§ H.R. 4333

Be it enacted by the Senate and House of Representatives of the United States of America in Congress assembled. That paragraph (1) of subsection (a) of section 1 of 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 (60 Stat. 427), as amended, is amended by striking the words "as might be calculated to deceive" and inserting in lieu thereof "as to

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be likely, when applied to the goods of such other person, to cause confusion, or to cause mistake, or to deceive": and by striking the words "or services" from the proviso thereof.

SEC. 2. Subsection (d) of section 2 is amended by striking the language beginning with the word "confusion", first appearance, and ending with the word "herewith" at the end of said subsection and inserting in lieu thereof the following: "confusion, or to cause mistake, or to deceives Provided. That when the Commissioner determines that confusion, mistake, or deception is not likely to result from the continued use by more than one person of the same or similar marks under conditions and limitations as to the mode or place of use of the marks or the goods in connection with which such marks are used, concurrent registrations maybe issued to such persons when they have become entitled to use such marks as a result of their concurrent lawful use in commerce prior to (i) the earliest of the filing dates of the applications pending under this Act; or (ii) the date of a registration issued under this Act; or (iii) July 5, 1947, in the case of registrations previously issued under the Act of March 3, 1881, or February 20, 1905, and continuing in full force and effect on that date; or (iv) July 5, 1947, in the case of applications filed under the Act of February 20, 1905,and registered after July 5, 1947. Concurrent registrations may also be issued by the

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Commissioner when a court of competent jurisdiction has finally determined that more than one person is entitled to use the same or similar marks in commerce. In issuing concurrent registrations, the Commissioner shall prescribe conditions and limitations as to the mode or place of use of the mark or the goods in connection with which such mark is registered to the respective persons."

SEC. 3. Section 6 is amended by striking the entire section and inserting in lieu thereof the following:
SEC. 6. (a) The Commissioner may require the applicant to disclaim an unregistrable component of a mark otherwise registrable. An applicant may voluntarily disclaim a component of a mark sought to be registered.
"(b) No disclaimer heretofore or hereafter made, or made under paragraph (d) of section 7 of this Act, shall prejudice or affect the applicant's or registrant's rights then existing or thereafter arising in the disclaimed matter, or his right of registration on another application if the disclaimed matter be or shall have become distinctive of his goods or services."

SEC. 4. The first sentence of subsection (a) of section 7 is amended by striking therefrom the word "either": by striking the words "name printed" and inserting in lieu thereof the words "signature placed"; by striking the words "and attested by an assistant commissioner or by one of the

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law examiners duly designated by the Commissioner," and by striking the words "and a record thereof, together with printed copies of the drawing and statement of the applicant, shall be kept in books for that purpose" and inserting in lieu thereof the words", and a record thereof shall be kept in the Patent Office." The second sentence of subsection (a) of section 7 is amended by striking therefrom the word "certificate" and inserting the word "registration" in lieu thereof: by striking therefrom the words "the drawing of": and by striking the words "the grant of".
Subsection (d) of section 7 is amended by striking the entire subsection and inserting in lieu thereof the following: "Upon application of the registrant the Commissioner may permit any registration to be surrendered for cancellation, and upon cancellation appropriate entry shall be made in the records of the Patent Office. Upon application of the registrant and payment of the prescribed fee, the Commissioner for good cause may permit any registration to be amended or to be disclaimed in part: Provided. That the amendment or disclaimer does not alter materially the character of the mark. Appropriate entry shall be made in the records of the Patent Office and upon the certificate of registration or, if said certificate is lost or destroyed, upon a certified copy thereof."
Subsection (e) of section 7 is amended by striking the

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words "certificates of"; by adding an "s" to the word "registration"; and striking the words "a chief of division" and inserting in lieu thereof "an employee of the Office".
Subsection (f) of section 7 is amended by striking from the first sentence the words", signed by the Commissioner and sealed with the seal of the Patent Office"; by striking the word "certificate", second occurrence: and by striking the word "certificate", third occurrence, and inserting the word "registration" in lieu thereof.

SEC. 5. Section 9 is amended by striking the entire section and inserting in lieu thereof the following:
"SEC. 9. (a) Each registration may be renewed for periods of twenty years from the end of the expiring period upon payment of the prescribed fee and the filling 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 attaching 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 provided.

