

## **Proposed Amendments to Lanham Act**

### **1. To amend §7 (15 U.S.C. §1057).**

#### **Reason for Amendment**

The Trademark Law Treaty Implementation Act amended section 8, 15 U.S.C. §1058, to replace the term "registrant" with the term "owner," to make it clear that the affidavit of continued use or excusable nonuse must be filed by the owner of the registration. See H.R. Rep. No. 194, 105th Cong., 1st Sess. 18-19 (1997). Section 7(e) of the Act, 15 U.S.C. §1057(e), is hereby amended to substitute "owner" for "registrant," for consistency with section 8, and to make it clear that only the owner of a registration can file a request to amend the registration. This codifies the longstanding practice of the United States Patent and Trademark Office (Office). Section 7(b) is amended for consistency with section 7(e).

Section 7(e) is further amended to delete the reference to a certified copy of a registration certificate that had been lost or destroyed, because it is unnecessary. Prior to 2004, the Trademark Rules of Practice required that any owner requesting amendment under section 7(e) submit the original certificate of registration or a certified copy thereof. The Office would attach an updated registration certificate showing the amendment to the original certificate or certified copy, and return it to the owner. However, the Office has determined that requiring the owner to submit an original certificate or a certified copy for the purpose of physically attaching an updated registration certificate was unnecessary and inefficient, and amended the rules to eliminate this requirement. See notice at 69 Fed. Reg. 51362 (Aug. 19, 2004). The Office now sends an updated registration certificate showing the amendment to the owner, and instructs the owner to attach it to the certificate of registration. Original certificates or certified copies thereof are no longer required, and the Office discourages owners from submitting them.

### **§7 (15 U.S.C. §1057). Certificates of registration**

#### **(a) Issuance and form**

Certificates of registration of marks registered upon the principal register shall be issued in the name of the United States of America, under the seal of the United States Patent and Trademark Office, and shall be signed by the Director or have his signature placed thereon, and a record thereof shall be kept in the United States Patent and Trademark Office. The registration shall reproduce the mark, and state that the mark is registered on the principal register under this chapter, the date of the first use of the mark, the date of the first use of the mark in commerce, the particular goods or services for which it is registered, the number and date of the registration, the term thereof, the date on which the application for registration was received in the United States Patent and

Trademark Office, and any conditions and limitations that may be imposed in the registration.

**(b) Certificate as prima facie evidence**

A certificate of registration of a mark upon the principal register provided by this chapter shall be prima facie evidence of the validity of the registered mark and of the registration of the mark, of the ownership of the mark, and of the owner's exclusive right to use the registered mark in commerce on or in connection with the goods or services specified in the certificate, subject to any conditions or limitations stated in the certificate.

**(c) Application to register mark considered constructive use**

Contingent on the registration of a mark on the principal register provided by this chapter, the filing of the application to register such mark shall constitute constructive use of the mark, conferring a right of priority, nationwide in effect, on or in connection with the goods or services specified in the registration against any other person except for a person whose mark has not been abandoned and who, prior to such filing—

(1) has used the mark;

(2) has filed an application to register the mark which is pending or has resulted in registration of the mark; or

(3) has filed a foreign application to register the mark on the basis of which he or she has acquired a right of priority, and timely files an application under section 1126(d) to register the mark which is pending or has resulted in registration of the mark.

**(d) Issuance to assignee**

A certificate of registration of a mark may be issued to the assignee of the applicant, but the assignment must first be recorded in the United States Patent and Trademark Office. In case of change of ownership the Director shall, at the request of the owner and upon a proper showing and the payment of the prescribed fee, issue to such assignee a new certificate of registration of the said mark in the name of such assignee, and for the unexpired part of the original period.

**(e) Surrender, cancellation, or amendment by owner**

Upon application of the owner the Director may permit any registration to be surrendered for cancellation, and upon cancellation appropriate entry shall be made in the records of the United States Patent and Trademark Office. Upon application of the owner and payment of the prescribed fee, the Director for good

cause may permit any registration to be amended or to be disclaimed in part: *Provided*, That the amendment or disclaimer does not alter materially the character of the mark. Appropriate entry shall be made in the records of the United States Patent and Trademark Office and upon the certificate of registration.

