

100TH CONGRESS  
1ST SESSION

# S. 1883

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".

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## IN THE SENATE OF THE UNITED STATES

NOVEMBER 19, 1987

Mr. DECONCINI 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 trade-marks used in commerce, to carry out the provisions of certain international conventions, and for other purposes".

1       *Be it enacted by the Senate and House of Representa-*  
2 *tives of the United States of America in Congress assembled,*  
3 That this Act may be cited as the "Trademark Law Revision  
4 Act of 1987".

5       SEC. 2. For purposes of this Act, the Act entitled "An  
6 Act to provide for the registration and protection of trade-  
7 marks used in commerce, to carry out the provisions of cer-

1 tain international conventions, and for other purposes” shall  
2 be referred to as the “Trademark Act of 1946”.

3 SEC. 3. Section 1 of the Trademark Act of 1946 (15  
4 U.S.C. 1051) is amended by—

5 (1) inserting a section heading before section 1 to  
6 read as follows:

7 “REQUIREMENTS FOR APPLYING TO REGISTER  
8 TRADEMARKS ON THE PRINCIPAL REGISTER”;

9 (2) striking out “may register his” and inserting  
10 in lieu thereof “may apply to register his”;

11 (3) redesignating paragraphs (1), (2), and (3) of  
12 subsection (a) as subparagraphs (A), (B), and (C),  
13 respectively;

14 (4) redesignating subsections (a), (b), and (c) as  
15 paragraphs (1), (2), and (3), respectively;

16 (5) inserting “(a)” after “SECTION 1.”;

17 (6) striking out “actually” in subparagraph (C), as  
18 redesignated herein; and

19 (7) adding at the end thereof the following:

20 “(b) A person who has a bona fide intention to use a  
21 trademark in commerce may apply to register the trademark  
22 under this Act on the principal register hereby established:

23 “(1) By filing in the Patent and Trademark  
24 Office—

25 “(A) a written application, in such form as  
26 may be prescribed by the Commissioner, verified

1 by the applicant, or by a member of the firm or  
2 an officer of the corporation or association apply-  
3 ing, specifying applicant's domicile and citizen-  
4 ship, applicant's bona fide intention to use the  
5 mark in commerce, the goods in connection with  
6 which the applicant has a bona fide intention to  
7 use the mark and the mode or manner in which  
8 the mark is intended to be used in connection  
9 with such goods, and including a statement to the  
10 effect that the person making the verification be-  
11 lieves himself, or the firm, corporation, or associa-  
12 tion in whose behalf he makes the verification, is  
13 entitled to use the mark in commerce, and that no  
14 other person, firm, corporation, or association, to  
15 the best of his knowledge and belief, has the right  
16 to use such mark in commerce either in the iden-  
17 tical form thereof or in such near resemblance  
18 thereto as to be likely, when applied to the goods  
19 of such other person, to cause confusion, or to  
20 cause mistake, or to deceive: *Provided*, That in  
21 the case of every application seeking concurrent  
22 use the applicant shall state exceptions to his  
23 claim of exclusive use, in which he shall specify,  
24 to the extent of his knowledge, any use by others,  
25 the goods in connection with which and the areas

1 in which such use exists, the periods of such use,  
2 and the goods and area for which the applicant  
3 has a bona fide intention to use the mark in com-  
4 merce and desires registration. However, with the  
5 exception of applications filed pursuant to section  
6 44 of this Act, no mark shall be registered until  
7 the applicant has met the requirements of section  
8 13(b)(2) hereof; and

9 “(B) a drawing of the mark.

10 “(2) By paying in the Patent and Trademark  
11 Office the filing fee.

12 “(3) By complying with such rules or regulations,  
13 not inconsistent with law, as may be prescribed by the  
14 Commissioner.

15 “(c) At any time during examination of an application  
16 filed under subsection (b), an applicant who has made use of  
17 the mark in commerce may claim the benefits thereof for pur-  
18 poses of this Act, by amending his application to bring it into  
19 conformity with the requirements of subsection (a).”.

