§ H.R. 13109

A. By filing in the Patent Office--
(a) A written application addressed to the commissioner, signed and verified by the applicant before any officer mentioned in section 15, stating the applicant's name, citizenship, domicile, residence and business address,

[2]
upon what goods the trade--mark is used, the duration of such use, how the right was acquired, and if by succession or assignment, from whom, and upon information and belief that the applicant is entitled to the exclusive use of the trade--mark in the United States, and that the applicant is using it in commerce. A description of the trade--mark may be included if desired by the applicant or required by the commissioner;
(b) A drawing of the trade--mark; and
(c) Such number of specimens or facsimiles of the trade--mark as actually used as may be required by the commissioner;
B. By paying into the Patent Office the sum of $10; and
C. By complying with such rules or regulations not inconsistent with law as may be prescribed by the commissioner.

If the applicant resides or is located in a foreign country, and the trade--mark has been registered by the applicant or an application for the registration thereof has been filed by him in such foreign country the application shall set forth this fact and shall give the date of such registration or application. In such cases the applicant need not allege use in commerce.

[3]

SEC. 2. No mark by which the goods to which it is applied by the applicant may be distinguished as to source or origin shall be refused registration as a trade--mark on account of its nature unless it--
(a) Consists of or comprises immoral, deceptive, or scandalous matter.
(b) Consists of or comprises the flag or coat of arms or other insignia of the United States, or of any State or municipality, or of any foreign nation, or any simulation thereof.
(c) Consists of or comprises the portrait or signature of a living individual unless by his written consent, or the name, portrait, or signature of any deceased President of the United States during the life of his widow, if any, unless by her written consent.
(d) Consists of or comprises a mark which so resembles a trade--mark previously used by another as to be likely, when applied to the goods of the applicant, to cause confusion or mistake or to deceive purchasers as to their source or origin.
When such previously used trade--mark is applied to merchandise of the same descriptive properties it shall constitute prima facie grounds for refusing registration.
(e) Consists of a mark which when applied to the goods of the applicant has merely a descriptive or geographical meaning or is merely a surname.

[4]

Rejection on any of the foregoing grounds shall be subject to rebuttal by evidence of relevant facts.
(f) Except as expressly excluded in paragraphs (a), (b), (c), and (d) of this section, nothing herein shall prevent the registration of any mark used as a trade--mark by the applicant in commerce which, in accordance with the principles of common law, shall be shown by proof convincing beyond a reasonable doubt to have acquired a secondary meaning distinguishing the applicant's goods.
(g) Registrations of a mark except under paragraph (f) of this section shall be prima facie evidence of ownership as of the date the application was filed. Registration of a mark by virtue of paragraph (f) shall be prima facie evidence of secondary meaning distinguishing the registrant's goods as of the date of registration.

SEC. 3. In addition to the registration provided in sections 1 and 2 of this Act, the commissioner shall keep a register of all marks communicated to him by an international bureau organized under the provisions of a treaty or convention to which the United States is a party and in connection with which the fee required by such conventions for international registration and the fee for registration provided by the laws of the United States have been paid where the mark so communicated is deemed by the Commissioner of Patents to be such that protection can be granted thereto in accordance

[5]
with existing law. The communications from the international bureau shall show the name and address of the owner of the mark; the date of application for registration in the State of first registration or deposit, which State must be one of the signatory countries; the number of the registration and the date of expiration in the State of first registration or deposit; a facsimile of the mark; a statement of the goods on which the mark is used in the State of first registration or deposit; the date of the application for recognition of the rights claimed under the convention; and such other data as may be useful concerning the mark. If objection is made to the registration of such mark, notice thereof shall be communicated by the commissioner to the said international bureau.
Registrations effected under the foregoing paragraph shall be subject to renewal and to cancellation in accordance with the provisions of this Act.
When protection is refused to any mark communicated by an international bureau as above specified, by reason of a prior registration or pending application for registration, the proprietor of the mark claiming recognition of rights under the treaty or convention shall have the right to seek and obtain the cancellation of the previously registered mark, upon proving, according to the procedure fixed by existing law, such refusal and--

[6]
(1) That he had legal protection for his mark in any of the contracting States before the date of use of the mark the registration of which he seeks to cancel; or
(2) That the registrant had no right to the ownership, use, or employment of the registered mark at the date of its deposit; or
(3) That the mark covered by the registration which he seeks to cancel has been abandoned.
The time within which such application for the cancellation of a registration may be made shall be two years from September 30, 1926, if the refusal to register was made prior to that date, and

in all other cases it shall be one year from the date of the receipt by the international bureau of the refusal to register.
The foregoing section shall be construed in accordance with the reservations adopted by the Senate of the United States on February 24, 1925, in ratifying the Convention for the Protection of Commercial, Industrial, and Agricultural Trade--Marks and Commercial Names, signed at Santiago, Chile, on April 28, 1923, the third, fourth, and fifth of said reservations being as follows:
Third. That the expressions in Article I "without prejudice to the rights of third parties" and in Article II" in the absence of other proof of ownership of a mark" are, and shall be, interpreted to protect every user of a

[7]
trade--mark in the United States having ownership thereof by reason of adoption and use, and with or without subsequent registration, from any claim of priority under this convention based upon an application or an entry in a signatory State subsequent to the actual date of such adoption and use in the United States.
Fourth. That the expression "legal protection for his mark" in section 2 (a) of Article V shall be interpreted to include ownership of the mark in the United States acquired by adoption and use and with or without subsequent registration.
Fifth. That nothing contained in this convention shall take away or lessen any trade--mark right or any right to use a trade--mark of any person residing or doing business in the United States heretofore or hereafter lawfully acquired under the common law or by virtue of the statutes of the several States or of the United States.
The commissioner may record transfers or assignments of trade--mark upon regular notification of such transfers or assignments received from the proper international bureau upon the payment of the statutory recording fee.
Owners of marks so registered, being domiciled in any country which is a party to said convention, shall enjoy, while the registration remains in force, all the rights and benefits conferred by said convention.

