissioner 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 on or in connection with which such marks are used, concurrent registrations may be issued to such persons when they have become entitled to use such marks as a result of their concurrent lawful use in commerce prior to (1) the earliest of the filing dates of the applications pending or of any registration issued under this Act; (2) July 5, 1947, in the case of registratio ns previously issued under the Act of March 3, 1881, or February 20, 1905, and continuing in full force and effect on that date; or (3) July 5, 1947, in the case of applications filed under the Act of February 20, 1905, and registered after July 5, 1947. Use prior to the filing date of any pending application or a registration shall not be required when the owner of such application or registration consents to the grant of a concurrent registration to the applicant. Concurrent registrations may also be issued 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 issuing concurrent registrations, the Commissioner shall prescribe conditions and limitations as to the mode or place of use of the mark or the goods on or in connection with which such mark is registered to the respective persons.";
(2) in subsection (e) by striking out "applied to" each place it appears and inserting in lieu thereof "used on or in connection with"; and
(3) in subsection (f)--
(A) by striking out "applied to" and inserting in lieu thereof "used on or in connection with"; and
(B) by striking out "five years" and all that follows through the end of the subsection and inserting in lieu thereof "five years before the date on which the claim of distinctiveness is made.".

SEC. 105 SERVICE MARKS REGISTRABLE
Section 3 (15 U.S.C. 1053) is amended--
(1) in the first sentence--
(A) by striking out "used in commerce"; and
(B) by striking out ", except when" and all that follows through "mark is used"; and
(2) by striking out the second sentence.

SEC. 106 COLLECTIVE AND CERTIFICATION MARKS REGISTRABLE
Section 4 (15 U.S.C. 1054) is amended--
(1) in the first sentence--
(A) by striking out "origin used in commerce," and inserting in lieu thereof "origin,"; and
(B) by striking out "except when" and inserting in lieu thereof "except in the case of certification marks when"; and
(2) by striking out the second sentence.

SEC. 107 USE BY RELATED COMPANIES
Section 5 (15 U.S.C. 1055) is amended by adding at the end thereof the following: "If first use of a mark by a person is controlled by the registrant or applicant for registration of the mark with respect to the nature and quality of the goods or services, such first use shall inure to the benefit of the registrant or applicant, as the case may be.".

SEC. 108 DISCLAIMER OF UNREGISTRABLE MATTER
Section 6(b) (15 U.S.C. 1056(b)) is amended by striking out "paragraph (d)" and inserting in lieu thereof "subsection (e)".

SEC. 109 CERTIFICATE OF REGISTRATION ON THE PRINCIPAL REGISTER
Section 7 (15 U.S.C. 1057) is amended--
(1) by amending subsection (b) to read as follows:
"(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 registered mark and of the registration of the mark, of the registrant's ownership of the mark, and 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 in the certificate.";
(2) by redesignating subsections (c), (d), (e), (f), and (g) as subsections (d), (e), (f), (g), and (h), respectively;
(3) by inserting after subsection (b) the following:
"(c) Contingent on the registration of a mark on the principal register provided by this Act, the filing of the application to register such mark shall constitute constructive use of the mark, conferring a right of priority, nationwide in effect, on or in connection with the goods or services specified in the registration against any other person except for a person whose mark has not been abandoned and who, prior to such filing--
"(1) has used the mark;
"(2) has filed an application to register the mark which is pending or has resulted in registration of the mark; or
"(3) has filed a foreign application to register the mark on the basis of which he or she has acquired a right of priority, and timely files an application under section 44(d) to register the mark which is pending or has resulted in registration of the mark.";
(4) in subsection (d), as redesignated by paragraph (2) of this section, by striking out "fee herein provided" and inserting in lieu thereof "prescribed fee";
(5) in subsection (f), as redesignated by paragraph (2) of this section, by striking out "fee required by law" and inserting in lieu thereof "prescribed fee"; and
(6) in subsection (h), as redesignated by paragraph (2) of this section, by striking out "required fee" and inserting in lieu thereof "prescribed fee".

