

TRADEMARK LAW TREATY IMPLEMENTATION ACT

JULY 21, 1997.—Committed to the Committee of the Whole House on the State of the Union and ordered to be printed

Mr. COBLE, from the Committee on the Judiciary,
submitted the following

R E P O R T

[To accompany H.R. 1661]

[Including cost estimate of the Congressional Budget Office]

The Committee on the Judiciary, to whom was referred the bill (H.R. 1661) to implement the provisions of the Trademark Law Treaty, having considered the same, reports favorably thereon with an amendment and recommends that the bill as amended do pass.

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The amendment is as follows:

Strike out all after the enacting clause and insert in lieu thereof the following:

SECTION 1. SHORT TITLE.

This Act may be cited as the “Trademark Law Treaty Implementation Act”.

SEC. 2. REFERENCE TO THE TRADEMARK ACT OF 1946.

For purposes of this Act, the Act entitled “An Act to provide for the registration and protection of trademarks used in commerce, to carry out the provisions of certain international conventions, and for other purposes”, approved July 5, 1946 (15 U.S.C. 1051 et seq.), shall be referred to as the “Trademark Act of 1946”.

SEC. 3. APPLICATION FOR REGISTRATION; VERIFICATION.

(a) APPLICATION FOR USE OF TRADEMARK.—Section 1(a) of the Trademark Act of 1946 (15 U.S.C. 1051(a)) is amended to read as follows:

“SECTION 1. (a)(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 Commissioner, and such number of specimens or facsimiles of the mark as used as may be required by the Commissioner.

“(2) The application shall include specification of the applicant’s domicile and citizenship, the date of the applicant’s first use of the mark, the date of the applicant’s first use of the mark in commerce, the goods in connection with which the mark is used, and a drawing of the mark.

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

“(A) 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 Commissioner. The Commissioner 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.—Subsection (b) of section 1 of the Trademark Act of 1946 (15 U.S.C. 1051(b)) is amended to read as follows:

“(b)(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 Commissioner.

“(2) The application shall include specification of the applicant’s domicile and citizenship, the goods in connection with which the applicant has a bona fide intention to use the mark, and a drawing of the mark.

“(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 entitled to use the mark in commerce;

“(B) the applicant’s bona fide intention to use the mark in commerce;

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

“(D) that, 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 for applications filed pursuant to section 44, no mark shall be registered until the applicant has met the requirements of subsections (c) and (d) of this section.

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

(c) CONSEQUENCE OF DELAYS.—Paragraph (4) of section 1(d) of the Trademark Act of 1946 (15 U.S.C. 1051(d)(4)) is amended to read as follows:

“(4) The failure to timely file a verified statement of use under paragraph (1) or an extension request under paragraph (2) shall result in abandonment of the application, unless it can be shown to the satisfaction of the Commissioner 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.”.

SEC. 4. REVIVAL OF ABANDONED APPLICATION.

Section 12(b) of the Trademark Act of 1946 (15 U.S.C. 1062(b)) is amended in the last sentence by striking “unavoidable” and by inserting “unintentional”.

SEC. 5. DURATION OF REGISTRATION; CANCELLATION; AFFIDAVIT OF CONTINUED USE; NOTICE OF COMMISSIONER'S ACTION.

Section 8 of the Trademark Act of 1946 (15 U.S.C. 1058) is amended to read as follows:

“DURATION

“SEC. 8. (a) Each registration shall remain in force for 10 years, except that the registration of any mark shall be canceled by the Commissioner for failure to comply with the provisions of subsection (b) of this section, upon the expiration of the following time periods, as applicable:

“(1) For registrations issued pursuant to the provisions of this Act, at the end of 6 years following the date of registration.

“(2) For registrations published under the provisions of section 12(c), at the end of 6 years following the date of publication under such section.

“(3) For all registrations, at the end of each successive 10-year period following the date of registration.

“(b) During the 1-year period immediately preceding the end of the applicable time period set forth in subsection (a), the owner of the registration shall pay the prescribed fee and file in the Patent and Trademark Office—

“(1) an affidavit setting forth those goods or services recited in the registration on or in connection with which the mark is in use in commerce and such number of specimens or facsimiles showing current use of the mark as may be required by the Commissioner; or

“(2) an affidavit setting forth those goods or services recited in the registration on or in connection with which the mark is not in use in commerce and showing that any such nonuse is due to special circumstances which excuse such nonuse and is not due to any intention to abandon the mark.

“(c) The owner of the registration may make the submissions required by this section, or correct any deficiency in a timely filed submission, within a grace period of 6 months after the end of the applicable time period set forth in subsection (a). Such submission must be accompanied by a surcharge prescribed therefor. If any submission required by this section filed during the grace period is deficient, the deficiency may be corrected within the time prescribed after notification of the deficiency. Such submission must be accompanied by a surcharge prescribed therefor.

“(d) Special notice of the requirement for affidavits under this section shall be attached to each certificate of registration and notice of publication under section 12(c).

“(e) The Commissioner shall notify any owner who files 1 of the affidavits required by this section of the Commissioner's acceptance or refusal thereof and, in the case of a refusal, the reasons therefor.

“(f) 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 address given in the last designation, such notice or process may be served upon the Commissioner.”.

SEC. 6. RENEWAL OF REGISTRATION.

Section 9 of the Trademark Act of 1946 (15 U.S.C. 1059) is amended to read as follows:

“RENEWAL OF REGISTRATION

“SEC. 9. (a) Subject to the provisions of section 8, 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 Commissioner. 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 during the grace period is deficient, the deficiency may be corrected within the time prescribed after notification of the deficiency, upon payment of a surcharge prescribed therefor.

“(b) If the Commissioner refuses to renew the registration, the Commissioner shall notify the registrant of the Commissioner’s refusal and the reasons therefor.

“(c) 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 address given in the last designation, such notice or process may be served upon the Commissioner.”.

SEC. 7. RECORDING ASSIGNMENT OF MARK.

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

“ASSIGNMENT

“SEC. 10. (a) 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 1(b) shall be assignable prior to the filing of an amendment under section 1(c) to bring the application into conformity with section 1(a) or the filing of the verified statement of use under section 1(d), 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. 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 conducted. 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 Patent and Trademark Office, the record shall be prima facie evidence of execution. 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 Patent and Trademark Office within 3 months after the date of the subsequent purchase or prior to the subsequent purchase. The Patent and Trademark Office shall maintain a record of information on assignments, in such form as may be prescribed by the Commissioner.

“(b) An assignee not domiciled in the United States 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 address given in the last designation, such notice or process may be served upon the Commissioner.”.

SEC. 8. INTERNATIONAL CONVENTIONS; COPY OF FOREIGN REGISTRATION.

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

(1) in subsection (d)—

(A) by striking “23, or 44(e) of this Act” and inserting “or 23 of this Act or under subsection (e) of this section”; and

(B) in paragraphs (3) and (4), by striking “this subsection (d)” and inserting “this subsection”; and
 (2) in subsection (e), by striking the second sentence and inserting the following: “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.”.

SEC. 9. MISCELLANEOUS AMENDMENTS.

(a) CANCELLATION OF FUNCTIONAL MARKS.—Section 14(3) of the Trademark Act of 1946 (15 U.S.C. 1064(3)) is amended by inserting “or is functional,” before “or has been abandoned”.

(b) INCONTESTABILITY DEFENSES.—Section 33(b) of the Trademark Act of 1946 (15 U.S.C. 1115(b)) is amended—

- (1) by redesignating paragraph (8) as paragraph (9); and
- (2) by inserting after paragraph (7) the following:
 “(8) That the mark is functional; or”.

SEC. 10. TRANSITION PROVISIONS.

(a) REGISTRATIONS IN 20-YEAR TERM.—The provisions of section 8(a) of the Trademark Act of 1946, as amended by section 5 of this Act, shall apply to a registration for trademark issued or renewed for a 20-year term, and existing on the effective date of this Act, on and after the date that is 1 year before the date on which the 20-year term expires.