[8]

SEC. (4) In addition to the registrations hereinbefore provided for, the commissioner shall keep a register of marks as a continuation of the register of marks heretofore registered under paragraph (b) of section 1 of the Act of March 19, 1920, entitled "An Act to give effect to certain provisions of the convention for the protection of trade--marks and commercial names, made and signed in the city of Buenos Aires, in the Argentine Republic, August 20, 1910, and for other purposes." Whenever any person engaged in manufacturing in, or exporting from, the United States shall apply for registration of any mark which distinguishes or is adapted to distinguish the goods as those of the applicant (including, for the purposes of this section, a trade--mark, symbol, label, package, configuration of goods, name, word or phrase) other than those expressly excluded by paragraphs (a), (b), (c), and (d) of section 2, which is used upon goods manufactured by or for such applicant and exported, or about to be exported, to any foreign country, accompanied by a verified statement that such mark distinguishes or is adapted and intended to distinguish the goods as those of the applicant, and shall pay into the Patent Office the sum of $25, the commissioner, subject to prompt examination and search and determination that the mark

distinguishes or is adapted to distinguish the goods as those of the applicant and is not excluded by paragraphs (a), (b),

[9]
(c), and (d), of section 2, shall forthwith register said mark in said register and issue a certificate of registration for such mark, which shall be evidence of the date of filing the application therefor, and of the claim of the registrant of right in such mark. Registrations under this section, including marks heretofore registered under paragraph (b) of section 1 of said Act of March 19, 1920, shall give the registrant the same protection in commerce of the marks so registered as the common law affords. Applications under this section shall not be published for opposition, as provided in section 7, and shall not be subject to opposition as provided in section 13, but the registrations shall be subject to cancellation under section 13, paragraph (b), or section 14, paragraph (f). Such registration shall not be used to stop importations under section 28. Registration under this section shall not preclude registration to the owner of a trade--mark under any other section of this Act.
Upon the filing in the Patent Office of the written consent of a registrant under section 1 and 2 hereof, a subsidiary or subsidiaries or representative or representatives of such registrant may register the same trade--mark under this section. By written notice to the commissioner, the said registrant may withdraw such consent, whereupon the registration under this section shall be transferred on the records of the Patent Office to the name of the registrant

[10]
under sections 1 and 2 hereof, or his nominee, or canceled at the said registrant's option.

SEC. 5. A. In order to have available for search purposes a collection of unregistered marks, the commissioner is authorized to form such a collection and to that end to accept, file, and classify such unregistered marks as may be entered as provided in this section.
(1) Any mark (including, for the purposes of this section, a trade--mark, symbol, label, package, configuration of goods, name, word, or phrase) used in commerce and identifying any merchandise or business, may be entered in the Patent Office by the user by filing one or more copies, facsimiles, or representations thereof, as the commissioner may direct, on a form to be furnished by the commissioner, and under oath, and by paying into the Patent Office a fee of $2. Any person using, in commerce, any such mark, which shall not have been registered and for which no application for registration has been filed before this Act becomes effective, who shall fail either to apply to register or enter such mark before the expiration of one year after the first use thereof in commerce, or within one year after this Act takes effect, shall, on applying to register in any form under this Act, pay, as a fee for such registration, in lieu of any other fees prescribed in this Act, the sum of $30. There shall be ex--

[11]
cepted from the foregoing the trade names embraced in article 8 of the convention mentioned in section 6hereof, but such trade names may be entered under this section at the option of the user thereof. Any user of a mark solely within a State may, at his option, enter the same under this section.
(2) The commissioner shall not accept for entry any mark already registered, or for which an application for registration is pending, for the same goods.

(3) The commissioner shall mark as abandoned or canceled and may remove from this collection abandoned marks and marks which are immoral, scandalous, or otherwise unlawfully entered.
(4) Any mark entered under the provisions of this section shall be marked as abandoned or canceled and may be removed from said collection of unregistered marks at the end of five years following the date of entry thereof, unless within three months next preceding the expiration of such five years the entrant or his successor in business shall file in the Patent Office an affidavit in such form as may be prescribed by the commissioner to the effect that said mark is still in use by the entrant or his successor in business. A form of such affidavit shall be mailed by the commissioner to the entrant not less than three months prior to the expiration of such five--year period but failure to receive such