20 SEC. 4. Section 2 of the Trademark Act of 1946  
21 (U.S.C. 1052) is amended—

22 (1) by amending subsection (d) to read as follows:

23 “(d) Consists of or comprises a mark which so resembles  
24 a mark registered in the Patent and Trademark Office, or a  
25 mark which is the subject of a previously filed pending appli-

1 cation, or a mark or trade name previously used in the  
2 United States by another and not abandoned, as to be likely,  
3 when applied to the goods of the applicant, to cause confu-  
4 sion, or to cause mistake, or to deceive: *Provided*, That when  
5 the Commissioner determines that confusion, mistake, or de-  
6 ception is not likely to result from the use by more than one  
7 person of the same or similar marks under conditions and  
8 limitations as to the mode or place of use of the marks or the  
9 goods in connection with which such marks are used, concu-  
10 rent registrations may be issued to such persons when they  
11 have become entitled to use such marks prior to (1) the earli-  
12 est of the filing dates of the applications pending or of any  
13 registration issued under this Act; or (2) July 5, 1947, in the  
14 case of registrations previously issued under the Act of March  
15 3, 1881, or February 20, 1905, and continuing in full force  
16 and effect on that date; or (3) July 5, 1947, in the case of  
17 applications filed under the Act of February 20, 1905, and  
18 registered after July 5, 1947. Use prior to the filing date of  
19 any pending application or a registration shall not be required  
20 when the owner of such application or registration consents  
21 to the grant of a concurrent registration to the applicant.  
22 Concurrent registrations may also be issued by the Commis-  
23 sioner when a court of competent jurisdiction has finally de-  
24 termined that more than one person is entitled to use the  
25 same or similar marks in commerce. In issuing concurrent

1 registrations, the Commissioner shall prescribe conditions  
2 and limitations as to the mode or place of use of the mark or  
3 the goods in connection with which such mark is registered  
4 to the respective persons;"; and

5 (2) in subsection (f) by striking out "five years"  
6 through the end of the subsection and inserting in lieu  
7 thereof "five years next preceding an offer of proof by  
8 the applicant."

9 SEC. 5. Section 3 of the Trademark Act of 1946 (15  
10 U.S.C. 1053) is amended by—

11 (1) striking out "used in commerce" in the first  
12 sentence; and

13 (2) striking out the second sentence.

14 SEC. 6. Section 4 of the Trademark Act of 1946 (15  
15 U.S.C. 1054) is amended by—

16 (1) striking out "origin used in commerce," and  
17 inserting in lieu thereof "origin,";

18 (2) striking out "except when" in the first sen-  
19 tence and inserting in lieu thereof "except in the case  
20 of certification marks when"; and

21 (3) striking out the second sentence.

22 SEC. 7. Section 5 of the Trademark Act of 1946 (15  
23 U.S.C. 1055) is amended by adding at the end thereof the  
24 following: "First use of a mark by a person, which use is  
25 controlled by the registrant or applicant for registration of the

1 mark in respect to the nature and quality of the goods or  
2 services, shall inure to the benefit of the registrant or  
3 applicant.”.

4 SEC. 8. Section 6(b) of the Trademark Act of 1946 (15  
5 U.S.C. 1056(b)) is amended by striking out “(d)” and insert-  
6 ing in lieu thereof “(e)”.

7 SEC. 9. Section 7 of the Trademark Act of 1946 (15  
8 U.S.C. 1057) is amended by—

9 (1) amending subsection (b) to read as follows:

10 “(b) A certificate of registration of a mark upon the  
11 principal register provided by this Act shall be prima facie  
12 evidence of the validity of the registered mark and of the  
13 registration thereof, of the registrant’s ownership of the  
14 mark, and of the registrant’s exclusive right to use the regis-  
15 tered mark in commerce on or in connection with the goods  
16 or services specified in the certificate, subject to any condi-  
17 tions or limitations stated therein.”;

18 (2) redesignating subsections (c), (d), (e), (f), and  
19 (g) as subsections (d), (e), (f), (g), and (h), respectively;  
20 and

21 (3) inserting between subsection (b) and subsection  
22 (d), as redesignated herein, the following:

23 “(c) Contingent on the registration of a mark on the  
24 principal register established herein, the filing of the applica-  
25 tion to register such mark shall constitute constructive use of

1 the mark, conferring a right of priority, nationwide in effect,  
2 on or in connection with the goods or services specified in the  
3 registration against any other person except for a person  
4 whose mark has not been abandoned and, who prior to such  
5 filing—

6 “(1) has used the mark;

7 “(2) has filed an application to register the mark  
8 on the principal register and that application is pending  
9 or has resulted in registration of the mark on the prin-  
10 cipal register; or

11 “(3) has filed a foreign application to register the  
12 mark on the basis of which he has acquired a right of  
13 priority by the timely filing under section 44(d) of an  
14 application to register the mark on the principal regis-  
15 ter and that application is pending or has resulted in  
16 registration of the mark on the principal register.”.