(b) APPLICATIONS FOR REGISTRATION.—This Act and the amendments made by this Act shall apply to any application for registration of a trademark pending on, or filed on or after, the effective date of this Act.

(c) AFFIDAVITS.—The provisions of section 8(b) of the Trademark Act of 1946, as amended by section 5 of this Act, shall apply to the filing of an affidavit if the sixth anniversary of the registration, or publication under section 12(c) of the Trademark Act of 1946, for which the affidavit is filed is on or after the effective date of this Act.

(d) RENEWAL APPLICATIONS.—The amendment made by section 6 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.

SEC. 11. EFFECTIVE DATE.

This Act and the amendments made by this Act shall take effect—

- (1) on the date that is 1 year after the date of the enactment of this Act,
 - or
 - (2) upon the entry into force of the Trademark Law Treaty with respect to the United States,
- whichever occurs first.

PURPOSE AND SUMMARY

The Trademark Law Treaty (“TLT”) harmonizes procedures of national trademark offices by establishing maximum requirements a “contracting party” (member state or intergovernmental organization) can impose for trademark applications or for granting filing dates. The treaty also eliminates many formal requirements governing renewals, recordation of assignments, changes of names or addresses, powers of attorney, drawings, signatures, and the like. A key feature of the TLT is the elimination of the legalization of signatures on documents, except in the case of a surrender of registration. Other important TLT provisions improve the treatment of multi-class and divisional applications.

For the most part, H.R. 1661 does not change U.S. domestic substantive law. Rather, under the treaty, and like the United States, other countries must provide for 10-year periods of protection and renewal (no more, and no less) in international applications. This reform is consistent with a trend in the international trademark community. In addition, countries must provide for service mark registration. Again, this obligation dovetails with an ongoing trend,

and is otherwise imposed on all members of the World Trade Organization (WTO).

Amendments are made to sections 1, 8, 9, 10, 12 and 44 of Title 15 of the U.S. Code, which update the "Lanham Act."

Section 1, which concerns the requirements for a complete trademark application, is amended as follows:

The application and verification will be separate. The application may be signed by the applicant or its attorney. The verification must be signed by the applicant. The application must be accompanied by the verification.

The Commissioner is given the authority, to set by regulation, the requirements for receiving a filing date.

An intent-to-use application which is abandoned after the Notice of Allowance issues, may be revived on a claim of "unintentional" abandonment. The Commissioner may set the rules, e.g., time limits, for the filing of such a claim.

Section 10, which concerns the recording of assignments, is amended to allow the assignment of an intent-to-use application after an amendment to allege use has been filed. This is to correct an oversight in earlier legislation.

The Commissioner may set by regulation what "prescribed information" must be filed in order to record an assignment. Current policy states that an assignment is recorded only when a complete copy of the assignment document is recorded.

Section 12(b) is amended to change the standard for revival of an application abandoned for failure to timely file a response. The old standard was "unavoidable delay." The new standard is "unintentional."

Section 8 is amended so that the requirements for all of the affidavits of use required to maintain a registration would appear in this section. Affidavits would be due between the 5th and 6th year, the 19th and 20th year etc. There would be a one year filing period for each affidavit and a six-month grace period. The actual substance of the filing mirrors the requirements which are already in the Lanham Act.

Section 9 is amended to state that only a request for renewal and a fee would be needed to renew the application. The time periods for filing the section 9 request for renewal would be between the 9th and the 10th year, the 19th and the 20th year etc. with a six-month grace period.

Section 44 is amended to state that no certified copy of the foreign registration need accompany the application based on foreign registration. The Commissioner has the authority to require submission of the certified copy during the application process.

The State Department is expected to send the TLT ratification package to the Senate. The changes contained in the TLT implementing legislation are necessary to bring U.S. law in compliance with the treaty so ratification can occur.

BACKGROUND AND NEED FOR THE LEGISLATION

The "Trademark Law Treaty," or "TLT," will harmonize the procedures of national trademark offices worldwide by establishing maximum requirements which member states or intergovernmental organizations may impose on users of their respective national sys-

tems. The treaty will also benefit trademark owners by eliminating several formal requirements otherwise needed for registration.

Both this bill and H.R. 567, the "Madrid Protocol Implementation Act," are intended to facilitate international trade for American individuals and entities wishing to do business overseas and are of particular importance to individual and small businesses looking for markets outside this country.

HEARINGS

The Committee's Subcommittee on Courts and Intellectual Property conducted hearings on H.R. 1661 on May 22, 1997. At this hearing, the Subcommittee heard testimony from Bruce Lehman, Commissioner of the United States Patent and Trademark Office and Assistant Secretary of the Department of Commerce; Shaun Donnelly, Deputy Assistant Secretary of the Department of State; Michael K. Kirk, Executive Director of the American Intellectual Property Law Association; and David C. Stimson, President of the International Trademark Association.

COMMITTEE CONSIDERATION

On June 10, 1997, the Subcommittee on Courts and Intellectual Property met in open session and reported favorably H.R. 1661 to the full Committee by voice vote, a quorum being present. The Subcommittee adopted an amendment by voice vote without objection which would add functionality as a defense and cancellation as a remedy to incontestable trademarks. On June 18, 1997, the Committee on the Judiciary met in open session and reported favorably H.R. 1661 to the House by voice vote, a quorum being present.

VOTE OF THE COMMITTEE

There were no recorded votes during consideration of H.R. 1661.

COMMITTEE OVERSIGHT FINDINGS

In compliance with clause 2(1)(3)(A) of rule XI of the Rules of the House of Representatives, the Committee reports that the findings and recommendations of the Committee, based on oversight activities under clause 2(b)(1) of rule X of the Rules of the House of Representatives, are incorporated in the descriptive portions of this report.

COMMITTEE ON GOVERNMENT REFORM AND OVERSIGHT FINDINGS

No findings or recommendations of the Committee on Government Reform and Oversight were received as referred to in clause 2(1)(3)(D) of rule XI of the Rules of the House of Representatives.

NEW BUDGET AUTHORITY AND TAX EXPENDITURES

Clause 2(1)(3)(B) of House Rule XI is inapplicable because this legislation does not provide new budgetary authority or increased tax expenditures.

CONGRESSIONAL BUDGET OFFICE COST ESTIMATE

In compliance with clause 2(1)(C)(3) of rule XI of the Rules of the House of Representatives, the Committee sets forth, with respect to the bill, H.R. 1661, the following estimate and comparison prepared by the Director of the Congressional Budget Office under section 403 of the Congressional Budget Act of 1974:

U.S. CONGRESS,
CONGRESSIONAL BUDGET OFFICE,
Washington, DC, July 16, 1997.

Hon. HENRY J. HYDE,
*Chairman, Committee on the Judiciary,
House of Representatives, Washington, DC.*

DEAR MR. CHAIRMAN: The Congressional Office has prepared the enclosed cost estimate for H.R. 1611, the Trademark Law Treaty Implementation Act.

If you wish further details on this estimate, we will be pleased to provide them. The CBO staff contacts are Rachel Forward (for federal costs), who can be reached at 226-2860, and Matt Eyles (for the private-sector impact), who can be reached at 226-2649.

Sincerely,

JUNE E. O'NEILL, *Director.*

Enclosure.

H.R. 1661—Trademark Law Treaty Implementation Act

Summary: CBO estimates that enacting this bill would have no significant effect on the federal budget. Because the bill would not affect direct spending or receipts, pay-as-you-go procedures would not apply. H.R. 1661 contains a private-sector mandate but the cost of the mandate would not exceed the \$100 million threshold specified in the Unfunded Mandates Reform Act of 1995 (UMRA). The bill contains no intragovernmental mandates as defined in UMRA and would impose no costs on state, local, or tribal governments.

