

**U.S. LEGISLATIVE CHANGES TO THE LANHAM ACT  
UNDER INTERNATIONAL AND DOMESTIC INITIATIVES**

PREPARED BY

OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C.

DECEMBER 1995

## TABLE OF CONTENTS

	Page
GATT/TRIPS/WORLD TRADE ORGANIZATION .....	1, 12
NORTH AMERICAN FREE TRADE AGREEMENT .....	2, 5
TRADEMARK LAW TREATY .....	4
ANTICOUNTERFEITING CONSUMER PROTECTION ACT OF 1995 .....	7
FEDERAL TRADEMARK DILUTION ACT OF 1995 .....	9
THE MADRID PROTOCOL .....	13

<b>GATT/TRIPS/WORLD TRADE ORGANIZATION</b>		
<b>Present Statute</b>	<b>Revised Statutory Provision</b>	<b>Authority/Effective Date</b>
<p><u>Marks Registrable on the Principal Register</u></p> <p><u>SEC. 2</u> No trademark by which the goods of the applicant may be distinguished from the goods of others shall be refused registration on the principal register on account of its nature unless it--</p> <p><u>Subsection 2(a)</u> Consists of or comprises immoral, deceptive, or scandalous matter; or matter which may disparage or falsely suggest a connection with persons, living or dead, institutions, beliefs, or national symbols, or bring them into contempt, or disrepute.</p>	<p>Consists of or comprises immoral, deceptive, or scandalous matter; or matter which may disparage or falsely suggest a connection with persons, living or dead, institutions, beliefs, or national symbols, or bring them into contempt, or disrepute; <i>which, when use on or in connection with wines or spirits, identifies a place other than the origin of the goods and is first used on or in connection with wines or spirits by the applicant on or after one year after the date on which the WTO Agreement (as defined in Section 2(a) of the Uruguay Round Agreements Act) enters into force with respect to the United States.</i></p>	<p>Bill to Implement the World Trade Organization, December 8, 1994; GATT/TRIPS provisions regarding trademarks to take effect January 1, 1996, Official Gazette Notice pending</p>

NORTH AMERICAN FREE TRADE AGREEMENT		
Present Statute	Revised Statutory Provision	Authority/Effective Date
<p><u>Subsection 2(e)</u>            Consists of a mark which (1) when used on or in connection with the goods of the applicant is merely descriptive or deceptively misdescriptive of them, or (2) when used on or in connection with the goods of the applicant is primarily geographically descriptive or deceptively misdescriptive of them, except as indications of regional origin may be registrable under section 1054 of this title, or (3) is primarily merely a surname</p>	<p>Consists of a mark which (1) when used on or in connection with the goods of the applicant is merely descriptive or deceptively misdescriptive of them, (2) when used on or in connection with the goods of the applicant is primarily geographically descriptive [or deceptively misdescriptive] of them, except as indications of regional origin may be registrable under section 4, (3) <i>when used on or in connection with the goods of the applicant is primarily geographically deceptively misdescriptive of them, or (4),</i> is primarily merely a surname</p>	<p>North American Free Trade Agreement Implementation Act            December 8, 1993</p>

<b>NORTH AMERICAN FREE TRADE AGREEMENT</b>		
<b>Present Statute</b>	<b>Revised Statutory Provision</b>	<b>Authority/Effective Date</b>
<p><u>Subsection 2(f)</u></p> <p>Except as expressly excluded in paragraphs (a), (b), (c), and (d) of this section, nothing in this chapter shall prevent the registration of a mark used by the applicant which has become distinctive of the applicant's goods in commerce. The Commissioner may accept as prima facie evidence that the mark has become distinctive, as used on or in connection with applicant's goods in commerce, proof of substantially exclusive and continuous use thereof as a mark by the applicant in commerce for the five years before the date on which the claim of distinctiveness is made.</p>	<p>Except as expressly excluded in paragraphs (a), (b), (c), (d), <b>and (e)(3)</b> of this section, nothing herein shall prevent the registration of a mark used by the applicant which has become distinctive of the applicant's goods in commerce. The Commissioner may accept as prima facie evidence that the mark has become distinctive, as used on or in connection with the applicant's goods in commerce, proof of substantially exclusive and continuous use thereof as a mark by the applicant in commerce for the five years before the date on which the claim of distinctiveness is made. <b><i>Nothing in this section shall prevent the registration of a mark which, when used on or in connection with the goods of the applicant, is primarily geographically deceptively misdescriptive of them, and which became distinctive of the applicant's goods in commerce before the date of the enactment of the North American Free Trade Agreement Implementation Act.</i></b></p>	<p>North American Free Trade Agreement Implementation Act December 8, 1993</p>

