

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

# S. 2595

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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

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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 the  
4       registration and protection of trademarks used in commerce,  
5       to carry out the provisions of international conventions, and  
6       for other purposes", approved July 5, 1946 (60 Stat. 427),  
7       as amended, is amended to read as follows:

1       “SECTION 1. The owner of a trademark used in com-  
2 merce may register his trademark under this Act on the prin-  
3 cipal register hereby established:

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

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

1 current use the applicant shall state exceptions to his  
2 claim of exclusive use, in which he shall specify, to the  
3 extent of his knowledge, any concurrent use by others,  
4 the goods in connection with which and the areas in  
5 which each concurrent use exists, the periods of each  
6 use, and the goods and area for which the applicant  
7 desires registration, or

8 “(2) specifying applicant’s domicile and citizen-  
9 ship, applicant’s intent to use the mark in commerce,  
10 the goods in connection with which the mark is intended  
11 to be used and the mode or manner in which the mark  
12 is intended to be used in connection with such goods,  
13 and including a statement to the effect that the person  
14 making the verification believes himself or the firm,  
15 corporation, or association in whose behalf he makes  
16 the verification, to be entitled to use the mark sought  
17 to be registered, and that no other person, firm, cor-  
18 poration or association, to the best of his knowledge and  
19 belief, is using 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,  
23 or to deceive: *Provided*, That no registration shall issue  
24 until the applicant has filed in the Patent Office, to-  
25 gether with the specimens or facsimiles of the mark as

' 1 actually used, as required by section 1 (b) of this Act,  
' 2 a verified statement of use accepted by the Commis-  
' 3 sioner setting forth that the mark is in use in commerce  
' 4 by the applicant, the date of applicant's first use of the  
' 5 mark and the date of applicant's first use of the mark  
' 6 in commerce, those of the goods specified in the appli-  
' 7 cation in connection with which the mark is used and  
' 8 the mode or manner in which the mark is used in con-  
' 9 nection with such goods, and any registration issuing  
' 10 on an application filed under this section 1 (a) (2) shall  
' 11 specify only the goods recited in such statement as the  
' 12 latter is accepted by the Commissioner. Such statement  
' 13 may be filed at any time after the application has been  
' 14 filed, and must be filed before the end of six months  
' 15 following the date of publication of the mark for opposi-  
' 16 tion, unless sooner required as provided in sections 13  
' 17 and 16 of this Act, and the failure to file such verified  
' 18 statement of use prior to the expiration of the specified  
' 19 period shall be deemed to be an abandonment of the  
' 20 application. In exceptional circumstances, the time for  
' 21 filing such verified statement of use may be extended by  
' 22 the Commissioner. The Commissioner shall notify any  
' 23 applicant who files such statement of his acceptance or  
' 24 refusal thereof and, if a refusal, the reasons therefor  
' 25 " (b) By filing in the Patent Office a drawing of the

1 mark, and such number of specimens or facsimiles of the  
 2 mark as actually used as may be required by the Commis-  
 3 sioner.

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

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

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

19 SEC. 2. (a) The first sentence of section 10 of such  
 20 Act is amended by changing the period at the end thereof to  
 21 a colon and adding the following proviso: “*Provided*, That  
 22 no application to register filed under section 1 (a) (2) of  
 23 this Act shall be assignable prior to the date the applicant  
 24 originally filing the application has filed the verified state-  
 25 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  
5 is amended by striking out “1 (d)” and inserting in lieu  
6 thereof “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  
11 the fee herein provided, the Commissioner shall promptly  
12 cause to be published, in the Official Gazette of the Patent  
13 Office, the mark, a statement of the goods as specified in the  
14 application, the name and address of the applicant, the date  
15 of first use claimed by the applicant, and the filing date of  
16 the application. *Provided*, The Commissioner may refuse to  
17 publish hereunder any mark which consists of or comprises  
18 obviously immoral or scandalous matter, or similar matter  
19 obviously 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 reg-  
23 istration of marks, who shall cause an examination to be  
24 made and, if on such examination it shall appear that the  
25 applicant is entitled to registration, the Commissioner shall

1 cause the mark to be published for opposition in the Official  
2 Gazette of the Patent Office, and the Commissioner shall  
3 include in the publication for opposition the date of initial  
4 publication hereunder. *Provided further,* That in the case  
5 of an applicant claiming concurrent use, or in the case of  
6 an application to be placed in an interference as provided  
7 for in section 16 of this Act, the mark, if otherwise reg-  
8 istrable, may be published subject to the determination of  
9 the rights of the parties to 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, the  
14 mark, a statement of the goods as specified in the applica-  
15 tion, 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  
20 he shall notify the applicant of his refusal and the reasons  
21 therefor. The Commissioner shall refer the application for  
22 registration of the mark so published to the examiner in  
23 charge of the registration of marks, who shall cause an  
24 examination to be made, and if on such examination it shall  
25 appear that the applicant would be entitled to registration

1 upon the filing of the verified statement of use prescribed in  
2 section 1 (a) (2) of this Act, the Commissioner shall cause  
3 the mark to be published for opposition in the Official Gazette  
4 of the Patent Office. The Commissioner shall include in the  
5 publication for opposition the date of filing of the application  
6 for registration hereunder, and in the event such verified  
7 statement of use has been duly filed, the Commissioner shall  
8 also include a statement of the goods for which the mark is  
9 in use, the date of applicant's first use of the mark, and the  
10 date 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 12  
18 of this Act of the mark sought to be registered. *Provided,*  
19 That in the case of an opposition against an application filed  
20 under section 1 (a) (2) of this Act in which the prescribed  
21 verified statement of use has not been filed, the Commis-  
22 sioner shall give the applicant ninety days within which to  
23 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 this  
11 Act, in which the prescribed verified statement of use has  
12 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 re-  
7 sulting 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 applica-  
11 tion.”

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

92<sup>d</sup> CONGRESS  
1<sup>st</sup> Session

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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

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By Mr McCLELLAN

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Read twice and referred to the Committee on the  
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