the appropriations account 'Joint Economic Committee' under the heading 'JOINT ITEMS' shall be paid from the Senate appropriations account for 'Salaries, Officers and Employees'.

"(b) This section shall apply to pay periods beginning on or after October 1, 2000."

§ 1025. Printing of monthly publication by Joint Economic Committee entitled "Economic Indicators"; distribution

The Joint Economic Committee is authorized to issue a monthly publication entitled "Economic Indicators", and a sufficient quantity shall be printed to furnish one copy to each Member of Congress; the Secretary and the Sergeant at Arms of the Senate; the Clerk, Sergeant at Arms, and Chief Administrative Officer of the House of Representatives; two copies to the libraries of the Senate and House, and the Congressional Library; seven hundred copies to the Joint Economic Committee; and the required number of copies to the Superintendent of Documents for distribution to depository libraries; and the Superintendent of Documents is authorized to have copies printed for sale to the public.


CODIFICATION

Section was not enacted as a part of the Employment Act of 1946 which comprises this chapter.

"Joint Economic Committee" substituted in text for "Joint Committee on the Economic Report" to conform to act June 18, 1956, ch. 399, § 2, 70 Stat. 290. See section 1024(a) of this title.

AMENDMENTS

1996—Pub. L. 104–186 substituted "Chief Administrative Officer" for "Doorkeeper".


CHAPTER 22—TRADEMARKS

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§ 1051. Application for registration; verification

(a) Application for use of trademark

(1) The owner of a trademark used in commerce may request registration of its trademark on the principal register hereby established by paying the prescribed fee and filing in the Patent and Trademark Office an application and a verified statement, in such form as may be prescribed by the Director. The Director shall promulgate rules prescribing the requirements for the application and for obtaining a filing date herein.

(b) Application for bona fide intention to use trademark

(1) A person who has a bona fide intention, under circumstances showing the good faith of such person, to use a trademark in commerce may request registration of its trademark on the principal register hereby established by paying the prescribed fee and filing in the Patent and Trademark Office an application and a verified statement, in such form as may be prescribed by the Director.

(2) The application shall include specification of the applicant’s domicile and citizenship, the goods in connection with which the applicant desires registration.

(3) The statement shall be verified by the applicant and specify—

(A) that the person making the verification believes that he or she, or the juristic person in whose behalf he or she makes the verification, to be the owner of the mark sought to be registered;

(B) to the best of the verifier’s knowledge and belief, the facts recited in the application are accurate;

(C) the mark is in use in commerce; and

(D) to the best of the verifier’s knowledge and belief, no other person has the right to use such mark in commerce either in the identical form thereof or in such near resemblance thereto as to be likely, when used on or in connection with the goods of such other person, to cause confusion, or to cause mistake, or to deceive, except that, in the case of every application claiming concurrent use, the applicant shall—

(i) state exceptions to the claim of exclusive use; and

(ii) shall specify, to the extent of the verifier’s knowledge—

(I) any concurrent use by others;

(II) the goods on or in connection with which and the areas in which each concurrent use exists;

(III) the periods of each use; and

(IV) the goods and area for which the applicant desires registration.

(4) The applicant shall comply with such rules or regulations as may be prescribed by the Director. The Director shall promulgate rules prescribing the requirements for the application and for obtaining a filing date herein.

1 So in original. The word “shall” probably should not appear.
Amendment of application under subsection (b) to conform to requirements of subsection (a)

At any time during examination of an application filed under subsection (b) of this section, an applicant who has made use of the mark in commerce may claim the benefits of such use for purposes of this chapter, by amending his or her application to bring it into conformity with the requirements of subsection (a) of this section.

Verified statement that trademark is used in commerce

(1) Within six months after the date on which the notice of allowance with respect to a mark is issued under section 1063(b)(2) of this title to an applicant under subsection (b) of this section, the applicant shall file in the Patent and Trademark Office, together with such number of specimens or facsimiles of the mark as used in commerce as may be required by the Director and payment of the prescribed fee, a verified statement that the mark is in use in commerce and specifies the goods or services identified in the notice of allowance on or in connection with which the mark is used in commerce. Subject to examination and acceptance of the statement of use, the mark shall be registered in the Patent and Trademark Office, a certificate of registration shall be issued for those goods or services recited in the statement of use for which the mark is entitled to registration, and notice of registration shall be published in the Official Gazette of the Patent and Trademark Office. Such examination may include an examination of the factors set forth in subsections (a) through (e) of section 1052 of this title. The notice of registration shall specify the goods or services for which the mark is registered.

(2) The Director shall extend, for one additional 6-month period, the time for filing the statement of use under paragraph (1), upon written request of the applicant before the expiration of the 6-month period provided in paragraph (1). In addition to an extension under the preceding sentence, the Director may, upon a showing of good cause by the applicant, further extend the time for filing the statement of use under paragraph (1) for periods aggregating not more than 24 months, pursuant to written request of the applicant made before the expiration of the last extension granted under this paragraph. Any request for an extension under this paragraph shall be accompanied by a verified statement that the applicant has a continued bona fide intention to use the mark in commerce and specifying those goods or services identified in the notice of allowance on or in connection with which the mark is used in commerce. Any request for an extension under this paragraph shall be accompanied by payment of the prescribed fee. The Director shall issue regulations setting forth guidelines for determining what constitutes good cause for purposes of this paragraph.

(3) The Director shall notify any applicant who files a statement of use of the acceptance or refusal thereof and, if the statement of use is refused, the reasons for the refusal. An applicant may amend the statement of use.

(e) Designation of resident for service of process and notices

If the applicant is not domiciled in the United States the applicant 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, the reasons for the refusal. An applicant may amend the statement of use.

PRIOR PROVISIONS


AMENDMENTS

2002—Subsec. (d)(1). Pub. L. 107–273, §13207(b)(1), in first sentence, substituted “specifying the date of the applicant’s first use of the mark in commerce and those goods or services specified in the notice of allowance or in connection with which the mark is used in commerce.” for “specifying the date of the applicant’s first use of the mark in commerce and, those goods or services specified in the notice of allowance or in connection with which the mark is used in commerce.”

Subsec. (e), Pub. L. 107–273, §13207(b)(2), amended subsec. (e) generally. Prior to amendment, subsec. (e) required applicant not domiciled in United States to designate name and address of some person resident in the United States on whom may be served notices or process in proceedings affecting the mark, unless it can be shown to the satisfaction of the Director that the delay in responding was unintentional, in which case the time for filing may be extended, but for a period not to exceed the period specified in paragraphs (1) and (2) for filing a statement of use.
this title shall take effect—

Amendment note below] and the amendments made by 3069, provided that: “This title [see Short Title of 1998 Date of 1998 Amendment note below] and the amendments made by this title shall apply to any application for registration of a trademark pending on, or filed on or after, the effective date of this Act [Oct. 30, 1998], or

this title shall apply to any application for registration of a trademark in commerce to register trademark by filing in the Patent and Trademark Office a written application in prescribed form and verified by applicant, by paying prescribed fee, and by complying with prescribed rules or regulations.

Subsec. (b). Pub. L. 105–330, § 103(b), amended subsec. (b) generally. Prior to amendment, subsec. (b) related to application by owner of a trademark used in commerce to register trademark by filing in the Patent and Trademark Office a written application in prescribed form and verified by applicant, by paying prescribed fee, and by complying with prescribed rules or regulations.


Pub. L. 105–330, § 201(a)(1)(B), which directed the striking out of “and, the mode or manner in which the mark is used on or in connection with such goods or services”, was executed by striking out “... and the mode or manner in which the mark is used on or in connection with such goods or services” after “notice of allowance on or in connection with which the mark is used in commerce”, to reflect the probable intent of Congress.

Subsec. (d)(4). Pub. L. 105–330, § 103(c), amended par. (4) generally. Prior to amendment, par. (4) read as follows: “The failure to timely file a verified statement of use under this subsection shall result in abandonment of the application.”

1988—Subsec. (a). Pub. L. 100–667, § 103(1) to (7), inserted “(a)” preceding introductory provisions and substituted “may apply to register his or her” for “may register his”, redesignated former subsecs. (a) to (c) as paras. (1) to (3), respectively, redesignated former paras. (1) to (3) as subs paras. (A) to (C), respectively, in par. (1)(A), substituted “used on or in connection with” for “applied to” and “goods on or in connection” for “goods in connection”, in par. (1)(C), struck out “actually” after “the mark as”, and in par. (2), substituted “prescribed” for “filling”.

Subsecs. (b), (c). Pub. L. 100–667, § 103(3), (9), added subsecs. (b) and (c) and redesignated former subsecs. (b) and (c) as paras. (2) and (3), respectively, of subsec. (a).


1962—Subsec. (a)(1). Pub. L. 87–772 substituted “as to be likely, when applied to the goods of such other person, to cause confusion, or to cause mistake, or to deceive” for “as might be calculated to deceive”, and “Patent and Trademark Office” for “Patent Office”.

Effective Date of 1999 Amendment
Amendment by Pub. L. 106–113 effective 4 months after Nov. 29, 1999, see section 1000(a)(9) [title IV, § 4731] of Pub. L. 106–113, set out as a note under section 1 of Title 35, Patents.

Effective Date of 1998 Amendment
Pub. L. 105–330, title I, § 109(b), Oct. 30, 1998, 112 Stat. 3069, provided that: “This title [see Short Title of 1998 Amendment note below] and the amendments made by this title shall apply to any application for registration of a trademark pending on, or filed on or after, the effective date of this Act [probably should be “this title”, see section 110 of Pub. L. 105–330, set out as an Effective Date of 1998 Amendment note below].”


“(1) on the date that is 1 year after the date of the enactment of this Act [Oct. 30, 1998], or

“(2) upon the entry into force of the Trademark Law Treaty with respect to the United States [Aug. 12, 2000], whichever occurs first.”

Pub. L. 105–330, title II, § 201(b), Oct. 30, 1998, 112 Stat. 3070, provided that: “The amendments made by this section [amending this section and sections 1052, 1057, 1059, 1064, 1091, 1094, 1113 to 1115, 1121, and 1124 of this title] shall take effect on the date of enactment of this Act [Oct. 30, 1998], and shall apply only to any civil action filed or proceeding before the United States Patent and Trademark Office commenced on or after such date relating to the registration of a mark.”

Effective Date of 1988 Amendment
Pub. L. 100–667, title I, § 126, Nov. 16, 1988, 102 Stat. 3948, provided that: “This title and the amendments made by this title [see Short Title of 1988 Amendment note below] shall become effective on the date which is one year after the date of enactment of this Act [Nov. 16, 1988].”

Effective Date of 1975 Amendment

Effective Date
Section 46(a) of act July 5, 1946, provided that this chapter shall be in force and take effect one year from July 5, 1946.

Short Title of 2010 Amendment

Short Title of 2006 Amendment

Short Title of 2004 Amendment

Short Title of 2002 Amendment

Short Title of 2001 Amendment
Pub. L. 107–269, title II, § 121, Dec. 10, 2002, 116 Stat. 2494, provided that: “This Act [amending section 1057 of this title, section 504 of Title 17, Copyrights, and sections 3559 and 3595 of Title 18, Crimes and Criminal Procedure, and sections 85 and 112 of Title 28, Judiciary and Judicial Procedure, and enacting provisions set out as notes under this section, section 1117 of this title, sections 2311 and 2318 of Title 18, and listed in a table relating to sentencing guidelines set out as a note under section 994 of Title 28] may be cited as the ‘Intellectual Property Protection and Courts Amendments Act of 2001’.”

Short Title of 1999 Amendment
This title [enacting section 1129 of this title, amending sections 1114, 1116, 1117, 1125, and 1127 of this title, section 470a of Title 16, Conservation, and section 1338 of Title 28, Judiciary and Judicial Procedure, and enacting provisions set out as notes under this section and sections 1117 and 1125 of this title] may be cited as the 'Anticybersquatting Consumer Protection Act'.

Pub. L. 106–43, § 1, Aug. 5, 1999, 113 Stat. 281, provided that: "This Act [amending sections 1052 to 1054, 1060, 1063, 1064, 1091, 1092, 1114, 1116 to 1118, 1122, and 1124 to 1127 of this title, enacting provisions set out as a note under section 1052 of this title, and amending provisions set out as a note under this section] may be cited as the 'Trademarks Amendments Act of 1999'.''

**SHORT TITLE OF 1998 AMENDMENT**


**SHORT TITLE OF 1992 AMENDMENT**

Pub. L. 102–542, § 1, Oct. 27, 1992, 106 Stat. 3567, provided that: 'This Act [amending sections 1114, 1125, and 1127 of this title, and enacting provisions set out as a note under section 1114 of this title] may be cited as the 'Trademark Remedy Clarification Act'.'

**SHORT TITLE OF 1988 AMENDMENT**

Pub. L. 100–667, title I, §101, Nov. 16, 1988, 102 Stat. 3935, provided that: 'This title [amending this section and sections 1052 to 1060, 1062, and 1126 of this title and enacting provisions set out as notes under this section and sections 1058 and 1059 of this title] may be cited as the 'Trademark Law Treaty Implementation Act'.'

**SHORT TITLE OF 1996 AMENDMENT**

Pub. L. 104–98, § 1, Jan. 16, 1996, 109 Stat. 985, provided that: 'This Act [amending sections 1112 and 1127 of this title and enacting provisions set out as a note under section 1125 of this title] may be cited as the 'Federal Trademark Dilution Act of 1995'.'

**SHORT TITLE OF 1986 AMENDMENT**

Pub. L. 102–542, §1, Oct. 27, 1992, 106 Stat. 3567, provided that: 'This Act [amending this section and sections 1114, 1125, and 1127 of this title, and enacting provisions set out as a note under section 1114 of this title] may be cited as the 'Trademark Remedy Clarification Act'.'

**SHORT TITLE OF 1984 AMENDMENT**

Pub. L. 98–620, title I, §101, Nov. 8, 1984, 98 Stat. 3335, provided that: 'This title [amending sections 1064 and 1127 of this title and enacting provisions set out as a note under section 1064 of this title] may be cited as the 'Trademark Law Revision Act of 1984'.'

**SHORT TITLE**

Act July 5, 1946, ch. 540, 60 Stat. 427, which is classified to this chapter, is popularly known as the 'Lanham Act' and also as the 'Trademark Act of 1946'.

**REPEAL OF INCONSISTENT PROVISIONS; CERTAIN PROVISIONS NOT AFFECTED**

Act July 5, 1946, ch. 540, 60 Stat. 427, which is classified to this chapter, is popularly known as the 'Lanham Act' and also as the 'Trademark Act of 1946'.

**REPEAL OF INCONSISTENT PROVISIONS; CERTAIN PROVISIONS NOT AFFECTED**

Act July 5, 1946, ch. 540, title XI, §46(a), 60 Stat. 444, as amended by Pub. L. 106–43, §8(b), Aug. 5, 1999, 113 Stat. 230, provided in part that all acts and parts of acts inconsistent with this chapter are repealed effective one year from July 5, 1946, but that "nothing contained in this Act [this chapter] shall be construed as limiting, restricting, modifying, or repealing any statute in force on the effective date of this Act [July 5, 1947] which does not relate to trademarks, or as restricting or increasing the authority of any Federal department or regulatory agency except as may be specifically provided in this Act [this chapter]."


**SAVINGS PROVISION**


**SEPARABILITY**

Act July 5, 1946, ch. 540, title XI, §50, 60 Stat. 446, provided that: 'If any provision of this Act [this chapter] or the application of such provision to any person or circumstance is held invalid, the remainder of the Act shall not be affected thereby.'

**TRANSFER OF FUNCTIONS**

For transfer of functions of other officers, employees, and agencies of Department of Commerce to Secretary of Commerce, with certain exceptions, see Reorg. Plan No. 5 of 1950, §§1, 2, eff. May 24, 1950, 15 F.R. 3174, 64 Stat. 1263, set out in the Appendix to Title 5, Government Organization and Employees.

**PENDING PROCEEDINGS AND EXISTING REGISTRATION AND RIGHTS UNDER PRIOR ACTS**

Act July 5, 1946, ch. 540, title XI, §46(a), 60 Stat. 444, provided in part that this chapter: "shall affect any suit, proceeding or appeal pending on the effective date of this chapter and that the repeal of all inconsistent acts shall not affect the validity of registrations granted or applied for under any of said Acts prior to the effective date of this Act [July 5, 1947], or rights or remedies thereunder except as provided in sections 8, 12, 14, 15, and 47 of this Act [sections 1058, 1062, 1064, and 1065 of this title and note under this section].''

Act July 5, 1946, ch. 540, title XI, §§46(b), 47, 60 Stat. 446, provided: '(b) Registrations now existing under the Act of March 3, 1881, or the Act of February 20, 1905 [sections 81 to 109 of this title], shall continue in full force and effect for the unexpired terms thereof and may be renewed under the provisions of section 9 of this Act [section 1059 of this title]. Such registrations and the renewals thereof shall be subject to and shall be entitled to the benefits of the provisions of this Act [this chapter] to the same extent and with the same force and effect as though registered on the principal register established by this Act [this chapter] except as limited in sections 8, 12, 14, and 15 of this Act [sections 1058, 1062, 1064, 1065, of this title]. Marks registered under the 'ten-year proviso' of section 5 of the Act of February 20, 1905, as amended [former section 85 of this title], shall be deemed to have become distinctive of the registrant's goods in commerce under paragraph (f) of section 2 of this Act [section 1052 of this title] and may be renewed under section 9 hereof [section 1059 of this title] as marks coming within said paragraph. Registrations now existing under the Act of March 19, 1920 [former sections 121 to 128 of this title], shall expire six months after the effective date of this Act [July 5, 1947], or twenty years from the dates of their registrations, whichever date is later; such registrations shall be subject to and entitled to the benefits of the provisions of this Act [this chapter] relating to
marks registered on the supplemental register established by this Act [this chapter], and may not be renewed unless renewal is required to support foreign registration. In that event renewal may be effected on the supplemental register under the provisions of section 9 of this Act [section 1059 of this title].

"Marks registered under previous Acts may, if eligible, also be registered under this Act [this chapter]."

"Sec. 47. (a) All applications for registration pending in the Patent Office at the effective date of this Act [July 5, 1947] may be amended, if practicable, to bring them under the provisions of this Act [this chapter]. The prosecution of such applications so amended and the grant of registrations thereon shall be proceeded with in accordance with the provisions of this Act [this chapter]. If such amendments are not made, the prosecution of said applications shall be proceeded with and registrations thereon granted in accordance with the Acts under which said applications were filed, and said Acts are hereby continued in force to this extent and for this purpose only, notwithstanding the foregoing general repeal thereof.

"(b) In any case in which an appeal is pending before the United States Court of Customs and Patent Appeals or any United States Circuit Court of Appeals or the United States Court of Appeals for the District of Columbia or the United States Supreme Court at the effective date of this Act [July 5, 1947], the court, if it be of the opinion that the provisions of this Act [this chapter] are applicable to the subject matter of the appeal, may apply such provision or may remand the case to the Commissioner [now Director] or to the district court for the taking of additional evidence or a new trial or for reconsideration of the decision on the record as made, as the appellate court may deem proper.

Act July 5, 1946, ch. 540, title XI, § 49, 60 Stat. 446, provided: "Nothing herein [in this chapter] shall adversely affect the rights or the enforcement of rights in marks acquired in good faith prior to the effective date of this Act [July 5, 1947]."

**Emergency Relief From Postal Situation Affecting Trademark Cases**

Relief as to filing date of trademark application or registration and excusal of delayed fees or actions affected by postal situation beginning on Mar. 18, 1970, and ending on or about Mar. 30, 1970, see note set out under section 111 of Title 35, Patents.

§ 1052. Trademarks registrable on principal register; concurrent registration

No trademark by which the goods of the applicant may be distinguished from the goods of others shall be refused registration on the principal register on account of its nature unless it—

(a) Consists of or comprises immoral, deceptive, or scandalous matter; or matter which may disparage or falsely suggest a connection with persons, living or dead, institutions, beliefs, or national symbols, or bring them into contempt, or disrepute; or a geographical indication which, when used on or in connection with wines or spirits, identifies a place other than the origin of the goods and is first used on or in connection with the goods of the applicant is primarily geographic.

(b) Consists of or comprises a mark which so resembles a mark registered in the Patent and Trademark Office, or a mark or trade name previously used in the United States by another and not abandoned, as to be likely, when used on or in connection with the goods of the applicant, to cause confusion, or to cause mistake, or to deceive: Provided, That if the Director determines that confusion, mistake, or deception is not likely to result from the continued use by more than one person of the same or similar marks under conditions and limitations as to the mode or place of use of the marks or the goods on or in connection with which such marks are used, concurrent registrations may be issued to such persons when they have become entitled to use such marks as a result of their concurrent lawful use in commerce prior to (1) the earliest of the filing dates of the applications pending or of any registration issued under this chapter; (2) July 5, 1947, in the case of registrations previously issued under the Act of March 3, 1881, or February 20, 1905, and continuing in full force and effect on that date; or (3) July 5, 1947, in the case of applications filed under the Act of February 20, 1905, and registered after July 5, 1947. Use prior to the filing date of any pending application or a registration shall not be required when the owner of such application or registration consents to the grant of a concurrent registration to the applicant. Concurrent registrations may also be issued by the Director when a court of competent jurisdiction has finally determined that more than one person is entitled to use the same or similar marks in commerce. In issuing concurrent registrations, the Director shall prescribe conditions and limitations as to the mode or place of use of the mark or the goods on or in connection with which such mark is registered to the respective persons.

(e) Consists of a mark which (1) when used on or in connection with the goods of the applicant is merely descriptive or deceptively mis-descriptive of them, (2) when used on or in connection with the goods of the applicant is primarily geographic-descriptive of them, except as indications of regional origin may be registrable under section 1054 of this title, (3) when used on or in connection with the goods of the applicant is primarily geographically deceptively mis-descriptive of them, (4) is primarily merely a surname, or (5) comprises any matter that, as a whole, is functional.

(f) Except as expressly excluded in subsections (a), (b), (c), (d), (e)(3), and (e)(5) of this section, nothing in this chapter shall prevent the registration of a mark used by the applicant which has become distinctive of the applicant's goods in commerce. The Director may accept as prima facie evidence that the mark has become distinctive, as used on or in connection with the applicant's goods in commerce, proof of substantially exclusive and continuous use thereof as a mark by the applicant in commerce for the five years before the date on which the claim of dis-
tinctiveness is made. Nothing in this section shall prevent the registration of a mark which, when used on or in connection with the goods of the applicant, is primarily geographically deceptively misdescriptive of them, and which became distinctive of the applicant's goods in commerce on or before December 8, 1993.

A mark which would be likely to cause dilution by blurring or dilution by tarnishment under section 1125(c) of this title, may be refused registration only pursuant to a proceeding brought under section 1063 of this title. A registration for a mark which would be likely to cause dilution by blurring or dilution by tarnishment under section 1125(c) of this title, may be canceled pursuant to a proceeding brought under either section 1064 of this title or section 1092 of this title.


REPRESENTATIVE OF THE UNITED STATES PATENT AND TRADEMARK OFFICE

PROVISIONS

acts March 3, 1881, and February 20, 1905, referred to in subsec. (d), are acts Mar. 3, 1881, ch. 138, 21 Stat. 502, and Feb. 20, 1905, ch. 592, 33 Stat. 724, which were reenacted as inconsistent with this chapter by act July 5, 1946, ch. 540, §46(a), 60 Stat. 444. Act Feb. 20, 1905, was classified to sections 81 to 109 of this title.

PRIOR PROVISIONS


AMENDMENTS

2006—Pub. L. 109–312, which directed substitution of "A mark which would be likely to cause dilution by blurring or dilution by tarnishment under section 1125(c) of this title, may be refused registration only pursuant to a proceeding brought under section 1063 of this title. A registration for a mark which would be likely to cause dilution by blurring or dilution by tarnishment under section 1125(c) of this title, may be canceled pursuant to a proceeding brought under either section 1064 of this title or section 1092 of this title," for last two sentences in subsec. (f) of this section, was executed by making the substitution for "A mark which would be likely to cause dilution by blurring or dilution by tarnishment under section 1125(c) of this title, may be refused registration only pursuant to a proceeding brought under section 1063 of this title. A registration for a mark which would cause dilution under section 1125(c) of this title may be canceled pursuant to a proceeding brought under either section 1064 of this title or section 1092 of this title," in concluding provisions of section to reflect the probable intent of Congress.