**(f) Copies of United States Patent and Trademark Office records as evidence**

Copies of any records, books, papers, or drawings belonging to the United States Patent and Trademark Office relating to marks, and copies of registrations, when authenticated by the seal of the United States Patent and Trademark Office and certified by the Director, or in his name by an employee of the Office duly designated by the Director, shall be evidence in all cases wherein the originals would be evidence; and any person making application therefor and paying the prescribed fee shall have such copies.

**(g) Correction of United States Patent and Trademark Office mistake**

Whenever a material mistake in a registration, incurred through the fault of the United States Patent and Trademark Office, is clearly disclosed by the records of the Office a certificate stating the fact and nature of such mistake shall be issued without charge and recorded and a printed copy thereof shall be attached to each printed copy of the registration and such corrected registration shall thereafter have the same effect as if the same had been originally issued in such corrected form, or in the discretion of the Director a new certificate of registration may be issued without charge. All certificates of correction heretofore issued in accordance with the rules of the United States Patent and Trademark Office and the registrations to which they are attached shall have the same force and effect as if such certificates and their issue had been specifically authorized by statute.

**(h) Correction of applicant's mistake**

Whenever a mistake has been made in a registration and a showing has been made that such mistake occurred in good faith through the fault of the applicant, the Director is authorized to issue a certificate of correction or, in his discretion, a new certificate upon the payment of the prescribed fee: *Provided*, That the correction does not involve such changes in the registration as to require republication of the mark.

**2. To amend §8 (15 U.S.C. §1058).**

Reason for Amendment

Sections (a), (b), and (c) of section 8, 15 U.S.C. §1058, are rewritten to indicate the time frames and requirements for filing the affidavit and to specify that filing

the affidavit in the name of someone other than the owner of the registration is a deficiency that may be corrected even after the grace period for filing the affidavit has expired. This reflects the spirit of the Trademark Law Treaty, as it will facilitate maintenance of registrations.

The heading of this section adds the words “affidavits and fees” to mirror the section 71 heading, 15 U.S.C. §1141k.

**§8 (15 U.S.C. §1058). Duration, affidavits and fees.**

**(a) Time periods for required affidavits**

Each registration shall remain in force for 10 years, except that the registration of any mark shall be canceled by the Director unless the owner of the registration files in the United States Patent and Trademark Office affidavits that meet the requirements of subsection (b), within the following time periods:

(1) Within the 1-year period immediately preceding the expiration of 6 years following the date of registration under this Act or the date of the publication under section 1062(c); and

(2) Within the 1-year period immediately preceding the expiration of 10 years following the date of registration, and each successive 10-year period following the date of registration.

(3) The owner may file the affidavit required under this section within the 6-month grace period immediately following the expiration of the periods in subparagraphs (1) and (2), together with the fee described in subsection (b) and the additional grace period surcharge prescribed by the Director.

**(b) Requirements for affidavit**

The affidavit referred to in subsection (a) must:

(1) (A) State that the mark is in use in commerce;

(B) Set forth the goods and/or services recited in the registration on or in connection with which the mark is in use in commerce;

(C) Be accompanied by such number of specimens or facsimiles showing current use of the mark in commerce as may be required by the Director; and

(D) Be accompanied by the fee prescribed by the Director; or

- (2) (A) Set forth the goods and/or services recited in the registration on or in connection with which the mark is not in use in commerce;
- (B) Include a showing that any nonuse is due to special circumstances which excuse such nonuse and is not due to any intention to abandon the mark; and
- (C) Be accompanied by the fee prescribed by the Director.

**(c) Deficient affidavit**

If any submission filed within the period set forth in subsection (a) is deficient, including that the affidavit was not filed in the name of the owner of the registration, the deficiency may be corrected after the statutory time period, within the time prescribed after notification of the deficiency. Such submission must be accompanied by the additional deficiency surcharge prescribed by the Director.

**(d) Notice of requirement**

Special notice of the requirement for such affidavit shall be attached to each certificate of extension of protection.

**(e) Notification of acceptance or refusal**

The Director shall notify any owner who files any affidavit required by this section of the Director's acceptance or refusal thereof and, in the case of a refusal, the reasons therefor.

