

sentence, substituted “The United States, all agencies and instrumentalities thereof, and all individuals, firms, corporations, other persons acting for the United States and with the authorization and consent of the United States, and any” for “Any”.

Par. (2). Pub. L. 106-113, §1000(a)(9) [title III, §3004(1)], in introductory provisions, substituted “under section 1125(a) or (d) of this title” for “under section 1125(a) of this title”.

Par. (2)(D), (E). Pub. L. 106-113, §1000(a)(9) [title III, §3004(2)], added subpar. (D) and redesignated former subpar. (D) as (E).

1998—Par. (1). Pub. L. 105-330 substituted “As used in this paragraph” for “As used in this subsection” in last paragraph.

1992—Par. (1). Pub. L. 102-542 inserted at end “As used in this subsection, the term ‘any person’ includes any State, any instrumentality of a State, and any officer or employee of a State or instrumentality of a State acting in his or her official capacity. Any State, and any such instrumentality, officer, or employee, shall be subject to the provisions of this chapter in the same manner and to the same extent as any nongovernmental entity.”

1988—Par. (2). Pub. L. 100-667 amended par. (2) generally. Prior to amendment, par. (2) read as follows: “Notwithstanding any other provision of this chapter, the remedies given to the owner of the right infringed shall be limited as follows: (a) Where an infringer in engaged solely in the business of printing the mark for others and establishes that he was an innocent infringer the owner of the right infringed shall be entitled as against such infringer only to an injunction against future printing; (b) where the infringement complained of is contained in or is part of paid advertising matter in a newspaper, magazine, or other similar periodical the remedies of the owner of the right infringed as against the publisher or distributor of such newspaper, magazine, or other similar periodical shall be confined to an injunction against the presentation of such advertising matter in future issues of such newspapers, magazines, or other similar periodical: *Provided*, That these limitations shall apply only to innocent infringers; (c) injunction relief shall not be available to the owner of the right infringed in respect of an issue of a newspaper, magazine, or other similar periodical containing infringing matter when restraining the dissemination of such infringing matter in any particular issue of such periodical would delay the delivery of such issue after the regular time therefor, and such delay would be due to the method by which publication and distribution of such periodical is customarily conducted in accordance with sound business practice, and not to any method or device adopted for the evasion of this section or to prevent or delay the issuance of an injunction or restraining order with respect to such infringing matter.”

1962—Par. (1). Pub. L. 87-772 amended provisions generally, and among other changes, inserted “distribution”, and struck out “purchasers as to the source of origin of such goods or services” after “or to deceive” in subsec. (a), inserted provisions regarding the likelihood of such use causing confusion, mistake, or deception, in subsec. (b), and struck out the limitation on recovery under subsec. (b) to acts committed with knowledge that such acts would deceive purchasers.

Par. (2)(b). Pub. L. 87-772 substituted “publisher” for “published”.

#### EFFECTIVE DATE OF 1999 AMENDMENT

Amendment by Pub. L. 106-113 applicable to all domain names registered before, on, or after Nov. 29, 1999, see section 1000(a)(9) [title III, §3010] of Pub. L. 106-113, set out as a note under section 1117 of this title.

#### EFFECTIVE DATE OF 1998 AMENDMENT

Amendment by Pub. L. 105-330 effective Oct. 30, 1998, and applicable only to any civil action filed or proceeding before the United States Patent and Trademark Of-

fice commenced on or after such date relating to the registration of a mark, see section 201(b) of Pub. L. 105-330, set out as a note under section 1051 of this title.

#### EFFECTIVE DATE OF 1992 AMENDMENT

Pub. L. 102-542, §4, Oct. 27, 1992, 106 Stat. 3568, provided that: “The amendments made by this Act [enacting section 1122 of this title and amending this section and sections 1125 and 1127 of this title] shall take effect with respect to violations that occur on or after the date of the enactment of this Act [Oct. 27, 1992].”

#### EFFECTIVE DATE OF 1988 AMENDMENT

Amendment by Pub. L. 100-667 effective one year after Nov. 16, 1988, see section 136 of Pub. L. 100-667, set out as a note under section 1051 of this title.

#### REPEAL AND EFFECT ON EXISTING RIGHTS

Repeal of inconsistent provisions, effect of this chapter on pending proceedings and existing registrations and rights under prior acts, see notes set out under section 1051 of this title.