H.R. 1661 would revise trademark registration procedures to require applicants to file with the United States Patent and Trademark Office (PTO) both a registration form and a form verifying that the trademark is used, or will be used, in commerce. The bill would require PTO to promulgate a rule to prescribe the contents of the trademark application and would authorize PTO to impose a surcharge on certain trademark renewal forms submitted after the applicable filing date. H.R. 1661 would take effect the earlier of one year after the date of enactment or upon ratification by the Senate of the Trademark Law Treaty.

ESTIMATED COSTS TO THE FEDERAL GOVERNMENT

Based on information from PTO, CBO estimates that the PTO would incur costs of less than \$500,000 in fiscal year 1999, subject to the availability of appropriated funds, to conduct the rulemaking required by the bill. Based on information from PTO, CBO expects that the agency would impose the surcharge for the late submission of certain documents as authorized by the bill, but that the amounts collected would not be significant. CBO does not expect that enacting H.R. 1661 would affect the number of trademark ap-

plications received by PTO, and thus would not affect the amount of user fees collected by the agency to cover the cost of processing those applications. Such fees are collected and spent under authority provided in annual appropriations acts.

PAY-AS-YOU-GO CONSIDERATIONS: None

ESTIMATED IMPACT ON STATE, LOCAL, AND TRIBAL GOVERNMENTS

H.R. 1661 contains no intergovernmental mandates as defined in UMRA and would impose no costs on state, local, or tribal governments.

ESTIMATED IMPACT ON THE PRIVATE SECTOR

H.R. 1661 would impose a new private-sector mandate by authorizing PTO to impose a surcharge on individuals who file late or incomplete trademark applications. Trademark law and trademark fees are the exclusive domain of the federal government. Therefore, an increase in existing trademark fees or the imposition of new fees constitutes a new enforceable duty and thus is a private-sector mandate under UMRA.

Based on information from PTO, CBO estimates that the direct costs of the new private-sector mandate in the bill would be negligible and fall well below the \$100 million statutory threshold in UMRA.

Although Section 4(5) of UMRA excludes from consideration legislation that is necessary to implement international treaty obligations, that exclusion does not apply to H.R. 1661. This bill would implement provisions of the Trademark Law Treaty, which the United States has not yet ratified. Section 11 contains a provision that makes H.R. 1661 effective one year after its date of enactment regardless of whether the Trademark Law Treaty is ratified. Thus, CBO has provided the above mandate statement.

Estimate prepared by: Federal Costs: Rachel Forward (226–2860). Impact on the Private Sector: Matthew Eyles (226–2649).

Estimate approved by: Robert A. Sunshine, Deputy Assistant Director for Budget Analysis.

CONSTITUTIONAL AUTHORITY

Pursuant to Rule XI, clause 2(1)(4) of the Rules of the House of Representatives, the Committee finds the authority for this legislation in Article I, clause 8, section 8 of the Constitution.

SECTION-BY-SECTION ANALYSIS

Section 1.—Short title

This section provides a short title: Trademark Law Treaty Implementation Act.

Section 2.—Reference to the Trademark Act of 1946

This section provides that the Act entitled “An Act to provide for the registration and protection of trademarks used in commerce, to carry out the provision of certain international conventions, and for

other purposes,” approved July 5, 1946, as amended (15 U.S.C. 1051 et. seq.) Shall be referred to as the “Trademark Act of 1946”.

Section 3.—Application for Registration; Verification

Summary

This section amends subsection 1(a) and 1(b) of the Trademark Act of 1946 (15 U.S.C. 1051(a) and 1051(b)) to create a clear distinction between the written application, the form of which may be prescribed by the Commissioner, and the declaration pertaining to applicant’s use or intention to use the mark, the substance of which is detailed in the respective subsections; to require that the declaration pertaining to use or intention to use be verified by the applicant; to authorize the Commissioner to promulgate rules prescribing both the elements of the application, in addition to those specified in the proposed provision, and those elements necessary for a filing date; to omit the requirement in the written application for a statement of the mode or manner in which the mark is used or intended to be used in connection with the specified goods or services; and to clarify and modernize the language of the subsections, as appropriate. In addition, an amendment is made to subsection 1(d) (15 U.S.C. 1051(d)) to clarify that an application may be revived after a notice of allowance is issued.

Trademark Law Treaty and Existing U.S. Law

With the goal of simplifying and harmonizing the registration process worldwide, Article 3(1) of the Trademark Law Treaty (Treaty) establishes a comprehensive list of indications or elements that may be required in an application to register a trademark or service mark (mark).

This list permits a Contracting Party to the Treaty (Party) to require, *inter alia*, a signature and declarations of use and intention to use a mark. The list does not permit a Party to require, *inter alia*, a statement of the mode or manner in which the mark is used, or intended to be used, in connection with the goods or services specified in the application. Article 3(4) of the Treaty obligates a Party that requires a signature to permit either the applicant or his representative to sign the application, except that Party may require declarations of use and intention to use a mark to be signed by the applicant.

The existing subsections 1(a) and 1(b) of the Trademark Act of 1946 (15 U.S.C. 1051(a) and 1051(b)) require, respectively, declarations pertaining to use and intention to use a mark and require verification by the applicant of the written application, which includes the aforementioned declarations. Under the terms of the Treaty, the United States may continue to require the aforementioned declarations and may require verification by the applicant of such declarations, but may not require verification by the applicant of the written application. Thus, it becomes necessary to distinguish the declarations of use and intention to use from the other elements of the application.

Additionally, the existing subsections 1(a) and 1(b) of the Trademark Act of 1946 (15 U.S.C. 1051(a) and 1051(b)) require, respectively, a statement of the mode or manner in which the mark is

used, or intended to be used, in connection with the goods specified in the application. Thus, it becomes necessary to delete the requirement for this statement from the list of required elements in the written application.

Distinction Between Written Application and Verified Declarations

Consistent with the Treaty obligations, the revision will distinguish between the written application and the declarations of use and intention to use for purposes of the signature requirement. The revision will continue to require a written application, in such form as may be prescribed by the Commissioner, and a declaration verified by the applicant, as set forth in the two subsections.

By separating the written application from the verified declarations, there will no longer be a requirement in the law for verification by the applicant of the written application. In the revision, as in the existing subsections, the Commissioner will have discretion to permit the written application to be filed with no signature or with the signature of applicant's representative. Also, the Commissioner may permit the filing of a single document, which combines the elements of the written application and the declaration, and which is signed by the applicant, as under the existing subsections.

Elements of the Written Application

The revision specifies a nonexclusive list of elements and grants authority to the Commissioner to prescribe, by regulation and consistent with law and international obligations, additional elements which the Commissioner considers to be necessary for an application and those elements necessary for receipt of a filing date. This improves the ability of the law pertaining to application requirements to accommodate advancing technology and further international procedural harmonization. The revision specifically requires the application to include applicant's domicile and citizenship, the dates of applicant's first use of the mark and first use of the mark in commerce in an application under subsection 1(a), the goods in connection with which the mark is used or intended to be used, and a reproduction of the mark. Consistent with the Treaty, the revision omits a requirement for specification of the mode or manner in which the mark is used, or intended to be used, in connection with the goods specified in the application.

Additionally, the revision reorganizes subsections 1(a) and (b) 1946 (15 U.S.C. 1051(a) and 1051(b)) to clarify the provisions and to modernize the language. To parallel the language of the Treaty, the phrase may apply to register is replaced by may request registration and the term drawing of the mark is replaced by reproduction of the mark. Reference to firm, corporation or association is replaced by a reference to "juristic person" or "person." Section 45 defines "person" as including "juristic persons." These terms are considered preferable in view of the numerous types of juristic persons in existence today.

The Verified Statement

Rather than requiring in the verified statement a repetition of statements in the written application identifying goods and, in a

section 1(a) application, dates of use, the revision requires a statement that, to the best of the applicant's knowledge and belief, the facts recited in the application are accurate. In addition, the revision specifies the averments that the applicant must make in the verified statement concerning applicant's use, or bona fide intention to use, the mark in commerce, ownership of the mark and lack of knowledge of conflicting third party rights. These averments do not differ from those in the existing provisions.