**(f) Designation of resident for service of process and notices**

If the owner is not domiciled in the United States, the owner may designate, by a document filed in the United States Patent and Trademark Office, the name and address of a 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 that person or mailing to that person a copy thereof at the address specified in the last designation so filed. If the person so designated cannot be found at the last designated address, or if the owner does not designate by a document filed in the United States Patent and Trademark Office the name and address of a 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 on the Director.

**3. To amend §15 (15 U.S.C. §1065).**

Reason for Amendment

The Trademark Law Treaty Implementation Act amended section 8, 15 U.S.C. §1058, to replace the term "registrant" with the term "owner" throughout

section 8, to make it clear that the affidavit of continued use or excusable nonuse must be filed by the owner of the registration. The first, second and seventh paragraphs of section 15, 15 U.S.C. §1065, of the Act are hereby amended to substitute “owner” for “registrant,” for consistency with section 8, and to make it clear that the owner of the registration must file an affidavit stating that the mark has been in continuous use in commerce for a period of five years after the date of registration in order to obtain the benefits of section 15. This codifies the longstanding practice of the Office.

**§15 (15 U.S.C. §1065). Incontestability of right to use mark under certain conditions**

Except on a ground for which application to cancel may be filed at anytime under paragraphs (3) and (5) of section 1064 of this title, and except to the extent, if any, to which the use of a mark registered on the principal register infringes a valid right acquired under the law of any State or Territory by use of a mark or trade name continuing from a date prior to the date of registration under this chapter of such registered mark, the right of the owner to use such registered mark in commerce for the goods or services on or in connection with which such registered mark has been in continuous use for five consecutive years subsequent to the date of such registration and is still in use in commerce, shall be incontestable: *Provided*, That—

- (1) there has been no final decision adverse to the owner’s claim of ownership of such mark for such goods or services, or to the owner’s right to register the same or to keep the same on the register; and
- (2) there is no proceeding involving said rights pending in the United States Patent and Trademark Office or in a court and not finally disposed of; and
- (3) an affidavit is filed with the Director within one year after the expiration of any such five-year period setting forth those goods or services stated in the registration on or in connection with which such mark has been in continuous use for such five consecutive years and is still in use in commerce, and the other matters specified in paragraphs (1) and (2) of this section; and
- (4) no incontestable right shall be acquired in a mark which is the generic name for the goods or services or a portion thereof, for which it is registered.

Subject to the conditions above specified in this section, the incontestable right with reference to a mark registered under this chapter shall apply to a mark registered under the Act of March 3, 1881, or the Act of February 20, 1905, upon

the filing of the required affidavit with the Director within one year after the expiration of any period of five consecutive years after the date of publication of a mark under the provisions of subsection (c) of section 1062 of this title.

The Director shall notify any owner who files the above-prescribed affidavit of the filing thereof.

#### **4. To amend §17(b), 15 U.S.C. §1067(b)**

##### Reason for Amendment

The section was previously amended by the Patent and Trademark Office Efficiency Act, 113 Stat. 1501A-583, to substitute “Director” for “Commissioner.”

Public Law 107-273, 116 Stat. 1902, Section 13202 entitled “Patent and Trademark Efficiency Act Amendments” subsequently directed amendment of this section by inserting “the Deputy Commissioner” after “Commissioner”; but because “Commissioner” no longer appeared in the text, this amendment was not entered. Further, the correct title is “Deputy Director.”

This proposed amendment will correct the omission of “Deputy Director” by inserting the correct title after the first occurrence of “Director” in section 17(b).

#### **§17 (15 U.S.C. §1067). Interference, opposition, and proceedings for concurrent use registration or for cancellation; notice; Trademark Trial and Appeal Board**

(a) \*\*\*\*\*

(b) The Trademark Trial and Appeal Board shall include the Director, the Deputy Director, the Commissioner for Patents, the Commissioner for Trademarks, and administrative trademark judges who are appointed by the Director.

#### **5. To amend §21(a)(1), 15 U.S.C. §1071(a)(1):**

##### Reason for Amendment

The Madrid Protocol Implementation Act of 2002, Public Law 107-273, 116 Stat. 1758, 1913-1921, added section 71, 15 U.S.C. §1141k, to require affidavits of use to be filed for registrations issued as extensions of protection under the Madrid Protocol. Reference to section 71 was inadvertently omitted from section 21, (15 U.S.C. §1071) which permits appeal of an adverse decision of the Director regarding an affidavit of continued use or renewal application to the United States Court of Appeals for the Federal Circuit.