[12]
form shall not excuse the failure to file such affidavit. At the expiration of each succeeding five--year period thereafter a similar procedure shall be followed in the case of each entered mark and the entered mark shall be marked as abandoned or canceled and may be removed from said collection unless such affidavit is filed by the entrant or his successor in business within three months preceeding the expiration of each such five--year period.
(5) An entry under this section shall have no legal effect except as evidence that, at its date, the entrant claimed a right in the entered mark.
(6) An entered mark shall not of itself be ground for rejection of an application for registration, but if the commissioner believes that an entered mark conflicts or may conflict with an application for registration under sections 1,2, or 23 hereof, the commissioner upon the publication of the applied--for mark shall notify both the applicant and the entrant.
B. (1) The commissioner shall cause to be assembled for search purposes, in such form as the commissioner may determine, all marks--
(a) Now registered and which may hereafter be registered;
(b) For which applications for registration are pending;

[13]
(c) Which may be entered under section 5 A; and
(d) Any other marks in actual use which the commissioner may direct.
Such collection of marks shall be open to public inspection at such times as the commissioner may prescribe.
(2) The commissioner may remove from the file for search purposes abandoned or other marks at his discretion.

SEC. 6. (a) An application for registration of a trade--mark, filed in this country by any person who has previously regularly filed an application for registration of the same trade--mark in a foreign country wherein he is domiciled, and which is his first application in any country, if such country by treaty, convention, or law, affords similar privileges to citizens of the United States, shall be accorded the same force and effect as would be accorded to the same application if filed in this country on the date on which the application was first filed in such foreign country, if such application is filed in this country within four months from the date on which the application was first filed in such foreign country. Applications under this section shall conform as nearly as practicable to the requirements of section 1, but need not allege use in commerce.

(b) Every owner of a trade--mark, being domiciled in any country which is a party to the international convention entered into at Paris March 20, 1883, revised at

[14]
Brussels December 14, 1900, and at Washington June 2, 1911, shall enjoy with respect to the registration of said trade--mark, and while such registration remains in force, all the rights and benefits concerning trade--marks and unfair competition conferred by said convention. Rights of priority under such registrations shall be determined as provided in said convention.
(c) Foreign or alien owners of trade--marks used in this country shall, unless otherwise provided by treaty, enjoy the same right to such trade--marks at common law, and the same right to register or enforce such trade--marks under the other sections of this Act as citizens or residents of the United States, and their rights of priority, unless otherwise provided by treaty, shall be determined by their actual use of such trade--marks within the United States.

SEC. 7. Upon the filing of an application for registration under sections 1, 2, or 23 hereof, and payment of the fees herein provided for, the commissioner shall cause an examination thereof to be made, and if on such examination it shall appear that the applicant is entitled to registration under the provisions of this Act, the commissioner shall cause the mark to be published at least once in the Official Gazette of the Patent Office. If no notice of opposition, as hereinafter pro-

[15]
vided, is filed within the period specified in section 13, paragraph (a), the commissioner may issue a certificate of registration therefor. If on examination an application is refused, the commissioner shall notify the applicant, giving his reasons therefor. Applications under sections 3 and 4 shall not be published for opposition, but shall be published when registered. This section (section 7) shall not apply to marks entered under section 5.

SEC. 8. Every applicant for registration of a trade--mark or for renewal of registration of a trade--mark, who is not resident within the United States, shall, before the issuance of the certificate of registration or renewal, as herein provided, designate, by a notice in writing filed in the Patent Office, some person residing within the United States on whom process or notice of proceedings affecting the registration of the trade--mark of which such applicant may claim to be the owner, brought under the provision of this Act or under other laws of the United States, may be served with the same force and effect as if served upon the applicant or registrant in person. Such designation shall be continuously maintained. Any nonresident registrant shall in like manner designate such a representative; and after this Act takes effect no suit or action shall be brought under any registration owned by such nonresident registrant, and no profits or damages for infringement of such registered mark

[16]
shall be recoverable under this Act, until and unless such notice of designation has been filed and maintained. Such service may be made by leaving a copy of the process or notice at the last address of which the commissioner has been notified or by mailing it to such address.

SEC. 9. In an ex parte case, appeal may be taken to the commissioner in person from the decision of the examiner in charge of trade--marks and from the decision of the commissioner to

the Court of Appeals of the District of Columbia. The conditions required in case of an appeal from the decision of the Board of Appeals by an applicant for patent, or a party to an interference as to an invention, shall be compelled with in an appeal to said Court of Appeals under this section, and the same rules of practice and procedure shall govern in every stage of such proceedings, as far as the same may be applicable.

SEC. 10. (a) All certificates of registration of trade--marks shall be issued in the name of the United States of America, under the seal of the Patent Office, and shall either be signed by the commissioner or have his name printed thereon and attested by an assistant commissioner or by one of the law examiners duly designated by the commissioner, and shall be recorded, together with printed copies of the drawing and application, in the Patent Office in books to be kept for that purpose. The certificate shall

[17]
state the date on which the application for registration was received in the Patent Office. Certificates of registration of trade--marks may be issued to the assignee of the applicant where the assignment has been recorded in the Patent Office. In case of succession or change of ownership the commissioner may, upon a proper showing at the request of the owner or successor and upon the payment of a fee of $10, issue to such owner or successor a new certificate of registration of the said trade--mark in the name of such owner or successor.
(b) The commissioner, upon application of the registrant, may permit any registration under this or any previous Act to be canceled or for good cause to be amended or disclaimed in whole or in part, at any time, provided when so amended it shall still contain registrable matter, and shall make appropriate entry upon the records of the Patent Office and upon the certificate of registration or if said certificate is lost or destroyed upon a certified copy thereof.
(c) Copies of any records, books, papers, or drawings relating to trade--marks belonging to the Patent Office, and of certificates of registration, authenticated by the seal of the Patent Office and certified by the commissioner or in his name by a chief of division duly designated by the commissioner, shall be evidence in all cases