The revision requires verification of the statement by the applicant and omits the specification of the appropriate person to verify the declaration for a juristic applicant, *i.e.*, the proposed revision omits the phrase requiring verification by "a member of the firm or an officer of the corporation or association applying." While this revision is not required by the Treaty, it will greatly simplify the filing of an application without compromising the integrity of the information contained therein. This revision will give the Patent and Trademark Office the discretion to determine the appropriate person with authority to sign the declaration for a juristic applicant.

Under the existing provision, the Patent and Trademark Office has been limited to accepting, for example, only the signature of an officer of a corporation on an application when another corporate manager's signature would be appropriate because the corporate manager has specific knowledge of the facts asserted in the application. The unnecessary rigidity of the existing provision has worked a hardship on applicants who have been denied filing dates because the person verifying their application has not met the strict requirement of being an officer of the corporate applicant. Additionally, the Patent and Trademark Office has had difficulty applying the officer requirement to foreign juristic entities whose managers are not clearly officers under the United States corporate standards.

Revival of Applicants After the Notice of Allowance Has Issued

Existing subsection 1(d) (15 U.S.C. 1051(d)) is amended to clarify that applications which are awaiting the filing of a statement of use or a request for extension of time to file a statement of use, may be revived if it can be shown to the satisfaction of the Commissioner that the failure to file was unintentional. Although the change is not necessary for the implementation of the TLT, the change clarifies that the Commissioner has the authority to revive such an application so long as reviving the application does not extend the statutory period for filing the statement of use. The standard for revival is that the applicant's failure to file was unintentional. This is the same standard that is being proposed in subsection 12(b) of the Trademark Act of 1946 (15 U.S.C. 1062(b)) for reviving applications during the examination process.

Section 4.—Revival of an Abandoned Application

Summary

This section amends subsection 12(b) of the Trademark Act of 1946 (15 U.S.C. 1062(b)) by amending the present standard for re-

viving an abandoned application upon a showing of unavoidable delay to the standard of “unintentional” delay.

Revival of Abandoned Applications Upon a Showing of Unavoidable Delay

Section 12(b) of the Trademark Act of 1946 (15 U.S.C. 1062(b)) provides that an application is abandoned if the applicant does not timely respond to an Office Action, “unless it can be shown to the satisfaction of the commissioner that the delay in responding was unavoidable, whereupon such time may be extended.”

Prior to the implementation of the Trademark Act of 1946, there was no statutory provision for abandonment and revival of abandoned trademark applications. There was a regulatory provision that an abandoned application could be revived if it were “shown to the satisfaction of the Commissioner that the delay in the prosecution of the same was unavoidable.” However, the legislative history of the Lanham Act is silent as to the meaning or intention behind the unavoidable delay standard for revival of abandoned applications.

The language of section 12(b) of the Trademark Act of 1946 is virtually identical to the analogous provision of the patent law, 35 U.S.C. 133, which provides for abandonment of patent applications and revival upon a showing of unavoidable delay. The requirements for reviving an unavoidably abandoned patent applications, set forth in 37 C.F.R. § 1.137(a), are identical to the requirements for reviving an abandoned trademark application under 37 C.F.R. § 2.66.

Courts have held that the Commissioner has broad discretion in determining whether a delay is unavoidable. Under current law, the Commissioner’s decision is subject to judicial review, but will be reversed only if it is arbitrary, capricious, or an abuse of discretion. *Morganroth v. Quigg*, 885 F.2d 843, 21 USPQ2d 1125 (Fed. Cir. 1989); *Smith v. Mossinghoff*, 671 F.2d 522, 213 USPQ 977 (D.C. Cir. 1982); *Douglas v. Manbeck*, 21 USPQ2d (E.D. Pa. 1991).

Revival of Unintentional Abandoned Applications

Prior to 1982, patent applications, like trademark applications, could be revived only upon a showing of unavoidable delay. Under Public Law 97–247, § 3, 96 Stat. 317 (1982) codified at 35 U.S.C. 41(a)(7), it became possible to revive an unintentionally abandoned patent application. Section 41(a)(7) establishes two different fees for filing petitions with two different standards to revive abandoned applications. There is one for a petition to revive an unavoidably abandoned application and another fee for a petition to revive an unintentionally abandoned application. The procedure for petitioning to revive an unintentionally abandoned application is set forth in 37 C.F.R. § 1.137(b), effective October 1, 1982. 58 Fed. Reg. 44277 (Aug. 20, 1993); 48 Fed. Reg. 2696 (Jan. 20, 1983). The rule requires, among other things, that the applicant submit a verified statement that the delay was unintentional, and provides that the “Commissioner may require additional information where there is a question that the delay was unintentional.”

The legislative history of Public Law 97–247 states:

Section 41(a)7 establishes two different fees for filing petitions with different standards to revive abandoned applications. . . . Since the section provides for two alternatives fees with different standards, the section would permit the applicant seeking revival . . . to choose one or the other of the fees and standards under such regulations as the Commissioner may establish. . . . This section would permit the Commissioner to have more discretion than present law to revive abandoned applications . . . in appropriate circumstances (emphasis added). H.R. Rep. No. 542, 97th Cong. 2d Sess. 6–7 (1982), quoted in *In re Rutan*, 231 USPQ 864, 865 (Comm'r Pats. 1986).

The legislative history of Public Law 97–247 pertains primarily to fees. However, the intent of Congress appears to be to give the Commissioner the power to revive abandoned applications using a much less strict standard than had been previously applied. *In re Rutan*, supra. Neither the legislative history of the Lanham Act nor the relevant case law limit the Commissioner's authority to establish procedures for revival of unintentionally abandoned trademark applications.

With the goal of the Trademark Law Treaty to simplify the registration process worldwide, this change parallels the unintentional standard for revival available to patent applicants and relaxes the standard for reviving trademark applications. This will enable the majority of applicants, who file a timely petition to revive an application that was abandoned due to an unintentional delay, to proceed to registration from the point that the application became abandoned, rather than requiring these applicants to refile their applications.

Section 5.—Duration of Registration; Cancellation; Affidavit of Continued Use; Notice of Commissioner's Action

Summary

This section amends section 8 of the Trademark Act of 1946 (15 U.S.C. 1058). The main purpose of the revision of this section is to set out, in one section, all of the requirements for filing any of the affidavits of use needed to maintain a registration and to ensure that the requirements of each use affidavit are identical. This section includes the affidavit of use filed between the fifth and the sixth year after registration, between the fifth and the sixth year after publication under subsection 12(c), and in the year preceding every ten year anniversary of the registration.

This purpose is accomplished by adding an obligation to file an affidavit of use or non-use, consistent with the requirements set forth in the subsections, in the year preceding every tenth anniversary of the registration, to provide for correction of deficiencies in submissions under these subsections; to provide for a grace period for making submissions required by these subsections; to modernize the language and to simplify and clarify the existing procedural requirements for filing affidavits under these subsections; and to harmonize certain procedural requirements for such affidavits with the requirements for a registration renewal application contained in section 9 of the Trademark Act of 1946.

Subsection 8(a) sets out the end of the statutory time period for filing each affidavit of use. Paragraph (1) of subsection 8(a) states that an affidavit of use must be filed by the end of six years following registration. Paragraph (2) of subsection 8(a) states that an affidavit of use must be filed by the end of six years following the date of publication under subsection 12(c) of the Trademark Act of 1946 (15 U.S.C. 1062(c)). Paragraph (3) of subsection 8(a) states that an affidavit of use must be filed by the end of each successive ten-year period following the date of registration.

Subsection 8(b) sets out the length of the time period during which the statutory filing can be made and the contents needed in each filing. In every case, there is a one year statutory period for filing the affidavit.