<b>TRADEMARK LAW TREATY</b>		
<b>Present Statute</b>	<b>Revised Statutory Provision</b>	<b>Authority/Effective Date</b>
<p>Renewal <u>Section 9(a)</u></p> <p>Each registration may be renewed for periods of ten years from the end of the expiring period upon payment of the prescribed fee and the filing of a verified application therefor, setting forth those goods or services recited in the registration on or in connection with which the mark is still in use in commerce and having attached thereto a specimen or facsimile showing current use of the mark, or showing that any nonuse is due to special circumstances which excuse such nonuse and it is not due to any intention to abandon the mark. Such application may be made at any time within six months before the expiration of the period for which the registration was issued or renewed, or it may be made within three months after such expiration on payment of the additional fee herein described.</p>	<p>Each registration may be renewed for periods of ten years from the end of the expiring period upon payment of the prescribed fee and the filing of a verified application therefor, setting forth those goods or services recited in the registration on or in connection with which the mark is still in use in commerce and having attached thereto a specimen or facsimile showing current use of the mark, or showing that any nonuse is due to special circumstances which excuse such nonuse and it is not due to any intention to abandon the mark. Such application may be made at any time within six months before the expiration of the period for which the registration was issued or renewed, or it may be made within <i>six</i> months after such expiration on payment of the additional fee herein described.</p>	<p>Trademark Law Treaty/Legislation presently being drafted</p> <p>The renewal grace period will be six months. Article 13(1)(i). Rule 8</p> <p>Contracting parties are prohibited from requiring submission of a declaration and/or evidence concerning use of the mark for purposes of renewal. However, the TLT does not prohibit the USPTO from requiring proof of use to maintain a registration independently of renewal. Article 13(4)(iii). Transitional Provision Article 22(5) may be invoked.</p>

<b>NORTH AMERICAN FREE TRADE AGREEMENT</b>		
<b>Present Statute</b>	<b>Revised Statutory Provision</b>	<b>Authority/Effective Date</b>
<p>TITLE II-THE SUPPLEMENTAL REGISTER Section 23(a)</p> <p>In addition to the principal register, the Commissioner shall keep a continuation of the register provided in paragraph (b) of section 1 of the Act of March 19, 1920, entitled "An Act to give effect to certain provisions of the convention for the protection of trademarks and commercial names, made and signed in the city of Buenos Aires, in the Argentine Republic, August 20, 1910, and for other purposes", to be called the supplemental register. All marks capable of distinguishing applicant's goods or services and not registrable on the principal register provided in this chapter, except those declared to be unregistrable under subsections (a), (b), (c) and (d) of section 1052 of this title, which are in lawful use in commerce by the owner thereof, on or in connection with any goods or services of the application may be registered on the supplemental register upon the payment of the prescribed fee and compliance with the provisions of subsections (a) and (e) of section 1051 of this title.</p>	<p>In addition to the principal register, the Commissioner shall keep a continuation of the register provided in paragraph (b) of section 1 of the Act of March 19, 1920, entitled "An Act to give effect to certain provisions of the convention for the protection of trademarks and commercial names, made and signed in the city of Buenos Aires, in the Argentine Republic, August 20, 1910, and for other purposes", to be called the supplemental register. All mark capable of distinguishing applicant's goods or services and not register herein provided, except those declared to be unregistrable under subsections (a), (b), (c), (d), <b>and (e)(3)</b> of section 2 of this Act, which are in lawful use in commerce by the owner thereof, on or in connection with any goods or services may be registered on the supplemental register upon the payment of the prescribed fee and compliance with the provisions of subsection (a) and (e) of section 1 so far as they are applicable. <b><i>Nothing in this section shall prevent the registration on the supplemental register of a mark, capable of distinguishing the applicant's goods or services and not</i></b></p>	<p>North American Free Trade Agreement Implementation Act December 8, 1993</p>

<b>NORTH AMERICAN FREE TRADE AGREEMENT</b>		
<b>Present Statute</b>	<b>Revised Statutory Provision</b>	<b>Authority/Effective Date</b>
	<p><u>Section 23(a) (Continued)</u>  <i>registrable on the principal register under this Act, that is declared to be unregistrable under Section 2(e)(3), if such mark has been in lawful use in commerce by the owner thereof, on or in connection with any goods or services, since before the date of the enactment of the North American Free Trade Agreement Implementation Act.</i></p>	



ANTICOUNTERFEITING CONSUMER PROTECTION ACT OF 1995		
Present Statute	Revised Statutory Provision	Authority/Effective Date
TITLE VI-REMEDIES Injunctions Section 34(d)(9) The court shall order that a United States marshal or other law enforcement officer is to serve a copy of the order under this subsection and then is to carry out the seizure under such order.	<i>The Court shall order that service of a copy of the order under this subsection shall be made by a Federal law enforcement officer (such as a United States marshal or an officer or agent of the United States Customs Service, Federal Bureau of Investigation, or Post Office) or may be made by a State or local law enforcement officer, who, upon making service, shall carry out the seizure under the order .</i>	Anticounterfeiting Consumer Protection Act of 1995, S. 1136, pending

