

91ST CONGRESS
1ST SESSION

S. 3110

IN THE SENATE OF THE UNITED STATES

NOVEMBER 4, 1969

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 trade-marks 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 trade-marks 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 prin-
2 cipal register hereby established.

3 “ (a) By filing in the Patent Office a written application
4 in such form as may be prescribed by the Commission, veri-
5 fied by the applicant, or by a member of the firm or an
6 officer of the corporation or association applying—

7 “ (1) specifying applicant’s domicile and citizenship,
8 the date of applicant’s first use of the mark, the date of
9 applicant’s first use of the mark in commerce, the
10 goods in connection with which the mark is used, and
11 the mode or manner in which the mark is used in con-
12 nection with such goods, and including a statement to
13 the 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
17 in commerce, and that no other person, firm, corpora-
18 tion, or association, to the best of his knowledge and
19 belief, has the right to use such mark in commerce
20 either in the identical form thereof or in such near
21 resemblance thereto as to be likely, when applied to
22 the goods of such other person, to cause confusion, or to
23 cause mistake, or to deceive: *Provided*, That in the
24 case of every application claiming concurrent use the
25 applicant shall state exceptions to his claim of exclusive

1 use, in which he shall specify, to the extent of his
2 knowledge, any concurrent use by others, the goods
3 in connection with which and the areas in which each
4 concurrent use exists, the periods of each use, and the
5 goods and area for which the applicant desires registra-
6 tion; or

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

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

24 “(b) By filing in the Patent Office a drawing of the
25 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 the
9 Patent Office the name and address of some person resident
10 in the United States on whom may be served notices or
11 process in proceedings affecting the mark. Such notices or
12 process may be served upon the person so designated by
13 leaving with him or mailing to him a copy thereof at the
14 address specified in the last designation so filed. If the person
15 so designated cannot be found at the address given in the
16 last designation, such notice or process may be served upon
17 the Commissioner.”

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

1 a successor to the entire business of the original applicant
2 for registration, which successor may file the verified state-
3 ment 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 thereof
6 “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 first
15 use claimed by the applicant, and the filing date of the appli-
16 cation *Provided*, The Commissioner may refuse to publish
17 hereunder any mark which consists of or comprises obviously
18 immoral or scandalous matter, or similar matter obviously
19 unfit for publication, in which event he shall notify the appli-
20 cant of his refusal and the reasons therefor. The Commis-
21 sioner shall refer the application for registration of the mark
22 so published to the examiner in charge of the registration of
23 marks, who shall cause an examination to be made and, if
24 on such examination it shall appear that the applicant is en-
25 titled to registration, the Commissioner shall cause the mark

1 to be published for opposition in the Official Gazette of the
2 Patent Office, and the Commissioner shall include in the pub-
3 lication 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
6 be placed in an interference as provided for in section 16
7 of this Act, the mark, if otherwise registrable, may be pub-
8 lished subject to the determination of the rights of the parties
9 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 be
13 published, in the Official Gazette of the Patent Office, the
14 mark, a statement of the goods as specified in the application,
15 the name and address of the applicant, and the filing date of
16 the application: *Provided*, The Commissioner may refuse
17 to publish hereunder any mark which consists of or com-
18 prises obviously immoral or scandalous matter, or similar mat-
19 ter obviously unfit for publication, in which event he shall
20 notify the applicant of his refusal and the reasons therefor.
21 The Commissioner shall refer the application for registration
22 of the mark so published to the examiner in charge of the
23 registration of marks, who shall cause an examination to be
24 made, and if on such examination it shall appear that the
25 applicant would be entitled to registration upon the filing of

1 the verified statement of use prescribed in section 1 (a) (2)
2 of this Act, the Commissioner shall cause the mark to be pub-
3 lished for opposition in the Official Gazette of the Patent
4 Office. The Commissioner shall include in the publication for
5 opposition the date of filing of the application for registration
6 hereunder, and in the event such verified statement of use has
7 been duly filed, the Commissioner shall also include a state-
8 ment of the goods for which the mark is in use, the date of
9 applicant's first use of the mark, and the date of applicant's
10 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, the
24 time for filing an opposition may be extended by the Com-
25 missioner, 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 appli-
13 cant ninety days within which to file such verified statement
14 of 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 out
19 "On filing each original application for registration of a
20 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, \$50; on filing each original ap-
24 plication under section 1 (a) (2) hereof or registration of a
25 mark in each class on the principal register, \$100."

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

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

9 SEC. 9. These amendments to the Act shall become
10 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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