

**THE TRADEMARK LAW TREATY,  
THE TRADEMARK LAW TREATY  
IMPLEMENTATION ACT, AND  
CHANGES IN UNITED STATES  
TRADEMARK PRACTICE**

*By P. Jay Hines\**

**I. INTRODUCTION**

The Trademark Law Treaty (“TLT”)<sup>1</sup> ushers in a new era in United States trademark practice. While the TLT always has been viewed as requiring only minor changes to the Lanham Act, we have not had such a sweeping overall change in United States trademark practice since the Trademark Law Revision Act of 1988,<sup>2</sup> which implemented intent-to-use. This article provides background information, an overview of the TLT, and a discussion of implementation of the Trademark Law Treaty Implementation Act (“TLTIA”)<sup>3</sup> by the United States Patent and Trademark Office (“USPTO”).<sup>4</sup>

**II. THE HISTORY OF THE TLT**

The TLT was adopted in Geneva, Switzerland on October 27, 1994, after six consecutive working sessions by the Trademark Committee of Experts. The original goal of the World Intellectual Property Organization (“WIPO”) was to harmonize substantive trademark law. This goal, however, proved too lofty a pursuit. Ultimately, the aim became the harmonization of administrative procedures for trademark applications, assignments and renewals, etc., including the adoption of a suppression of the requirements for the legalization and certification of signatures.<sup>5</sup>

The final working session of the Committee of Experts produced two working documents, namely, the draft TLT and draft

---

\* Partner in the firm of Oblon, Spivak, McClelland, Maier & Neustadt, P.C., Arlington, Virginia, Associate Member of the International Trademark Association; member of the Treaty Promotion Subcommittee of the External Affairs Committee of the International Trademark Association. © 2000 P. Jay Hines.

1. Trademark Law Treaty, Geneva, October 27, 1994.

2. Pub L No 100-667, 102 Stat 3935 (1988).

3. Pub L No 105-330, 112 Stat 3064 (15 USC §1051).

4. An overview of the major changes to the Lanham Act under the TLTIA follows at the end of this article as Appendix 1.

5. WIPO, “History of the Preparations for the Trademark Law Treaty,” Memorandum prepared by the International Bureau, Geneva, May 4, 1994; Basile Catomeris, “Trademark Law Treaty, WIPO’s Latest Convention,” 64 Trademark World 35, February, 1994.

regulations with model international forms. Over sixty Paris Union members, five observer state members of WIPO, sixteen non-governmental organizations,<sup>6</sup> and additional United Nations organizations participated. WIPO arranged for submission of the draft treaty, including regulations and standard forms to a Diplomatic Conference, which was held from October 10 through October 24, 1994.

The single greatest objection to the revised TLT was the provision allowing for a vote of the European Union, in addition to its member states. The voting rights issue, which also has until recently prevented United States accession to the Madrid Protocol,<sup>7</sup> was resolved by eliminating the provisions for a TLT Union and Assembly entirely. On October 27, 1994, thirty-six countries approved the draft Treaty. By October 27, 1995, fifty-one nations had signed the TLT, which took effect on August 1, 1996.<sup>8</sup>

To date, twenty-five countries have become a party to the TLT, including the United Kingdom, Japan and the Russian Federation. In addition, the United States Senate ratified the TLT on June 26, 1998. Implementing legislation, the TLTIA, was signed by President Clinton on October 30, 1998, to become effective one year later.

United States government representatives favored enactment of the treaty due to its potential benefits to trademark owners interested in international protection of marks and based upon the anticipated minimal changes to the Lanham Act necessary for compliance with the TLT. As long as the constitutionally-mandated United States use-based system and certain other substantive law requirements, such as assignment with good will, could be maintained, the United States delegation, headed by the USPTO's Michael Kirk, and assisted by Lynne Beresford and Carlyle Walters, promoted the adoption of the TLT and the streamlining of trademark procedures abroad.

---

6. Among the non-governmental organizations present were the International Trademark Association, the Brazilian Association of Industrial Property, the European Communities Trade Mark Association, the International Association for the Protection of Industrial Property, the International Chamber of Commerce, the International Federation of Industrial Property Attorneys, the Federation of German Industry, the Institute of Trademark Agents, the Japan Intellectual Property Association and the Arab Society for the Protection of Industrial Property. WIPO, Third Provisional List of Participants, Diplomatic Conference for the Conclusion of the Trademark Law Treaty, Geneva, October 20, 1994.

7. INTA Bulletin, Vol 55, No. 4, p. 1, February 15, 2000.

8. The first five nations to ratify the TLT, which caused it to become effective three months later, were the Czech Republic, Republic of Moldova, Sri Lanka, Ukraine and United Kingdom. INTA Bulletin, Vol 51 No. 10, p. 3, July 29, 1996. The text of the TLT and the Regulations, as well as the status of ratifications or accessions to the TLT, may be found at the World Intellectual Property Organization website at <http://www.wipo.org>.