Subsection 8(c) sets out the time period for filing the use affidavit where the statutory period has expired, the so-called grace period, and allows for correction of deficiencies in the filings submitted under this section. This subsection permits the filing of the use affidavit, or the correction of a timely filed affidavit, after the statutory period for filing has ended upon payment of an additional “grace period” surcharge. The section also provides that a correction to the “grace” period affidavit may be made upon payment of an additional deficiency surcharge.

Subsection 8(d) sets out the requirement that the Commissioner attach to each certificate of registration, and notice of publication under section 12(c), a special notice of the requirement for the affidavits required by this section. This section preserves an obligation of the Commissioner that is set out in the last sentence of existing section 8(a) and in section 12(c).

Subsection 8(e) preserves the obligation of the Commissioner, in existing subsection 8(c), to notify any who files an affidavit under section 8 of his acceptance or refusal of the affidavit. The subsection has been revised to reflect the revisions in subsections 8(a) and (b) by stating that it applies to any of the above prescribed affidavits.

Subsection 8(f) has been added to require the appointment by owners, not domiciled in the United States, of a domestic representative for service of notices or process in proceedings affecting the mark.

Trademark Law Treaty and Existing U.S. Law

With the goal of simplifying and harmonizing the process for renewal of a trademark or service mark registration worldwide, Article 13(1) of the Treaty establishes a comprehensive list of indications that may be required in a request to renew a trademark or service mark registration. This list does not include a declaration and/or evidence concerning use of the mark. Article 13(4)(iii) expressly prohibits a requirement for the furnishing of a declaration and/or evidence concerning use of the mark as part of a request for renewal. However, the Treaty contains no prohibition against a requirement for the periodic filing of a declaration and/or evidence of use in connection with a registration, as long as such requirement is not part of the requirements for renewal. In fact, Article 13(1)(b) of the Treaty, concerning renewal fees, recognizes that fees may be

required in connection with the filing of a declaration and/or evidence of use of a registered mark.

Existing sections 8 and 9 of the Trademark Act of 1946 are the two provisions of the Act containing requirements for registration maintenance. These two sections are analogous in their requirements for the filing of a verified document attesting to the use of the mark in commerce and specimens or facsimiles, or a showing of excusable non-use. Section 8 of the Trademark Act of 1946 requires the aforementioned filing during the year preceding the sixth year following registration to avoid cancellation of the registration. Section 9 of the Trademark Act of 1946 requires the aforementioned filing as part of the registration renewal application. Under the terms of the Treaty, the United States may continue to require the periodic filing of a verified document attesting to the use of the mark in commerce and specimens or facsimiles, or a showing of excusable non-use. However, the United States may not make such a requirement in connection with registration renewal.

Periodic Filing of the Affidavit

The U.S. Patent and Trademark Office continues to believe in the value of requiring a periodic filing verifying the continued use of the mark as a way to maintain the integrity of the trademark register by periodically removing from the register marks no longer in use in commerce. Therefore, consistent with the Treaty obligations, the proposed revision adds to section 8 of the Trademark Act of 1946 an obligation to file an affidavit of use or excusable non-use, consistent with the requirements set forth in the subsection, in the year preceding the tenth anniversary of the registration and every ten years thereafter. This revision is proposed in view of the proposed deletion of the requirement in connection with registration renewal, in section 9 of the Trademark Act of 1946, for a verified statement attesting to the use of the mark in commerce, accompanied by specimens or facsimiles, or a showing of excusable non-use.

Harmonization of Sections 8 and 9 Requirements

The revision harmonizes certain procedural requirements for the affidavits required under this section with the requirements for a registration renewal application contained in section 9 of the Trademark Act of 1946. While both sections contain requirements for registration maintenance, the specific requirements pertaining to the filing required by each existing section differ unnecessarily. These differing requirements have caused confusion to some registrants, particularly those proceeding *pro se*, resulting in the cancellation of registrations of marks still in use in commerce due to noncompliance with the technical requirements of one or the other of these maintenance sections. Furthermore, since the revision to section 8 adds an affidavit requirement at ten-year intervals, harmonizing the filing procedures with those for renewal enables the registrant to make both filings at the same time, thus, simplifying registration maintenance.

Grace Period and Correction of Deficiencies

Rule 8 of the Regulations under the Trademark Law Treaty provides that a renewal request must be accepted for at least a six-month period, upon payment of a surcharge, after the date the renewal is due. The existing provisions of section 9 of the Trademark Act of 1946 permit the renewal application to be filed within a three-month period, upon payment of a surcharge, after the date the renewal is due. The existing provisions of section 8 of the Trademark Act of 1946 contain no grace period for the filing of the required affidavit after its due date. As described below, the revision incorporates the six-month grace period required by the treaty for filing renewal requests and harmonizes the requirements for filings under sections 8 and 9 of the Trademark Act of 1946. Harmonization of the filing requirements of sections 8 and 9 will require the amendment of both sections to provide this six-month grace period for making the required filing. This amendment is a liberalization of sections 8 and 9 of the Trademark Act of 1946, which is desirable to avoid, to the extent possible, the removal from the register for mere technical reasons of marks that are still in use in commerce.

The revision to section 8 of the Trademark Act of 1946 will amend the existing law by providing a six-month grace period for filing the required affidavit, conditioned upon payment of a “grace period surcharge.” Additionally, the revision permits the correction of a deficiency after the sixth anniversary of registration. Such correction must be accompanied by a “deficiency surcharge” and be filed no later than the end of a prescribed period after notification of the deficiency. This change is consistent with the practice proposed in the revision to section 9(a) of the Trademark Act of 1946, concerning renewal.

Only an owner who did not make any filing prior to the end of the sixth year after registration may make the required filing under the grace period provisions. The owner filing an affidavit prior to the end of the sixth year, but correcting a deficiency either during or after the grace period, will be subject to the “deficiency surcharge” only. On the other hand, the owner filing an affidavit during the six-month grace period, will be subject to the “grace period surcharge” (for the ability to file the affidavit during the grace period) and, if notified of deficiencies, the “deficiency surcharge” (for the ability to correct a deficiency after the end of the sixth year after registration).

Simplification and Clarification of Section

The revision conforms the requirements of subsections 8(a) and (b) of the Trademark Act of 1946 to current practice. First, the language in the existing subsections “attaching to the affidavit is a specimen or facsimile showing current use of the mark” is revised to clarify that the specimens or facsimiles are to be filed along with the affidavit but are not considered part of the affidavit for purposes of complying with the requirement to set forth in the affidavit the goods or services on or in connection with which the mark is in use in commerce. The sentence comprising subsection 8(a) of the Trademark Act of 1946 has been revised to clarify and distinguish the requirements for the fee, the affidavit, the specimens and

a showing of non-use. The revision further permits the Commissioner to specify the number of specimens or facsimiles required so that he may require a specimen or facsimile for each class of goods or services identified in the registration. The language “setting forth those goods or services recited in the registration on or in connection with which the mark is not in use in commerce” is proposed to be added to parallel the affidavit requirements pertaining to use of the mark and to clarify that the owner must specify the goods or services to which a showing of non-use pertains.

Existing Subsection 8(b)

The requirements set out in former subsection 8(b) of the Trademark Act of 1946, pertaining to marks published pursuant to section 12(c) of the Trademark Act of 1946, have been set out in subsections 8(a)(2), 8(b) and (8)(c) and conform to the proposed revisions as to the time of filing the affidavit, the grace period and the correction of deficiencies.

Existing Subsection 8(c)

Subsection 8(c) of the Trademark Act of 1946 is now set out in the subsection 8(c) and is amended to reflect the revisions in subsections 8(a) and (b) to add requirements for the periodic filing of additional affidavits by changing reference from “. . . any owner who files either of the above-prescribed affidavits . . .” to “. . . any owner who files one of the above-prescribed affidavits. . . .”