SEC. 110 DURATION OF REGISTRATION
Section 8(a)(15 U.S.C. 1058(a)) is amended--
(1) by striking out "twenty" and inserting in lieu thereof "ten"; and
(2) by striking out "showing that said mark is in use in commerce or showing that its" and inserting in lieu thereof "setting forth those goods or services recited in the registration on or in connection with which the mark is in use in commerce and attaching to the affidavit a specimen or facsimile showing current use of the mark, or showing that any".

SEC. 111 RENEWAL OF REGISTRATION
Section 9 (15 U.S.C. 1059) is amended--
(1) in subsection (a) by striking out "twenty" and inserting in lieu thereof "ten"; and
(2) in subsection (c) by striking out "1(d) hereof" and inserting in lieu thereof "1(e) of this Act".

SEC. 112 ASSIGNMENT
Section 10 (15 U.S.C. 1060) is amended--
(1) in the first sentence by striking out "and in any such assignment" and inserting in lieu thereof the following: ". However, no application to register a mark under section 1(b) shall be assignable prior to the filing of the verified statement of use under section 1(d), except to a successor to the business of the applicant, or portion thereof, to which the mark pertains, if that business is ongoing and existing. In any assignment authorized by this section"; and
(2) in the last paragraph by striking out "1(d) hereof" and inserting in lieu thereof "1(e) of this Act".

SEC. 113 EXAMINATION OF APPLICATION
Section 12(a) (15 U.S.C. 1062(a)) is amended--
(1) by striking out "fee herein provided" and inserting in lieu thereof "prescribed fee"; and
(2) by striking out "to registration, the" and inserting in lieu thereof "to registration, or would be entitled to registration upon the acceptance of the statement of use required by section 1(d) of this Act, the".

SEC. 114 OPPOSITION TO MARKS

Section 13 (15 U.S.C. 1063) is amended--
(1) by inserting "(a)" before "Any person";
(2) by striking out "required fee" and inserting in lieu thereof "prescribed fee"; and
(3) by adding at the end thereof the following:
"(b) Unless registration is successfully opposed--
"(1) a mark entitled to registration on the principal register based on an application filed under section 1(a) or pursuant to section 44 shall be registered in the Patent and Trademark Office, a certificate of registration shall be issued, and notice of the registration shall be published in the Official Gazette of the Patent and Trademark Office; or
"(2) a notice of allowance shall be issued to the applicant if the applicant applied for registration under section 1(b).".

SEC. 115 CANCELLATION OF REGISTRATIONS
Section 14 (15 U.S.C. 1064) is amended--
(1) in the matter preceding subsection (a)--
(A) by inserting "as follows" after "be filed"; and
(B) by striking out "1905--" and inserting in lieu thereof "1905:";
(2) in subsection (a)--
(A) by striking out "(a) within" and inserting in lieu thereof "(1) Within"; and
(B) by striking out "; or" and inserting in lieu thereof a period;
(3) in subsection (b)--
(A) by striking out "(b) within" and inserting in lieu thereof "(2) Within"; and
(B) by striking out "; or" and inserting in lieu thereof a period;
(4) by amending subsection (c) to read as follows:
"(3) At any time if the registered mark becomes the generic name for the goods or services, or a portion thereof, for which it is registered, or has been abandoned, or its registration was obtained fraudulently or contrary to the provisions of section 4 or of subsection (a), (b), or (c) of section 2 for a registration under this Act, or contrary to similar prohibitory provisions of such prior Acts for a registration under such Acts, 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 on or in connection with which the mark is used. If the registered mark becomes the generic name for less than all of the goods or services for which it is registered, a petition to cancel the registration for only those goods or services may be filed. A registered mark shall not be deemed to be the generic name of goods or services solely because such mark is also used as a name of or to identify a unique product or service. The primary significance of the registered mark to the relevant public rather than purchaser motivation shall be the test for determining whether the registered mark has become the generic name of goods or services on or in connection with which it has been used.".
(5) in subsection (d)--
(A) by striking out "(d) at" and inserting in lieu thereof "(4) At"; and
(B) by striking out "; or" and inserting in lieu thereof a period;
(6) in subsection (e)--
(A) by striking out "(e) at" and inserting in lieu thereof "(5) At"; and
(B) by striking out "(1)", "(2)", "(3)", and "(4)" and inserting in lieu thereof "(A)", "(B)", "(C)", and "(D)", respectively; and
(7) in the proviso at the end of the section by striking out "subsections (c) and (e)" and inserting in lieu thereof "paragraphs(3) and (5)".