The critical issue, as noted above, was the United States State Department's reluctance to agree to a precedent-setting separate vote for the European Union, apart from and in addition to the right of suffrage for member states. When the formal administrative mechanism was removed, making TLT a self-effectuating treaty, this resolved the matter.<sup>9</sup> The USPTO issued a Rules Package for TLTIA implementation.<sup>10</sup> A hearing was held by the USPTO on June 10, 1999 and comments on the proposed rules were due June 25, 1999. The final rules were issued on September 8, 1999.<sup>11</sup>

### III. MAJOR PROVISIONS OF THE TLT

#### A. *An Overview of the TLT*

TLT applies to marks consisting of "visible signs." Three dimensional marks are included, but not holograms, sound marks or olfactory marks. While service marks are explicitly covered, collective marks, certification marks and guarantee marks are excluded. With the notions of gesture, tactile and motion marks, as well as the discussion of other non-traditional marks being in vogue, one wonders if the scope of the TLT went far enough to effectively advance trademark jurisprudence. It is, however, a stepping stone.

While Contracting Parties<sup>12</sup> by declaration may exclude from application associated marks, defensive marks and derivative marks, key provisions, such as the prohibition of certification of signatures, may not be excluded.<sup>13</sup> Thus, the goal of the TLT to streamline and harmonize the procedural aspects of trademark registration is preserved.

In addition to providing for the registration of service marks, the TLT requires national Trademark Offices to accept multiclass applications, and to issue a single Certificate of Registration covering one or more classes of goods and services under the Nice Classification system.<sup>14</sup> The TLT provision allowing for the division of applications works in conjunction with the multiclass

---

9. The problem with this resolution, however, may come strongly to light in the future, when an expansion of TLT to address more substantive harmonization might be attempted.

10. 64 Fed Reg 25223 (May 11, 1999).

11. 64 Fed Reg 48900 (September 8, 1999).

12. TLT, Article 1, Abbreviated Expressions (ix). "Contracting Party" means any State or intergovernmental organization party to this Treaty.

13. Gerd F. Kunze, "The Trademark Law Treaty," *Managing Intellectual Property*, pp. 23-27, February 1995.

14. TLT, Article 3(5) and Article 6.

system, providing flexibility in the event of difficulties in one class but not others.<sup>15</sup>

### *B. The TLT as a Treaty of Maximums*

TLT is a treaty of maximums, setting forth all requirements that a Contracting Party may impose for trademark applications, filing dates, powers of attorney, assignments, changes of name and address, changes in ownership and renewals. Fewer requirements may be imposed, but not additional ones.<sup>16</sup>

### *C. TLT Requirements for Applications and Issuance of Filing Dates*

Article 3 sets forth the maximum requirements for an application. Article 5 sets forth the maximum requirements for issuance of a filing date.<sup>17</sup> The long-standing signature and use requirements in the United States, i.e., signature by the applicant (an officer or general partner for corporations and partnerships, respectively) and use prior to registration were provided for in Article 3.<sup>18</sup> These were key issues to the United States delegation

15. TLT, Article 7.

16. For example, under TLT, Article 5(1), the day on which an office receives the following indications and elements in the language required must be considered the filing date:

1. an express or implicit indication that the registration of a mark is sought;
2. indications allowing the identity of the applicant to be established;
3. indications sufficient to contact the applicant or his representatives, if any, by mail;
4. a sufficiently clear reproduction of the mark whose registration is sought; and
5. the list of the goods or services for which registration is sought.

An office may require fewer than the noted indications or accept additional languages. Further, offices requiring a declaration of intent to use, or of actual use, can make the filing date dependent on having received such a declaration, signed by the applicant himself even if he has a representative. TLT, Article 5(1)(a)(vi).

17. TLT, Article 3(1) and Article 5(1).

18. Article 3(1)(a)—Any Contracting Party may require that an application contain some or all of the following indications or elements:

- (xvi)—a signature by the person specified in paragraph (4); and
- (xvii)—a declaration of intention to use the mark, as required by the law of the Contracting Party.

Article 3(1)(b)—The applicant may file, instead of or in addition to the declaration of intention to use the mark referred to in subparagraph (a)(xvii), a declaration of actual use of the mark and evidence to that effect, as required by the law of the Contracting Party.

Article 3(4) obligates a Party that requires a signature to permit either the applicant or his or her representative to sign the application. However, a Party may require declarations of use and intent to use a mark to be signed by the applicant.

Article 3(4)(a)—The signature referred to in paragraph (1)(a)(xvi) may be the signature of the applicant or the signature of his representative.

to the Diplomatic Conference, although at the time of implementation the rules were significantly relaxed regarding who may sign on behalf of an applicant.<sup>19</sup>

Requirements pertaining to the form of signature are addressed in Article 8, which allows for printed or stamped signature, or use of a seal, instead of a handwritten signature. Reproduction of the same by telefacsimile or other electronic means may suffice as long as the sender of the communication is identified as prescribed by the Contracting Party. Most importantly, paragraph 4 of Article 8 prohibits “the attestation, notarization, authentication, legalization or other certification of any signature or other means of self-identification . . . except, if the law of the Contracting Party so provides, where the signature concerns the surrender of a registration.”<sup>20</sup>

#### ***D. What May Not Be Required in an Application Under the TLT***

Throughout the pendency of an application, Trademark Offices under the TLT may not require any of the following: (1) the furnishing of any certificate of or extract from a register of commerce; (2) an indication of the applicant’s carrying on of an industrial or commercial activity, as such or relating to the goods or services in the application; or (3) the furnishing of evidence to the effect that the mark has been registered in the register of marks of another Contracting Party, except where the applicant claims the application of Article 6 quinquies of the Paris Convention. Article 6 quinquies of the Paris Convention pertains to a registration based upon a prior registration in another country of the Paris Convention.<sup>21</sup>

Trademark Offices of a Contracting Party may require evidence “in the course of the examination of the application where the Office may reasonably doubt the veracity of any indication or element contained in the application.”<sup>22</sup>

---

Article 3(4)(b)—Notwithstanding subparagraph (a), any Contracting Party may require that the declarations referred to in paragraph (1)(a)(xvii) and (b) be signed by the applicant himself even if he has a representative.