Subsection 8(f)—Appointment of Domestic Representative

Section 5 of this Act adds a section 8(f) to the Trademark Act of 1946 to provide for the appointment of a domestic representative for service of notices or process in proceedings affecting the mark by owners not domiciled in the United States. This new subsection is consistent with similar requirements imposed on applicants by subsection 1(e) of the Trademark Act of 1946. This is necessary because the appointment required in subsection 1(e) of the Trademark Act of 1946 pertains only during the pendency of the application.

Registrant or Owner; Who must file?

Throughout the revised section 8, the term “registrant” has been replaced by the term “owner.” The practice at the Patent and Trademark Office has been to require that the current owner of the registration file all the post-registration affidavits needed to maintain a registration. The current owner of the registration must aver to actual knowledge of the use of the mark in the subject registration. However, the definition of “registrant” in section 45 of the Act states that the “terms ‘applicant’ and ‘registrant’ embrace the legal representatives, predecessors, successors and assigns of each applicant and registrant.” Therefore, use of the term “registrant” in section 8 of the Act would imply that any legal representative, predecessor, successor or assign of the registrant could successfully file the affidavits required by sections 8 and 9. To correct this situation, and to keep with the general principal, as set out in section 1, that the owner is the proper person to prosecute an application,

section 8 has been amended to state that the owner must file the affidavits required by the section.

Section 6.—Renewal of Registration

Summary

This section amends subsection 9(a) of the Trademark Act of 1946 to cross-reference the obligatory registration maintenance requirements of section 8 of the Trademark Act of 1946, to delete the obligation to submit as part of a renewal application verified statements regarding the use of the mark in commerce and attaching to the application verified statements regarding the use of the mark in commerce and attaching to the application a specimen or facsimile showing current use of the mark; to extend the time for filing a renewal application to up to one year before the expiration of the period for which the registration was issued or renewed and, for an additional fee, up to six months after the end of the expiring period of the registration, and to grant authority to the Commissioner to prescribe the form of the written application for renewal of the registration.

This section amends subsection 9(c) to specify the requirements for the appointment by registrants not domiciled in the United States of a domestic representative for service of notices or process in proceedings affecting the mark.

Trademark Law Treaty and Existing Law

As discussed in the analysis of the amendment to section 8 of the Trademark Act of 1946, Article 13(1) of the Treaty establishes a comprehensive list of indications that may be required in a request to renew a trademark or service mark registration. The goal of this Article is simplifying and harmonizing the process for renewal of a trademark or service mark registration worldwide. This list does not include a declaration and/or evidence concerning use of the mark. Article 13(4)(iii) expressly prohibits a requirement for the furnishing of a declaration and/or evidence concerning use of the mark as part of a request for renewal. However, the Treaty contains no prohibition against a requirement for the periodic filing of a declaration and/or evidence of use in connection with a registration, as long as such requirement is not part of the requirements for renewal. In fact, Article 13(1)(b) of the Treaty, concerning renewal fees, recognizes that fees may be required in connection with the filing of a declaration and/or evidence of use of a registered mark.

Sections 8 and 9 of the Trademark Act of 1946 are the two provisions of the Act containing requirements for registration maintenance. These two sections are analogous in their requirements for the filing of a verified document attesting to the use of the mark in commerce and specimens or facsimiles, or a showing of excusable non-use. Section 8 of the Trademark Act of 1946 requires the aforementioned filing during the year preceding the sixth year following registration to avoid cancellation of the registration. Section 9 of the Trademark Act of 1946 requires the aforementioned filing as part of the registration renewal application. Under the terms of the Treaty, the United States may continue to require the periodic fil-

ing of a verified document attesting to the use of the mark in commerce and specimens or facsimiles, or a showing of excusable non-use. However, the United States may not make such a requirement in connection with registration renewal.

Use Requirement for Registration Renewal

Separate from the obligation to renew a trademark registration at ten-year intervals, the U.S. Patent and Trademark Office continues to believe in the value of requiring a period filing verifying the continued use of the mark as a way to maintain the integrity of the trademark register by periodically removing from the register marks no longer in use in commerce. Therefore, consistent with the Treaty obligations, the proposed revision deletes from subsection 9(a) of the Trademark Act of 1946 the requirement that the renewal application include a verified statement attesting to the use of the mark in commerce, accompanied by a specimen or facsimile evidencing current use of the mark, or a showing of excusable non-use. These requirements are to be added to subsection 8(a) of the Trademark Act of 1946 in the form of an obligation to file an affidavit of use or excusable non-use, consistent with the requirements set forth in the subsection, on the tenth anniversary of the registration and every ten years thereafter.

Also, consistent with the treaty obligations, the requirement that the renewal application be verified is to be deleted and the Commissioner is granted authority to prescribe the form of the written renewal application, consistent with law and international treaties or agreements to which the United States is a party.

Grace Period and Harmonization

Rule 8 of the Regulations under the Trademark Law Treaty provides that a renewal request must be accepted for at least a six-month period, upon payment of a surcharge, after the date the renewal is due. The existing provisions of section 9 of the Trademark Act of 1946 permit the renewal application to be filed within a three-month period, upon payment of a surcharge, after the date the renewal is due. The revision changes the three-month grace period for requesting registration renewal to the six-month grace period required by the treaty and harmonizes the requirements for filings under section 8 and 9 of the Trademark Act of 1946. Harmonization of the filing requirements of sections 8 and 9 will require the amendment of both sections to provide this six-month grace period for making the required filing. This amendment is a liberalization of sections 8 and 9 of the Trademark Act of 1946, which is desirable to avoid, to the extent possible, the removal from the register for more technical reasons of marks that are still in use in commerce. In particular, consistent with the filing requirements in section 8 of the Trademark Act of 1946, the period for filing a renewal request is expressly defined as the period one year prior to expiration of the period for which the registration was issued or renewed, or within a grace period of six months after the end of the expiring period.

Subsection 9(c)—Appointment of Domestic Representative

Subsection 6(b) of this Act amends subsection 9(c) to the Trademark Act of 1946 to provide for the appointment of a domestic representative for service of notices or process in proceedings affecting the mark by owners not domiciled in the United States, rather than referencing the requirements in subsection 1(e) of the Trademark Act of 1946. This is preferable because the appointment required in subsection 1(e) of the Trademark Act of 1946 pertains only during the pendency of the application.

Section 7.—Recording Assignment of Mark

This section amends section 10 of the Trademark Act of 1946 (15 U.S.C. 1060) to clarify that the PTO will record a change in ownership without requiring a copy of the underlying document; and to remove the proscription against the assignment of a mark in an application filed under section 1(b) of the Trademark Act of 1946 (15 U.S.C. 1051(b)) (intent-to-use) upon the filing of an amendment to allege use pursuant to section 1(c) of the Trademark Act of 1946 (15 U.S.C. 1051(c)).

The PTO has interpreted the present reference to a “record of assignments” in section 10 to require the PTO to record a copy of the actual assignment document. Article 11(4) of the Trademark Law Treaty prohibits the requirement of a statement or proof of such transfer in order to record an assignment of a trademark registration. The amendment clarifies that, rather than maintaining a “record of assignments,” the PTO “shall maintain a record of the prescribed information on assignments, in such form as may be prescribed by the Commissioner.” The amendment authorizes the PTO to determine what information regarding assignments it will record and maintain. The revision will ensure that a transfer of goodwill remains a necessary element of a valid assignment of a trademark; however, the PTO will not require a statement or proof of the transfer of goodwill in order to record an assignment of a trademark registration.