<b>ANTICOUNTERFEITING CONSUMER PROTECTION ACT OF 1995</b>		
<b>Present Statute</b>	<b>Revised Statutory Provision</b>	<b>Authority/Effective Date</b>
<p>Monetary Relief  <u>Section 35</u>            (new)</p>	<p><u>Section 35(c)</u>            In a case involving the use of a counterfeit mark (as defined in section 34(d) (15 U.S.C. 1116(d)) in connection with the sale, offering for sale, or distribution of goods or services, the plaintiff may elect, at any time before final judgment is rendered by the trial court, to recover, instead of actual damages and profits under subsection (a), an award of statutory damages for any such use in the amount of-</p> <p>(1) not less than \$500 or more than \$100,000 per counterfeit mark per type of goods or services sold, offered for sale, or distributed, as the court considers just; or</p> <p>(2) if the court finds that the use of the counterfeit mark was willful, not more than \$1,000,000 per counterfeit mark per type of goods or services sold, offered for sale, or distributed, as the court considers just.</p>	<p>Anticounterfeiting Consumer Protection Act of 1995, S. 1136, pending</p>

<b>FEDERAL TRADEMARK DILUTION ACT OF 1995</b>		
<b>Present Statute</b>	<b>Revised Statutory Provision</b>	<b>Authority/Effective Date</b>
<p>TITLE VIII-FALSE DESIGNATIONS OF ORIGIN AND FALSE DESCRIPTIONS FORBIDDEN  <u>Section 43</u>            (new)</p>	<p>TITLE VIII-FALSE DESIGNATIONS OF ORIGIN, FALSE DESCRIPTIONS, AND DILUTION FORBIDDEN            (c)(1) The registrant of a famous mark registered under the Act of March 3, 1881, or the Act of February 20, 1905, or on the principal register shall be entitled, subject to the principles of equity and upon such terms as the court deems reasonable, to an injunction against another person's commercial use in commerce of a mark or trade name, if such use begins after the registrant's mark becomes famous and causes dilution of the distinctive quality of the registrant's mark, and to obtain such other relief as is provided in this subsection. In determining whether a mark is distinctive and famous, a court may consider factors such as, but not limited to-</p> <ul style="list-style-type: none"> <li>(A) the degree of inherent or acquired distinctiveness of the mark;</li> <li>(B) the duration and extent of use of the mark in connection with the goods or services with which the mark is used;</li> <li>(C) the duration and extent of advertising and publicity of the mark;</li> <li>(D) the geographical extent of the trading area in which the mark is used;</li> <li>(E) the channels of trade for the goods or services with which the mark is used;</li> <li>(F) the degree of recognition of the registrant's mark in the trading areas and channels of trade of the registrant</li> </ul>	<p>Bill to Establish Lanham Act Protection Against Dilution (H.R. 1295), pending</p>

<b>FEDERAL TRADEMARK DILUTION ACT OF 1995</b>		
<b>Present Statute</b>	<b>Revised Statutory Provision</b>	<b>Authority/Effective Date</b>
<u>43 (Continued)</u>	<p>and the person against whom the injunction is sought; and</p> <p>(G) the nature and extent of use of the same or similar marks by third parties.</p> <p>(2) In an action brought under this subsection, the registrant shall be entitled only to injunctive relief unless the person against whom the injunction is sought willfully intended to trade on the registrant's reputation or to cause dilution of the registrant's mark. If such willful intent is proven, the registrant shall also be entitled to remedies set forth in sections 35(a) and 36, subject to the discretion of the court and the principles of equity.</p> <p>(3) The ownership by a person of a valid registration of a mark under the Act of March 3, 1881, or the Act of February 20, 1905, or on the principal register shall be a complete bar to an action against that person, with respect to that mark, that is brought by another person under the common law or a statute of a State and that seeks to prevent dilution of the distinctiveness of a mark, label, or form of advertisement.</p> <p>(4) The following shall not be actionable under this section:</p> <p style="padding-left: 20px;">(A) Fair use of a registrant's mark by another person in comparative commercial advertising or promotion to identify the registrant's competing goods or services.</p> <p style="padding-left: 20px;">(B) Noncommercial use of a mark.</p>	

<b>FEDERAL TRADEMARK DILUTION ACT</b>		
<b>Present Statute</b>	<b>Revised Statutory Provision</b>	<b>Authority/Effective Date</b>
TITLE X-CONSTRUCTION AND DEFINITIONS <u>Section 45</u> (new)	Section 45 of the Trademark Act of 1946 (15 USC 1127) is amended by inserting after the paragraph defining when a mark shall be "abandoned" the following: "The term 'dilution' means the lessening of the capacity of a registrant's mark to identify and distinguish goods or services, regardless of the presence or absence of-- "(1) competition between the registrant and other parties, or "(2) likelihood of confusion, mistake, or deception".	Bill to Establish Lanham Act Protection Against Dilution (H.R. 1295), pending