Article 3(6)—Any Contracting Party may require that, where a declaration of intention to use has been filed under paragraph (1)(a)(xvii), the applicant furnish to the Office within a time limit fixed in its law, subject to the minimum time limit prescribed in the Regulations, evidence of the actual use of the mark, as required by the said law.

19. See *infra* Section IV A.

20. TLT, Article 8(4).

21. TLT, Article 3(7).

22. TLT, Article 3(8); and similar evidence may also be required with respect to representation, Article 4(7); changes in name or address, Article 10(5); changes in ownership, Article 11(5); correction of a mistake, Article 12(4); and duration and renewal,

Contracting Parties may not consider that goods or services are similar to each other merely on the ground that they appear in the same class of the Nice Classification.<sup>23</sup>

No application may be refused without the applicant being informed within a reasonable time of an anticipated refusal. Article 14 obliges the National Offices to afford an opportunity to make observations on anticipated refusals within a reasonable time.

No request to change the name or address of a trademark owner, or a request to correct a mistake in a trademark registration, may be refused without giving the trademark owner an opportunity to comment.<sup>24</sup>

### *E. Assignments Under the TLT*

Article 11(4) of the TLT prohibits the requirement of a statement of proof of actual transfer in order to record an assignment of a trademark registration. Further, the documentation required for recordation purposes is made much more flexible. Where a change in ownership results from a contract, National Offices may require that a request to record the change be accompanied by one of the following:

1. a copy of the contract, which may be required to be certified as being in conformity with the original;
2. an extract of the contract showing the change in ownership, which may be required to be certified as being a true extract of the contract;
3. an uncertified certificate of transfer drawn up in the form, and with the content, prescribed in the Regulations and signed by both parties; or
4. an uncertified transfer document drawn up in the form, and with the content, prescribed in the regulations and signed by both parties.<sup>25</sup>

In order to take into account the substantive law on assignments, such as the United States statutory requirement that an assignment must include the “good will of the business in which the mark is used, or with that part of the good will of the business connected with the use of and symbolized by the mark,”<sup>26</sup> the

---

Article 13(5).

23. TLT, Article 9(2).

24. TLT, Articles 10 and 12, respectively.

25. TLT, Article 11(1)(b).

26. Trademark Act of 1946 (15 USC §§1051 et seq) as amended, §10 (15 USC §1060).

parties to a transfer may provide the following additional indications on a transfer document:

1. whether the transfer is made with the requisite good will;
2. whether the rights arising from the use of the mark have been assigned;
3. whether the transferee shall have the right to sue for past infringements;
4. whether the transfer has been effected in consideration for money received; and
5. which is the effective date of the transfer.

However, this information may not be requested by the Office.<sup>27</sup>

### *F. Renewals Under the TLT*

Article 13 of the TLT mandates a simple renewal application, requiring little more than a request for a renewal and a fee. The TLT prohibits, for the purpose of effecting renewal, any examination as to substance.<sup>28</sup> The following are also prohibited:

1. any reproduction or other identification of the mark (other than the registration number);
2. the furnishing of evidence to the effect that the mark has been registered, or that its registration has been renewed, in the register of any other Contracting Party; and
3. the furnishing of a declaration and/or evidence concerning use of the mark.<sup>29</sup>

The United States was concerned that the TLT not exclude the possibility that a Contracting Party may request, from time to time, a declaration or evidence of use apart from renewal. Such a request can be made as long as it is not made a condition for renewal.<sup>30</sup>

---

27. Kunze, *supra* note 13.

28. TLT, Article 13(6).

29. TLT, Article 13(4).

30. TLT, Article 3(6) and Article 13(4)(iii).

#### IV. UNITED STATES IMPLEMENTATION OF THE TLT UNDER TLTA

##### *A. Applications and Filing Dates*

The United States implementing legislation, the TLTA, attempts to reconcile the application, filing date and signature requirements of the TLT with the United States statutory scheme by limiting application requirements in Section 1 of the Lanham Act and at the same time maintaining signature requirements for a separate verified statement.<sup>31</sup> Amended Trademark Act Section 1(a)(2) requires that a use-based application include the following non-exclusive elements:

- specification of the applicant's domicile and citizenship;
- the date of the applicant's first use of the mark;
- the date of the applicant's first use of the mark in commerce;
- a list of the goods or services in connection with which the mark is used; and
- a clear drawing of the mark.