[18]
wherein the originals would be evidence; and any person making application therefor and paying the fee required by law shall have such copies.
(d) Whenever a mistake in a trade--mark registration, incurred through the fault of the Patent Office, is clearly disclosed by the records of the office, a certificate stating the fact and nature of such mistake, signed by the commissioner and sealed with the seal of the Patent Office, may be issued, without charge, and recorded in the records of trade--marks and a printed copy thereof attached to each printed copy of the trade--
mark registration, and such certificate shall thereafter be considered as part of the original, and every trade--mark registration, together with such certificate, shall have the same effect and operation in law on the trial of all actions or causes thereafter arising as if the same had been originally issued in such corrected form. All such certificates heretofore issued in accordance with the rules of the Patent Office and the trade--mark registrations to which they are attached shall have the same force and effect as if such certificates had been specifically authorized by statute.

(e) Whenever a mistake has been made in a trade--mark registration and a showing has been made that such mistake occurred in good faith through the fault of the applicant, the commissioner is authorized to issue a certificate of

[19]
correction upon the payment of a fee of $10, provided the correction is not such as to necessitate republication of the mark.

SEC. 11. Each certificate of registration shall remain in force for twenty years and shall be effective throughout the United States: Provided. That the registration of any mark under the provisions of this Act shall be canceled at the end of five years following the date of said registration, unless within three months next preceding the expiration of such five years the registrant shall file in the Patent Office an affidavit in such form as may be prescribed by the commissioner to the effect that said mark is still in use by the registrant. If, however, nonuse is due to special circumstances beyond the control of the registrant and not to any intention not to use or to abandon such trade--mark, the registrant shall file an affidavit to this effect at the time and in the manner provided for the affidavit of continued use, in which case the registration shall not be canceled because of such nonuse. Forms for such affidavits shall be mailed by the commissioner to the registrant or to his duly authorized attorney or to his representative designated as provided in section 8 hereof, not less than three months prior to the expiration of such five--year period, but failure to receive such form shall not excuse the failure to file such affidavit.

[20]
Certificates of registration may be renewed for like periods of twenty years from the end of the expiring period on payment of the renewal fees required by this Act upon requests by the registrant, and such requests may be made at any time within six months prior to the expiration of the period for which the certificates of registration were issued or renewed. Certificates of registration in force at the date at which this Act takes effect shall remain in force for the period for which they were issued and shall have the same force and effect as if the Acts under which they were issued had not been repealed, but they shall be renewable only under the provisions of this Act, and when so renewed shall have the same force and effect as certificates issued under this Act.

SEC. 12. (a) Registration under sections 1 and 2 hereof or under the Act of February 20, 1905, shall, from the date when this Act takes effect, be constructive notice as of the date of registration to all persons of the fact of registration and of the fact that the registrant claims the right to the exclusive use in commerce of the mark so registered.
(b) It shall be the duty of the registrant to accompany a trade--mark registered under sections 1,2, and 3hereof and trade names, marks, and devices registered under section 23 hereof with the words "Registered in U.S. Patent Office" or "Reg. U.S. Pat. Off.", and in any suit for infringement under this Act by a registrant failing so to mark, no profits

[21]

and no damages shall be recovered except on proof that the defendant had actual notice or knowledge and continued to infringe after such notice or knowledge, and no such profits or damages shall accrue except after such notice or knowledge.
(c) It shall be unlawful for any person to accompany any mark, name, or device used in commerce and not registered under sections 1,2,3, or 23 hereof or a mark merely entered under section 5 hereof, or merely registered under section 4 hereof, with the words "Registered in U.S. Patent Office", or "Reg. U.S. Pat. Off.", or "Deposited in the U.S. Patent Office", or "Entered in the U.S. Patent Office", or "Recorded in the U.S. Patent Office", or with any other letters, words, or abbreviations of like import; or to use in commerce in connection with any such mark any such words or abbreviations on any label or in any catalogue, circular, or advertising matter.
(d) Any person who violates the provisions of section 12 (c) of this Act shall be guilty of a misdemeanor punishable by a fine of not less than $100 or more than $250.

SEC. 13. The following shall be the contested proceedings in the Patent Office:
(a) Opposition: Any person who would be damaged by the registration of a mark may oppose the same by filing notice of opposition in the Patent Office, in such form as the commissioner may by rule prescribe, within thirty days after

[22]
the publication in the Official Gazette of the mark sought to be registered. A notice of opposition may be filed by an authorized attorney, but shall be void unless ratified by the opposer within a reasonable time after such filing. For good cause shown the time for filing notice of opposition may be extended by the commissioner not more than thirty days and for good cause shown the commissioner may receive a notice of opposition filed within sixty days from the date of publication.
(b) Cancellation: Any person who is damaged by the registration of a trade--mark, except a person against whom a suit is pending thereunder, may at any time apply to the commissioner to cancel the registration thereof by filing a petition in the Patent Office in such form as the commissioner may by rule prescribe. Abandonment shall be among the grounds for cancellation. Nonuse by the registrant for more than two years shall be prima facie evidence of abandonment unless such nonuse is shown to be due to special circumstances beyond the control of the registrant and not to any intention not to use or to abandon such trade--mark.
(c) Interference: Whenever application is made for the registration of a trade--mark which so resembles a trade--mark for which a certificate of registration has previously been issued to another, or for the registration of which