Subsecs. (d), (f). Pub. L. 106–113 substituted "Director" for "Commissioner" wherever appearing.


Subsec. (e). Pub. L. 105–330, §201(a)(2)(A), struck out "or" before "(4)" and inserted "or (5)" comprises any matter that, as a whole, is functional" before period at end.

Subsec. (f). Pub. L. 105–330, §201(a)(2)(B), substituted "subsections (a), (b), (c), (d), (e)(3), and (e)(5)" for "paragraphs (a), (b), (c), (d), and (e)(3)" in conclusion provisions of section to reflect the probable intent of Congress.

1991—Subsec. (a). Pub. L. 102–396 amended subsec. (a) generally. Prior to amendment, subsec. (a) read as follows: "Consists of or comprises immovable, deceptive, or scandalous matter; or matter which may disparage or falsely suggest a connection with persons, dead, institutions, beliefs, or national symbols, or bring them into contempt, or disrepute.

1993—Subsec. (e). Pub. L. 102–182, §333(a)(1), amended subsec. (e) generally. Prior to amendment, subsec. (e) read as follows: "Consists of a mark which, (1) when used on or in connection with the goods of the applicant is merely descriptive or deceptively misdescriptive of them, or (2) when used on or in connection with the goods of the applicant is primarily geographically descriptive or deceptively misdescriptive of them, except as indications of regional origin may be registrable under section 1064 of this title, or (3) is primarily merely a surname."

1988—Subsec. (d). Pub. L. 100–667, §104(a), amended subsec. (d) generally. Prior to amendment, subsec. (d) read as follows: "Consists of or comprises a mark which so resembles a mark registered in the Patent and Trademark Office or a mark or trade name previously used in the United States by another and not abandoned, as to be likely, when applied to the goods of the applicant, to cause confusion, or to cause mistake, or to deceive: Provided, That the Commissioner determines that confusion, mistake, or deception is not likely to result from the continued use by more than one person of the same or similar marks under conditions and limitations as to the mode or place of use of the marks or the goods in connection with which such marks are used, concurrent registrations may be issued to such persons when they have become entitled to use such marks as a result of their concurrent lawful use in commerce prior to (i) the earliest of the filing dates of the applications pending or of any registration issued under this chapter; or (ii) July 5, 1947, in the case of registrations previously issued under the Act of March 3, 1881, or February 20, 1905, and continuing in full force and effect on that date; or (iii) July 5, 1947, in the case of applications filed under the Act of February 20, 1905, and registered after July 5, 1947. Concurrent registrations may also be issued by the Commissioner when a court of competent jurisdiction has finally determined that more than one person is entitled to use the same or similar marks in commerce. In issuing concurrent registrations, the Commissioner shall prescribe conditions and limitations as to the mode or place of use of the mark or the goods in connection with which such mark is registered to the respective persons."
their concurrent lawful use in commerce prior to the earliest of the filing dates of the applications pending or of any registration issued thereunder or any application for registration previously issued under the act of Mar. 3, 1881, or Feb. 20, 1905, and continuing in full force and effect on that date, or July 5, 1947, in the case of applications under the act of Feb. 20, 1905, and registered after July 5, 1947, for provisions which restricted issuance of concurrent registrations to persons entitled to use such mark as a result of their concurrent lawful use thereof in commerce prior to any of the filing dates of the applications involved, and provisions directing that issuance of the mark be upon such conditions and limitations as to the mode or place of use of the mark or the goods in connection with which such marks are used, for provisions which required issuance under conditions and limitations as to the mode or place of use of the goods in connection with which such registrations may be granted, and for eliminations of provisions which limited confusion, mistake, or deception to purchasers, required written notice of applications for concurrent registrations and of hearings thereon, and publication in the Official Gazette upon a decision to grant such a registration and permitted a court to order such a registration under section 4915 of the Revised Statutes.

Effective Date of 1999 Amendments
Amendment by Pub. L. 106–113 effective 4 months after Nov. 29, 1999, see section 100(a)(9) (title IV, § 4731) of Pub. L. 106–113, set out as a note under section 1 of Title 35, Patents.

Pub. L. 106–43, §2(e), Aug. 5, 1999, 113 Stat. 218, provided that: ‘‘The amendments made by this section [amending this section and sections 1063, 1064, and 1092 of this title] shall take effect on the date of enactment of this Act (Aug. 5, 1999) and shall apply only to any application for registration filed on or after January 16, 1996.’’

Effective Date of 1998 Amendment
Amendment by Pub. L. 105–330 effective Oct. 30, 1998, and applicable only to any civil action filed or proceeding before the United States Patent and Trademark Office commenced on or after such date relating to the registration of a mark, see section 301(b) of Pub. L. 105–330, set out as a note under section 1053 of this title.

Effective Date of 1994 Amendment

Effective Date of 1993 Amendment
Pub. L. 103–182, title III, §335, Dec. 8, 1993, 107 Stat. 2116, provided that:

‘‘(a) In General.—Subject to subsections (b) and (c), the amendments made by this subtitle [subtitle C (§§331–335) of title III of Pub. L. 103–182, enacting section 104A of Title 17, Copyrights, amending this section, section 1061 of this title, and section 104 of Title 35, Patents, and amending provisions set out as a note under section 109 of Title 17] take effect on the date the Agreement [North American Free Trade Agreement] enters into force with respect to the United States [Jan. 1, 1994].’’

(b) Section 331.—The amendments made by section 331 [amending section 104 of Title 35] shall apply to all patent applications that are filed on or after the date of the enactment of this Act [Dec. 8, 1993]; Provided, That an applicant for a patent, or a patentee, may not establish a date of invention by reference to knowledge or use thereof, or other activity with respect thereto, in a NAFTA country, except as provided in sections 119 and 365 of title 35, United States Code, that is earlier than the date of the enactment of this Act.

(c) Section 333.—The amendments made by section 333 [amending this section and section 1091 of this title] shall apply only to trademark applications filed on or after the date of the enactment of this Act.’’

Effective Date of 1988 Amendment
Amendment by Pub. L. 100–667 effective one year after Nov. 16, 1988, see section 136 of Pub. L. 100–667, set out as a note under section 1051 of this title.

Effective Date of 1975 Amendment

Repeal and Effect on Existing Rights
Repeal of inconsistent provisions, effect of this chapter on pending proceedings and existing registrations and rights under prior acts, see notes set out under section 1051 of this title.

Transfer of Functions
For transfer of functions of other officers, employees, and agencies of Department of Commerce to Secretary of Commerce, with certain exceptions, see Reorg. Plan No. 5 of 1950, §§1, 2, eff. May 24, 1950, 15 F.R. 3174, 64 Stat. 1263, set out in the Appendix to Title 5, Government Organization and Employees.

Uruguay Round Agreements: Entry into Force
The Uruguay Round Agreements, including the World Trade Organization Agreement and agreements annexed to that Agreement, as referred to in section 351(d) of Title 19, Customs Duties, entered into force with respect to the United States on Jan. 1, 1995. See note set out under section 3511 of Title 19.

Marks Registered Under Ten-Year Proviso of Trademark Act of 1905
Marks registered under the ‘‘ten-year proviso’’ of section 5 of the act of Feb. 20, 1905, as amended, deemed to have become distinctive of the registrant’s goods in commerce under par. (f) of this section, see section 46(b) of act July 5, 1946, set out in note under section 1053 of this title.

§1053. Service marks registrable
Subject to the provisions relating to the registration of trademarks, so far as they are applicable, service marks shall be registrable, in the same manner and with the same effect as are trademarks, and when registered they shall be entitled to the protection provided in this chapter in the case of trademarks. Applications and procedure under this section shall conform as nearly as practicable to those prescribed for the registration of trademarks.

(Amendments

1988—Pub. L. 100–667 struck out ‘‘used in commerce’’ after ‘‘applicable, service marks’’ and ‘‘, except when used so as to represent falsely that the owner thereof makes or sells the goods on which such mark is used. The Commissioner may establish a separate register for such service marks’’ after ‘‘case of trade-marks’’.

Effective Date of 1988 Amendment
Amendment by Pub. L. 100–667 effective one year after Nov. 16, 1988, see section 136 of Pub. L. 100–667, set out as a note under section 1051 of this title.
§ 1054. Collective marks and certification marks registrable

Subject to the provisions relating to the registration of trademarks, so far as they are applicable, collective and certification marks, including indications of regional origin, shall be registrable under this chapter, in the same manner and with the same effect as are trademarks, by persons, and nations, States, municipalities, and the like, exercising legitimate control over the use of the marks sought to be registered, even though not possessing an industrial or commercial establishment, and when registered they shall be entitled to the protection provided in this chapter in the case of trademarks, except in the case of certification marks when used so as to represent falsely that the owner or a user thereof makes or sells the goods or performs the services on or in connection with which such mark is used. Applications and procedure under this section shall conform as nearly as practicable to those prescribed for the registration of trademarks.


Prior Provisions


Amendments

1999—Pub. L. 106–43 substituted “‘trademarks’ for ‘‘marks wherever appearing.”

1988—Pub. L. 100–667 substituted “‘origin,”’ for “‘origin used in commerce,”’ and “‘except in the case of certification marks when’’ for “‘except when’” and struck out after first sentence “‘The Commissioner may establish a separate register for such collective marks and certification marks.’’

Effective Date of 1988 Amendment

Amendment by Pub. L. 100–667 effective one year after Nov. 16, 1988, see section 136 of Pub. L. 100–667, set out as a note under section 1601 of this title.

§ 1055. Use by related companies affecting validity and registration

Where a registered mark or a mark sought to be registered is or may be used legitimately by related companies, such use shall inure to the benefit of the registrant or applicant for registration, and such use shall not affect the validity of such mark or of its registration, provided such mark is not used in such manner as to deceive the public. If first use of a mark by a person is controlled by the registrant or applicant for registration of the mark with respect to the nature and quality of the goods or services, such first use shall inure to the benefit of the registrant or applicant, as the case may be.


Amendments

1988—Pub. L. 100–667 inserted at end “‘If first use of a mark by a person is controlled by the registrant or applicant for registration of the mark with respect to the nature and quality of the goods or services, such first use shall inure to the benefit of the registrant or applicant, as the case may be.’”

Effective Date of 1988 Amendment

Amendment by Pub. L. 100–667 effective one year after Nov. 16, 1988, see section 136 of Pub. L. 100–667, set out as a note under section 1601 of this title.

Repeal and Effect on Existing Rights

Repeal of inconsistent provisions, effect of this chapter on pending proceedings and existing registrations and rights under prior acts, see notes set out under section 1601 of this title.

§ 1056. Disclaimer of unregistrable matter

(a) Compulsory and voluntary disclaimers

The Director may require the applicant to disclaim an unregistrable component of a mark otherwise registrable. An applicant may voluntarily disclaim a component of a mark sought to be registered.

(b) Prejudice of rights

No disclaimer, including those made under subsection (e) of section 1057 of this title, shall prejudice or affect the applicant’s or registrant’s rights then existing or thereafter arising in the disclaimer matter, or his right of registration on another application if the disclaimer matter be or shall have become distinctive of his goods or services.


Amendments


1988—Subsec. (b). Pub. L. 100–667 substituted “‘subsection (e)” for “‘paragraph (d).”

Repeal and Effect on Existing Rights

Repeal of inconsistent provisions, effect of this chapter on pending proceedings and existing registrations and rights under prior acts, see notes set out under section 1601 of this title.
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 112(d) of this title 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, 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.

 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.

(Prior Provisions)

Subsecs. (a) and (c) are from acts Feb. 20, 1905, ch. 592, §11, 33 Stat. 727; Mar. 4, 1925, ch. 535, §3, 43 Stat. 1269. Subsec. (e) is from act Mar. 19, 1920, ch. 104, §7, 41 Stat. 535. Subsec. (f) is from act Mar. 4, 1925, ch. 535, §3, 43 Stat. 1269.

Amendments


Subsec. (e). Pub. L. 111–146, §3(a)(1), inserted “United States” before “Patent and Trademark Office” in two places, substituted “owner” for “registrant” in two places, and struck out “or, if said certificate is lost or destroyed, upon a certified copy thereof” after “certificate of registration”.


Subsec. (g). Pub. L. 111–146, §3(a)(4), amended subsec. (g) generally. Prior to amendment, text read as follows: “Whenever a material mistake in a registration, incurred through the fault of the 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 certificate 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 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.”

1999—Subsecs. (a), (d) to (h). Pub. L. 106–113 substituted “Director” for “Commissioner” wherever appearing.


1988—Subsec. (b). Pub. L. 100–667, §109(1), amended subsec. (b) generally. Prior to amendment, subsec. (b) read as follows: “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 registration, registrant’s ownership of the mark, and of registrant’s exclusive right to use the mark in commerce in connection with the goods or services specified in the certificate, subject to any conditions and limitations stated therein.”


Subsec. (d). Pub. L. 100–667, §109(2), (4), redesignated former subsec. (c) as (d) and substituted “prescribed fee” for “fee herein provided”. Former subsec. (d) redesignated (e).

Subsec. (e). Pub. L. 100–667, §109(2), redesignated former subsec. (d) as (e). Former subsec. (e) redesignated (f).

Subsec. (f). Pub. L. 100–667, §109(2), redesignated former subsec. (e) as (f) and substituted “prescribed fee” for “fee required by law”. Former subsec. (f) redesignated (g).

Subsec. (g). Pub. L. 100–667, §109(2), redesignated former subsec. (f) as (g). Former subsec. (g) redesignated (h).

Subsec. (h). Pub. L. 100–667, §109(2), (6), redesignated former subsec. (g) as (h) and substituted “prescribed fee” for “required fee”.

1975—Subsecs. (a), (c) to (f). Pub. L. 93–596 substituted “Patent and Trademark Office” for “Patent Office”.

1962—Subsec. (a). Pub. L. 87–772 substituted “signature placed” for “name printed”, and struck out provisions requiring an attestation by an assistant commissioner or by one of the law examiners designated by the Commissioner, together with printed copies of the drawing and statement of the applicant, to be kept in books for that purpose.

Subsec. (d). Pub. L. 87–772, among other changes, removed the requirement of a fee in connection with the voluntary surrender or cancellation of a registration.

Subsec. (e). Pub. L. 87–772 substituted “an employee of the Office” for “a chief of division”, among other changes.

Subsec. (f). Pub. L. 87–772, among other changes, struck out “-signed by the Commissioner and sealed with the seal of the Patent Office” after “nature of such mistake”.

1950—Subsec. (a). Act Aug. 17, 1950, made it unnecessary to include in the certificate a statement of the applicant.

Effective date of 1999 Amendment

Amendment by Pub. L. 106–113 effective 4 months after Nov. 29, 1999, see section 1000(a)(9) [title IV, §4731] of Pub. L. 106–113, set out as a note under Title 43, Patents.

Effective date of 1998 Amendment

Amendment by Pub. L. 105–330 effective Oct. 30, 1998, and applicable only to any civil action filed or proceeding before the United States Patent and Trademark Office commenced on or after such date relating to the registration of a mark, see section 201(b) of Pub. L. 105–330, set out as a note under section 1051 of this title.

Effective date of 1988 Amendment

Amendment by Pub. L. 100–667 effective one year after Nov. 16, 1988, see section 136 of Pub. L. 100–667, set out as a note under section 1051 of this title.

Effective date of 1975 Amendment


Repeal and Effect on Existing Rights

Repeal of inconsistent provisions, effect of this chapter on pending proceedings and existing registrations
and rights under prior acts, see notes set out under section 1651 of this title.

Transfer of Functions

For transfer of functions of other officers, employees, and agencies of Department of Commerce, with certain exceptions, to Secretary of Commerce, with power to delegate, see Reorg. Plan No. 5 of 1950, §§ 1, 2, eff. May 24, 1950, 15 F.R. 3174, 64 Stat. 1283, set out in the Appendix to Title 5, Government Organization and Employees.

§ 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 10 years following the date of registration, and each successive 10-year period following the date of registration.

(2) The owner may file the affidavit required under this section within the 6-month grace period immediately following the expiration of the periods established in paragraphs (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) shall—

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

(B) set forth the goods and 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 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 shall 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 registration and notice of publication under section 1062(c) of this title.

(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 any notices or process in proceedings affecting the mark may be served. Such notices or process shall be served by the Director on the person so designated by leaving with that person or mailing to that person a copy of the notice or process 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, the owner may designate, by a document filed in the Patent and Trademark Office, the name and address of a person resident in the United States on whom any notices or process in proceedings affecting the mark, such notices or process may be served on the Director.

Amendments

2010–Pub. L. 111–146 amended section generally. Prior to amendment, section related to duration of registrations, affidavits of continuing use, grace period for submissions and correction of deficiencies, certain notice requirements related to affidavits, and designation of resident for service of process and notices.

2002–Subsec. (f). Pub. L. 107–273 amended subsec. (f) generally. Prior to amendment, text read as follows: ‘‘If the registrant is not domiciled in the United States, the registrant shall designate by a written document filed in the Patent and Trademark Office the name and address of some 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.’’

1999–Subsecs. (a) to (c). Pub. L. 106–113, §1000(a)(9) [title IV, §4732(b)(1)(B)], substituted ‘‘Director’’ for ‘‘Commissioner’’ wherever appearing.
§ 1059. Renewal of registration

(a) Period of renewal; time for renewal

Subject to the provisions of section 1058 of this title, each registration may be renewed for periods of 10 years at the end of each successive 10-year period following the date of registration upon payment of the prescribed fee and the filing of a written application, in such form as may be prescribed by the Director. Such application may be made at any time within 1 year before the end of each successive 10-year period for which the registration was issued or renewed, or it may be made within a grace period of 6 months after the end of each successive 10-year period, upon payment of a fee and surcharge prescribed therefor. If any application filed under this section is deficient, the deficiency may be corrected within the time prescribed after notification of the deficiency, upon payment of a surcharge prescribed therefor.

(b) Notification of refusal of renewal

If the Director refuses to renew the registration, the Director shall notify the registrant of the Commissioner’s refusal and the reasons therefor.

(c) Designation of resident for service of process and notices

If the registrant is not domiciled in the United States the registrant 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

\[\text{\textsuperscript{1}So in original. Probably should be "Director's".}\]
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 address given in the last designation, or if the registrant 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.


PRIORITY PROVIDENCES

AMENDMENTS
2002—Subsec. (c). Pub. L. 107–273 amended subsec. (c) generally. Prior to amendment, text read as follows: “If the registrant is not domiciled in the United States, the registrant shall designate by a written document filed in the Patent and Trademark Office the name and address of some 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 a copy thereof at the address specified in the last designation so filed. If the person so designated cannot be found at the address given in the last designation, such notice or process may be served upon the Director.”


Subsec. (b). Pub. L. 106–113, §1000(a)(9) [title IV, §4732(b)(1)(B), (C)], amended subsec. (b) identically, substituting “Director” for “Commissioner” in two places.

Subsec. (c). Pub. L. 106–113, §1000(a)(9) [title IV, §4732(b)(1)(B)], substituted “Director” for “Commissioner”.

1998—Pub. L. 105–330 amended section catchline and text generally. Prior to amendment, text consisted of subsecs. (a) to (c) relating to period of renewal and time for renewal, notification of refusal of renewal, and applicants for renewal not domiciled in the United States.


Subsec. (c). Pub. L. 100–667, §111(2), substituted “1051(e)” for “1051(d)”.

1962—Pub. L. 87–772 designated existing provisions as subsecs. (a) and (c), added subsec. (b), and among other changes, amended subsec. (a) by substituting provisions requiring a verified application specifying the goods or services recited in the registration or in connection with which the mark is still in use in commerce and having attached a specimen showing current use of the mark, or showing that any nonuse is due to special circumstances which excuse the nonuse and that it’s not due to an intention to abandon the mark, for provisions requiring an affidavit by the registrant stating that the mark is still in use in commerce.

EFFECTIVE DATE OF 1998 AMENDMENT

For provisions relating to applicability of amendment by Pub. L. 105–330 to applications for registration of trademarks, see section 109(b) of Pub. L. 105–330, set out as a note under section 1051 of this title.

Pub. L. 105–330, title I, §109(d), Oct. 30, 1998, 112 Stat. 3069, provided that: “The amendment made by section 106 (amending this section) shall apply to the filing of an application for renewal of a registration if the expiration date of the registration for which the renewal application is filed is on or after the effective date of this Act [probably should be “this title”, see section 110 of Pub. L. 105–330, set out as an Effective Date of 1998 Amendment note under section 1051 of this title].”

EFFECTIVE DATE OF 1988 AMENDMENT
Amendment by Pub. L. 100–667 effective one year after Nov. 16, 1988, see section 136 of Pub. L. 100–667, set out as a note under section 1051 of this title.

REPEAL AND EFFECT ON EXISTING RIGHTS
Repeal of inconsistent provisions, effect of this chapter on pending proceedings and existing registrations and rights under prior acts, see notes set out under section 1051 of this title.

RENEWAL UNDER PRIOR ACTS
Renewal of registrations under prior acts, see section 46(b) of act July 5, 1946, set out as a note under section 1051 of this title.

EXTENSION OF TIME FOR RENEWAL BY FOREIGN REGISTRANT
Act July 17, 1946, ch. 587, 60 Stat. 568, provided for extension of time for renewal by a foreign registrant and expired by its own terms July 17, 1949.

§ 1060. Assignment

(a)(1) A registered mark or a mark for which an application to register has been filed shall be assignable with the good will of the business in which the mark is used, or with that part of the good will of the business connected with the use of and symbolized by the mark. Notwithstanding the preceding sentence, no application to register a mark under section 1051(b) of this title shall be assignable prior to the filing of an amendment under section 1051(c) of this title to bring the application into conformity with section 1051(a) of this title or the filing of the verified statement of use under section 1051(d) of this title, except for an assignment to a successor to the business of the applicant, or portion thereof, to which the mark pertains, if that business is ongoing and existing.

(2) In any assignment authorized by this section, it shall not be necessary to include the good will of the business connected with the use of and symbolized by any other mark used in the business or by the name or style under which the business is ongoing and existing.

(3) Assignments shall be by instruments in writing duly executed. Acknowledgment shall be prima facie evidence of the execution of an assignment, and when the prescribed information reporting the assignment is recorded in the United States Patent and Trademark Office, the record shall be prima facie evidence of execution.

(4) An assignment shall be void against any subsequent purchaser for valuable consideration.
without notice, unless the prescribed information reporting the assignment is recorded in the United States Patent and Trademark Office within 3 months after the date of the assignment or prior to the subsequent purchase.

(3) The United States Patent and Trademark Office shall maintain a record of information on assignments, in such form as may be prescribed by the Director.

(b) An assignee not domiciled in the United States 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 address given in the last designation, or if the assignee 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 upon the Director.


PRIOR PROVISIONS


AMENDMENTS

2002—Subsecs. (a), (b), Pub. L. 107–273 amended amended subsec. (a) and (b) generally, in subsec. (a) substituting pars. (1) to (5) for substantially identical undesignated provisions, and in subsec. (b) adding provisions relating to service on Director if assignee does not designate name and address of a person resident in the United States on whom may be served notices or process.


1996—Pub. L. 104–41, §6(a)(1), which directed the amendment of the penultimate sentence of this section by substituting “assignment” for “subsequent purchase,” was executed by making the substitution for “subsequent purchase” in two places in the penultimate sentence of subsec. (a), after “date of the” and “prior to the”, to reflect the probable intent of Congress.


1988—Pub. L. 100–667 amended section catchline and text generally. Prior to amendment, text read as follows:

"A registered mark or a mark for which application to register has been filed shall be assignible with the goodwill of the business in which the mark is used, or with that part of the goodwill of the business connected with the use of and symbolized by the mark. However, no application to register a mark under section 1051(b) of this title shall be assignible prior to the filing of the verified statement of use under section 1051(d) of this title, except to a successor to the business of the applicant, or portion thereof, to which the mark pertains. If that business is ongoing and existing. In any assignment authorized by this section it shall not be necessary to include the goodwill of the business connected with the use of and symbolized by any other mark used in the business or by the name or style under which the business is conducted. Assignments shall be by instruments in writing duly executed. Acknowledgment shall be prima facie evidence of the execution of an assignment and when recorded in the Patent and Trademark Office the record shall be prima facie evidence of execution. An assignment shall be void as against any subsequent purchaser for a valuable consideration without notice, unless it is recorded in the Patent and Trademark Office within three months after the date thereof or prior to such subsequent purchase. A separate record of assignments submitted for recording hereunder shall be maintained in the Patent and Trademark Office.