The TLT implementing legislation specifically excludes any statutory requirements for a "method of use clause." Section 201 of TLTA, entitled "Technical Corrections to Trademark Act of 1946," deletes the language "the mode or manner in which the mark is used on or in connection with such goods or services" from Section 1(d)(1).<sup>32</sup> However, an examining attorney has the discretion to inquire about the method or intended method of use if necessary for proper examination.<sup>33</sup>

The requirements for a separate verified statement for a use-based application remain essentially unchanged and must include the following averments:

- that the person making the verification believes that he or she, or the juristic person on whose behalf he or she makes the verification, to be the owner of the mark sought to be registered;
- that, to the best of the verifier's knowledge and belief, the facts recited in the application are accurate;
- that the mark is in use in commerce; and

---

31. See Appendix 1, Section 1; TLTA, §103(a), Trademark Act of 1946, §1(a)(3) (15 USC §1051(a)(3)).

32. TLTA, §201(a)(1)(B).

33. 37 CFR §2.61(b) (1999) and In re Page, 51 USPQ2d 1660, 1665 (TTAB 1999).



- that, to the best of the verifier's knowledge and belief, no other person has the right to use such mark in commerce either in the identical form thereof or in such near resemblance thereto, as to be likely, when used on or in connection with the goods of such other person, to cause confusion, or to cause mistake, or to deceive.<sup>34</sup>

Under the somewhat convoluted scheme outlined above, the Commissioner retains discretion to permit a simple, bare-bones application to be filed and receive a filing date with no signature or with the signature of the applicant's representative.<sup>35</sup> The Declaration, or verified statement, may then be filed during prosecution of the application, before approval for publication or acceptance on the Supplemental Register.<sup>36</sup> However, a combined application and verification document may be filed unsigned, with submission of the signed document once the application Serial Number has been issued, or in response to an Office Action. This insures the earliest possible date and is the recommended course of action for the sake of efficiency and peace of mind.

The notion of a "juristic person" omits the overly strict requirement that an "officer" sign the declaration. The USPTO rules require that a person properly authorized to sign on behalf of the owner sign the verification. This includes a person with legal authority sufficient to bind the owner and/or a person with firsthand knowledge and actual or implied authority to act on behalf of the owner.<sup>37</sup> The same principles apply to the signature required for Declarations of Use under Section 8.<sup>38</sup> With any

---

34. TLTIA, §103(a), Trademark Act of 1946, §1(a)(3) (15 USC §1051(a)(3)).

The separate verified statement for an intent-to-use or Section 44 application must include the following averments:

- that the person making the verification believes that he or she, or the juristic person on whose behalf he or she makes the verification, to be entitled to use the mark in commerce;
- specify the applicant's bona fide intention to use the mark in commerce;
- that, to the best of verifier's knowledge and belief, the facts recited in the application are accurate; and
- that, to the best of the verifiers knowledge and belief, no other person has the right to use such mark in commerce either in the identical form thereof or in such near resemblance thereto, as to be likely, when used on or in connection with the goods of such other person, to cause confusion, or to cause mistake, or to deceive.

TLTIA, §103(b), Trademark Act of 1946, §1(b)(3) (15 USC §1051(b)(3)).

35. TLTIA, §103, Trademark Act of 1946, §§1(a)(1) and (4) (15 USC §§1051(a)(1) and (4)).

36. 64 Fed Reg 48908 (September 8, 1999), discussing Final Trademark Rule 2.33(c).

37. 64 Fed Reg 48918 (September 8, 1999), setting forth Final Trademark Rule 2.33(a).

38. 64 Fed Reg 48902 (September 8, 1999), discussing Final Trademark Rule 2.161(b).

luck, this will eliminate the need for make-work “color of authority” demonstrations on behalf of foreign applicants.

The new minimum requirements for receiving a filing date track TLT Article 5 and are:

1. the name of the applicant;
2. a name and address for correspondence;
3. a clear drawing of the mark;
4. a listing of the goods or services; and
5. the filing fee for at least one class of goods or services.<sup>39</sup>

The following former minimum requirements for receiving a filing date were eliminated:

1. a stated basis for filing;
2. a verification or declaration signed by the applicant;
3. an allegation of use in commerce, a specimen of use and the date of first use in commerce in an application under Section 1(a) of the Act;
4. an allegation of the applicant’s bona fide intention to use the mark in commerce in an application under Section 1(b) or Section 44 of the Act;
5. a claim of priority in an application under Section 44(d) of the Act; and
6. a certified copy of a foreign registration in an application under Section 44(e) of the Act.<sup>40</sup>

A priority claim must still be filed within six months of the filing date of the foreign application.<sup>41</sup>

Section 44(e) of the Act is amended to delete requirements for filing a certified copy of the home country registration with the application. But, in conformity with Article 3(7) of the TLT, the USPTO now requires that the applicant submit the certificate before the mark is published for opposition or approved for registration on the Supplemental Register.<sup>42</sup>

Article 3(1)(b) of the TLT provides for combining use and intent-to-use bases in the same application. The USPTO’s new rules permit an applicant to claim more than one basis provided

39. 64 Fed Reg 25226 (May 11, 1999), discussing proposed revision to Trademark Rule 2.21; 64 Fed Reg 48907 (September 8, 1999); 37 CFR §2.21 (1999).

40. *Ibid.* The USPTO, however, prefers applicants to submit complete applications. Exam Guide No. 3-99, effective date October 30, 1999 (accessible on the USPTO web site at [www.uspto.gov](http://www.uspto.gov)).

41. 64 Fed Reg 48909 (September 8, 1999); 37 CFR §§2.34(a)(4)(i) and 2.35(e).