17 SEC. 10. Section 8(a) of the Trademark Act of 1946 (15  
18 U.S.C. 1058a) is amended by—

19 (1) striking out “twenty” and inserting in lieu  
20 thereof “ten”; and

21 (2) striking out “showing that said mark is in use  
22 in commerce or showing that its” and inserting in lieu  
23 thereof “setting forth those goods or services recited in  
24 the registration on or in connection with which the  
25 mark is in use in commerce and having attached there-

1 to a specimen or facsimile showing current use of the  
2 mark, or showing that any”.

3 SEC. 11. Section 9(a) of the Trademark Act of 1946 (15  
4 U.S.C. 1059(a)) is amended by striking out “twenty” and  
5 inserting in lieu thereof “ten”.

6 SEC. 12. Section 10 of the Trademark Act of 1946 (15  
7 U.S.C. 1060) is amended to read as follows:

8 “ASSIGNMENT AND GRANT OF SECURITY INTEREST

9 “SEC. 10. (a) A registered mark or a mark for which  
10 application to register has been filed shall be assignable with  
11 the goodwill of the business in which the mark is used, or  
12 with that part of the goodwill of the business connected with  
13 the use of and symbolized by the mark. However, no applica-  
14 tion to register a mark under section 1(b) shall be assignable  
15 prior to the filing of the verified statement of use under sec-  
16 tion 13(b)(2), except to a successor to the business of the  
17 applicant, or portion thereof, to which the mark pertains.

18 “(b)(1) A security interest in a registered mark or a  
19 mark for which application to register has been filed may be  
20 obtained and will be superior to any interest subsequently  
21 granted to a third party, provided—

22 “(A) the party granted the security interest ob-  
23 tains a security interest in the goodwill of the business  
24 in which the mark is used, or with that part of the  
25 goodwill of the business connected with the use of and  
26 symbolized by the mark;

1           “(B) the mark is not subject to a valid, prior per-  
2           fected security interest; and

3           “(C) notice of such interest is filed in the Patent  
4           and Trademark Office within ten days after being  
5           granted.

6           “(2) A party granted a security interest in a registered  
7           mark or a mark for which application to register has been  
8           filed may, after default by the party granting the security  
9           interest, require the debtor to assign the mark to—

10           “(A) a transferee who is also being assigned that  
11           part of the goodwill of the business connected with the  
12           use of and symbolized by the mark; or

13           “(B) the party holding the security interest, even  
14           though such party does not presently engage in the  
15           business to which the mark relates, provided that the  
16           secured party either subsequently engages in the busi-  
17           ness to which the mark relates or holds the mark only  
18           for the purpose of subsequently transferring the mark  
19           along with the goodwill associated with the mark and  
20           that such subsequent transfer occurs prior to dissipa-  
21           tion of the goodwill.

22           “(3) A security interest in a mark obtained pursuant to  
23           this section will extend to the consideration received upon the  
24           sale, exchange, collection or other disposition of the mark for  
25           ten days after receipt of the consideration by the transferor

1 and will then lapse unless a financing statement or other doc-  
2 ument is filed as required by appropriate State law.

3       “(c) In any assignment of or grant of a security interest  
4 in a mark it shall not be necessary to include the goodwill of  
5 the business connected with the use of and symbolized by any  
6 other mark used in the business or by the name or style  
7 under which the business is conducted.

8       “(d) Assignments and grants of security interest shall be  
9 by instruments in writing duly executed. Acknowledgment  
10 shall be prima facie evidence of the execution of an assign-  
11 ment or a grant of a security interest and when recorded in  
12 the Patent and Trademark Office the record shall be prima  
13 facie evidence of execution. An assignment of or grant of a  
14 security interest in a mark shall be void as against any subse-  
15 quent purchaser or other entity being granted an interest for  
16 a valuable consideration without notice, unless recorded in  
17 the Patent and Trademark Office within three months after  
18 the date thereof or prior to such subsequent purchase in the  
19 case of an assignment, or within ten days after the grant of  
20 any security interest.

21       “(e) A separate record of documents submitted for re-  
22 cording under this section shall be maintained in the Patent  
23 and Trademark Office. Such record shall include any release,  
24 cancellation, discharge, or satisfaction relating to any con-  
25 veyance or other instrument affecting title to or any interest

1 in a registered mark or a mark for which application to regis-  
2 ter has been filed.