"An assignee not domiciled in the United States shall be subject to and comply with the provisions of section 1051(e) of this title."

1982—Pub. L. 97–45 added “(b)” and inserted subsec. (b). However, no application to register a mark under section 1051(b) of this title shall be assignible prior to the filing of the verified statement of use under section 1051(d) of this title, except to a successor to the business of the applicant, or portion thereof, to which the mark pertains. If that business is ongoing and existing. In any assignment authorized by this section for “and in any such assignment” in first par., and “1051(e)” for “1051(d)” in last par.


1962—Pub. L. 87–772 substituted provisions which require a separate record of assignments to be kept in the Patent Office, for provisions which required the Commissioner to keep such record, and eliminated provisions permitting the cancellation of any assigned registration at any time if the registered mark is being used by, or with the permission of, the assignee so as to misrepresent the source of the goods or services in connection with which the mark is used.

EFFECTIVE DATE OF 1999 AMENDMENT

Amendment by Pub. L. 106–113 effective 4 months after Nov. 29, 1999, see section 1090(a)(9) [title IV, §4733] of Pub. L. 106–113, set out as a note under section 1 of Title 33, Patents.

EFFECTIVE DATE OF 1998 AMENDMENT


For provisions relating to applicability of amendment by Pub. L. 105–330 to applications for registration of trademarks, see section 1090(a)(9) of Pub. L. 105–330, set out as a note under section 1051 of this title.

EFFECTIVE DATE OF 1988 AMENDMENT

Amendment by Pub. L. 100–667 effective one year after Nov. 16, 1988, see section 136 of Pub. L. 100–667, set out as a note under section 1051 of this title.

EFFECTIVE DATE OF 1975 AMENDMENT


REPEAL AND EFFECT ON EXISTING RIGHTS

Repeal of inconsistent provisions, effect of this chapter on pending proceedings and existing registrations.
and rights under prior acts, see notes set out under section 1061 of this title.

Transfer of Functions

For transfer of functions of other officers, employees, and agencies of Department of Commerce, with certain exceptions, to Secretary of Commerce, with power to delegate, see Reorg. Plan No. 3 of 1950, §§1, 2, eff. May 24, 1950, 15 F.R. 3174, 64 Stat. 983; set out in the Appendix to Title 5, Government Organization and Employees.

§1061. Execution of acknowledgments and verifications

Acknowledgments and verifications required under this chapter may be made before any person within the United States authorized by law to administer oaths, or, when made in a foreign country, before any diplomatic or consular officer of the United States or before any official authorized to administer oaths in the foreign country concerned whose authority is proved by a certificate of a diplomatic or consular officer of the United States, or apostille of an official designated by a foreign country which, by treaty or convention, accords like effect to apostilles of designated officials in the United States, and shall be valid if they comply with the laws of the state or country where made.


Prior Provisions


Amendments

1982—Pub. L. 97–247 substituted “is” for “shall be” after “whose authority”, and inserted “, or apostille of an official designated by a foreign country which, by treaty or convention, accords like effect to apostilles of designated officials in the United States”.

Effective Date of 1982 Amendment


Repeal and Effect on Existing Rights

Repeal of inconsistent provisions, effect of this chapter on pending proceedings and existing registrations and rights under prior acts, see notes set out under section 1061 of this title.

§1062. Publication

(a) Examination and publication

Upon the filing of an application for registration and payment of the prescribed fee, the Director shall refer the application to the examiner in charge of the registration of marks, who shall cause an examination to be made and, if on such examination it shall appear that the applicant is entitled to registration, or would be entitled to registration upon the acceptance of the statement of use required by section 1051(d) of this title, the Director shall cause the mark to be published in the Official Gazette of the Patent and Trademark Office: Provided, That in the case of an applicant claiming concurrent use, or in the case of an application to be placed in an interference as provided for in section 1066 of this title the mark, if otherwise registrable, may be published subject to the determination of the rights of the parties to such proceedings.

(b) Refusal of registration; amendment of application; abandonment

If the applicant is found not entitled to registration, the examiner shall advise the applicant thereof and of the reasons therefor. The applicant shall have a period of six months in which to reply or amend his application, which shall then be reexamined. This procedure may be repeated until (1) the examiner finally refuses registration of the mark or (2) the applicant fails for a period of six months to reply or amend or appeal, whereupon the application shall be deemed to have been abandoned, unless it can be shown to the satisfaction of the Director that the delay in responding was unintentional, whereupon such time may be extended.

(c) Republication of marks registered under prior acts

A registrant of a mark registered under the provisions of the Act of March 3, 1881, or the Act of February 20, 1905, may, at any time prior to the expiration of the registration thereof, upon the payment of the prescribed fee file with the Director an affidavit setting forth those goods stated in the registration on which said mark is in use in commerce and that the registrant claims the benefits of this chapter for said mark. The Director shall publish notice thereof with a reproduction of said mark in the Official Gazette, and notify the registrant of such publication and of the requirement for the affidavit of use or nonuse as provided for in subsection (b) of section 1058 of this title. Marks published under this subsection shall not be subject to the provisions of section 1063 of this title.


References in Text


Prior Provisions


Amendments


1989—Subsec. (a). Pub. L. 100–667 substituted “prescribed fee” for “fee herein provided”, and “entitled to registration, or would be entitled to registration upon the acceptance of the statement of use required by section 1051(d) of this title, the” for “entitled to registration, the”.


1950—Subsec. (b). Pub. L. 95–308 struck out “or” before “and, if”.
§ 1063. Opposition to registration

(a) Any person who believes that he would be damaged by the registration of a mark upon the principal register, including the registration of any mark which would be likely to cause dilution by blurring or dilution by tarnishment under section 1125(c) of this title, may, upon payment of the prescribed fee, file an opposition in the Patent and Trademark Office, stating the grounds therefor, within thirty days after the publication under subsection (a) of section 1062 of this title of the mark sought to be registered. Upon written request prior to the expiration of the thirty-day period, the time for filing opposition shall be extended for an additional thirty days, and further extensions of time for filing opposition may be granted by the Director for good cause when requested prior to the expiration of an extension. The Director shall notify the applicant of each extension of the time for filing opposition. An opposition may be amended under such conditions as may be prescribed by the Director.

(b) Unless registration is successfully opposed—

(1) a mark entitled to registration on the principal register based on an application filed under section 1051(a) of this title or pursuant to section 1126 of this title shall be registered in the Patent and Trademark Office, a certificate of registration shall be issued, and notice of the registration shall be published in the Official Gazette of the Patent and Trademark Office; or

(2) a notice of allowance shall be issued to the applicant if the applicant applied for registration under section 1051(b) of this title.

(3) under section 4 of Pub. L. 93–596, set out as a note under section 1051 of this title.


Prior Provisions


Amendments

2006—Subsec. (a). Pub. L. 109–312 substituted “the registration of any mark which would be likely to cause dilution by blurring or dilution by tarnishment” for “as a result of dilution”.


1998—Pub. L. 100–667 designated existing provisions as subsec. (a), substituted “prescribed fee” for “required fee”, and added subsec. (b).

1995—Pub. L. 104–339 substituted “an” for “a verified” after “required fee, file”, inserted “when requested prior to the expiration of an extension” after “Commissioner for good cause”, and struck out provision that an unverified opposition could be filed by an unregistered attorney, but such opposition would be null and void unless verified by the opposer within a reasonable time after such filing is fixed by the Commissioner.


1986—Pub. L. 99–514 substituted “extension of time for filing opposition” for “time for filing opposition”.

A petition to cancel a registration of a mark, stating the grounds relied upon, may, upon payment of the prescribed fee, be filed as follows by any person who believes that he is or will be damaged, including as a result of a likelihood of dilution by blurring or dilution by tarnishment under section 1125(c) of this title, by the registration of a mark on the principal register established by this chapter, or under the Act of March 3, 1881, or the Act of February 20, 1905:

(1) Within five years from the date of the registration of the mark under this chapter.

(2) Within five years from the date of publication under section 1062(c) of this title of a mark registered under the Act of March 3, 1881, or the Act of February 20, 1905.


REFERENCES IN TEXT
Acts March 3, 1881 and February 20, 1905, referred to in opening par. and pars. (2) and (4), are acts Mar. 3, 1881, ch. 136, 21 Stat. 562 and Feb. 20, 1905, ch. 592, 33 Stat. 724, which were repealed insofar as inconsistent with this chapter by act July 5, 1946, ch. 540, §46(a), 60 Stat. 444. Act Feb. 20, 1905, was classified to sections 81 to 109 of this title.

PRIOR PROVISIONS

AMENDMENTS
2006—Pub. L. 109-312 substituted “, including as a result of a likelihood of dilution by blurring or dilution by tarnishment under section 1125(c) of this title,” for “, including as a result of dilution under section 1125(c) of this title,” in introductory provisions.
1999—Pub. L. 106-43 inserted “, including as a result of dilution under section 1125(c) of this title,” after “damaged” in introductory provisions.
1998—Pub. L. 105-330, §301, inserted at end “Nothing in paragraph (5) shall be deemed to prohibit the registrant from using its certification mark in advertising...
or promoting recognition of the certification program or of the goods or services meeting the certification standards of the registrant. Such uses of the certification mark shall not be grounds for cancellation under paragraph (5), so long as the registrant does not itself produce, manufacture, or sell any of the certified goods or services to which its identical certification mark is applied.”

Par. (3). Pub. L. 105–330, §201(a)(4), inserted “or is functional,” before “or has been abandoned”.

[...]

Amendment by Pub. L. 100–667 effective one year after Nov. 16, 1988, see section 136 of Pub. L. 100–667, set out as a note under section 1051 of this title.

Effective Date of 1982 Amendment
Amendment by Pub. L. 97–247 effective six months after Aug. 27, 1982, see section 17(c) of Pub. L. 97–247, set out as a note under section 294 of Title 35, Patents.

Finality of Judgments Prior to November 8, 1984
Pub. L. 98–620, title I, §104, Nov. 8, 1984, 98 Stat. 3336, provided that: “Nothing in this title [amending this section and section 1127 of this title and enacting provisions set out as a note under section 1051 of this title] shall be construed to provide a basis for reopening of any final judgment entered prior to the date of enactment of this title [Nov. 8, 1984].”

Repeal and Effect on Existing Rights
Repeal of inconsistent provisions, effect of this chapter on pending proceedings and existing registrations and rights under prior acts, see notes set out under section 1051 of this title.

Transfer of Functions
For transfer of functions of Federal Trade Commission, with certain exceptions, to Chairman of such Commission, see Reorg. Plan No. 8 of 1950, §1, eff. May 24, 1950, 15 F.R. 8175, 64 Stat. 1264, set out under section 41 of this title.

Restriction on Use of Funds to Cancel
Registration of Trademarks
For provisions restricting the use of funds authorized to be appropriated to carry out section 41 et seq. of this title for fiscal year 1980, 1981, or 1982, for the purpose of taking any action under this section with respect to the cancellation of the registration of any mark on the ground that such mark has become the common descriptive name of an article or substance, see section 18 of Pub. L. 96–252, set out as a note under section 57c of this title.

§1065. Incontestability of right to use mark under certain conditions

Except on a ground for which application to cancel may be filed at any time 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 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 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 registrant who files the above-prescribed affidavit of the filing thereof.

(75, 1946, ch. 540, § 46(a), 60 Stat. 444. Act Feb. 20, 1905, was repealed on March 3, 1881 and February 20, 1905, referred to in text, are acts Mar. 3, 1881, ch. 129, 21 Stat. 502 and Feb. 20, 1905, ch. 592, 33 Stat. 724, which were repealed insofar as inconsistent with this chapter by act July 5, 1946, ch. 540, § 46(a), 60 Stat. 444. Act Feb. 20, 1905, was classified to sections 81 to 89 of this title.

AMENDMENTS

2010—Pub. L. 111–146, § 3(b)(1), substituted “right of the owner” for “right of the registrant” in introductory provisions.

Par. (1), Pub. L. 111–146, § 3(b)(2), amended par. (1) generally. Prior to amendment, par. (1) read as follows: “there has been no final decision adverse to registrant’s claim of ownership of such mark for such goods or services, or to registrant’s right to register the same or to keep the same on the register; and”.

Par. (2), Pub. L. 111–146, § 3(b)(3), inserted “United States” before “Patent and Trademark Office”.

1999—Pub. L. 106–113 substituted “Director” for “Commissioner” in par. (3) and in two places in concluding provisions.

1989—Pub. L. 100–667, in introductory provisions, substituted “paragraphs (5) and (6)’” for “subsections (c) and (e)’, in par. (3) ‘paragraphs for ‘subsections’, and in par. (4) ‘the generic name for the goods or services or a portion thereof, for which it is registered’ for ‘the common descriptive name of any article or substance, patented or otherwise’.


1962—Pub. L. 87–772 substituted “(c) and (d)” and “section 1064” for “(c)” and “section 1063” in provision preceding par. (1), and struck out “or trade name” after “in a mark” in par. (4).
a mark which so resembles a mark previously registered by another, or for the registration of which an other has previously made application, as to be likely to mislead to the goods or when used in connection with the services of the applicant to cause confusion or mistake or to deceive, the Commissioner may declare that an interference exists’’.

Effective Date of 1999 Amendment
Amendment by Pub. L. 106–113 effective 4 months after Nov. 29, 1999, see section 1000(a)(9) [title IV, § 4716] of Pub. L. 106–113, set out as a note under section 1 of Title 35, Patents.

Effective Date of 1988 Amendment
Amendment by Pub. L. 100–667 effective one year after Nov. 16, 1988, see section 136 of Pub. L. 100–667, set out as a note under section 1503 of this title.

Repeal and Effect on Existing Rights
Repeal of inconsistent provisions, effect of this chapter on pending proceedings and existing registrations and rights under prior acts, see notes set out under section 1051 of this title.

Transfer of Functions
For transfer of functions of other officers, employees, and agencies of Department of Commerce, with certain exceptions, to Secretary of Commerce, with power to delegate, see Reorg. Plan No. 5 of 1956, §§1, 2, eff. May 24, 1956, 15 F.R. 8174, 64 Stat. 1263, set out in the Appendix to Title 5, Government Organization and Employees.

§ 1067. Interference, opposition, and proceedings for concurrent use registration or for cancellation; notice; Trademark Trial and Appeal Board

(a) In every case of interference, opposition to registration, application to register as a lawful concurrent user, or application to cancel the registration of a mark, the Director shall give notice to all parties and shall direct a Trademark Trial and Appeal Board to determine and decide the respective rights of registration.

(b) The Trademark Trial and Appeal Board shall include the Director, Deputy 1 Director of the United States Patent and Trademark Office 2 the Commissioner for Patents, the Commissioner for Trademarks, and administrative trademark judges who are appointed by the Secretary of Commerce, in consultation with the Director.

(c) Authority of the Secretary.—The Secretary of Commerce may, in his or her discretion, deem the appointment of an administrative trademark judge who, before August 12, 2008, held office pursuant to an appointment by the Director to take effect on the date on which the Director initially appointed the administrative trademark judge.

(d) Defense to Challenge of Appointment.—It shall be a defense to a challenge to the appointment of an administrative trademark judge

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1 So in original. Probably should be preceded by “the”.
2 So in original. Probably should be followed by a comma.
become effective on the date of its enactment [Oct. 15, 1980]. Members of the Trademark Trial and Appeal Board on the date of enactment shall continue to be members under and in accordance with the provisions of section 17 of the Act of July 5, 1946, as amended [this section], in effect immediately preceding the date of enactment."

**Effective Date of 1975 Amendment**

**Effective Date of 1958 Amendment**
Pub. L. 85–609, § 3, Aug. 8, 1958, 72 Stat. 541, provided that: "This Act [amending this section and sections 1051, 1069, and 1113 of this title] shall take effect on approval [Aug. 8, 1958]; it shall apply to ex parte appeals taken to the Commissioner prior to the date of approval which have not been heard and shall not apply to any such appeal which has been heard or decided in which event further proceedings may be had as though this Act had not been passed; it shall apply to inter partes cases instituted prior to the date of approval which have not been heard by an examiner of interferences, but shall not apply to any such case which has been heard or decided by an examiner of interferences in which event further proceedings may be had as though this Act had not passed."
§ 1070. Appeals to Trademark Trial and Appeal Board from decisions of examiners

An appeal may be taken to the Trademark Trial and Appeal Board from any final decision of the examiner in charge of the registration of marks upon the payment of the prescribed fee.

 PRIOR PROVISIONS

AMENDMENTS
1958—Pub. L. 85–609 substituted “Trademark Trial and Appeal Board” for “Commissioner in person” and “fee” for “fees”, and struck out “of interferences or” after “examiner in charge”.

EFFECTIVE DATE OF 1958 AMENDMENT
For effective date and applicability of amendment by Pub. L. 85–609, see section 3 of Pub. L. 85–609, set out as a note under section 1057 of this title.

§ 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 of this title or section 1141k of this title, 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.

§ 1070. Appeals to Trademark Trial and Appeal Board from decisions of examiners

An appeal may be taken to the Trademark Trial and Appeal Board from any final decision of the examiner in charge of the registration of marks upon the payment of the prescribed fee.

 PRIOR PROVISIONS

AMENDMENTS
1958—Pub. L. 85–609 substituted “Trademark Trial and Appeal Board” for “Commissioner in person” and “fee” for “fees”, and struck out “of interferences or” after “examiner in charge”.

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§ 1071. Appeal to courts

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(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 the 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) of this title before the mark is registered, if such applicant cannot prevail without establishing constructive use pursuant to section 1057(c) of this title.

(b) Civil action; persons entitled to; jurisdiction of court; status of Director; procedure

(1) Whenever a person entitled to 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) of this title before the mark is registered, if such applicant cannot prevail without establishing constructive use pursuant to section 1057(c) of this title.

(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 Court of Appeals for the Federal Circuit. Any adverse party residing in foreign countries may be served by publication or otherwise as the court directs.

(5) 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) of this title before the mark is registered, if such applicant cannot prevail without establishing constructive use pursuant to section 1057(c) of this title.

(6) 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.

(7) 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.

(8) 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 Eastern District of Virginia 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.


CODIFICATION

Pub. L. 93–596, which provided for the substitution of “Patent and Trademark Office” for “Patent Office” each time appearing in this chapter, became effective Jan. 2, 1975, as did Pub. L. 93–600, which in the course of amending subsec. (a)(3) and (4) of this section, re-
its mandate and opinion to the Commissioner for provisions which required the court to decide such appeal on the evidence produced before the Patent and Trademark Office and to return to the Commissioner a certificate of its proceedings and decision.


1975—Subsec. (a)(2). Pub. L. 93-600 substituted provisions relating to filing of notice of appeal with the Commissioner and the contents of such notice of appeal, for provisions relating to giving notice of appeal to the Commissioner and requiring filing in the Patent Office reasons for appeal.

Subsec. (a)(3). Pub. L. 93-600 inserted provision requiring the Commissioner to furnish the court with a brief explaining the grounds of the decision of the Office.


Subsec. (a)(4). Pub. L. 93-600 substituted "decide" for "hear and determine" and struck out "Upon its determination," before "the court shall return" and provision requiring the decision to be confined to the points set forth in the reasons of appeal.


1982—Pub. L. 97-772 amended section generally, and among other changes, incorporated with necessary changes in language, the various provisions of Title 35, Patents, relating to the procedure of appeals to the Court of Customs and Patent Appeals and review by civil action in patent cases, which had previously been incorporated by reference only.

1988—Pub. L. 100-667 authorized appeals by persons dissatisfied with the decision of the Trademark Trial and Appeal Board, and substituted "Trademark Trial and Appeal Board" for "Commission" in proviso.


EFFECTIVE DATE OF 2011 AMENDMENT

Pub. L. 112-29, § 9(b), Sept. 16, 2011, 125 Stat. 316, provided that: "The amendments made by this section [amending this section and sections 32, 145, 146, 154, and 293 of Title 35, Patents] shall take effect on the date of the enactment of this Act [Sept. 16, 2011] and shall apply to any civil action commenced on or after that date."

EFFECTIVE DATE OF 1999 AMENDMENT


EFFECTIVE DATE OF 1988 AMENDMENT

Amendment by Pub. L. 100-667 effective one year after Nov. 16, 1988, see section 136 of Pub. L. 100-667, set out as a note under section 1661 of this title.

EFFECTIVE DATE OF 1984 AMENDMENT

Amendment by Pub. L. 98-629 applicable to proceedings pending in the Patent and Trademark Office on Nov. 8, 1984, and to appeals pending in the United States Court of Appeals for the Federal Circuit on that date, see section 414(c) of Pub. L. 98-629, set out as a note under section 412 of Title 35, Patents.

EFFECTIVE DATE OF 1982 AMENDMENT


EFFECTIVE DATE OF 1975 AMENDMENTS

Amendment by Pub. L. 93-600 effective Jan. 2, 1975, but not to affect any suit, proceeding, or appeal then pending, see section 4 of Pub. L. 93-600, set out as a note under section 1063 of this title.


EFFECTIVE DATE OF 1958 AMENDMENT

For effective date and applicability of amendment by Pub. L. 85-609, see section 3 of Pub. L. 85-609, set out as a note under section 1067 of this title.

REPEAL AND EFFECT ON EXISTING RIGHTS

Repeal of inconsistent provisions, effect of this chapter on pending proceedings and existing registrations and rights under prior acts, see notes set out under section 1661 of this title.

TRANSFER OF FUNCTIONS

For transfer of functions of other officers, employees, and agencies of Department of Commerce, with certain exceptions, to Secretary of Commerce, with power to delegate, see Reorg. Plan No. 5 of 1950, §§ 1, 2, eff. May 24, 1950, 15 F.R. 4174, 64 Stat. 1263, set out in the Appendix to Title 5, Government Organization and Employees.

REORGANIZATION PLAN NO. 5 OF 1950

Amendment by Pub. L. 85-609 as subject to Reorganization Plan No. 5 of 1950, see note set out under section 1067 of this title.

§ 1072. Registration as constructive notice of claim of ownership

Registration of a mark on the principal register provided by this chapter or under the Act of March 3, 1881, or the Act of February 20, 1905, shall be constructive notice of the registrant’s claim of ownership thereof.

(July 5, 1946, ch. 540, title I, § 22, 60 Stat. 435.)

REFERENCES IN TEXT


REPEAL AND EFFECT ON EXISTING RIGHTS

Repeal of inconsistent provisions, effect of this chapter on pending proceedings and existing registrations and rights under prior acts, see notes set out under section 1661 of this title.

SUBCHAPTER II—THE SUPPLEMENTAL REGISTER

§ 1091. Supplemental register

(a) Marks registrable

In addition to the principal register, the Director shall keep a continuation of the register provided in paragraph (b) of section 1 of the Act of March 19, 1921, entitled "An Act to give effect to certain provisions of the convention for the protection of trademarks and commercial names, made and signed in the city of Buenos Aires, in the Argentine Republic, August 20, 1910, and for other purposes", to be called the supplemental register. All marks capable of distinguishing applicant’s goods or services and not registrable on the principal register provided in this chapter, except those declared to be unregistrable under subsections (a), (b), (c), (d),
and (e)(3) of section 1052 of this title, which are in lawful use in commerce by the owner thereof, on or in connection with any goods or services may be registered on the supplemental register upon the payment of the prescribed fee and compliance with the provisions of subsections (a) and (e) of section 1051 of this title so far as they are applicable. Nothing in this section shall prevent the registration on the supplemental register of a mark, capable of distinguishing the applicant’s goods or services and not registrable on the principal register under this chapter, that is declared to be unregistrable under section 1052(e)(3) of this title, if such mark has been in lawful use in commerce by the owner thereof, on or in connection with any goods or services, since before December 8, 1993.

