

109TH CONGRESS
2D SESSION

H. R.

To enact certain laws relating to trademarks and other intellectual property as subtitles III and IV of title 35, United States Code, and to redesignate that title as “Patents, Trademarks, and Other Intellectual Property”.

IN THE HOUSE OF REPRESENTATIVES

, 2006

Mr. SENSENBRENNER (for himself and Mr. CONYERS) introduced the following bill; which was referred to the Committee on the Judiciary

A BILL

To enact certain laws relating to trademarks and other intellectual property as subtitles III and IV of title 35, United States Code, and to redesignate that title as “Patents, Trademarks, and Other Intellectual Property”.

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

3 **SECTION 1. TABLE OF CONTENTS.**

4 The table of contents for this Act is as follows:

- Sec. 1. Table of contents.
- Sec. 2. Purpose; conformity with original intent.
- Sec. 3. Title heading and analysis.
- Sec. 4. Subtitle I of title 35, United States Code.
- Sec. 5. Subtitle II of title 35, United States Code.
- Sec. 6. Enactment of subtitles III and IV of title 35, United States Code.
- Sec. 7. Conforming cross-references.
- Sec. 8. Transitional and savings provisions.
- Sec. 9. Repeals.

5 **SEC. 2. PURPOSE; CONFORMITY WITH ORIGINAL INTENT.**

6 (a) PURPOSE.—The purpose of this Act is to enact certain laws relating
7 to trademarks and other intellectual property as subtitles III and IV of title

1 35, United States Code, and to redesignate title 35 as “Patents, Trade-
2 marks, and Other Intellectual Property”.

3 (b) CONFORMITY WITH ORIGINAL INTENT.—In the codification of laws
4 by this Act, the intent is to conform to the understood policy, intent, and
5 purpose of Congress in the original enactments, with such amendments and
6 corrections as will remove ambiguities, contradictions, and other imperfec-
7 tions, in accordance with section 205(c)(1) of House Resolution No. 988,
8 93d Congress, as enacted into law by Public Law 93–554 (2 U.S.C.
9 285b(1)).

10 **SEC. 3. TITLE HEADING AND ANALYSIS.**

11 Title 35, United States Code, is amended by striking the title heading
12 and analysis and inserting the following:

13 **“TITLE 35—PATENTS, TRADEMARKS,
14 AND OTHER INTELLECTUAL PROPERTY**

“Subtitle	Sec.
“I. UNITED STATES PATENT AND TRADEMARK OFFICE	1
“II. PATENTS	100
“III. TRADEMARKS	501
“IV. OTHER INTELLECTUAL PROPERTY PROVISIONS	901”.

15 **SEC. 4. SUBTITLE I OF TITLE 35, UNITED STATES CODE.**

16 Title 35, United States Code, is amended by striking the part heading
17 for part I and inserting the following:

18 **“Subtitle I—United States Patent and Trademark
19 Office”.**

20 **SEC. 5. SUBTITLE II OF TITLE 35, UNITED STATES CODE.**

21 (a) PART A.—Title 35, United States Code, is amended by striking the
22 part heading and analysis for part II and inserting the following:

23 **“Subtitle II—Patents**

24 “PART A—PATENTABILITY OF INVENTIONS AND GRANT OF PATENTS

“Chap.	Sec.
“10. Patentability of Inventions	100
“11. Application for Patent	111
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“15. Plant Patents	161
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“25. Amendment and Correction of Patents	251
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1 “PART C—PATENT COOPERATION TREATY

2 **“35. Definitions 351**

3 **“36. International Stage 361**

4 **“37. National Stage 371**

2 “PART A—PATENTABILITY OF INVENTIONS AND GRANT OF
3 PATENTS”.

4 (b) PART B.—Title 35, United States Code, is amended by striking the
5 part heading and analysis for part III and inserting the following:

6 “PART B—PATENTS AND PROTECTION OF PATENT RIGHTS”.

7 (c) PART C.—Title 35, United States Code, is amended by striking the
8 heading for part IV and inserting the following:

9 “PART C—PATENT COOPERATION TREATY”.

10 **SEC. 6. ENACTMENT OF SUBTITLES III AND IV OF TITLE 35, UNITED**
11 **STATES CODE.**

12 Title 35, United States Code, is amended by adding at the end the follow-
13 ing:

14 **“Subtitle III—Trademarks**

15 “PART A—GENERAL PROVISIONS

“Chap. Sec.

16 **“51. General Provisions 501**

17 “PART B—DOMESTIC REGISTRATION

“61. Principal Register 601

“62. Supplemental Register 631

“63. Practice, Procedure, and Prohibitions 651

18 “PART C—INTERNATIONAL REGISTRATION

19 **“81. International Register 801**

20 “PART A—GENERAL PROVISIONS

21 **“CHAPTER 51—GENERAL PROVISIONS**

- 22 “Sec.
- 23 “501. Definitions.
- 24 “502. Purposes of subtitle.
- 25 “503. Applicability to the United States and to States.

26 **“§ 501. Definitions**

27 “In this subtitle:

28 “(1) ABANDON.—

29 “(A) IN GENERAL.—The term ‘abandon’, with reference to
30 abandonment of a mark by the owner of the mark, means to—

31 “(i) discontinue use of the mark with intent (which may be
inferred from circumstances) not to resume the use; or

“(ii) engage in a course of conduct (including acts of com-
mission and acts of omission) that causes the mark—

“(I) to become the generic name for the good or serv-
ice on or in connection with which the mark is used; or

“(II) otherwise to lose its significance as a mark.

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1 “(B) PRIMA FACIE EVIDENCE.—For purposes of subparagraph
2 (A)(i), nonuse of a mark for 3 consecutive years is prima facie evi-
3 dence of abandonment of the mark.

4 “(C) TEST.—For purposes of subparagraph (A)(ii), purchaser
5 motivation is not a test for determining abandonment.

6 “(2) APPLICANT.—The term ‘applicant’ includes the legal represent-
7 atives, predecessors, and successors and assigns of an applicant.

8 “(3) CERTIFICATION MARK.—The term ‘certification mark’ means a
9 word, name, symbol, or device (or combination thereof) that is used by
10 a person other than its owner, or for which the owner files an applica-
11 tion to register on the principal register with a bona fide intention to
12 permit a person other than the owner to use in commerce, to certify—

13 “(A) regional or other origin, material, mode of manufacture,
14 quality, accuracy, or other characteristics of the good or service of
15 the person; or

16 “(B) that the work or labor on the good or service was per-
17 formed by members of a labor organization or other organization.

18 “(4) COLLECTIVE MARK.—

19 “(A) IN GENERAL.—The term ‘collective mark’ means a trade-
20 mark or service mark—

21 “(i) that is used by the members of a cooperative, an asso-
22 ciation, or other collective group or organization; or

23 “(ii) for which a cooperative, association, or other collective
24 group or organization files an application to register on the
25 principal register with a bona fide intention to use the mark
26 in commerce.

27 “(B) INCLUSION.—The term ‘collective mark’ includes a mark
28 indicating membership in a labor organization, an association, or
29 other organization.

30 “(5) COLORABLE IMITATION.—The term ‘colorable imitation’, with
31 reference to an imitation of a registered mark, includes an imitation
32 that so resembles the registered mark as to be likely to cause confu-
33 sion, cause mistake, or deceive.

34 “(6) COMMERCE.—The term ‘commerce’ means all commerce that
35 may lawfully be regulated by Congress.

36 “(7) COUNTERFEIT.—The term ‘counterfeit’, with reference to a
37 counterfeit of a registered mark, means a spurious mark that is iden-
38 tical to, or substantially indistinguishable from, the registered mark.

39 “(8) DILUTION.—The term ‘dilution’ means the lessening of the ca-
40 pacity of a famous mark to identify and distinguish a good or service,
41 regardless of the presence or absence of—

1 “(A) competition between the owner of the famous mark and
2 other persons; or

3 “(B) the likelihood of confusion, mistake, or deception.

4 “(9) DOMAIN NAME.—The term ‘domain name’ means an alpha-
5 numeric designation that is registered with or assigned by a domain
6 name registrar as part of an electronic address on the internet.

7 “(10) DOMAIN NAME REGISTRAR.—The term ‘domain name reg-
8 istrar’ means a domain name registrar, registry, or other registration
9 authority.

10 “(11) INFRINGE.—For purposes of sections 654 and 655 of this
11 title, the term ‘infringe’, with reference to infringement of a registered
12 mark, means, without the consent of the registrant of the registered
13 mark, to—

14 “(A) use in commerce a reproduction, counterfeit, copy, or
15 colorable imitation of the registered mark in connection with the
16 sale, offering for sale, distribution, or advertising of a good or
17 service on or in connection with which the use is likely to cause
18 confusion, cause mistake, or deceive; or

19 “(B)(i) reproduce, counterfeit, copy, or colorably imitate the
20 registered mark; and

21 “(ii) apply the reproduction, counterfeit, copy, or colorable imi-
22 tation to a label, sign, print, package, wrapper, receptacle, or ad-
23 vertisement intended to be used in commerce on or in connection
24 with the sale, offering for sale, distribution, or advertising of a
25 good or service on or in connection with which the use is likely
26 to cause confusion, cause mistake, or deceive.

27 “(12) INTERNET.—The term ‘internet’ has the meaning given the
28 term ‘Internet’ in section 230(f) of the Communications Act of 1934
29 (47 U.S.C. 230(f)).

30 “(13) MARK.—The term ‘mark’ includes a trademark, service mark,
31 collective mark, or certification mark.

32 “(14) NOTICE OF ALLOWANCE.—The term ‘notice of allowance’
33 means a notice of allowance issued under section 613(b)(2) of this title.

34 “(15) OFFICIAL GAZETTE.—The term ‘Official Gazette’ means the
35 Official Gazette of the United States Patent and Trademark Office
36 published by the Office.

37 “(16) PERSON.—The term ‘person’ includes—

38 “(A) the United States, an agency or instrumentality of the
39 United States, and an individual, firm, or corporation acting for
40 the United States and with the authorization and consent of the
41 United States; and

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1 “(B) a State, an instrumentality of a State, and an officer or
2 employee of a State or instrumentality of a State acting in the of-
3 ficial capacity of the officer or employee.

4 “(17) PRINCIPAL REGISTER.—The term ‘principal register’ means
5 the register provided under chapter 61.

6 “(18) REGISTERED MARK.—The term ‘registered mark’ means a
7 mark registered in the Office under—

8 “(A) this subtitle;

9 “(B) the Act of March 3, 1881 (ch. 138, 21 Stat. 502);

10 “(C) the Act of February 20, 1905 (ch. 592, 33 Stat. 724); or

11 “(D) the Act of March 19, 1920 (ch. 104, 41 Stat. 533).

12 “(19) REGISTRANT.—The term ‘registrant’ includes the legal rep-
13 resentatives, predecessors, and successors and assigns of a registrant.

14 “(20) RELATED COMPANY.—The term ‘related company’ means a
15 person whose use of a mark is controlled by the owner of the mark
16 with respect to the nature and quality of a good or service on or in
17 connection with which the mark is used.

18 “(21) SERVICE MARK.—

19 “(A) IN GENERAL.—The term ‘service mark’ means a word,
20 name, symbol, or device (or combination thereof) that is used by
21 a person, or for which a person files an application to register on
22 the principal register with a bona fide intention to use the mark
23 in commerce, to—

24 “(i) identify and distinguish a service (including a unique
25 service) of one person from the services of others; and

26 “(ii) indicate the source of the service, even if the source
27 is unknown.

28 “(B) INCLUSIONS.—The term ‘service mark’ includes a title,
29 character name, or other distinctive feature of a radio or television
30 program without regard to whether the feature or program adver-
31 tises the goods of the sponsor of the program.

32 “(22) SUPPLEMENTAL REGISTER.—The term ‘supplemental register’
33 means the register provided under chapter 62.

34 “(23) TRADE NAME.—

35 “(A) IN GENERAL.—The term ‘trade name’ means a name used
36 by a person to identify the business or vocation of the person.

37 “(B) INCLUSION.—The term ‘trade name’ includes a commer-
38 cial name.

39 “(24) TRADEMARK.—The term ‘trademark’ includes a word, name,
40 symbol, or device (or combination thereof) that is used by a person,

1 or for which a person files an application to register on the principal
2 register with a bona fide intention to use the mark in commerce, to—

3 “(A) identify and distinguish a good (including a unique prod-
4 uct) of the person from a good manufactured or sold by another
5 person; and

6 “(B) indicate the source of the good, even if the source is un-
7 known.

8 “(25) UNITED STATES.—The term ‘United States’ includes all terri-
9 tory that is under the jurisdiction and control of the United States.

10 “(26) USE IN COMMERCE.—

11 “(A) IN GENERAL.—The term ‘use in commerce’ means the
12 bona fide use of a mark in the ordinary course of trade and not
13 merely to reserve a right in the mark.

14 “(B) WHEN MARK IN USE IN COMMERCE.—A mark is consid-
15 ered to be in use in commerce when—

16 “(i) in the case of a good—

17 “(I)(aa) the mark is placed in any manner on the
18 good, containers of the good, displays associated with the
19 good or its containers, or tags or labels affixed to the
20 good or its containers; or

21 “(bb) if the nature of the good makes such placement
22 impracticable, the mark is placed on documents associ-
23 ated with the good or with sales of the good; and

24 “(II) the good is sold or transported in commerce; and

25 “(ii) in the case of a service—

26 “(I)(aa) the mark is used or displayed in the sale or
27 advertising of the service; and

28 “(bb) the service is rendered in commerce; or

29 “(II)(aa) the service is rendered in more than one
30 State, or in the United States and a foreign country; and

31 “(bb) the person rendering the service is engaged in
32 commerce in connection with the service.

33 **“§ 502. Purposes of subtitle**

34 “The purposes of this subtitle are—

35 “(1) to regulate commerce by making actionable the deceptive and
36 misleading use of marks in that commerce;

37 “(2) to protect registered marks used in that commerce from inter-
38 ference by State or territorial legislation;

39 “(3) to protect persons engaged in that commerce against unfair
40 competition;

1 “(4) to prevent fraud and deception in that commerce by the use of
2 reproductions, copies, counterfeits, or colorable imitations of registered
3 marks; and

4 “(5) to provide rights and remedies stipulated by treaties and con-
5 ventions respecting trademarks, trade names, and unfair competition
6 entered into between the United States and foreign countries.

7 **“§ 503. Applicability to the United States and to States**

8 “(a) UNITED STATES.—

9 “(1) IN GENERAL.—The United States, an agency or instrumentality
10 of the United States, and an individual, firm, or corporation acting for
11 the United States and with the authorization and consent of the United
12 States shall be subject to this subtitle in the same manner and to the
13 same extent as a nongovernmental entity.

14 “(2) WAIVER OF SOVEREIGN IMMUNITY.—The United States, all
15 agencies and instrumentalities of the United States, and all individuals,
16 firms, corporations, and other persons acting for the United States and
17 with the authorization and consent of the United States are not im-
18 mune from a suit in Federal or State court by a person (including a
19 governmental or nongovernmental entity) for a violation under this sub-
20 title.

21 “(b) STATES.—

22 “(1) IN GENERAL.—A State, an instrumentality of a State, and an
23 officer or employee of a State or instrumentality of a State acting in
24 the official capacity of the officer or employee shall be subject to this
25 subtitle in the same manner and to the same extent as a nongovern-
26 mental entity.

27 “(2) WAIVER OF SOVEREIGN IMMUNITY.—A State, instrumentality of
28 a State, or officer or employee of a State or instrumentality of a State
29 acting in an official capacity is not immune, under the 11th amend-
30 ment to the Constitution or under any other doctrine of sovereign im-
31 munity, from a suit in Federal court by a person (including a govern-
32 mental or nongovernmental entity) for a violation under this subtitle.

33 “(c) AVAILABLE REMEDIES.—In a civil action against a person described
34 in subsection (a)(2) or (b)(2), remedies are available for the violation to the
35 same extent as the remedies are available for the violation in a civil action
36 against a person other than a person described in subsection (a)(2) or
37 (b)(2), including—

38 “(1) injunctive relief under section 656 of this title;

39 “(2) actual damages, profits, costs, and an attorney’s fee under sec-
40 tion 657 of this title;

41 “(3) destruction of infringing articles under section 658 of this title;

1 “(4) the remedies provided for under sections 654, 659, 660, 663
2 and 664 of this title; and

3 “(5) other remedies provided under this subtitle.

4 “PART B—DOMESTIC REGISTRATION

“Chap.		Sec.
“61. Principal Register		601
“62. Supplemental Register		631
“63. Practice, Procedure, and Prohibitions		651

5 “CHAPTER 61—PRINCIPAL REGISTER

- “Sec.
- “601. Request for registration.
- “602. Marks registrable on principal register; concurrent registration.
- “603. Service marks registrable.
- “604. Collective marks and certification marks registrable.
- “605. Use by related companies.
- “606. Disclaimer of unregistrable matter.
- “607. Certificates of registration.
- “608. Duration.
- “609. Renewal of registration.
- “610. Assignment.
- “611. Execution of acknowledgments and verifications.
- “612. Examination and publication.
- “613. Opposition to registration.
- “614. Cancellation of registration.
- “615. Incontestability of right to use mark under certain conditions.
- “616. Interference.
- “617. Determination by Trademark Trial and Appeal Board.
- “618. Application of equitable principles in inter partes proceedings.
- “619. Appeals to Trademark Trial and Appeal Board from decisions of examiners.
- “620. Judicial review.
- “621. Registration as constructive notice of claim of ownership.

6 “§ 601. Request for registration

7 “(a) APPLICATION FOR REGISTRATION OF TRADEMARK.—

8 “(1) PAYMENT OF FEE AND FILING OF APPLICATION.—The owner
9 of a mark used in commerce may request registration of the mark on
10 the principal register by—

11 “(A) paying the prescribed fee; and

12 “(B) filing in the Office—

13 “(i) an application and a verified statement, in such form
14 as the Director may prescribe; and

15 “(ii) such number of specimens or facsimiles of the mark
16 as used as the Director may require.

17 “(2) CONTENTS OF APPLICATION.—The application shall—

18 “(A) specify—

19 “(i) the applicant’s domicile and citizenship;

20 “(ii) the date of the applicant’s first use of the mark;

21 “(iii) the date of the applicant’s first use of the mark in
22 commerce; and

23 “(iv) the good or service in connection with which the mark
24 is used; and

1 “(B) include a drawing of the mark.

2 “(3) VERIFICATION OF STATEMENT.—The statement shall be verified
3 by the applicant and specify that—

4 “(A) the applicant believes that the applicant is the owner of
5 the mark sought to be registered;

6 “(B) to the best of the applicant’s knowledge and belief, the
7 facts recited in the application are accurate;

8 “(C) the mark is in use in commerce; and

9 “(D) to the best of the applicant’s knowledge and belief, no
10 other person has the right to use that mark in commerce either
11 in the identical form of the mark or in such near resemblance to
12 that form as to be likely, when used on or in connection with a
13 good or service of the other person, to cause confusion, cause mis-
14 take, or deceive, except that, in the case of an application that
15 claims concurrent use, the applicant shall—

16 “(i) state exceptions to the claim of exclusive use; and

17 “(ii) specify, to the extent of the applicant’s knowledge—

18 “(I) any concurrent use by another person;

19 “(II) each good or service on or in connection with
20 which, and each area in which, each concurrent use ex-
21 exists;

22 “(III) the periods of each use; and

23 “(IV) each good or service and each area for which the
24 applicant desires registration.

25 “(4) COMPLIANCE WITH REGULATIONS.—

26 “(A) IN GENERAL.—The applicant shall comply with such regu-
27 lations as the Director may prescribe.

28 “(B) REQUIREMENTS FOR APPLICATION AND FILING DATE.—
29 The Director shall prescribe regulations establishing the require-
30 ments for the application and for obtaining a filing date under this
31 subsection.

32 “(b) APPLICATION BEFORE USE IN COMMERCE.—

33 “(1) PAYMENT OF FEE AND FILING OF APPLICATION.—A person
34 that has a bona fide intention, under circumstances showing the good
35 faith of the person, to use a mark in commerce may request registra-
36 tion of the mark on the principal register by—

37 “(A) paying the prescribed fee; and

38 “(B) filing in the Office an application and a verified statement
39 in such form as the Director may prescribe.

