

111TH CONGRESS
2^D SESSION

S. 2968

AN ACT

To make certain technical and conforming amendments to
the Lanham Act.

1 *Be it enacted by the Senate and House of Representa-*
2 *tives of the United States of America in Congress assembled,*

1 **SECTION 1. SHORT TITLE.**

2 This Act may be cited as the “Trademark Technical
3 and Conforming Amendment Act of 2010.”.

4 **SEC. 2. DEFINITION.**

5 For purposes of this Act, the term “Trademark Act
6 of 1946” means the Act entitled “An Act to provide for
7 the registration and protection of trademarks used in com-
8 merce, to carry out the provisions of certain international
9 conventions, and for other purposes”, approved July 5,
10 1946 (commonly referred to as the “Lanham Act”; 15
11 U.S.C. 1051 et. seq).

12 **SEC. 3. TECHNICAL AND CONFORMING AMENDMENTS.**

13 (a) CERTIFICATES OF REGISTRATION.—Section 7 of
14 the Trademark Act of 1946 (15 U.S.C. 1057) is amend-
15 ed—

16 (1) by inserting “United States” before “Patent
17 and Trademark Office” each place that term ap-
18 pears;

19 (2) in subsection (b), by striking “registrant’s”
20 each place that appears and inserting “owner’s”;

21 (3) in subsection (e)—

22 (A) by striking “registrant” each place
23 that term appears and inserting “owner”; and

24 (B) in the third sentence, by striking “or,
25 if said certificate is lost or destroyed, upon a
26 certified copy thereof”; and

1 (4) by amending subsection (g) to read as fol-
2 lows:

3 “(g) CORRECTION OF PATENT AND TRADEMARK OF-
4 FICE MISTAKE.—Whenever a material mistake in a reg-
5 istration, incurred through the fault of the United States
6 Patent and Trademark Office, is clearly disclosed by the
7 records of the Office a certificate stating the fact and na-
8 ture of such mistake shall be issued without charge and
9 recorded and a printed copy thereof shall be attached to
10 each printed copy of the registration and such corrected
11 registration shall thereafter have the same effect as if the
12 same had been originally issued in such corrected form,
13 or in the discretion of the Director a new certificate of
14 registration may be issued without charge. All certificates
15 of correction heretofore issued in accordance with the rules
16 of the United States Patent and Trademark Office and
17 the registrations to which they are attached shall have the
18 same force and effect as if such certificates and their issue
19 had been specifically authorized by statute.”.

20 (b) INCONTESTABILITY OF RIGHT TO USE MARK
21 UNDER CERTAIN CONDITIONS.—Section 15 of the Trade-
22 mark Act of 1946 (15 U.S.C. 1065) is amended—

23 (1) by striking “right of the registrant” and in-
24 serting “right of the owner”;

1 (2) by amending paragraph (1) to read as fol-
2 lows:

3 “(1) there has been no final decision adverse to
4 the owner’s claim of ownership of such mark for
5 such goods or services, or to the owner’s right to
6 register the same or to keep the same on the reg-
7 ister; and”;

8 (3) in paragraph (2), by inserting “United
9 States” before “Patent and Trademark Office”.

10 (c) APPEAL TO COURTS.—Section 21 of the Trade-
11 mark Act of 1946 (15 U.S.C. 1071) is amended—

12 (1) by inserting “United States” before “Patent
13 and Trademark Office” each place that term ap-
14 pears;

15 (2) in subsection (a)(1), by inserting “or section
16 71” after “section 8”; and

17 (3) in subsection (b)(4), by striking “If there
18 be” and inserting “If there are”.

19 (d) CONFORMING REQUIREMENTS FOR AFFIDA-
20 VITS.—

21 (1) DURATION, AFFIDAVITS AND FEES.—Sec-
22 tion 8 of the Trademark Act of 1946 (15 U.S.C.
23 1058) is amended to read as follows:

1 **“SEC. 8. DURATION, AFFIDAVITS AND FEES.**

2 “(a) TIME PERIODS FOR REQUIRED AFFIDAVITS.—

3 Each registration shall remain in force for 10 years, ex-
4 cept that the registration of any mark shall be canceled
5 by the Director unless the owner of the registration files
6 in the United States Patent and Trademark Office affida-
7 vits that meet the requirements of subsection (b), within
8 the following time periods:

9 “(1) Within the 1-year period immediately pre-
10 ceding the expiration of 6 years following the date
11 of registration under this Act or the date of the pub-
12 lication under section 12(c).