Additionally, pertaining to the proscription against the assignment of a mark in an application filed under section 1(b) of the Trademark Act of 1946 (intent-to-use), the amendment adds reference to section 1(c) of the Trademark Act of 1946 so that the filing of an amendment to allege use pursuant to section 1(c) removes the restriction against assigning the mark except to the successor to the business of the applicant, or portion thereof, to which the mark pertains, if that business is ongoing and existing. Presently, prior to registration of an application filed pursuant to section 1(b) of the Trademark Act of 1946 (15 U.S.C. 1051(b)), based upon a bona fide intention to use a mark in commerce on the identified goods or services, applicants must file either a verified statement of use under section 1(d) of the Trademark Act of 1946 (15 U.S.C. 1051(c)). The substance of the two filings is essentially the same. The difference between the two filings is the point at which the filing is made. Presently, section 10 of the Trademark Act of 1946 (15 U.S.C. 1060) limits the assignability of an application to register a mark under section 1(b) of the Trademark Act of 1946 (15 U.S.C. 1051(b)) until such time as applicant files a verified statement of use under section 1(d) of the Trademark Act of 1946 (15 U.S.C.

1051(d)). Since the effect of the filing of an amendment to allege use under section 1(c) of the Trademark Act of 1946 (15 U.S.C. 1051(c)) is analogous, there is no policy or legal reason for omitting to include reference to section 1(c) in section 10.

Section 8.—International Conventions; Copy of Foreign Registration

This section amends section 44(e) of the Trademark Act of 1946 (15 U.S.C. 1126 (e)) to change the requirement that an application be accompanied by a certificate or certified copy of the foreign registration, which has been interpreted to be a filing date requirement, so that such copy may be submitted to the PTO prior to registration, within such time limits as may be prescribed by the Commissioner. Such a requirement as a prerequisite to receiving a filing date is prohibited pursuant to Article 5 of the Trademark Law Treaty.

Section 9.—Miscellaneous Amendments

This section amends section 14(3) of the Trademark Act of 1946 (15 U.S.C. 1064 (3)) to add functionality to the list of statutory defenses to infringement in a suit involving an incontestible registration. The amendment also adds functionality as a ground for cancellation of an incontestible registration. These changes become necessary to clarify confusion among certain courts over functionality issues.

The need to be able to assert functionality as a defense and as a ground for cancellation has grown with the increase in trade dress applications, where registration is sought for three dimensional features and colors, many of which have utilitarian aspects. With this increase, the number of functional designs which are registered as trademarks in error and attain incontestible status is likewise expected to rise. The amendment provides both a means of rectifying the Trademark Register by removal of such marks and a necessary means of defending a charge of infringement of such marks.

Section 10.—Transitional Provisions

This section seeks to clarify the status of trademarks and applications throughout the time period for enactment. Section 10(a) states that section 8(a) of the Trademark Act of 1946, as amended by section 5 of this Act, applies to a registration for a trademark issued or renewed for a 20-year term, and existing on the effective date of this Act, on or after the date that is one year before the date on which the 20-year term expires.

Section 10(b) states the Act and the amendments to the Act apply to all applications pending on, or filed after, the effective date of the Act.

Section 10(c) states that section 8(b) of the Trademark Act of 1946, as amended by section 5 of this act, applies to the filing of an affidavit if the sixth anniversary of the registration, or publication under section 12(c) of the Trademark Act of 1946, for which the affidavit is filed on or after the effective date of this Act.

Section 10(d) states that the amendment made by section 6 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 the Act.

Section 11.—Effective Date

This section provides that this Act shall take effect one year after enactment of the Act or upon entry into force of the Treaty in respect to the United States, whichever occurs first. Since the provisions of the Act will modernize and simplify procedures pertaining to trademark application filing and registration maintenance, this section provides that, if the U.S. has not acceded to the treaty and become subject to the obligations thereunder within a year after enactment, the Act will become effective so that it benefits can be realized by trademark owners.

Since the United States is not one of the first five States to deposit its instrument of ratification or accession, Article 20 of the Treaty provides that the Treaty shall enter into force three months after the date on which the instrument of ratification or accession is deposited.

CHANGES IN EXISTING LAW MADE BY THE BILL, AS REPORTED

In compliance with clause 3 of rule XIII of the Rules of the House of Representatives, changes in existing law made by the bill, as reported, are shown as follows (existing law proposed to be omitted is enclosed in black brackets, new matter is printed in italics, existing law in which no change is proposed is shown in roman):

ACT OF JULY 5, 1946

(Commonly referred to as the "Trademark Act of 1946")

AN ACT To provide for the registration and protection of trade-marks used in commerce, to carry out the provisions of certain international conventions, and for other purposes.

Be it enacted by the Senate and House of Representatives of the United States of America in Congress assembled,

TITLE I—THE PRINCIPAL REGISTER

SECTION 1. (a) The owner of a trade-mark used in commerce may apply to register his or her trade-mark under this Act on the principal register hereby established:

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

(A) a written application, in such form as may be prescribed by the Commissioner, verified by the applicant, or by a member of the firm or an officer of the corporation or association applying, specifying applicant's domicile and citizenship, the date of applicant's first use of the mark, the date of applicant's first use of the mark in commerce, the goods in connection with which the mark is used and the mode or manner in which the mark is used in connection with such goods, and including a statement to the effect that the person making the verification believes him-

self, or the firm, corporation, or association in whose behalf he makes the verification, to be the owner of the mark sought to be registered, that the mark is in use in commerce, and that no other person, firm, corporation, or association, to the best of his knowledge and belief, 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: *Provided*, That in the case of every application claiming concurrent use the applicant shall state exceptions to his claim of exclusive use in which he shall specify, to the extent of his knowledge, any concurrent use by others, the goods in connection with which and the areas in which each concurrent use exists, the periods of each use, and the goods and area for which the applicant desires registration;

[(B) a drawing of the mark; and

[(C) such number of specimens or facsimiles of the mark as used as may be required by the Commissioner.

[(2) By paying into the Patent and Trademark Office the prescribed fee.

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

[(b) A person who has a bona fide intention, under circumstances showing the good faith of such person, to use a trademark in commerce may apply to register the trademark under this Act on the principal register hereby established:

[(1) By filing in the Patent and Trademark Office—

[(A) a written application, in such form as may be prescribed by the Commissioner, verified by the applicant, or by a member of the firm or an officer of the corporation or association applying, specifying applicant's domicile and citizenship, applicant's bona fide intention to use the mark in commerce, the goods on or in connection with which the applicant has a bona fide intention to use the mark and the mode or manner in which the mark is intended to be used on or in connection with such goods, including a statement to the effect that the person making the verification believes himself or herself, or the firm, corporation, or association in whose behalf he or she makes the verification, to be entitled to use the mark in commerce, and that 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, to cause confusion, or to cause mistake, or to deceive; however, except for applications filed pursuant to section 44, no mark shall be registered until the applicant has met the requirements of subsection (d) of this section; and

[(B) a drawing of the mark.

[(2) By paying in the Patent and Trademark Office the prescribed fee.

[(3) By complying with such rules or regulations, not inconsistent with law, as may be prescribed by the Commissioner.]

SECTION 1. (a)(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 Commissioner, and such number of specimens or facsimiles of the mark as used as may be required by the Commissioner.

(2) The application shall include specification of the applicant's domicile and citizenship, the date of the applicant's first use of the mark, the date of the applicant's first use of the mark in commerce, the goods in connection with which the mark is used, and a drawing of the mark.

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

(A) 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 Commissioner. The Commissioner shall promulgate rules prescribing the requirements for the application and for obtaining a filing date herein.

(b)(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 Commissioner.

(2) The application shall include specification of the applicant's domicile and citizenship, the goods in connection with which the ap-

plicant has a bona fide intention to use the mark, and a drawing of the mark.

(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 entitled to use the mark in commerce;

(B) the applicant's bona fide intention to use the mark in commerce;

(C) that, to the best of the verifier's knowledge and belief, the facts recited in the application are accurate; and

(D) that, 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 for applications filed pursuant to section 44, no mark shall be registered until the applicant has met the requirements of subsections (c) and (d) of this section.

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

* * * * *
(d)(1) * * *
* * * * *

[(4) The failure to timely file a verified statement of use under this subsection shall result in abandonment of the application.]