40 “(2) CONTENTS OF APPLICATION.—The application shall—

41 “(A) specify—

1 “(i) the applicant’s domicile and citizenship; and
2 “(ii) each good or service in connection with which the ap-
3 plicant has a bona fide intention to use the mark; and
4 “(B) include a drawing of the mark.
5 “(3) VERIFICATION OF STATEMENT.—The statement shall be verified
6 by the applicant and specify that—
7 “(A) the applicant believes that the applicant is entitled to use
8 the mark in commerce;
9 “(B) the applicant has a bona fide intention to use the mark
10 in commerce;
11 “(C) to the best of the applicant’s knowledge and belief, the
12 facts recited in the application are accurate; and
13 “(D) to the best of the applicant’s knowledge and belief, no
14 other person has the right to use the mark in commerce either in
15 the identical form of the mark or in such near resemblance to that
16 form as to be likely, when used on or in connection with a good
17 or service of the other person, to cause confusion, cause mistake,
18 or deceive.
19 “(4) OTHER REQUIREMENTS.—Except in the case of an application
20 under section 665 of this title, a mark shall not be registered until the
21 applicant meets the requirements of paragraphs (6) and (7).
22 “(5) COMPLIANCE WITH REGULATIONS.—
23 “(A) IN GENERAL.—The applicant shall comply with such regu-
24 lations as the Director may prescribe.
25 “(B) REQUIREMENTS FOR APPLICATION AND FILING DATE.—
26 The Director shall prescribe regulations establishing the require-
27 ments for the application and for obtaining a filing date under this
28 subsection.
29 “(6) AMENDMENT OF APPLICATION AFTER USE OF MARK IN COM-
30 MERCE.—At any time during examination of an application filed under
31 this subsection, an applicant that has made use of the mark in com-
32 merce may claim the benefits of that use for purposes of this subtitle
33 by amending the application to bring the application into conformity
34 with the requirements of subsection (a).
35 “(7) STATEMENT OF USE.—
36 “(A) IN GENERAL.—
37 “(i) TIME WITHIN WHICH STATEMENT MUST BE FILED.—
38 Not later than 6 months after the date on which the notice
39 of allowance with respect to a mark is issued under section
40 613(b)(2) of this title to an applicant under this subsection,
41 the applicant shall file in the Office, with such number of

1 specimens or facsimiles of the mark as used in commerce as
2 the Director may require, and payment of the prescribed fee,
3 a verified statement that specifies—

4 “(I) that the mark is in use in commerce;

5 “(II) the date of the first use of the mark in com-
6 merce by the applicant; and

7 “(III) each good or service specified in the notice of
8 allowance on or in connection with which the mark is
9 used in commerce.

10 “(ii) REGISTRATION.—Subject to examination and accept-
11 ance of the statement of use—

12 “(I) the mark shall be registered in the Office;

13 “(II) a certificate of registration shall be issued for
14 each good or service specified in the statement of use for
15 which the mark is entitled to registration; and

16 “(III) notice of registration shall be published in the
17 Official Gazette.

18 “(iii) EXAMINATION.—Examination of the statement of use
19 may include an examination of the factors described in sec-
20 tion 602(b) of this title.

21 “(iv) NOTICE OF REGISTRATION.—The notice of registra-
22 tion shall specify each good or service for which the mark is
23 registered.

24 “(B) EXTENSION OF FILING PERIOD.—

25 “(i) IN GENERAL.—On written request of the applicant be-
26 fore the expiration of the 6-month period provided under sub-
27 paragraph (A), the Director shall extend, for one additional
28 6-month period, the time for filing the statement of use under
29 that subparagraph.

30 “(ii) ADDITIONAL EXTENSION FOR GOOD CAUSE.—

31 “(I) IN GENERAL.—In addition to an extension under
32 clause (i), on written request of the applicant showing
33 good cause, made before the expiration of the last exten-
34 sion granted under this subparagraph, the Director may
35 further extend the time for filing the statement of use
36 under subparagraph (A) for periods aggregating not
37 more than 24 months.

38 “(II) REGULATIONS.—The Director shall prescribe
39 regulations stating guidelines for determining what con-
40 stitutes good cause for purposes of subclause (I).

1 “(iii) VERIFIED STATEMENT.—A request for an extension
2 under this subparagraph shall be accompanied by a verified
3 statement that—

4 “(I) states that the applicant has a continued bona
5 fide intention to use the mark in commerce; and

6 “(II) specifies each good or service identified in the
7 notice of allowance on or in connection with which the
8 applicant has a continued bona fide intention to use the
9 mark in commerce.

10 “(iv) FEE.—A request for an extension under this subpara-
11 graph shall be accompanied by payment of the prescribed fee.

12 “(C) NOTIFICATION OF ACCEPTANCE OR REFUSAL.—The Direc-
13 tor shall notify an applicant that files a statement of use of—

14 “(i) the acceptance or refusal of the statement of use; and

15 “(ii) if the statement of use is refused, the reasons for the
16 refusal.

17 “(D) AMENDMENT.—An applicant may amend the statement of
18 use.

19 “(E) RESULT OF FAILURE TO FILE STATEMENT.—

20 “(i) IN GENERAL.—A failure to timely file a verified state-
21 ment of use under subparagraph (A) or an extension request
22 under subparagraph (B) shall result in abandonment of the
23 application unless the applicant shows to the satisfaction of
24 the Director that the delay in responding was unintentional.

25 “(ii) UNINTENTIONAL DELAY.—In a case of unintentional
26 delay, the Director may extend the time for filing for a period
27 not to exceed the period specified in subparagraphs (A) and
28 (B) for filing a statement of use.

29 “(c) SERVICE OF NOTICES AND PROCESS.—

30 “(1) DESIGNATION OF AGENT.—An applicant not domiciled in the
31 United States may designate by a document filed in the Office the
32 name and address of a person residing in the United States on which
33 may be served notices and process in proceedings affecting the mark.

34 “(2) MEANS OF SERVICE.—Notice or process described in paragraph
35 (1)—

36 “(A) may be served on a person designated under paragraph (1)
37 by leaving with the person or mailing to the person a copy of the
38 notice or process at the address specified in the last designation
39 filed; or

1 “(B) if the person cannot be found at that address, or if the
2 applicant does not make a designation under paragraph (1), may
3 be served on the Director.

4 **“§ 602. Marks registrable on principal register; concurrent**
5 **registration**

6 “(a) IN GENERAL.—Except as provided in this section, the Director shall
7 not refuse registration on the principal register of a mark by which a good
8 or service of the applicant may be distinguished from the goods or services
9 of other persons on account of the nature of the mark.

10 “(b) GROUNDS FOR REFUSAL.—

11 “(1) IN GENERAL.—Registration of a mark may be refused if the
12 mark consists of or comprises—

13 “(A) immoral, deceptive, or scandalous matter;

14 “(B) matter that may disparage, falsely suggest a connection
15 with, or bring into contempt or disrepute a person (living or dead),
16 institution, belief, or national symbol; or

17 “(C) a geographical indication that—

18 “(i) when used on or in connection with a wine or spirit,
19 identifies a place other than the origin of the wine or spirit;
20 and

21 “(ii) is first used on or in connection with the wine or spirit
22 by the applicant on or after January 1, 1996.

23 “(2) FLAGS, COATS OF ARMS, AND OTHER INSIGNIA.—Registration
24 of a mark may be refused if the mark consists of or comprises—

25 “(A) the flag or coat of arms or other insignia of the United
26 States, a State or municipality, or a foreign country; or

27 “(B) any simulation of such an insignia.

28 “(3) IDENTIFIED INDIVIDUALS.—Registration of a mark may be re-
29 fused if the mark consists of or comprises—

30 “(A) a name, portrait, or signature identifying a particular liv-
31 ing individual, except by the written consent of the individual; or

32 “(B) the name, signature, or portrait of a deceased President
33 of the United States during the life of the widow or widower of
34 the President, except by the written consent of the widow or wid-
35 ower.

36 “(4) CLOSE RESEMBLANCE.—

37 “(A) IN GENERAL.—Subject to subparagraph (B), registration
38 of a mark may be refused if the mark consists of or comprises a
39 mark that so resembles a registered mark, or a mark or trade
40 name previously used in the United States by another person and
41 not abandoned, as to be likely, when used on or in connection with

1 a good or service of the applicant, to cause confusion, cause mis-
2 take, or deceive.

3 “(B) CONCURRENT REGISTRATION.—

4 “(i) IN GENERAL.—The Director may issue concurrent reg-
5 istrations of a mark described in subparagraph (A) as pro-
6 vided in clause (ii) or (iii).

7 “(ii) ISSUANCE ON DETERMINATION OF DIRECTOR.—If the
8 Director determines that confusion, mistake, or deception is
9 not likely to result from the continued use by more than one
10 person of the same or similar marks under conditions and
11 limitations concerning the mode or place of use of the marks
12 or the good or service on or in connection with which the
13 marks are used, the Director may issue concurrent registra-
14 tions to those persons if—

15 “(I) the persons have become entitled to use the
16 marks as a result of the concurrent lawful use in com-
17 merce by the persons before—

18 “(aa) the earliest of the filing dates of the pend-
19 ing applications or of any registration issued under
20 this subtitle;

21 “(bb) July 5, 1947, in the case of a registration
22 issued under the Act of March 3, 1881 (ch. 138, 21
23 Stat. 502), or the Act of February 20, 1905 (ch.
24 592, 33 Stat. 724), and continuing in full force and
25 effect on July 5, 1947; or

26 “(cc) July 5, 1947, in the case of an application
27 filed under the Act of February 20, 1905 (ch. 592,
28 33 Stat. 724), and registered after July 5, 1947; or

29 “(II) the owner of the application or registration con-
30 sents to the grant of a concurrent registration to the ap-
31 plicant.

32 “(iii) ISSUANCE ON DETERMINATION OF COURT.—The Di-
33 rector may issue concurrent registrations if a court of com-
34 petent jurisdiction makes a final determination that more
35 than one person is entitled to use the same or similar marks
36 in commerce.

37 “(iv) CONDITIONS AND LIMITATIONS.—In issuing concur-
38 rent registrations, the Director shall prescribe conditions and
39 limitations concerning—

40 “(I) the mode or place of use of the mark; or

1 “(II) the good or service on or in connection with
2 which the mark is registered to the respective persons.

3 “(5) MERELY DESCRIPTIVE, OR DECEPTIVELY MISDESCRIPTIVE,
4 MATTER.—Registration of a mark may be refused if the mark—

5 “(A) when used on or in connection with a good or service of
6 the applicant, is merely descriptive, or is deceptively misdescrip-
7 tive, of the good or service;

8 “(B) when used on or in connection with a good or service of
9 the applicant, is primarily geographically descriptive of the good
10 or service, except as indications of regional origin may be registra-
11 ble under section 604 of this title;

12 “(C) when used on or in connection with a good or service of
13 the applicant, is primarily geographically deceptively misdescriptive
14 of the good or service, except that this subparagraph does not pre-
15 clude the registration of a mark that, when used on or in connec-
16 tion with a good or service of the applicant—

17 “(i) is primarily geographically deceptively misdescriptive of
18 the good or service; and

19 “(ii) became distinctive of the good or service in commerce
20 before December 8, 1993;

21 “(D) is primarily merely a surname; or

22 “(E) comprises any matter that, as a whole, is functional.

23 “(c) REGISTRATION OF DISTINCTIVE MARK.—

24 “(1) IN GENERAL.—Except as excluded under paragraphs (1) to (4)
25 of subsection (b) and subparagraphs (C) and (E) of subsection (b)(5),
26 this subtitle does not preclude the registration of a mark used by an
27 applicant that has become distinctive of the applicant’s good or service
28 in commerce.

29 “(2) PRIMA FACIE EVIDENCE.—The Director may accept as prima
30 facie evidence that a mark has become distinctive, as used on or in con-
31 nection with the applicant’s good or service in commerce, proof of sub-
32 stantially exclusive and continuous use of the mark as a mark by the
33 applicant in commerce during the 5-year period before the date on
34 which the claim of distinctiveness is made.

35 “(d) MARK THAT WOULD CAUSE DILUTION.—In the case of a mark that
36 when used would cause dilution under section 664(c) of this title—

37 “(1) the mark may be refused registration only pursuant to a pro-
38 ceeding brought under section 613 of this title; and

39 “(2) registration of the mark may be canceled pursuant to a proceed-
40 ing brought under section 614 or 632 of this title.

1 **“§ 603. Service marks registrable**

2 “(a) IN GENERAL.—Subject to the provisions of this subtitle relating to
3 the registration of trademarks, so far as the provisions are applicable, a
4 service mark shall be registrable in the same manner and with the same
5 effect as a trademark.

6 “(b) PROTECTION.—When registered, a service mark is entitled to the
7 protection provided under this subtitle in the case of a trademark.

8 “(c) APPLICATIONS; PROCEDURE.—Applications and procedure under this
9 section shall conform as nearly as practicable to those prescribed for the
10 registration of trademarks.

11 **“§ 604. Collective marks and certification marks registrable**

12 “(a) IN GENERAL.—Subject to the provisions of this subtitle relating to
13 the registration of trademarks, so far as the provisions are applicable, a col-
14 lective mark or certification mark (including any indication of regional ori-
15 gin) shall be registrable under this subtitle in the same manner and with
16 the same effect as a trademark, by a person, or by a foreign country, State,
17 municipality, or other governmental entity, that exercises legitimate control
18 over the use of the mark sought to be registered, even though the person
19 or governmental entity does not possess an industrial or commercial estab-
20 lishment.

21 “(b) PROTECTION.—

22 “(1) IN GENERAL.—When registered, a collective mark or certifi-
23 cation mark is entitled to the protection provided under this subtitle
24 in the case of a trademark.

25 “(2) EXCEPTION.—A certification mark is not entitled to the protec-
26 tion provided under this subtitle if the certification mark is used to rep-
27 resent falsely that the owner or a user of the certification mark makes
28 or sells a good or performs a service on or in connection with which
29 the certification mark is used.

30 “(c) APPLICATIONS; PROCEDURE.—Applications and procedure under this
31 section shall conform as nearly as practicable to those prescribed for the
32 registration of trademarks.

33 **“§ 605. Use by related companies**

34 “(a) IN GENERAL.—In a case in which a registered mark or a mark
35 sought to be registered is or may be used legitimately by related companies,
36 the use shall inure to the benefit of the registrant or applicant for registra-
37 tion.

38 “(b) NO EFFECT ON VALIDITY.—The use of a mark as described in sub-
39 section (a) shall not affect the validity of the mark or of its registration
40 so long as the mark is not used to deceive the public.

1 “(e) FIRST USE.—If first use of a mark by a person is controlled by the
2 registrant or applicant for registration of the mark with respect to the na-
3 ture and quality of a good or service, the first use shall inure to the benefit
4 of the registrant or the applicant, as the case may be.

5 **“§ 606. Disclaimer of unregistrable matter**

6 “(a) COMPULSORY DISCLAIMER.—The Director may require an applicant
7 to disclaim an unregistrable component of a mark otherwise registrable.

8 “(b) VOLUNTARY DISCLAIMER.—An applicant may voluntarily disclaim a
9 component of a mark sought to be registered.

10 “(c) RIGHTS NOT PREJUDICED OR AFFECTED.—A disclaimer (including
11 a disclaimer made under section 607(e) of this title) does not prejudice or
12 affect—

13 “(1) the applicant’s or registrant’s rights existing on the date of a
14 disclaimer or thereafter arising in the disclaimed matter; or

15 “(2) the applicant’s or registrant’s right of registration on another
16 application, if the disclaimed matter is distinctive or becomes distinc-
17 tive of a good or service of the applicant or registrant.

18 **“§ 607. Certificates of registration**

19 “(a) ISSUANCE AND CONTENTS.—

20 “(1) IN GENERAL.—A certificate of registration of a mark registered
21 on the principal register—

22 “(A) shall be issued in the name of the United States, under
23 the seal of the Office; and

24 “(B) shall be signed by the Director or have the signature of
25 the Director placed on the certificate.

26 “(2) RECORD.—A record of a certificate of registration shall be kept
27 in the Office.

28 “(3) CONTENTS.—A certificate of registration shall—

29 “(A) reproduce the mark;

30 “(B) state that the mark is registered on the principal register
31 under this subtitle;

32 “(C) state the date of the first use of the mark and the date
33 of the first use of the mark in commerce;

34 “(D) specify each good or service for which the mark is reg-
35 istered; and

36 “(E) state—

37 “(i) the number and date of the registration;

38 “(ii) the term of the registration;

39 “(iii) the date on which the application for registration was
40 received in the Office; and

1 “(iv) any conditions and limitations that are imposed in the
2 registration.

3 “(b) PRIMA FACIE EVIDENCE OF VALIDITY.—A certificate of registration
4 of a mark on the principal register is prima facie evidence of—

5 “(1) the validity of the registered mark and of the registration of
6 the mark;

7 “(2) the registrant’s ownership of the mark; and

8 “(3) the registrant’s exclusive right to use the registered mark in
9 commerce on or in connection with each good or service specified in
10 the certificate, subject to conditions or limitations stated in the certifi-
11 cate.

12 “(c) APPLICATION CONSTITUTES CONSTRUCTIVE USE.—Contingent on
13 the registration of a mark on the principal register, the filing of an applica-
14 tion to register the mark—

15 “(1) is constructive use of the mark; and

16 “(2) confers a right of priority, nationwide in effect, on or in connec-
17 tion with each good or service specified in the registration against any
18 person except a person that—

19 “(A) has a mark that has not been abandoned; and

20 “(B) before the filing—

21 “(i) used the mark;

22 “(ii) filed an application to register the mark, which appli-
23 cation is pending or has resulted in registration of the mark;
24 or

25 “(iii)(I) filed a foreign application to register the mark on
26 the basis of which the person has acquired a right of priority;
27 and

28 “(II) timely files an application under section 665(d) of
29 this title to register the mark, which application is pending
30 or has resulted in registration of the mark.

31 “(d) ISSUANCE TO ASSIGNEE.—

32 “(1) IN GENERAL.—A certificate of registration of a mark may be
33 issued to an assignee of the applicant only after the assignment is re-
34 corded in the Office.

35 “(2) NEW CERTIFICATE OF REGISTRATION.—In case of assignment
36 of a mark, the Director, at the request of the assignee and on a proper
37 showing and payment of the prescribed fee, shall issue to the assignee
38 a new certificate of registration of the mark in the name of the as-
39 signee and for the unexpired part of the original period.

40 “(e) CANCELLATION OR AMENDMENT.—

1 “(1) CANCELLATION.—On application of the registrant, the Director
2 may permit a registration to be surrendered for cancellation.

3 “(2) AMENDMENT OR DISCLAIMER.—On application of the registrant
4 and payment of the prescribed fee, the Director for good cause may
5 permit a registration to be amended or to be disclaimed in part, so long
6 as the amendment or disclaimer does not alter materially the character
7 of the mark.

8 “(3) RECORDATION.—Cancellation, amendment, or disclaimer of a
9 registration under this subsection shall be entered in the records of the
10 Office. Amendment or disclaimer of a registration under this subsection
11 also shall be entered on the certificate of registration (or on a certified
12 copy if the certificate is lost or destroyed).

13 “(f) COPIES OF RECORDS AND REGISTRATIONS.—

14 “(1) AVAILABILITY OF COPIES.—On application by a person and
15 payment of the prescribed fee, the Director shall provide the person a
16 copy of a registration or of any other record belonging to the Office
17 that relates to a mark.

18 “(2) COPIES AS EVIDENCE.—A copy of a registration or other record
19 described in paragraph (1), when authenticated by the seal of the Of-
20 fice and certified by the Director or an employee of the Office des-
21 ignated by the Director, shall be evidence in any case in which the
22 original would be evidence.

23 “(g) CORRECTION OF MISTAKE BY OFFICE.—

24 “(1) IN GENERAL.—If a material mistake in a registration, incurred
25 through the fault of the Office, is clearly disclosed by the records of
26 the Office—

27 “(A)(i) the Director, without charge, shall issue and record a
28 certificate stating the fact and nature of the mistake; and

29 “(ii) a printed copy of the certificate shall be attached to each
30 printed copy of the registration certificate; or

31 “(B) the Director, without charge, may issue a new certificate
32 of registration.

33 “(2) EFFECT.—A corrected registration has the same effect as if the
34 certificate had originally been issued in the corrected form.

35 “(3) CERTIFICATES OF CORRECTION ISSUED ADMINISTRATIVELY.—
36 A certificate of correction issued under the rules of the Office before
37 July 5, 1946, and the registration to which the certificate is attached,
38 has the same effect as if the certificate and its issuance had been au-
39 thorized by statute.

40 “(h) CORRECTION OF MISTAKE BY APPLICANT.—If a mistake is made in
41 a registration and a showing is made that the mistake occurred in good

1 faith through the fault of the applicant, the Director, on payment of the
2 prescribed fee, may issue a certificate of correction or a new certificate of
3 registration if the correction does not involve a change in the registration
4 that would require republication of the mark.

5 **“§ 608. Duration**

6 “(a) IN GENERAL.—A registration remains in force for 10 years, except
7 that the Director shall cancel the registration of a mark, for failure to com-
8 ply with subsection (b), on the expiration of the following time periods:

9 “(1) In the case of a registration issued under this subtitle, at the
10 end of 6 years following the date of registration.

11 “(2) In the case of a registration published under section 612(d) of
12 this title, at the end of 6 years following the date of publication under
13 section 612(d) of this title.

14 “(3) In the case of any registration, at the end of each successive
15 10-year period following the date of registration.

16 “(b) AFFIDAVIT OF USE OR NONUSE.—During the one-year period imme-
17 diately preceding the end of the applicable time period specified in sub-
18 section (a), the owner of a registration shall pay the prescribed fee and file
19 in the Office—

20 “(1)(A) an affidavit that specifies each good or service specified in
21 the registration on or in connection with which the mark is in use in
22 commerce; and

23 “(B) such number of specimens or facsimiles showing current use of
24 the mark as the Director may require; or

25 “(2) an affidavit that—

26 “(A) specifies each good or service specified in the registration
27 on or in connection with which the mark is not in use in com-
28 merce; and

29 “(B) shows that the nonuse is due to special circumstances that
30 excuse the nonuse and not to any intention to abandon the mark.