13 “(2) Within the 1-year period immediately pre-
14 ceding the expiration of 10 years following the date
15 of registration, and each successive 10-year period
16 following the date of registration.

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

23 “(b) REQUIREMENTS FOR AFFIDAVIT.—The affidavit
24 referred to in subsection (a) shall—

25 “(1)(A) state that the mark is in use in com-
26 merce;

1 “(B) set forth the goods and services recited in
2 the registration on or in connection with which the
3 mark is in use in commerce;

4 “(C) be accompanied by such number of speci-
5 mens or facsimiles showing current use of the mark
6 in commerce as may be required by the Director;
7 and

8 “(D) be accompanied by the fee prescribed by
9 the Director; or

10 “(2)(A) set forth the goods and services recited
11 in the registration on or in connection with which
12 the mark is not in use in commerce;

13 “(B) include a showing that any nonuse is due
14 to special circumstances which excuse such nonuse
15 and is not due to any intention to abandon the
16 mark; and

17 “(C) be accompanied by the fee prescribed by
18 the Director.

19 “(c) DEFICIENT AFFIDAVIT.—If any submission filed
20 within the period set forth in subsection (a) is deficient,
21 including that the affidavit was not filed in the name of
22 the owner of the registration, the deficiency may be cor-
23 rected after the statutory time period, within the time pre-
24 scribed after notification of the deficiency. Such submis-

1 sion shall be accompanied by the additional deficiency sur-
2 charge prescribed by the Director.

3 “(d) NOTICE OF REQUIREMENT.—Special notice of
4 the requirement for such affidavit shall be attached to
5 each certificate of registration and notice of publication
6 under section 12(c).

7 “(e) NOTIFICATION OF ACCEPTANCE OR REFUSAL.—
8 The Director shall notify any owner who files any affidavit
9 required by this section of the Director’s acceptance or
10 refusal thereof and, in the case of a refusal, the reasons
11 therefor.

12 “(f) DESIGNATION OF RESIDENT FOR SERVICE OF
13 PROCESS AND NOTICES.—If the owner is not domiciled
14 in the United States, the owner may designate, by a docu-
15 ment filed in the United States Patent and Trademark
16 Office, the name and address of a person resident in the
17 United States on whom may be served notices or process
18 in proceedings affecting the mark. Such notices or process
19 may be served upon the person so designated by leaving
20 with that person or mailing to that person a copy thereof
21 at the address specified in the last designation so filed.
22 If the person so designated cannot be found at the last
23 designated address, or if the owner does not designate by
24 a document filed in the United States Patent and Trade-
25 mark Office the name and address of a person resident

1 in the United States on whom may be served notices or
2 process in proceedings affecting the mark, such notices or
3 process may be served on the Director.”.

4 (2) AFFIDAVITS AND FEES.—Section 71 of the
5 Trademark Act of 1946 (15 U.S.C. 1141k) is
6 amended to read as follows:

7 **“SEC. 71. DURATION, AFFIDAVITS AND FEES.**

8 “(a) TIME PERIODS FOR REQUIRED AFFIDAVITS.—
9 Each extension of protection for which a certificate has
10 been issued under section 69 shall remain in force for the
11 term of the international registration upon which it is
12 based, except that the extension of protection of any mark
13 shall be canceled by the Director unless the holder of the
14 international registration files in the United States Patent
15 and Trademark Office affidavits that meet the require-
16 ments of subsection (b), within the following time periods:

17 “(1) Within the 1-year period immediately pre-
18 ceding the expiration of 6 years following the date
19 of issuance of the certificate of extension of protec-
20 tion.