<b>GATT/TRIPS/WORLD TRADE ORGANIZATION</b>		
<b>Present Statute</b>	<b>Revised Statutory Provision</b>	<b>Authority/Effective Date</b>
<p><u>Section 45</u> Abandonment A mark shall be deemed to be "abandoned" when either of the following occurs: (1) When its use has been discontinued with intent not to resume such use. Intent not to resume may be inferred from circumstances. Nonuse for two consecutive years shall be prima facie evidence of abandonment.</p>	<p>A mark shall be deemed to be "abandoned" when either of the following occurs: (1) When its use has been discontinued with intent not to resume such use. Intent not to resume may be inferred from circumstances. Nonuse for <i>three</i> consecutive years shall be prima facie evidence of abandonment.</p>	<p>Bill to Implement the World Trade Organization, signed December 8, 1994; GATT/TRIPS provisions regarding trademarks to take effect January 1, 1996, Official Gazette Notice pending</p>

<b>THE MADRID PROTOCOL</b>		
<b>Present Statute</b>	<b>Revised Statutory Provision</b>	<b>Authority/Effective Date</b>
<p>TITLE XII-THE MADRID PROTOCOL  <u>Section 60</u>            (new)</p>	<p><b>"SEC. 60. DEFINITIONS.</b>            "For purposes of this title:            "(1) MADRID PROTOCOL.-The term 'Madrid Protocol' means the Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks, adopted at Madrid, Spain, on June 27, 1989.            "(2) BASIC APPLICATION.-The term 'basic application' means the application for the registration of a mark that has been filed with an Office of a Contracting Party and that constitutes the basis for an application for the international registration of that mark.            "(3) BASIC REGISTRATION.-The term 'basic registration' means the registration of a mark that has been granted by an Office of a Contracting Party and that constitutes the basis for an application for the international registration of that mark.            "(4) CONTRACTING PARTY.-The term 'Contracting Party' means any country or inter-governmental organization that is a party to the Madrid Protocol.            "(5) DATE OF RECORDAL.-The term 'date of recordal' means the date on which a request for extension of protection that is filed after an international registration is granted is recorded on the International Register.</p>	<p>Bill to Implement Madrid Protocol (H.R. 1270), pending</p>

<b>THE MADRID PROTOCOL</b>		
<b>Present Statute</b>	<b>Revised Statutory Provision</b>	<b>Authority/Effective Date</b>
<u>Section 60 (Continued)</u>	<p>"(6) DECLARATION OF BONA FIDE INTENTION TO USE THE MARK IN COMMERCE.-The term 'declaration of bona fide intention to use the mark in commerce' means a declaration that is signed by the applicant for, or holder of, an international registration who is seeking extension of protection of a mark to the United States and that contains a statement that-</p> <p>"(A) the applicant or holder has a bona fide intention to use the mark in commerce,</p> <p>"(B) the person making the declaration believes himself or herself, or the firm, corporation, or association in whose behalf he or she makes the declaration, to be entitled to use the mark in commerce, and</p> <p>"(C) no other person, firm, corporation, or association, to the best of his or her knowledge and belief, has the right to use such mark in commerce either in the identical form of the mark or in such near resemblance to the mark as to be likely, when used on or in connection with the goods of such other person, firm, corporation, or association, to cause confusion, or to cause mistake, or to deceive.</p> <p>"(7) EXTENSION OF PROTECTION.-The term 'extension of protection' means the protection resulting from an international registration that extends to a Contracting Party at the request of the holder of the international registration, in accordance with the Madrid Protocol.</p>	



<b>THE MADRID PROTOCOL</b>		
<b>Present Statute</b>	<b>Revised Statutory Provision</b>	<b>Authority/Effective Date</b>
<u>Section 60 (Continued)</u>	<p>"(8) HOLDER OF AN INTERNATIONAL REGISTRATION.- A 'holder' of an international registration is the natural or juristic person in whose name the international registration is recorded on the International Register.</p> <p>"(9) INTERNATIONAL APPLICATION.- The term 'international application' means an application for international registration that is filed under the Madrid Protocol.</p> <p>"(10) INTERNATIONAL BUREAU.-The term 'International Bureau' means the International Bureau of the World Intellectual Property Organization.</p> <p>"(11) INTERNATIONAL REGISTER.-The term 'International Register' means the official collection of such data concerning international registrations maintained by the International Bureau that the Madrid Protocol or its implementing regulations require or permit to be recorded, regardless of the medium which contains such data.</p> <p>"(12) INTERNATIONAL REGISTRATION.-The term 'international registration' means the registration of a mark granted under the Madrid Protocol.</p>	