31 “(c) GRACE PERIOD FOR SUBMISSION.—

32 “(1) IN GENERAL.—The owner of a registration may make the sub-
33 missions required under this section within a grace period of 6 months
34 after the end of the applicable time period specified in subsection (a).

35 “(2) DEFICIENT SUBMISSION.—If a submission filed under this sec-
36 tion is deficient, the deficiency may be corrected after the statutory
37 time period and within the time prescribed after notification of the de-
38 ficiency.

39 “(3) SURCHARGE.—A submission under paragraph (1) or (2) shall
40 be accompanied by payment of a surcharge prescribed by the Director.

1 “(d) ATTACHMENT OF NOTICE OF AFFIDAVIT REQUIREMENT.—Notice of
2 the requirement for affidavits under this section shall be attached to each
3 certificate of registration and each notice of publication under section
4 612(d) of this title.

5 “(e) NOTIFICATION OF ACCEPTANCE OR REFUSAL OF AFFIDAVIT.—The
6 Director shall notify an owner that files an affidavit under this section of—

7 “(1) the Director’s acceptance or refusal of the affidavit; and

8 “(2) in the case of a refusal, the reasons for the refusal.

9 “(f) SERVICE OF NOTICES AND PROCESS.—

10 “(1) DESIGNATION OF AGENT.—A registrant not domiciled in the
11 United States may designate by a document filed in the Office the
12 name and address of a person residing in the United States on which
13 may be served notices and process in proceedings affecting the mark.

14 “(2) MEANS OF SERVICE.—Notice or process described in paragraph
15 (1)—

16 “(A) may be served on a person designated under paragraph (1)
17 by leaving with the person or mailing to the person a copy of the
18 notice or process at the address specified in the last designation
19 filed; or

20 “(B) if the person cannot be found at that address, or if the
21 registrant does not make a designation under paragraph (1), may
22 be served on the Director.

23 **“§ 609. Renewal of registration**

24 “(a) IN GENERAL.—Subject to section 608 of this title, on payment of
25 the prescribed fee and the filing of a written application in such form as
26 the Director may prescribe, a registration may be renewed for a period of
27 10 years at the end of each successive 10-year period following the date of
28 registration.

29 “(b) APPLICATION.—An application under subsection (a) may be made—

30 “(1) at any time within one year before the end of each successive
31 10-year period for which the registration was issued or renewed; or

32 “(2) on payment of a surcharge in addition to the prescribed fee,
33 within a grace period of 6 months after the end of any such 10-year
34 period.

35 “(c) DEFICIENT APPLICATION.—If an application filed under this section
36 is deficient, the deficiency may be corrected within the time prescribed after
37 notification of the deficiency, on payment of a surcharge prescribed for cor-
38 recting the deficiency.

39 “(d) NOTIFICATION OF REFUSAL TO RENEW.—If the Director refuses to
40 renew the registration, the Director shall notify the registrant of the Direc-
41 tor’s refusal and the reasons for the refusal.

1 “(e) SERVICE OF NOTICES AND PROCESS.—

2 “(1) DESIGNATION OF AGENT.—A registrant not domiciled in the
3 United States may designate by a document filed in the Office the
4 name and address of a person residing in the United States on which
5 may be served notices and process in proceedings affecting the mark.

6 “(2) MEANS OF SERVICE.—Notice or process described in paragraph
7 (1)—

8 “(A) may be served on a person designated under paragraph (1)
9 by leaving with the person or mailing to the person a copy of the
10 notice or process at the address specified in the last designation
11 filed; or

12 “(B) if the person cannot be found at that address, or if the
13 registrant does not make a designation under paragraph (1), may
14 be served on the Director.

15 **“§ 610. Assignment**

16 “(a) IN GENERAL.—

17 “(1) ASSIGNABILITY.—A registered mark or a mark for which an ap-
18 plication to register has been filed shall be assignable with—

19 “(A) the goodwill of the business in which the mark is used; or

20 “(B) the part of the goodwill of the business that is connected
21 with the use of and symbolized by the mark.

22 “(2) APPLICATION BEFORE USE IN COMMERCE.—

23 “(A) IN GENERAL.—An application to register a mark under
24 section 601(b) of this title is not assignable before the filing of—

25 “(i) an amendment under section 601(b)(6) of this title to
26 bring the application into conformity with section 601(a) of
27 this title; or

28 “(ii) the filing of a verified statement of use under section
29 601(b)(7) of this title.

30 “(B) EXCEPTION.—An application to register a mark under sec-
31 tion 601(b) of this title may be assigned to a successor to the
32 business of the applicant, or to the portion of the business to
33 which the mark pertains, if that business is ongoing and existing.

34 “(3) GOODWILL.—In an assignment authorized by this section, it is
35 not necessary to include the goodwill of the business connected with the
36 use of and symbolized by—

37 “(A) another mark used in the business; or

38 “(B) the name or style under which the business is conducted.

39 “(4) INSTRUMENT OF ASSIGNMENT.—An assignment shall be made
40 by an executed instrument.

41 “(5) ACKNOWLEDGMENT AND RECORD AS PRIMA FACIE EVIDENCE.—

1 “(A) ACKNOWLEDGMENT.—Acknowledgment is prima facie evi-
2 dence of the execution of an assignment.

3 “(B) RECORD.—When the prescribed information reporting an
4 assignment is recorded in the Office, the record is prima facie evi-
5 dence of the execution of the assignment.

6 “(6) VOIDING OF ASSIGNMENT.—An assignment is void against a
7 subsequent purchaser for valuable consideration without notice unless
8 the prescribed information reporting the assignment is recorded in the
9 Office—

10 “(A) not later than 3 months after the date of the assignment;

11 or

12 “(B) before the subsequent purchase.

13 “(7) RECORD OF INFORMATION.—The Director shall maintain a
14 record of information on assignments in such form as the Director may
15 prescribe.

16 “(b) SERVICE OF NOTICES AND PROCESS.—

17 “(1) DESIGNATION OF AGENT.—An assignee not domiciled in the
18 United States may designate by a document filed in the Office the
19 name and address of a person residing in the United States on which
20 may be served notices and process in proceedings affecting the mark.

21 “(2) MEANS OF SERVICE.—Notice or process described in paragraph
22 (1)—

23 “(A) may be served on a person designated under paragraph (1)
24 by leaving with the person or mailing to the person a copy of the
25 notice or process at the address specified in the last designation
26 filed; or

27 “(B) if the person cannot be found at that address, or if the
28 assignee does not make a designation under paragraph (1), may
29 be served on the Director.

30 **“§ 611. Execution of acknowledgments and verifications**

31 “An acknowledgment or verification required under this subtitle—

32 “(1)(A) may be made before an individual in the United States au-
33 thorized by law to administer oaths; or

34 “(B) when made in a foreign country, may be made before—

35 “(i) a diplomatic or consular officer of the United States; or

36 “(ii) an official authorized to administer oaths in the foreign
37 country whose authority is proved by—

38 “(I) a certificate of a diplomatic or consular officer of the
39 United States; or

1 “(II) an apostille of an official designated by a foreign
2 country which, by treaty or convention, accords like effect to
3 apostilles of designated officials in the United States; and

4 “(2) shall be valid if the acknowledgment or verification complies
5 with the laws of the State or country in which the acknowledgment or
6 verification is made.

7 **“§ 612. Examination and publication**

8 “(a) IN GENERAL.—On filing of an application for registration and pay-
9 ment of the prescribed fee, the Director shall refer the application to the
10 examiner in charge of the registration of marks for examination.

11 “(b) DETERMINATION OF ENTITLEMENT.—

12 “(1) IN GENERAL.—If the examiner determines that the applicant is
13 entitled to registration, or would be entitled to registration on the ac-
14 ceptance of the statement of use required by section 601(b)(7) of this
15 title, the Director shall publish the mark in the Official Gazette.

16 “(2) CONCURRENT USE OR INTERFERENCE.—In the case of an ap-
17 plication in which the applicant claims concurrent use or of an applica-
18 tion that is to be placed in an interference under section 616 of this
19 title, the mark, if otherwise registrable, may be published subject to the
20 determination of the rights of the parties in a proceeding under section
21 617 of this title.

22 “(c) DETERMINATION OF NONENTITLEMENT.—

23 “(1) NOTICE OF INITIAL REFUSAL.—If the examiner determines that
24 an applicant is not entitled to registration, the examiner shall notify
25 the applicant of the determination that the applicant is not entitled to
26 registration and the reasons for the determination.

27 “(2) REPLY OR AMENDMENT.—The applicant has 6 months in which
28 to reply or amend the application, which shall then be reexamined.

29 “(3) ADDITIONAL PROCEDURE.—The procedure under paragraphs
30 (1) and (2) may be repeated until—

31 “(A) the examiner finally refuses registration of the mark; or

32 “(B) the applicant does not, within the 6-month period specified
33 in paragraph (2)—

34 “(i) reply to the latest notice;

35 “(ii) amend the application; or

36 “(iii) appeal the determination of nonentitlement.

37 “(4) CONSTRUCTIVE ABANDONMENT.—If the applicant fails to reply,
38 amend, or appeal, the application shall be deemed to be abandoned un-
39 less the applicant shows to the satisfaction of the Director that the
40 delay in responding was unintentional, in which case the Director may
41 extend the time for reply, amendment, or appeal.

1 “(d) REPUBLICATION OF MARKS REGISTERED UNDER PRIOR ACTS.—

2 “(1) FILING OF AFFIDAVIT.—Before a registration of a mark under
3 the Act of March 3, 1881 (ch. 138, 21 Stat. 502), or the Act of Feb-
4 ruary 20, 1905 (ch. 592, 33 Stat. 724), expires, the registrant, on pay-
5 ment of the prescribed fee, may file with the Director an affidavit
6 that—

7 “(A) specifies each good or service specified in the registration
8 on which the mark is in use in commerce; and

9 “(B) states that the registrant claims the benefits of this sub-
10 title for the mark.

11 “(2) PUBLICATION; NOTIFICATION.—The Director shall—

12 “(A) publish notice of the filing with a reproduction of the mark
13 in the Official Gazette; and

14 “(B) notify the registrant of the publication and of the require-
15 ment for the affidavit of use or nonuse under section 608(b) of
16 this title.

17 “(3) INAPPLICABILITY OF SECTION 613.—A mark published under
18 this subsection is not subject to section 613 of this title.

19 **“§ 613. Opposition to registration**

20 “(a) FILING.—

21 “(1) IN GENERAL.—Not later than 30 days after the publication of
22 the mark under section 612(b) of this title, on payment of the pre-
23 scribed fee, a person that believes that it would be damaged by the reg-
24 istration of the mark on the principal register (including damage as a
25 result of dilution under section 664(e) of this title) may file in the Of-
26 fice an opposition that states each ground for opposition.

27 “(2) EXTENSION.—

28 “(A) IN GENERAL.—On written request before expiration of the
29 30-day period, the Director shall extend the time for filing opposi-
30 tion for an additional 30 days.

31 “(B) FURTHER EXTENSIONS.—If requested before the expira-
32 tion of an extension, the Director, for good cause, may grant fur-
33 ther extensions of the time for filing opposition.

34 “(C) NOTIFICATION OF APPLICANT.—The Director shall notify
35 the applicant of each extension of time for filing opposition.

36 “(3) AMENDMENT.—A person that files an opposition may amend
37 the opposition under such conditions as the Director may prescribe.

38 “(b) UNSUCCESSFUL OPPOSITION.—Unless registration is successfully op-
39 posed—

1 “(1)(A) a mark entitled to registration on the principal register
2 based on an application filed under section 601(a) of this title or pur-
3 suant to section 665 of this title shall be registered in the Office;

4 “(B) a certificate of registration shall be issued; and

5 “(C) notice of the registration shall be published in the Official Ga-
6 zette; or

7 “(2) if the applicant applied for registration under section 601(b) of
8 this title, a notice of allowance shall be issued to the applicant.

9 **“§ 614. Cancellation of registration**

10 “(a) IN GENERAL.—On payment of the prescribed fee, a person that be-
11 lieves that it is or will be damaged (including as a result of dilution under
12 section 664(c) of this title) by the registration of a mark on the principal
13 register or under the Act of March 3, 1881 (ch. 138, 21 Stat. 502), or the
14 Act of February 20, 1905 (ch. 592, 33 Stat. 724), may, not later than the
15 time specified in subsection (b), file with the Director a petition to cancel
16 the registration of the mark that states each ground for cancellation.

17 “(b) TIME FOR FILING.—A petition under subsection (a) shall be filed—

18 “(1)(A) in the case of a registration under this subtitle, not later
19 than 5 years after the date of registration of the mark under this sub-
20 title; or

21 “(B) in the case of a registration under the Act of March 3, 1881
22 (ch. 138, 21 Stat. 502), or the Act of February 20, 1905 (ch. 592,
23 33 Stat. 724)—

24 “(i) not later than 5 years after the date of publication of the
25 mark under section 612(d) of this title; or

26 “(ii) at any time if the mark has not been published under sec-
27 tion 612(d) of this title;

28 “(2) at any time if—

29 “(A) the registered mark becomes the generic name for a good
30 or service for which the mark is registered;

31 “(B) the registered mark is functional;

32 “(C) the registered mark has been abandoned;

33 “(D)(i) in the case of a registration under this subtitle, the reg-
34 istration was obtained fraudulently or contrary to section 604 of
35 this title or paragraph (1), (2), or (3) of subsection (b) of section
36 602 of this title; or

37 “(ii) in the case of a registration under the Act of March 3,
38 1881 (ch. 138, 21 Stat. 502), or the Act of February 20, 1905
39 (ch. 592, 33 Stat. 724), the registration was obtained contrary to
40 similar prohibitory provisions of the applicable Act; or

1 “(E) the registered mark is being used by, or with the permis-
2 sion of, the registrant so as to misrepresent the source of a good
3 or service on or in connection with which the mark is used; or

4 “(3) in the case of a certification mark, at any time on the ground
5 that the registrant—

6 “(A) does not control, or is not able legitimately to exercise con-
7 trol over, the use of the mark;

8 “(B) engages in the production or marketing of a good or serv-
9 ice to which the certification mark is applied;

10 “(C) permits the use of the certification mark for purposes
11 other than to certify; or

12 “(D) discriminately refuses to certify or to continue to certify
13 a good or service of a person that maintains the standards or con-
14 ditions that the mark certifies.

15 “(c) REGISTERED MARK AS GENERIC NAME.—

16 “(1) FEWER THAN ALL GOODS OR SERVICES.—If a registered mark
17 becomes the generic name for fewer than all of the goods or services
18 for which the registered mark is registered, a person may file at any
19 time a petition under subsection (a) to cancel the registration for any
20 good or service for which the mark has become the generic name.

21 “(2) TEST FOR DETERMINATION.—

22 “(A) IN GENERAL.—The primary significance of a registered
23 mark to the relevant public, and not purchaser motivation, shall
24 be the test for determining whether a registered mark has become
25 the generic name of a good or service on or in connection with
26 which the registered mark has been used.

27 “(B) UNIQUE GOOD OR SERVICE.—A registered mark shall not
28 be determined to be the generic name for a good or service solely
29 because the registered mark is also used as a name of or to iden-
30 tify a unique good or service.

31 “(d) PETITION BY FEDERAL TRADE COMMISSION.—

32 “(1) GROUNDS.—The Federal Trade Commission may file a petition
33 to cancel a mark registered on the principal register on a ground speci-
34 fied in paragraph (2) or (3) of subsection (b).

35 “(2) NO FEE.—The Federal Trade Commission shall not be required
36 to pay a filing fee.

37 “(e) USE OF MARK IN ADVERTISING OR PROMOTION.—Subsection (b)(3)
38 does not prohibit a registrant from using its certification mark in advertis-
39 ing or promoting recognition of the certification program or of a good or
40 service meeting the certification standards of the registrant and such uses
41 are not grounds for cancellation under subsection (b)(3) so long as the reg-

1 istrant does not produce, manufacture, or sell any certified good or service
2 to which its identical certification mark is applied.

3 **“§ 615. Incontestability of right to use mark under certain**
4 **conditions**

5 “(a) IN GENERAL.—Except on a ground for which application to cancel
6 may be filed at any time under paragraph (2) or (3) of section 614(b) of
7 this title, and except to the extent to which the use of a mark registered
8 on the principal register infringes a valid right acquired under the law of
9 a State or territory by use of a mark or trade name continuing from a date
10 before the date of registration of the mark under this subtitle, the right of
11 a registrant to use the registered mark in commerce for a good or service
12 on or in connection with which the registered mark has been in continuous
13 use for 5 consecutive years subsequent to the date of the registration and
14 is still in use in commerce, is incontestable if—

15 “(1) there has been no final decision adverse to—

16 “(A) the registrant’s claim of ownership of the mark for the
17 good or service; or

18 “(B) the registrant’s right to register the mark or to keep the
19 mark on the register;

20 “(2) there is no proceeding involving the rights described in sub-
21 section (a)(1)(B) pending in the Office or in a court and not finally
22 disposed of; and

23 “(3) not later than one year after the expiration of any 5-year period
24 subsequent to registration, the registrant files with the Director an af-
25 fidavit that—

26 “(A) specifies each good or service specified in the registration
27 on or in connection with which the mark—

28 “(i) was in continuous use for that 5-year period; and

29 “(ii) is still in use in commerce; and

30 “(B) verifies the matters specified in paragraphs (1) and (2).

31 “(b) NO INCONTESTABLE RIGHT FOR GENERIC NAME.—An incontestable
32 right shall not be acquired in a mark that is the generic name for any good
33 or service for which the mark is registered.

34 “(c) APPLICABILITY TO MARK REGISTERED UNDER PRIOR ACT.—Sub-
35 ject to the conditions specified in this section, an incontestable right with
36 respect to a mark registered under this subtitle shall apply to a mark reg-
37 istered under the Act of March 3, 1881 (ch. 138, 21 Stat. 502), or the Act
38 of February 20, 1905 (ch. 592, 33 Stat. 724), on the filing of the affidavit
39 required under subsection (a)(3) not later than one year after the expiration
40 of any 5-year period of continuous use after the date of publication of the
41 registered mark under section 612(d) of this title.

1 “(d) NOTICE.—The Director shall notify a registrant that files an affida-
2 vit under this section of the filing.

3 **“§ 616. Interference**

4 “(a) IN GENERAL.—On petition showing extraordinary circumstances, the
5 Director may declare that an interference exists if application is made for
6 registration of a mark that so resembles a mark previously registered by
7 another person, or for the registration of which another person has pre-
8 viously made application, as to be likely when used on or in connection with
9 a good or service of the applicant to cause confusion, cause mistake, or de-
10 ceive.

11 “(b) INCONTESTABLE RIGHT TO USE.—Interference shall not be declared
12 between an application and the registration of a mark to which the right
13 to use the mark has become incontestable.

14 **“§ 617. Determination by Trademark Trial and Appeal**
15 **Board**

16 “(a) IN GENERAL.—In a case of interference, opposition to registration,
17 application to register as a lawful concurrent user, or application to cancel
18 the registration of a mark, the Director shall—

19 “(1) give notice to all parties; and

20 “(2) direct a Trademark Trial and Appeal Board to determine the
21 respective rights of registration.

22 “(b) MEMBERS OF TRADEMARK TRIAL AND APPEAL BOARD.—A Trade-
23 mark Trial and Appeal Board shall include—

24 “(1) the Director;

25 “(2) the Deputy Director;

26 “(3) the Commissioner for Patents;

27 “(4) the Commissioner for Trademarks; and

28 “(5) administrative trademark judges appointed by the Director.

29 “(c) ACTION BY THE DIRECTOR.—

30 “(1) IN GENERAL.—In a proceeding under this section, the Director
31 may, as the rights of the parties under this subtitle are determined in
32 the proceedings—

33 “(A) refuse to register an opposed mark;

34 “(B) cancel a registration, in whole or in part;

35 “(C) modify an application or registration by limiting the goods
36 or services specified in the application or registration;

37 “(D) otherwise restrict or rectify with respect to the principal
38 register or supplemental register the registration of a registered
39 mark;

40 “(E) refuse to register any or all of several interfering marks;

41 or

1 “(F) register a mark for the person entitled to have the mark
2 registered.

3 “(2) REGISTRATION BASED ON CONCURRENT USE.—The Director
4 shall determine and fix the conditions and limitations for the registra-
5 tion of a mark based on concurrent use as provided in section
6 602(b)(4) of this title.

7 “(3) FINAL JUDGMENT BEFORE USE IN COMMERCE.—A final judg-
8 ment shall not be entered in favor of an applicant under section 601(b)
9 of this title before the mark is registered if the applicant cannot prevail
10 without establishing constructive use under section 607(c) of this title.

11 **“§ 618. Application of equitable principles in inter partes**
12 **proceedings**

13 “Equitable principles of laches, estoppel, and acquiescence, in circum-
14 stances in which those principles apply, may be considered and applied in
15 an inter partes proceeding.

16 **“§ 619. Appeals to Trademark Trial and Appeal Board from**
17 **decisions of examiners**

18 “An appeal may be taken to the Trademark Trial and Appeal Board from
19 a final decision of the examiner in charge of the registration of marks on
20 payment of the prescribed fee.