[23]
another has previously made application, as to be likely, in the opinion of the commissioner, when applied to the goods of the applicant, to cause confusion or mistake or to deceive purchasers as to their source or origin the commissioner may declare that an interference exists.
(d) In every case of opposition to registration, petition for the cancellation of a registered trade--mark, or interference, the commissioner shall direct the examiner in charge of interferences to determine the issues according to the common law or treaty rights of the parties, and under rules prescribed by the commissioner.
(e) Appeal may be taken to the commissioner in person from the decision of the examiner of interferences.

(f) The commissioner may refuse to register the mark against the registration of which opposition is filed, may cancel the registration of a registered trade--mark, or may refuse to register both of two interfering marks, or may register the trade--mark for the person entitled thereto. Action shall be stayed for sixty days after final decision by the commissioner to give time for proceeding as provided in section 14.
(g) Whenever there shall be pending in the Patent Office an interference and an opposition or cancellation concerning the same trade--mark and involving the same or like issues, so that the proceedings may conveniently be

[24]
determined upon the same evidence, such proceedings may be consolidated upon motion of any party thereto or by direction of the commissioner.
(h) In any suit pending in a Federal court between the parties to a contested proceeding in the Patent Office involving the same trade--mark, the commissioner shall, on the request and at the expense of any party to such suit, certify and transmit to the clerk of the court a transcript of the record in such contested proceeding, including the testimony and exhibits, or such portion thereof as the parties may stipulate. The record so certified shall be treated as evidence in the suit and shall have the same force and effect as if taken and produced therein.

SEC. 14. (a) Upon the decision of the commissioner any party to any of the proceedings mentioned in section 13 hereof may, within sixty days after the decision of the commissioner, file a bill in equity for relief in any court of original jurisdiction named in section 21 hereof in the district of the residence or principal place of business of the adverse party; or, if there are two or more such parties, then in the district of the residence or principal place of business of any of them; or, if such party is not domiciled in the United States, then in the court of the district of the residence of the representative designated as provided in section 8 hereof; or, if no representative is so designated, then in the District of

[25]
Columbia. The court shall then issue its process (which may be served anywhere in the United States) to all parties to such proceeding and shall thereupon have general jurisdiction of the controversy and of the parties.
(b) In all suits brought hereunder the record in the Patent Office shall be admitted in whole or in part, on motion of either party, subject to such terms and conditions as to costs, expenses, and the further cross--examination of the witnesses as the court may impose, without prejudice, however, to the right of the parties to take further testimony. The testimony and exhibits or parts thereof of the record in the Patent Office when admitted shall have the same force and effect as if originally taken and produced in the suit.
(c) The court may determine the right to registration, order the cancellation of registrations, restore canceled registrations and otherwise rectify the register, and shall make and enter such orders and decrees as the case may require, including relief by way of injunction, damages, profits, costs, and otherwise, as provided in section 18, and such judgment or decree may be enforced as provided in section 22 hereof.
(d) Except in ex parte cases, the provisions of section 4915 of the Revised Statutes shall not apply in trade--mark cases.

[26]
(e) Any order of the court with respect to the right of registration, the cancellation of registrations, the restoration of canceled registrations, or otherwise rectifying the register shall be served upon the commissioner, who shall make appropriate entry upon the records of the Patent Office and be controlled thereby.
(f) In lieu of the method provided in paragraph (b) of section 13 any person damaged by any registration of a trade--mark may have relief by a suit in equity against the registrant for cancellation of such registration brought in the district of the residence of the registrant or if the registrant is not a resident of the United States then in the district of the residence of the representative designated, as provided in section 8 hereof, or if no representative is so designated then in the District of Columbia, and the court on due proceedings had may, according to the circumstances of the case, adjudge the right to cancellation of such registration in whole or in part or to other rectification of the register. And such adjudication in favor of the right of a party shall authorize the commissioner to cancel such registration in whole or in part or otherwise rectify the register as the case may require, on the party filing in the Patent Office a copy of the adjudication and otherwise complying with the requirements of law.

[27]

SEC. 15. (a) Every registered trade--mark and every mark for the registration of which application has been made, together with the application for registration of the same, shall be assignable in connection with the business and good will in which the mark is used, or the portion thereof to which the mark is appurtenant, by an instrument in writing, duly acknowledged or otherwise proved, according to the laws of the country or State in which it is executed or made; any such assignment shall be void as against any subsequent purchaser for a valuable consideration, without notice, unless it is recorded in the Patent Office within three months from the date thereof or prior to such subsequent purchase. The commissioner shall keep a record of such assignments.
The commissioner shall not accept for record any such assignment in which the assignee therein named is not a resident within the United States unless and until such assignee shall designate by a notice in writing filed in the Patent Office some person residing within the United States on whom process or notice of proceeding affecting the registration or entry of the mark of which such assignee may claim to be the owner, brought under the provisions of this Act or under other laws of the United States, may be served with the same force and effect as if served upon the assignee in person.