<b>THE MADRID PROTOCOL</b>		
<b>Present Statute</b>	<b>Revised Statutory Provision</b>	<b>Authority/Effective Date</b>
<u>Section 60 (Continued)</u>	<p>"(13) INTERNATIONAL REGISTRATION DATE. The term 'international registration date' means the date assigned to the international registration by the International Bureau.</p> <p>"(14) NOTIFICATION OF REFUSAL.-The term 'notification of refusal' means the notice sent by an Office of a Contracting Party to the International Bureau declaring that an extension of protection cannot be granted.</p> <p>"(15) OFFICE OF A CONTRACTING PARTY.-The term 'Office of a Contracting Party' means-</p> <p style="padding-left: 40px;">"(A) the office, or governmental entity, of a Contracting Party that is responsible for the registration of marks, or</p> <p style="padding-left: 40px;">"(B) the common office, or governmental entity, of more than 1 Contracting Party that is responsible for the registration of marks and is so recognized by the International Bureau.</p> <p>"(16) OFFICE OF ORIGIN.-The term 'office of origin' means the Office of a Contracting Party with which a basic application was filed or by which a basic registration was granted.</p>	

<b>THE MADRID PROTOCOL</b>		
<b>Present Statute</b>	<b>Revised Statutory Provision</b>	<b>Authority/Effective Date</b>
<u>Section 60 (Continued)</u>	"(17) OPPOSITION PERIOD.-The term 'opposition period' means the time allowed for filing an opposition in the Patent and Trademark Office, including any extension of time granted under section 13.	

<b>THE MADRID PROTOCOL</b>		
<b>Present Statute</b>	<b>Revised Statutory Provision</b>	<b>Authority/Effective Date</b>
<u>Section 61</u> (new)	<p><b>"SEC. 61. INTERNATIONAL APPLICATIONS BASED ON UNITED STATES APPLICATIONS OR REGISTRATIONS.</b></p> <p>"The owner of a basic application pending before the Patent and Trademark Office, or the owner of a basic registration granted by the Patent and Trademark Office, who-</p> <p>"(1) is a national of the United States,            "(2) is domiciled in the United States, or            "(3) has a real and effective industrial or commercial establishment in the United States, may file an international application by submitting to the Patent and Trademark Office a written application in such form, together with such fees, as may be prescribed by the Commissioner.</p>	Bill to Implement Madrid Protocol (H.R. 1270), pending

<b>THE MADRID PROTOCOL</b>		
<b>Present Statute</b>	<b>Revised Statutory Provision</b>	<b>Authority/Effective Date</b>
<u>Section 62</u> (new)	<p><b>"SEC. 62. CERTIFICATION OF THE INTERNATIONAL APPLICATION.</b></p> <p>"Upon the filing of an application for international registration and payment of the prescribed fees, the Commissioner shall examine the international application for the purpose of certifying that the information contained in the international application corresponds to the information contained in the basic application or basic registration at the time of the certification. Upon examination and certification of the international application, the Commissioner shall transmit the international application to the International Bureau.</p>	Bill to Implement Madrid Protocol (H.R. 1270), pending

<b>THE MADRID PROTOCOL</b>		
<b>Present Statute</b>	<b>Revised Statutory Provision</b>	<b>Authority/Effective Date</b>
<p><u>Section 63</u> (new)</p>	<p><b>"SEC. 63. RESTRICTION, ABANDONMENT, CANCELLATION, OR EXPIRATION OF A BASIC APPLICATION OR BASIC REGISTRATION.</b></p> <p>"With respect to an international application transmitted to the International Bureau under section 62, the Commissioner shall notify the International Bureau whenever the basic application or basic registration which is the basis for the international application has been restricted, abandoned, or canceled, or has expired, with respect to some or all of the goods and services listed in the international registration-</p> <p>"(1) within 5 years after the international registration date; or</p> <p>"(2) more than 5 years after the international registration date if the restriction, abandonment, or cancellation of the basic application or basic registration resulted from an action that began before the end of that 5-year period.</p>	<p>Bill to Implement Madrid Protocol (H.R. 1270), pending</p>

<b>THE MADRID PROTOCOL</b>		
<b>Present Statute</b>	<b>Revised Statutory Provision</b>	<b>Authority/Effective Date</b>
<p><u>Section 64</u> (new)</p>	<p><b>"SEC. 64. REQUEST FOR EXTENSION OF PROTECTION SUBSEQUENT TO INTERNATIONAL REGISTRATION.</b>            "The holder of an international registration that is based upon a basic application filed with the Patent and Trademark Office or a basic registration granted by the Patent and Trademark Office may request an extension of protection of its international registration by filing such a request-            " (1) directly with the International Bureau,            or            "(2) with the Patent and Trademark Office for transmittal to the International Bureau, if the request is in such form, and contains such transmittal fee, as may be prescribed by the Commissioner.</p>	<p>Bill to Implement Madrid Protocol (H.R. 1270), pending</p>