21 **“§ 620. Judicial review**

22 “(a) PERSONS THAT MAY APPEAL OR BRING CIVIL ACTION; TIMING.—
23 An applicant for registration of a mark, a party to an interference proceed-
24 ing, a party to an opposition proceeding, a party to an application to reg-
25 ister as a lawful concurrent user, a party to a cancellation proceeding, a
26 registrant that has filed an affidavit as provided in section 608 of this title,
27 or an applicant for renewal may, within such time after the date of a deci-
28 sion of the Director or of the Trademark Trial and Appeal Board as the
29 Director prescribes (but not less than 60 days after that date)—

30 “(1) appeal the decision to the United States Court of Appeals for
31 the Federal Circuit under subsection (b); or

32 “(2) bring a civil action in United States district court for review
33 of the decision under subsection (c).

34 “(b) APPEAL TO UNITED STATES COURT OF APPEALS FOR THE FED-
35 ERAL CIRCUIT.—

36 “(1) IN GENERAL.—In an appeal brought under subsection (a)(1),
37 the procedures stated in this subsection apply.

38 “(2) RIGHTS UNDER SUBSECTION (c).—

39 “(A) WAIVER BY APPELLANT.—A person that takes an appeal
40 under this subsection waives the right to bring a civil action under
41 subsection (c).

1 “(B) DISMISSAL ON ELECTION BY ADVERSE PARTY.—

2 “(i) IN GENERAL.—An appeal shall be dismissed if an ad-
3 verse party to the proceeding, other than the Director, files
4 notice with the Director not later than 20 days after the ap-
5 pellant files notice of appeal in accordance with paragraph (3)
6 that the adverse party elects to have all further proceedings
7 conducted in a civil action under subsection (c).

8 “(ii) CIVIL ACTION.—The appellant shall have 30 days
9 after the date the notice of appeal is filed under clause (i)
10 to bring a civil action under subsection (c).

11 “(iii) FAILURE TO BRING CIVIL ACTION.—If the appellant
12 does not bring a civil action within the time specified in
13 clause (ii), the decision appealed from shall govern any fur-
14 ther proceedings in the case.

15 “(3) NOTICE OF APPEAL.—Within the time described in subsection
16 (a), the appellant shall file with the Director a written notice of appeal.

17 “(4) TRANSMITTAL OF DOCUMENTS AND SUBMISSION OF BRIEF.—

18 “(A) CERTIFIED LIST.—The Director shall transmit to the
19 court a certified list of the documents comprising the record in the
20 Office.

21 “(B) COPIES OF DOCUMENTS.—The court may request that the
22 Director forward the original or certified copies of the documents
23 during pendency of the appeal.

24 “(C) EX PARTE PROCEEDING.—In an ex parte proceeding, the
25 Director shall submit to the court a brief that—

26 “(i) explains the grounds for the decision of the Office; and

27 “(ii) addresses all issues involved in the appeal.

28 “(5) NOTICE OF HEARING.—Before hearing an appeal, the court
29 shall give notice of the time and place of the hearing to the Director
30 and the parties in the appeal.

31 “(6) DECISION OF COURT.—

32 “(A) REVIEW OF DECISION.—The court shall review the deci-
33 sion from which the appeal is taken on the record before the Of-
34 fice.

35 “(B) MANDATE AND OPINION.—

36 “(i) IN GENERAL.—After the court makes a determination
37 of the issues, the court shall issue a mandate and opinion to
38 the Director, the Director shall enter the mandate and opin-
39 ion in the record in the Office, and the mandate and opinion
40 shall govern the further proceedings in the case.

1 “(ii) APPLICATION BEFORE USE IN COMMERCE.—A final
2 judgment shall not be entered in favor of an applicant under
3 section 601(b) of this title before the mark is registered if the
4 applicant cannot prevail without establishing constructive use
5 under section 607(c) of this title.

6 “(c) CIVIL ACTION.—

7 “(1) IN GENERAL.—In a civil action brought under subsection
8 (a)(2), the procedures stated in this subsection apply.

9 “(2) STATUS AND RIGHTS OF DIRECTOR.—The Director shall not be
10 made a party to an inter partes proceeding under this subsection, shall
11 be notified of the filing of the complaint by the clerk of the court in
12 which the complaint is filed, and has the right to intervene in the civil
13 action.

14 “(3) NO ADVERSE PARTY.—In a case in which there is no adverse
15 party—

16 “(A) a copy of the complaint shall be served on the Director;

17 “(B) unless the court finds the expenses to be unreasonable, all
18 expenses of the civil action shall be paid by the party bringing the
19 case, whether the final decision is in favor of that party or not;

20 “(C) the record in the Office shall be admitted on motion of any
21 party, on terms and conditions as to costs, expenses, and the fur-
22 ther cross-examination of the witnesses as the court imposes, with-
23 out prejudice to the right of any party to take further testimony;
24 and

25 “(D) when admitted, the testimony and exhibits of the record
26 in the Office have the same effect as if originally taken and pro-
27 duced in the civil action.

28 “(4) ADVERSE PARTY.—In a case in which there is an adverse
29 party—

30 “(A) a civil action under this subsection may be brought against
31 the party in interest as shown by the record of the Office at the
32 time of the decision complained of;

33 “(B) any party in interest may become a party to the civil ac-
34 tion;

35 “(C) the United States District Court for the District of Colum-
36 bia has jurisdiction in a case in which—

37 “(i) adverse parties reside in a plurality of districts not em-
38 braced within the same State; or

39 “(ii) an adverse party resides in a foreign country;

1 “(D) the court may issue a summons against the adverse par-
2 ties directed to the marshal of any district in which any adverse
3 party resides; and

4 “(E) a summons against an adverse party residing in a foreign
5 country may be served by publication or otherwise as the court di-
6 rects.

7 “(5) DETERMINATIONS.—In a civil action under this subsection, the
8 court may, as the facts in the case appear—

9 “(A) determine that an applicant is entitled to a registration on
10 the application;

11 “(B) determine that a registration should be canceled; or

12 “(C) determine any other matter as the issues in the civil action
13 require.

14 “(6) NECESSARY ACTION.—An adjudication under this subsection
15 shall authorize the Director to take necessary action on compliance
16 with the requirements of law.

17 “(7) APPLICATION BEFORE USE IN COMMERCE.—A final judgment
18 shall not be entered in favor of an applicant under section 601(b) of
19 this title before the mark is registered if the applicant cannot prevail
20 without establishing constructive use under section 607(e) of this title.

21 **“§ 621. Registration as constructive notice of claim of own-
22 ership**

23 “Registration of a mark on the principal register or under the Act of
24 March 3, 1881 (ch. 138, 21 Stat. 502), or the Act of February 20, 1905
25 (ch. 592, 33 Stat. 724), is constructive notice of the registrant’s claim of
26 ownership of the mark.

27 **“CHAPTER 62—SUPPLEMENTAL REGISTER**

“Sec.

“631. Supplemental register.

“632. Publication and cancellation of marks.

“633. Registration certificates for marks on principal and supplemental registers to be dif-
ferent.

“634. Provisions of title applicable to registrations on supplemental register.

“635. No preclusion of registration on principal register; no admission of nondistinctiveness.

“636. Registration on supplemental register not used to stop importations.

28 **“§ 631. Supplemental register**

29 “(a) MAINTENANCE OF SUPPLEMENTAL REGISTER.—The Director shall
30 keep a continuation of the register provided under section 1(b) of the Act
31 of March 19, 1920 (ch. 104, 41 Stat. 533).

32 “(b) MARKS REGISTRABLE.—

33 “(1) IN GENERAL.—On payment of the prescribed fee and compli-
34 ance with subsections (a) and (c) of section 601 of this title (to the
35 extent that those subsections are applicable), there may be registered
36 on the supplemental register a mark that—

1 “(A) is capable of distinguishing a good or service of the appli-
2 cant;

3 “(B) is not registrable on the principal register;

4 “(C) except as provided in paragraph (2), is not a mark de-
5 scribed in paragraph (1), (2), (3), (4), or (5)(C) of section 602(b)
6 of this title; and

7 “(D) is in lawful use in commerce by the owner of the mark,
8 on or in connection with any good or service.

9 “(2) GEOGRAPHICALLY MISDESCRIPTIVE MARKS IN LAWFUL USE.—
10 Paragraph (1) does not preclude the registration on the supplemental
11 register of a mark that is capable of distinguishing a good or service
12 of the applicant and not registrable on the principal register, but is a
13 mark described in paragraph (5)(C) of section 602(b) of this title, if
14 the mark has been in lawful use in commerce by the owner of the
15 mark, on or in connection with a good or service, since before Decem-
16 ber 8, 1993.

17 “(c) APPLICATION AND EXAMINATION.—

18 “(1) IN GENERAL.—On the filing of an application for registration
19 on the supplemental register and payment of the prescribed fee, the Di-
20 rector shall refer the application to the examiner in charge of the reg-
21 istration of marks for examination.

22 “(2) DETERMINATION OF ENTITLEMENT.—If the examiner deter-
23 mines that the applicant is entitled to registration, the registration
24 shall be granted.

25 “(3) DETERMINATION OF NONENTITLEMENT.—If the examiner de-
26 termines that the applicant is not entitled to registration, section
27 612(c) of this title shall apply.

28 “(d) NATURE OF MARK.—For the purposes of registration on the supple-
29 mental register, a mark—

30 “(1) may consist of any mark, symbol, label, package, configuration
31 of goods, name, word, slogan, phrase, surname, geographical name, nu-
32 meral, device, or matter that as a whole is not functional (or combina-
33 tion thereof); and

34 “(2) shall be capable of distinguishing a good or service of the appli-
35 cant.

36 **“§ 632. Publication and cancellation of marks**

37 “(a) PUBLICATION.—A mark for the supplemental register shall not be
38 subject to opposition, but shall be published on registration in the Official
39 Gazette.

40 “(b) PETITION FOR CANCELLATION.—

1 “(1) FILING.—A person that believes that it is or will be damaged
2 by the registration of a mark on the supplemental register (including
3 as a result of dilution under section 664(c) of this title) may at any
4 time apply to the Director to cancel the registration of the mark by
5 filing a petition that states each ground for cancellation and paying the
6 prescribed fee.

7 “(2) REFERRAL TO BOARD.—On filing of the petition—

8 “(A) the Director shall refer the petition to the Trademark
9 Trial and Appeal Board; and

10 “(B) the Board shall give notice of the petition to the reg-
11 istrant.

12 “(c) DETERMINATION OF NONENTITLEMENT.—If after a hearing the
13 Board determines that the registrant is not entitled to registration or that
14 the mark has been abandoned, the Director shall cancel the registration.

15 “(d) APPLICATION BEFORE USE IN COMMERCE.—A final judgment shall
16 not be entered in favor of an applicant under section 601(b) of this title
17 before the mark is registered, if the applicant cannot prevail without estab-
18 lishing constructive use under section 607(c) of this title.

19 **“§ 633. Registration certificates for marks on principal and**
20 **supplemental registers to be different**

21 “A certificate of registration of a mark registered on the supplemental
22 register shall be conspicuously different from a certificate of registration of
23 a mark on the principal register.

24 **“§ 634. Provisions of title applicable to registrations on sup-**
25 **plemental register**

26 “(a) IN GENERAL.—So far as applicable, the provisions of chapters 51,
27 61, and 63 govern applications for registration, and registrations, on the
28 supplemental register as well as applications for registration, and registra-
29 tions, on the principal register.

30 “(b) INAPPLICABLE PROVISIONS.—An application for registration, or a
31 registration, on the supplemental register is not subject to, and shall not
32 receive the advantages of—

33 “(1) section 601(b) of this title;

34 “(2) subsection (b)(5) or (c) of section 602 of this title;

35 “(3) subsection (b) or (c) of section 607 of this title;

36 “(4) subsections (a) and (b) of section 612 of this title;

37 “(5) sections 613 to 617 of this title;

38 “(6) section 621 of this title;

39 “(7) section 655 of this title; or

40 “(8) section 663 of this title.

1 **“§ 635. No preclusion of registration on principal register;**
2 **no admission of nondistinctiveness**

3 “(a) NO PRECLUSION OF REGISTRATION.—Registration of a mark on the
4 supplemental register or under the Act of March 19, 1920 (ch. 104, 41
5 Stat. 533), does not preclude registration by the registrant on the principal
6 register.

7 “(b) NO ADMISSION OF NONDISTINCTIVENESS.—Registration of a mark
8 on the supplemental register does not constitute an admission that the mark
9 has not acquired distinctiveness.

10 **“§ 636. Registration on supplemental register not used to**
11 **stop importations**

12 “Registration on the supplemental register or under the Act of March 19,
13 1920 (ch. 104, 41 Stat. 533), shall not be filed in the Department of Home-
14 land Security or be used to stop importations.

15 **“CHAPTER 63—PRACTICE, PROCEDURE, AND**
16 **PROHIBITIONS**

“Sec.

“651. Notice of registration; limitation on recovery of profits and damages in infringement
action.

“652. Marks for multiple goods and services.

“653. Fees.

“654. Remedies for infringement.

“655. Registration on principal register as evidence of exclusive right to use mark.

“656. Injunctive relief.

“657. Recovery for violation of rights.

“658. Destruction of violative articles.

“659. Power of court over registration.

“660. Civil liability for false or fraudulent registration.

“661. Jurisdiction of Federal courts; prohibition of State and local requirements.

“662. Regulations for conduct of proceedings in Office.

“663. Prohibition of importation of goods bearing infringing marks or names.

“664. False designations of origin; false descriptions; dilution.

“665. United States registration based on foreign registration pursuant to international con-
vention.

17 **“§ 651. Notice of registration; limitation on recovery of prof-**
18 **its and damages in infringement action**

19 “(a) NOTICE OF REGISTRATION.—Notwithstanding section 621 of this
20 title, a registrant of a registered mark may give notice that a mark is reg-
21 istered by displaying with the mark the words ‘Registered in U.S. Patent
22 and Trademark Office’ or ‘Reg. U.S. Pat. & Tm. Off.’ or the letter R en-
23 closed within a circle, thus ®.

24 “(b) LIMITATION ON RECOVERY OF PROFITS AND DAMAGES IN IN-
25 FRINGEMENT ACTION.—In a civil action for infringement under this subtitle
26 by a registrant that fails to give notice of registration as described in sub-
27 section (a), no profits or damages shall be recovered under this subtitle un-
28 less the defendant had actual notice of the registration.

1 **“§ 652. Marks for multiple goods and services**

2 “(a) CLASSIFICATION.—The Director may by regulation establish a classi-
3 fication of goods and services for the convenience of Office administration
4 but not to limit or extend the applicant’s or registrant’s rights.

5 “(b) APPLICATION COVERING MORE THAN ONE GOOD OR SERVICE.—An
6 applicant may apply to register a mark for any or all of the goods or serv-
7 ices on or in connection with which the applicant is using or has a bona
8 fide intention to use the mark in commerce, and the Director may issue a
9 single certificate of registration for the mark.

10 **“§ 653. Fees**

11 “(a) FOR SERVICES PERFORMED AND MATERIALS FURNISHED.—The Di-
12 rector shall establish fees for the filing and processing of an application for
13 the registration of a mark and for all other services performed by and mate-
14 rials furnished by the Office relating to marks.

15 “(b) ADJUSTMENT.—The Director may adjust fees established under sub-
16 section (a) once each year to reflect, in the aggregate, any fluctuations dur-
17 ing the preceding 12 months in the Consumer Price Index, as determined
18 by the Secretary of Labor. The Director may ignore a fluctuation of less
19 than 1 percent.

20 “(c) EFFECTIVE DATE.—A fee established under this section shall not
21 take effect until at least 30 days after notice of the fee is published in the
22 Federal Register and in the Official Gazette.

23 “(d) APPLICATION COVERING MORE THAN ONE CLASS.—If, under sec-
24 tion 652(b) of this title, the Director permits the filing of an application
25 for the registration of a mark for a good or service that falls within more
26 than one class, the applicant shall pay a fee equal to the sum of the fees
27 for filing an application in each class.

28 “(e) WAIVER.—The Director may waive the payment of a fee for a service
29 or material relating to marks in connection with an occasional request made
30 by a department or agency of the Federal Government or an officer or the
31 department or agency.

32 “(f) EXEMPTION.—The Indian Arts and Crafts Board shall not be
33 charged a fee to register a Government trademark of genuineness and qual-
34 ity for an Indian product or for a product of a particular Indian tribe or
35 group.

36 **“§ 654. Remedies for infringement**

37 “(a) IN GENERAL.—A person that infringes a registered mark is liable
38 in a civil action by the registrant of the registered mark for the remedies
39 provided in this section.

40 “(b) KNOWLEDGE OF INTENT.—A registrant shall not recover profits or
41 damages for infringement described in section 501(11)(B) of this title un-

1 less the acts described in that subparagraph are committed with knowledge
2 that the reproduction, counterfeit, copy, or colorable imitation is intended
3 to be used to cause confusion, cause mistake, or deceive.

4 “(e) LIMITATIONS.—

5 “(1) DEFINITIONS.—In this subsection—

6 “(A) ELECTRONIC COMMUNICATION.—The term ‘electronic com-
7 munication’ has the meaning given the term in section 2510 of
8 title 18.

9 “(B) PERIODICAL.—The term ‘periodical’ means a newspaper,
10 magazine, or similar periodical.

11 “(C) PLAINTIFF.—The term ‘plaintiff’ means—

12 “(i) the owner of a right infringed under this subtitle; and

13 “(ii) a person that brings an action under subsection (a)
14 or (d) of section 664 of this title.

15 “(D) VIOLATING MATTER.—The term ‘violating matter’ means
16 matter that is the subject of a violation under section 664(a) of
17 this title.

18 “(E) VIOLATOR.—The term ‘violator’ means a person that vio-
19 lates section 664(a) of this title.

20 “(2) LIMITATIONS.—Notwithstanding any other provision of this
21 subtitle, the remedies given to the plaintiff are limited as provided in
22 this subsection.

23 “(3) CASE INVOLVING PRINTING.—A plaintiff shall be entitled as
24 against the defendant only to an injunction against future printing if
25 the defendant—

26 “(A) is engaged solely in the business of printing the mark or
27 violating matter for others; and

28 “(B) establishes that the defendant was an innocent infringer
29 or innocent violator.

30 “(4) CASE INVOLVING ADVERTISING.—A plaintiff shall be entitled as
31 against a defendant only to an injunction against the presentation of
32 paid advertising matter in any future issue of a periodical or any future
33 transmission of an electronic communication if—

34 “(A) the infringement or violation is contained in or is part of
35 that paid advertising matter in the periodical or electronic commu-
36 nication;

37 “(B) the defendant is the publisher or distributor of the periodi-
38 cal or electronic communication; and

39 “(C) the defendant establishes that the defendant was an inno-
40 cent infringer or innocent violator.

1 “(5) CASE INVOLVING DELAY IN DELIVERY OR TRANSMISSION.—In-
2 junctive relief is not available to a plaintiff with respect to a particular
3 issue of a periodical or particular electronic communication if—

4 “(A) restraining the dissemination of the infringing matter or
5 violating matter in that issue or communication would delay the
6 delivery of the issue or transmission of the communication after
7 the regular delivery time of the issue or transmission; and

8 “(B) the delay would be due to the method by which publication
9 and distribution of the periodical or transmission of the electronic
10 communication is customarily conducted in accordance with sound
11 business practice and not to any method or device adopted to
12 evade this section or to prevent or delay the issuance of an injunc-
13 tion or restraining order with respect to the infringing matter or
14 violating matter.

15 “(6) CASE INVOLVING A DOMAIN NAME.—

16 “(A) IN GENERAL.—A domain name registrar that takes an ac-
17 tion described in subparagraph (B)—

18 “(i) is not liable for monetary relief to any person for that
19 action, regardless of whether the domain name is finally de-
20 termined to infringe or dilute the mark; and

21 “(ii) is subject to injunctive relief only if the domain name
22 registrar—

23 “(I) does not expeditiously deposit, with a court in
24 which a civil action is brought regarding the disposition
25 of the domain name, documents sufficient for the court
26 to establish the control and authority of the court re-
27 garding the disposition of the registration and use of the
28 domain name; or

29 “(II)(aa) transfers, suspends, or otherwise modifies
30 the domain name during the pendency of the civil action,
31 except on order of the court; or

32 “(bb) willfully fails to comply with such a court order.

33 “(B) ACTION.—An action referred to in subparagraph (A) is an
34 action of refusing to register, removing from registration, transfer-
35 ring, temporarily disabling, or permanently canceling a domain
36 name—

37 “(i) in compliance with a court order under section 664(d)
38 of this title; or

39 “(ii) in the implementation of a reasonable policy by the
40 domain name registrar prohibiting the registration of a do-

1 main name of a person that is identical to, confusingly similar
2 to, or dilutive of the mark of another person.

3 “(C) BAD FAITH.—A domain name registrar is not liable for
4 damages under this section for the registration or maintenance of
5 a domain name for another absent a showing of bad faith intent
6 to profit from the registration or maintenance of the domain
7 name.

8 “(D) KNOWING AND MATERIAL MISREPRESENTATION.—If a do-
9 main name registrar takes an action described under subpara-
10 graph (B) based on a knowing and material misrepresentation by
11 another person that a domain name is identical to, confusingly
12 similar to, or dilutive of a mark—

13 “(i) the person making the knowing and material misrepre-
14 sentation is liable for the damages, costs, and attorney’s fees
15 incurred by the domain name registrant as a result of the ac-
16 tion; and

17 “(ii) the court may also grant injunctive relief to the do-
18 main name registrant, including the reactivation of the do-
19 main name or the transfer of the domain name to the domain
20 name registrant.