### § 1115. Registration on principal register as evidence of exclusive right to use mark; defenses

#### (a) Evidentiary value; defenses

Any registration issued under the Act of March 3, 1881, or the Act of February 20, 1905, or of a mark registered on the principal register provided by this chapter and owned by a party to an action shall be admissible in evidence and shall be prima facie evidence of the validity of the registered mark and of the registration of the mark, of the registrant’s ownership of the mark, and of the registrant’s exclusive right to use the registered mark in commerce on or in connection with the goods or services specified in the registration subject to any conditions or limitations stated therein, but shall not preclude another person from proving any legal or equitable defense or defect, including those set forth in subsection (b) of this section, which might have been asserted if such mark had not been registered.

#### (b) Incontestability; defenses

To the extent that the right to use the registered mark has become incontestable under section 1065 of this title, the registration shall be conclusive evidence of the validity of the registered mark and of the registration of the mark, of the registrant’s ownership of the mark, and of the registrant’s exclusive right to use the registered mark in commerce. Such conclusive evidence shall relate to the exclusive right to use the mark on or in connection with the goods or services specified in the affidavit filed under the provisions of section 1065 of this title, or in the renewal application filed under the provisions of section 1059 of this title if the goods or services specified in the renewal are fewer in number, subject to any conditions or limitations in the registration or in such affidavit or renewal application. Such conclusive evidence of the right to use the registered mark shall be subject to proof of infringement as defined in section 1114 of this title, and shall be subject to the following defenses or defects:

- (1) That the registration or the incontestable right to use the mark was obtained fraudulently; or

(2) That the mark has been abandoned by the registrant; or

(3) That the registered mark is being used by or with the permission of the registrant or a person in privity with the registrant, so as to misrepresent the source of the goods or services on or in connection with which the mark is used; or

(4) That the use of the name, term, or device charged to be an infringement is a use, otherwise than as a mark, of the party's individual name in his own business, or of the individual name of anyone in privity with such party, or of a term or device which is descriptive of and used fairly and in good faith only to describe the goods or services of such party, or their geographic origin; or

(5) That the mark whose use by a party is charged as an infringement was adopted without knowledge of the registrant's prior use and has been continuously used by such party or those in privity with him from a date prior to (A) the date of constructive use of the mark established pursuant to section 1057(c) of this title, (B) the registration of the mark under this chapter if the application for registration is filed before the effective date of the Trademark Law Revision Act of 1988, or (C) publication of the registered mark under subsection (c) of section 1062 of this title: *Provided, however*, That this defense or defect shall apply only for the area in which such continuous prior use is proved; or

(6) That the mark whose use is charged as an infringement was registered and used prior to the registration under this chapter or publication under subsection (c) of section 1062 of this title of the registered mark of the registrant, and not abandoned: *Provided, however*, That this defense or defect shall apply only for the area in which the mark was used prior to such registration or such publication of the registrant's mark; or

(7) That the mark has been or is being used to violate the antitrust laws of the United States; or

(8) That the mark is functional; or

(9) That equitable principles, including laches, estoppel, and acquiescence, are applicable.

(July 5, 1946, ch. 540, title VI, § 33, 60 Stat. 438; Pub. L. 87-772, § 18, Oct. 9, 1962, 76 Stat. 774; Pub. L. 100-667, title I, § 128(a), (b), Nov. 16, 1988, 102 Stat. 3944; Pub. L. 105-330, title II, § 201(a)(9), Oct. 30, 1998, 112 Stat. 3070; Pub. L. 107-273, div. C, title III, § 13207(b)(7), Nov. 2, 2002, 116 Stat. 1908.)

#### REFERENCES IN TEXT

Acts March 3, 1881, and February 20, 1905, referred to in subsec. (a), are acts Mar. 3, 1881, ch. 138, 21 Stat. 502 and Feb. 20, 1905, ch. 592, 33 Stat. 724, which were repealed insofar as inconsistent with this chapter by act July 5, 1946, ch. 540, § 46(a), 60 Stat. 444. Act Feb. 20, 1905, was classified to sections 81 to 109 of this title.

The effective date of the Trademark Law Revision Act of 1988, referred to in subsec. (b)(5), is one year after Nov. 16, 1988. See section 136 of Pub. L. 100-667, set out as an Effective Date of 1988 Amendment note under section 1051 of this title.

#### PRIOR PROVISIONS

Act Feb. 20, 1905, ch. 592, §§ 16, 21, 33 Stat. 728, 729.