42. TLTIA, §108, Trademark Act of 1946, §44(e) (15 USC §1126(e)); 64 Fed Reg 48908 (September 8, 1999); 37 CFR §§2.34(a)(3)(ii) and 2.34(a)(4)(iii); see Appendix 1, Section 44.

that applicant meets the requirements for all bases claimed. The goods or services to which each basis applies must be set out. Further, an applicant may not claim both prior use and intent-to-use as the basis for registration for identical goods or services in one application.<sup>43</sup> Such an application would not be accepted for registration until use is demonstrated for the goods covered by the intent-to-use basis, unless a request for division is made. However, such a request defeats any advantage of combining these bases in the original application.

Article 3(1)(b) of the TLT indicates that an applicant may file, instead of or in addition to a declaration of intention to use the mark, a declaration of actual use of the mark and evidence to that effect, as required by the law of the Contracting Party. The USPTO has amended its rules to require one rather than three specimens of use per class of goods or services in the application, whether with an application under Section 1(a) of the Trademark Act, or an Amendment to Allege Use or Statement of Use of a mark under Sections 1(b) or (d) of the Trademark Act.<sup>44</sup>

Finally, in conformity with TLT Article 4(3) regarding powers of attorney, the USPTO's implementation package allows an applicant to file a power of attorney that relates to more than one trademark application or registration, or to all existing and future applications and registrations. Such "global" powers of attorney are in effect for all registrations whether or not they have an immediate deadline. Someone relying on such a power of attorney must:

1. include a copy of the previously filed power of attorney; or
2. refer to the previously filed power of attorney, specifying: the filing date; the application serial number, registration number, or inter partes proceeding number for which the original power of attorney was filed; and the name of the party who signed the power of attorney; or, if the application serial number is not known, submit a copy of the application or a copy of the mark, and specify the filing date.<sup>45</sup>

---

43. 64 Fed Reg 25227 (May 11, 1999), discussing the new Trademark Rule 2.34(b)(1); 64 Fed Reg 48909, 48919 (September 8, 1999).

44. 64 Fed Reg 48901 (September 8, 1999), amending Trademark Rules 2.56(a), 2.76(b)(2), 2.86(b) and 2.88(b)(2).

45. 64 Fed Reg 48907 (September 8, 1999), discussing the newly added Trademark Rule 2.17(d).

### *B. Declarations of Use and Renewals Under TLTIA*

In its revisions to Sections 8 and 9 of the Trademark Act, the United States implementing legislation provides for a new trap for unwary trademark owners and practitioners.<sup>46</sup> Because the TLT mandates a simple renewal application, a registration may be issued a Certificate of Renewal while at the same time being canceled for failure to comply with new requirements in connection with a Declaration of Use between the 9th and 10th year, 19th and 20th year, 29th and 30th year, etc. after registration.

The implementing legislation provides for longer grace periods for filing Sections 8 and 9 declarations and for the new deficiency Office Action that enables one to perfect most problems in the filings beyond the statutory period. The latter will operate like current Post Registration official actions. However, a deficiency fee will be applied if the mistake is not corrected within the statutory period of filing.<sup>47</sup>

The new Section 8 sets out, in one section, all requirements for filing any affidavits of use needed to maintain a registration. Further, the requirements of each use affidavit are the same. In every instance, there is a one-year statutory period for filing the affidavit.<sup>48</sup> There is a new six-month grace period after the end of the applicable time period for the payment of a surcharge. Filing the Section 8 affidavit or Declaration within the statutory time period and by the current owner are minimum requirements that cannot be cured after expiration of the filing period.<sup>49</sup> Almost any other type of deficiency may be cured with payment of a deficiency surcharge after expiration of the filing period.

If filing a declaration of excusable nonuse for some or all of the goods, the rules now require setting forth the date when use of the mark in commerce stopped and the approximate date when use is expected to resume.<sup>50</sup> The registrant must also recite the facts to show that nonuse as to those goods or services is due to special circumstances that excuse the nonuse, and is not due to an intention to abandon the mark.<sup>51</sup> This codifies current practice.

The same time periods of one year prior or with a six-month grace period after also apply to renewals under Section 9.<sup>52</sup> Other

---

46. TLTIA, §§105 and 106, Trademark Act of 1946, §§8(a) and 9(a) (15 USC §§1058(a) and 1059(a)).

47. TLTIA, §105, Trademark Act of 1946, §8(c)(2) (15 USC §1058(c)(2)); 64 Fed Reg 48925 (September 8, 1999), setting forth new Trademark Rule 2.164.

48. See Appendix 1, Section 8, for the requirements.

49. 64 Fed Reg 25225 (May 11, 1999); 64 Fed Reg 48913 (September 8, 1999).

50. 64 Fed Reg 48925 (September 8, 1999).

51. *Ibid.*

52. See Appendix 1 for the requirements for a complete renewal application.

than filing within the expanded time period, all deficiencies may be cured after expiration of the period.<sup>53</sup>

While Article 13(4)(iii) of the TLT specifically prohibits a requirement of furnishing a declaration of use or evidence concerning use of the mark in connection with a request for renewal, the TLTIA amends Section 9(a) of the Act to state that “subject to the provisions of Section 8, each registration may be renewed. . . .”<sup>54</sup> The rules package likewise states “that renewal of a registration is subject to the provisions of §8 of the Act.”<sup>55</sup> Thus, one wonders if the new supposed separation of use and renewal requirements complies with TLT.