[28]
(b) If any such assignment be acknowledged before any notary public of a State or any clerk or commissioner of any United States district court, or before any secretary of legation or consular officer authorized by the laws of the United States to administer oaths or perform notarial acts, or before any notary public, judge, or magistrate of any foreign country authorized to administer oaths or perform notarial acts in such country and whose authority shall be approved by certificate of a diplomatic or consular officer of the United States, the certificate of such acknowledgment shall be prima facie evidence of the execution of such assignment and when recorded in the Patent Office such record shall be prima facie evidence of the execution of such assignment.

SEC. 16. Fees payable to the Patent Office under this Act shall be as follows: On filing each original application for registration of a trade--mark except under section 4, $10; under section 4, $25; on filing each such application after one year, as provided in section 5, additional, $20; on filing application under section23, $10; on filing each application for renewal, $10; on issuing a new certificate under section 10, paragraphs (a) and (c), $10; on each entry under section 5, $2; on filing notice of opposition or a petition for cancellation (except under section 10 (b)), $10; on filing a disclaimer or an amendment to a registration, $10; on appeal

[29]
from the examiner in charge of trade--marks to the commissioner, $15; on appeal from the decision of the examiner in charge of interferences to the commissioner, $15; for manuscript copies, for every one hundred words or fraction thereof, 10 cents; for each printed copy of registration and drawing, 10 cents; for comparing other copies, 5 cents for every one hundred words or fraction thereof; for certifying in any case, additional,75 cents; for each additional registration or application which may be included under a single certificate, 25cents additional; for recording every assignment or other paper of three hundred words or under, $1; of over three hundred and under one thousand words, $2; and for each additional thousand words or fraction thereof,$1; for each additional trade--mark or application included, or involved in one writing where more than one is so included or involved, additional, 25 cents.

SEC. 17. The commissioner is authorized to refund fees paid by mistake or in excess.

SEC. 18. Any person who shall infringe in commerce any trade--mark registered under section 1, 2, or 3hereof shall be liable--
(a) To an injunction restraining infringement of such registered trade--mark.
(b) To pay to the owner such damages as he may have suffered from the infringement.

[30]
(c) To pay to the owner all profits which the infringer shall have made from such infringement, and in proving profits the plaintiff shall be required to prove sales only, and the defendant shall be required to prove every element of cost or deduction claimed; but there shall be no recovery of profits from any defendant whose adoption and use of an infringing trade--mark was in good faith and without knowledge of the plaintiff's right thereto, except such profits as accrued therefrom after such defendant had actual notice or knowledge thereof.
(d) If the court shall find that the damages or profits or both are either inadequate or excessive, the court may in its discretion decree the payment of such sum as the court shall find to be just according to the circumstances of the case, such sum to constitute compensation and not a penalty.
(e) To deliver up, on oath, upon such terms and conditions as the court may prescribe, all copies, counterfeits, or colorable imitations of the registered trade--mark, to be impounded during the pendency of the proceeding.
(f) To deliver up, on oath, for destruction, all copies, counterfeits, or colorable imitations of the registered trade--mark, and all plates, molds, matrices or other means of making the same.

[31]

(g) To deliver up, on oath, for destruction, all printed matter containing any copies, counterfeits, or colorable imitations of the registered trade--mark, and all plates, molds, matrices, or other means of making the same; but when such printed matter is a catalogue, or otherwise consists mainly of noninfringing matter, the objectionable contents thereof may be obliterated or otherwise removed as the court may direct.
(h) The remedy of injunction against infringement of a registered trade--mark may extend throughout the United States or any lesser territory, as may be determined by the court according to the circumstances of the case, and need not be limited to be merely coextensive with the territory within which the owner has used such registered trade--mark; and the court may give the plaintiff the benefit of all other remedies named in this section.
(i) This section shall be applicable only to infringements committed after this Act shall take effect; for infringements previously committed the remedies shall be those provided by the statutes heretofore in force.
(j) The benefits of this section shall not inure to entries made under section 5, or to registration under section 4.
(k) Rules and regulations for practice and procedure under this section and under sections 14 and 28 (c) may be prescribed by the Supreme Court of the United States.

[32]

SEC. 19. Any court given jurisdiction under this Act may, in any action, suit, or proceeding, enter a judgment or decree enforcing the remedies herein provided. It shall be the duty of the clerks of said courts upon the filing of any pleading in any action, suit, or proceeding under this Act, to give notice to the commissioner, giving the title of the case and the numbers of the registrations or of any entry which may be involved therein, and upon the entry of each judgment or decree to give notice thereof to the commissioner; and for each such notice the clerk shall tax a fee of 50 cents as costs of suit. It shall be the duty of the commissioner on receipt of each such notice to enter the same in the file wrapper of each registration so named.

SEC. 20. The proceedings for an injunction, damages, and profits, and those for the seizure of infringing trade--marks, plates, molds, matrices, or other means for making such infringing marks may be united in one action.

SEC. 21. The District and Territorial Courts of the United States, the District Court of the Canal Zone, and the Supreme Court of the District of Columbia shall have original jurisdiction, and the circuit courts of appeal of the United States and the Court of Appeals of the District of Columbia shall have appellate jurisdiction of all actions, suits, and proceedings concerning registrations and registered trade--marks, trade names, and devices under this Act,

[33]
without regard to diversity or lack of diversity of the citizenship of the parties and irrespective of the amount in controversy, and the judgments of such appellate courts shall be final, except that they may be reviewed by the Supreme Court as provided by sections 239 and 240 (United States Code 346--347), respectively, of the Judicial Code.