This proposed amendment will correct the omission of the reference to section 71 in section 21(a)(1).

## **§21 (15 U.S.C. §1071). Appeal to courts**

### **(a) Persons entitled to appeal; United States Court of Appeals for the Federal Circuit; waiver of civil action; election of civil action by adverse party; procedure**

(1) An applicant for registration of a mark, party to an interference proceeding, party to an opposition proceeding, party to an application to register as a lawful concurrent user, party to a cancellation proceeding, a registrant who has filed an affidavit as provided in section 1058 or section 1141k, or an applicant for renewal, who is dissatisfied with the decision of the Director or Trademark Trial and Appeal Board, may appeal to the United States Court of Appeals for the Federal Circuit thereby waiving his right to proceed under subsection (b) of this section: *Provided*, That such appeal shall be dismissed if any adverse party to the proceeding, other than the Director, shall, within twenty days after the appellant has filed notice of appeal according to paragraph (2) of this subsection, files notice with the Director that he elects to have all further proceedings conducted as provided in subsection (b) of this section. Thereupon the appellant shall have thirty days thereafter within which to file a civil action under subsection (b) of this section, in default of which the decision appealed from shall govern the further proceedings in the case.

(2) When an appeal is taken to the United States Court of Appeals for the Federal Circuit, the appellant shall file in the United States Patent and Trademark Office a written notice of appeal directed to the Director, within such time after the date of the decision from which the appeal is taken as the Director prescribes, but in no case less than 60 days after that date.

(3) The Director shall transmit to the United States Court of Appeals for the Federal Circuit a certified list of the documents comprising the record in the United States Patent and Trademark Office. The court may request that the Director forward the original or certified copies of such documents during pendency of the appeal. In an ex parte case, the Director shall submit to that court a brief explaining the grounds for the decision of the United States Patent and Trademark Office, addressing all the issues involved in the appeal. The court shall, before hearing an appeal, give notice of the time and place of the hearing to the Director and parties in the appeal.

(4) The United States Court of Appeals for the Federal Circuit shall review the decision from which the appeal is taken on the record before the United States Patent and Trademark Office. Upon its determination the court shall issue its mandate and opinion to the Director, which shall be entered of record in the United States Patent and Trademark Office and shall govern the further proceedings in the case. However, no final judgment shall be entered in favor of an applicant under section 1051(b) before the mark is registered, if such applicant cannot prevail without establishing constructive use pursuant to section 1057(c).

(b) (1) Whenever a person authorized by subsection (a) of this section to appeal to the United States Court of Appeals for the Federal Circuit is dissatisfied with the decision of the Director or Trademark Trial and Appeal Board, said person may, unless appeal has been taken to said United States Court of Appeals for the Federal Circuit, have remedy by a civil action if commenced within such time after such decision, not less than sixty days, as the Director appoints or as provided in subsection (a) of this section. The court may adjudge that an applicant is entitled to a registration upon the application involved, that a registration involved should be canceled, or such other matter as the issues in the proceeding require, as the facts in the case may appear. Such adjudication shall authorize the Director to take any necessary action, upon compliance with the requirements of law. However, no final judgment shall be entered in favor of an applicant under section 1051(b) before the mark is registered, if such applicant cannot prevail without establishing constructive use pursuant to section 1057(c).

(2) The Director shall not be made a party to an inter partes proceeding under this subsection, but he shall be notified of the filing of the complaint by the clerk of the court in which it is filed and shall have the right to intervene in the action.

(3) In any case where there is no adverse party, a copy of the complaint shall be served on the Director, and, unless the court finds the expenses to be unreasonable, all the expenses of the proceeding shall be paid by the party bringing the case, whether the final decision is in favor of such party or not. In suits brought hereunder, the record in the United States Patent and Trademark Office shall be admitted on motion of any party, upon such terms and conditions as to costs, expenses, and the further cross-examination of the witnesses as the court imposes, without prejudice to the right of any party to take further testimony. The testimony and exhibits of the record in the United States Patent and Trademark Office, when admitted, shall have the same effect as if originally taken and produced in the suit.

