

111TH CONGRESS
2^D SESSION

S. 2968

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

IN THE SENATE OF THE UNITED STATES

JANUARY 28, 2010

Mr. LEAHY (for himself and Mr. SESSIONS) introduced the following bill;
which was considered, read the third time, and passed

A BILL

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

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

3 **SECTION 1. SHORT TITLE.**

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

6 **SEC. 2. DEFINITION.**

7 For purposes of this Act, the term “Trademark Act
8 of 1946” means the Act entitled “An Act to provide for
9 the registration and protection of trademarks used in com-
10 merce, to carry out the provisions of certain international
11 conventions, and for other purposes”, approved July 5,

1 1946 (commonly referred to as the “Lanham Act”; 15
2 U.S.C. 1051 et. seq).

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

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

7 (1) by inserting “United States” before “Patent
8 and Trademark Office” each place that term ap-
9 pears;

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

12 (3) in subsection (e)—

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

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

18 (4) by amending subsection (g) to read as fol-
19 lows:

20 “(g) CORRECTION OF PATENT AND TRADEMARK OF-
21 FICE MISTAKE.—Whenever a material mistake in a reg-
22 istration, incurred through the fault of the United States
23 Patent and Trademark Office, is clearly disclosed by the
24 records of the Office a certificate stating the fact and na-
25 ture of such mistake shall be issued without charge and

1 recorded and a printed copy thereof shall be attached to
2 each printed copy of the registration and such corrected
3 registration shall thereafter have the same effect as if the
4 same had been originally issued in such corrected form,
5 or in the discretion of the Director a new certificate of
6 registration may be issued without charge. All certificates
7 of correction heretofore issued in accordance with the rules
8 of the United States Patent and Trademark Office and
9 the registrations to which they are attached shall have the
10 same force and effect as if such certificates and their issue
11 had been specifically authorized by statute.”.

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

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

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

19 “(1) there has been no final decision adverse to
20 the owner’s claim of ownership of such mark for
21 such goods or services, or to the owner’s right to
22 register the same or to keep the same on the reg-
23 ister; and”;

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

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

3 (1) by inserting “United States” before “Patent
4 and Trademark Office” each place that term ap-
5 pears;

6 (2) in subsection (a)(1), by inserting “or section
7 71” after “section 8”; and

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

10 (d) CONFORMING REQUIREMENTS FOR AFFIDA-
11 VITS.—

12 (1) DURATION, AFFIDAVITS AND FEES.—Sec-
13 tion 8 of the Trademark Act of 1946 (15 U.S.C.
14 1058) is amended to read as follows:

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

16 **“(a) TIME PERIODS FOR REQUIRED AFFIDAVITS.—**

17 Each registration shall remain in force for 10 years, ex-
18 cept that the registration of any mark shall be canceled
19 by the Director unless the owner of the registration files
20 in the United States Patent and Trademark Office affida-
21 vits that meet the requirements of subsection (b), within
22 the following time periods:

23 “(1) Within the 1-year period immediately pre-
24 ceding the expiration of 6 years following the date

1 of registration under this Act or the date of the pub-
2 lication under section 12(c).

3 “(2) Within the 1-year period immediately pre-
4 ceding the expiration of 10 years following the date
5 of registration, and each successive 10-year period
6 following the date of registration.

7 “(3) The owner may file the affidavit required
8 under this section within the 6-month grace period
9 immediately following the expiration of the periods
10 established in paragraphs (1) and (2), together with
11 the fee described in subsection (b) and the additional
12 grace period surcharge prescribed by the Director.

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

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

17 “(B) set forth the goods and services recited in
18 the registration on or in connection with which the
19 mark is in use in commerce;

20 “(C) be accompanied by such number of speci-
21 mens or facsimiles showing current use of the mark
22 in commerce as may be required by the Director;
23 and

24 “(D) be accompanied by the fee prescribed by
25 the Director; or

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

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

8 “(C) be accompanied by the fee prescribed by
9 the Director.

10 “(c) DEFICIENT AFFIDAVIT.—If any submission filed
11 within the period set forth in subsection (a) is deficient,
12 including that the affidavit was not filed in the name of
13 the owner of the registration, the deficiency may be cor-
14 rected after the statutory time period, within the time pre-
15 scribed after notification of the deficiency. Such submis-
16 sion shall be accompanied by the additional deficiency sur-
17 charge prescribed by the Director.

18 “(d) NOTICE OF REQUIREMENT.—Special notice of
19 the requirement for such affidavit shall be attached to
20 each certificate of registration and notice of publication
21 under section 12(e).

22 “(e) NOTIFICATION OF ACCEPTANCE OR REFUSAL.—
23 The Director shall notify any owner who files any affidavit
24 required by this section of the Director’s acceptance or

1 refusal thereof and, in the case of a refusal, the reasons
2 therefor.

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

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

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

24 “(a) TIME PERIODS FOR REQUIRED AFFIDAVITS.—
25 Each extension of protection for which a certificate has

1 been issued under section 69 shall remain in force for the
2 term of the international registration upon which it is
3 based, except that the extension of protection of any mark
4 shall be canceled by the Director unless the holder of the
5 international registration files in the United States Patent
6 and Trademark Office affidavits that meet the require-
7 ments of subsection (b), within the following time periods:

8 “(1) Within the 1-year period immediately pre-
9 ceding the expiration of 6 years following the date
10 of issuance of the certificate of extension of protec-
11 tion.

12 “(2) Within the 1-year period immediately pre-
13 ceding the expiration of 10 years following the date
14 of issuance of the certificate of extension of protec-
15 tion, and each successive 10-year period following
16 the date of issuance of the certificate of extension of
17 protection.

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

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

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

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

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

10 “(D) be accompanied by the fee prescribed by
11 the Director; or

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

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

19 “(C) be accompanied by the fee prescribed by
20 the Director.

21 “(c) DEFICIENT AFFIDAVIT.—If any submission filed
22 within the period set forth in subsection (a) is deficient,
23 including that the affidavit was not filed in the name of
24 the holder of the international registration, the deficiency
25 may be corrected after the statutory time period, within

1 the time prescribed after notification of the deficiency.
2 Such submission shall be accompanied by the additional
3 deficiency surcharge prescribed by the Director.

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

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

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

1 mark Office the name and address of a person resident
 2 in the United States on whom may be served notices or
 3 process in proceedings affecting the mark, such notices or
 4 process may be served on the Director.”.

5 **SEC. 4. STUDY AND REPORT.**

6 (a) IN GENERAL.—Not later than 1 year after the
 7 date of enactment of this Act, the Secretary of Commerce,
 8 in consultation with the Intellectual Property Enforcement
 9 Coordinator, shall study and report to the Committee on
 10 the Judiciary of the Senate and the Committee on the Ju-
 11 diciary of the House of Representatives on—

12 (1) the extent to which small businesses may be
 13 harmed by litigation tactics by corporations attempt-
 14 ing to enforce trademark rights beyond a reasonable
 15 interpretation of the scope of the rights granted to
 16 the trademark owner; and

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

19 (b) RECOMMENDATIONS.—The study and report re-
 20 quired under paragraph (1) shall also include any policy
 21 recommendations the Secretary of Commerce and the In-
 22 tellectual Property Enforcement Coordinator deem appro-
 23 priate.

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