(4) The failure to timely file a verified statement of use under paragraph (1) or an extension request under paragraph (2) shall result in abandonment of the application, unless it can be shown to the satisfaction of the Commissioner 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.

* * * * *

[DURATION

[SEC. 8. (a) Each certificate of registration shall remain in force for ten years: *Provided*, That the registration of any mark under the provisions of this Act shall be canceled by the Commissioner at the end of six years following its date, unless within one year next preceding the expiration of such six years the registrant shall file in the Patent and Trademark Office an affidavit setting forth those goods or services recited in the registration on or in connection with which the mark is in use in commerce and attaching to the affidavit a specimen or facsimile showing current use of the mark, or showing that any nonuse is due to special circumstances which excuse such nonuse and is not due to any intention to abandon the mark. Special notice of the requirement for such affidavit shall be attached to each certificate of registration.

[(b) Any registration published under the provisions of subsection (c) of section 12 of this Act shall be canceled by the Commissioner at the end of six years after the date of such publication unless within one year next preceding the expiration of such six years the registrant shall file in the Patent and Trademark Office an affidavit showing that said mark is in use in commerce or showing that its nonuse is due to special circumstances which excuse such nonuse and is not due to any intention to abandon the mark.

[(c) The Commissioner shall notify any registrant who files either of the above-prescribed affidavits of his acceptance or refusal thereof and, if a refusal, the reasons therefore.

[SEC. 9. (a) Each registration may be renewed for periods of ten years from the end of the expiring period upon payment of the prescribed fee and the filing of a verified application therefor, setting forth those goods or services recited in the registration on or in connection with which the mark is still in use in commerce and having attached thereto a specimen or facsimile showing current use of the mark, or showing that any nonuse is due to special circumstances which excuse such nonuse and it is not due to any intention to abandon the mark. Such application may be made at any time within six months before the expiration of the period for which the registration was issued or renewed, or it may be made within three months after such expiration on payment of the additional fee herein prescribed.

[(b) If the Commissioner refuses to renew the registration, he shall notify the registrant of his refusal and the reasons therefor.

[(c) An applicant for renewal not domiciled in the United States shall be subject to and comply with the provisions of section 1(e) of this Act.

[ASSIGNMENT

[SEC. 10. A registered mark or a mark for which application to register has been filed shall be assignable 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 1(b) shall be assignable prior to the filing of the verified statement of use under section 1(d), 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 1(e) of this Act.]

DURATION

SEC. 8. (a) Each registration shall remain in force for 10 years, except that the registration of any mark shall be canceled by the Commissioner for failure to comply with the provisions of subsection (b) of this section, upon the expiration of the following time periods, as applicable:

(1) For registrations issued pursuant to the provisions of this Act, at the end of 6 years following the date of registration.

(2) For registrations published under the provisions of section 12(c), at the end of 6 years following the date of publication under such section.

(3) For all registrations, at the end of each successive 10-year period following the date of registration.

(b) During the 1-year period immediately preceding the end of the applicable time period set forth in subsection (a), the owner of the registration shall pay the prescribed fee and file in the Patent and Trademark Office—

(1) an affidavit setting forth those goods or services recited in the registration on or in connection with which the mark is in use in commerce and such number of specimens or facsimiles showing current use of the mark as may be required by the Commissioner; or

(2) an affidavit setting forth those goods or services recited in the registration on or in connection with which the mark is not in use in commerce and showing that any such nonuse is due to special circumstances which excuse such nonuse and is not due to any intention to abandon the mark.

(c) The owner of the registration may make the submissions required by this section, or correct any deficiency in a timely filed submission, within a grace period of 6 months after the end of the applicable time period set forth in subsection (a). Such submission must be accompanied by a surcharge prescribed therefor. If any submission required by this section filed during the grace period is deficient, the deficiency may be corrected within the time prescribed after notification of the deficiency. Such submission must be accompanied by a surcharge prescribed therefor.

(d) Special notice of the requirement for affidavits under this section shall be attached to each certificate of registration and notice of publication under section 12(c).

(e) The Commissioner shall notify any owner who files 1 of the affidavits required by this section of the Commissioner's acceptance or refusal thereof and, in the case of a refusal, the reasons therefor.

(f) 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 address given in the last designation, such notice or process may be served upon the Commissioner.

RENEWAL OF REGISTRATION

SEC. 9. (a) Subject to the provisions of section 8, 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 Commissioner. 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 during the grace period is deficient, the deficiency may be corrected within the time prescribed after notification of the deficiency, upon payment of a surcharge prescribed therefor.

(b) If the Commissioner refuses to renew the registration, the Commissioner shall notify the registrant of the Commissioner's refusal and the reasons therefor.

(c) 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 address given in the last designation, such notice or process may be served upon the Commissioner.

ASSIGNMENT

SEC. 10. (a) 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 1(b) shall be assignable prior to the filing of an amendment under section 1(c) to bring the application into conformity with section 1(a) or the filing of the verified statement of use under section 1(d), 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. 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 conducted. 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 Patent and Trademark Office, the record shall be prima facie evidence of execution. An assignment shall be void against any subsequent purchaser for valuable consideration without notice, unless the prescribed information reporting the as-

signment is recorded in the Patent and Trademark Office within 3 months after the date of the subsequent purchase or prior to the subsequent purchase. The Patent and Trademark Office shall maintain a record of information on assignments, in such form as may be prescribed by the Commissioner.

(b) An assignee not domiciled in the United States 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 address given in the last designation, such notice or process may be served upon the Commissioner.

* * * * *

PUBLICATION

SEC. 12. (a) * * *

(b) 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 Commissioner that the delay in responding was [unavoidable] *unintentional*, whereupon such time may be extended.

* * * * *

SEC. 14. 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 by the registration of a mark on the principal register established by this Act, 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 Act.

(2) Within five years from the date of publication under section 12(c) hereof of a mark registered under the Act of March 3, 1881, or the Act of February 20, 1905.

(3) At any time if the registered mark becomes the generic name for the goods or services, or a portion thereof, for which it is registered, *or is functional*, or has been abandoned, or its registration was obtained fraudulently or contrary to the provisions of section 4 or of subsection (a), (b), or (c) of section 2 for a registration under this Act, or contrary to similar prohibitory provisions of such prior Acts for a registration under such Acts, or if the registered mark is being used by, or with the permission of, the registrant so as to misrepresent the source of the goods or services on or in connection with which the mark is used. If the registered mark becomes the generic name for less

than all of the goods or services for which it is registered, a petition to cancel the registration for only those goods or services may be filed. A registered mark shall not be deemed to be the generic name of goods or services solely because such mark is also used as a name of or to identify a unique product or service. The primary significance of the registered mark to the relevant public rather than purchaser motivation shall be the test for determining whether the registered mark has become the generic name of goods or services on or in connection with which it has been used.

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TITLE VI—REMEDIES

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SEC. 33. (a) * * *

(b) To extent that the right to use the registered mark has become incontestable under section 15, 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 15, or in the renewal application filed under the provisions of section 9 if the goods or services specified in the renewal 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 32, 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
- (7) That the mark has been or is being used to violate the anti-trust laws of the United States; or
- (8) *That the mark is functional; or*
- [(8)] (9) That equitable principles, including laches, estoppel, and acquiescence, are applicable.

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TITLE VIX—INTERNATIONAL CONVENTIONS

SEC. 44. (a) * * *

* * * * *

(d) An application for registration of a mark under section 1, 3, 4, [23, or 44(e) of this Act] *or 23 of this Act or under subsection (e) of this section* filed by 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) 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) * * *

* * * * *

(3) the rights required 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 applicant filed under **[this subsection (d)]** *this subsection*;

(4) nothing in **[this subsection (d)]** *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 country 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) A mark duly registered in the country of origin of the foreign applicant may be registered on the principal register if eligible, otherwise on the supplemental register herein provided. **[The application therefor shall be accompanied by a certification or a certified copy of the subsections registration in the country of origin of the applicant.]** *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.* 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.

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