(b) Application and proceedings for registration

Upon the filing of an application for registration on the supplemental register and payment of the prescribed fee the Director shall refer the application to the examiner in charge of the registration of marks, who shall cause an examination to be made and if on such examination it shall appear that the applicant is entitled to registration, the registration shall be granted. If the applicant is found not entitled to registration the provisions of subsection (b) of section 1062 of this title shall apply.

(c) Nature of mark

For the purposes of registration on the supplemental register, a mark may consist of any trademark, symbol, label, package, configuration of goods, name, word, slogan, phrase, surname, geographical name, numeral, device, any matter that as a whole is not functional, or any combination of any of the foregoing, but such mark must be capable of distinguishing the applicant’s goods or services.


References in Text

Paragraph (b) of section 1 of the Act of March 19, 1920, referred to in subsec. (a), is paragraph (b) of section 1 of act Mar. 19, 1920, ch. 104, 41 Stat. 533, which was classified to section 121(b) of this title, and repealed by act July 5, 1946, ch. 540, § 46(a), 60 Stat. 450, insofar as inconsistent.

Prior Provisions


Amendments


1998—Subsec. (c). Pub. L. 106–330 substituted “device, any matter that as a whole is not functional,” for “or device”.

1993—Subsec. (a). Pub. L. 103–182 substituted “(d), and (e)(3)” for “and (d)” and inserted at end “Nothing in this section shall prevent the registration on the supplemental register of a mark, capable of distinguishing the applicant’s goods or services and not registrable on the principal register under this chapter, that is declared to be unregistrable under section 1052(e)(3) of this title, if such mark has been in lawful use in commerce by the owner thereof, on or in connection with any goods or services, since before December 8, 1993.”

1966—Pub. L. 100–667, § 121(b), struck out unnumbered concluding paragraph which read as follows: “Upon a proper showing by the applicant that he requires domestic registration as a basis for foreign protection of his mark, the Commissioner may waive the requirement of a full year's use and may grant registration forthwith.”

Subsec. (a). Pub. L. 100–667, § 121(1), (4), designated first par. as subsec. (a), made technical amendment to reference in the original act to subsections (a), (b), (c), and (d) of section 1052 of this title resulting in no change in text, substituted “are in lawful use in commerce by the owner thereof, on” for “have been in lawful use in commerce by the proprietor thereof, upon” struck out “for the year preceding the filing of the application” after “any goods and services”, and inserted “subsections (a) and (e) of” before “section 1051”.

Subsec. (b). Pub. L. 100–667, § 121(2), (3), designated second par. as subsec. (b) and substituted “prescribed fee” for “fee herein provided”.


1962—Pub. L. 87–772 struck out “has begun the lawful use of his mark in foreign commerce and that he” before “requires domestic registration” in last par.

Effective Date of 1999 Amendment

Amendment by Pub. L. 106–113 effective 4 months after Nov. 29, 1999, see section 1000(a)(9) [title IV, § 4731] of Pub. L. 106–113, set out as a note under section 1 of Title 35, Patents.

Effective Date of 1998 Amendment

Amendment by Pub. L. 105–330 effective Oct. 30, 1998, and applicable only to any civil action filed or proceeding before the United States Patent and Trademark Office commenced on or after such date relating to the registration of a mark, see section 201(b) of Pub. L. 105–330, set out as a note under section 1051 of this title.

Effective Date of 1993 Amendment

Amendment by Pub. L. 103–182 applicable only to trademark applications filed on or after Dec. 8, 1993, see section 333(c) of Pub. L. 103–182, set out in a note under section 1052 of this title.

Effective Date of 1988 Amendment

Amendment by Pub. L. 100–667 effective one year after Nov. 16, 1988, see section 136 of Pub. L. 100–667, set out as a note under section 1051 of this title.

Repeal and Effect on Existing Rights

Repeal of inconsistent provisions, effect of this chapter on pending proceedings and existing registrations and rights under prior acts, see notes set out under section 1051 of this title.

Transfer of Functions

For transfer of functions of other officers, employees, and agencies of Department of Commerce, with certain exceptions, to Secretary of Commerce, with power to delegate, see Reorg. Plan No. 5 of 1950, §§ 1, 2, eff. May 27, 1950, 15 F.R. 2744, 64 Stat. 1281, set out in the Appendix to Title 5, Government Organization and Employees.
§ 1092. Publication; not subject to opposition; cancellation

Marks for the supplemental register shall not be published for or be subject to opposition, but shall be published on registration in the Official Gazette of the Patent and Trademark Office. Whenever any person believes that such person is or will be damaged by the registration of a mark on the supplemental register—

(1) for which the effective filing date is after the date on which such person’s mark became famous and which would be likely to cause dilution by blurring or dilution by tarnishment under section 1125(c) of this title; or

(2) on grounds other than dilution by blurring or dilution by tarnishment,

such person may at any time, upon payment of the prescribed fee and the filing of a petition stating the ground therefor, apply to the Director to cancel such registration. The Director shall refer such application to the Trademark Trial and Appeal Board which shall give notice thereof to the registrant. If it is found after a hearing before the Board that the registrant is not entitled to registration, or that the mark has been abandoned, the registration shall be canceled by the Director. However, no final judgment shall be entered in favor of an applicant under section 1051(b) of this title before the mark is registered, if such applicant cannot prevail without establishing constructive use pursuant to section 1057(c) of this title.


Prior Provisions

Amendments
2006—Pub. L. 109–312 amended second sentence generally. Prior to amendment, second sentence read as follows: “Whenever any person believes that he is or will be damaged by the registration of a mark on this register, including as a result of dilution under section 1125(c) of this title, he may at any time, upon payment of the prescribed fee and the filing of a petition stating the ground therefor, apply to the Director to cancel such registration.” The words following “tarnishment,” in second sentence are shown as a flush provision notwithstanding directory language showing them as part of cl. (2), to reflect the probable intent of Congress.

1999—Pub. L. 106–113 substituted “Director” for “Commissioner” wherever appearing. Pub. L. 106–93 inserted “; including as a result of dilution under section 1125(c) of this title,” after “register” in second sentence.

1989—Pub. L. 100–667 struck out “verified” after “filing of a” substituted “is not entitled to registration,” for “was not entitled to register the mark at the time of his application for registration thereof,” struck out “is not used by the registrant or” after “that the mark,” and inserted provision that no final judgment be entered before mark is registered if applicant cannot prevail without establishing constructive use.


1962—Pub. L. 87–772 provided for payment of the prescribed fee and the filing of a verified petition.

1958—Pub. L. 85–609 substituted provisions requiring the Commissioner to refer applications to the Trademark Trial and Appeal Board for provisions which required referral to the examiner in charge of interferences.

Effective Date of 1999 Amendments
Amendment by Pub. L. 106–113 effective 4 months after Nov. 29, 1999, see section 1000(a)(9) [title IV, §4731] of Pub. L. 106–113, set out as a note under section 1 of Title 35, Patents.

Amendment by Pub. L. 106–93 effective Aug. 5, 1999, and applicable only to any application for registration filed on or after Jan. 16, 1996, see section 2(e) of Pub. L. 106–43, set out as a note under section 1052 of this title.

Effective Date of 1988 Amendment
Amendment by Pub. L. 100–667 effective one year after Nov. 16, 1988, see section 136 of Pub. L. 100–667, set out as a note under section 1051 of this title.

Effective Date of 1975 Amendment

Effective Date of 1958 Amendment
For effective date and applicability of amendment by Pub. L. 85–609, see section 3 of Pub. L. 85–609, set out as a note under section 1057 of this title.

Repeal and Effect on Existing Rights
Repeal of inconsistent provisions, effect of this chapter on pending proceedings and existing registrations and rights under prior acts, see notes set out under section 1051 of this title.

Transfer of Functions
For transfer of functions of other officers, employees, and agencies of Department of Commerce, with certain exceptions, to Secretary of Commerce, with power to delegate, see Reorg. Plan No. 5 of 1950, set out in the Appendix to Title 5, Government Organization and Employees.

Reorganization Plan No. 5 of 1950
Amendment by Pub. L. 85–609 as subject to Reorganization Plan No. 5 of 1950, see note set out under section 1057 of this title.

§ 1093. Registration certificates for marks on principal and supplemental registers to be different

The certificates of registration for marks registered on the supplemental register shall be conspicuously different from certificates issued for marks registered on the principal register.


Repeal and Effect on Existing Rights
Repeal of inconsistent provisions, effect of this chapter on pending proceedings and existing registrations and rights under prior acts, see notes set out under section 1051 of this title.

§ 1094. Provisions of chapter applicable to registrations on supplemental register

The provisions of this chapter shall govern so far as applicable for registration and registrations on the supplemental register.
as well as those on the principal register, but applications for and registrations on the supplemental register shall not be subject to or receive the advantages of sections 1051(b), 1052(e), 1052(f), 1057(b), 1057(c), 1062(a), 1063 to 1068, inclusive, 1072, 1115 and 1124 of this title.


PRIOR PROVISIONS


AMENDMENTS


1988—Pub. L. 100–667 inserted reference to sections 1051(b) and 1057(c).

EFFECTIVE DATE OF 1998 AMENDMENT

Amendment by Pub. L. 105–330 effective Oct. 30, 1998, and applicable only to any civil action filed or proceeding before the United States Patent and Trademark Office commenced on or after such date relating to the registration of a mark, see section 201(b) of Pub. L. 105–330, set out as a note under section 1051 of this title.

EFFECTIVE DATE OF 1988 AMENDMENT

Amendment by Pub. L. 100–667 effective one year after Nov. 16, 1988, see section 136 of Pub. L. 100–667, set out as a note under section 1051 of this title.

REPEAL AND EFFECT ON EXISTING RIGHTS

Repeal of inconsistent provisions, effect of this chapter on pending proceedings and existing registrations and rights under prior acts, see notes set out under section 1051 of this title.

§ 1095. Registration on principal register not precluded

Registration of a mark on the supplemental register, or under the Act of March 19, 1920, shall not preclude registration by the registrant on the principal register established by this chapter. Registration of a mark on the supplemental register shall not constitute an admission that the mark has not acquired distinctiveness.


REFERENCES IN TEXT

Act of March 19, 1920, referred to in text, is act Mar. 19, 1920, ch. 104, §§1–9, 41 Stat. 533, which was generally classified to sections 121 to 128 of this title, and which was repealed insofar as inconsistent with this chapter by act July 5, 1946, ch. 540, §46(b), 60 Stat. 444.

1988—Pub. L. 100–667 inserted at end “Registration of a mark on the supplemental register shall not constitute an admission that the mark has not acquired distinctiveness.”

EFFECTIVE DATE OF 1988 AMENDMENT

Amendment by Pub. L. 100–667 effective one year after Nov. 16, 1988, see section 136 of Pub. L. 100–667, set out as a note under section 1051 of this title.

§ 1096. Registration on supplemental register not used to stop importations

Registration on the supplemental register or under the Act of March 19, 1920, shall not be filed in the Department of the Treasury or be used to stop importations.

(July 5, 1946, ch. 540, title II, § 28, 60 Stat. 436.)

REFERENCES IN TEXT

Act of March 19, 1920, referred to in text, is act Mar. 19, 1920, ch. 104, §§1–9, 41 Stat. 533, which was generally classified to sections 121 to 128 of this title, and which was repealed insofar as inconsistent with this chapter by act July 5, 1946, ch. 540, §46(b), 60 Stat. 444.

REPEAL AND EFFECT ON EXISTING RIGHTS

Repeal of inconsistent provisions, effect of this chapter on pending proceedings and existing registrations and rights under prior acts, see notes set out under section 1051 of this title.

SUBCHAPTER III—GENERAL PROVISIONS

§ 1111. Notice of registration; display with mark; recovery of profits and damages in infringement suit

Notwithstanding the provisions of section 1072 of this title, a registrant of a mark registered in the Patent and Trademark Office, may give notice that his mark is registered by displaying with the mark the words “Registered in U.S. Patent and Trademark Office” or “Reg. U.S. Pat. & Tm. Off.” or the letter R enclosed within a circle, thus ®; and in any suit for infringement under this chapter by such a registrant failing to give such notice of registration, no profits and no damages shall be recovered under the provisions of this chapter unless the defendant had actual notice of the registration.


PRIOR PROVISIONS


AMENDMENTS

1962—Pub. L. 87–772 substituted “as used” after “with the mark.”

1957—Pub. L. 93–596 substituted “Patent and Trademark Office, may give notice that his mark is registered by displaying with the mark the words ‘Registered in U.S. Patent and Trademark Office’ or ‘Reg. U.S. Pat. & Tm. Off.’” for “Patent Office, may give notice that his mark is registered by displaying with the mark the words ‘Registered in U.S. Patent Office’ or ‘Reg. U.S. Pat. Off.’.”

1948—Pub. L. 79–667 substituted “in the Patent Office, may” for “under the Act of March 3, 1881, or the Act of February 20, 1905, or on the principal register established by this chapter, shall”, and “to give such notice of registration.” for “so to mark goods bearing the registered mark, or by a registrant under the Act of March 19, 1920, or by the registrant of a mark on the supplemental register provided by this chapter”.

EFFECTIVE DATE OF 1988 AMENDMENT

Amendment by Pub. L. 100–667 effective one year after Nov. 16, 1988, see section 136 of Pub. L. 100–667, set out as a note under section 1051 of this title.
Effective Date of 1975 Amendment
Pub. L. 93–596, § 4, Jan. 2, 1975, 88 Stat. 1949, provided that: "This Act [amending this section, sections 1051, 1052, 1057, 1058, 1060, 1062, 1063, 1065, 1067, 1097, 1092, 1112, 1113, 1116 to 1120, 1123, and 1127 of this title, and sections 2 to 4, 6 to 8, 10, 11, 21 to 26, 31 to 33, 41, 104, 119, 121, 122, 135, 142 to 144, 146, 152, 153, 253 to 255, 261, 268, and 283 of Title 35, Patents, and enacting provisions set out as a note under section 1 of title 35] shall become effective upon enactment [Jan. 2, 1975]. However, any registrant may continue to give notice of his registration in accordance with section 29 of the Trademark Act of 1946 (60 Stat. 427), as amended Oct. 9, 1962 (76 Stat. 769) [this section], as an alternative to notice in accordance with section 29 of the Trademark Act as amended by section 2 of this Act, regardless of whether his mark was registered before or after the effective date of this Act."

Repeal and Effect on Existing Rights
Repeal of inconsistent provisions, effect of this chapter on pending proceedings and existing registrations and rights under prior acts, see notes set out under section 1061 of this title.

§ 1112. Classification of goods and services; registration in plurality of classes

The Director may establish a classification of goods and services, for convenience of Patent and Trademark Office administration, but not to limit or extend the applicant’s or registrant’s rights. The applicant may apply to register a mark for any or all of the goods or services on or in connection with which he or she is using or has a bona fide intention to use the mark in commerce: Provided, That if the Director by regulation permits the filing of an application for the registration of a mark for goods or services which fall within a plurality of classes, a fee equaling the sum of the fees for filing an application in each class shall be paid, and the Director may issue a single certificate of registration for such mark:


Prior Provisions

Amendments
1999—Pub. L. 106–113 substituted "Director" for "Commissioner" wherever appearing.

1988—Pub. L. 100–667 inserted "or registrant’s" after "applicant’s" and substituted "may apply" for "may file an application", "goods or services on or in connection with which he or she is using or has a bona fide intention to use the mark in commerce: Provided, That if the Commissioner by regulation permits the filing of an application for the registration of a mark for goods or services which fall" for "Provided, That when such goods or services fall".


1962—Pub. L. 87–772, among other changes, substituted "may" for "shall".

Effective Date of 1999 Amendment
Amendment by Pub. L. 106–113 effective 4 months after Nov. 29, 1999, see section 1000(a)(9) [title IV, § 4731] of Pub. L. 106–113, set out as a note under section 1 of Title 35, Patents.

Effective Date of 1988 Amendment
Amendment by Pub. L. 100–667 effective one year after Nov. 16, 1988, see section 136 of Pub. L. 100–667, set out as a note under section 1061 of this title.

Effective Date of 1975 Amendment

Repeal and Effect on Existing Rights
Repeal of inconsistent provisions, effect of this chapter on pending proceedings and existing registrations and rights under prior acts, see notes set out under section 1061 of this title.

Transfer of Functions
For transfer of functions of other officers, employees, and agencies of Department of Commerce, with certain exceptions, to Secretary of Commerce, with power to delegate, see Reorg. Plan No. 5 of 1950, §§ 1, 2, eff. May 4, 1950, 15 F.R. 3174, 64 Stat. 1263, set out in the Appendix to Title 5, Government Organization and Employees.

§ 1113. Fees

(a) Applications; services; materials

The Director shall establish fees for the filing and processing of an application for the registration of a trademark or other mark and for all other services performed by and materials furnished by the Patent and Trademark Office related to trademarks and other marks. Fees established under this subsection may be adjusted by the Director once each year to reflect, in the aggregate, any fluctuations during the preceding 12 months in the Consumer Price Index, as determined by the Secretary of Labor. Changes of less than 1 percent may be ignored. No fee established under this section shall take effect until at least 30 days after notice of the fee has been published in the Federal Register and in the Official Gazette of the Patent and Trademark Office.

(b) Waiver; Indian products

The Director may waive the payment of any fee for any service or material related to trademarks or other marks in connection with an occasional request made by a department or agency of the Government, or any officer thereof. The Indian Arts and Crafts Board will not be charged any fee to register Government trademarks of genuineness and quality for Indian products or for products of particular Indian tribes and groups.

19, 1920, ch. 104, § 8, 41 Stat. 535; Apr. 11, 1930, ch. 132, § 4,

than once every three years. No fee established under

mark or other mark or for the renewal or assignment

generally. Prior to amendment, subsec. (a) read as fol-

low: "The Commissioner will establish fees for the fil-

ing and processing of an application for the registra-

tion of a trademark or other mark and for all other

services performed by and materials furnished by the

Patent and Trademark Office related to trademarks

and other marks. However, no fee for the filing or proc-

essing of an application for the registration of a trade-

mark or other mark or for the renewal or assignment

of a trademark or other mark will be adjusted more

than once every three years. No fee established under

this section will take effect prior to sixty days follow-

ing notice in the Federal Register."

1982—Subsec. (a). Pub. L. 97–256 struck out "of Pat-

ents" after "Commissioner".

Pub. L. 97–247 struck out provisions directing that fees be set and adjusted by the Commissioner to re-

cover in aggregate 50 per centum of the estimated aver-

age cost to the Office of processing and that fees for all

other services or materials related to trademarks and

other marks recover the estimated average cost to the

Office of performing the service or furnishing the ma-

terial.

1980—Subsec. (a). Pub. L. 96–517 in revising fee prov-

isions required the Commissioner to establish fees based

on recovery of estimated average cost of processing ap-

plications, performing services and providing material;

authorized triennial adjustments; and prescribed an ef-

fective date for fees; deleted prior provisions contain-

ing statutory schedule covering fees for filing; applica-

tions for registration and renewals, affidavits, revival

petitions for abandoned applications, opposition or ap-

plication for cancellation, disclaimers, and notice of

benefits for a mark to be published; and fees covering;

appeals from examiners in charge of registration, cer-

tificates of amendment, certifying, printed copies of

registered marks, and recordation of documents and pa-

pers relating to property in a registration or applica-

tion.

Subsec. (b). Pub. L. 96–517 added subsec. (b) and

struck out former subsec. (b) authorizing Commis-

sioner to establish charges for copies of records, publi-

cations, or services of Patent and Trademark Office.

See subsec. (a).

Subsec. (c). Pub. L. 96–517 in revising fee provisions

struck out subsec. (c) authorizing Commissioner to re-

fund any mistaken or excessive payments.


and Trademark Office" for "Patent Office".

Subsec. (b). Pub. L. 93–596 substituted "Patent and

Trademark Office" for "Patent Office".

1965—Pub. L. 89–83 increased fees for filing an applica-

tion for registration of a mark from $25 to $35; for ins-

urance of a new certificate of registration following a

change of ownership of a mark or correction of a regis-

trant's mistake from $10 to $15; for a certificate of

correction of registrant's mistake from $10 to $15; for

filing a disclaimer from $10 to $15; and for recording an

assignment, agreement, or other paper relating to the

property in a registration or application from $1 for

documents not exceeding six pages plus $1 for each ad-

ditional two pages or less and 50 cents additional for

each additional registration or application included in

one writing, to a $20 fee for every document plus an ad-

dditional fee of $3 for each additional item where the
document relates to more than one application or regi-

stration; eliminated provisions which established fees

for the surrender or cancellation of a registration, for

an abstract of title, for a title report required for office

use, for certificates that marks have not been reg-

istered, and for copies of various specified records and

documents; added the fees for the filing and affidavit under

section 105(a) or (b) of this title and for filing a peti-
tion for the revival of an abandoned application; em-

powered the Commissioner to establish charges for cop-

ies of records, publications or services furnished by the

Patent Office; and made the provisions relating to re-
funds of sums paid by mistake permissive.

1958—Pub. L. 85–609 struck out "to the Commis-

sioner" after "on appeal from an examiner in charge of

the registration of marks" and, provisions which re-

quired payment of a $25 fee on appeals from an exami-

ner in charge of interferences to the Commissioner.

Effective Date of 1999 Amendment

Amendment by Pub. L. 106–113 effective 4 months after

Nov. 29, 1999, see section 1000(a)(9) [title IV, § 4731] of

Pub. L. 106–113, set out as a note under section 1 of

Title 35, Patents.

Effective Date of 1998 Amendment


and applicable only to any civil action filed or proceed-

ing before the United States Patent and Trademark Of-

fice commenced on or after such date relating to the

registration of a mark, see section 201(b) of Pub. L.

105–330, set out as a note under section 1051 of this title.

Effective Date of 1982 Amendment

Amendment by Pub. L. 97–247 effective Oct. 1, 1982,

see section 17(a) of Pub. L. 97–247, set out as a note

under section 41 of Title 35, Patents.

Effective Date of 1980 Amendment

Amendment by Pub. L. 96–517 effective Dec. 12, 1980,

with provision for continuation of fees in effect as of

such date until corresponding fees are established un-

der this section, see section 8(a), (d) of Pub. L. 96–517,

set out as a note under section 41 of Title 35, Patents.

Effective Date of 1975 Amendment

Amendment by Pub. L. 93–596 effective Jan. 2, 1975,

see section 4 of Pub. L. 93–596, set out as a note under

section 1111 of this title.

Effective Date of 1965 Amendment

For effective date and applicability of amendment by

Pub. L. 89–83, see section 7(a), (d) of Pub. L. 89–83,

set out as a note under section 41 of Title 35, Patents.

Effective Date of 1958 Amendment

For effective date and applicability of amendment by

Pub. L. 85–609, see section 3 of Pub. L. 85–609, set out as

a note under section 1056 of this title.

Repeal and Effect on Existing Rights

Repeal of inconsistent provisions, effect of this chap-

ter on pending proceedings and existing registrations

and rights under prior acts, see notes set out under sec-

tion 1051 of this title.

Transfer of Functions

For transfer of functions of other officers, employees,

and agencies of Department of Commerce, with certain

exceptions, to Secretary of Commerce, with power to
delegate, see Reorg. Plan No. 5 of 1950, §§ 1, 2, eff. May

24, 1950, 15 F.R. 3174, 64 Stat. 1283, set out in the Appen-
dix to Title 5, Government Organization and Employ-

ees.

 Appropriations and Fees Authorized To Be Carried Over

For provisions authorizing fees collected under this
chapter, and certain appropriations, to remain avail-
able until expended, see section 2 of Pub. L. 99–607, set
out as a note under section 42 of Title 35, Patents.
§ 1114. Remedies; infringement; innocent infringement by printers and publishers

(1) Any person who shall, without the consent of the registrant—

(a) use in commerce any reproduction, counterfeit, copy, or colorable imitation of a registered mark in connection with the sale, offering for sale, distribution, or advertising of any goods or services on or in connection with which such use is likely to cause confusion, or to cause mistake, or to deceive; or

(b) reproduce, counterfeit, copy, or colorably imitate a registered mark and apply such reproduction, counterfeit, copy, or colorable imitation to labels, signs, prints, packages, wrappers, receptacles or advertisements intended to be used in commerce upon or in connection with the sale, offering for sale, distribution, or advertising of goods or services on or in connection with which such use is likely to cause confusion, or to cause mistake, or to deceive,

shall be liable in a civil action by the registrant for the remedies hereinafter provided. Under subsection (b) hereof, the registrant shall not be entitled to recover profits or damages unless the acts have been committed with knowledge that such imitation is intended to be used to cause confusion, or to cause mistake, or to deceive.