<b>THE MADRID PROTOCOL</b>		
<b>Present Statute</b>	<b>Revised Statutory Provision</b>	<b>Authority/Effective Date</b>
<p><u>Section 65</u> (new)</p>	<p><b>"SEC. 65. EXTENSION OF PROTECTION OF AN INTERNATIONAL REGISTRATION TO THE UNITED STATES UNDER THE MADRID PROTOCOL.</b></p> <p>"(a) IN GENERAL.-Subject to the provisions of section 68, the holder of an international registration shall be entitled to the benefits of extension of protection of that international registration to the United States to the extent necessary to give effect to any provision of the Madrid Protocol.</p> <p>"(b) IF UNITED STATES IS OFFICE OF ORIGIN.-An extension of protection resulting from an international registration of a mark shall not apply to the United States if the Patent and Trademark Office is the office of origin with respect to that mark.</p>	<p>Bill to Implement Madrid Protocol (H.R. 1270), pending</p>



<b>THE MADRID PROTOCOL</b>		
<b>Present Statute</b>	<b>Revised Statutory Provision</b>	<b>Authority/Effective Date</b>
<p><u>Section 66</u> (new)</p>	<p><b>"SEC. 66. EFFECT OF FILING A REQUEST FOR EXTENSION OF PROTECTION OF AN INTERNATIONAL REGISTRATION TO THE UNITED STATES.</b></p> <p>"(a) REQUIREMENT FOR REQUEST FOR EXTENSION OF PROTECTION.-A request for extension of protection of an international registration to the United States that the International Bureau transmits to the Patent and mark Office shall be deemed to be properly filed in the United States if such request, when received by the International Bureau, has attached to it a declaration of bona fide intention to use the mark in commerce that is verified by the applicant for, or holder of, the international registration.</p> <p>"(b) EFFECT OF PROPER FILING.-Unless extension protection is refused under section 68, the proper filing of the request for extension of protection under subsection (a) shall constitute constructive use of the mark, conferring the same rights as those specified in section 7(c), as of the earliest of the following:</p> <p>"(1) The international registration date, if the request for extension of protection was filed in the international application.</p>	<p>Bill to Implement Madrid Protocol (H.R. 1270), pending</p>

<b>THE MADRID PROTOCOL</b>		
<b>Present Statute</b>	<b>Revised Statutory Provision</b>	<b>Authority/Effective Date</b>
<u>Section 66 (continued)</u>	"(2) The date of recordal of the request for extension of protection, if the request for extension of protection was made after the international registration date." (3) The date of priority claimed pursuant to section 67.	

<b>THE MADRID PROTOCOL</b>		
<b>Present Statute</b>	<b>Revised Statutory Provision</b>	<b>Authority/Effective Date</b>
<p><u>Section 67</u> (new)</p>	<p><b>SEC. 67. RIGHT OF PRIORITY FOR REQUEST FOR EXTENSION OF PROTECTION TO THE UNITED STATES.</b>            "The holder of an international registration with an extension of protection to the United States shall be entitled claim a date of priority based on the right of priority within the meaning of Article 4 of the Paris Convention for the Protection of Industrial Property if-</p> <p>"(1) the international registration contained a claim of such priority; and</p> <p>"(2)(A) the international application contained a request for extension of protection to the United States, or</p> <p>"(B) the date of recordal of the request for extension of protection to the United States is not later than 6 months after the date of the first regular national filing (within the meaning of Article 4(A)(3) of the Paris Convention for the Protection of Industrial Property) or a subsequent application (within the meaning of Article 4(C)(4) of the Paris Convention).</p>	<p>Bill to Implement Madrid Protocol (H.R. 1270), pending</p>

<b>THE MADRID PROTOCOL</b>		
<b>Present Statute</b>	<b>Revised Statutory Provision</b>	<b>Authority/Effective Date</b>
<p><u>Section 68</u> (new)</p>	<p><b>SEC. 68. EXAMINATION OF AND OPPOSITION TO REQUEST FOR EXTENSION OF PROTECTION; NOTIFICATION OF REFUSAL.</b>  "(a) EXAMINATION AND OPPOSITION.-(1) A request extension of protection described in section 66(a) shall be examined as an application for registration on the Principal Registration under this Act, and if on such examination it appears that the applicant is entitled to extension of protection under this title, the Commissioner shall cause the mark to be published in the Official Gazette of the Patent and Trademark Office.  "(2) Subject to the provisions of subsection (c), a request for extension of protection under this title shall be subject to opposition under section 13. Unless successfully opposed, the request for extension of protection shall not be refused.  "(3) Extension of protection shall not be refused under this section on the ground that the mark has not been used in commerce.  "(4) Extension of protection shall be refused under this section to any mark not registrable on the Principal Register.  "(b) NOTIFICATION OF REFUSAL.-If, a request for extension of protection is refused under subsection</p>	<p>Bill to Implement Madrid Protocol (H.R. 1270), pending</p>