3 “(f) An assignee or holder of a security interest not  
4 domiciled in the United States shall be subject to and comply  
5 with the provisions of section 1(d) of this Act.”

6 SEC. 13. Section 12(a) of the Trademark Act of 1946  
7 (15 U.S.C. 1062a) is amended by striking out “to registra-  
8 tion, the” and inserting in lieu thereof “to registration, or  
9 would be entitled to registration upon the acceptance of the  
10 statement of use prescribed in section 13(b)(2) of this Act,  
11 the”.

12 SEC. 14. Section 13 of the Trademark Act of 1946 (15  
13 U.S.C. 1063) is amended by—

14 (1) inserting “(a)” before “Any person”; and

15 (2) adding at the end thereof the following:

16 “(b) Unless registration is successfully opposed—

17 “(1) a mark entitled to registration on the princi-  
18 pal register based on an application filed under section  
19 1(a) or pursuant to section 44, shall be registered in  
20 the Patent and Trademark Office, and a certificate of  
21 registration issued, and notice of the registration shall  
22 be published in the Official Gazette of the Patent and  
23 Trademark Office; or

24 “(2) a notice of allowance shall be issued to the  
25 applicant if he applied for registration under section

1 1(b). Within six months following the date of the notice  
2 of allowance, the applicant must file in the Patent and  
3 Trademark Office, together with such number of speci-  
4 mens or facsimiles of the mark as used in commerce as  
5 may be required by the Commissioner and payment of  
6 the prescribed fee, a verified statement that the mark  
7 is in use in commerce and specifying the date of appli-  
8 cant's first use of the mark and the date of applicant's  
9 first use of the mark in commerce, those goods or serv-  
10 ices specified in the notice of allowance on or in con-  
11 nection with which the mark is used in commerce and  
12 the mode or manner in which the mark is used in con-  
13 nection with such goods or services. Subject to exami-  
14 nation and acceptance of the statement of use, the  
15 mark shall be registered in the Patent and Trademark  
16 Office, and a certificate of registration issued, for those  
17 goods or services recited in the statement of use for  
18 which the mark is entitled to registration and notice of  
19 registration shall be published in the Official Gazette of  
20 the Patent and Trademark Office. The notice shall  
21 specify the goods or services for which the mark is  
22 registered.

23 (A) The time for filing the statement of use shall  
24 be extended for an additional six-month period upon  
25 written request of the applicant prior to expiration of

1 the six-month period. Such request shall be accompa-  
2 nied by a verified statement that the applicant has a  
3 continued bona fide intention to use the mark in com-  
4 merce and specifying those goods or services identified  
5 in the notice of allowance on or in connection with  
6 which the applicant has a continued bona fide intention  
7 to use the mark in commerce. Up to six further exten-  
8 sions of six months each shall be obtained when re-  
9 quested prior to the expiration of the extended period  
10 and accompanied by a verified statement that the ap-  
11 plicant has a continued bona fide intention to use the  
12 mark in commerce and specifying those goods or serv-  
13 ices identified in the most recent extension for which  
14 the applicant has a continued bona fide intention to use  
15 the mark in commerce. Each request for an extension  
16 shall be accompanied by payment of the prescribed fee.

17 “(B) The Commissioner shall notify any applicant  
18 who files a statement of use of the acceptance or refus-  
19 al thereof and, if a refusal, the reasons therefor. An  
20 applicant may amend his statement of use and may  
21 seek review by the Commissioner of a final refusal.

22 “(C) The failure to timely file a verified statement  
23 of use shall result in abandonment of the application.”.

24 SEC. 15. Section 14(c) of the Trademark Act of 1946  
25 (15 U.S.C. 1064(c)) is amended to read as follows:

1           “(c) at any time if the registered mark becomes  
2           the generic name for the goods or services, or a por-  
3           tion thereof, for which it is registered, or has been  
4           abandoned, or its registration was obtained fraudulently  
5           or contrary to the provisions of section 4 or of subsec-  
6           tion (a), (b), or (c) of section 2 for a registration here-  
7           under, or contrary to similar prohibitory provisions of  
8           such prior Acts for a registration thereunder, or if the  
9           registered mark is being used by, or with the permis-  
10          sion of, the registrant so as to misrepresent the source  
11          of the goods or services in connection with which the  
12          mark is used. If the registered mark becomes the ge-  
13          neric name for less than all of the goods or services for  
14          which it is registered, a petition to cancel the registra-  
15          tion for only those goods or services may be filed. A  
16          registered mark shall not be deemed to be the generic  
17          name of goods or services solely because such mark is  
18          also used as a name of or to identify a unique product  
19          or service. The primary significance of the registered  
20          mark to the relevant public rather than purchaser moti-  
21          vation shall be the test for determining whether the  
22          registered mark has become the generic name of goods  
23          or services in connection with which it has been used;  
24          or”