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"(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 (d) hereof."

SEC. 6. Section 10 is amended by changing the colon following the word "conducted" to a period and striking the words "Provided. That any assigned registration may be canceled at any time if the registered mark is being used by, or with the permission of, the assignee so as to misrepresent the source of the goods or services in connection with which the mark is used"; and striking the sentence "The Commissioner shall keep a separate record of such assignments submitted to him for recording." and inserting in lieu thereof "A separate record of assignments submitted for recording hereunder shall be maintained in the Patent Office."

SEC. 7. Subsection (a) of section 12 is amended by changing the period at the end thereof to a colon and inserting after the colon the following: "Provided. That in the case of an applicant claiming concurrent use, or in the case of an application to be placed in an interference as provided for in section 16 of this Act, the mark, if otherwise registrable, may be published subject to the determination of the rights of the parties to such proceedings."

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Subsection (c) of section 12 is amended by striking therefrom the first word of the last sentence and inserting in lieu thereof the words "Marks published under this".

SEC. 8. Section 13 is amended by striking the words "notice of" each occurrence, and by adding at the end thereof the following sentence: "An opposition may be amended under such conditions as may be prescribed by the Commissioner."

SEC. 9. Section 14 is amended by striking said section in its entirety and inserting in lieu thereof the following:
"SEC. 14. A verified petition to cancel a registration of a mark, stating the grounds relied upon, may, upon payment of the prescribed fee, be filed 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--
"(a) within five years from the date of the registration of the mark under this Act; or
"(b) 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; or
"(c) at any time if the registered mark becomes the common descriptive name of an article or substance, or has been abandoned, or its registration was obtained

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fraudulently or contrary to the provisions of section 4 or of subsections (a), (b), or (c) of section 2 of this Act for a registration hereunder, or contrary to similar prohibitory provisions of said prior Acts for a registration hereunder, 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 in connection with which the mark is used; or,
"(d) at any time if the mark is registered under the Act of March 3, 1881, or the Act of February 20, 1905,and has not been published under the provisions of subsection (c) of section 12 of this Act; or

"(e) at any time in the case of a certification mark on the ground that the registrant (1) does not control, or is not able legitimately to exercise control over, the use of such mark, or (2) engages in the production or marketing of any goods or services to which the certification mark is applied, or (3) permits the use of the certification mark for purposes other than to certify, or (4) discriminately refuses to certify or to continue to certify the goods or services of any person who maintains the standards or conditions which such mark certifies:
"Provided, That the Federal Trade Commission may apply to cancel on the grounds specified in subsections
(c) and (e)

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of this section any mark registered on the principal register established by this Act, and the prescribed fee shall not be required."

SEC. 10. Section 15 is amended by striking "(c) and (d)" in the first paragraph and inserting in lieu thereof the following: "(c) and (e)".
Section 15 is amended by striking "or trade name " from paragraph numbered (4).

SEC. 11. Section 16 is amended by striking therefrom the word "purchasers".

SEC. 12. Section 21 is amended by striking the entire section, and inserting in lieu thereof the following:

SEC. 21. (a) (1) An applicant for registration of a mark, party to an interference proceeding, party to an opposition proceeding, party to an application to register as a lawful concurrent user, party to a cancellation proceeding, a registrant who has filed an affidavit as provided in section 8, or an applicant for renewal, who is dissatisfied with the decision of the Commissioner or Trademark Trial and Appeal Board, may appeal to the United States Court of Customs and Patent Appeals thereby waiving his right to proceed under section 21(b)hereof: Provided, That such appeal shall be dismissed if any adverse party to the proceeding, other than the Commissioner, shall, within twenty

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days after the appellant has filed notice of appeal according to section 21 (a) (2) hereof, files notice with the Commissioner that he elects to have all further proceedings conducted as provided in section 21(b) hereof. Thereupon the appellant shall have thirty days thereafter within which to file a civil action under said section21 (b), in default of which the decision appealed from shall govern the further proceedings in the case.
"(2) When an appeal is taken to the United States Court of Customs and Patent Appeals, the appellant shall give notice thereof to the Commissioner, and shall file in the Patent Office his reasons of appeal, specifically set forth in writing, within such time after the date of the decision appealed from, not less than sixty days, as the Commissioner appoints.
"(3) The court shall, before hearing such appeal, give notice of the time and place of the hearing to the Commissioner and the parties thereto. The Commissioner shall transmit to the court certified copies of all the necessary original papers and evidence in the case specified by the appellant and any additional papers and evidence specified by the appellee, and in an ex parte

case the Commissioner shall furnish the court with the grounds of the decision of the Patent Office, in writing, touching all the points involved by the reasons of appeal.