SEC. 22. Any injunction which may be granted according to section 18 may be served anywhere in the United States, and shall be operative, and may be enforced by proceedings to punish for contempt, or otherwise, by the court by which such injunction was granted, or by any other Federal court having jurisdiction of the party enjoined. The clerk of the court or the judge granting the injunction shall, when requested to do so by the court before which application to enforce said injunction is made, transfer without delay to said court a certified copy of any necessary papers on which the said injunction was granted that are on file in his office.

SEC. 23. Subject to the same provisions as appear in section 2 hereof relating to trade--marks, so far as the same may be applicable, any person, firm, corporation, union, agricultural or other association, being the owner thereof, may register any trade name or device, including union

[34]
labels, collective marks, and the marks of associations, used in commerce upon or in relation to specific goods or specific service, in the same manner and with the same effect, and when registered they shall be entitled to the same protection and remedies against infringement as provided herein in the case of trade--marks used upon goods. Applications under this section shall comply as nearly as practicable with the requirements of section 1, and the same procedure shall be followed so far as applicable with respect to trade names and devices as is provided in the sections of this Act relating to trade--marks.

SEC. 24. Nothing in this Act shall prevent, lessen, impeach, or avoid any remedy at law or in equity which any party aggrieved by any wrongful use of any trade--mark might have had at common law; nor shall anything in this Act deprive a defendant in a suit upon any registered trade--mark or in any proceeding under this Act of any defenses against the validity of the trade--mark which he would have had if the trade--mark had not been registered.

SEC. 25. All applications for registration and all contested proceedings pending in the Patent Office at the time of the passage of this Act shall be proceeded with under the provisions of this Act.

SEC. 26. Any person who shall file application for or procure registration or entry of a trade--mark in the Patent

[35]
Office by a fraudulent declaration or representation, oral, written, or by any fraudulent means, shall be liable to pay any damages sustained in consequence thereof to the injured party, and such fraudulent declaration or representation shall constitute perjury.

SEC. 27. The commissioner may make rules and regulations, not inconsistent with law, concerning the registration of trade--marks, trade names and devices, the entry of marks under section 5 (a) hereof and practice in proceedings in the Patent Office. He may require of the applicant or entrant such information and in such form as he deems necessary. He may require nonregistrable matter to be disclaimed, but no such disclaimer shall affect any common law rights. He may establish a classification of merchandise, for convenience of Patent Office administration, but not to limit or extend the applicant's rights. The applicant may register his

trade--mark in one application for any or all goods included in one class upon which the mark has actually been used in commerce. The commissioner may establish a classification under section 23hereof.

SEC. 28. (a) Any merchandise, whatever may be its source or origin, which shall bear any registered trade--mark or any infringement thereof, shall not be imported into the United States or admitted to entry at any customhouse of the United States unless the written consent of the registrant

[36]
to such importation or entry be first had and obtained, or unless such offending mark be removed or obliterated; and if brought into the United States in violation of the provisions of this section, any person selling, offering for sale, or dealing in such merchandise shall be amenable, at the suit of the registrant, to the liabilities prescribed in section 18 hereof, and in addition be required to reexport or destroy such merchandise or to remove or obliterate such infringing trade--mark therefrom, and such merchandise shall be subject to seizure and forfeiture for violation of the customs laws. In order to aid the officers of the customs in enforcing this section the registrant may require a copy of the certificate of registration of his trade--mark to be recorded in books which shall be kept for this purpose in the Department of the Treasury, under such regulations as the Secretary of the Treasury shall prescribe, and thereupon the Secretary of the Treasury shall cause one or more copies of the same to be transmitted to each collector or other proper officer of customs.
(b) Any merchandise, whatever may be its source or origin, which shall bear the name or a simulation thereof of any domestic manufacture or manufacturer or trader, or of any manufacturer or trader located in any foreign country which by treaty, convention, or law affords similar privileges to citizens of the United States, shall not be imported

[37]
into the United States or admitted to entry at any customhouse of the United States unless the written consent of such manufacturer or trader to such importation or entry be first had and obtained, or unless such offending name be removed or obliterated, and if brought into the United States in violation of the provisions of this section, any person selling, offering for sale, or dealing in such merchandise may be enjoined from dealing therein and in addition be required to export or destroy such merchandise or to remove or obliterate such name therefrom, and the merchandise shall be subject to seizure and forfeiture for violation of the customs laws. In order to aid the officers of the customs in enforcing this section, any such domestic or foreign manufacturer or trader may require as statement of his business or commercial name and the locality where his business is located and where his goods are manufactured to be recorded in books which shall be kept for this purpose in the Department of the Treasury under such regulations as the Secretary of the Treasury shall prescribe, and thereupon the Secretary of the Treasury shall cause one or more copies of such record to be transmitted to each collector or other proper officer of customs.
(c) The owner, importer, or consignee of merchandise refused entry or seized under paragraphs (a) and
(b) of this section may have relief against the registrant, manu-

[38]
facturer, or trader by a bill in equity or by a summary proceeding on petition in any court of original jurisdiction named in section 21, in the district where such merchandise is held, or where such registrant, manufacturer, or trader or a designated representative under section 8 is an inhabitant or may be found, and after such notice and upon such proceedings as the court may direct, the court may determine whether the plaintiff or petitioner for any reason has the right to import such merchandise under the names or marks which it bears.
(d) A decree or order of such court for the plaintiff or petitioner, upon being certified to the collector of the port where the merchandise is held, shall be warrant to such collector to release the merchandise from arrest or seizure or forfeiture under this section.
(e) Such order or decree, whether interlocutory or final, shall be appealable, and the court making such order or decree may, in its discretion, suspend the operation thereof pending appeal.

