

111TH CONGRESS  
2D SESSION

# S. 2968

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IN THE HOUSE OF REPRESENTATIVES

JANUARY 29, 2010

Referred to the Committee on the Judiciary

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## 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”; 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:

NANCY ERICKSON,

*Secretary.*