21 “(E) CIVIL ACTION TO ESTABLISH REGISTRATION OR USE.—

22 “(i) IN GENERAL.—On notice to the mark owner, a domain
23 name registrant whose domain name has been suspended, dis-
24 abled, or transferred under a policy described in subpara-
25 graph (B)(ii) may bring a civil action to establish that the
26 registration or use of the domain name by the registrant is
27 not unlawful under this subtitle.

28 “(ii) RELIEF.—In a civil action under clause (i), the court
29 may grant injunctive relief to the domain name registrant, in-
30 cluding the reactivation of the domain name or transfer of the
31 domain name to the domain name registrant.

32 “(7) CASE INVOLVING ALTERATION OF A MOTION PICTURE.—

33 “(A) IN GENERAL.—A person that engages in conduct described
34 in section 110(11) of title 17 and that complies with the require-
35 ments set forth in section 110(11) is not liable on account of the
36 conduct for a violation of any right under this subtitle. This sub-
37 paragraph does not preclude liability, nor restrict the defenses or
38 limitations on rights granted under this subtitle, of a person for
39 conduct not described in section 110(11), even if that person also
40 engages in conduct described in section 110(11).

1 “(B) MANUFACTURER, LICENSEE, OR LICENSOR OF TECH-
2 NOLOGY.—A manufacturer, licensee, or licensor of technology that
3 enables the making of limited portions of audio or video content
4 of a motion picture imperceptible as described in subparagraph
5 (A) is not liable on account of the manufacture or license for a
6 violation of any right under this subtitle, if the manufacturer, li-
7 censee, or licensor ensures that the technology provides a clear and
8 conspicuous notice at the beginning of each performance that the
9 performance of the motion picture is altered from the performance
10 intended by the director or copyright holder of the motion picture.

11 “(C) NONAPPLICABILITY OF LIMITATIONS ON LIABILITY.—The
12 limitations on liability in subparagraphs (A) and (B) do not apply
13 to a manufacturer, licensee, or licensor of technology that fails to
14 comply with this paragraph.

15 “(D) APPLICABILITY OF NOTICE REQUIREMENT.—The require-
16 ments under subparagraph (B) to provide notice apply only with
17 respect to technology manufactured after the end of the 180-day
18 period beginning on April 27, 2005.

19 “(E) NO INFERENCE CREATED.—Failure by a manufacturer, li-
20 censee, or licensor of technology to qualify for the exemption under
21 subparagraph (A) or (B) does not create an inference that a man-
22 ufacturer, licensee, or licensor of technology that engages in con-
23 duct described in section 110(11) of title 17 is liable for trade-
24 mark infringement by reason of the conduct.

25 **“§ 655. Registration on principal register as evidence of ex-**
26 **clusive right to use mark**

27 “(a) REGISTRATION AS PRIMA FACIE EVIDENCE OF VALIDITY.—A reg-
28 istration of a mark on the principal register or under the Act of March 3,
29 1881 (ch. 138, 21 Stat. 502), or the Act of February 20, 1905 (ch. 592,
30 33 Stat. 724) that is owned by a party to a civil action—

31 “(1)(A) is admissible in evidence; and

32 “(B) is prima facie evidence of—

33 “(i) the validity of the registered mark and the registration of
34 the mark;

35 “(ii) the registrant’s ownership of the mark; and

36 “(iii) the registrant’s exclusive right to use the registered mark
37 in commerce on or in connection with each good or service speci-
38 fied in the registration, subject to any conditions or limitations
39 stated in the registration; but

40 “(2) does not preclude another person from proving any legal or
41 equitable defense or defect (including those described in subsection

1 (b)(3)(B)) that might have been asserted if the mark had not been reg-
2 istered.

3 “(b) REGISTRATION AS CONCLUSIVE EVIDENCE OF VALIDITY.—

4 “(1) IN GENERAL.—To the extent that the right to use a registered
5 mark has become incontestable under section 615 of this title, the reg-
6 istration is conclusive evidence of—

7 “(A) the validity of the registered mark and the registration of
8 the mark;

9 “(B) the ownership of the mark by the registrant; and

10 “(C) the exclusive right of the registrant to use the registered
11 mark in commerce.

12 “(2) RELATION OF CONCLUSIVE EVIDENCE TO EXCLUSIVE RIGHT.—

13 The conclusive evidence shall relate to the exclusive right to use the
14 mark on or in connection with each good or service specified in an affi-
15 davit filed under section 615 of this title, or a renewal application filed
16 under section 609 of this title if the goods or services specified in the
17 renewal are fewer, subject to any conditions or limitations in the reg-
18 istration or in the affidavit or renewal application,.

19 “(3) PROOF OF INFRINGEMENT; DEFENSES AND DEFECTS.—

20 “(A) IN GENERAL.—The conclusive evidence of the right to use
21 the registered mark is subject to—

22 “(i) proof of infringement; and

23 “(ii) the defenses or defects described in subparagraph (B).

24 “(B) DEFENSES AND DEFECTS.—The defenses or defects re-
25 ferred to in subparagraph (A) are the following:

26 “(i) FRAUD.—The registration or the incontestable right to
27 use the registered mark was obtained fraudulently.

28 “(ii) ABANDONMENT.—The registered mark has been aban-
29 doned by the registrant.

30 “(iii) PERMISSION.—The registered mark is being used by
31 or with the permission of the registrant (or a person in priv-
32 ity with the registrant) so as to misrepresent the source of
33 a good or service on or in connection with which the reg-
34 istered mark is used.

35 “(iv) NAMES; DESCRIPTIVE TERMS; GEOGRAPHIC ORIGIN.—
36 The use by a party of a name, term, or device alleged to be
37 an infringement is a use, otherwise than as a mark, of—

38 “(I) the party’s individual name in the party’s own
39 business;

40 “(II) the individual name of any other person in priv-
41 ity with the party; or

1 “(III) a term or device that is descriptive of and used
2 fairly and in good faith only to describe a good or service
3 of the party or the geographic origin of a good or service
4 of the party.

5 “(v) NO KNOWLEDGE OF PRIOR USE.—

6 “(I) IN GENERAL.—The mark, the use of which is al-
7 leged to be an infringement, was adopted by the party
8 without knowledge of the prior use by the registrant, and
9 the mark has been continuously used by the party (or
10 another person in privity with the party) since a date be-
11 fore—

12 “(aa) the date of constructive use of the mark es-
13 tablished under section 607(e) of this title;

14 “(bb) the registration of the mark under this sub-
15 title, if the application for registration was filed be-
16 fore November 16, 1989; or

17 “(cc) publication of the registered mark under
18 section 612(d) of this title.

19 “(II) LIMITATION TO AREA.—The defense or defect
20 under subclause (I) applies only with respect to the area
21 in which the continuous prior use is proved.

22 “(vi) PRIOR REGISTRATION.—

23 “(I) IN GENERAL.—The mark, the use of which is al-
24 leged to be an infringement—

25 “(aa) was registered and used before the registra-
26 tion under this subtitle or publication under section
27 612(d) of this title of the registered mark of the
28 registrant; and

29 “(bb) has not been abandoned.

30 “(II) LIMITATION TO AREA.—The defense or defect
31 under subclause (I) applies only with respect to the area
32 in which the mark was used before registration or publi-
33 cation of the registrant’s mark.

34 “(vii) VIOLATION OF ANTITRUST LAW.—The registered
35 mark has been or is being used to violate an antitrust law
36 of the United States.

37 “(viii) FUNCTIONALITY.—The registered mark is func-
38 tional.

39 “(ix) EQUITABLE PRINCIPLES.—An equitable principle (in-
40 cluding laches, estoppel, and acquiescence) is applicable.

1 **“§ 656. Injunctive relief**

2 “(a) JURISDICTION TO GRANT AND ENFORCE INJUNCTION.—

3 “(1) IN GENERAL.—In a civil action under this subtitle, the court
4 may grant an injunction, according to the principles of equity and on
5 terms that the court considers reasonable, to prevent the violation of
6 a right of the registrant of a registered mark or to prevent a violation
7 under subsection (a), (c) or (d) of section 664 of this title.

8 “(2) PROVISIONS OF INJUNCTION.—An injunction under paragraph
9 (1) may direct the defendant to file with the court and serve on the
10 plaintiff within 30 days after the injunction is served on the defendant
11 (or within any such extended period as the court may direct) a report
12 in writing under oath that describes in detail the manner and form in
13 which the defendant has complied with the injunction.

14 “(3) SERVICE AND ENFORCEMENT OF INJUNCTION.—An injunction
15 granted on hearing, after notice to the defendant, by a United States
16 district court—

17 “(A) may be served on the parties against which the injunction
18 is granted anywhere in the United States where those parties may
19 be found; and

20 “(B) may be enforced by proceedings to punish for contempt,
21 or otherwise, by the court by which the injunction was granted or
22 by another United States district court in the jurisdiction the de-
23 fendant may be found.

24 “(b) JURISDICTION OF COURTS OTHER THAN GRANTING COURT.—

25 “(1) IN GENERAL.—A court described in subsection (a) has jurisdic-
26 tion to enforce the injunction, as provided in this subtitle, as fully as
27 if the injunction had been granted by the district court in which the
28 injunction is sought to be enforced.

29 “(2) DELIVERY OF RECORD.—If required by the court before which
30 application to enforce the injunction is made, the clerk of the court or
31 judge granting the injunction shall transfer without delay to the court
32 to which the application is made a certified copy of the record on which
33 the injunction was granted.

34 “(c) DUTIES OF CLERKS OF COURTS AND DIRECTOR.—

35 “(1) NOTICE.—

36 “(A) IN GENERAL.—Not later than one month after the filing
37 of a civil action or other proceeding involving a registered mark,
38 the clerk of a court described in subsection (a) shall give notice
39 of the filing, in writing, to the Director.

40 “(B) CONTENTS.—The notice shall disclose—

1 “(i) in order, so far as known, the names and addresses of
2 the parties to the proceeding; and

3 “(ii) the designating number of the registration on which
4 the proceeding was brought.

5 “(2) ADDITIONAL REGISTRATIONS.—The clerk shall give notice as
6 provided in paragraph (1) of any additional registration subsequently
7 included in the proceeding by amendment, answer, or other pleading.

8 “(3) JUDGMENT.—

9 “(A) NOTICE.—Not later than one month after judgment is en-
10 tered or an appeal is taken, the clerk of the court shall give notice
11 of the judgment or appeal to the Director.

12 “(B) ENDORSEMENT.—On receipt of the notice, the Director
13 shall immediately record the judgment or appeal in the registra-
14 tion file.

15 “(d) COUNTERFEIT MARKS.—

16 “(1) DEFINITION.—In this subsection—

17 “(A) IN GENERAL.—The term ‘counterfeit mark’ means—

18 “(i) a counterfeit of a mark that is registered on the prin-
19 cipal register for a good or service that is sold, offered for
20 sale, or distributed and that is in use, without regard to
21 whether the person against which relief is sought knew the
22 mark was registered; and

23 “(ii) a spurious designation that is identical to, or substan-
24 tially indistinguishable from, a designation with respect to
25 which the remedies of this subtitle are made available by rea-
26 son of section 220506 of title 36.

27 “(B) EXCLUSION.—The term ‘counterfeit mark’ does not in-
28 clude a mark or designation used on or in connection with a good
29 or service of which the manufacturer or producer, at the time of
30 the manufacture or production in question, was authorized, by the
31 holder of the right to use the mark or designation, to use the
32 mark or designation for the type of good or service manufactured
33 or produced.

34 “(2) SEIZURE OF GOODS, MARKS, AND RECORDS.—In the case of a
35 civil action under section 654(a) of this title for infringement described
36 in section 501(11)(A) of this title, or under section 220506 of title 36,
37 with respect to a violation that consists of using a counterfeit mark in
38 connection with the sale, offering for sale, or distribution of a good or
39 service, the court, on ex parte application, may grant an order under
40 subsection (a) providing for the seizure of goods and counterfeit marks
41 involved in the violation, the means of making the marks, and records

1 documenting the manufacture, sale, or receipt of things involved in the
2 violation.

3 “(3) POTENTIAL PROSECUTION.—

4 “(A) NOTICE TO UNITED STATES ATTORNEY.—The court shall
5 not receive an application under this subsection unless the appli-
6 cant has given notice of the application that is reasonable under
7 the circumstances to the United States attorney for the district in
8 which the order is sought.

9 “(B) PARTICIPATION.—The United States attorney may partici-
10 pate in the proceedings arising under the application if the pro-
11 ceedings may affect evidence of an offense against the United
12 States.

13 “(C) DENIAL OF APPLICATION.—The court may deny the appli-
14 cation if the court determines that the public interest in a poten-
15 tial prosecution requires that the application be denied.

16 “(4) BASIS AND CONTENTS OF APPLICATION.—The application for
17 an order under this subsection shall—

18 “(A) be based on an affidavit or a verified complaint establish-
19 ing facts sufficient to support the findings of fact and conclusions
20 of law required for the order under paragraph (6)(A); and

21 “(B) contain the information required by paragraph (6)(B) to
22 be contained in the order.

23 “(5) CRITERIA FOR GRANTING APPLICATION.—The court shall not
24 grant the application unless—

25 “(A) the person obtaining an order provides security determined
26 by the court to be adequate for the payment of damages that a
27 person may be entitled to recover as a result of a wrongful seizure
28 or wrongful attempted seizure under this subsection; and

29 “(B) the court finds that it clearly appears from specific facts
30 that—

31 “(i) an order other than an ex parte seizure order is not
32 adequate to achieve the purposes of section 654 of this title;

33 “(ii) the applicant has not publicized the requested seizure;

34 “(iii) the applicant is likely to succeed in showing that the
35 person against which seizure would be ordered used a coun-
36 terfeit mark in connection with the sale, offering for sale, or
37 distribution of a good or service;

38 “(iv) an immediate and irreparable injury will occur if the
39 seizure is not ordered;

40 “(v) the material to be seized will be located at the place
41 identified in the application;

1 “(vi) the harm to the applicant of denying the application
2 outweighs the harm to the legitimate interests of the person
3 against which seizure would be ordered of granting the appli-
4 cation; and

5 “(vii) the person against which seizure would be ordered,
6 or a person acting in concert with the person, would destroy,
7 move, hide, or otherwise make the material inaccessible to the
8 court, if the applicant were to proceed on notice to the per-
9 son.

10 “(6) CONTENTS OF ORDER.—An order under this subsection shall
11 contain—

12 “(A) the findings of fact and conclusions of law required for the
13 order;

14 “(B) a particular description of the material to be seized, and
15 a description of each place at which the material is to be seized;

16 “(C) the time period, which shall end not later than 7 days after
17 the date on which the order is issued, during which the seizure
18 is to be made;

19 “(D) the amount of security required to be provided under this
20 subsection; and

21 “(E) a date for the hearing required under paragraph (11).

22 “(7) PROTECTION AGAINST PUBLICITY.—The court shall take appro-
23 priate action to protect the person against which an order under this
24 subsection is directed from publicity, by or at the behest of the plain-
25 tiff, about the order and any seizure under the order.

26 “(8) SEIZURE OF MATERIAL.—

27 “(A) CUSTODY.—Material seized under this subsection shall be
28 taken into the custody of the court.

29 “(B) PROTECTIVE ORDER.—

30 “(i) IN GENERAL.—The court shall enter an appropriate
31 protective order with respect to discovery by the applicant of
32 any records that are seized.

33 “(ii) CONTENTS.—The protective order shall provide for
34 appropriate procedures to ensure that confidential informa-
35 tion contained in the records is not improperly disclosed to
36 the applicant.

37 “(9) ORDER UNDER SEAL.—

38 “(A) IN GENERAL.—An order under this subsection and the
39 documents supporting the order shall be sealed until the person
40 against which the order is directed has an opportunity to contest
41 the order.

1 “(B) ACCESS.—After the seizure has been carried out, a person
2 against which the order is issued shall have access to the order
3 and supporting documents.

4 “(10) SERVICE AND CARRYING OUT OF ORDER.—

5 “(A) IN GENERAL.—The court shall order that service of a copy
6 of an order under this subsection shall be made by a Federal law
7 enforcement officer (such as a United States marshal or an officer
8 or agent of the United States Bureau of Customs and Border Pro-
9 tection, the United States Secret Service, the Federal Bureau of
10 Investigation, or the United States Postal Service) or may be
11 made by a State or local law enforcement officer, who, on making
12 service, shall carry out the seizure under the order.

13 “(B) PROTECTIVE ORDER.—The court shall issue an order, if
14 appropriate, to protect the defendant from undue damage from the
15 disclosure of trade secrets or other confidential information during
16 the course of the seizure, including, if appropriate, an order re-
17 stricting the access of the applicant (or any agent or employee of
18 the applicant) to the secrets or other information.

19 “(11) HEARING.—

20 “(A) IN GENERAL.—Unless a hearing is waived by all parties,
21 the court shall hold a hearing as set by the court in the order of
22 seizure.

23 “(B) HEARING DATE.—The hearing shall be held not earlier
24 than 10 nor later than 15 days after the order is issued, unless
25 the applicant shows good cause for another date or unless the per-
26 son against which the order is directed consents to another date.

27 “(C) BURDEN OF PROOF.—At the hearing the party obtaining
28 the order shall have the burden to prove that the facts supporting
29 findings of fact and conclusions of law necessary to support the
30 order remain in effect. If that party fails to meet that burden, the
31 seizure order shall be dissolved or modified appropriately.

32 “(D) DISCOVERY.—In connection with a hearing under this
33 paragraph, the court may make orders modifying the time limits
34 for discovery under the Federal Rules of Civil Procedure (28 App.
35 U.S.C.) as are necessary to prevent frustration of the purposes of
36 the hearing.

37 “(12) WRONGFUL SEIZURE.—A person that suffers damage by rea-
38 son of a wrongful seizure under this subsection may bring a civil action
39 against the person obtaining the order of seizure to recover appropriate
40 relief, including—

1 “(A) damages for lost profits, cost of materials, and loss of
2 goodwill;

3 “(B) punitive damages, if the seizure was sought in bad faith;

4 “(C) unless the court finds extenuating circumstances, a reason-
5 able attorney’s fee; and

6 “(D) in the discretion of the court, prejudgment interest on the
7 amount of relief recovered at an annual interest rate established
8 under section 6621(a)(2) of the Internal Revenue Code of 1986
9 (26 U.S.C. 6621(a)(2)) for—

10 “(i) the period commencing on the date of service of the
11 pleading containing a claim for prejudgment interest and end-
12 ing on the date on which judgment is entered; or

13 “(ii) such shorter period as the court considers appropriate.

14 **“§ 657. Recovery for violation of rights**

15 “(a) AMOUNT OF RECOVERY IN GENERAL.—

16 “(1) IN GENERAL.—If a violation of a right of the registrant of a
17 registered mark, a violation under section 664(a) or (d) of this title,
18 or a willful violation under section 664(c) of this title is established in
19 a civil action arising under this subtitle, the plaintiff, subject to sec-
20 tions 651 and 654 of this title, and subject to the principles of equity,
21 is entitled to recover—

22 “(A) defendant’s profits;

23 “(B) any damages sustained by the plaintiff; and

24 “(C) the costs of the civil action.

25 “(2) ASSESSMENT OF PROFITS AND DAMAGES.—

26 “(A) IN GENERAL.—The court shall assess profits and damages
27 or cause profits and damages to be assessed under the direction
28 of the court.

29 “(B) PROFITS.—

30 “(i) PROOF.—In assessing profits—

31 “(I) the plaintiff shall be required to prove defendant’s
32 sales only; and

33 “(II) the defendant shall be required to prove all ele-
34 ments of cost or deduction claimed.

35 “(ii) ADJUSTMENT OF INADEQUATE OR EXCESSIVE PROF-
36 ITS.—If the court finds that the amount of the recovery based
37 on profits is inadequate or excessive, the court may enter
38 judgment for the amount that the court finds to be just, ac-
39 cording to the circumstances of the case.

1 “(iii) NATURE OF RECOVERY.—An amount entered in judg-
2 ment under this subparagraph constitutes compensation and
3 is not a penalty.

4 “(C) DAMAGES.—In assessing damages, the court may enter
5 judgment, according to the circumstances of the case, for more
6 than the amount found as actual damages but not exceeding 3
7 times that amount.

8 “(3) ATTORNEY’S FEE.—The court in an exceptional case may
9 award a reasonable attorney’s fee to the prevailing party.

10 “(4) INTENTIONAL USE OF COUNTERFEIT MARK.—In a case of a vio-
11 lation of section 654(a) of this title constituting infringement described
12 in section 501(11)(A) of this title, or of section 220506 of title 36, that
13 consists of intentionally using a mark or designation, knowing that the
14 mark or designation is a counterfeit mark (as defined in section 656(d)
15 of this title), in connection with the sale, offering for sale, or distribu-
16 tion of a good or service, unless the court finds extenuating circum-
17 stances, the court—

18 “(A) shall enter judgment for—

19 “(i) if the amount of profits is greater than the amount of
20 damages—

21 “(I) 3 times the amount of profits;

22 “(II) the amount of damages;

23 “(III) the costs of the civil action; plus

24 “(IV) a reasonable attorney’s fee; or

25 “(ii) if the amount of damages is greater than the amount
26 of profits—

27 “(I) 3 times the amount of damages;

28 “(II) the amount of profits;

29 “(III) the costs of the civil action; plus

30 “(IV) a reasonable attorney’s fee; and

31 “(B) may award prejudgment interest on the amount of relief
32 recovered at an annual interest rate established under section
33 6621(a)(2) of the Internal Revenue Code of 1986 (26 U.S.C.
34 6621(a)(2)) for—

35 “(i) the period commencing on the date of service of the
36 pleading containing a claim for prejudgment interest and end-
37 ing on the date on which judgment is entered; or

38 “(ii) such shorter period as the court considers appropriate.