SEC. 116 INCONTESTABILITY OF RIGHT TO USE MARK
Section 15 (15 U.S.C. 1065) is amended--
(1) by striking out "subsections (c) and (e)" and inserting in lieu thereof "paragraphs (3) and (5)";
(2) in paragraph (3) by striking out "subsections (1) and (2) hereof" and inserting in lieu thereof "paragraphs (1) and (2) of this section"; and

(3) in paragraph (4) by striking out "the common descriptive name of any article or substance, patented or otherwise" and inserting in lieu thereof "the generic name for the goods or services or a portion thereof, for which it is registered".

SEC. 117 INTERFERENCE
Section 16 (15 U.S.C. 1066) is amended by striking out "applied to the goods or when used in connection with the services" and inserting in lieu thereof "used on or in connection with the goods or services".

SEC. 118 ACTION OF COMMISSIONER IN PROCEEDINGS
Section 18 (15 U.S.C. 1068) is amended--
(1) by striking out "or restrict" and inserting in lieu thereof "the registration, in whole or in part, may modify the application or registration by limiting the goods or services specified therein, may otherwise restrict or rectify with respect to the register";
(2) by striking out "or may refuse" and inserting in lieu thereof "may refuse"; and
(3) adding at the end thereof the following: "However, no final judgment shall be entered in favor of an applicant under section 1(b) before the mark is registered, if such applicant cannot prevail without establishing constructive use pursuant to section 7(c).".

SEC. 119 APPLICATION OF EQUTTABLE PRINCIPLES
Section 19 (15 U.S.C. 1069) is amended by striking out the second sentence.

SEC. 120 APPEALS
Section 21 (15 U.S.C. 1071) is amended--
(1) in subsection (a)(1)--
(A) by striking out "section 21(b) hereof" each place it appears and inserting in lieu thereof "subsection (b) of this section";
(B) by striking out "section 21(a)(2) hereof" and inserting in lieu thereof "paragraph (2) of this subsection"; and
(C) by striking out "said section 21(b)" and inserting in lieu thereof "subsection (b) of this section";
(2) in subsection (a)(4), by adding at the end thereof the following: "However, no final judgment shall be entered in favor of an applicant under section 1(b) before the mark is registered, if such applicant cannot prevail without establishing constructive use pursuant to section 7(c).";
(3) in subsection (b)(1)--
(A) by striking out "section 21(a) hereof" and inserting in lieu thereof "subsection (a) of this section";
(B) by striking out "section 21(a)" and inserting in lieu thereof "subsection (a) of this section"; and
(C) by adding at the end thereof the following: "However, no final judgment shall be entered in favor of an applicant under section 1(b) before the mark is registered, if such applicant cannot prevail without establishing constructive use pursuant to section 7(c)."; and
(4) in subsection (b)(3), by striking out "(3)" and all that follows through the end of the first sentence and inserting in lieu thereof the following:
"(3) In any case where there is no adverse party, a copy of the complaint shall be served on the Commissioner, and, unless the court finds the expenses to be unreasonable, all the expenses of the proceeding shall be paid by the party bringing the case, whether the final decision is in favor of such party or not.".