**THE MADRID PROTOCOL**

<b>Present Statute</b>	<b>Revised Statutory Provision</b>	<b>Authority/Effective Date</b>
<u>Section 68 (Continued)</u>	<p>(a), the Commissioner shall declare in a notification of refusal (as provided in subsection (c)) that the extension of protection cannot be granted, together with a statement of all grounds on which the refusal was based.</p> <p>"(c) NOTICE TO INTERNATIONAL BUREAU.-(1) Within 18 months after the date on which the International Bureau transmits to the Patent and Trademark Office a notification of a request for extension of protection, the Commissioner shall transmit to the International Bureau any of the following that applies to such request:</p> <p>"(A) A notification of refusal based on an examination of the request for extension of protection.</p> <p>"(B) A notification of refusal based on the filing of an opposition to the request.</p> <p>"(C) A notification of the possibility that an opposition to the request may be filed after the end of that 18 month period.</p> <p>"(2) If the Commissioner has sent a notification of the possibility of opposition under paragraph (1)(C), the Commissioner shall, if applicable, transmit to the International Bureau a notification of refusal on the basis of the opposition, together with a statement of all the grounds for the opposition, within 7 months after the beginning of the opposition period or within 1 month after the end of the opposition period, whichever is earlier.</p>	

**THE MADRID PROTOCOL**

<b>Present Statute</b>	<b>Revised Statutory Provision</b>	<b>Authority/Effective Date</b>
<p><u>Section 68 (Continued)</u></p>	<p>"(3) If a notification of refusal of a request for extension of protection is transmitted under paragraph (1) or (2), no grounds for refusal of such request other than those set forth in such notification may be transmitted to the International Bureau by the Commissioner after the expiration of the time periods set forth in paragraph (1) or (2), as the case may be.</p> <p>"(4) If a notification specified in paragraph (1) or (2) is not sent to the International Bureau within the time period set forth in such paragraph, with respect to a request for extension of protection, the request for extension of protection shall not be refused and the Commissioner shall issue a certificate of extension of protection pursuant to the request.</p> <p>"(d) DESIGNATION OF AGENT FOR SERVICE OF PROCESS.-In responding to a notification of refusal with respect to a mark, the holder of the international registration of the mark shall designate, by a written document filed in the Patent and Trademark Office, the name and address of a person resident in the United States on whom may be served notices or process in proceedings affecting the mark. Such notices or process may be served upon the person so designated by leaving with that person, or mailing to that person, a copy thereof at the address specified in the last designation so filed. If the person so designated cannot be found at the address given in the last designation, such notice or process may be served upon the Commissioner.</p>	

<b>THE MADRID PROTOCOL</b>		
<b>Present Statute</b>	<b>Revised Statutory Provision</b>	<b>Authority/Effective Date</b>
<p><u>Section 69</u> (new)</p>	<p><b>SEC. 69. EFFECT OF EXTENSION OF PROTECTION</b>            "(a) ISSUANCE OF EXTENSION OF PROTECTION.-Unless a request for extension of protection is refused under section 68, the Commissioner shall issue a certificate of extension of protection pursuant to the request and shall cause notice of such certificate of extension of protection to be published in the Official Gazette of the Patent and Trademark Office.            "(b) EFFECT OF EXTENSION OF PROTECTION.-From the date on which a certificate of extension of protection is issued under subsection (a)-            "(1) such extension of protection shall have the same effect and validity as a registration on the Principal Register, and "(2) the holder of the international registration shall have the same rights and remedies as the owner of a registration on the Principal Register.</p>	<p>Bill to Implement Madrid Protocol (H.R. 1270), pending</p>

<b>THE MADRID PROTOCOL</b>		
<b>Present Statute</b>	<b>Revised Statutory Provision</b>	<b>Authority/Effective Date</b>
<p><u>Section 70</u> (new)</p>	<p><b>"SEC. 70. DEPENDENCE OF EXTENSION OF PROTECTION TO THE UNITED STATES ON THE UNDERLINING INTERNATIONAL REGISTRATION</b></p> <p>"(a) EFFECT OF CANCELLATION OF INTERNATIONAL REGISTRATION.-If the International Bureau notifies the Patent and Trademark Office of the cancellation of an international registration with respect to some or all of the goods and services listed in the international registration, the Commissioner shall cancel any extension of protection to the United States with respect to such goods and services as of the date on which the international registration was canceled.</p> <p>(b) EFFECT OF FAILURE TO RENEW INTERNATIONAL REGISTRATION.-If the International Bureau does not renew an international registration, the corresponding extension of protection to the United States shall cease to be valid as of the date of the expiration of the international registration.</p> <p>"(c) TRANSPORTATION OF AN EXTENSION OF PROTECTION INTO A UNITED STATES APPLICATION.-The holder of an international registration canceled in whole or in part by the International Bureau at the request of the office of origin, under Article 6(4) of the</p>	<p>Bill to Implement Madrid Protocol (H.R. 1270), pending</p>