SEC. 29. Any person who shall affix, apply, or annex, or use in connection with any article or articles of merchandise, or any container or containers of the same, a false designation of origin, or any false description or representation including words or other symbols, tending falsely to identify the origin of the merchandise, or falsely to describe

[39]
or represent the same, and shall cause such merchandise to enter into commerce, and any person who shall knowingly cause or procure the same to be transported in commerce, or shall knowingly deliver the same to any carrier to be so transported, shall be liable to an action at law for damages and to a suit in equity for an injunction, at the suit of any person doing business in the locality falsely indicated as that of origin, or in the
region in which said locality is situated, or of any person who is or is likely to be damaged by the use of any false description or representation, or at the suit of any association of such persons, and any article marked or labeled in contravention of the provisions of this section shall not be imported into the United States or admitted to entry at any customhouse of the United States. The owner, importer, or consignee of merchandise refused entry in any customhouse under this section may have any recourse by protest or appeal that is given under the customs revenue laws, or may have the remedy given by paragraphs (c), (d), and (e) of section 28.

SEC. 30. In the construction of this Act, unless otherwise plainly apparent from the context, the United States includes and embraces all territory which is under the jurisdiction and control of the United States. The word "States" includes and embraces the District of Columbia, the Territories of the United States, and such other territory as

[40]
shall be under the jurisdiction and control of the United States. The word "commerce" means all commerce within the control of Congress. The terms "person" and "owner" and any other word or term used to designate the applicant or other entitled to a benefit or privilege or rendered liable under the provisions of this Act, include a firm, corporation, or association, or any legal representative or entity capable of possessing and transferring title, as well as a natural person. The terms "applicant" and "registrant" embrace the legal representatives, successors, and assigns of such applicant or registrant. The term "commissioner" means the Commissioner of Patents. The term "trade--mark" includes any mark so used as to distinguish the source or origin of the

users' goods, and a trade--mark shall be deemed to be applied to an article when it is placed in any manner in or upon either the article itself or the receptacle or package or upon the envelope or other thing in, by, or with which the goods are packed or inclosed or otherwise prepared for sale or distribution. The term "registered" means registered under this Act or under any of the prior Acts named in the following section so long as such registration shall remain in force but has no application to marks entered under section 5. Words used in the singular include the plural, and vice versa. Except as otherwise expressly provided, this Act is

[41]
declaratory of the common law of trade--marks, trade names, and devices and applies such law, so far as concerns registered trade--marks, trade names, and devices, to commerce within the control of Congress, and in case of doubt its provisions are to be construed accordingly.
SEC. 31. This Act shall be in force and take effect sixty days after its passage. All Acts and parts of Acts inconsistent herewith are hereby repealed, including the following, namely: The Act of Congress, approved March 3, 1881, entitled "An Act to authorize the registration of trade--marks and protect the same," the Act approved August 5, 1882, entitled "An Act relating to the registration of trade--marks," the Act of February20, 1905 (United States Code, title 15, section 81 to 109, inclusive), as amended, entitled "An Act to authorize the registration of trade--marks used in commerce with foreign nations, or among the several States, with Indian tribes, and to protect the same," the Act of March 19, 1920 (United States Code, title 15, sections 121 to 128, inclusive), entitled "An Act to give effect to certain provisions of the convention for the protection of trade--marks and commercial names, made and signed in the city of Buenos Aires, in the Argentine Republic, August 20, 1910, and for other purposes," and section 526 of the "Tariff Act of 1922" (United States Code, title 19, sections 141 to 143, inclusive), except that

[42]
this repeal shall not affect the validity of registrations under said Acts, respectively, or rights or remedies thereunder for infringements committed before this Act shall take effect. Registrations under the Act of March 19, 1920, shall expire in twenty years from the date of registration, and such registrations shall not be used to stop importations under section 28 of this Act. Sections 13 and 14 of this Act (except paragraph (a) of section 13) shall apply to registrations under the Act of March 19, 1920.

SEC. 32. Section 4 of the Act of January 5, 1905 (United States Code, title 36, section 4), as amended, entitled "An Act to incorporate the National Red Cross," and section 7 of the Act of June 15, 1916 (United States Code, title 36, section 27), entitled "An Act to incorporate the Boy Scouts of America, and for other purposes," are not repealed or affected by this Act.

SEC. 33. There is hereby authorized to be appropriated, out of any money in the Treasury not otherwise appropriated, for clerical service, office equipment, stationery, and supplies for carrying into effect this Act for the fiscal year ending June 30, 1929, $50,000, and thereafter such sums as Congress may deem necessary, to be expended by the Commissioner of Patents.

SEC. 34. This Act may be cited as the "Trade--Mark Act, 1928."