SEC. 121 SUPPLEMENTAL REGISTER
Section 23 (15 U.S.C. 1091) is amended--
(1) by inserting "(a)" before "In addition" in the first paragraph;
(2) by inserting "(b)" before "Upon the" in the second paragraph;
(3) by inserting "(c)" before "For the purposes" in the third paragraph;
(4) in subsection (a), as designated by paragraph (1) of this section--

(A) by striking out "paragraphs (a)," and inserting in lieu thereof "subsections (a),";
(B) by striking out "have been in lawful use in commerce by the proprietor thereof, upon" and inserting in lieu thereof "are in lawful use in commerce by the owner thereof, on";
(C) by striking out "for the year preceding the filing of the application"; and
(D) by inserting before "section 1" the following: "subsections(a) and (e) of";
(5) in subsection (b), as designated by paragraph (2) of this section, by striking out "fee herein provided" and inserting in lieu thereof "prescribed fee"; and
(6) by striking out the last paragraph.

SEC. 122 CANCELLATION ON SUPPLEMENTAL REGISTER
Section 24 (15 U.S.C. 1092) is amended--
(1) by striking out "verified" in the second sentence;
(2) by striking out "was not entitled to register the mark at the time of his application for registration thereof," and inserting in lieu thereof "is not entitled to registration,";
(3) by striking out "is not used by the registrant or"; and
(4) by adding at the end thereof the following: "However, no final judgment shall be entered in favor of an applicant under section 1(b) before the mark is registered, if such applicant cannot prevail without establishing constructive use pursuant to section 7(c).".

SEC. 123 PROVISIONS OF ACT APPLICABLE TO SUPPLEMENTAL REGISTER
Section 26 (15 U.S.C. 1094) is amended--
(1) by inserting "1(b)," after "section"; and
(2) by inserting "7(c)," after "7(b)".

SEC. 124 REGISTRATION ON PRINCIPAL REGISTER NOT PRECLUDED
Section 27 (15 U.S.C. 1095) is amended by adding at the end thereof the following: "Registration of a mark on the supplemental register shall not constitute an admission that the mark has not acquired distinctiveness.".

SEC. 125 NOTICE OF REGISTRATION
Section 29 (15 U.S.C. 1111) is amended by striking out "as used".

SEC. 126 CLASSIFICATION OF GOODS AND SERVICES
Section 30 (15 U.S.C. 1112) is amended--
(1) by inserting "or registrant's" after "applicant's";
(2) by striking out "may file an application" and inserting in lieu thereof "may apply";
(3) by striking out "goods and services upon or in connection with which he is actually using the mark:" and inserting in lieu thereof "goods or services on or in connection with which he or she is using or has a bona fide intention to use the mark in commerce:"; and
(4) by amending the proviso to read as follows: "Provided, That if the Commissioner by regulation permits the filing of an application for the registration of a mark for goods or services which fall within a plurality of classes, a fee equaling the sum of the fees for filing an application in each class shall be paid, and the Commissioner may issue a single certificate of registration for such mark.".

SEC. 127 INNOCENT INFRINGEMENT AND VIOLATIONS OF SECTION 43(a)
Section 32(2) (15 U.S.C. 1114(2)) is amended to read as follows:
"(2) Notwithstanding any other provision of this Act, the remedies given to the owner of a right infringed under this Act or to a person bringing an action under section 43(a) shall be limited as follows:
"(A) Where an infringer or violator is engaged solely in the business of printing the mark or violating matter for others and establishes that he or she was an innocent infringer or innocent violator, the owner of the right infringed or person bringing the action under section 43(a) shall be entitled as against such infringer or violator only to an injunction against future printing.