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"(4) The court shall hear and determine such appeal on the evidence produced before the Patent Office, and the decision shall be confined to the points set forth in the reasons of appeal. Upon its determination, the court shall return to the Commissioner a certificate of its proceedings and decision, which shall be entered of record in the Patent Office and govern the further proceedings in the case.
"(b) (1) Whenever a person authorized by section 21 (a) hereof to appeal to the United States Court of Customs and Patent Appeals is dissatisfied with the decision of the Commissioner or Trademark Trial and Appeal Board, said person may, unless appeal has been taken to said Court of Customs and Patent Appeals, have remedy by a civil action if commenced within such time after such decision, not less than sixty days, as the Commissioner appoints or as provided in section 21 (a). The court may adjudge that an applicant is entitled to a registration upon the application involved, that a registration involved should be canceled, or such other matters as the issues in the proceeding require, as the facts in the case may appear. Such adjudication shall authorize the Commissioner to take any necessary action, upon compliance with the requirements of law.
"(2) The Commissioner shall not be made a party to an inter partes proceeding under this subsection, but he shall be notified of the filing of the complaint by the clerk of

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the court in which it is filed and shall have the right to intervene in the action.
"(3) In all cases where there is no adverse party, a copy of the complaint shall be served on the Commissioner, and all the expenses of the proceedings shall be paid by the party bringing them, whether the final decision is in his favor or not. In suits brought hereunder, the record in the Patent Office shall be admitted on motion of any party, upon such terms and conditions as to costs, expenses, and the further cross--examination of the witnesses as the court imposes, without prejudice to the right of any party to take further testimony. The testimony and exhibits of the record in the Patent Office, when admitted, shall have the same effect as if originally taken and produced in the suit.
"(4) Where there is an adverse party, such suit may be instituted against the party in interest as shown by the records of the Patent Office at the time of the decision complained of, but any party in interest may become a party to the action. If there be adverse parties residing in a plurality of districts not embraced within the same State, or an adverse party residing in a foreign country, the United States District Court for the District of Columbia shall have jurisdiction and may issue summons against the adverse parties directed to the marshal of any district in which any adverse party resides. Summons against adverse parties

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residing in foreign countries may be served by publication or otherwise as the court directs."

SEC. 13. Section 23 is amended by striking from the last paragraph thereof the words "has begun the lawful use of his mark in foreign commerce and that he."

SEC. 14. Section 24 is amended by inserting in the second sentence thereof, following the word "time", the following:", upon payment of the prescribed fee and the filing of a verified petition stating the ground therefor,"; and by inserting in the third sentence following the word "Board" the word "which".

SEC. 15. Section 29 is amended by deleting the following: "under the Act of March 3, 1881, or the Act of February 20, 1905, or on the principal register established by this Act, shall" and inserting in lieu thereof the following: "In the Patent Office, may"; and by deleting "so to mark goods bearing the registered mark, or by a registrant under the Act of March 19, 1920, or by the registrant of a mark on the supplemental register provided by this Act" and inserting in lieu thereof "to give such notice of registration."

SEC. 16. Section 30 is amended by striking the word "shall" in the first sentence and inserting in lieu thereof the word "may"; and by striking therefrom all of said section except the first sentence thereof and inserting in lieu thereof the following: "The applicant may file an application to

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register a mark for any or all of the goods and services upon or in connection with which he is actually using the mark: "Provided, That when such goods or services fall within a plurality of classes, a fee equaling the sum of the fees for filing an application in each case shall be paid, and the Commissioner may issue a single certificate of registration for such mark."