39 “(b) STATUTORY DAMAGES FOR USE OF COUNTERFEIT MARK.—In a
40 case involving the use of a counterfeit mark (as defined in section 656(d)
41 of this title) in connection with the sale, offering for sale, or distribution

1 of a good or service, the plaintiff may elect, at any time before final judg-
2 ment is rendered by the trial court, to recover, instead of the amount of
3 profits and damages under subsection (a), an award of statutory damages
4 in the amount of—

5 “(1) not less than \$500 nor more than \$100,000 per counterfeit
6 mark per type of good or service sold, offered for sale, or distributed,
7 as the court considers just; or

8 “(2) if the court finds that the use of the counterfeit mark was will-
9 ful, not more than \$1,000,000 per counterfeit mark per type of good
10 or service sold, offered for sale, or distributed, as the court considers
11 just.

12 “(c) STATUTORY DAMAGES FOR CYBERSPACE PIRACY.—In a case involv-
13 ing a violation of section 664(d)(1) of this title, the plaintiff may elect, at
14 any time before final judgment is rendered by the trial court, to recover,
15 instead of the amount of profits and damages under subsection (a), an
16 award of statutory damages in the amount of not less than \$1,000 nor more
17 than \$100,000 per domain name, as the court considers just.

18 “(d) PROVISION OF FALSE CONTACT INFORMATION TO DOMAIN NAME
19 REGISTRAR.—

20 “(1) IN GENERAL.—There is a rebuttable presumption that a viola-
21 tion described in this section is willful if the violator (or a person acting
22 in concert with the violator) knowingly provides (or knowingly causes
23 to be provided) materially false contact information to a domain name
24 registrar in registering, maintaining, or renewing a domain name used
25 in connection with the violation.

26 “(2) EFFECT OF SUBSECTION.—This subsection does not limit what
27 may be considered to be a willful violation under this section.

28 **“§ 658. Destruction of violative articles**

29 “(a) IN GENERAL.—In a civil action under this subtitle in which a viola-
30 tion of a right of the registrant of a registered mark, a violation under sec-
31 tion 664(a) of this title, or a willful violation under section 664(c) of this
32 title is established, the court may order that the articles described in sub-
33 section (b) be destroyed.

34 “(b) VIOLATIVE ARTICLES.—The articles referred to in subsection (a)
35 are—

36 “(1) all labels, signs, prints, packages, wrappers, receptacles, and ad-
37 vertisements in the possession of the defendant—

38 “(A) that bear the registered mark; or

39 “(B) in the case of a violation of section 664(a) of this title or
40 a willful violation under section 664(c) of this title, that bear the
41 word, term, name, symbol, or device (or combination thereof), des-

1 ignation, description, or representation that is the subject of the
2 violation;

3 “(2) all reproductions, counterfeits, copies, and colorable imitations
4 of an article described in paragraph (1); and

5 “(3) all plates, molds, matrices, and other means of making any arti-
6 cle described in paragraph (1) or (2).

7 “(e) EVIDENCE OF OFFENSE.—

8 “(1) NOTICE TO UNITED STATES ATTORNEY.—A party seeking an
9 order under this section for destruction of articles seized under section
10 656(d) of this title shall give 10 days’ notice to the United States at-
11 torney for the district in which the order is sought (unless good cause
12 is shown for less notice).

13 “(2) PARTICIPATION.—If the destruction may affect evidence of an
14 offense against the United States, the United States attorney may seek
15 a hearing on the destruction or participate in a hearing otherwise to
16 be held with respect to the destruction.

17 **“§ 659. Power of court over registration**

18 “(a) IN GENERAL.—In a civil action involving a registered mark, the
19 court may enter an order to—

20 “(1) determine the right to registration;

21 “(2) cancel any part of a registration or restore a canceled registra-
22 tion; and

23 “(3) otherwise rectify the register with respect to the registration of
24 a party to the civil action.

25 “(b) CERTIFICATION TO THE DIRECTOR.—The court shall certify an
26 order under subsection (a) to the Director, and the Director shall make ap-
27 propriate entry on the records of the Office and shall be controlled by the
28 entry.

29 **“§ 660. Civil liability for false or fraudulent registration**

30 “A person that procures registration in the Office of a mark by a false
31 or fraudulent declaration or representation, oral or in writing, or by any
32 false means, is liable in a civil action by a person injured by that act for
33 damages sustained in consequence of that act.

34 **“§ 661. Jurisdiction of Federal courts; prohibition of State
35 and local requirements**

36 “(a) JURISDICTION OF FEDERAL COURTS.—The United States district
37 courts and the territorial courts of the United States have original jurisdic-
38 tion, and the courts of appeals of the United States (other than the United
39 States Court of Appeals for the Federal Circuit) have appellate jurisdiction,
40 over all civil actions arising under this subtitle, without regard to the

1 amount in controversy or to diversity or lack of diversity of the citizenship
2 of the parties.

3 “(b) PROHIBITION OF STATE AND LOCAL REQUIREMENTS.—A State,
4 other jurisdiction of the United States, or political subdivision or agency of
5 a State or other jurisdiction of the United States shall not require—

6 “(1) alteration of a registered mark; or

7 “(2) that an additional mark, trade name, or corporate name that
8 may be associated with or incorporated into the registered mark be dis-
9 played in the mark in a manner differing from the display of the addi-
10 tional mark, trade name, or corporate name contemplated by the reg-
11 istered mark as exhibited in the certificate of registration issued by the
12 Office.

13 **“§ 662. Regulations for conduct of proceedings in Office**

14 “The Director shall prescribe regulations, not inconsistent with law, for
15 the conduct of proceedings in the Office under this subtitle.

16 **“§ 663. Prohibition of importation of goods bearing infring-
17 ing marks or names**

18 “(a) ARTICLES NOT TO BE ADMITTED.—Except as provided in section
19 526(d) of the Tariff Act of 1930 (19 U.S.C. 1526(d)), an article of im-
20 ported merchandise shall not be admitted to entry at a customs house of the
21 United States if the article—

22 “(1) copies or simulates—

23 “(A) the name of a domestic manufacture, manufacturer, or
24 trader; or

25 “(B) a manufacturer or trader located in a foreign country that,
26 by treaty, convention, or law affords similar privileges to citizens
27 of the United States;

28 “(2) copies or simulates a trademark registered in accordance with
29 this subtitle; or

30 “(3) bears a name or mark calculated to induce the public to believe
31 that the article is manufactured in the United States or in a foreign
32 country or locality other than the country or locality in which the arti-
33 cle is manufactured.

34 “(b) ENFORCEMENT.—

35 “(1) PROVISION OF INFORMATION.—A domestic manufacturer or
36 trader, or a foreign manufacturer or trader entitled under the provi-
37 sions of a treaty, convention, declaration, or agreement between the
38 United States and any foreign country to the advantages afforded by
39 law to citizens of the United States in respect to trademarks and trade
40 names may—

1 “(A) require that its name and residence, the name of the local-
2 ity in which its goods are manufactured, and a copy of the certifi-
3 cate of registration of its trademark, issued in accordance with
4 this subtitle, be recorded in books that the Secretary of Homeland
5 Security shall keep under regulations that the Secretary shall pre-
6 scribe; and

7 “(B) may provide the Secretary of Homeland Security with fac-
8 similes of its name, the name of the locality in which its goods
9 are manufactured, or of its registered trademark.

10 “(2) DISSEMINATION.—On receipt of information under paragraph
11 (1), the Secretary of Homeland Security shall cause the information to
12 be disseminated to the appropriate customs officers.

13 **“§ 664. False designations of origin; false descriptions; dilu-**
14 **tion**

15 “(a) USE OF FALSE DESIGNATION OF ORIGIN OR FALSE OR MISLEADING
16 DESCRIPTION OR REPRESENTATION OF FACT.—

17 “(1) CIVIL ACTION.—A person that, on or in connection with a good
18 or service, or a container for a good, uses in commerce a word, term,
19 name, symbol, or device (or combination thereof), or a false designation
20 of origin, false or misleading description of fact, or false or misleading
21 representation of fact, that—

22 “(A) is likely to cause confusion, cause mistake, or deceive, con-
23 cerning—

24 “(i) the affiliation, connection, or association of that person
25 with another person; or

26 “(ii) the origin, sponsorship, or approval by another person
27 of a good, service, or commercial activity of that person; or

28 “(B) in commercial advertising or promotion, misrepresents the
29 nature, characteristics, qualities, or geographic origin of a good,
30 service, or commercial activity of that person or any other person;
31 “shall be liable in a civil action by a person that believes that it is or
32 is likely to be damaged by that act.

33 “(2) BURDEN OF PROOF.—In a civil action for trade dress infringe-
34 ment under this subtitle for trade dress not registered on the principal
35 register, the person that asserts trade dress protection has the burden
36 of proving that the matter sought to be protected is not functional.

37 “(b) PROHIBITION OF IMPORTATION.—

38 “(1) IN GENERAL.—A good that is marked or labeled in violation of
39 this section shall not be imported into the United States or admitted
40 to entry at any customhouse of the United States.

1 “(2) RECOURSE.—The owner, importer, or consignee of a good re-
2 fused entry at any customhouse under paragraph (1) may have—

3 “(A) any recourse by protest or appeal that is given under the
4 customs revenue laws; or

5 “(B) the remedy provided by section 656(d) of this title in cases
6 involving goods refused entry or seized.

7 “(e) DILUTION.—

8 “(1) IN GENERAL.—Subject to paragraph (5) and to principles of eq-
9 uity and on terms that the court considers reasonable, the owner of a
10 famous mark is entitled to relief as provided under paragraph (3)
11 against another person’s use in commerce of a mark or trade name if
12 the use begins after the mark has become famous and causes dilution
13 of the distinctive quality of the mark.

14 “(2) CONSIDERATIONS.—In determining whether a mark is distinc-
15 tive and famous, a court may consider factors such as—

16 “(A) the degree of inherent or acquired distinctiveness of the
17 mark;

18 “(B) the duration and extent of use of the mark in connection
19 with the good or service with which the mark is used;

20 “(C) the duration and extent of advertising and publicity of the
21 mark;

22 “(D) the geographical extent of the trading area in which the
23 mark is used;

24 “(E) the channels of trade for the good or service with which
25 the mark is used;

26 “(F) the degree of recognition of the mark in the trading areas
27 and channels of trade used by the owner of the mark and by the
28 person against which the injunction is sought;

29 “(G) the nature and extent of use of the same mark or similar
30 marks by third parties; and

31 “(H) whether the mark was registered on the principal register
32 or under the Act of March 3, 1881 (ch. 138, 21 Stat. 502), or
33 the Act of February 20, 1905 (ch. 592, 33 Stat. 724).

34 “(3) RELIEF.—In a civil action under this subsection, the owner of
35 the famous mark—

36 “(A) is entitled only to injunctive relief as provided in section
37 656 of this title unless the person against which the injunction is
38 sought willfully intended to trade on the owner’s reputation or to
39 cause dilution of the famous mark; or

40 “(B) if willful intent is proven, is entitled to injunctive relief as
41 provided in section 656 of this title and to the remedies provided

1 under sections 657(a) and 658 of this title, subject to the discre-
2 tion of the court and principles of equity.

3 “(4) DEFENSE OF VALID REGISTRATION.—The ownership by a per-
4 son of a valid registration on the principal register or under the Act
5 of March 3, 1881 (ch. 138, 21 Stat. 502), or the Act of February 20,
6 1905 (ch. 592, 33 Stat. 724), is a complete defense to a civil action
7 against that person, with respect to that mark, that is brought by an-
8 other person under the common law or a statute of a State and that
9 seeks to prevent dilution of the distinctiveness of a mark, label, or form
10 of advertisement.

11 “(5) FAIR USE, NONCOMMERCIAL USE, AND NEWS REPORTING AND
12 COMMENTARY NONACTIONABLE.—The following are not actionable
13 under this section:

14 “(A) Fair use of a famous mark by another person in compara-
15 tive commercial advertising or promotion to identify the competing
16 good or service of the owner of the famous mark.

17 “(B) Noncommercial use of a mark.

18 “(C) All forms of news reporting and news commentary.

19 “(d) CYBERSPACE PIRACY.—

20 “(1) LIABILITY.—

21 “(A) DEFINITION.—In this paragraph, the term ‘traffic’ means
22 to engage in a transaction such as a sale, purchase, loan, pledge,
23 license, exchange of currency, or other transfer for consideration
24 or receipt in exchange for consideration.

25 “(B) LIABILITY.—A person is liable in a civil action by the
26 owner of a mark (including a personal name that is protected as
27 a mark under this section) if, without regard to the goods or serv-
28 ices of the parties, the person—

29 “(i) has a bad faith intent to profit from the mark; and

30 “(ii) registers, traffics in, or uses a domain name that—

31 “(I) in the case of a mark that is distinctive at the
32 time of registration of the domain name, is identical or
33 confusingly similar to that mark;

34 “(II) in the case of a famous mark that is famous at
35 the time of registration of the domain name, is identical
36 or confusingly similar to or dilutive of that mark; or

37 “(III) is a trademark, word, or name protected under
38 section 706 of title 18 or section 220506 of title 36.

39 “(C) BAD FAITH.—

1 “(i) FACTORS IN DETERMINING BAD FAITH.—In determin-
2 ing whether a person has a bad faith intent described under
3 subparagraph (B), a court may consider factors such as—

4 “(I) the mark or other intellectual property rights of
5 the person in the domain name;

6 “(II) the extent to which the domain name consists of
7 the legal name of the person or a name that is otherwise
8 commonly used to identify that person;

9 “(III) the person’s prior use of the domain name in
10 connection with the bona fide offering of any good or
11 service;

12 “(IV) the person’s bona fide noncommercial or fair use
13 of the mark in a site accessible under the domain name;

14 “(V) the person’s intent to divert consumers from the
15 mark owner’s online location to a site accessible under
16 the domain name that could harm the goodwill rep-
17 resented by the mark, either for commercial gain or with
18 the intent to tarnish or disparage the mark, by creating
19 a likelihood of confusion as to the source, sponsorship,
20 affiliation, or endorsement of the site;

21 “(VI) the person’s offer to transfer, sell, or otherwise
22 assign the domain name to the mark owner or any third
23 party for financial gain without having used, or having
24 an intent to use, the domain name in the bona fide offer-
25 ing of any good or service, or the person’s prior conduct
26 indicating a pattern of that conduct;

27 “(VII) the person’s provision of material and mislead-
28 ing false contact information when applying for the reg-
29 istration of the domain name, the person’s intentional
30 failure to maintain accurate contact information, or the
31 person’s prior conduct indicating a pattern of that con-
32 duct;

33 “(VIII) without regard to the goods or services of the
34 parties, the person’s registration or acquisition of mul-
35 tiple domain names that the person knows are—

36 “(aa) identical or confusingly similar to marks of
37 other persons that are distinctive at the time of reg-
38 istration of the domain names; or

39 “(bb) dilutive of famous marks of other persons
40 that are famous at the time of registration of the
41 domain names; and

1 “(IX) the extent to which the mark incorporated in
2 the person’s domain name registration is or is not dis-
3 tinctive and famous (within the meaning of subsection
4 (e)(2)).

5 “(ii) DEFENSE TO FINDING OF BAD FAITH.—Bad faith in-
6 tent on the part of a person shall not be found if the court
7 determines that the person believed and had reasonable
8 grounds to believe that the use of the domain name was a fair
9 use or was otherwise lawful.

10 “(D) ORDER OF FORFEITURE, CANCELLATION, OR TRANSFER
11 OF DOMAIN NAME.—In a civil action involving the registration,
12 trafficking, or use of a domain name under this paragraph, a
13 court may order the forfeiture or cancellation of the domain name
14 or the transfer of the domain name to the owner of the mark.

15 “(E) REQUIREMENT FOR FINDING OF LIABILITY.—A person is
16 liable for using a domain name under subparagraph (B) only if
17 the person is the domain name registrant or an authorized licensee
18 of the registrant.

19 “(2) IN REM ACTION.—

20 “(A) IN GENERAL.—The owner of a mark may bring an in rem
21 action against a domain name in the judicial district in which the
22 domain name registrar that registered or assigned the domain
23 name is located if—

24 “(i) the domain name violates any right of the owner of a
25 registered mark or a right protected under subsection (a) or
26 (c); and

27 “(ii) the court finds that the owner—

28 “(I) is not able to obtain in personam jurisdiction over
29 a person that would be a proper defendant in a civil ac-
30 tion under paragraph (1); or

31 “(II) has not been able to locate a person that would
32 be a proper defendant in a civil action under paragraph
33 (1) through due diligence by—

34 “(aa) sending a notice of the alleged violation and
35 intent to proceed under this paragraph to the do-
36 main name registrant at the postal address and
37 email address provided by the domain name reg-
38 istrant to the domain name registrar; and

39 “(bb) publishing notice of the civil action as the
40 court may direct promptly after bringing the civil
41 action.

1 “(B) SERVICE OF PROCESS.—The actions under subparagraph
2 (A)(ii) constitute service of process.

3 “(C) VENUE.—In an in rem action under this paragraph, a do-
4 main name is deemed to have its situs in the judicial district in
5 which—

6 “(i) the domain name registrar that registered or assigned
7 the domain name is located; or

8 “(ii) records sufficient to establish control and authority re-
9 garding the disposition of the registration and use of the do-
10 main name are deposited with the court.

11 “(D) REMEDIES.—

12 “(i) FORFEITURE, CANCELLATION, OR TRANSFER OF DO-
13 MAIN NAME.—

14 “(I) IN GENERAL.—The remedies in an in rem action
15 under this paragraph shall be limited to a court order
16 for—

17 “(aa) the forfeiture or cancellation of the domain
18 name; or

19 “(bb) the transfer of the domain name to the
20 owner of the mark.

21 “(II) DUTIES OF DOMAIN NAME REGISTRAR.—On re-
22 ceipt of written notification of a filed, stamped copy of
23 a complaint filed by the owner of a mark in a United
24 States district court under this paragraph, the domain
25 name registrar—

26 “(aa) shall expeditiously deposit with the court
27 records sufficient to establish the court’s control
28 and authority regarding the disposition of the reg-
29 istration and use of the domain name; and

30 “(bb) shall not transfer, suspend, or otherwise
31 modify the domain name during the pendency of the
32 action except on order of the court.

33 “(ii) INJUNCTIVE OR MONETARY RELIEF.—A domain name
34 registrar is not liable for injunctive or monetary relief under
35 this paragraph except in a case of bad faith or reckless dis-
36 regard (including a willful failure to comply with an order
37 under clause (i)(II)(bb)).

38 “(3) OTHER ACTIONS AND REMEDIES.—The availability of a civil ac-
39 tion under paragraph (1) or an in rem action under paragraph (2) and
40 of any remedy available under paragraph (1) or (2) is in addition to
41 any other civil action or remedy that is available.

1 “(4) OTHER JURISDICTION.—The in rem jurisdiction established
2 under paragraph (2) is in addition to any other in rem or in personam
3 jurisdiction that exists.

4 **“§ 665. United States registration based on foreign registra-**
5 **tion pursuant to international convention**

6 “(a) DEFINITION.—In this section, the term ‘country of origin’, with re-
7 spect to an applicant, means—

8 “(1) the country in which the applicant has a bona fide and effective
9 industrial or commercial establishment; or

10 “(2) if the applicant does not have a bona fide and effective indus-
11 trial or commercial establishment—

12 “(A) the country in which the applicant is domiciled; or

13 “(B) if the applicant does not have a domicile in any of the
14 countries described in subsection (c), the country of which the ap-
15 plicant is a national.

16 “(b) REGISTRATION OF MARKS COMMUNICATED BY INTERNATIONAL BU-
17 REAUS.—

18 “(1) MAINTENANCE OF REGISTER.—The Director shall register on
19 the principal register or supplemental register, as appropriate, all
20 marks communicated to the Director by the international bureaus pro-
21 vided for by the conventions for the protection of industrial property,
22 marks, and trade names, and the repression of unfair competition, to
23 which the United States is a party.

24 “(2) PAYMENT OF FEES.—On the payment of the fees required by
25 the conventions and the fees required under this subtitle, the Director
26 may place marks described in paragraph (1) on the register.

27 “(3) INFORMATION ON REGISTER.—The register shall contain—

28 “(A) a facsimile of the mark or trade name;

29 “(B) the name, citizenship, and address of the registrant;

30 “(C) the number, date, and place of the first registration of the
31 mark, including the dates on which application for the registration
32 was filed and granted and the term of the registration;

33 “(D) a list of each good or service to which the mark is applied,
34 as shown by the registration in the country of origin; and

35 “(E) other data that may be useful concerning the mark.

36 “(4) CONTINUATION OF PREVIOUS REGISTER.—The register main-
37 tained under paragraph (1) shall be a continuation of the register pro-
38 vided under section 1(a) of the Act of March 19, 1920 (ch. 104, 41
39 Stat. 533).