21 “(2) Within the 1-year period immediately pre-
22 ceding the expiration of 10 years following the date
23 of issuance of the certificate of extension of protec-
24 tion, and each successive 10-year period following

1 the date of issuance of the certificate of extension of
2 protection.

3 “(3) The holder may file the affidavit required
4 under this section within a grace period of 6 months
5 after the end of the applicable time period estab-
6 lished in paragraph (1) or (2), together with the fee
7 described in subsection (b) and the additional grace
8 period surcharge prescribed by the Director.

9 “(b) REQUIREMENTS FOR AFFIDAVIT.—The affidavit
10 referred to in subsection (a) shall—

11 “(1)(A) state that the mark is in use in com-
12 merce;

13 “(B) set forth the goods and services recited in
14 the extension of protection on or in connection with
15 which the mark is in use in commerce;

16 “(C) be accompanied by such number of speci-
17 mens or facsimiles showing current use of the mark
18 in commerce as may be required by the Director;
19 and

20 “(D) be accompanied by the fee prescribed by
21 the Director; or

22 “(2)(A) set forth the goods and services recited
23 in the extension of protection on or in connection
24 with which the mark is not in use in commerce;

1 “(B) include a showing that any nonuse is due
2 to special circumstances which excuse such nonuse
3 and is not due to any intention to abandon the
4 mark; and

5 “(C) be accompanied by the fee prescribed by
6 the Director.

7 “(c) DEFICIENT AFFIDAVIT.—If any submission filed
8 within the period set forth in subsection (a) is deficient,
9 including that the affidavit was not filed in the name of
10 the holder of the international registration, the deficiency
11 may be corrected after the statutory time period, within
12 the time prescribed after notification of the deficiency.
13 Such submission shall be accompanied by the additional
14 deficiency surcharge prescribed by the Director.

15 “(d) NOTICE OF REQUIREMENT.—Special notice of
16 the requirement for such affidavit shall be attached to
17 each certificate of extension of protection.

18 “(e) NOTIFICATION OF ACCEPTANCE OR REFUSAL.—
19 The Director shall notify the holder of the international
20 registration who files any affidavit required by this section
21 of the Director’s acceptance or refusal thereof and, in the
22 case of a refusal, the reasons therefor.

23 “(f) DESIGNATION OF RESIDENT FOR SERVICE OF
24 PROCESS AND NOTICES.—If the holder of the inter-
25 national registration of the mark is not domiciled in the

1 United States, the holder may designate, by a document
2 filed in the United States Patent and Trademark Office,
3 the name and address of a person resident in the United
4 States on whom may be served notices or process in pro-
5 ceedings affecting the mark. Such notices or process may
6 be served upon the person so designated by leaving with
7 that person or mailing to that person a copy thereof at
8 the address specified in the last designation so filed. If
9 the person so designated cannot be found at the last des-
10 ignated address, or if the holder does not designate by a
11 document filed in the United States Patent and Trade-
12 mark Office the name and address of a person resident
13 in the United States on whom may be served notices or
14 process in proceedings affecting the mark, such notices or
15 process may be served on the Director.”.

16 **SEC. 4. STUDY AND REPORT.**

17 (a) IN GENERAL.—Not later than 1 year after the
18 date of enactment of this Act, the Secretary of Commerce,
19 in consultation with the Intellectual Property Enforcement
20 Coordinator, shall study and report to the Committee on
21 the Judiciary of the Senate and the Committee on the Ju-
22 diciary of the House of Representatives on—

23 (1) the extent to which small businesses may be
24 harmed by litigation tactics by corporations attempt-
25 ing to enforce trademark rights beyond a reasonable

1 interpretation of the scope of the rights granted to
2 the trademark owner; and

3 (2) the best use of Federal Government services
4 to protect trademarks and prevent counterfeiting.

5 (b) RECOMMENDATIONS.—The study and report re-
6 quired under paragraph (1) shall also include any policy
7 recommendations the Secretary of Commerce and the In-
8 tellectual Property Enforcement Coordinator deem appro-
9 priate.

Passed the Senate January 28, 2010.

Attest:

Secretary.

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