1        SEC. 16. Section 15(4) of the Trademark Act of 1946  
2 (15 U.S.C. 1065(4)) is amended by striking out “the common  
3 descriptive name” and inserting in lieu thereof “the generic  
4 name”.

5        SEC. 17. Section 18 of the Trademark Act of 1946 (15  
6 U.S.C. 1068) is amended by—

7            (1) striking out “or restrict” and inserting in lieu  
8 thereof “the registration, in whole or in part, may  
9 modify the application or registration by limiting the  
10 goods or services specified therein, may otherwise re-  
11 strict or rectify with respect to the register”;

12            (2) striking out “or” before “may refuse”; and

13            (3) adding at the end thereof the following:

14        “However, no final judgment shall be entered in favor  
15 of an applicant under section 1(b) who alleges likeli-  
16 hood of confusion prior to the mark being registered.”.

17        SEC. 18. Section 21 of the Trademark Act of 1946 (15  
18 U.S.C. 1071) is amended—

19            (1) in subsection (a), by striking out “section  
20 21(b)” each place it appears and inserting in lieu there-  
21 of “subsection (b)”;

22            (2) in subsection (a), by striking out “section  
23 21(a)(2)” and inserting in lieu thereof “paragraph (2) of  
24 this subsection”;

1           (3) in subsection (a)(4), by adding at the end  
2 thereof the following: "However, no final judgment  
3 shall be entered in favor of an applicant under section  
4 1(b) who alleges likelihood of confusion prior to the  
5 mark being registered.";

6           (4) in subsection (b), by striking out "section  
7 21(a)" each place it appears and inserting in lieu there-  
8 of "subsection (a)";

9           (5) in subsection (b)(1), by adding at the end  
10 thereof the following: "However, no final judgment  
11 shall be entered in favor of an applicant under section  
12 1(b) who alleges likelihood of confusion prior to the  
13 mark being registered."; and

14           (6) in subsection (b)(3), by amending the first sen-  
15 tence of such paragraph to read as follows:

16           "(3) In any case where there is no adverse party, a copy  
17 of the complaint shall be served on the Commissioner, and,  
18 unless otherwise directed by the court, all the expenses of the  
19 proceeding shall be paid by the party bringing the case,  
20 whether the final decision is in favor of such party or not."

21           SEC. 19. Section 23 of the Trademark Act of 1946 (15  
22 U.S.C. 1091) is amended by—

23           (1) inserting "(a)" before "In addition" in the first  
24 paragraph;

1           (2) inserting “(b)” before “Upon the” in the  
2 second paragraph;

3           (3) inserting “(c)” before “For the purposes” in  
4 the third paragraph;

5           (4) striking out “paragraphs (a),” in subsection  
6 (a), as designated herein, and inserting in lieu thereof  
7 “subsections (a),”;

8           (5) striking out “have been in lawful use in com-  
9 merce by the proprietor thereof, upon” in subsection  
10 (a), as designated herein, and inserting in lieu thereof  
11 “are in use in commerce by the owner thereof, on”;

12           (6) striking out “for the year preceding the filing  
13 of the application” in subsection (a), as designated  
14 herein;

15           (7) inserting before “section 1” in subsection (a),  
16 as designated herein, the following: “subsections (a)  
17 and (d) of”;

18           (8) adding at the end of subsection (c), as desig-  
19 nated herein, the following: “The filing of an applica-  
20 tion to register a mark on the supplemental register, or  
21 registration of a mark thereon, shall not constitute an  
22 admission that the mark is not eligible for registration  
23 on the principal register established herein.”; and

24           (9) striking out the last paragraph.

1       SEC. 20. Section 24 of the Trademark Act of 1946 (15  
2 U.S.C. 1092) is amended by—

3           (1) striking out “was not entitled to register the  
4 mark at the time of his application for registration  
5 thereof,” and inserting in lieu thereof “is not entitled  
6 to registration,”; and

7           (2) by adding at the end thereof the following:  
8       “However, no final judgment shall be entered in favor  
9 of an applicant under section 1(b) who alleges likeli-  
10 hood of confusion prior to the mark being registered.”.