### *C. Assignments Under the TLTIA*

In conforming with the TLT, the amendments to Section 10 of the Lanham Act under the implementing legislation clarify that the USPTO will maintain “a record of information on assignments” rather than a “record of assignments submitted for recording.”<sup>56</sup> Thus, an original assignment document or a true copy of an actual assignment document will no longer be required. The Office instead has followed the TLT in permitting the filing of a copy of the assignment document or a copy of an extract from the document evidencing the effect on title, or a statement signed by both parties explaining how the conveyance affects title.<sup>57</sup> While under the TLT, in the case of a merger, a copy of a document from a competent authority evidencing the merger, and certified as being in conformity with the original document, may be required,<sup>58</sup> the USPTO has not made this distinction between contracts and mergers.

In addition, the United States implementing legislation confirms that the proscription against the assignment of an intent-to-use application is eliminated by the filing of an Amendment to Allege Use in addition to the filing of a Statement of Use.<sup>59</sup> This amounts to a correction of an oversight in the Trademark Law Revision Act of 1988.<sup>60</sup>

---

53. 64 Fed Reg 25233 (May 11, 1999); 64 Fed Reg 48915 (September 8, 1999).

54. TLTIA, §106, Trademark Act of 1946, §9(a) (15 USC §1059(a)).

55. 64 Fed Reg 25232 (May 11, 1999); 64 Fed Reg 48914 (September 8, 1999).

56. TLTIA, §107, Trademark Act of 1946, §10 (15 USC §1060).

57. 64 Fed Reg 48927 (September 8, 1999); see Appendix 1, Section 10.

58. TLT, Article 11(1)(c).

59. 64 Fed Reg 48906 (September 8, 1999).

60. *Supra* note 2.

### *D. Other Changes Under the TLTIA*

The United States implementing legislation also includes a few changes to United States practice that are unrelated to the TLT. These include a new standard for the revival of applications,<sup>61</sup> a specific refusal under the new Trademark Act Section 2(e)(5) for marks considered functional, with corresponding amendments to Trademark Act Section 14(3) to subject incontestable registrations to cancellations on grounds of functionality,<sup>62</sup> and clarification of the use of certification marks by the owner.<sup>63</sup>

An application that becomes abandoned for failure to meet a response deadline or to timely file a request for an extension of time to file a Statement of Use currently may be revived if it can be shown that the failure to file was caused by "unavoidable" delay. Generally, this requires a verified statement detailing the procedures in place to prevent such occurrences and the reason for delay (usually human error) in the particular instance. The new standard of "unintentional" delay relaxes the necessary showing for revival, parallels the available patent application standard and is consistent with the simplification goals of the TLT. An unverified written statement that the delay was unintentional is all that is required. The applicant will need to timely file a Petition to the Commissioner and pay a fee.<sup>64</sup>

The "functionality" amendments were prompted by the need to codify current practice and by conflicting case law with respect to trade dress for product configurations.<sup>65</sup> Under present practice, the trademark examining attorney faced with a de jure functional shape or color mark application resorts to Sections 1, 2 and 45 generally on a theory that the subject mark does not operate as a mark.<sup>66</sup> The amendment will enable the examining attorney to cite a new specific section in refusing a mark considered to be functional.

A corresponding change, and one that some believe may go too far in codifying case law, adds "functionality" as a ground for challenging even an incontestible mark.<sup>67</sup> Presumably, a de facto functional mark, registered pursuant to Section 2(f) of the Trade-

---

61. 64 Fed Reg 48903 (September 8, 1999).

62. TLTIA, §201, Trademark Act of 1946, §14(3) (15 USC §1064(3)).

63. TLTIA, §301, Trademark Act of 1946, §14 (15 USC §1064).

64. 64 Fed Reg 48903 (September 8, 1999).

65. *Shakespeare Co. v. Silstar Corp. of America*, 9 F3d 1091, 28 USPQ2d 1765 (CA 4 1993).

66. TMEP §1202.03(a)(i)(c).

67. TLTIA, §201, Trademark Act of 1946, §14(3) (15 USC §1064(3)).

mark Act that has acquired incontestable status may be canceled if it becomes de jure functional.

Newly-added language clarifies that a certification mark owner may use its mark in advertising or to promote the recognition of the certification program for the goods or services meeting the certification standards of the registrant. As long as the registrant does not itself produce, manufacture or sell any of the certified goods or services to which its identical certification mark is applied, the promotional uses will not be grounds for cancellation under Section 14, paragraph 5.<sup>68</sup>

## V. CONCLUSION

The numerous changes to the Lanham Act under the TLT, coupled with the introduction of additional changes by the USPTO to the United States practice rules under the TLTIA, result in considerable changes to United States trademark practice. The amendments to the rules on application filing date and signature requirements, revival of abandoned applications, assignments and other changes will help to streamline United States procedural requirements for trademark registration and maintenance. Whether simplification of procedural practices throughout the world will become a reality remains to be seen. However, having the United States enact TLT is a major step in the right direction.

---

68. TLTIA, §301, Trademark Act of 1946, §14 (15 USC §1064).

## APPENDIX 1

*Section By Section List of Changes  
to the Lanham Act Under TLTIA*<sup>69</sup>**Section 1.**

The trademark owner now requests registration by filing an application and a verified statement.