40 “(c) EXTENSION OF BENEFITS TO PERSONS FROM CERTAIN COUN-
41 TRIES.—

1 “(1) IN GENERAL.—In addition to the rights to which an owner of
2 a mark is otherwise entitled by this subtitle, a person whose country
3 of origin is a party to a convention or treaty relating to marks, trade
4 names, or the repression of unfair competition, to which the United
5 States is also a party, or extends reciprocal rights to nationals of the
6 United States by law, is entitled to the benefits of this section under
7 the conditions expressed in this section to the extent necessary to give
8 effect to any provision of the convention, treaty, or reciprocal law.

9 “(2) REQUIREMENT OF PRIOR REGISTRATION IN COUNTRY OF ORI-
10 GIN.—A registration of a mark in the United States by a person de-
11 scribed in paragraph (1) shall not be granted until the mark is reg-
12 istered in the country of origin of the applicant unless the applicant
13 alleges use in commerce.

14 “(d) EFFECT OF APPLICATION FOR REGISTRATION AFTER APPLICATION
15 FOR REGISTRATION IN COUNTRY OF ORIGIN.—

16 “(1) IN GENERAL.—An application for registration of a mark under
17 subsection (e) or under section 601, 603, 604, or 631 of this title, filed
18 by a person described in subsection (e) that has previously filed an ap-
19 plication for registration of the same mark in one of the countries de-
20 scribed in subsections (a) and (c), shall be accorded the same effect as
21 would be accorded to the same application if the application had been
22 filed in the United States on the date on which the application was
23 first filed in the foreign country (or, subject to paragraph (2), the date
24 on which a subsequent application was filed) if—

25 “(A) the application in the United States is filed not later than
26 6 months after the date on which the application was filed in the
27 foreign country; and

28 “(B) the application conforms as nearly as practicable to the re-
29 quirements of this subtitle, including a statement that the appli-
30 cant has a bona fide intention to use the mark in commerce.

31 “(2) RIGHT ACCORDED ON BASIS OF SUBSEQUENT APPLICATION.—
32 The right provided in this section may be based on a subsequent regu-
33 larly filed application in the same foreign country, instead of the first-
34 filed foreign application, so long as any foreign application filed before
35 the subsequent application—

36 “(A) has been withdrawn, abandoned, or otherwise disposed of,
37 without having been made available for public inspection and with-
38 out leaving any rights outstanding; and

39 “(B) has not served and will not serve as a basis for claiming
40 a right of priority.

1 “(3) RIGHTS ACQUIRED BY THIRD PARTIES.—The rights acquired by
2 third parties before the date of the filing of the application in the for-
3 eign country shall not be affected by a registration granted under this
4 subsection.

5 “(4) EFFECT OF SUBSECTION.—This subsection does not entitle the
6 owner of a registration granted under this section to recover for an act
7 committed before the date on which the owner’s mark was registered
8 in the United States unless the registration is based on use in com-
9 merce.

10 “(e) REGISTRATION OF MARK REGISTERED IN COUNTRY OF ORIGIN.—

11 “(1) IN GENERAL.—A mark registered in the country of origin of the
12 foreign applicant may be registered on the principal register, if eligible,
13 or if not eligible on the supplemental register as provided in this sub-
14 title.

15 “(2) APPLICATION.—The applicant shall submit to the Director,
16 within such time as the Director may prescribe, an application that—

17 “(A) includes a true copy, photocopy, certification, or certified
18 copy of the registration in the country of origin of the applicant;
19 and

20 “(B) states that the applicant has a bona fide intention to use
21 the mark in commerce.

22 “(3) USE IN COMMERCE.—Use in commerce of the mark is not a
23 prerequisite to registration under this subsection.

24 “(f) REGISTRATION INDEPENDENT OF REGISTRATION IN COUNTRY OF
25 ORIGIN.—

26 “(1) IN GENERAL.—The registration of a mark under subsection
27 (c)(2), (d), or (e) by a person described in subsection (c)(1) shall be
28 independent of the registration in the country of origin.

29 “(2) DURATION; VALIDITY; TRANSFER.—The duration, validity, or
30 transfer in the United States of the registration shall be governed by
31 this subtitle.

32 “(g) PROTECTION OF TRADE NAMES.—The trade names of a person de-
33 scribed in subsection (c)(1) shall be protected without the obligation of filing
34 or registration whether or not the trade name forms a part of a mark.

35 “(h) PROTECTION AND REMEDIES AVAILABLE TO PERSONS DESIGNATED
36 IN SUBSECTION (c)(1).—

37 “(1) IN GENERAL.—A person that under subsection (c)(1) is entitled
38 to the benefits of and subject to the provisions of this subtitle is enti-
39 tled to effective protection against unfair competition.

40 “(2) REMEDIES.—The remedies provided under this subtitle for in-
41 fringement of marks are available to a person described in subsection

1 (e)(1) to the extent that the remedies are appropriate in repressing acts
2 of unfair competition.

3 “(i) SAME BENEFITS FOR CITIZENS OR RESIDENTS OF THE UNITED
4 STATES.—A citizen or resident of the United States has the same benefits
5 as are granted by this section to persons described in subsection (c)(1).

6 “PART C—INTERNATIONAL REGISTRATION

“Chap. Sec.
7 “81. International Register 801

7 “CHAPTER 81—INTERNATIONAL REGISTER

- “Sec.
- “801. Definitions.
- “802. International applications based on United States applications or registrations.
- “803. Certification of the international application.
- “804. Restriction, abandonment, cancellation, or expiration of a basic application or basic registration.
- “805. Request for extension of protection subsequent to international registration.
- “806. Extension of protection of an international registration to the United States under the Madrid Protocol.
- “807. Effect of filing a request for extension of protection of an international registration to the United States.
- “808. Right of priority for request for extension of protection to the United States.
- “809. Examination of and opposition to request for extension of protection; notification of refusal.
- “810. Effect of extension of protection.
- “811. Dependence of extension of protection to the United States on the underlying international registration.
- “812. Affidavits and fees.
- “813. Assignment of an extension of protection.
- “814. Incontestability.
- “815. Rights of extension of protection.

8 “§ 801. Definitions

9 “In this chapter—

10 “(1) BASIC APPLICATION.—The term ‘basic application’ means the
11 application for the registration of a mark that has been filed with an
12 Office of a Contracting Party and that constitutes the basis for an ap-
13 plication for the international registration of that mark.

14 “(2) BASIC REGISTRATION.—The term ‘basic registration’ means the
15 registration of a mark that has been granted by an Office of a Con-
16 tracting Party and that constitutes the basis for an application for the
17 international registration of that mark.

18 “(3) CONTRACTING PARTY.—The term ‘Contracting Party’ means a
19 country or inter-governmental organization that is a party to the Ma-
20 drid Protocol.

21 “(4) DATE OF RECORDAL.—The term ‘date of recordal’ means the
22 date on which a request for extension of protection, filed after an inter-
23 national registration is granted, is recorded on the International Reg-
24 ister.

1 “(5) DECLARATION OF BONA FIDE INTENTION TO USE THE MARK
2 IN COMMERCE.—The term ‘declaration of bona fide intention to use the
3 mark in commerce’ means a declaration that—

4 “(A) is signed by the applicant for, or holder of, an inter-
5 national registration that is seeking extension of protection of a
6 mark to the United States; and

7 “(B) contains a statement that—

8 “(i) the applicant or holder has a bona fide intention to use
9 the mark in commerce;

10 “(ii) the individual making the declaration believes the indi-
11 vidual, or the firm, corporation, or association in behalf of
12 which the individual makes the declaration, to be entitled to
13 use the mark in commerce; and

14 “(iii) no other individual, firm, corporation, or association,
15 to the best of the individual’s knowledge and belief, has the
16 right to use the mark in commerce in the identical form of
17 the mark or in such near resemblance to the mark as to be
18 likely, when used on or in connection with a good or service
19 of the other individual, firm, corporation, or association, to
20 cause confusion, cause mistake, or deceive.

21 “(6) EXTENSION OF PROTECTION.—The term ‘extension of protec-
22 tion’ means the protection resulting from an international registration
23 that extends to the United States at the request of the holder of the
24 international registration, in accordance with the Madrid Protocol.

25 “(7) HOLDER.—A ‘holder’, with reference to the holder of an inter-
26 national registration, means the person in whose name the inter-
27 national registration is recorded on the International Register.

28 “(8) INTERNATIONAL APPLICATION.—The term ‘international appli-
29 cation’ means an application for international registration that is filed
30 under the Madrid Protocol.

31 “(9) INTERNATIONAL BUREAU.—The term ‘International Bureau’
32 means the International Bureau of the World Intellectual Property Or-
33 ganization.

34 “(10) INTERNATIONAL REGISTER.—The term ‘International Reg-
35 ister’ means the official collection of data concerning international reg-
36 istrations maintained by the International Bureau that the Madrid
37 Protocol or its implementing regulations require or permit to be re-
38 corded.

39 “(11) INTERNATIONAL REGISTRATION.—The term ‘international reg-
40 istration’ means the registration of a mark granted under the Madrid
41 Protocol.

1 “(12) INTERNATIONAL REGISTRATION DATE.—The term ‘inter-
2 national registration date’ means the date assigned to the international
3 registration by the International Bureau.

4 “(13) MADRID PROTOCOL.—The term ‘Madrid Protocol’ means the
5 Protocol Relating to the Madrid Agreement Concerning the Inter-
6 national Registration of Marks, adopted at Madrid, Spain, on June 27,
7 1989.

8 “(14) NOTIFICATION OF REFUSAL.—The term ‘notification of re-
9 fusal’ means the notice sent by the Director to the International Bu-
10 reau declaring that an extension of protection cannot be granted.

11 “(15) OFFICE OF A CONTRACTING PARTY.—The term ‘Office of a
12 Contracting Party’ means—

13 “(A) the office, or governmental entity, of a Contracting Party
14 that is responsible for the registration of marks; or

15 “(B) the common office, or governmental entity, of more than
16 one Contracting Party that is responsible for the registration of
17 marks and is so recognized by the International Bureau.

18 “(16) OFFICE OF ORIGIN.—The term ‘office of origin’ means the Of-
19 fice of a Contracting Party with which a basic application was filed or
20 by which a basic registration was granted.

21 “(17) OPPOSITION PERIOD.—The term ‘opposition period’ means the
22 time allowed for filing an opposition in the Office, including an exten-
23 sion of time granted under section 613 of this title.

24 **“§ 802. International applications based on United States ap-
25 plications or registrations**

26 “(a) FILING.—The owner of a basic application pending before the Office,
27 or the owner of a basic registration granted by the Director, may file an
28 international application by submitting to the Office a written application
29 in the form, together with the fees, that the Director prescribes.

30 “(b) QUALIFIED OWNER.—A qualified owner under subsection (a) shall—

31 “(1) be a national of the United States;

32 “(2) be domiciled in the United States; or

33 “(3) have a real and effective industrial or commercial establishment
34 in the United States.

35 **“§ 803. Certification of the international application**

36 “(a) EXAMINATION OF INTERNATIONAL APPLICATION.—On the filing of
37 an application for international registration and payment of the prescribed
38 fees, the Director shall examine the international application for the purpose
39 of certifying that the information contained in the international application
40 corresponds to the information contained in the basic application or basic
41 registration at the time of the certification.

1 “(b) TRANSMITTAL OF INTERNATIONAL APPLICATION.—On examination
2 and certification of the international application, the Director shall transmit
3 the international application to the International Bureau.

4 **“§ 804. Restriction, abandonment, cancellation, or expira-**
5 **tion of a basic application or basic registration**

6 “With respect to an international application transmitted to the Inter-
7 national Bureau under section 803 of this title, the Director shall notify the
8 International Bureau when the basic application or basic registration that
9 is the basis for the international application has been restricted, abandoned,
10 or canceled, or has expired, with respect to some or all of the goods and
11 services listed in the international registration—

12 “(1) within 5 years after the international registration date; or

13 “(2) more than 5 years after the international registration date if
14 the restriction, abandonment, or cancellation of the basic application or
15 basic registration resulted from an action that began before the end of
16 that 5-year period.

17 **“§ 805. Request for extension of protection subsequent to**
18 **international registration**

19 “The holder of an international registration that is based on a basic ap-
20 plication filed with the Office or a basic registration granted by the Director
21 may request an extension of protection of its international registration by
22 filing the request—

23 “(1) directly with the International Bureau; or

24 “(2) with the Office for transmittal to the International Bureau, if
25 the request is in the form, and contains the transmittal fee, that the
26 Director prescribes.

27 **“§ 806. Extension of protection of an international registra-**
28 **tion to the United States under the Madrid Proto-**
29 **col**

30 “(a) IN GENERAL.—Subject to section 809 of this title, the holder of an
31 international registration is entitled to the benefits of extension of protec-
32 tion of that international registration to the United States to the extent nec-
33 essary to give effect to any provision of the Madrid Protocol.

34 “(b) WHEN UNITED STATES OFFICE IS OFFICE OF ORIGIN.—If the Of-
35 fice is the office of origin for applying for, or registering, a mark, an inter-
36 national registration based on the application or registration cannot be used
37 to obtain the benefits of the Madrid Protocol in the United States.

1 **“§ 807. Effect of filing a request for extension of protection**
2 **of an international registration to the United**
3 **States**

4 “(a) REQUEST FOR EXTENSION OF PROTECTION DEEMED PROPERLY
5 FILED.—A request for extension of protection of an international registra-
6 tion to the United States that the International Bureau transmits to the
7 Office shall be considered to be properly filed in the United States if the
8 request, when received by the International Bureau, has attached to it a
9 declaration of bona fide intention to use the mark in commerce that is veri-
10 fied by the applicant for, or holder of, the international registration.

11 “(b) PROPER FILING AS CONSTRUCTIVE USE OF THE MARK.—Unless ex-
12 tension of protection is refused under section 809 of this title, the proper
13 filing of the request for extension of protection under subsection (a) con-
14 stitutes constructive use of the mark, conferring the same rights as those
15 specified in section 607(c) of this title, as of the earliest of the following:

16 “(1) The international registration date, if the request for extension
17 of protection was filed in the international application.

18 “(2) The date of recordal of the request for extension of protection,
19 if the request for extension of protection was made after the inter-
20 national registration date.

21 “(3) The date of priority claimed under section 808 of this title.

22 **“§ 808. Right of priority for request for extension of protec-**
23 **tion to the United States**

24 “The holder of an international registration with a request for an exten-
25 sion of protection to the United States is entitled to claim a date of priority
26 based on a right of priority within the meaning of Article 4 of the Paris
27 Convention for the Protection of Industrial Property if—

28 “(1) the request for extension of protection contains a claim of prior-
29 ity; and

30 “(2) the date of international registration or the date of the recordal
31 of the request for extension of protection to the United States is not
32 later than 6 months after the date of the first regular national filing
33 (within the meaning of Article 4(A)(3) of the Paris Convention for the
34 Protection of Industrial Property) or a subsequent application (within
35 the meaning of Article 4(C)(4) of the Paris Convention for the Protec-
36 tion of Industrial Property).

37 **“§ 809. Examination of and opposition to request for exten-**
38 **sion of protection; notification of refusal**

39 “(a) EXAMINATION OF REQUEST FOR EXTENSION OF PROTECTION.—

40 “(1) APPLICANT ENTITLED TO EXTENSION.—

1 “(A) EXAMINATION.—A request for extension of protection de-
2 scribed in section 807(a) of this title shall be examined as an ap-
3 plication for registration on the principal register under this sub-
4 title.

5 “(B) EXTENSION.—If on examination it appears that the appli-
6 cant is entitled to extension of protection under this chapter, the
7 Director shall cause the mark to be published in the Official Ga-
8 zette.

9 “(2) REQUEST SUBJECT TO OPPOSITION.—Subject to subsection (c),
10 a request for extension of protection under this chapter is subject to
11 opposition under section 613 of this subtitle.

12 “(3) EXTENSION NOT TO BE REFUSED.—Extension of protection
13 shall not be refused on the ground that the mark has not been used
14 in commerce.

15 “(4) EXTENSION TO BE REFUSED.—Extension of protection shall be
16 refused to any mark not registrable on the principal register.

17 “(b) NOTIFICATION OF REFUSAL.—

18 “(1) IN GENERAL.—If a request for extension of protection is re-
19 fused under subsection (a), the Director shall declare in a notification
20 of refusal (as provided in subsection (c)) that the extension of protec-
21 tion cannot be granted.

22 “(2) STATEMENT OF GROUNDS.—A notification under paragraph (1)
23 shall contain a statement of all grounds on which the refusal is based.

24 “(c) TRANSMITTAL OF NOTIFICATION TO INTERNATIONAL BUREAU.—

25 “(1) TRANSMITTAL OF APPLICABLE NOTIFICATIONS.—Not later than
26 18 months after the date on which the International Bureau transmits
27 to the Office a notification of a request for extension of protection, the
28 Director shall transmit to the International Bureau any of the follow-
29 ing that applies to the request:

30 “(A) A notification of refusal based on an examination of the
31 request for extension of protection.

32 “(B) A notification of refusal based on the filing of an opposi-
33 tion to the request.

34 “(C) A notification of the possibility that an opposition to the
35 request may be filed after the end of that 18-month period.

36 “(2) TRANSMITTAL OF NOTIFICATION OF REFUSAL.—If the Director
37 has sent a notification of the possibility of opposition under paragraph
38 (1)(C), the Director shall, if applicable, transmit to the International
39 Bureau a notification of refusal on the basis of the opposition, includ-
40 ing a statement of all the grounds for the opposition, not later than
41 the earlier of—

1 “(A) 7 months after the beginning of the opposition period; or

2 “(B) one month after the end of the opposition period.

3 “(3) LIMITATION ON GROUNDS FOR REFUSAL.—If a notification of
4 refusal of a request for extension of protection is transmitted under
5 paragraph (1) or (2), no grounds for refusal of the request other than
6 those contained in the notification may be transmitted to the Inter-
7 national Bureau by the Director after the expiration of the time periods
8 specified in paragraph (1) or (2), as the case may be.

9 “(4) NOTIFICATION NOT SENT WITHIN STATED TIME PERIOD.—If a
10 notification described in paragraph (1) or (2) is not transmitted to the
11 International Bureau within the time period specified in paragraph (1)
12 or (2), with respect to a request for extension of protection—

13 “(A) the request for extension of protection shall not be refused;
14 and

15 “(B) the Director shall issue a certificate of extension of protec-
16 tion pursuant to the request.

17 “(d) SERVICE OF NOTICES AND PROCESS.—

18 “(1) DESIGNATION OF AGENT.—In responding to a notification of
19 refusal with respect to a mark, the holder of the international registra-
20 tion of the mark may designate by a document filed in the Office the
21 name and address of a person residing in the United States on which
22 may be served notices and process in proceedings affecting the mark.

23 “(2) MEANS OF SERVICE.—Notice or process described in paragraph
24 (1)—

25 “(A) may be served on a person designated under paragraph (1)
26 by leaving with the person or mailing to the person a copy of the
27 notice or process at the address specified in the last designation
28 filed; or

29 “(B) if the person cannot be found at that address, or if the
30 holder does not make a designation under paragraph (1), may be
31 served on the Director.

32 **“§ 810. Effect of extension of protection**

33 “(a) ISSUANCE OF CERTIFICATE AND PUBLICATION OF NOTICE.—Unless
34 a request for extension of protection is refused under section 809 of this
35 title, the Director shall—

36 “(1) issue a certificate of extension of protection pursuant to the re-
37 quest; and

38 “(2) cause notice of the certificate to be published in the Official Ga-
39 zette.

1 “(b) EFFECT AND VALIDITY OF EXTENSION AND RIGHTS AND REMEDIES
2 OF HOLDER.—On and after the date on which a certificate of extension of
3 protection is issued under subsection (a)—

4 “(1) the extension of protection has the same effect and validity as
5 a registration on the principal register; and

6 “(2) the holder of the international registration has the same rights
7 and remedies as the owner of a registration on the principal register.

8 **“§ 811. Dependence of extension of protection to the United**
9 **States on the underlying international registration**

10 “(a) CANCELLATION OF EXTENSION OF PROTECTION TO UNITED
11 STATES.—If the International Bureau notifies the Office of the cancellation
12 of an international registration with respect to some or all of the goods and
13 services listed in the international registration, the Director shall cancel any
14 extension of protection to the United States with respect to those goods and
15 services as of the date on which the international registration was canceled.

16 “(b) INTERNATIONAL REGISTRATION NOT RENEWED.—If the Inter-
17 national Bureau does not renew an international registration, the cor-
18 responding extension of protection to the United States ceases to be valid
19 as of the date of the expiration of the international registration.

20 “(c) APPLICATION FOR REGISTRATION AFTER INTERNATIONAL REG-
21 ISTRATION CANCELED.—

22 “(1) FILING.—The holder of an international registration canceled
23 in whole or in part by the International Bureau at the request of the
24 office of origin, under article 6(4) of the Madrid Protocol, may file an
25 application under section 601 or 665 of this title for the registration
26 of the same mark for any of the goods and services to which the can-
27 cellation applies that were covered by an extension of protection to the
28 United States based on that international registration.