<b>THE MADRID PROTOCOL</b>		
<b>Present Statute</b>	<b>Revised Statutory Provision</b>	<b>Authority/Effective Date</b>
<u>Section 70 (Continued)</u>	<p>Madrid Protocol, may file an application, under section 1 or 44 of this Act, for the registration of the same mark for any of the goods and services to which the cancellation applies that were covered by an extension of protection to the United States based on that international registration. Such an application shall be treated as if it had been filed on the international registration date or the date of recordal of the request for extension of protection with the International Bureau, whichever date applies, and, if the extension of protection enjoyed priority under section 67 of this title, shall enjoy the same priority. Such an application shall be entitled to the benefits covered by this subsection only if the application is filed not later than 3 months after the date on which the international registration was canceled, in whole or in part, and only if the application complies with all the requirements of this Act which apply to any application filed pursuant to section 1 or 44.</p>	

<b>THE MADRID PROTOCOL</b>		
<b>Present Statute</b>	<b>Revised Statutory Provision</b>	<b>Authority/Effective Date</b>
<p><u>Section 71</u> (new)</p>	<p><b>"SEC. 71 AFFIDAVITS AND FEES.</b>  <b>"(a) REQUIRED AFFIDAVITS AND FEES.</b>-An extension of protection for which a certificate of extension of protection has been issued under section 69 shall remain in force for the term of the international registration upon which it is based, except that the extension of protection of any mark shall be canceled by the Commissioner-</p> <p style="padding-left: 2em;">"(1) at the end of the 6-year period beginning on the date on which the certificate of extension of protection was issued by the Commissioner, unless within the 1-year period preceding the expiration of that 6-year period the holder of the international registration files in the Patent and Trademark Office an affidavit under subsection (b) together with a fee prescribed by the Commissioner; and</p> <p style="padding-left: 2em;">"(2) at the end of the 10-year period beginning on the date on which the certificate of extension of protection was issued by the Commissioner, and at the end of each 10-year period thereafter, unless-</p> <p style="padding-left: 4em;">(A) within the 6-month period preceding the expiration of such 10-year period the holder of the international registration files in the Patent and Trademark Office an affidavit under subsection (B) together with a fee prescribed by the Commissioner; or</p>	<p>Bill to Implement Madrid Protocol (H.R. 1270), pending</p>

<b>THE MADRID PROTOCOL</b>		
<b>Present Statute</b>	<b>Revised Statutory Provision</b>	<b>Authority/Effective Date</b>
<u>Section 71 (Continued)</u>	<p>"(B) within 3 months after the expiration of such 10-year period, the holder of the international registration files in the Patent and Trademark Office an affidavit under subsection (b) together with the fee described in subparagraph (A) and an additional fee prescribed by the Commissioner.</p> <p>"(b) CONTENTS OF AFFIDAVIT.-The affidavit referred to in subsection (a) shall set forth those goods or services recited in the extension of protection on or in connection with which the mark is in use in commerce and the holder of the international registration shall attach to the affidavit a specimen or facsimile showing the current use of the mark in commerce, or shall set forth that any nonuse is due to special circumstances which excuse such nonuse and is not due to any intention to abandon the mark. Special notice of the requirement for such affidavit shall be attached to each certificate of extension of protection.</p>	

<b>THE MADRID PROTOCOL</b>		
<b>Present Statute</b>	<b>Revised Statutory Provision</b>	<b>Authority/Effective Date</b>
<u>Section 72</u> (new)	<b>"SEC. 72. ASSIGNMENT OF AN EXTENSION OF PROTECTION.</b> "An extension of protection may be assigned, together with the goodwill associated with the mark, only to a person who is a national of, is domiciled in, or has a bona fide and effective industrial or commercial establishment either in a country that is a Contracting Party or in a country that is a member of an intergovernmental organization that is a Contracting Party.	Bill to Implement Madrid Protocol (H.R. 1270), pending
<u>Section 73</u> (new)	<b>"SEC. 73. INCONTESTABILITY</b> "The period of continuous use prescribed under section 15 for a mark covered by an extension of protection issued under this title may begin no earlier than the date on which the Commissioner issues the certificate of the extension of protection under section 69, except as provided in section 74.	Bill to Implement Madrid Protocol (H.R. 1270), pending

<b>THE MADRID PROTOCOL</b>		
<b>Present Statute</b>	<b>Revised Statutory Provision</b>	<b>Authority/Effective Date</b>
<u>Section 74</u> (new)	<p><b>"SEC. 74. RIGHTS OF EXTENSION OF PROTECTION.</b></p> <p>"An extension of protection shall convey the same rights as an existing registration for the same mark, if-</p> <p>"(1) the extension of protection and the existing registration are owned by the same person;</p> <p>"(2) the goods and services listed in the existing registration are also listed in the extension of protection; and</p> <p>"(3) the certificate of extension of protection is issued after the date of the existing registration."</p>	Bill to Implement Madrid Protocol (H.R. 1270), pending