"(B) Where the infringement or violation complained of is contained in or is part of paid advertising matter in a newspaper, magazine, or other similar periodical or in an electronic communication as defined in section 2510(12) of title 18, United States Code, the remedies of the owner of the right infringed or person bringing the action under section 43(a) as against the publisher or distributor of such newspaper, magazine, or other similar periodical or electronic communication shall be limited to an injunction against the presentation of such advertising matter in future issues of such newspapers, magazines, or other similar periodicals or in future transmissions of such electronic communications. The limitations of this subparagraph shall apply only to innocent infringers and innocent violators.
"(C) Injunctive relief shall not be available to the owner of the right infringed or person bringing the action under section 43(a) with respect to an issue of a newspaper, magazine, or other similar periodical or an electronic communication containing infringing matter or violating matter where restraining the dissemination of such infringing matter or violating matter in any particular issue of such periodical or in an electronic communication would delay the delivery of such issue or transmission of such electronic communication after the regular time for such delivery or transmission, and such delay would be due to the method by which publication and distribution of such periodical or transmission of such electronic communication is customarily conducted in accordance with sound business practice, and not due to any method or device adopted to evade this section or to prevent or delay the issuance of an injunction or restraining order with respect to such infringing matter o r violating matter.
"(D) As used in this paragraph--
"(i) the term 'violator' means a person who violates section 43(a); and
"(ii) the term 'violating matter' means matter that is the subject of a violation under section 43(a).".

SEC. 128 REMEDIES
(a) Prima Facte Evidence of Exclusive Right To Use Mark.----Section 33(a) (15 U.S.C. 1115(a)) is amended--
(1) by inserting "the validity of the registered mark and of the registration of the mark, of the registrant's ownership of the mark, and of the" after "prima facie evidence of";
(2) by inserting "or in connection with" after "in commerce on";
(3) by striking out "an opposing party" and inserting in lieu thereof "another person"; and
(4) by inserting ", including those set forth in subsection (b)," after "or defect".
(b) Conclusive Evidence of Exclusive Right To Use Mark.----Section 33(b) (15 U.S.C. 1115(b)) is amended--
(1) in subsection (b) by amending the matter before paragraph (1) to read as follows:
"(b) To the extent that the right to use the registered mark has become incontestable under section 15, the registration shall be conclusive evidence of the validity of the registered mark and of the registration of the mark, of the registrant's ownership of the mark, and of the registrant's exclusive right to use the registered mark in commerce. Such conclusive evidence shall relate to the exceusive right to use the mark on or in connection with the goods or services specified in the affidavit filed under the provisions of section 15, or in the renewal application filed under the provisions of section 9 if the goods or services specified in the renewal are fewer in number, subject to any conditions or limitations in the registration or in such affidavit or renewal application. Such conclusive evidence of the right to use the registered mark shall be subject to proof of infringement as defined in section 32, and shall be subject to the following defenses or defects:";
(2) in paragraph (3) by inserting "on or" after "goods or services";
(3) in paragraph (4)--
(A) by striking out "trade or service"; and
(B) by striking out "to users";
(4) in paragraph (5) by striking out "registration of the mark under this Act or" and inserting in lieu thereof "(A) the date of constructive use of the mark established pursuant to section 7(c), (B) the registration of the mark under this Act if the application for registration is filed before the effective date of the Trademark Law Revision Act of 1988, or (C)";

(5) in paragraph (7) by striking out the period and inserting in lieu thereof "; or"; and
(6) by adding at the end of the subsection the following:"(8) That equitable principles, including laches, estoppel, and acquiescence, are applicable.".
(c) Injunctions.----Section 34(a) (15 U.S.C. 116(a)) is amended in the first sentence by inserting "or to prevent a violation under section 43(a)" after "Office".
(d) Notice of Suit to Commissioner.----Section 34(c) (15 U.S.C 1116(c)) is amended--
(1) by striking out "proceeding arising" and inserting in lieu thereof "proceeding involving a mark registered"; and
(2) by striking out "decision is rendered, appeal taken or a decree issued" and inserting in lieu thereof "judgment is entered or an appeal is taken".
(e) Civil Actions Arising From Use of Counterfeit Marks.----Section 34(d)(1)(B) (15 U.S.C. 1116(d)(1)(B)) is amended by inserting "on or" after "designation used".