29 “(2) FILING DATE; PRIORITY.—The application—

30 “(A) shall be treated as if it had been filed on the international
31 registration date or the date of recordal of the request for exten-
32 sion of protection with the International Bureau, whichever date
33 applies; and

34 “(B) if the extension of protection enjoyed priority under sec-
35 tion 808 of this title, shall enjoy the same priority.

36 “(3) ENTITLEMENT TO BENEFITS.—The application is entitled to
37 the benefits conferred by this subsection only if it—

38 “(A) is filed not later than 3 months after the date on which
39 the international registration was canceled, in whole or in part;
40 and

1 “(B) complies with all the requirements of this subtitle that
2 apply to an application filed under section 601 or 665 of this title.

3 **“§ 812. Affidavits and fees**

4 “(a) DURATION OF EXTENSION OF PROTECTION.—An extension of pro-
5 tection for which a certificate of extension of protection has been issued
6 under section 810 of this title remains in effect for the term of the inter-
7 national registration on which the extension of protection is based, except
8 that the Director shall cancel an extension of protection of a mark on the
9 expiration of the following time periods:

10 “(1) 6 YEARS.—At the end of 6 years beginning on the date on
11 which the Director issues the certificate of extension of protection, un-
12 less within one year preceding the expiration of the 6-year period the
13 holder of the international registration files in the Office an affidavit
14 under subsection (b) and pays a fee prescribed by the Director; and

15 “(2) 10 YEARS.—At the end of 10 years beginning on the date on
16 which the Director issues the certificate of extension of protection, and
17 at the end of each subsequent 10-year period, unless—

18 “(A) within 6 months preceding the expiration of the 10-year
19 period, the holder of the international registration files in the Of-
20 fice an affidavit under subsection (b) and pays a fee prescribed by
21 the Director; or

22 “(B) within 3 months after the expiration of the 10-year period,
23 the holder of the international registration files in the Office an
24 affidavit under subsection (b) and pays the fee described in sub-
25 paragraph (A) and the surcharge prescribed by the Director.

26 “(b) CONTENTS OF AFFIDAVIT.—

27 “(1) IN GENERAL.—An affidavit referred to in subsection (a) shall
28 specify each good or service recited in the extension of protection on
29 or in connection with which the mark is in use in commerce.

30 “(2) CURRENT USE.—The holder of the international registration
31 shall—

32 “(A) attach to the affidavit a specimen or facsimile showing the
33 current use of the mark in commerce; or

34 “(B) state that any nonuse is due to special circumstances that
35 excuse the nonuse and is not due to an intention to abandon the
36 mark.

37 “(3) SPECIAL NOTICE.—Special notice of the requirement for the af-
38 fidavit shall be attached to each certificate of extension of protection.

39 “(c) NOTICE.—The Director shall—

1 “(1) notify the holder of an international registration that files an
2 affidavit of the acceptance or refusal of the affidavit by the Director;
3 and

4 “(2) in the case of a refusal, state in the notice the reasons for the
5 refusal.

6 “(d) SERVICE OF NOTICES AND PROCESS.—

7 “(1) DESIGNATION OF AGENT.—The holder of the international reg-
8 istration of the mark may designate, by a document filed in the Office,
9 the name and address of a person residing in the United States on
10 which notices or process in proceedings affecting the mark may be
11 served.

12 “(2) MEANS OF SERVICE.—Notice or process described in paragraph
13 (1)—

14 “(A) may be served on a person designated under paragraph (1)
15 by leaving with the person or mailing to the person a copy of the
16 notice or process at the address specified in the last designation
17 filed; or

18 “(B) if the person cannot be found at that address, or if the
19 holder does not make a designation under paragraph (1), may be
20 served on the Director.

21 **“§ 813. Assignment of extension of protection**

22 “An extension of protection may be assigned, together with the goodwill
23 associated with the mark, only to a person that is a national of, is domiciled
24 in, or has a bona fide and effective industrial or commercial establishment
25 in—

26 “(1) a country that is a Contracting Party; or

27 “(2) a country that is a member of an intergovernmental organiza-
28 tion that is a Contracting Party.

29 **“§ 814. Incontestability**

30 “The period of continuous use prescribed under section 615 of this title
31 for a mark covered by an extension of protection issued under this chapter
32 may begin not earlier than the date on which the Director issues the certifi-
33 cate of extension of protection under section 810 of this title, except as pro-
34 vided in section 815 of this title.

35 **“§ 815. Rights of extension of protection**

36 “If a United States registration and a subsequently issued certificate of
37 extension of protection to the United States are owned by the same person,
38 identify the same mark, and list the same good or service, the extension of
39 protection has the same rights that accrued to the registration before issu-
40 ance of the certificate of extension of protection.

“Subtitle IV—Other Intellectual Property Provisions

“Chap. “91. Miscellaneous Sec. 901

“CHAPTER 91—MISCELLANEOUS

- “Sec. “901. National Intellectual Property Law Enforcement Coordination Council. “902. Cyberpiracy protection for individuals.

“§ 901. National Intellectual Property Law Enforcement Coordination Council

“(a) DEFINITIONS.—In this section:

“(1) COORDINATOR.—The term ‘Coordinator’ means the Coordinator for International Intellectual Property Enforcement appointed under subsection (d).

“(2) COUNCIL.—The term ‘Council’ means the National Intellectual Property Law Enforcement Coordination Council established by subsection (b).

“(b) ESTABLISHMENT OF COUNCIL.—There is established the National Intellectual Property Law Enforcement Coordination Council.

“(c) MEMBERSHIP.—The Council consists of the following members:

- “(1) The Coordinator, who serves as head of the Council. “(2) The Director, who serves as co-chair of the Council. “(3) The Assistant Attorney General, Criminal Division, who serves as co-chair of the Council. “(4) The Under Secretary of State for Economic and Agricultural Affairs. “(5) The Ambassador, Deputy United States Trade Representative. “(6) The Commissioner of Customs. “(7) The Under Secretary of Commerce for International Trade.

“(d) COORDINATOR.—

“(1) IN GENERAL.—The President shall appoint a Coordinator for International Intellectual Property Enforcement.

“(2) SEPARATE POSITION.—No individual shall serve as Coordinator while serving in another position in the Federal Government.

“(3) REPORTING BY CO-CHAIRS.—The co-chairs of the Council shall report to the Coordinator on matters concerning the Council.

“(e) DUTIES.—The Council shall—

- “(1) coordinate domestic and international intellectual property law enforcement among Federal and foreign entities; “(2) establish policies, objectives, and priorities concerning international intellectual property protection and intellectual property law enforcement;

1 “(3) promulgate a strategy for protecting American intellectual prop-
2 erty overseas; and

3 “(4) coordinate and oversee implementation by Federal agencies with
4 responsibilities for intellectual property protection and intellectual prop-
5 erty law enforcement of the policies, objectives, and priorities estab-
6 lished under paragraph (2) and the fulfillment of the responsibilities
7 assigned to those agencies in the strategy described in paragraph (3).

8 “(f) BUDGET.—The Coordinator shall—

9 “(1) develop for each year, with the advice of the members of the
10 Council and any other Federal agencies with responsibilities for intel-
11 lectual property protection and intellectual property law enforcement,
12 a budget proposal to implement the strategy described in subsection
13 (e)(3) and for the operations of the Council; and

14 “(2) submit the budget proposal to the President and to Congress.

15 “(g) STAFF.—

16 “(1) IN GENERAL.—The Coordinator may select, appoint, employ,
17 and fix compensation of officers and employees as are necessary to
18 carry out the functions of the Council.

19 “(2) TEMPORARY REASSIGNMENT.—The Coordinator may direct,
20 with the concurrence of the head of a Federal agency, the temporary
21 reassignment within the Federal Government of personnel employed by
22 the department or agency.

23 “(h) CONSULTATION.—The Council shall consult with the Register of
24 Copyrights on law enforcement matters relating to copyright and related
25 rights and matters.

26 “(i) NO EFFECT ON AUTHORITIES.—This section does not—

27 “(1) derogate from—

28 “(A) the duties of the Secretary of State or from the duties of
29 the United States Trade Representative as set forth in section 141
30 of the Trade Act of 1974 (19 U.S.C. 2171); or

31 “(B) the duties and functions of the Register of Copyrights; or

32 “(2) otherwise alter authorities relating to copyright matters.

33 “(j) ANNUAL REPORTS.—The Council annually shall submit to the Presi-
34 dent and to the Committees on Appropriations and on the Judiciary of the
35 Senate and the Committees on Appropriations and on the Judiciary of the
36 House of Representatives a report that describes the coordination activities
37 of the Council.

38 “(k) AVAILABILITY OF FUNDS.—Notwithstanding section 1346 of title 31
39 or section 610 of the Treasury and General Government Appropriations Act,
40 2000 (Pub. L. 106–58, 113 Stat. 467), amounts made available for any fis-
41 cal year are available for interagency funding of the Council.

1 **“§ 902. Cyberpiracy protection for individuals**

2 “(a) DEFINITION.—In this section, the term ‘domain name’ has the
3 meaning given the term in section 501 of this title.

4 “(b) LIABILITY.—A person that registers a domain name that consists of
5 the name of another living individual, or a name substantially and confus-
6 ingly similar to the name of the other individual, without that individual’s
7 consent, with the specific intent to profit from that name by selling the do-
8 main name for financial gain to that individual or a third party, is liable
9 in a civil action by that individual.

10 “(c) GOOD FAITH REGISTRATION.—

11 “(1) IN GENERAL.—A person who in good faith registers a domain
12 name consisting of the name of another living individual, or a name
13 substantially and confusingly similar to the name of the other individ-
14 ual, is not liable under subsection (b) if—

15 “(A) the name is used in, affiliated with, or related to a work
16 of authorship protected under title 17 (including a work made for
17 hire (as defined in section 101 of title 17));

18 “(B) the person registering the domain name—

19 “(i) is the copyright owner or licensee of the work; and

20 “(ii) intends to sell the domain name in conjunction with
21 the lawful exploitation of the work; and

22 “(C) the registration is not prohibited by a contract between the
23 registrant and the named individual.

24 “(2) EFFECT OF SUBSECTION.—This subsection—

25 “(A) applies only to a civil action brought under subsection (b);
26 and

27 “(B) does not limit the protections afforded under this subtitle
28 or any other provision of Federal or State law.

29 “(d) REMEDIES.—In a civil action under subsection (b), a court—

30 “(1) may award injunctive relief (including the forfeiture or cancella-
31 tion of the domain name or the transfer of the domain name to the
32 plaintiff); and

33 “(2) may award costs and an attorney’s fee to the prevailing party.

34 “(e) APPLICABILITY.—This section applies to domain names registered on
35 or after November 29, 1999.”.

36 **SEC. 7. CONFORMING CROSS-REFERENCES.**

37 (a) TITLE 17.—Section 504(e)(3) of title 17, United States Code, is
38 amended to read as follows:

39 “(C) For purposes of this paragraph, the term ‘domain name’ has
40 the meaning given that term in section 501 of title 35.”.

1 (b) TITLE 18.—Section 2320 of title 18, United States Code, is amend-
2 ed—

3 (1) in subsection (c), by striking “the Lanham Act” and substituting
4 “subtitle III of title 35”;

5 (2) in subsection (e)(1)—

6 (A) in subparagraph (B), by striking “the Lanham Act” and
7 substituting “subtitle III of title 35”; and

8 (B) by striking “such mark or designation.” and substituting
9 “such mark or designation.”;

10 (3) in subsection (e)(3), by striking “value; and” and substituting
11 “value.”; and

12 (4) by striking subsection (e)(4).

13 (c) TITLE 28.—Section 1295(a)(4)(B) of title 28, United States Code, is
14 amended by striking “section 21 of the Trademark Act of 1946 (15 U.S.C.
15 1071)” and substituting “section 620 of title 35”.

16 (d) TITLE 35.—Title 35, United States Code, is amended—

17 (1) in the 2d sentence of section 1(a), by striking “this title” and
18 substituting “this subtitle and subtitle II”;

19 (2) in section 1(e), by striking “this title” and substituting “this
20 subtitle and subtitle II”;

21 (3) in section 3(a)(1), by striking “this title” and substituting “this
22 subtitle and subtitle II”;

23 (4) in section 42(c), by striking “section 31 of the Trademark Act
24 of 1946” and substituting “section 653 of this title”;

25 (5) in the matter preceding subsection (a) in section 100, by striking
26 “this title” and substituting “this subtitle and subtitle I”;

27 (6) in section 101, by striking “this title” and substituting “this sub-
28 title and subtitle I”;

29 (7) in section 105(a), by striking “this title” and substituting “this
30 subtitle and subtitle I”;

31 (8) in section 105(b), by striking “this title” and substituting “this
32 subtitle and subtitle I”;

33 (9) in section 111(a)(1), by striking “this title” and substituting
34 “this subtitle and subtitle I”;

35 (10) in section 111(b)(1), by striking “this title” the first place the
36 term appears and substituting “this subtitle and subtitle I”;

37 (11) in section 111(b)(8), by striking “this title” the first place the
38 term appears and substituting “this subtitle and subtitle I”;

39 (12) in the 3d sentence of section 115, by striking “this title” and
40 substituting “this subtitle and subtitle I”;

1 (13) in the 1st undesignated paragraph of section 116, by striking
2 “this title” and substituting “this subtitle and subtitle I”;

3 (14) in the 1st sentence of section 122(b)(1)(A), by striking “this
4 title” and substituting “this subtitle and subtitle I”;

5 (15) in section 122(b)(2)(B)(v), by striking “this title” and sub-
6 stituting “this subtitle and subtitle I”;

7 (16) in section 152, by striking “this title” and substituting “this
8 subtitle and subtitle I”;

9 (17) in section 154(a)(2), by striking “this title” the first place the
10 term appears and substituting “this subtitle and subtitle I”;

11 (18) in section 157(a), by striking “this title” the first place the
12 term appears and substituting “this subtitle and subtitle I”;

13 (19) in the 1st sentence of section 157(e), by striking “this title”
14 the first place the term appears and substituting “this subtitle and
15 subtitle I”;

16 (20) in the 2d sentence of section 157(e), by striking “this title” and
17 substituting “this subtitle and subtitle I”;

18 (21) in section 161, by striking “this title” each place the term ap-
19 pears and substituting “this subtitle and subtitle I”;

20 (22) in section 164, by striking “this title” and substituting “this
21 subtitle and subtitle I”;

22 (23) in section 171, by striking “this title” each place the term ap-
23 pears and substituting “this subtitle and subtitle I”;

24 (24) in section 201(d), by striking “this title” and substituting “this
25 subtitle and subtitle I”;

26 (25) in section 202(c)(3), by striking “this title” and substituting
27 “this subtitle and subtitle I”;

28 (26) in section 251, by striking “this title” and substituting “this
29 subtitle and subtitle I”;

30 (27) in the 1st undesignated paragraph of section 261, by striking
31 “this title” and substituting “this subtitle and subtitle I”;

32 (28) in the 2d sentence of section 271(g), by striking “this title” and
33 substituting “this subtitle and subtitle I”;

34 (29) in the 3d sentence of section 271(g), by striking “this title” and
35 substituting “this subtitle and subtitle I”;

36 (30) in section 271(h), by striking “this title” and substituting “this
37 subtitle and subtitle I”;

38 (31) in subparagraph (2) of the 2d undesignated paragraph of sec-
39 tion 282, by striking “part II of this title” and substituting “part A
40 of this subtitle”;

1 (32) in subparagraph (4) of the 2d undesignated paragraph of sec-
2 tion 282, by striking “this title” and substituting “this subtitle and
3 subtitle I”;

4 (33) in section 283, by striking “this title” and substituting “this
5 subtitle and subtitle I”;

6 (34) in section 287(b)(1), by striking “this title” and substituting
7 “this subtitle and subtitle I”;

8 (35) in the 2d undesignated paragraph of section 289, by striking
9 “this title” and substituting “this subtitle and subtitle I”;

10 (36) in the 1st sentence of section 290, by striking “this title” and
11 substituting “this subtitle and subtitle I”;

12 (37) in section 296(a), by striking “this title” and substituting “this
13 subtitle and subtitle I”;

14 (38) in section 351(b), by striking “this title” and substituting “this
15 subtitle and subtitle I”;

16 (39) in section 364(a), by striking “and this title” and substituting
17 “this subtitle, and subtitle I”; and

18 (40) in section 375(a), by striking “this title” the first place the
19 term appears and substituting “this subtitle and subtitle I”.

20 (e) TITLE 36.—Section 220506(e) of title 36, United States Code, is
21 amended by striking “the Act of July 5, 1946 (15 U.S.C. 1051 et seq.)
22 (popularly known as the Trademark Act of 1946)” and substituting “sub-
23 title III of title 35”.

24 **SEC. 8. TRANSITIONAL AND SAVINGS PROVISIONS.**

25 (a) CUTOFF DATE.—This Act replaces certain provisions of law enacted
26 on or before February 28, 2006. If a law enacted after that date amends
27 or repeals a provision replaced by this Act, that law is deemed to amend
28 or repeal, as the case may be, the corresponding provision enacted by this
29 Act. If a law enacted after that date is otherwise inconsistent with this Act,
30 it supersedes this Act to the extent of the inconsistency.

31 (b) ORIGINAL DATE OF ENACTMENT UNCHANGED.—For purposes of de-
32 termining whether one provision of law supersedes another based on enact-
33 ment later in time, the date of enactment of a provision enacted by this Act
34 is deemed to be the date of enactment of the provision it replaced.

35 (c) REFERENCES TO PROVISIONS REPLACED.—A reference to a provision
36 of law replaced by this Act, including a reference in a regulation, order, or
37 other law, is deemed to refer to the corresponding provision enacted by this
38 Act.

39 (d) REGULATIONS, ORDERS, AND OTHER ADMINISTRATIVE ACTIONS.—A
40 regulation, order, or other administrative action in effect under a provision

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1 of law replaced by this Act continues in effect under the corresponding pro-
 2 vision enacted by this Act.

3 (e) ACTIONS TAKEN AND OFFENSES COMMITTED.—An action taken or
 4 an offense committed under a provision of law replaced by this Act is
 5 deemed to have been taken or committed under the corresponding provision
 6 enacted by this Act.

7 **SEC. 9. REPEALS.**

8 The following provisions of law are repealed, except with respect to rights
 9 and duties that matured, penalties that were incurred, or proceedings that
 10 were begun before the date of enactment of this Act:

Schedule of Laws Repealed

Act	Section	United States Code Former Classification	
Lanham Act (Act of July 5, 1946, ch. 540, 60 Stat. 427)	1	15 U.S.C. 1051.	
	2	15 U.S.C. 1052.	
	3	15 U.S.C. 1053.	
	4	15 U.S.C. 1054.	
	5	15 U.S.C. 1055.	
	6	15 U.S.C. 1056.	
	7	15 U.S.C. 1057.	
	8	15 U.S.C. 1058.	
	9	15 U.S.C. 1059.	
	10	15 U.S.C. 1060.	
	11	15 U.S.C. 1061.	
	12	15 U.S.C. 1062.	
	13	15 U.S.C. 1063.	
	14	15 U.S.C. 1064.	
	15	15 U.S.C. 1065.	
	16	15 U.S.C. 1066.	
	17	15 U.S.C. 1067.	
	18	15 U.S.C. 1068.	
	19	15 U.S.C. 1069.	
	20	15 U.S.C. 1070.	
	21	15 U.S.C. 1071.	
	22	15 U.S.C. 1072.	
	23	15 U.S.C. 1091.	
	24	15 U.S.C. 1092.	
	25	15 U.S.C. 1093.	
	26	15 U.S.C. 1094.	
	27	15 U.S.C. 1095.	
	28	15 U.S.C. 1096.	
	29	15 U.S.C. 1111.	
	30	15 U.S.C. 1112.	
	31	15 U.S.C. 1113.	
	32	15 U.S.C. 1114.	
	33	15 U.S.C. 1115.	
	34	15 U.S.C. 1116.	
	35	15 U.S.C. 1117.	
	36	15 U.S.C. 1118.	
	37	15 U.S.C. 1119.	
	38	15 U.S.C. 1120.	
	39	15 U.S.C. 1121.	
	40	15 U.S.C. 1122.	
	41	15 U.S.C. 1123.	
	42	15 U.S.C. 1124.	
	43	15 U.S.C. 1125.	
	44	15 U.S.C. 1126.	
	45	15 U.S.C. 1127.	
	60	15 U.S.C. 1141.	
	61	15 U.S.C. 1141a.	
	62	15 U.S.C. 1141b.	
	63	15 U.S.C. 1141e.	
	64	15 U.S.C. 1141d.	
	65	15 U.S.C. 1141e.	
	66	15 U.S.C. 1141f.	
	67	15 U.S.C. 1141g.	
	68	15 U.S.C. 1141h.	
	69	15 U.S.C. 1141i.	
	70	15 U.S.C. 1141j.	
	71	15 U.S.C. 1141k.	
	72	15 U.S.C. 1141l.	
	73	15 U.S.C. 1141m.	
	74	15 U.S.C. 1141n.	
	Public Law 106–58	653	15 U.S.C. 1128.

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Schedule of Laws Repealed—Continued

Act	Section	United States Code Former Classification
Public Law 106-113	div. B, 1000(a)(9) [title III, § 3002(b)].	15 U.S.C. 1129.
Public Law 108-447	div. B, title II, provisos under heading “National Intellectual Property Law Enforcement Coordination Council”.	15 U.S.C. 1128 note.