(4) Where there is an adverse party, such suit may be instituted against the party in interest as shown by the records of the United States Patent and Trademark Office at the time of the decision complained of, but any party in interest may become a party to the action. If there are adverse parties residing in a plurality of districts not embraced within the same State, or an adverse party residing in a foreign country, the United States District Court for the District of Columbia shall have jurisdiction and may issue summons against the adverse parties directed to the marshal of any district in which any adverse party resides. Summons against adverse parties residing in foreign countries may be served by publication or otherwise as the court directs.

6. To amend §71 (15 U.S.C. § 1141k)

Reason for Amendment

To bring the provisions for maintaining extensions of protection under the Madrid Protocol in conformity with the provisions for maintaining registrations: The provisions of the Trademark Law Treaty Implementation Act, Public Law No. 105-330, 112 Stat. 3064, which changed the grace periods for filing affidavits of use or excusable nonuse and provided for correction of deficiencies in such affidavits, were inadvertently omitted from section 71, 15 U.S.C. §1141k, which sets forth the requirements for filing affidavits of use or excusable nonuse for registered extensions of protection of international registrations to the United States pursuant to section 69, 15 U.S.C. §1141i, of the Trademark Act.

In addition, section 71(c) provides that the filing of the affidavit in the name of someone other than the “holder” of the international registration is a deficiency that may be cured even after the grace period for filing the affidavit have expired, upon payment of an additional surcharge. This reflects the spirit of the Trademark Law Treaty, as it will facilitate maintenance of extensions of protection.

The heading of this section adds the word “Duration” to mirror the section 8 heading.

**§71 (15 U.S.C. § 1141k). Duration, affidavits and fees.**

**(a) Time periods for required affidavits**

Each extension of protection for which a certificate has been issued under section 1141i shall remain in force for the term of the international registration upon which it is based, except that the extension of protection of any mark shall be canceled by the Director unless the holder of the international registration files in the United States Patent and Trademark Office affidavits that meet the requirements of subsection (b), within the following time periods:

- (1) Within the 1-year period immediately preceding the expiration of 6 years following the date of issuance of the certificate of extension of protection; and
- (2) Within the 1-year period immediately preceding the expiration of 10 years following the date of issuance of the certificate of extension of protection, and each successive 10-year period following the date of issuance of the certificate of extension of protection.
- (3) The holder may file the affidavit required under this section within a grace period of 6 months after the end of the applicable

time period in subparagraph (1) or (2) of this section, together with the fee described in paragraph (b) and the additional grace period surcharge prescribed by the Director.

**(b) Requirements for affidavit**

The affidavit referred to in subsection (a) must:

- (1) (A) State that the mark is in use in commerce;
- (B) Set forth the goods and/or services recited in the extension of protection on or in connection with which the mark is in use in commerce;
- (C) Be accompanied by such number of specimens or facsimiles showing current use of the mark in commerce as may be required by the Director; and
- (D) Be accompanied by the fee prescribed by the Director; or
- (2) (A) Set forth the goods and/or services recited in the extension of protection on or in connection with which the mark is not in use in commerce;
- (B) Include a showing that any nonuse is due to special circumstances which excuse such nonuse and is not due to any intention to abandon the mark; and
- (C) Be accompanied by the fee prescribed by the Director.

**(c) Deficient affidavit**

If any submission filed within the period set forth in subsection (a) is deficient, including that the affidavit was not filed in the name of the holder of the international registration, the deficiency may be corrected after the statutory time period, within the time prescribed after notification of the deficiency. Such submission must be accompanied by the additional deficiency surcharge prescribed by the Director.

**(d) Notice of requirement**

Special notice of the requirement for such affidavit shall be attached to each certificate of extension of protection.

**(e) Notification of acceptance or refusal**

The Director shall notify the holder of the international registration who files any affidavit required by this section of the Director's acceptance or refusal thereof and, in the case of a refusal, the reasons therefor.

**(f) Designation of resident for service of process and notices**

If the holder of the international registration of the mark is not domiciled in the United States, the holder may designate, by a document filed in the United States Patent and Trademark Office, the name and address of a 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 that person or mailing to that person a copy thereof at the address specified in the last designation so filed. If the person so designated cannot be found at the last designated address, or if the holder does not designate by a document filed in the United States Patent and Trademark Office the name and address of a 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 on the Director.