11       SEC. 21. Section 26 of the Trademark Act of 1946 (15  
12 U.S.C. 1094) is amended by—

13           (1) inserting “1(b),” after “sections”; and

14           (2) inserting “7(c),” after “7(b)”.

15       SEC. 22. Section 30 of the Trademark Act of 1946 (15  
16 U.S.C. 1112) is amended by striking out “goods and services  
17 upon or in connection with which he is actually using the  
18 mark” and inserting in lieu thereof “goods or services on or  
19 in connection with which he is using or he has a bona fide  
20 intention to use the mark in commerce”.

21       SEC. 23. Section 33(a) of the Trademark Act of 1946  
22 (15 U.S.C. 1115(a)) is amended by—

23           (1) inserting “the validity of the registered mark  
24 and of the registration thereof, of the registrant’s own-

1       ership of the mark, and of the” after “prima facie evi-  
2       dence of”;

3               (2) inserting “or in connection with” after “in  
4       commerce on”; and

5               (3) inserting “, including those set forth in subsec-  
6       tion (b),” after “or defect”.

7       SEC. 24. Section 33(b) of the Trademark Act of 1946  
8 (15 U.S.C. 1115(b)) is amended by—

9               (1) amending the matter in subsection (b) before  
10       paragraph (1) to read as follows:

11       “(b) To the extent that the right to use the registered  
12       mark has become incontestable under section 15, the regis-  
13       tration shall be conclusive evidence of the validity of the reg-  
14       istered mark and of the registration thereof, of the regis-  
15       trant’s ownership of the mark, and of the registrant’s exclu-  
16       sive right to use the registered mark in commerce. Such con-  
17       clusive evidence shall relate to the exclusive right to use the  
18       mark on or in connection with the goods or services specified  
19       in the affidavit filed under the provisions of section 15 or, if  
20       fewer in number, the renewal application filed under the pro-  
21       visions of section 9 hereof, subject to any conditions or limita-  
22       tions in the registration or in such affidavit or renewal appli-  
23       cation. Such conclusive evidence of the right to use the regis-  
24       tered mark shall be subject to proof of infringement as de-

1 fined in section 32, and shall be subject to the following de-  
2 fenses or defects:”; and

3           (2) adding at the end of the subsection, the  
4 following:

5 “In addition, equitable principles, including laches, estoppel,  
6 and acquiescence, where applicable, may be considered and  
7 applied.”.

8           SEC. 25. Section 34 of the Trademark Act of 1946 (15  
9 U.S.C. 1116) is amended—

10           (1) in subsection (a) by—

11                   (A) striking out “of the registrant of a mark  
12 registered in the Patent and Trademark Office”  
13 and inserting in lieu thereof “protected under this  
14 Act”; and

15                   (B) adding at the end thereof the following:

16 “However, no final judgment shall be entered in favor of an  
17 applicant under section 1(b) who alleges likelihood of confu-  
18 sion prior to the mark being registered.”; and

19           (2) in subsection (c) by striking out “proceeding  
20 arising” and inserting in lieu thereof “proceeding in-  
21 volving a mark registered”.

22           SEC. 26. Section 35(a) of the Trademark Act of 1946  
23 (15 U.S.C. 1117(a)) is amended by striking out “of the regis-  
24 trant of a mark registered in the Patent and Trademark

1 Office” and inserting in lieu thereof “protected under this  
2 Act”.

3 SEC. 27. Section 36 of the Trademark Act of 1946 (15  
4 U.S.C. 1118) is amended by—

5 (1) striking out “of the registrant of a mark regis-  
6 tered in the Patent and Trademark Office” and insert-  
7 ing in lieu thereof “protected under this Act”; and

8 (2) striking out “registered mark” and inserting in  
9 lieu thereof “mark”.