As used in this paragraph, the term "any person" includes the United States, all agencies and instrumentalities thereof, and all individuals, firms, corporations, other persons acting for the United States and with the authorization and consent of the United States, and any State, any instrumentality of a State, and any officer or employee of a State or instrumentality of a State acting in his or her official capacity. The United States, all agencies and instrumentalities thereof, all individuals, firms, corporations, other persons acting for the United States and with the authorization and consent of the United States, and any State, and any such instrumentality, officer, or employee, shall be subject to the provisions of this chapter in the same manner and to the same extent as any nongovernmental entity.

(2) Notwithstanding any other provision of this chapter, the remedies given to the owner of a right infringed under this chapter or to a person bringing an action under section 1125(a) or (d) of this title shall be limited as follows:

(A) Where an infringer or violator is engaged solely in the business of printing the mark or violating matter for others and establishes that he or she was an innocent infringer or innocent violator, the owner of the right infringed or person bringing the action under section 1125(a) of this title shall be entitled as against such infringer or violator only to an injunction against future printing.

(B) Where the infringement or violation complained of is contained in or is part of paid advertising matter in a newspaper, magazine, or other similar periodical or in an electronic communication as defined in section 2510(12) of title 18, the remedies of the owner of the right infringed or person bringing the action under section 1125(a) of this title as against the publisher or distributor of such newspaper, magazine, or other similar periodical or electronic communication shall be limited to an injunction against the presentation of such advertising matter in future issues of such newspapers, magazines, or other similar periodicals or in future transmissions of such electronic communications. The limitations of this subparagraph shall apply only to innocent infringers and innocent violators.

(C) Injunctive relief shall not be available to the owner of the right infringed or person bringing the action under section 1125(a) of this title with respect to an issue of a newspaper, magazine, or other similar periodical or an electronic communication containing infringing matter or violating matter where restraining the dissemination of such infringing matter or violating matter where restraining the dissemination of such infringing matter or violating matter would delay the delivery of such issue or transmission of such electronic communication after the regular time for such delivery or transmission, and such delay would be due to the method by which publication and distribution of such periodical or transmission of such electronic communication is customarily conducted in accordance with sound business practice, and not due to any method or device adopted to evade this section or to prevent or delay the issuance of an injunction or restraining order with respect to such infringing matter or violating matter.

(D)(I) A domain name registrar, a domain name registry, or other domain name registration authority that takes any action described
(E) As used in this paragraph—
(i) the term "violator" means a person who violates section 1125(a) of this title; and
(ii) the term "violating matter" means matter that is the subject of a violation under section 1125(a) of this title.

(3)(A) Any person who engages in the conduct described in paragraph (11) of section 110 of title 17 and who complies with the requirements set forth in that paragraph is not liable on account of such conduct for a violation of any right under this chapter. This subparagraph does not preclude liability, nor shall it be construed to restrict the defenses or limitations on rights granted under this chapter, of a person for conduct not described in paragraph (11) of section 110 of title 17, even if that person also engages in conduct described in paragraph (11) of section 110 of such title.

(B) A manufacturer, licensee, or licensor of technology that enables the making of limited portions of audio or video content of a motion picture imperceptible as described in subparagraph (A) is not liable on account of such manufacture or license for a violation of any right under this chapter, if such manufacturer, licensee, or licensor ensures that the technology provides a clear and conspicuous notice at the beginning of each performance that the performance of the motion picture is altered from the performance intended by the director or copyright holder of the motion picture. The limitations on liability in subparagraph (A) and this subparagraph shall not apply to a manufacturer, licensee, or licensor of technology that fails to comply with this paragraph.

(C) The requirement under subparagraph (B) to provide notice shall apply only with respect to technology manufactured after the end of the 180-day period beginning on April 27, 2005.

(D) Any failure by a manufacturer, licensee, or licensor of technology to qualify for the exemption under subparagraphs (A) and (B) shall not be construed to create an inference that any such party that engages in conduct described in paragraph (11) of section 110 of title 17 is liable for trademark infringement by reason of such conduct.

(7) Any person who engages in the conduct described in paragraph (1) of section 110 of title 17 and who complies with the requirements set forth in that paragraph is not liable on account of such conduct for a violation of any right under this chapter. This subparagraph does not preclude liability, nor shall it be construed to restrict the defenses or limitations on rights granted under this chapter, of a person for conduct not described in paragraph (1) of section 110 of title 17, even if that person also engages in conduct described in paragraph (1) of section 110 of such title.

(2) An action referred to under clause (i) of paragraph (3) is an action of refusal to register, removing from registration, transferring, temporarily disabling, or permanently canceling a domain name—
(i) in compliance with a court order under section 1125(d) of this title; or
(ii) in the implementation of a reasonable policy by such registrar, registry, or authority prohibiting the registration of a domain name that is identical to, confusingly similar to, or dilutive of another's mark.

(3) A domain name registrar, a domain name registry, or other domain name registration authority described in subparagraph (i) may be subject to injunctive relief only if such registrar, registry, or other registration authority has—
(aa) not expeditiously deposited with a court, in which an action has been filed regarding the disposition of the domain name, documents sufficient for the court to establish the court's control and authority regarding the disposition of the registration and use of the domain name;
(bb) transferred, suspended, or otherwise modified the domain name during the pendency of the action, except upon order of the court;
(cc) willfully failed to comply with any such court order.

(4) An action referred to under clause (ii) of paragraph (3) is an action of refusal to register, removing from registration, transferring, temporarily disabling, or permanently canceling a domain name—
(i) in compliance with a court order under section 1125(d) of this title; or
(ii) in the implementation of a reasonable policy by such registrar, registry, or authority prohibiting the registration of a domain name that is identical to, confusingly similar to, or dilutive of another's mark.

(5) A domain name registrar, a domain name registry, or other domain name registration authority shall not be liable for damages under this section for the registration or maintenance of a domain name for another absent a showing of bad faith intent to profit from such registration or maintenance of the domain name.

(6) If a registrar, registry, or other registration authority takes an action described under clause (ii) based on a knowing and material misrepresentation by any other person that a domain name is identical to, confusingly similar to, or dilutive of another's mark.

(7) A domain name registrant whose domain name has been suspended, disabled, or transferred under a policy described under clause (ii)(II) may, upon notice to the mark owner, file a civil action to establish that the registration or use of the domain name by such registrant is not unlawful under this chapter. The court may grant injunctive relief to the domain name registrant, including the reactivation of the domain name or transfer of the domain name to the domain name registrant.
sentence, substituted “The United States, all agencies and instrumentalities thereof, and all individuals, firms, corporations, other persons acting for the United States and with the authorization and consent of the United States, and any” for “Any”.

Par. (2). Pub. L. 106–113, §1000(a)(9) [title III, §3001(a)], in introductory provisions, substituted “under section 1125(a) or (d) of this title” for “under section 1125(a) of this title”.

Par. (2)(D), (E). Pub. L. 106–113, §1000(a)(9) [title III, §3004(1)], added subpar. (D) and redesignated former subpar. (D) as (E).

1998—Par. (1). Pub. L. 105–330 substituted “As used in this paragraph” for “As used in this subsection” in last paragraph.

1992—Par. (1). Pub. L. 102–542 inserted at end “As used in this subsection, the term ‘any person' includes any State, any instrumentality of a State, and any officer or employee of a State or instrumentality of a State acting in his or her official capacity. Any State, and any such instrumentality, officer, or employee, shall be subject to the provisions of this chapter in the same manner and to the same extent as any nongovernmental entity.”

1988—Par. (2). Pub. L. 100–667 amended par. (2) generally. Prior to amendment, par. (2) read as follows: “Notwithstanding any other provision of this chapter, the remedies given to the owner of the right infringed shall be limited as follows: (a) Where an infringer engaged solely in the business of printing the mark for others and establishes that he was an innocent infringer, the owner of the right infringed shall be entitled as against such infringer only to an injunction against future printing; (b) where the infringement complained of is contained in or is part of paid advertising matter in a newspaper, magazine, or other similar periodical the remedies of the owner of the right infringed as against the publisher or distributor of such newspaper, magazine, or other similar periodical shall be confined to an injunction against the presentation of such advertising matter in future issues of such newspapers, magazines, or other similar periodical: Provided, That these limitations shall apply only to innocent infringers; (c) injunction relief shall not be available to the owner of the right infringed in respect of an issue of a newspaper, magazine, or other similar periodical containing infringing matter when restraining the dissemination of such infringing matter in any particular issue of such periodical would delay the delivery of such issue after the regular time thereof, and such delay would be due to the method by which publication and distribution of such periodical is customarily conducted in accordance with sound business practice, and not to any method or device adopted for the evasion of this section or to prevent or delay the issuance of an injunction or restraining order with respect to such infringing matter.”

1962—Par. (1). Pub. L. 87–772 amended provisions generally, and among other changes, inserted “distribution”, and struck out “purchasers as to the source of origin of such goods or services” after “or to deceive” in subsec. (a), inserted provisions regarding the likelihood of such use causing confusion, mistake, or deception, in subsec. (b), and struck out the limitation on recovery under subsec. (b) to acts committed with knowledge that such acts would deceive purchasers.


**Effective Date of 1999 Amendment**

Amendment by Pub. L. 106–113 applicable to all domain names registered before, on, or after Nov. 29, 1999, see section 1000(a)(9) [title III, §3010] of Pub. L. 106–113, set out as a note under section 1117 of this title.

**Effective Date of 1998 Amendment**

Amendment by Pub. L. 100–667 effective one year after Nov. 16, 1988, see section 136 of Pub. L. 100–667, set out as a note under section 1061 of this title.

**Repeal and Effect on Existing Rights**

Repeal of inconsistent provisions, effect of this chapter on pending proceedings and existing registrations and rights under prior acts, see notes set out under section 1061 of this title.

§1115. Registration on principal register as evidence of exclusive right to use mark; defenses

(a) Evidentiary value; defenses

Any registration issued under the Act of March 3, 1881, or the Act of February 20, 1905, or of a mark registered on the principal register provided by this chapter and owned by a party to an action shall be admissible in evidence and shall be prima facie evidence of the validity of the registered mark and of the registration of the mark, of the registrant’s ownership of the mark, and of the registrant’s exclusive right to use the registered mark in commerce on or in connection with the goods or services specified in the registration subject to any conditions or limitations stated therein, but shall not preclude another person from proving any legal or equitable defense or defect, including those set forth in subsection (b) of this section, which might have been asserted if such mark had not been registered.

(b) Incontestability; defenses

To the extent that the right to use the registered mark has become incontestable under section 1065 of this title, the registration shall be conclusive evidence of the validity of the registered mark and of the registration of the mark, of the registrant’s ownership of the mark, and of the registrant’s exclusive right to use the registered mark in commerce. Such conclusive evidence shall relate to the exclusive right to use the mark on or in connection with the goods or services specified in the affidavit filed under the provisions of section 1065 of this title, or in the renewal application filed under the provisions of section 1059 of this title if the goods or services specified in such affidavit or renewal application are fewer in number, subject to any conditions or limitations in the registration or in such affidavit or renewal application. Such conclusive evidence of the right to use the registered mark shall be subject to proof of infringement as defined in section 1114 of this title, and shall be subject to the following defenses or defects:

(1) That the registration or the incontestable right to use the mark was obtained fraudulently; or
(2) That the mark has been abandoned by the registrant; or
(3) That the registered mark is being used by or with the permission of the registrant or a person in privity with the registrant, so as to misrepresent the source of the goods or services on or in connection with which the mark is used; or
(4) That the use of the name, term, or device charged to be an infringement is a use, otherwise than as a mark, of the party’s individual name in his own business, or of the individual name of anyone in privity with such party, or of a term or device which is descriptive of and used fairly and in good faith only to describe the goods or services of such party, or their geographic origin; or
(5) That the mark whose use by a party is charged as an infringement was adopted without knowledge of the registrant’s prior use and has been continuously used by such party or those in privity with him from a date prior to (A) the date of constructive use of the mark established pursuant to section 1057(c) of this title, (B) the registration of the mark under this chapter if the application for registration is filed before the effective date of the Trademark Law Revision Act of 1988, or (C) publication of the registered mark under subsection (c) of section 1062 of this title: Provided, however, that this defense or defect shall apply only for the area in which such continuous prior use is proved; or
(6) That the mark whose use is charged as an infringement was registered and used prior to the registration under this chapter or publication under subsection (c) of section 1062 of this title of the registered mark of the registrant, and not abandoned: Provided, however, That this defense or defect shall apply only for the area in which the mark was used prior to such registration or such publication of the registrant’s mark; or
(7) That the mark has been or is being used to violate the antitrust laws of the United States; or
(8) That the mark is functional; or
(9) That equitable principles, including laches, estoppel, and acquiescence, are applicable.


REFERENCES IN TEXT


PRIOR PROVISIONS

§ 1116. Injunctive relief

(a) Jurisdiction; service

The several courts vested with jurisdiction of civil actions arising under this chapter shall have power to grant injunctions, according to the principles of equity and upon such terms as the court may deem reasonable, to prevent the violation of any right of the registrant of a mark registered in the Patent and Trademark Office or to prevent a violation under subsection (a), (c), or (d) of section 1125 of this title. Any such injunction may include a provision directing the defendant to file with the court and serve on the plaintiff within thirty days after the service on the defendant of such injunction, or such extended period as the court may direct, a report in writing under oath setting forth in detail the manner and form in which the defendant has complied with the injunction. Any such injunction granted upon hearing, after notice to the defendant, by any district court of the United States, may be served on the parties against whom such injunction is granted anywhere in the United States where they may be found, and shall be operative and may be enforced by proceedings to punish for contempt, or found, and shall be operative and may be enforced by proceedings to punish for contempt, or

(b) Transfer of certified copies of court papers

The said courts shall have jurisdiction to enforce said injunction, as provided in this chapter, as fully as if the injunction had been granted by the district court in which it is sought to be enforced. The clerk of the court or judge granting the injunction shall, when required to do so by the court before which application to enforce said injunction is made, transfer without delay to said court a certified copy of all papers on file in his office upon which said injunction was granted.

(c) Notice to Director

It shall be the duty of the clerks of such courts within one month after the filing of any action, suit, or proceeding involving a mark registered under the provisions of this chapter to give notice thereof in writing to the Director setting forth in order so far as known the names and addresses of the litigants and the designating number or numbers of the registration or registrations upon which the action, suit, or proceeding has been brought, and in the event any other registration be subsequently included in the action, suit, or proceeding by amendment, answer, or other pleading, the clerk shall give like notice thereof to the Director; and within one month after the judgment is entered or an appeal is taken the clerk of the court shall give notice thereof to the Director, and it shall be the duty of the Director on receipt of such notice forthwith to endorse the same upon the file wrapper of the said registration or registrations and to incorporate the same as a part of the contents of said file wrapper.

(d) Civil actions arising out of use of counterfeit marks

(1)(A) In the case of a civil action arising under section 1114(1)(a) of this title or section 220506 of title 36 with respect to a violation that consists of using a counterfeit mark in connection with the sale, offering for sale, or distribution of goods or services, the court may, upon ex parte application, grant an order under subsection (a) of this section pursuant to this subsection providing for the seizure of goods and counterfeit marks involved in such violation and the means of making such marks, and records documenting the manufacture, sale, or receipt of things involved in such violation.

(B) As used in this subsection the term “counterfeit mark” means—

(i) a counterfeit of a mark that is registered on the principal register in the United States Patent and Trademark Office for such goods or services sold, offered for sale, or distributed and that is in use, whether or not the person against whom relief is sought knew such mark was so registered; or

(ii) a spurious designation that is identical with, or substantially indistinguishable from, a designation as to which the remedies of this chapter are made available by reason of section 220506 of title 36;

but such term does not include any mark or designation used on or in connection with goods or services of which the manufacturer\(^1\) or producer was, at the time of the manufacture or production in question authorized to use the mark or designation for the type of goods or services so manufactured or produced, by the holder of the right to use such mark or designation.

(2) The court shall not receive an application under this subsection unless the applicant has given such notice of the application as is reasonable under the circumstances to the United States attorney for the judicial district in which such order is sought. Such attorney may participate in the proceedings arising under such application if such proceedings may affect evidence of an offense against the United States. The court may deny such application if the court determines that the public interest in a potential prosecution so requires.

(3) The application for an order under this subsection shall—

(A) be based on an affidavit or the verified complaint establishing facts sufficient to support the findings of fact and conclusions of law required for such order; and

(B) contain the additional information required by paragraph (5) of this subsection to be set forth in such order.

(4) The court shall not grant such an application unless—

(A) the person obtaining an order under this subsection provides the security determined adequate by the court for the payment of such damages as any person may be entitled to recover as a result of a wrongful seizure or wrongful attempted seizure under this subsection; and

(B) the court finds that it clearly appears from specific facts that—

(i) an order other than an ex parte seizure order is not adequate to achieve the purposes of section 1114 of this title;

\(^1\) So in original. Probably should be “manufacturer”.\("
(ii) the applicant has not publicized the requested seizure;
(iii) the applicant is likely to succeed in showing that the person against whom seizure would be ordered used a counterfeit mark in connection with the sale, offering for sale, or distribution of goods or services;
(iv) an immediate and irreparable injury will occur if such seizure is not ordered;
(v) the matter to be seized will be located at the place identified in the application;
(vi) the harm to the applicant of denying the application outweighs the harm to the legitimate interests of the person against whom seizure would be ordered of granting the application; and
(vii) the person against whom seizure would be ordered, or persons acting in concert with such person, would destroy, move, hide, or otherwise make such matter inaccessible to the court, if the applicant were to proceed on notice to such person.

(5) An order under this subsection shall set forth—
(A) the findings of fact and conclusions of law required for the order;
(B) a particular description of the matter to be seized, and a description of each place at which such matter is to be seized;
(C) the time period, which shall end not later than seven days after the date on which such order is issued, during which the seizure is to be made;
(D) the amount of security required to be provided under this subsection; and
(E) a date for the hearing required under paragraph (10) of this subsection.

(6) The court shall take appropriate action to protect the person against whom an order under this subsection is directed from publicity, by or at the behest of the plaintiff, about such order and any seizure under such order.

(7) Any materials seized under this subsection shall be taken into the custody of the court. For seizures made under this section, the court shall enter an appropriate protective order with respect to discovery and use of any records or information that has been seized. The protective order shall provide for appropriate procedures to ensure that confidential, private, proprietary, or privileged information contained in such records is not improperly disclosed or used.

(8) An order under this subsection, together with the supporting documents, shall be sealed until the person against whom the order is directed has an opportunity to contest such order, except that any person against whom such order is issued shall have access to such order and supporting documents after the seizure has been carried out.

(9) The court shall order that service of a copy of the order under this subsection shall be made by a Federal law enforcement officer (such as a United States marshal or an officer or agent of the United States Customs Service, Secret Service, Federal Bureau of Investigation, or Post Office) or may be made by a State or local law enforcement officer, who, upon making service, shall carry out the seizure under the order. The court shall issue orders, when appropriate, to protect the defendant from undue damage from the disclosure of trade secrets or other confidential information during the course of the seizure, including, when appropriate, orders restricting the access of the applicant (or any agent or employee of the applicant) to such secrets or information.

(10)(A) The court shall hold a hearing, unless waived by all the parties, on the date set by the court in the order of seizure. That date shall be no sooner than ten days after the order is issued and no later than fifteen days after the order is issued, unless the applicant for the order shows good cause for another date or unless the party against whom such order is directed consents to another date for such hearing. At such hearing the party obtaining the order shall have the burden to prove that the facts supporting findings of fact and conclusions of law necessary to support such order are still in effect. If that party fails to meet that burden, the seizure order shall be dissolved or modified appropriately.

(B) In connection with a hearing under this paragraph, the court may make such orders modifying the time limits for discovery under the Rules of Civil Procedure as may be necessary to prevent the frustration of the purposes of such hearing.

(11) A person who suffers damage by reason of a wrongful seizure under this subsection has a cause of action against the applicant for the order under which such seizure was made, and shall be entitled to recover such relief as may be appropriate, including damages for lost profits, cost of materials, loss of good will, and punitive damages in instances where the seizure was sought in bad faith, and, unless the court finds extenuating circumstances, to recover a reasonable attorney’s fee. The court in its discretion may award prejudgment interest on relief recovered under this paragraph, at an annual interest rate established under section 6621(a)(2) of title 26, commencing on the date of service of the claimant’s pleading setting forth the claim under this paragraph and ending on the date such recovery is granted, or for such shorter time as the court deems appropriate.

References in Text


Prior Provisions

AMENDMENTS

2008—Subsec. (d)(7). Pub. L. 110–403 amended par. (7) generally. Prior to amendment, par. (7) read as follows: “Any materials seized under this subsection shall be taken into the custody of the court. The court shall enter an appropriate protective order with respect to discovery by the applicant of any records that have been seized. The protective order shall provide for appropriate procedures to assure that confidential information contained in such records is not improperly disclosed to the applicant.”


1998—Subsec. (a). Pub. L. 106–113, § 1000(a)(9) [title III, § 3003(a)(1)], substituted “(a), (b), or (c)” for “(a) or (c)” in first sentence.

Pub. L. 106–43 substituted “subsection (a) or (c) of section 1125 of this title” for “section 1125(a) of this title” in first sentence.


1996—Subsec. (d)(9). Pub. L. 104–153 inserted first sentence and struck out former first sentence which read as follows: “The court shall order that a United States marshal or other law enforcement officer is to serve a copy of the order under this subsection and then is to carry out the seizure under such order.”

1995—Subsec. (a). Pub. L. 104–67, § 128(c), inserted “or to prevent a violation under section 1125(a) of this title” after “Office” in first sentence.

Subsec. (c). Pub. L. 104–67, § 128(d), substituted “proceeding involving a marked” for “proceeding arising” and “judgment is entered or an appeal is taken” for “decision is rendered, appeal taken or a decree issued”.

Subsec. (d)(1)(B). Pub. L. 104–67, § 128(e), inserted “on or after” for “or designation used” in concluding provisions.

1988—Pub. L. 98–473 designated first, second, and third undesignated pars. as subssecs. (a), (b), and (c), respectively and added subsec. (d).


EFFECTIVE DATE OF 1999 AMENDMENT

Amendment by section 1000(a)(9) [title III, § 3003(a)(1)] of Pub. L. 106–113 applicable to all domain names registered before, on, or after Nov. 29, 1999, see section 1000(a)(9) [title III, § 3010] of Pub. L. 106–113, set out as a note under section 1117 of this title.

Amendment by section 1000(a)(9) [title IV, § 4732(b)(1)(B)] of Pub. L. 106–113 effective 4 months after Nov. 29, 1999, see section 1000(a)(9) [title IV, § 4731] of Pub. L. 106–113, set out as a note under section 1 of Title 35, Patents.

EFFECTIVE DATE OF 1988 AMENDMENT

Amendment by Pub. L. 100–667 effective one year after Nov. 16, 1988, see section 136 of Pub. L. 100–667, set out as a note under section 1151 of this title.

EFFECTIVE DATE OF 1975 AMENDMENT


REPEAL AND EFFECT ON EXISTING RIGHTS

Repeal of inconsistent provisions, effect of this chapter on pending proceedings and existing registrations and rights under prior acts, see notes set out under section 1061 of this title.

TRANSFER OF FUNCTIONS

For transfer of functions, personnel, assets, and liabilities of the United States Customs Service of the Department of the Treasury, including functions of the Secretary of the Treasury relating thereto, to the Secretary of Homeland Security, and for treatment of related references, see sections 2331, 551(d), 552(d), and 557 of Title 6, Domestic Security, and the Department of Homeland Security Reorganization Plan of November 25, 2002, as modified, set out as a note under section 542 of Title 6.

