

92<sup>D</sup> CONGRESS  
1<sup>ST</sup> SESSION

# H. R. 10727

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## IN THE HOUSE OF REPRESENTATIVES

SEPTEMBER 16, 1971

MR. KASTENMEIER introduced the following bill, which was referred to the Committee on the Judiciary

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## A BILL

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

1       *Be it enacted by the Senate and House of Representa-*  
2 *tives of the United States of America in Congress assembled,*  
3 That section 1 of the Act entitled "An Act to provide for  
4 the registration and protection of trademarks used in com-  
5 merce, to carry out the provisions of international conven-  
6 tions, and for other purposes", approved July 5, 1946 (60  
7 Stat. 427), as amended, is amended to read as follows:

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

1 merce may register his trademark under this Act on the  
2 principal register hereby established:

3 “(a) By filing in the Patent Office a written applica-  
4 tion, in such form as may be prescribed by the Commis-  
5 sioner, verified by the applicant, or by a member of the  
6 firm or an officer of the corporation or association applying—

7 “(1) specifying applicant’s domicile and citizen-  
8 ship, the date of applicant’s first use of the mark, the  
9 date of applicant’s first use of the mark in commerce,  
10 the goods in connection with which the mark is used, and  
11 the mode or manner in which the mark is used in connec-  
12 tion with such goods, and including a statement to the  
13 effect that the person making the verification believes  
14 himself, or the firm, corporation, or association in whose  
15 behalf he makes the verification, to be the owner of the  
16 mark sought to be registered, that the mark is in use in  
17 commerce, and that no other person, firm, corporation,  
18 or association, to the best of his knowledge and belief,  
19 has the right to use such mark in commerce either in the  
20 identical form thereof or in such near resemblance there-  
21 to as to be likely, when applied to the goods of such  
22 other person, to cause confusion, or to cause mistake, or  
23 to deceive: *Provided*, That in the case of every applica-  
24 tion claiming concurrent use the applicant shall state  
25 exceptions to his claim of exclusive use, in which he shall

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

6 “(2) specifying applicant’s domicile and citizen-  
7 ship, applicant’s intent to use the mark in commerce,  
8 the goods in connection with which the mark is intended  
9 to be used and the mode or manner in which the mark  
10 is intended to be used in connection with such goods,  
11 and including a statement to the effect that the person  
12 making the verification believes himself, or the firm,  
13 corporation, or association in whose behalf he makes the  
14 verification, to be entitled to use the mark sought to be  
15 registered, and that no other person, firm, corporation,  
16 or association, to the best of his knowledge and belief,  
17 is using such mark in commerce either in the identical  
18 form thereof or in such near resemblance thereto as to  
19 be likely, when applied to the goods of such other per-  
20 son, to cause confusion, or to cause mistake, or to de-  
21 ceive. *Provided*, That no registration shall issue until  
22 the applicant has filed in the Patent Office, together with  
23 the specimens or facsimiles of the mark as actually used,  
24 as required by section 1 (b) of this Act, a verified state-  
25 ment of use accepted by the Commissioner setting forth

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

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

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

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

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

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

18 SEC. 2. (a) The first sentence of section 10 of such  
19 Act is amended by changing the period at the end thereof to  
20 a colon and adding the following proviso. “*Provided*, That  
21 no application to register filed under section 1 (a) (2) of  
22 this Act shall be assignable prior to the date the applicant  
23 originally filing the application has filed the verified state-  
24 ment of use prescribed in section 1 (a) (2) of this Act,

1 except to a successor to the entire business of the original  
2 applicant for registration, which successor may file the veri-  
3 fied statement of use.”

4 (b) The second paragraph of section 10 of such Act is  
5 amended by striking out “1 (d)” and inserting in lieu there-  
6 of “1 (e)”.

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

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

1 mark to be published for opposition in the Official Gazette of  
2 the Patent Office, and the Commissioner shall include in the  
3 publication for opposition the date of initial publication here-  
4 under: *Provided further*, That in the case of an applicant  
5 claiming concurrent use, or in the case of an application to be  
6 placed in an interference as provided for in section 16 of this  
7 Act, the mark, if otherwise registrable, may be published  
8 subject to the determination of the rights of the parties to  
9 such proceedings.

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

1 of the verified statement of use prescribed in section 1 (a) (2)  
2 of this Act, the Commissioner shall cause the mark to be  
3 published for opposition in the Official Gazette of the Patent  
4 Office. The Commissioner shall include in the publication  
5 for opposition the date of filing of the application for regis-  
6 tration hereunder, and in the event such verified statement  
7 of use has been duly filed, the Commissioner shall also in-  
8 clude a statement of the goods for which the mark is in use,  
9 the date of applicant's first use of the mark, and the date  
10 of applicant's first use of the mark in commerce."

11 SEC. 4. The first two sentences of section 13 of such  
12 Act are amended to read as follows "Any person who be-  
13 lieves that he would be damaged by the registration of a  
14 mark upon the principal register may, upon payment of the  
15 required fee, file a verified opposition in the Patent Office,  
16 stating the grounds therefor, within thirty days after the  
17 publication for opposition under subsection (a) of section  
18 12 of this Act of the mark sought to be registered: *Provided,*  
19 That in the case of an opposition against an application  
20 filed under section 1 (a) (2) of this Act in which the pre-  
21 scribed verified statement of use has not been filed, the Com-  
22 missioner shall give the applicant ninety days within which  
23 to file such verified statement of use. For good cause shown,  
24 the time for filing an opposition may be extended by the  
25 Commissioner, who shall notify the parties."



1        SEC. 5. The first sentence of section 16 of such Act is  
2 amended to read as follows: "Whenever application is made  
3 for the registration of a mark which so resembles a mark  
4 previously registered by another, or for the registration of  
5 which another has previously made application, as to be  
6 likely when applied to the goods or when used in connection  
7 with the services of the applicant to cause confusion or mis-  
8 take or to deceive, the Commissioner may declare that an  
9 interference exists: *Provided*, That in the case of an inter-  
10 ference involving an applicant under section 1 (a) (2) of  
11 this Act, in which the prescribed verified statement of use  
12 has not been filed, the Commissioner shall give the applicant  
13 ninety days within which to file such verified statement of  
14 use."

15        SEC. 6. Section 26 of such Act is amended by inserting  
16 "1 (a) (2)," after the word "sections", and inserting "(1),  
17 12 (a) (2)," after "12 (a)".

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

1 each class on the principal register, an amount prescribed  
2 by the Commissioner up to \$100.”

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

5 “(c) For the purpose of this Act, an application filed  
6 under the provisions of section 1(a)(2), or registration  
7 resulting from such application, shall be accorded the same  
8 force and effect as if the applicant or registrant had com-  
9 menced use of the mark in commerce on the goods specified  
10 in the statement of use on the date of filing of the appli-  
11 cation.”

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

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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

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By **MI** **KASTENMEIER**

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Referred to the Committee on the Judiciary