10 SEC. 28. Section 43(a) of the Trademark Act of 1946  
11 (15 U.S.C 1125(a)) is amended to read as follows:

12 “(a)(1) Any person who uses in commerce on or in con-  
13 nection with any goods or services, or any container for  
14 goods, any word, term, name, symbol, or device or any com-  
15 bination thereof, or who shall engage in any act, trade prac-  
16 tice, or course of conduct, which—

17 “(A) is likely to cause confusion, or to cause mis-  
18 take, or to deceive as to the affiliation, connection, or  
19 association of such person with another, or to the  
20 origin, sponsorship, or approval of his goods, services,  
21 or commercial activities by another; or

22 “(B) by use of a false designation of origin or of a  
23 false or misleading description or representation, or by  
24 omission of material information, misrepresents the  
25 nature, characteristics, or qualities of his or another

1 person's goods, services, commercial activities or their  
2 geographic origin; or

3 "(C) is likely to disparage or tarnish a mark used  
4 by another;

5 shall be liable in a civil action by any person who believes  
6 that he is or is likely to be damaged in his business or profes-  
7 sion by such action.

8 "(2) The relief provided in this subsection shall be in  
9 addition to and shall not affect those remedies otherwise  
10 available under this Act, under common law, or pursuant to  
11 any statute of the United States: *Provided*, That nothing in  
12 this subsection shall be construed so as to preempt the juris-  
13 diction of any State to grant relief in cases of unfair com-  
14 petition."

15 SEC. 29. Section 43 of the Trademark Act of 1946 (15  
16 U.S.C. 1125) is amended by adding at the end thereof the  
17 following new subsection:

18 "(c)(1) The owner of a famous mark registered under  
19 the Act of March 3, 1881, or the Act of February 20, 1905,  
20 or on the principal register established herein shall be enti-  
21 tled, subject to the principles of equity, to an injunction  
22 against another person's use in commerce of a mark, com-  
23 mencing after the registrant's mark becomes famous, which  
24 causes dilution of the distinctive quality of the registrant's  
25 mark, and to obtain such other relief as is provided in this

1 subsection. In determining whether a mark is distinctive and  
2 famous, a court may consider factors such as, but not limited  
3 to—

4           “(A) the degree of inherent or acquired distinc-  
5           tiveness of the mark;

6           “(B) the duration and extent of use of the mark  
7           on or in connection with the goods or services;

8           “(C) the duration and extent of advertising and  
9           publicity of the mark;

10           “(D) the geographical extent of the trading area  
11           in which the mark is used;

12           “(E) the channels of trade for the goods or serv-  
13           ices with which the mark is used;

14           “(F) the degree of recognition of the mark in its  
15           and in the other person’s trading areas and channels of  
16           trade; and

17           “(G) the nature and extent of use of the same or  
18           similar marks by third parties.

19           “(2) The registrant shall be entitled only to injunctive  
20 relief in an action brought under this subsection, unless the  
21 subsequent user willfully intended to trade on the registrant’s  
22 reputation or to cause dilution of the registrant’s mark. If  
23 such willful intent is proven, the registrant shall also be enti-  
24 tled to the remedies set forth in sections 35(a) and 36 hereof,

1 subject to the discretion of the court and the principles of  
2 equity.

3 “(3) Ownership of a valid registration under the Act of  
4 1881 or the Act of 1905 or on the principal register estab-  
5 lished herein shall be a complete bar to an action brought by  
6 another person, under the common law or statute of a State,  
7 seeking to prevent dilution of the distinctiveness of a mark,  
8 label, or form of advertisement.”

9 SEC. 30. Section 44 of the Trademark Act of 1946 (15  
10 U.S.C. 1126) is amended—

11 (1) by striking out “paragraph (b)” each place it  
12 appears and inserting in lieu thereof “subsection (b)”;

13 (2) in subsection (d)(2) by striking out “but use in  
14 commerce need not be alleged” and inserting in lieu  
15 thereof “including a statement that the applicant has a  
16 bona fide intention to use the mark in commerce”;

17 (3) in subsection (d)(3), by striking out “foreing”  
18 and inserting in lieu thereof “foreign”;

19 (4) in subsection (e) by adding at the end thereof  
20 the following: “The application must state the appli-  
21 cant’s bona fide intention to use the mark in com-  
22 merce, but use in commerce shall not be required prior  
23 to registration.”; and

1           (5) in subsection (f), by striking out “paragraphs  
2       (c), (d),” and inserting in lieu thereof “subsections (c),  
3       (d),”.