The new minimum requirements for receiving a filing date (Rule 2.21) are:

1. The name of the applicant;
2. A name and address for correspondence;
3. A clear drawing of the mark;
4. A listing of the goods or services; and
5. The filing fee for at least one class of goods and services.

The new requirements for a written application (Rule 2.32), which must be in English, are:

1. A request for registration;
2. The name of the applicant(s);
3. The citizenship of the applicant(s); or the state or nation under the laws of which the applicant is organized if applicant is a corporation, association, partnership or other juristic person; or the names and citizenship of the general partners if applicant is a partnership;
4. The address of the applicant;
5. One or more bases for registration;
6. A list of the goods and/or services on or in connection with which the applicant uses or intends to use the mark; and
7. The international class of goods or services, if known.

The verified statement for a use-based application must allege:

That the applicant has adopted and is using the mark shown in the accompanying drawing; that the applicant believes it is the owner of the mark; that the mark is in use in commerce, specifying the type of commerce; that to the best of the declarant's knowledge and belief, no other person has the right to use the mark in commerce, either in the identical form or in such near resemblance as to be likely, when applied to the goods or services of the other person, to cause confusion or mistake, or to deceive; that the specimen shows

---

69. Sections refer to the Lanham Act; Rules refer to the USPTO rules in Volume 37 of the Code of Federal Regulations.



the mark as used on or in connection with the goods or services; and that the facts set forth in the application are true. Rule 2.33(b)(1).

The verified statement for an intent-to-use application must allege:

That the applicant has a bona fide intention to use the mark shown in the accompanying drawing in commerce on or in connection with the specified goods or services; that the applicant believes it is entitled to use the mark; that to the best of the declarant's knowledge and belief, no other person has the right to use the mark in commerce, either in the identical form or in such near resemblance as to be likely, when applied to the goods or services of the other person, to cause confusion or mistake, or to deceive; and that the facts set forth in the application are true. Rule 2.33(b)(2).

For an application based upon use under Section 1(a) of the Act, there are the following additional requirements:

1. The date of the applicant's first use of the mark anywhere on or in connection with the goods and/or services in each class;
2. The date of the applicant's first use of the mark in commerce as a trademark or service mark, specifying the type of commerce; and
3. One specimen for each class showing how the applicant actually uses the mark in commerce. Rule 2.34(a)(1).

**Note:**

If the verified statement for a use based application is not filed with the initial application, the verified statement must allege that the mark was in use in commerce on or in connection with the goods or services listed in the application as of the application filing date. Rule 2.34(a)(1).

If the verified statement for an intent-to-use application under Section 1(b), Section 44(e) or Section 44(d) of the Act, verifying that the applicant has a bona fide intention to use the mark in commerce on or in connection with the goods or services listed in the application, the verified statement must allege that the applicant had a bona fide intention to use the mark in commerce as of the filing date of the application. Rule 2.34(a)(2-4).

### ***Multiple Bases***

The applicant may claim more than one basis in a single application provided that the applicant fulfills all requirements for each basis claimed. However, the applicant may not claim both use and intent-to-use under Sections 1(a) and 1(b) for the identical goods or services in the same application. Rule 2.34(b)(1). The applicant claiming more than one basis must list each basis followed by the goods or services to which that basis applies. If some or all of the goods or services are covered by use and Sections 44(d) or (e), or intent-to-use and 44(d) or (e), this must be stated. Rule 2.34(b)(2).

### ***Deletion of the Method of Use Clause Requirement***

Section 1(d)(1) of the Act is amended to delete “and, the mode or manner in which the mark is used on or in connection with such goods or services.”

### ***Revival of Abandoned Application***

Section 1(d)(4) of the Act is amended to provide revival of an application that has been abandoned for failure to timely file a Statement of Use or an Extension Request if it can be shown to the satisfaction of the Commissioner that the delay in responding was unintentional.

#### **Note:**

The petition to revive must be filed within two months of the mailing date of the notice of abandonment, or within two months of actual knowledge of the abandonment if the applicant was diligent in checking the status of the application. The requirements for filing a petition to revive (Rule 2.66), whether for failure to timely respond to a Notice of Allowance or an Office Action, are:

1. The petition fee;
2. A statement signed by someone with firsthand knowledge of the facts, that the delay in filing the response, statement of use or extension request was unintentional; and
3. The proposed response, statement of use or extension request, unless the applicant alleges that it did not receive the Office Action or Notice of Allowance.

### **Section 2.**

Section 2(e) of the Act is amended to add Section 2(e)(5) as follows:

Consists of a mark which . . . (5) comprises any matter that, as a whole, is functional.”

Section 2(f) of the Act is amended to refer to new Section 2(e)(5) when listing the express exclusions from registration pursuant to the statutory provisions for acquired distinctiveness.

### **Section 8.**

Section 8(a) of the Act is amended to set forth the new time periods for affidavits or declarations of use at the end of 6 years following the date of registration (or the date of publication under Section 12(c)) and at the end of each successive 10 year period following the date of registration.