For transfer of the functions, personnel, assets, and obligations of the United States Secret Service, including the functions of the Secretary of the Treasury relating thereto, to the Secretaries of Homeland Security, and for treatment of related references, see sections 381, 551(d), 552(d), and 557 of Title 6, Domestic Security, and the Department of Homeland Security Reorganization Plan of November 25, 2002, as modified, set out as a note under section 542 of Title 6.

For transfer of functions of other officers, employees, and agencies of Department of Commerce, with certain exceptions, to Secretary of Commerce, with power to delegate, see Reorg. Plan No. 5 of 1950, §§ 1, 2, eff. May 24, 1950, 15 F.R. 3174, 64 Stat. 1263, set out in the Appendix to Title 5, Government Organization and Employees.

§ 1117. Recovery for violation of rights

(a) Profits; damages and costs; attorney fees

When a violation of any right of the registrant of a mark registered in the Patent and Trademark Office, a violation under section 1125(a) or (d) of this title, or a willful violation under section 1125(c) of this title, shall have been established in any civil action arising under this chapter, the plaintiff shall be entitled, subject to the provisions of sections 1111 and 1114 of this title, and subject to the principles of equity, to recover (1) defendant’s profits, (2) any damages sustained by the plaintiff, and (3) the costs of the action. The court shall assess such profits and damages or cause the same to be assessed under its direction. In assessing profits the plaintiff shall be required to prove defendant’s sales only; defendant must prove all elements of cost or deduction claimed. In assessing damages the court may enter judgment, according to the circumstances of the case, for any sum above the amount found as actual damages, not exceeding three times such amount. If the court shall find that the amount of the recovery based on profits is either inadequate or excessive the court may in its discretion enter judgment for such sum as the court shall find to be just, according to the circumstances of the case. Such sum in either of the above circumstances shall constitute compensation and not a penalty. The court in exceptional cases may award reasonable attorney fees to the prevailing party.

(b) Treble damages for use of counterfeit mark

In assessing damages under subsection (a) for any violation of section 1114(1)(a) of this title or section 220506 of title 36, in a case involving use of a counterfeit mark or designation (as defined in section 1116(d) of this title), the court shall, unless the court finds extenuating circumstances, enter judgment for three times such profits or damages, whichever amount is greater, together with a reasonable attorney’s fee, if the violation consists of—

(1) intentionally using a mark or designation, knowing such mark or designation is a counterfeit mark (as defined in section 1116(d) of this title), in connection with the sale, of—
(c) Statutory damages for use of counterfeit marks

In a case involving the use of a counterfeit mark (as defined in section 1116(d) of this title) in connection with the sale, offering for sale, or distribution of goods or services, the plaintiff may elect, at any time before final judgment is rendered by the trial court, to recover, instead of actual damages and profits under subsection (a) of this section, an award of statutory damages for any such use in connection with the sale, offering for sale, or distribution of goods or services in the amount of—

(1) not less than $1,000 or more than $200,000 per counterfeit mark per type of goods or services sold, offered for sale, or distributed, as the court considers just; or

(2) if the court finds that the use of the counterfeit mark was willful, not more than $2,000,000 per counterfeit mark per type of goods or services offered for sale, or distributed, as the court considers just.

(d) Statutory damages for violation of section 1125(d)(1)

In a case involving a violation of section 1125(d)(1) of this title, the plaintiff may elect, at any time before final judgment is rendered by the trial court, to recover, instead of actual damages and profits, an award of statutory damages in the amount of not less than $1,000 and not more than $100,000 per domain name, as the court considers just.

(e) Rebuttable presumption of willful violation

In the case of a violation referred to in this section, it shall be a rebuttable presumption that the violation is willful for purposes of determining relief if the violator, or a person acting in concert with the violator, knowingly provided or knowingly caused to be provided materially false contact information to a domain name registrar, domain name registry, or other domain name registration authority in connection with the registration, maintaining, or renewing a domain name used in connection with the violation. Nothing in this subsection limits what may be considered a willful violation under this section.


Prior Provisions


Amendments

2008—Subsec. (b). Pub. L. 110–403, §103, added subsec. (b) generally. Prior to amendment, text read as follows: “In assessing damages under subsection (a) of this section, the court shall, unless the court finds extenuating circumstances, enter judgment for three times such profits or damages, whichever is greater, together with a reasonable attorney’s fee, in the case of a violation of section 1114(1)(a) of this title or section 220506 of title 36 that includes of intentionally using a mark or designation, knowing such mark or designation is a counterfeit mark (as defined in section 1116(d) of this title), in connection with the sale, offering for sale, or distribution of goods or services. In such cases, the court may in its discretion award prejudgment interest on such amount at an annual interest rate established under section 6621(a)(2) of title 26, commencing on the date of the service of the claimant’s pleadings setting forth the claim for such entry and ending on the date such entry is made, or for such shorter time as the court deems appropriate.”

Subsec. (c)(1). Pub. L. 110–403, §104(1), substituted “$1,000” for “$100” and “$200,000” for “$100,000”.


2002—Subsec. (a). Pub. L. 107–273, §13207(a), substituted “‘a violation under section 1125(a) or (d) of this title,’” for “‘a violation under section 1125(a), (c), or (d) of this title,’” in first sentence.


1999—Subsec. (a). Pub. L. 106–113, §1000(a)(9) [title III, §3003(a)(2)], inserted “, or a violation under section 1125(a) of this title,” after “section 1125(“a”)” in first sentence.

1998—Subsec. (b). Pub. L. 106–43 substituted “a violation under section 1125(a) of this title, or a willful violation under section 1125(c) of this title,” for “or a violation under section 1125(a) of this title,” in first sentence.


1988—Subsec. (a). Pub. L. 100–667 inserted “, or a violation under section 1125(a) of this title,” after “Office” in first sentence.


1984—Pub. L. 98–473 added provisions relating to awarding of attorney fees in exceptional cases.


1982—Pub. L. 97–772 substituted “1114” for “1113(1)(b)”.

Effective Date of 1999 Amendment

§1118. Destruction of infringing articles

In any action arising under this chapter, in which a violation of any right of the registrant of a mark registered in the Patent and Trademark Office, a violation under section 1215(a) of this title, or a willful violation under section 1125(c) of this title, shall have been established, the court may order that all labels, signs, prints, packages, wrappers, receptacles, and advertisements in the possession of the defendant, bearing the registered mark or, in the case of a violation of section 1125(a) of this title or a willful violation under section 1125(c) of this title, the word, term, name, symbol, device, combination thereof, designation, description, or representation that is the subject of the violation, or any reproduction, counterfeit, copy, or colorable imitation thereof, and all plates, molds, matrices, and other means of making the same, shall be delivered up and destroyed. The party seeking an order under this section for destruction of articles seized under section 1116(d) of this title shall give ten days’ notice to the United States attorney for the judicial district in which such order is sought (unless good cause is shown for lesser notice) and such United States attorney may, if such destruction may affect evidence of an offense against the United States, seek a hearing on such destruction or participate in any hearing otherwise to be held with respect to such destruction.


Prior Provisions

Amendments 1999—Pub. L. 106–43, in first sentence, substituted “a violation under section 1125(a) of this title, or a willful violation under section 1125(c) of this title,” for “or a violation under section 1125(a) of this title,” and inserted “or a willful violation under section 1125(c) of this title” before “the word.”

1988—Pub. L. 100–667 inserted first sentence “or, a violation under section 1125(a) of this title,” after “Office” and “or, in the case of a violation of section 1125(a) of this title, the word, term, name, symbol, device, combination thereof, designation, description, or representation that is the subject of the violation,” after “registered mark.”

1984—Pub. L. 98–473 inserted “The party seeking an order under this section for destruction of articles seized under section 1116(d) of this title shall give ten days’ notice to the United States attorney for the judicial district in which such order is sought (unless good cause is shown for lesser notice) and such United States attorney may, if such destruction may affect evidence of an offense against the United States, seek a hearing on such destruction or participate in any hearing otherwise to be held with respect to such destruction.”

§ 1119. Power of court over registration

In any action involving a registered mark the court may determine the right to registration, order the cancelation of registrations, in whole or in part, restore canceled registrations, and otherwise rectify the register with respect to the registrations of any party to the action. Decrees and orders shall be certified by the court to the Director, who shall make appropriate entry upon the records of the Patent and Trademark Office, and shall be controlled thereby.


Prior Provisions

Amendments
1999—Pub. L. 106–113 substituted “Director” for “Commissioner”.


Effective Date of 1999 Amendment

§ 1120. Civil liability for false or fraudulent registration

Any person who shall procure registration in the Patent and Trademark Office of a mark by a false or fraudulent declaration or representation, oral or in writing, or by any false means, shall be liable in a civil action by any person injured thereby for any damages sustained in consequence thereof.


Prior Provisions

Amendments

Effective Date of 1975 Amendment

Repeal and Effect on Existing Rights
Repeal of inconsistent provisions, effect of this chapter on pending proceedings and existing registrations and rights under prior acts, see notes set out under section 1651 of this title.

Transfer of Functions
For transfer of functions of other officers, employees, and agencies of Department of Commerce, with certain exceptions, to Secretary of Commerce, with power to delegate, see Reorg. Plan No. 5 of 1950, §§ 1, 2, eff. May 24, 1950, 15 F.R. 3174, 64 Stat. 1263, set out in the Appendix to Title 5, Government Organization and Employees.

§ 1121. Jurisdiction of Federal courts; State and local requirements that registered trademarks be altered or displayed differently; prohibition

(a) The district and territorial courts of the United States shall have original jurisdiction and the courts of appeal of the United States (other than the United States Court of Appeals for the Federal Circuit) shall have appellate jurisdiction, of all actions arising under this chapter, without regard to the amount in controversy or to diversity or lack of diversity of the citizenship of the parties.

(b) No State or other jurisdiction of the United States or any political subdivision or any agency thereof may require alteration of a registered mark, or require that additional trademarks, service marks, trade names, or corporate names that may be associated with or incorporated into the registered mark be displayed in the mark in a manner differing from the display of such additional trademarks, service marks, trade names, or corporate names contemplated by the registered mark as exhibited in the certificate of registration issued by the United States Patent and Trademark Office.


Codification
Pub. L. 100–667, §131(b)(1), transferred section 39a of act July 5, 1946, which was classified to section 1121a of this title, to subsec. (b) of this section.

In subsec. (a), the words “and the United States Court of Appeals for the District of Columbia” following “the Courts of Appeal of the United States” have been deleted as superfluous in view of section 41 of Title 28, Judiciary and Judicial Procedure, which includes the District of Columbia within the eleven judicial circuits of the United States. The word “and” has been inserted preceding “the courts of appeal of the United States” to preserve the conjunctive sense of the sentence.

Prior Provisions
§ 1121a

AMENDMENTS

Subsec. (b). Pub. L. 100–667, § 131(b), redesignated section 1121a of this title as subsec. (b) of this section and substituted “service marks” for “servicemarks” in two places.  

EFFECTIVE DATE OF 1998 AMENDMENT

Amendment by Pub. L. 105–330 effective Oct. 30, 1998, and applicable only to any civil action filed or proceeding before the United States Patent and Trademark Office commenced on or after such date relating to the registration of a mark, see section 201(b) of Pub. L. 105–330, set out as a note under section 1051 of this title.

EFFECTIVE DATE OF 1988 AMENDMENT

Amendment by Pub. L. 100–667 effective one year after Nov. 16, 1988, see section 136 of Pub. L. 100–667, set out as a note under section 1051 of this title.

EFFECTIVE DATE OF 1982 AMENDMENT


REPEAL AND EFFECT ON EXISTING RIGHTS

Repeal of inconsistent provisions, effect of this chapter on pending proceedings and existing registrations and rights under prior acts, see notes set out under section 1051 of this title.

§ 1121a. Transferred

CODIFICATION

Section, act July 5, 1946, ch. 540, title VI, § 39a, as added Oct. 12, 1982, Pub. L. 97–296, 96 Stat. 1316, which prohibited State and local requirements that registered trademarks be altered or displayed differently, was transferred to subsec. (b) of section 39 of act July 5, 1946, by section 131(b)(1) of Pub. L. 100–667 and is classified to section 1121(b) of this title.

§ 1122. Liability of United States and States, and instrumentalities and officials thereof

(a) Waiver of sovereign immunity by the United States

The United States, all agencies and instrumentalities thereof, and all individuals, firms, corporations, other persons acting for the United States and with the authorization and consent of the United States, shall not be immune from suit in Federal or State court by any person, including any governmental or non-governmental entity, for any violation under this chapter.

(b) Waiver of sovereign immunity by States

Any State, instrumentality of a State or any officer or employee of a State or instrumentality of a State acting in his or her official capacity, shall not be immune, under the eleventh amendment of the Constitution of the United States or under any other doctrine of sovereign immunity, from suit in Federal court by any person, including any governmental or non-governmental entity for any violation under this chapter.

(c) Remedies

In a suit described in subsection (a) or (b) of this section for a violation described therein, remedies (including remedies both at law and in equity) are available for the violation to the same extent as such remedies are available for such a violation in a suit against any person other than the United States or any agency or instrumentality thereof, or any individual, firm, corporation, or other person acting for the United States and with authorization and consent of the United States, or a State, instrumentality of a State, or officer or employee of a State or instrumentality of a State acting in his or her official capacity. Such remedies include injunctive relief under section 1116 of this title, actual damages, profits, costs and attorney’s fees under section 1117 of this title, destruction of infringing articles under section 1118 of this title, the remedies provided for under sections 1114, 1119, 1120, 1124 and 1125 of this title, and for any other remedies provided under this chapter.


CONSTITUTIONALITY

For information regarding constitutionality of section 40 of act July 5, 1946, as added by section 3(b) of Pub. L. 102–542, see Congressional Research Service, The Constitution of the United States of America: Analysis and Interpretation, Appendix 1, Acts of Congress Held Unconstitutional in Whole or in Part by the Supreme Court of the United States.

PRIOR PROVISIONS

A prior section 1122, act July 5, 1946, ch. 540, title VI, § 40, related to review of cases by the Supreme Court, prior to repeal by act May 24, 1949, ch. 139, § 142, 63 Stat. 109. See section 1254 of Title 28, Judiciary and Judicial Procedure.

AMENDMENTS

Subsec. (b). Pub. L. 106–43, § 4(b)(1), (2), redesignated subsec. (a) as (b) and inserted heading. Former subsec. (b) redesignated (c).  
Subsec. (c). Pub. L. 106–43, § 4(b)(1), (3), redesignated subsec. (b) as (c) and in first sentence substituted “subsection (a) or (b) of this section for a violation described therein” for “subsection (a) of this section for a violation described in that subsection”.  
Subsec. (d). Pub. L. 106–43, § 4(b)(1), redesignated subsec. (c) as (d).

EFFECTIVE DATE

Section effective with respect to violations that occur on or after Oct. 27, 1992, see section 4 of Pub. L. 102–542, set out as an Effective Date of 1992 Amendment note under section 1114 of this title.

§ 1123. Rules and regulations for conduct of proceedings in Patent and Trademark Office

The Director shall make rules and regulations, not inconsistent with law, for the conduct of proceedings in the Patent and Trademark Office under this chapter.

§ 1124. Importation of goods bearing infringing marks or names forbidden

Except as provided in subsection (d) of section 1528 of title 19, no article of imported merchandise which shall copy or simulate the name of any domestic manufacturer, or manufacturer, or trader, or of any manufacturer or trader located in any foreign country which, by treaty, convention, or law affords similar privileges to citizens of the United States, or which shall copy or simulate a trademark registered in accordance with the provisions of this chapter or shall bear a name or mark calculated to induce the public to believe that the article is manufactured in the United States, or that it is manufactured in any foreign country or locality other than the country or locality in which it is in fact manufactured, shall be admitted to entry at any customs house of the United States; and, in order to aid the officers of the customs in enforcing this prohibition, any domestic manufacturer or trader, and any foreign manufacturer or trader, who is entitled under the provisions of a treaty, convention, declaration, or agreement between the United States and any foreign country to the advantages afforded by law to citizens of the United States in respect to trademarks and commercial names, may require his name and residence, and the name of the locality in which his goods are manufactured, and a copy of the certificate of registration of his trademark, issued in accordance with the provisions of this chapter, to be recorded in books which shall be kept for this purpose in the Department of the Treasury, under such regulations as the Secretary of the Treasury shall prescribe, and may furnish to the Department facsimiles of his name, the name of the locality in which his goods are manufactured, or of his registered trademark, and thereupon the Secretary of the Treasury shall cause one or more copies of the same to be transmitted to each collector or other proper officer of customs.

(75) Pub. L. 93–596 substituted “name of the any domestic” for “name of the any domestic”; “name of the any domestic” for “name of the any domestic”; “name of any domestic” for “name of the any domestic”.

Effective Date of 1975 Amendment


REPEAL AND EFFECT ON EXISTING RIGHTS

Repeal of inconsistent provisions, effect of this chapter on pending proceedings and existing registrations and rights under prior acts, see notes set out under section 1 of Title 35, Patents.

Transfer of Functions

For transfer of functions of other officers, employees, and agencies of Department of Commerce, with certain exceptions, to Secretary of Commerce, with power to delegate, see Reorg. Plan No. 5, of 1950, §§ 1, 2, eff. May 24, 1950, 15 F.R. 3174, 64 Stat. 1263, set out in the Appendix to Title 5, Government Organization and Employees.

§ 1125. False designations of origin, false descriptions, and dilution forbidden

(a) Civil action

(1) Any person who, on or in connection with any goods or services, or any container for goods, uses in commerce any word, term, name, symbol, or device, or any combination thereof, or any false designation of origin, false or misleading description of fact, or false or misleading representation of fact, which—

(A) is likely to cause confusion, or to cause mistake, or to deceive as to the affiliation, connection, or association of such person with another person, or as to the origin, sponsorship, or approval of his or her goods, services, or commercial activities by another person, or
(B) in commercial advertising or promotion, misrepresents the nature, characteristics, qualities, or geographic origin of his or her or another person’s goods, services, or commercial activities, shall be liable in a civil action by any person who believes that he or she is or is likely to be damaged by such act.

(2) As used in this subsection, the term “any person” includes any State, instrumentality of a State or employee of a State or instrumentality of a State acting in his or her official capacity.

Any State, and any such instrumentality, officer, or employee, shall be subject to the provisions of this chapter in the same manner and to the same extent as any nongovernmental entity.

(3) In a civil action for trade dress infringement under this chapter for trade dress not registered on the principal register, the person who asserts trade dress protection has the burden of proving that the matter sought to be protected is not functional.

(b) Importation

Any goods marked or labeled in contravention of the provisions of this section shall not be imported into the United States or admitted to entry at any customhouse of the United States. The owner, importer, or consignee of goods refused entry at any customhouse under this section may have any recourse by protest or appeal that is given under the customs revenue laws or may have the remedy given by this chapter in cases involving goods refused entry or seized.

(c) Dilution by blurring; dilution by tarnishment

(1) Injunctive relief

Subject to the principles of equity, the owner of a famous mark that is distinctive, inherently or through acquired distinctiveness, shall be entitled to an injunction against another person who, at any time after the owner’s mark has become famous, commences use of a mark or trade name in commerce that is likely to cause dilution by blurring or dilution by tarnishment of the famous mark, regardless of the presence or absence of actual or likely confusion, of competition, or of actual economic injury.

(2) Definitions

(A) For purposes of paragraph (1), a mark is famous if it is widely recognized by the general consuming public of the United States as a designation of source of the goods or services of the mark’s owner. In determining whether a mark possesses the requisite degree of recognition, the court may consider all relevant factors, including the following:

(i) The degree of inherent or acquired distinctiveness of the mark.

(ii) The extent of actual recognition of the mark.

(iii) The extent of actual recognition of the mark.

(iv) Whether the mark was registered under the Act of March 3, 1881, or the Act of February 20, 1905, or on the principal register.

(B) For purposes of paragraph (1), “dilution by blurring” is association arising from the similarity between a mark or trade name and a famous mark that impairs the distinctiveness of the famous mark. In determining whether a mark or trade name is likely to cause dilution by blurring, the court may consider all relevant factors, including the following:

(i) The degree of similarity between the mark or trade name and the famous mark.

(ii) The degree of inherent or acquired distinctiveness of the famous mark.

(iii) The extent to which the owner of the famous mark is engaging in substantially exclusive use of the mark.

(iv) The degree of recognition of the famous mark.

(v) Whether the user of the mark or trade name intended to create an association with the famous mark.

(vi) Any actual association between the mark or trade name and the famous mark.

(C) For purposes of paragraph (1), “dilution by tarnishment” is association arising from the similarity between a mark or trade name and a famous mark that harms the reputation of the famous mark.

(3) Exclusions

The following shall not be actionable as dilution by blurring or dilution by tarnishment under this subsection:

(A) Any fair use, including a nominative or descriptive fair use, or facilitation of such fair use, of a famous mark by another person other than as a designation of source for the person’s own goods or services, including use in connection with—

(i) advertising or promotion that permits consumers to compare goods or services;

(ii) identifying and parodying, criticizing, or commenting upon the famous mark owner or the goods or services of the famous mark owner.

(B) All forms of news reporting and news commentary.

(C) Any noncommercial use of a mark.

(4) Burden of proof

In a civil action for trade dress dilution under this chapter for trade dress not registered on the principal register, the person who asserts trade dress protection has the burden of proving that—

(A) the claimed trade dress, taken as a whole, is not functional and is famous; and

(B) if the claimed trade dress includes any mark or marks registered on the principal register, the unregistered matter, taken as a whole, is famous separate and apart from any fame of such registered marks.

(5) Additional remedies

In an action brought under this subsection, the owner of the famous mark shall be entitled to injunctive relief as set forth in section 1116 of this title. The owner of the famous mark shall also be entitled to the remedies set forth in sections 1117(a) and 1118 of this title,
subject to the discretion of the court and the
principles of equity if—

(A) the mark or trade name that is likely to
cause dilution by blurring or dilution by
tarnishment was first used in commerce by
the person against whom the injunction is
sought after October 6, 2006; and

(B) in a claim arising under this sub-
section—

(i) by reason of dilution by blurring, the
person against whom the injunction is
sought willfully intended to harm the rep-
utation of the famous mark.

(6) Ownership of valid registration a complete
bar to action

The ownership by a person of a valid reg-
istration under the Act of March 3, 1881, or the
Act of February 20, 1905, or on the principal
register under this chapter shall be a complete
bar to an action against that person, with re-
spect to that mark, that—

(A) is brought by another person under the
common law or a statute of a State; and

(B)(i) seeks to prevent dilution by blurring
or dilution by tarnishment; or

(ii) asserts any claim of actual or likely
damage or harm to the distinctiveness or
reputation of a mark, label, or form of ad-
vertisement.

(7) Savings clause

Nothing in this subsection shall be con-
strued to impair, modify, or supersede the
applicability of the patent laws of the United
States.

d) Cyberpiracy prevention

(1)(A) A person shall be liable in a civil action
by the owner of a mark, including a personal
name which is protected as a mark under this
section, if, without regard to the goods or ser-
vices of the parties, that person—

(i) has a bad faith intent to profit from that
mark, including a personal name which is pro-
tected as a mark under this section; and

(ii) registers, traffics in, or uses a domain
name that—

(I) in the case of a mark that is distinctive
at the time of registration of the domain
name, is identical or confusingly similar to
that mark;

(II) in the case of a famous mark that is
famous at the time of registration of the
domain name, is identical or confusingly simi-
lar to or dilutive of that mark; or

(III) is a trademark, word, or name pro-
tected by reason of section 706 of title 18 or
section 220506 of title 36.

