92D CONGRESS
1ST SESSION

S. 2595

IN THE SENATE OF THE UNITED STATES

SEPTEMBER 28, 1971

MR MCCLELLAN (by request) introduced the following bill, which was read twice and referred to the Committee on the Judiciary

A BILL

To amend the Act entitled "An Act to provide for the registration and protection of trademarks used in commerce, to carry out the provisions of international conventions, and for other purposes", approved July 5, 1946, as amended.

Be it enacted by the Senate and House of Representatives of the United States of America in Congress assembled, That section 1 of the Act entitled "An Act to provide for the registration and protection of trademarks used in commerce, to carry out the provisions of international conventions, and for other purposes", approved July 5, 1946 (60 Stat. 427), as amended, is amended to read as follows:

FINAL ACTION

"SECTION 1. The owner of a trademark used in commerce may register his trademark under this Act on the principal register hereby established:

"(a) By filing in the Patent Office 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—

"(1) 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 commerce either in the identical form thereof or in such near resemblance thereto as to be likely, when applied to the goods of such other person, to cause confusion, or to cause mistake, or to deceive: *Provided*, That in the case of every application claiming con-

current 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 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, or

"(2) specifying applicant's domicile and citizenship, applicant's intent to use the mark in commerce, the goods in connection with which the mark is intended to be used and the mode or manner in which the mark is intended to be 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 entitled to use the mark sought to be registered, and that no other person, firm, corporation or association, to the best of his knowledge and belief, is using such mark in commerce either in the identical form thereof or in such near resemblance thereto as to be likely, when applied to the goods of such other person, to cause confusion, or to cause mistake, or to deceive: *Provided,* That no registration shall issue until the applicant has filed in the Patent Office, together with the specimens or facsimiles of the mark as

actually used, as required by section 1(b) of this Act, a verified statement of use accepted by the Commissioner setting forth that the mark is in use in commerce by the applicant, the date of applicant's first use of the mark and the date of applicant's first use of the mark in commerce, those of the goods specified in the application 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 any registration issuing on an application filed under this section 1(a)(2) shall specify only the goods recited in such statement as the latter is accepted by the Commissioner. Such statement may be filed at any time after the application has been filed, and must be filed before the end of six months following the date of publication of the mark for opposition, unless sooner required as provided in sections 13 and 16 of this Act, and the failure to file such verified statement of use prior to the expiration of the specified period shall be deemed to be an abandonment of the application In exceptional circumstances, the time for filing such verified statement of use may be extended by the Commissioner The Commissioner shall notify any applicant who files such statement of his acceptance or refusal thereof and, if a refusal, the reasons therefor

"(b) By filing in the Patent Office a drawing of the

mark, and such number of specimens or facsimiles of the mark as actually used as may be required by the Commissioner.

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

"(d) By complying with such rules or regulations, not inconsistent with law, as may be prescribed by the Commissioner.

"(e) 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 with him or mailing to him 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."

SEC. 2. (a) The first sentence of section 10 of such Act is amended by changing the period at the end thereof to a colon and adding the following proviso: "*Provided,* That no application to register filed under section 1(a)(2) of this Act shall be assignable prior to the date the applicant originally filing the application has filed the verified statement of use prescribed in section 1(a)(2) of this Act,

except to a successor to the entire business of the original applicant for registration, which successor may file the verified statement of use."

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

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

"(a) (1) Upon the filing of an application for registration under section 1(a)(1) of this Act and payment of the fee herein provided, the Commissioner shall promptly cause to be published, in the Official Gazette of the Patent Office, the mark, a statement of the goods as specified in the application, the name and address of the applicant, the date of first use claimed by the applicant, and the filing date of the application: *Provided*, The Commissioner may refuse to publish hereunder any mark which consists of or comprises obviously immoral or scandalous matter, or similar matter obviously unfit for publication in which event he shall notify the applicant of his refusal and the reasons therefor. The Commissioner shall refer the application for registration of the mark so published 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 for opposition in the Official Gazette of the Patent Office, and the Commissioner shall include in the publication for opposition the date of initial publication hereunder *Provided further,* That in the case of an applicant claiming concurrent use, or in the case of an application to be placed in an interference as provided for in section 16 of this Act, the mark, if otherwise registrable, may be published subject to the determination of the rights of the parties to such proceedings.

"(2) Upon the filing of an application for registration under section 1 (a) (2) of this Act and payment of the fee herein provided, the Commissioner shall promptly cause to be published, in the Official Gazette of the Patent Office, the mark, a statement of the goods as specified in the application, the name and address of the applicant, and the filing date of the application. *Provided,* The Commissioner may refuse to publish hereunder any mark which consists of or comprises obviously immoral or scandalous matter, or similar matter obviously unfit for publication, in which event he shall notify the applicant of his refusal and the reasons therefor. The Commissioner shall refer the application for registration of the mark so published 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 would be entitled to registration

upon the filing of the verified statement of use prescribed in section 1 (a) (2) of this Act, the Commissioner shall cause the mark to be published for opposition in the Official Gazette of the Patent Office. The Commissioner shall include in the publication for opposition the date of filing of the application for registration hereunder, and in the event such verified statement of use has been duly filed, the Commissioner shall also include a statement of the goods for which the mark is in use, the date of applicant's first use of the mark, and the date of applicant's first use of the mark in commerce."

SEC. 4. The first two sentences of section 13 of such Act are amended to read as follows: "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 opposition in the Patent Office, stating the grounds therefor, within thirty days after the publication for opposition under subsection (a) of section 12 of this Act of the mark sought to be registered. *Provided*, That in the case of an opposition against an application filed under section 1 (a) (2) of this Act in which the prescribed verified statement of use has not been filed, the Commissioner shall give the applicant ninety days within which to file such verified statement of use. For good cause shown, the time for filing an opposition may be extended by the Commissioner, who shall notify the parties."

SEC. 5. The first sentence of section 16 of such Act is amended to read as follows: "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, the Commissioner may declare that an interference exists: *Provided,* That in the case of an interference involving an applicant under section 1 (a) (2) of this Act, in which the prescribed verified statement of use has not been filed, the Commissioner shall give the applicant ninety days within which to file such verified statement of use."

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

SEC. 7. Section 31 of such Act is amended by striking out "On filing each original application for registration of a mark in each class, $35." and inserting in lieu thereof "On filing each original application under section 1 (a) (1) hereof for registration of a mark in each class on either the principal or the supplemental register, an amount prescribed by the Commissioner up to $50, on filing each original application under section 1 (a) (2) hereof for registration of a mark in

each class on the principal register, an amount prescribed by the Commissioner up to $100."

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

"(c) For the purpose of this Act, an application filed under the provisions of section 1(a) (2), or registration resulting from such application, shall be accorded the same force and effect as if the applicant or registrant had commenced use of the mark in commerce on the goods specified in the statement of use on the date of filing of the application."

SEC. 9. These amendments to the Act shall become effective ninety days after their enactment.

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