New Section 8(b) sets the opening of the filing period at 1 year immediately preceding the end of the 6 or 10 year term. Rule 2.160(a)(1) and (2). The requirements for the affidavit or declaration of use, in addition to payment of a fee of \$200 per class (Rule 2.161(b-g)), are:

1. A statement that is signed and verified (sworn to) or supported by a declaration under §2.20 of the Rules by a person properly authorized to sign on behalf of the owner, attesting to the continued use or excusable nonuse of the mark within the period set forth in Section 8 of the Act;
2. The registration number;
3. The fee, which, if filed during the grace period, is \$200 per class for the regular fee and an additional \$100 per class for the late fee;
4. The goods and/or services for which the mark is in use in commerce, and/or the goods or services for which excusable nonuse is claimed. If the affidavit or declaration covers less than all of the classes in the registration, a specification of the goods or services being deleted from the registration;
5. A statement that the registered mark is in use in commerce on or in connection with the goods or services in the registration; and
6. A specimen showing current use of the mark for each class of goods or services, unless excusable nonuse is claimed.

New Section 8(c) of the Act sets the grace period of 6 months after the end of the applicable time period for the affidavit or declaration of use, and the corresponding requisite surcharge. Rule 2.160(a)(3). It also establishes the new deficiency correction

procedure (Rule 2.164) and the corresponding requisite surcharge of \$100. Rule 2.6.

**Note:**

The filing of the Section 8 by the current owner of the registration is a minimum requirement that cannot be cured after expiration of the filing period.

**Section 9.**

Section 9(a) expands the filing period for each successive 10 year renewal to any time within 1 year before the end of each successive 10 year period, and within a 6 month grace period after the 10 year anniversary from the date of registration. Rule 2.182. The proposed fee for an application for renewal is reduced to \$200 per class. The additional fee for filing a renewal during the grace period remains at \$100 per class. New Section 9(a) also establishes the new deficiency correction procedure (Rule 2.185), with a proposed corresponding requisite surcharge of \$100. Rule 2.6.

The requirements for a complete renewal application (Rule 2.183) are:

1. A signed request for renewal;
2. A renewal fee for each class;
3. A grace period surcharge if the renewal application is filed during the grace period;
4. If the registrant is not domiciled in the United States, a designation of a domestic representative; and
5. If the renewal application covers less than all of the goods or services, a list of the particular goods or services to be renewed.

Section 9(b), regarding issuance of a notice if the renewal application is not acceptable, remains unchanged. Rule 2.84(a). However, under amended Section 9, all deficiencies, other than filing within the expanded time period, may be corrected after expiration of the statutory filing period. If the deficiencies in a renewal application filed prior to the expiration date are corrected during the registration term, or during the grace period for a renewal application filed during the grace period, no surcharge will apply. Rule 2.185(a)(1). If deficiencies are corrected after the expiration of term in which the renewal application is filed, payment of the surcharge will be required, even for a deficiency which could be corrected without a fee under current law. Rule 2.185(a)(2).

Section 9(c) is expanded to set out the language of Section 1(e) of the Act with respect to the requirements for designation of a domestic representative for renewal applicants not domiciled in the United States.

### **Section 10.**

Section 10 of the Act is amended to permit assignment of an intent-to-use application once the applicant has filed an amendment to allege use. This corrects an oversight in prior legislation that referred only to the filing of a verified statement of use as the triggering event for the valid assignment of an intent-to-use application. Rule 3.16.

Section 10 is also amended to call for the maintenance of “a record of information on assignments,” rather than a “record of assignments submitted for recording.” An original or true copy of the complete assignment document will no longer be required. The trademark owner may now record a transfer of title by submitting any one of the following under Rule 3.25(a):

1. The original document;
2. A copy of the document;
3. A copy of an extract from the document evidencing the effect on title; or
4. A statement signed by both the party conveying the interest and the party receiving the interest explaining how the conveyance affects title.

New Section 10(b) sets out the language of Section 1(e) of the Act with respect to the requirement for designation of a domestic representative for assignees not domiciled in the United States.

### **Section 12.**

Section 12 of the Act is amended in the last sentence to change the standard for revival of an application from “unavoidable” delay to “unintentional” delay (discussed above under Section 1).

### **Section 14.**

Section 14 of the Act, regarding cancellation, is amended by inserting “or is functional” before “or has been abandoned.” This adds functionality to the list of grounds for which a trademark registration may always be canceled.

Section 14 of the Act is also amended to clarify the use of certification marks for advertising or promotional purposes by adding at the end:

Nothing in paragraph (5) shall be deemed to prohibit the registrant from using its certification mark in advertising or promoting recognition of the certification program or of the goods or services meeting the certification standards of the registrant. Such uses of the certification mark shall not be grounds for cancellation under paragraph (5), so long as the registrant does not itself produce, manufacture, or sell any of the certified goods or services to which its identical certification mark is applied.

### **Section 23.**

Section 23(c) of the Act, regarding what a mark may consist of for registration on the Supplemental Register, is amended by striking “or device” and inserting “device, any matter that as a whole is not functional.”

### **Section 33.**

Section 33(b) of the Act is amended to add “(8) That the mark is functional; or” to the list of incontestability defenses, and to redesignate current paragraph (8) as paragraph (9).

### **Section 44.**

The TLTIA makes minor housekeeping changes to Section 44(d) of the Act and amends Section 44(e) to delete the requirement for filing the certified copy of the home country registration with the application. The second sentence is stricken and changed to read: “Such applicant shall submit, within such time period as may be prescribed by the Commissioner, a certification or a certified copy of the registration in the country of origin of the applicant.” The Office now requires that the applicant submit the certificate before the mark is published for opposition or approved for registration on the Supplemental Register.

---