(B)(i) In determining whether a person has a
bad faith intent described under subpara-
graph (A), a court may consider factors such as, but
not limited to—

(I) the trademark or other intellectual prop-
erty rights of the person, if any, in the domain
name;

(II) the extent to which the domain name
consists of the legal name of the person or a
name that is otherwise commonly used to
identify that person;

(III) the person’s prior use, if any, of the do-
main name in connection with the bona fide
offering of any goods or services;

(IV) the person’s bona fide noncommercial or
fair use of the mark in a site accessible under
the domain name;

(V) the person’s intent to divert consumers
from the mark owner’s online location to a
site accessible under the domain name that
could harm the goodwill represented by the
mark, either for commercial gain or with the
intent to tarnish or disparage the mark, by
creating a likelihood of confusion as to the
source, sponsorship, affiliation, or endorse-
ment of the site;

(VI) the person’s offer to transfer, sell, or
otherwise assign the domain name to the
mark owner or any third party for financial
gain without having used, or having an intent
to use, the domain name in the bona fide offer-
ing of any goods or services, or the person’s
prior conduct indicating a pattern of such con-
duct;

(VII) the person’s provision of material and
misleading false contact information when ap-
plying for the registration of the domain
name, the person’s intentional failure to
maintain accurate contact information, or the
person’s prior conduct indicating a pattern of
such conduct;

(VIII) the person’s registration or acquisi-
tion of multiple domain names which the per-
son knows are identical or confusingly similar
to marks of others that are distinctive at the
time of registration of such domain names, or
dilutive of famous marks of others that are fa-
mous at the time of registration of such do-
main names, without regard to the goods or
services of the parties; and

(IX) the extent to which the mark incor-
porated in the person’s domain name registra-
tion is or is not distinctive and famous within
the meaning of subsection (c).

(ii) Bad faith intent described under subpara-
graph (A) shall not be found in any case in which
the court determines that the person believed
and had reasonable grounds to believe that the
use of the domain name was a fair use or other-
wise lawful.

(C) In any civil action involving the registra-
tion, trafficking, or use of a domain name under
this paragraph, a court may order the forfei-
ture or cancellation of the domain name or the tran-
sfer of the domain name to the owner of the
mark.

(D) A person shall be liable for using a domain
name under subparagraph (A) only if that person
is the domain name registrant or that reg-
istrant’s authorized licensee.

(E) As used in this paragraph, the term ‘‘traf-
fics in’’ refers to transactions that include, but
are not limited to, sales, purchases, loans,
pledges, licenses, exchanges of currency, and
any other transfer for consideration or receipt
in exchange for consideration.

(2)(A) The owner of a mark may file an in rem
civil action against a domain name in the judi-

cial district in which the domain name reg-
istrant, domain name registry, or other domain
name authority that registered or assigned the domain name is located if—

(i) the domain name violates any right of the owner of a mark registered in the Patent and Trademark Office, or protected under subsection (a) or (c) of this section; and

(ii) the court finds that the owner—

(I) is not able to obtain in personam jurisdiction over a person who would have been a defendant in a civil action under paragraph (1); or

(II) through due diligence was not able to find a person who would have been a defendant in a civil action under paragraph (1) by—

(aa) sending a notice of the alleged violation and intent to proceed under this paragraph to the registrant of the domain name at the postal and e-mail address provided by the registrant to the registrar; and

(bb) publishing notice of the action as the court may direct promptly after filing the action.

(B) The actions under subparagraph (A)(i) shall constitute service of process.

(C) In an action under this paragraph, a domain name shall be deemed to have its situs in the judicial district in which—

(i) the domain name registrar, registry, or other domain name authority that registered or assigned the domain name is located; or

(ii) documents sufficient to establish control and authority regarding the disposition of the registration and use of the domain name are deposited with the court.

(D)(i) The remedies in an in rem action under this paragraph shall be limited to a court order for the forfeiture or cancellation of the domain name or the transfer of the domain name to the owner of the mark. Upon receipt of written notification of a filed, stamped copy of a complaint filed by the owner of a mark in a United States district court under this paragraph, the domain name registrar, domain name registry, or other domain name authority shall—

(I) expeditiously deposit with the court documents sufficient to establish the court’s control and authority regarding the disposition of the registration and use of the domain name to the court; and

(II) not transfer, suspend, or otherwise modify the domain name during the pendency of the action, except upon order of the court.

(ii) The domain name registrar or registry or other domain name authority shall not be liable for injunctive or monetary relief under this paragraph except in the case of bad faith or reckless disregard, which includes a willful failure to comply with any such court order.

(3) The civil action established under paragraph (1) and the in rem action established under paragraph (2), and any remedy available under either such action, shall be in addition to any other civil action or remedy otherwise applicable.

(4) The in rem jurisdiction established under paragraph (2) shall be in addition to any other jurisdiction that otherwise exists, whether in rem or in personam.


REFERENCES IN TEXT


PRIOR PROVISIONS


AMENDMENTS

2012—Subsec. (c)(6). Pub. L. 112–119 added subpars. (A) and (B) and struck out former subpars. (A) and (B) which read as follows—

“(A)(i) is brought by another person under the common law or a statute of a State; and

“(ii) seeks to prevent dilution by blurring or dilution by tarnishment; or

“(B) asserts any claim of actual or likely damage or harm to the distinctiveness or reputation of a mark, label, or form of advertisement, or

2006—Subsec. (c). Pub. L. 109–312, §2(1), added subsec. (c) and struck out former subsec. (c) which related to remedies for dilution of famous marks.


2012—Subsec. (c)(6). Pub. L. 112–119 added subpars. (A) and (B) and struck out former subpars. (A) and (B) which read as follows—

“(A)(i) is brought by another person under the common law or a statute of a State; and

“(ii) seeks to prevent dilution by blurring or dilution by tarnishment; or

“(B) asserts any claim of actual or likely damage or harm to the distinctiveness or reputation of a mark, label, or form of advertisement, or

1992—Subsec. (a). Pub. L. 102–542 designated existing provisions as par. (1), redesignated former pars. (1) and (2) as subpars. (A) and (B), respectively, and added par. (2).

1988—Subsec. (a). Pub. L. 100–667 amended subsec. (a) generally. Prior to amendment, subsec. (a) read as follows—

“Any person who shall affix, apply, or annex, or use in connection with any goods or services, or any container or containers for goods, a false designation of origin, or any false description or representation, including words or other symbols tending falsely to describe or represent the same, and shall cause such goods or services to enter into commerce, and any person who shall with knowledge of the falsity of such designation of origin or description or representation cause or procure the same to be transported or used in commerce or deliver the same to any carrier to be transported or used, shall be liable to a civil action by any person doing business in the locality falsely indicated as that of origin or in the region in which said locality is situated, or by any person who believes that he is or is likely to be damaged by the use of any such false description or representation.”

EFFECTIVE DATE OF 2012 AMENDMENT

Pub. L. 112–190, §1(b), Oct. 5, 2012, provided that: “The amendment made by subsection (a) [amending this section] shall apply to any action commenced on or after the date of the enactment of this Act [Oct. 5, 2012].”

EFFECTIVE DATE OF 1999 AMENDMENT

Amendment by Pub. L. 106–113 applicable to all domain names registered before, on, or after Nov. 29, 1999, see section 1000(a)(9) [title III, §3010] of Pub. L. 106–113, set out as a note under section 1117 of this title.
Effective Date of 1996 Amendment
Pub. L. 104–98, §5, Jan. 16, 1996, 109 Stat. 987, provided that: "This Act [amending this section and section 1127 of this title and enacting provisions set out as a note under section 1051 of this title] and the amendments made by this Act shall take effect on the date of the enactment of this Act [Jan. 16, 1996]."

Effective Date of 1992 Amendment
Amendment by Pub. L. 102–542 effective with respect to violations that occur on or after Oct. 27, 1992, see section 4 of Pub. L. 102–542, set out as a note under section 1114 of this title.

Effective Date of 1988 Amendment
Amendment by Pub. L. 100–667 effective one year after Nov. 16, 1990, see section 136 of Pub. L. 100–667, set out as a note under section 1051 of this title.

Repeal and Effect on Existing Rights
Repeal of inconsistent provisions, effect of this chapter on pending proceedings and existing registrations and rights under prior acts, see notes set out under section 1051 of this title.

Study on Abusive Domain Name Registrations Involving Personal Names

"(a) IN GENERAL.—Not later than 180 days after the date of the enactment of this Act [Nov. 29, 1999], the Secretary of Commerce, in consultation with the Patent and Trademark Office and the Federal Election Commission, shall conduct a study and report to Congress with recommendations on guidelines and procedures for resolving disputes involving the registration or use by a person of a domain name that includes the personal name of another person, in whole or in part, or a name confusingly similar thereto, including consideration of and recommendations for—

"(1) protecting personal names from registration by another person as a second level domain name for purposes of selling or otherwise transferring such domain name to such other person or any third party for financial gain;

"(2) protecting individuals from bad faith uses of their personal names as second level domain names by others with malicious intent to harm the reputation of the individual or the goodwill associated with that individual’s name;

"(3) protecting consumers from the registration and use of domain names that include personal names in the second level domain in manners which are intended or are likely to confuse or deceive the public as to the affiliation, connection, or association of the domain name registrant, or a site accessible under the domain name, with such other person, or as to the origin, sponsorship, or approval of the goods, services, or commercial activities of the domain name registrant;

"(4) protecting the public from registration of domain names that include the personal names of government officials, official candidates, and potential official candidates for Federal, State, or local political office in the United States, and the use of such domain names in a manner that disrupts the electoral process or the public’s ability to access accurate and reliable information regarding such individuals;

"(5) existing remedies, whether under State law or otherwise, and the extent to which such remedies are sufficient to address the considerations described in paragraphs (1) through (4); and

"(6) the guidelines, procedures, and policies of the Internet Corporation for Assigned Names and Numbers and the extent to which they address the considerations described in paragraphs (1) through (4)."

"(b) GUIDELINES AND PROCEDURES.—The Secretary of Commerce shall, under its Memorandum of Understanding with the Internet Corporation for Assigned Names and Numbers, collaborate to develop guidelines and procedures for resolving disputes involving the registration or use by a person of a domain name that includes the personal name of another person, in whole or in part, or a name confusingly similar thereto."

§1126. International Conventions
(a) Register of marks communicated by international bureaus
The Director shall keep a register of all marks communicated to him by the international bureaus provided for by the conventions for the protection of industrial property, trademarks, trade and commercial names, and the repression of unfair competition to which the United States is or may become a party, and upon the payment of the fees required by such conventions and the fees required in this chapter may place the marks so communicated upon such register. This register shall show a facsimile of the mark or trade or commercial name; the name, citizenship, and address of the registrant; the number, date, and place of the first registration of the mark, including the dates on which application for such registration was filed and granted and the term of such registration; a list of goods or services to which the mark is applied as shown by the registration in the country of origin, and such other data as may be useful concerning the mark. This register shall be a continuation of the register provided in section 1(a) of the Act of March 19, 1920.
(b) Benefits of section to persons whose country of origin is party to convention or treaty
Any person whose country of origin is a party to any convention or treaty relating to trademarks, trade or commercial names, or the repression of unfair competition, to which the United States is also a party, or extends reciprocal rights to nationals of the United States by law, shall be entitled to the benefits of this section under the conditions expressed herein to the extent necessary to give effect to any provision of such convention, treaty or reciprocal law, in addition to the rights which any owner of a mark is otherwise entitled by this chapter.
(c) Prior registration in country of origin; country of origin defined
No registration of a mark in the United States by a person described in subsection (b) of this section shall be granted until such mark has been registered in the country of origin of the applicant, unless the applicant alleges use in commerce. For the purposes of this section, the country of origin of the applicant is the country in which he has a bona fide and effective industrial or commercial establishment, or if he has not such an establishment the country in which he is domiciled, or if he has not a domicile in any of the countries described in subsection (b) of this section, the country of which he is a national.
(d) Right of priority
An application for registration of a mark under section 1051, 1053, 1054, or 1091 of this title or under subsection (e) of this section, filed by
be protected without the obligation of filing or registration whether or not they form parts of marks.

(h) Protection of foreign nationals against unfair competition

Any person designated in subsection (b) of this section as entitled to the benefits and subject to the provisions of this chapter shall be entitled to effective protection against unfair competition, and the remedies provided in this chapter for infringement of marks shall be available so far as they may be appropriate in repressing acts of unfair competition.

(i) Citizens or residents of United States entitled to benefits of section

Citizens or residents of the United States shall have the same benefits as are granted by this section to persons described in subsection (b) of this section.


REFERENCES IN TEXT

Section 1(a) of the Act of March 19, 1920, referred to in subsec. (a), is section 1(a) of act Mar. 19, 1920, ch. 104, 41 Stat. 533, which was classified to section 121(a) of title 15, and repealed by act July 5, 1946, ch. 540, § 121(a)(12), 60 Stat. 441.

PRIORITY PROVISIONS


Amendments

2002—Subsec. (e). Pub. L. 107–273 substituted “a true copy, a photocopy, a certification,” for ““a certification”.”


1998—Subsec. (d), Pub. L. 105–330, § 108(1)(A), in introductory provisions, substituted “or 1091 of this title or under subsection (e) of this section” for ““1091 of this title, or subsection (e) of this section”’.


Subsec. (e). Pub. L. 105–330, § 108(2), substituted “such applicant shall submit, within such time period as may be prescribed by the Commissioner, a certification or a certified copy of the registration in the country of origin of the applicant” for ““The application therefore shall be accompanied by a certification or a certified copy of the registration in the country of origin of the applicant””.

1988—Subsec. (a). Pub. L. 100–667, §133(2), substituted ““required in this chapter” for “herein prescribed.”

MENDMENTS

1988—Pub. L. 100–667, § 133(2), substituted ““required in this chapter” for “herein prescribed.”

a person described in subsection (b) of this section who has previously duly filed an application for registration of the same mark in one of the countries described in subsection (b) of this section shall be accorded the same force and effect as would be accorded to the same application if filed in the United States on the same date on which the application was first filed in such foreign country: Provided, That—

(1) the application in the United States is filed within six months from the date on which the application was first filed in the foreign country;

(2) the application conforms as nearly as practicable to the requirements of this chapter, including a statement that the applicant has a bona fide intention to use the mark in commerce;

(3) the rights acquired by third parties before the date of the filing of the first application in the foreign country shall in no way be affected by a registration obtained on an application filed under this subsection;

(4) nothing in this subsection shall entitle the owner of a registration granted under this section to sue for acts committed prior to the date on which his mark was registered in this chapter unless the registration is based on use in commerce.

In like manner and subject to the same conditions and requirements, the right provided in this section may be based upon a subsequent regularly filed application in the same foreign country, instead of the first filed foreign application: Provided, That any foreign application filed prior to such subsequent application has been withdrawn, abandoned, or otherwise disposed of, without having been laid open to public inspection and without leaving any rights outstanding, and has not served, nor thereafter shall serve, as a basis for claiming a right of priority.

(e) Registration on principal or supplemental register; copy of foreign registration

A mark duly registered in the country of origin of the foreign applicant may be registered on the supplemental register in this chapter provided the following conditions and requirements are met:

(i) Citizens or residents of the United States shall be entitled to benefits of section

Citizens or residents of the United States shall be entitled to the benefits and subject to the provisions of this chapter.

(j) Protection of foreign nationals against unfair competition

Any person designated in subsection (b) of this section as entitled to the benefits and subject to the provisions of this chapter shall be entitled to effective protection against unfair competition, and the remedies provided in this chapter for infringement of marks shall be available so far as they may be appropriate in repressing acts of unfair competition.

(k) Domestic registration independent of foreign registration

The registration of a mark under the provisions of subsections (c), (d), and (e) of this section by a person described in subsection (b) of this section shall be independent of the registration in the country of origin and the duration, validity, or transfer in the United States of such registration shall be governed by the provisions of this chapter.

(l) Trade or commercial names of foreign nations protected without registration

Trade names or commercial names of persons described in subsection (b) of this section shall be protected without the obligation of filing or registration whether or not they form parts of marks.
Subsec. (c). Pub. L. 100–667, §133(1), made technical amendment in two places to references in the original act to subsection (b) of this section, resulting in no change in text.

Subsec. (d). Pub. L. 100–667, §133(1), (3), (4), (5), in introductory provisions, made technical amendment in two places to references in the original act to subsection (b) of this section, resulting in no change in text, and substituted “section 1051, 1053, 1054, or 1091 of this title, or subsection (e) of this section” for “sections 1051, 1052, 1053, 1054, or 1091 of this title”, in par. (2), substituted “including a statement that the applicant has a bona fide intention to use the mark in commerce” for “but use in commerce need not be alleged”, and in par. (3), substituted “foreign” for “foreigning”.

Subsec. (e). Pub. L. 100–667, §133(6), inserted at end “The application must state the applicant's bona fide intention to use the mark in commerce, but use in commerce shall not be required prior to registration.”

Subsec. (f). Pub. L. 100–667, §133(1), (7), made technical amendment to references in the original act to subsection (b) of this section, resulting in no change in text.

Subsecs. (g) to (l). Pub. L. 100–667, §133(1), (8), made technical amendment to references in the original act to subsection (b) of this section, resulting in no change in text.

1962—Subsec. (b). Pub. L. 87–772 inserted “or extends reciprocal rights to nationals of the United States by law,” and substituted provisions requiring the person's country of origin to be a party to any convention or treaty, for provisions which required such persons to be nationals of, domiciled in, or have a bona fide and effective business or commercial establishment in a foreign country which was a party to the International Convention for the Protection of Industrial Property, or the General Inter-American Convention for Trade Mark and Commercial Protection, or any other convention or treaty relating to trademarks, trade, or commercial names.

Subsec. (e). Pub. L. 87–772 inserted “certification or a” after “accompanied by” and struck out “application for or” before “registration”.

1961—Subsec. (d). Pub. L. 87–333 inserted par. at end authorizing the right provided by this section to be based upon a subsequent application in the same foreign country, instead of the first application, provided that any foreign application filed prior to such subsequent one was withdrawn, or otherwise disposed of, without having been open to public inspection and without leaving any rights outstanding, nor any basis for claiming priority.

EFFECTIVE DATE OF 1999 AMENDMENT
Amendment by Pub. L. 106–113 effective 4 months after Nov. 29, 1999, see section 1000(a)(9) [title IV, §4731] of Pub. L. 106–113, set out as a note under section 1 of Title 33, Patents.

EFFECTIVE DATE OF 1998 AMENDMENT

For provisions relating to applicability of amendment by Pub. L. 105–330 to applications for registration of trademarks, see section 109(b) of Pub. L. 105–330, set out as a note under section 1051 of this title.

EFFECTIVE DATE OF 1988 AMENDMENT
Amendment by Pub. L. 100–667 effective one year after Nov. 16, 1988, see section 136 of Pub. L. 100–667, set out as a note under section 1051 of this title.

EFFECTIVE DATE OF 1961 AMENDMENT
Pub. L. 87–333, §3, Oct. 3, 1961, 75 Stat. 748, provided that: “This Act [amending this section and section 119 of Title 33, Patents] shall take effect on the date when the Convention of Paris for the Protection of Industrial Property of March 20, 1883, as revised at Lisbon, October 31, 1958, comes into force with respect to the United States and shall apply only to applications thereafter filed in the United States by persons entitled to the benefit of said convention, as revised at the time of such filing.”

REPEAL AND EFFECT ON EXISTING RIGHTS
Repeal of inconsistent provisions, effect of this chapter on pending proceedings and existing registrations and rights under prior acts, see notes set out under section 1051 of this title.

TRANSFER OF FUNCTIONS
For transfer of functions of other officers, employees, and agencies of Department of Commerce, with certain exceptions, to Secretary of Commerce, with power to delegate, see Reorg. Plan No. 5 of 1950, §§1, 2, eff. May 24, 1950, 15 F.R. 3174, 64 Stat. 1263, set out in the Appendix to Title 5, Government Organization and Employees.

§1127. Construction and definitions; intent of chapter
In the construction of this chapter, unless the contrary is plainly apparent from the context—

The United States includes and embraces all territory which is under its jurisdiction and control. The word “commerce” means all commerce which may lawfully be regulated by Congress. The term “principal register” refers to the register provided for by sections 1051 to 1072 of this title, and the term “supplemental register” refers to the register provided for by sections 1091 to 1096 of this title.

The term “person” and any other word or term used to designate the applicant or other entitled to a benefit or privilege or rendered liable under the provisions of this chapter includes a juristic person as well as a natural person. The term “juristic person” includes a firm, corporation, union, association, or other organization capable of suing and being sued in a court of law.

The term “person” also includes the United States, any agency or instrumentality thereof, or any individual, firm, or corporation acting for the United States and with the authorization and consent of the United States. The United States, any agency or instrumentality thereof, and any individual, firm, or corporation acting for the United States and with the authorization and consent of the United States, shall be subject to the provisions of this chapter in the same manner and to the same extent as any nongovernmental entity.

The term “person” also includes any State, any instrumentality of a State, and any officer or employee of a State or instrumentality of a State acting in his or her official capacity. Any State, and any such instrumentality, officer, or employee, shall be subject to the provisions of this chapter in the same manner and to the same extent as any nongovernmental entity.

The terms “applicant” and “registrant” embrace the legal representatives, predecessors, successors and assigns of such applicant or registrant.

The term “Director” means the Under Secretary of Commerce for Intellectual Property and Director of the United States Patent and Trademark Office.
The term “related company” means any person whose use of a mark is controlled by the owner of the mark with respect to the nature and quality of the goods or services on or in connection with which the mark is used.

The term “commercial name” means any name used by a person to identify his or her business or vocation.

The term “trademark” includes any word, name, symbol, or device, or any combination thereof—

(1) used by a person, or
(2) which a person has a bona fide intention to use in commerce and applies to register on the principal register established by this chapter,

to identify and distinguish his or her goods, including a unique product, from those manufactured or sold by others and to indicate the source of the goods, even if that source is unknown.

The term “service mark” means any word, name, symbol, or device, or any combination thereof—

(1) used by a person, or
(2) which a person has a bona fide intention to use in commerce and applies to register on the principal register established by this chapter,

to identify and distinguish the services of one person, including a unique service, from the services of others and to indicate the source of the services, even if that source is unknown.

The term “certification mark” means any word, name, symbol, or device, or any combination thereof—

(1) used by a person other than its owner, or
(2) which its owner has a bona fide intention to permit a person other than the owner to use in commerce and files an application to register on the principal register established by this chapter,

to certify regional or other origin, material, mode of manufacture, quality, accuracy, or other characteristics of such person’s goods or services or that the work or labor on the goods or services was performed by members of a union or other organization.

The term “collective mark” means a trade-mark or service mark—

(1) used by the members of a cooperative, an association, or other collective group or organization, or
(2) which such cooperative, association, or other collective group or organization has a bona fide intention to use in commerce and applies to register on the principal register established by this chapter,

and includes marks indicating membership in a union, an association, or other organization.

The term “mark” includes any trademark, service mark, collective mark, or certification mark.

The term “use in commerce” means the bona fide use of a mark in the ordinary course of trade, and not made merely to reserve a right in a mark. For purposes of this chapter, a mark shall be deemed to be in use in commerce—

(1) on goods when—
(A) it is placed in any manner on the goods or their containers or the displays associated therewith or on the tags or labels affixed thereto, or if the nature of the goods makes such placement impracticable, then on documents associated with the goods or their sale, and
(B) the goods are sold or transported in commerce, and
(2) on services when it is used or displayed in the sale or advertising of services and the services are rendered in commerce, or the services are rendered in more than one State or in the United States and a foreign country and the person rendering the services is engaged in commerce in connection with the services.

A mark shall be deemed to be “abandoned” if either of the following occurs:

(1) When its use has been discontinued with intent not to resume such use. Intent not to resume may be inferred from circumstances. Nonuse for 3 consecutive years shall be prima facie evidence of abandonment. “Use” of a mark means the bona fide use of such mark made in the ordinary course of trade, and not made merely to reserve a right in a mark.
(2) When any course of conduct of the owner, including acts of omission as well as commission, causes the mark to become the generic name for the goods or services on or in connection with which it is used or otherwise to lose its significance as a mark. Purchaser motivation shall not be a test for determining abandonment under this paragraph.

The term “colorable imitation” includes any mark which so resembles a registered mark as to be likely to cause confusion or mistake or to deceive.

The term “registered mark” means a mark registered in the United States Patent and Trademark Office under this chapter or under the Act of March 3, 1881, or the Act of February 20, 1905, or the Act of March 19, 1920. The phrase “marks registered in the Patent and Trademark Office” means registered marks.


A “counterfeit” is a spurious mark which is identical with, or substantially indistinguishable from, a registered mark.

The term “domain name” means any alphanumeric designation which is registered with or assigned by any domain name registrar, domain name registry, or other domain name registration authority as part of an electronic address on the Internet.