SEC. 17. Subsection (1) of section 32 is amended by striking the entire subsection and inserting in lieu thereof the following:
"any person who shall, without the consent of the registrant--
"(a) use in commerce any reproduction, counterfeit, copy, or colorable imitation of a registered mark in connection with the sale, offering for sale, distribution, or advertising of any goods or services on or in connection with which such use is likely to cause confusion, or to cause mistake, or to deceive; or
"(b) reproduce, counterfeit, copy, or colorably imitate a registered mark and apply such reproduction, counterfeit, copy, or colorable imitation to labels, signs, prints, packages, wrappers, receptacles or advertisements intended to be used in commerce upon or in connection with the sale, offering for sale, distribution, or

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advertising of goods or services on or in connection with which such use is likely to cause confusion, or to cause mistake, or to deceive.
shall be liable in a civil action by the registrant for the remedies hereinafter provided. Under subsection (b)hereof, the registrant shall not be entitled to recover profits or damages unless the acts have been committed with knowledge that such imitation is intended to be used to cause confusion, or to cause mistake, or to deceive."
Paragraph (b) of subsection (2) of section 32 is amended by striking the word "published" and inserting in lieu thereof the word "publisher".

SEC. 18. Subsection (a) of section 33 is amended by striking therefrom the words "certificate of" in the first line, and changing "certificate", second appearance, to registration".
Subsection (b) of section 33 is amended by striking the word "certificate", first appearance, and inserting the word "registration" in lieu thereof and by striking therefrom the word "certificate", second appearance, and inserting in lieu thereof "affidavit filed under the provisions of said section 15".
Paragraph (3) of subsection (b) of section 33 is amended by striking therefrom the words "has been assigned

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and"; and by striking therefrom the word "assignee" and inserting in lieu thereof the words "registrant or a person in privity with the registrant'.
Paragraph (5) of subsection (b) of section 33 is amended by striking therefrom the word "the" following the words "date prior to" and inserting in lieu thereof the words "registration of the mark under this Act or"; by striking therefrom "(a) or" following the word "subsection"; and by changing the period to "or"
Paragraph (6) of subsection (b) of section 33 is amended by inserting the words "registration under this Actor" after the word "the", second appearance; by striking therefrom "(a) or" following the word "subsection", first appearance; by striking from the proviso the words "only where the said mark has been published pursuant to subsection (c) of section 12 and shall apply"; by striking the words "the date of" following the words "prior to" in said proviso and inserting in lieu thereof "such registration or such"; by striking therefrom the words "under subsection (a) or (c) of section 12 of this Act"; and by changing the period to "; or".

SEC. 19. Section 35 is amended by striking "31(1) (b)" and inserting in lieu thereof "32".SEC. 20. Subsection (b) of section 44 is amended by

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striking said subsection in its entirety and inserting in lieu thereof the following:
"(b) Any person whose country of origin is a party to any convention or treaty relating to trademarks, trade or commercial names, or the repression of unfair competition, to which the United States is also a party, or extends reciprocal rights to nationals of the United States by law, shall be entitled to the benefits of this section under the conditions expressed herein to the extent necessary to give effect to any provision of such convention, treaty or reciprocal law, in addition to the rights to which any owner of a mark is otherwise entitled by this Act."
Subsection (c) of section 44 is amended by inserting after the word "a" in the second sentence the words "certification or a"; and by striking from said second sentence the words "application for or".

SEC. 21. Section 45 is amended as follows: The sixth paragraph of said section, relating to the definition of "applicant, registrant", is amended by changing "and", second appearance, to "predecessors,".
The ninth paragraph of said section, relating to the meaning of the terms "trade name" and "commercial name", is amended by inserting a comma between the words "commercial" and "agricultural".

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The eleventh paragraph of said section, being the definition of "service mark", is amended by striking the definition in its entirety and inserting in lieu thereof:
"The term 'service mark' means a mark used in the sale or advertising of services to identify the services of one person and distinguished them from the services of others. Titles, character names and other distinctive features of radio or television programs may be registered as service marks notwithstanding that they, or the programs, may advertise the goods of the sponsor."
The fifteenth paragraph of said section, relating to use in commerce, is amended by changing the period at the end of said paragraph to a comma and adding the words "or the services are rendered in more than one State or in this and a foreign country and the person rendering the services is engaged in commerce in connection therewith."
The seventeenth paragraph of said section, relating to the meaning of the term "colorable imitation", is amended by changing "terms" to "term" and deleting the word "purchasers" at the end thereof.
The final paragraph of said section is amended by striking therefrom the word "commence" and inserting in lieu thereof the word "commerce".