SEC. 129 RECOVERY FOR VIOLATION OF RIGHTS
Section 35(a) (15 U.S.C. 1117(a)) is amended in the first sentence by inserting ", or a violation under section 43(a)," after "Office".

SEC. 130 DESTRUCTION OF INFRINGING ARTICLES
Section 36 (15 U.S.C. 1118) is amended in the first sentence--
(1) by inserting ", or a violation under section 43(a)," after "Office"; and
(2) by inserting after "registered mark" the following: "or, inthe case of a violation of section 43(a), the word, term, name, symbol, device, combination thereof, designation, description, or representation that is the subject of the violation,".

SEC. 131 JURISDICTION
(a) Jurisdiction of Courts.----Section 39 (15 U.S.C. 1121) is amended by inserting "(a)" after "Sec. 39.".
(b) Certain Actions by States Precluded.----Section 39a (15 U.S.C. 1121a) is amended--
(1) by striking out "Sec. 39a." and inserting in lieu thereof "(b)"; and
(2) by striking out "servicemarks" each place it appears and inserting in lieu thereof "service marks".

SEC. 132 UNREGISTERED MARKS, DESCRIPTIONS, AND REPRESENTATIONS
Section 43(a) (15 U.S.C. 1125(a)) is amended to read as follows:
"(a) Any person who, on or in connection with any goods or services, or any container for goods, uses in commerce any word, term, name, symbol, or device, or any combination thereof, or any false designation of origin, false or misleading description of fact, or false or misleading representation of fact, which--
"(1) is likely to cause confusion, or to cause mistake, or to deceive as to the affiliation, connection, or association of such person with another person, or as to the origin, sponsorship, or approval of his or her goods, services, or commercial activities by another person, or
"(2) in commercial advertising or promotion, misrepresents the nature, characteristics, qualities, or geographic origin of his or her or another person's goods, services, or commercial activities,
shall be liable in a civil action by any person who believes that he or she is or is likely to be damaged by such act.".

SEC. 133 INTERNATIONAL MATTERS
Section 44 (15 U.S.C. 1126) is amended--
(1) in subsections (c), (d), (f), (g), and (h) by striking out "paragraph (b)" each place it appears and inserting in lieu thereof "subsection (b)";
(2) in subsection (a) by striking out "herein prescribed" and inserting in lieu thereof "required in this Act";
(3) in subsection (d) by striking out "sections 1, 2, 3, 4, or 23" and inserting in lieu thereof "section 1, 3, 4, 23, or 44(e)";

(4) in subsection (d)(2) by striking out "but use in commerce need not be alleged" and inserting in lieu thereof "including a statement that the applicant has a bona fide intention to use the mark in commerce";
(5) in subsection (d)(3) by striking out "foreing" and inserting in lieu thereof "foreign";
(6) in subsection (e) by adding at the end thereof the following: "The application must state the applicant's bona fide intention to use the mark in commerce, but use in commerce shall not be required prior to registration.";
(7) in subsection (f) by striking out "paragraphs (c), (d)," and inserting in lieu thereof "subsections (c), (d),"; and
(8) in subsection (i) by striking out "paragraph (b) hereof" and inserting in lieu thereof "subsection (b) of this section".