The term “Internet” has the meaning given that term in section 230(f)(1) of title 47.

Words used in the singular include the plural and vice versa.

The intent of this chapter is to regulate commerce within the control of Congress by making actionable the deceptive and misleading use of marks in such commerce; to protect registered
marks used in such commerce from interference by State, or territorial legislation; to protect persons engaged in such commerce against unfair competition; to prevent fraud and deception in such commerce by the use of reproductions, copies, counterfeits, or colorable imitations of registered marks; and to provide rights and remedies stipulated by treaties and conventions respecting trademarks, trade names, and unfair competition entered into between the United States and foreign nations.


REFERENCES IN TEXT


PrioR PROVISIONS


AMENDMENTS


Prior to amendment, par. read as follows: “The term ‘Commissioner’ means the Commissioner of Patents and Trademarks.”


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Prior to amendment, par. read as follows: “The term ‘Commissioner’ means the Commissioner of Patents and Trademarks.”

1996—Pub. L. 104–98 inserted par. defining “dilution” after par. defining “abandoned”. Pub. L. 103–465 amended par. defining “abandoned” generally. Prior to amendment, par. read as follows: “A mark shall be deemed to be ‘abandoned’ when either of the following occurs: ‘(1) When its use has been discontinued with intent not to resume such use. Intent not to resume may be inferred from circumstances. Nonuse for two consecutive years shall be prima facie evidence of abandon ment. ‘Use’ of a mark means the bona fide use of that mark made in the ordinary course of trade, and not made merely to reserve a right in a mark. ‘(2) When any course of conduct of the owner, including acts of omission as well as commission, causes the mark to become the generic name for the goods or services on or in connection with which it is used or otherwise to lose its significance as a mark. Purchaser motivation shall not be a test for determining abandonment under this paragraph.’”

1992—Pub. L. 102–542 inserted after fourth undesignated par. “The term ‘person’ also includes any State, any instrumentality of a State, and any officer or employee of a State or instrumentality of a State acting in his or her official capacity. Any State, and any such instrumentality, officer, or employee, shall be subject to the provisions of this chapter in the same manner and to the same extent as any nongovernmental entity.”

1988—Pub. L. 100–667, § 134(1), amended par. defining “related company” generally. Prior to amendment, par. read as follows: “The term ‘related company’ means any person who legitimately controls or is controlled by the registrant or applicant for registration in respect to the nature and quality of the goods or services in connection with which the mark is used.”

Prior to amendment, par. read as follows: “The terms ‘trade name’ and ‘commercial name’ include individual names and surnames, firm names and trade names used by manufacturers, industrialists, merchants, agriculturists, and others to identify their businesses, vocations, or occupations; the names or titles lawfully adopted and used by persons, associations, corporations, companies, unions, and any manufacturing, industrial, commercial, agricultural, or other organizations engaged in trade or commerce and capable of suing and being sued in a court of law.”

Pub. L. 100–667, § 134(2), amended par. defining “trade mark” and “commercial name” generally. Prior to amendment, par. read as follows: “The terms ‘trade name’ and ‘commercial name’ include individual names and surnames, firm names and trade names used by manufacturers, industrialists, merchants, agriculturists, and others to identify their businesses, vocations, or occupations; the names or titles lawfully adopted and used by persons, associations, corporations, companies, unions, and any manufacturing, industrial, commercial, agricultural, or other organizations engaged in trade or commerce and capable of suing and being sued in a court of law.”

Pub. L. 100–667, § 134(3), amended par. defining “trade mark” generally. Prior to amendment, par. read as follows: “The term ‘trademark’ includes any word, name, symbol, or device or any combination thereof adopted and used by a manufacturer or merchant to identify and distinguish his goods, including a unique product, from those manufactured or sold by others and to indicate the source of the goods, even if that source is unknown.”

Pub. L. 100–667, § 134(4), amended par. defining “service mark” generally. Prior to amendment, par. read as follows: “The term ‘service mark’ means a mark used in the sale or advertising of services to identify and distinguish the services of one person, including a unique service, from the services of others and to indicate the source of the services, even if that source is unknown.”

Titles, character names and other distinctive features of radio or television programs may be registered as service marks notwithstanding that they, or the programs, may advertise the goods of the sponsor.”

Pub. L. 100–667, § 134(5), amended par. defining “certification mark” generally. Prior to amendment, par. read as follows: “The term ‘certification mark’ means a mark used upon or in connection with the products or services of one or more persons other than the owner of the mark to certify regional or other origin, material, mode of manufacture, quality, accuracy or other characteristics of such goods or services or that the work or labor on the goods or services was performed by members of a union or other organization.”

Pub. L. 100–667, § 134(6), amended par. defining “collective mark” generally. Prior to amendment, par. read as follows: “The term ‘collective mark’ means a trade mark or service mark used by the members of a cooperative association, an association or other collective group or organization and includes marks used to indicate membership in a union, an association or other organization.”

Pub. L. 100–667, § 134(7), amended par. defining “mark” generally. Prior to amendment, par. read as follows: “The term ‘mark’ includes any trade-mark, service mark, collective mark, or certification mark mark made in the ordinary course of trade, and not made merely to reserve a right in a mark.”

Prior to amendment, par. read as follows: “The term ‘mark’ includes any trade-mark, service mark, collective mark, or certification mark made in the ordinary course of trade, and not made merely to reserve a right in a mark.”
entitled to registration under this chapter whether registered or not.”

Pub. L. 108–467, §134(b), substituted par. defining “use in commerce” for former par. which read as follows: “For the purposes of this chapter a mark shall be deemed to be employed in commerce (a) on goods when it is placed in any manner on the goods or their containers or in the displays associated therewith or on the tags or labels affixed thereto and the goods are sold or transported in commerce and (b) on services when it is used or displayed in the sale or advertising of services and the services are rendered in commerce, or the services are rendered in more than one State or in this and a foreign country and the person rendering the services is engaged in commerce in connection therewith.” and par. providing when a mark is deemed abandoned for former par. which read as follows: “A mark shall be deemed to be ‘abandoned’—

“(a) When its use has been discontinued with intent not to resume may be inferred from circumstances. Nonuse for two consecutive years shall be prima facie abandonment.

“(b) When any course of conduct of the registrant, including acts of omission as well as commission, causes the mark to lose its significance as an indication of origin. Purchaser motivation shall not be a test for determining abandonment under this subparagraph.”

1984—Pub. L. 98–620, §103(1), in definition of “trade-mark” substituted “‘trademark’” for “‘trade-mark’”, and substituted “identify and distinguish his goods, including a unique product, from those manufactured or sold by others and to indicate the source of the goods, even if that source is unknown” for “identify his goods and distinguishing them from those manufactured or sold by others.”

Pub. L. 98–620, §103(2), in definition of “service mark” substituted ‘‘The term ‘service mark’ means a mark used in the sale or advertising of services to identify and distinguish the services of one person, including a unique service, from the services of others and to indicate the source of the services, even if that source is unknown’’ for ‘‘The term ‘service mark’ means a mark used in the sale or advertising of services to identify the services of one person and distinguish them from the services of others’’.

Pub. L. 98–620, §103(3), in subpar. (b) of par. relating to when a mark shall be deemed to be ‘‘abandoned’’, inserted ‘‘Purchaser motivation shall not be a test for determining abandonment under this subparagraph.’’


1962—Pub. L. 87–772 substituted, ‘‘predecessors,’’ for ‘‘ancestors,’’ ‘‘successors,’’ for ‘‘heirs,’’ and ‘‘in definition of ‘applicant’ and ‘registrant’’, ‘‘Titles, character names and other distinctive features of radio or television programs may be registered as service marks notwithstanding that they, or the programs, may advertise the goods of the sponsor’’ for ‘‘and includes without limitation the marks, names, symbols, titles, designs, slogans, character names, and distinctive features of radio or other advertising used in commerce’’, in definition of ‘‘service mark’’, inserted ‘‘or the services are rendered in more than one State or in this and a foreign country and the person rendering the services is engaged in commerce in connection therewith’’ in fifteenth paragraph relating to use in commerce, struck out ‘‘purchasers’’ after ‘‘de- ceive’’ in definition of ‘‘colorable imitation’’, and substituted ‘‘commerce’’ for ‘‘commercium’’ in last par. relating to the intent of the chapter.

Effective Date of 1999 Amendment

Amendment by section 1000(a)(9) [title III, §3005] of Pub. L. 106–113 applicable to all domain names registered before, on, or after Nov. 29, 1999, see section 1000(a)(9) [title III, §3010] of Pub. L. 106–113, set out as a note under section 1117 of this title.

Amendment by section 1000(a)(9) [title IV, §4732(b)(1)(A)] of Pub. L. 106–113 effective 4 months after Nov. 29, 1999, see section 1000(a)(9) [title IV, §4731] of Pub. L. 106–113, set out as a note under section 1 of Title 35, Patents.

Effective Date of 1994 Amendment

Amendment by Pub. L. 103–465 effective one year after the date on which the WTO Agreement enters into force with respect to the United States [Jan. 1, 1995], see section 523 of Pub. L. 103–465, set out as a note under section 1052 of this title.

Effective Date of 1992 Amendment

Amendment by Pub. L. 102–542 effective with respect to violations that occur on or after Oct. 27, 1992, see section 4 of Pub. L. 102–542, set out as a note under section 1114 of this title.

Effective Date of 1988 Amendment

Amendment by Pub. L. 100–667 effective one year after Nov. 16, 1988, see section 136 of Pub. L. 100–667, set out as a note under section 1051 of this title.

Effective Date of 1975 Amendment


Repeal and Effect on Existing Rights

Repeal of inconsistent provisions, effect of this chapter on pending proceedings and existing registrations and rights under prior acts, see notes set out under section 1051 of this title.

Transfer of Functions

For transfer of functions of other officers, employees, and agencies of Department of Commerce, with certain exceptions, to Secretary of Commerce, with power to delegate, see Reorg. Plan No. 5 of 1950, §§1, 2, eff. May 24, 1950, 15 F.R. 3174, 64 Stat. 1263, set out in the Appendix to Title 5, Government Organization and Employees.
has been filed with an Office of a Contracting Party and that constitutes the basis for an application for the international registration of that mark.

(2) Basic registration
The term “basic registration” means the registration of a mark that has been granted by an Office of a Contracting Party and that constitutes the basis for an application for the international registration of that mark.

(3) Contracting Party
The term “Contracting Party” means any country or inter-governmental organization that is a party to the Madrid Protocol.

(4) Date of recordal
The term “date of recordal” means the date on which a request for extension of protection, filed after an international registration is granted, is recorded on the International Register.

(5) Declaration of bona fide intention to use the mark in commerce
The term “declaration of bona fide intention to use the mark in commerce” means a declaration that is signed by the applicant for, or holder of, an international registration who is seeking extension of protection of a mark to the United States and that contains a statement that—
(A) the applicant or holder has a bona fide intention to use the mark in commerce;
(B) the person making the declaration believes himself or herself, or the firm, corporation, or association in whose behalf he or she makes the declaration, to be entitled to use the mark in commerce; and
(C) no other person, firm, corporation, or association, to the best of his or her knowledge and belief, has the right to use such mark in commerce either in the identical form of the mark or in such near resemblance to the mark as to be likely, when used on or in connection with the goods of such other person, firm, corporation, or association, to cause confusion, mistake, or deception.

(6) Extension of protection
The term “extension of protection” means the protection resulting from an international registration that extends to the United States at the request of the holder of the international registration, in accordance with the Madrid Protocol.

(7) Holder of an international registration
A “holder” of an international registration is the natural or juristic person in whose name the international registration is recorded on the International Register.

(8) International application
The term “international application” means an application for international registration that is filed under the Madrid Protocol.

(9) International Bureau

(10) International Register
The term “International Register” means the official collection of data concerning international registrations maintained by the International Bureau that the Madrid Protocol or its implementing regulations require or permit to be recorded.

(11) International registration
The term “international registration” means the registration of a mark granted under the Madrid Protocol.

(12) International registration date
The term “international registration date” means the date assigned to the international registration by the International Bureau.

(13) Madrid Protocol
The term “Madrid Protocol” means the Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks, adopted at Madrid, Spain, on June 27, 1989.

(14) Notification of refusal
The term “notification of refusal” means the notice sent by the United States Patent and Trademark Office to the International Bureau declaring that an extension of protection cannot be granted.

(15) Office of a Contracting Party
The term “Office of a Contracting Party” means—
(A) the office, or governmental entity, of a Contracting Party that is responsible for the registration of marks; or
(B) the common office, or governmental entity, of more than 1 Contracting Party that is responsible for the registration of marks and is so recognized by the International Bureau.

(16) Office of origin
The term “office of origin” means the Office of a Contracting Party with which a basic application was filed or by which a basic registration was granted.

(17) Opposition period
The term “opposition period” means the time allowed for filing an opposition in the United States Patent and Trademark Office, including any extension of time granted under section 1063 of this title.


Effective Date
“(1) the date on which the Madrid Protocol (as defined in section 60 of the Trademark Act of 1946 [this section]) enters into force with respect to the United States [Nov. 2, 2003]; or
“(2) the date occurring 1 year after the date of enactment of this Act [Nov. 2, 2002].”
§ 1141a. International applications based on United States applications or registrations

(a) In general

The owner of a basic application pending before the United States Patent and Trademark Office, or the owner of a basic registration granted by the United States Patent and Trademark Office may file an international application by submitting to the United States Patent and Trademark Office a written application in such form, together with such fees, as may be prescribed by the Director.

(b) Qualified owners

A qualified owner, under subsection (a) of this section, shall—
(1) be a national of the United States;
(2) be domiciled in the United States; or
(3) have a real and effective industrial or commercial establishment in the United States.


§ 1141b. Certification of the international application

(a) Certification procedure

Upon the filing of an application for international registration and payment of the prescribed fees, the Director shall examine the international application for the purpose of certifying that the information contained in the international application corresponds to the information contained in the basic application or basic registration at the time of the certification.

(b) Transmittal

Upon examination and certification of the international application, the Director shall transmit the international application to the International Bureau.


§ 1141c. Restriction, abandonment, cancellation, or expiration of a basic application or basic registration

With respect to an international application transmitted to the International Bureau under section 1141b of this title, the Director shall notify the International Bureau whenever the basic application or basic registration which is the basis for the international application has been restricted, abandoned, or canceled, or has expired, with respect to some or all of the goods and services listed in the international registration—
(1) within 5 years after the international registration date; or
(2) more than 5 years after the international registration date if the restriction, abandonment, or cancellation of the basic application or basic registration resulted from an action that began before the end of that 5-year period.


§ 1141d. Request for extension of protection subsequent to international registration

The holder of an international registration that is based upon a basic application filed with the United States Patent and Trademark Office or a basic registration granted by the Patent and Trademark Office may request an extension of protection of its international registration by filing such a request—
(1) directly with the International Bureau; or
(2) with the United States Patent and Trademark Office for transmittal to the International Bureau, if the request is in such form, and contains such transmittal fee, as may be prescribed by the Director.


§ 1141e. Extension of protection of an international registration to the United States under the Madrid Protocol

(a) In general

Subject to the provisions of section 1141h of this title, the holder of an international registration shall be entitled to the benefits of extension of protection of that international registration to the United States to the extent necessary to give effect to any provision of the Madrid Protocol.

(b) If the United States is office of origin

Where the United States Patent and Trademark Office is the office of origin for a trademark application or registration, any international registration based on such application or registration cannot be used to obtain the benefits of the Madrid Protocol in the United States.


§ 1141f. Effect of filing a request for extension of protection of an international registration to the United States

(a) Requirement for request for extension of protection

A request for extension of protection of an international registration to the United States that the International Bureau transmits to the United States Patent and Trademark Office shall be deemed to be properly filed in the United States if such request, when received by the International Bureau, has attached to it a declaration of bona fide intention to use the mark in commerce that is verified by the applicant for, or holder of, the international registration.

(b) Effect of proper filing

Unless extension of protection is refused under section 1141h of this title, the proper filing of the request for extension of protection under subsection (a) of this section shall constitute constructive use of the mark, conferring the same rights as those specified in section 1057(c) of this title, as of the earliest of the following:

(1)
(1) The international registration date, if the request for extension of protection was filed in the international application.

(2) The date of recordal of the request for extension of protection, if the request for extension of protection was made after the international registration date.

(3) The date of priority claimed pursuant to section 1141g of this title.


§1141g. Right of priority for request for extension of protection to the United States

The holder of an international registration with a request for an extension of protection to the United States shall be entitled to claim a date of priority based on a right of priority within the meaning of Article 4 of the Paris Convention for the Protection of Industrial Property if—

(1) the request for extension of protection contains a claim of priority; and

(2) the date of international registration or the date of the recordal of the request for extension of protection to the United States is not later than 6 months after the date of the first regular national filing (within the meaning of Article 4(A)(3) of the Paris Convention for the Protection of Industrial Property) or a subsequent application (within the meaning of Article 4(C)(4) of the Paris Convention for the Protection of Industrial Property).


§1141h. Examination of and opposition to request for extension of protection; notification of refusal

(a) Examination and opposition

(1) A request for extension of protection described in section 1141f(a) of this title shall be examined as an application for registration on the Principal Register under this chapter, and if on such examination it appears that the applicant is entitled to extension of protection under this subchapter, the Director shall cause the mark to be published in the Official Gazette of the United States Patent and Trademark Office.

(2) Subject to the provisions of subsection (c) of this section, a request for extension of protection under this subchapter shall be subject to opposition under section 1063 of this title.

(3) Extension of protection shall not be refused on the ground that the mark has not been used in commerce.

(4) Extension of protection shall be refused to any mark not registrable on the Principal Register.

(b) Notification of refusal

If, a request for extension of protection is refused under subsection (a) of this section, the Director shall declare in a notification of refusal (as provided in subsection (c) of this section) that the extension of protection cannot be granted, together with a statement of all grounds on which the refusal was based.

(c) Notice to International Bureau

(1) Within 18 months after the date on which the International Bureau transmits to the Patent and Trademark Office a notification of a request for extension of protection, the Director shall transmit to the International Bureau any of the following that applies to such request:

(A) A notification of refusal based on an examination of the request for extension of protection.

(B) A notification of refusal based on an opposition to the request.

(C) A notification of the possibility that an opposition to the request may be filed after the end of that 18-month period.

(2) If the Director has sent a notification of the possibility of opposition under paragraph (1)(C), the Director shall, if applicable, transmit to the International Bureau a notification of refusal on the basis of the opposition, together with a statement of all the grounds for the opposition, within 7 months after the beginning of the opposition period or within 1 month after the end of the opposition period, whichever is earlier.

(3) If a notification of refusal of a request for extension of protection is transmitted under paragraph (1) or (2), no grounds for refusal of such request other than those set forth in such notification may be transmitted to the International Bureau by the Director after the expiration of the time periods set forth in paragraph (1) or (2), as the case may be.

(4) If a notification specified in paragraph (1) or (2) is not sent to the International Bureau within the time period set forth in such paragraph, with respect to a request for extension of protection, the request for extension of protection shall not be refused and the Director shall issue a certificate of extension of protection pursuant to the request.

(d) Designation of agent for service of process

In responding to a notification of refusal with respect to a mark, the holder of the international registration of the mark may designate, by a document filed in the United States Patent and Trademark Office, the name and address of a person residing in the United States for service of notices or process in proceedings affecting the mark may be served. Such notices or process may be served upon the person designated by leaving with that person, or mailing to that person, a copy thereof at the address specified in the last designation filed. If the person designated cannot be found at the address given in the last designation, 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 residing in the United States for service of notices or process in proceedings affecting the mark, the notice or process may be served on the Director.


1 So in original. The comma probably should not appear.
§ 1141i. Effect of extension of protection

(a) Issuance of extension of protection

Unless a request for extension of protection is refused under section 1141h of this title, the Director shall issue a certificate of extension of protection pursuant to the request and shall cause notice of such certificate of extension of protection to be published in the Official Gazette of the United States Patent and Trademark Office.

(b) Effect of extension of protection

From the date on which a certificate of extension of protection is issued under subsection (a) of this section—

(1) such extension of protection shall have the same effect and validity as a registration on the Principal Register; and

(2) the holder of the international registration shall have the same rights and remedies as the owner of a registration on the Principal Register.


§ 1141j. Dependence of extension of protection to the United States on the underlying international registration

(a) Effect of cancellation of international registration

If the International Bureau notifies the United States Patent and Trademark Office of the cancellation of an international registration with respect to some or all of the goods and services listed in the international registration, the Director shall cancel any extension of protection to the United States with respect to such goods and services as of the date on which the international registration was canceled.

(b) Effect of failure to renew international registration

If the International Bureau does not renew an international registration, the corresponding extension of protection to the United States shall cease to be valid as of the date of the expiration of the international registration.

(c) Transformation of an extension of protection into a United States application

The holder of an international registration canceled in whole or in part by the International Bureau at the request of the office of origin, under article 6(4) of the Madrid Protocol, may file an application, under section 1051 or 1126 of this title, for the registration of the same mark for any of the goods and services to which the cancellation applies that were covered by an extension of protection to the United States based on that international registration. Such an application shall be treated as if it had been filed on the international registration date or the date of recordal of the request for extension of protection with the International Bureau, whichever date applies, and, if the extension of protection enjoyed priority under section 1141g of this title, shall enjoy the same priority. Such an application shall be entitled to the benefits conferred by this subsection only if the application is filed not later than 3 months after the date on which the international registration was canceled, in whole or in part, and only if the application complies with all the requirements of this chapter which apply to any application filed pursuant to section 1051 or 1126 of this title.


§ 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 of this title 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.

(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 established in paragraph (1) or (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) shall—

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

(B) set forth the goods and services recited in the extension of protection on or in connection with which the mark is not 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 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 shall 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.


AMENDMENTS

2010—Pub. L. 111–146 amended section generally. Prior to amendment, section related to required affidavits and fees, contents of affidavit, notification of Director's acceptance or refusal, and service of notice or process.

§ 1145l. Assignment of an extension of protection

An extension of protection may be assigned, together with the goodwill associated with the mark, only to a person who is a national of, is domiciled in, or has a bona fide and effective industrial or commercial establishment either in a country that is a Contracting Party or in a country that is a member of an intergovernmental organization that is a Contracting Party.


§ 1145m. Incontestability

The period of continuous use prescribed under section 1065 of this title for a mark covered by an extension of protection issued under this chapter may begin no earlier than the date on which the Director issues the certificate of the extension of protection under section 1141l of this title, except as provided in section 1141n of this title.


§ 1145n. Rights of extension of protection

When a United States registration and a subsequently issued certificate of extension of protection to the United States are owned by the same person, identify the same mark, and list the same goods or services, the extension of protection shall have the same rights that accrued to the registration prior to issuance of the certificate of extension of protection.


CHAPTER 23—DISSEMINATION OF TECHNICAL, SCIENTIFIC AND ENGINEERING INFORMATION

8 sec. Purpose of chapter.
1151. Purpose of chapter.
1152. Clearinghouse for technical information; removal of security classification.
1153. Rules, regulations, and fees.
1153a. Repealed.
1154. Reference of data to armed services and other Government agencies.
1155. General standards and limitations; preservation of security classification.
1156. Use of existing facilities.
1157. Relation to other provisions.

§ 1151. Purpose of chapter

The purpose of this chapter is to make the results of technological research and development more readily available to industry and business, and to the general public, by clarifying and defining the functions and responsibilities of the Department of Commerce as a central clearinghouse for technical information which is useful to American industry and business.

(Sept. 9, 1950, ch. 936, § 1, 64 Stat. 823.)

§ 1152. Clearinghouse for technical information; removal of security classification

The Secretary of Commerce (hereinafter referred to as the “Secretary”) is directed to establish and maintain within the Department of Commerce a clearinghouse for the collection and dissemination of scientific, technical, and engineering information, and to this end to take such steps as he may deem necessary and desirable—

(a) To search for, collect, classify, coordinate, integrate, record, and catalog such information from whatever sources, foreign and domestic, that may be available;

(b) To make such information available to industry and business, to State and local governments, to other agencies of the Federal Government, and to the general public, through the preparation of abstracts, digests, translations, bibliographies, indexes, and microfilm and other reproductions, for distribution either directly or