4       SEC. 31. Section 45 of the Trademark Act of 1946 (15  
5 U.S.C. 1127) is amended by—

6           (1) amending the paragraph defining “related  
7       company” to read as follows:

8           “The term ‘related company’ means any person  
9       whose use of a mark is controlled by the owner of the  
10      mark in respect to the nature and quality of the goods  
11      or services on or in connection with which the mark is  
12      used.”;

13          (2) amending the paragraph defining “trade  
14      name” and “commercial name” to read as follows:

15          “The terms ‘trade name’ and ‘commercial name’  
16      mean any name used by a person to identify his busi-  
17      ness or vocation.”;

18          (3) amending the paragraph defining “trademark”  
19      to read as follows:

20          “The term ‘trademark’ means any word, name,  
21      symbol, or device or any combination thereof used by a  
22      person, or which a person has a bona fide intention to  
23      use in commerce and applies for registration on the  
24      principal register established by this Act, to identify  
25      and distinguish his goods, including a unique product,

1 from those of others and to indicate the source of the  
2 goods, even if that source is unknown.”;

3 (4) amending the paragraph defining “service  
4 mark” to read as follows:

5 “The term ‘service mark’ means any word, name,  
6 symbol, or device or any combination thereof used by a  
7 person, or which a person has a bona fide intention to  
8 use in commerce and applies for registration on the  
9 principal register established by this Act, to identify  
10 and distinguish the services of one person, including a  
11 unique service, from those of others and to indicate the  
12 source of the services, even if that source is unknown.  
13 Titles, character names, and other distinctive features  
14 of radio or television programs may be registered as  
15 service marks notwithstanding that they, or the pro-  
16 grams, may advertise the goods of the sponsor.”;

17 (5) amending the paragraph defining “certification  
18 mark” to read as follows:

19 “The term ‘certification mark’ means any word,  
20 name, symbol, or device or any combination thereof  
21 used by a person other than its owner, or for which  
22 there is a bona fide intention for such use in commerce  
23 through the filing of an application for registration on  
24 the principal register established by this Act, to certify  
25 regional or other origin, material, mode of manufac-

1       ture, quality, accuracy, or other characteristics of such  
2       person's goods or services or that the work or labor on  
3       the goods or services was performed by members of a  
4       union or other organization.”;

5               (6) amending the paragraph defining “collective  
6       mark” to read as follows:

7               “The term ‘collective mark’ means a trademark  
8       or service mark used by the members of a cooperative,  
9       an association, or other collective group or organiza-  
10      tion, or which such members have a bona fide intention  
11      to use in commerce and apply for registration on the  
12      principal register established by this Act, and includes  
13      marks indicating membership in a union, an associa-  
14      tion, or other organization.”;

15              (7) amending the paragraph defining “mark” to  
16      read as follows:

17              “The term ‘mark’ includes any trademark, service  
18      mark, collective mark, or certification mark.”;

19              (8) amending the matter which appears between  
20      the paragraph defining “mark”, and the paragraph de-  
21      fining “colorable imitation” to read as follows:

22              “The term ‘use in commerce’ means use of a  
23      mark in the ordinary course of trade, commensurate  
24      with the circumstances, and not made merely to re-  
25      serve a right in a mark. For purposes of this Act, a

1 mark shall be deemed to be in use in commerce (1) on  
2 goods when it is placed in any manner on the goods or  
3 their containers or the displays associated therewith or  
4 on the tags or labels affixed thereto, or if the nature of  
5 the goods makes such placement impracticable then on  
6 documents associated with the goods or their sale, and  
7 the goods are sold or transported in commerce, and (2)  
8 on services when it is used or displayed in the sale or  
9 advertising of services and the services are rendered in  
10 commerce, or the services are rendered in more than  
11 one State or in this and a foreign country and the  
12 person rendering the services is engaged in commerce  
13 in connection therewith.

14 "A mark shall be deemed to be 'abandoned'—

15 "(1) when its use has been discontinued with  
16 intent not to resume. Intent not to resume may be  
17 inferred from circumstances. Nonuse for two con-  
18 secutive years shall be prima facie evidence of  
19 abandonment. 'Use' means use made in the ordi-  
20 nary course of trade, commensurate with the cir-  
21 cumstances, and not made merely to reserve a  
22 right in a mark; or

23 "(2) when any course of conduct of the  
24 owner, including acts of omission as well as com-  
25 mission, causes the mark to become the generic

1 name for the goods or services or otherwise to  
2 lose its significance as a mark. Purchaser motiva-  
3 tion shall not be a test for determining abandon-  
4 ment under this subparagraph.

5 “The term ‘dilution’ means the lessening of the  
6 distinctive quality of a famous mark through use of the  
7 mark by another person, regardless of the presence or  
8 absence of (1) competition between the users of the  
9 mark, or (2) likelihood of confusion, mistake, or decep-  
10 tion arising from that use.”

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