SEC. 134 CONSTRUCTION AND DEFINITIONS
Section 45 (15 U.S.C. 1127) is amended--
(1) by amending the paragraph defining "related company" to read as follows:
"The term 'related company' means any person whose use of a mark is controlled by the owner of the mark with respect to the nature and quality of the goods or services on or in connection with which the mark is used.";
(2) by amending the paragraph defining "trade name" and "commercial name" to read as follows:
"The terms 'trade name' and 'commercial name' mean any name used by a person to identify his or her business or vocation.";
(3) by amending the paragraph defining "trademark" to read as follows:"The term 'trademark' includes any word, name, symbol, or device, or any combination thereof-- "(1) used by a person, or
"(2) which a person has a bona fide intention to use in commerce and applies to register on the principal register established by this Act,
to identify and distinguish his or her goods, including a unique product, from those manufactured or sold by others and to indicate the source of the goods, even if that source is unknown.";
(4) by amending the paragraph defining "service mark" to read as follows:
"The term 'service mark' means any word, name, symbol, or device, or any combination thereof--
"(1) used by a person, or
"(2) which a person has a bona fide intention to use in commerce and applies to register on the principal register established by this Act,
to identify and distinguish the services of one person, including a unique service, from the services of others and to indicate the source of the services, even if that source is unknown. Titles, character names, and other distinctive features of radio or television programs may be registered as service marks notwithstanding that they, or the programs, may advertise the goods of the sponsor.";
(5) by amending the paragraph defining "certification mark" to read as follows:"The term 'certification mark' means any word, name, symbol, or device, or any combination thereof-- "(1) used by a person other than its owner, or
"(2) which its owner has a bona fide intention to permit a person other than the owner to use in commerce and files an application to register on the principal register established by this Act, to certify regional or other origin, material, mode of manufacture, quality, accuracy, or other characteristics of such person's goods or services or that the work or labor on the goods or services was performed by members of a union or other organization.";
(6) by amending the paragraph defining "collective mark" to read as follows:"The term 'collective mark' means a trademark or service mark-- "(1) used by the members of a cooperative, an association, or other collective group or organization, or
"(2) which such cooperative, association, or other collective group or organization has a bona fide intention to use in commerce and applies to register on the principal register established by this Act, and includes marks indicating membership in a union, an association, or other organization.";
(7) by amending the paragraph defining "mark" to read as follows:"The term 'mark' includes any trademark, service mark, collective mark, or certification mark.";

(8) by amending the matter which appears between the paragraph defining "mark", and the paragraph defining "colorable imitation" to read as follows:
"The term 'use in commerce' means the bona fide use of a mark in the ordinary course of trade, and not made merely to reserve a right in a mark. For purposes of this Act, a mark shall be deemed to be in use in commerce--
"(1) on goods when--
"(A) 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, or if the nature of the goods makes such placement impracticable, then on documents associated with the goods or their sale, and
"(B) the goods are sold or transported in commerce, and
"(2) on services when it is used or displayed in the sale or advertising of services and the services are rendered in commerce, or the services are rendered in more than one State or in the United States and a foreign country and the person rendering the services is engaged in commerce in connection with the services.
"A mark shall be deemed to be 'abandoned' when either of the following occurs:
"(1) When its use has been is continued with intent not to resume such use. Intent not to resume may be inferred from circumstances. Nonuse for two consecutive years shall be prima facie evidence of abandonment. 'Use' of a mark means the bona fide use of that mark made in the ordinary course of trade, and not made merely to reserve a right in a mark.
"(2) When any course of conduct of the owner, including acts of omission as well as commission, causes the mark to become the generic name for the goods or services on or in connection with which it is used or otherwise to lose its significance as a mark. Purchaser motivation shall not be a test for determining abandonment under this paragraph.";

SEC. 135 PENDING APPLICATIONS
The Tradeamrk Act of 1946 is amended by adding at the end thereof the following:
"Sec. 51. All certificates of registration based upon applications for registration pending in the Patent and Trademark Office on the effective date of the Trademark Law Revision Act of 1988 shall remain in force for a period of 10 years.".

SEC. 136 EFFECTIVE DATE
This title and the amendments made by this title shall become effective on the date which is one year after the date of enactment of this Act.