#### AMENDMENTS

2002—Subsec. (b)(8). Pub. L. 107-273 realigned margins. 1998—Subsec. (b)(8), (9). Pub. L. 105-330 added par. (8) and redesignated former par. (8) as (9).

1988—Subsec. (a). Pub. L. 100-667, § 128(a), inserted “the validity of the registered mark and of the registration of the mark, of the registrant’s ownership of the mark, and of the” after “facie evidence of”, inserted “or in connection with” after “in commerce on”, substituted “another person” for “an opposing party”, and inserted “, including those set forth in subsection (b) of this section.” after “or defect”.

Subsec. (b). Pub. L. 100-667, § 128(b)(1), amended introductory provisions generally. Prior to amendment, introductory provisions read as follows: “If the right to use the registered mark has become incontestable under section 1065 of this title, the registration shall be conclusive evidence of the registrant’s exclusive right to use the registered mark in commerce on or in connection with the goods or services specified in the affidavit filed under the provisions of said section 1065 subject to any conditions or limitations stated therein except when one of the following defenses or defects is established:”.

Subsec. (b)(3). Pub. L. 100-667, § 128(b)(2), inserted “on or” after “goods or services”.

Subsec. (b)(4). Pub. L. 100-667, § 128(b)(3), struck out “trade or service” after “than as a” and “to users” after “only to describe”.

Subsec. (b)(5). Pub. L. 100-667, § 128(b)(4), substituted “(A) the date of constructive use of the mark established pursuant to section 1057(c) of this title, (B) the registration of the mark under this chapter if the application for registration is filed before the effective date of the Trademark Law Revision Act of 1988, or (C)” for “registration of the mark under this chapter or”.

Subsec. (b)(8). Pub. L. 100-667, § 128(b)(5), (6), added par. (8).

1962—Subsec. (a). Pub. L. 87-772 substituted “registration subject to” for “certificate subject to”, and struck out “certificate of” before “registration issued”.

Subsec. (b). Pub. L. 87-772 substituted “registration shall” for “certificate shall”, and “affidavit filed under the provisions of said section 1065” for “certificate” in text preceding par. (1), substituted “registrant or a person in privity with the registrant,” for “assignee”, and struck out “has been assigned and” after “registered mark” in par. (3), substituted “registration of the mark under this chapter or” for “the”, and struck out “(a) or” before “(c) of section 1062” in par. (5), inserted “registration under this chapter”, substituted “such registration or such” for “the date of”, and struck out “(a) or” before “(c) of section 1062”, “only where the said mark has been published pursuant to subsections (c) of section 1062 of this title and shall apply” after “defect shall apply”, and “under subsection (a) or (c) of section 1062 of this title” after “registrant’s mark”, in par. (6).

#### EFFECTIVE DATE OF 1998 AMENDMENT

Amendment by Pub. L. 105-330 effective Oct. 30, 1998, and applicable only to any civil action filed or proceeding before the United States Patent and Trademark Office commenced on or after such date relating to the registration of a mark, see section 201(b) of Pub. L. 105-330, set out as a note under section 1051 of this title.

#### EFFECTIVE DATE OF 1988 AMENDMENT

Amendment by Pub. L. 100-667 effective one year after Nov. 16, 1988, see section 136 of Pub. L. 100-667, set out as a note under section 1051 of this title.

#### REPEAL AND EFFECT ON EXISTING RIGHTS

Repeal of inconsistent provisions, effect of this chapter on pending proceedings and existing registrations and rights under prior acts, see notes set out under section 1051 of this title.

**§ 1116. Injunctive relief****(a) Jurisdiction; service**

The several courts vested with jurisdiction of civil actions arising under this chapter shall have power to grant injunctions, according to the principles of equity and upon such terms as the court may deem reasonable, to prevent the violation of any right of the registrant of a mark registered in the Patent and Trademark Office or to prevent a violation under subsection (a), (c), or (d) of section 1125 of this title. Any such injunction may include a provision directing the defendant to file with the court and serve on the plaintiff within thirty days after the service on the defendant of such injunction, or such extended period as the court may direct, a report in writing under oath setting forth in detail the manner and form in which the defendant has complied with the injunction. Any such injunction granted upon hearing, after notice to the defendant, by any district court of the United States, may be served on the parties against whom such injunction is granted anywhere in the United States where they may be found, and shall be operative and may be enforced by proceedings to punish for contempt, or otherwise, by the court by which such injunction was granted, or by any other United States district court in whose jurisdiction the defendant may be found.

**(b) Transfer of certified copies of court papers**

The said courts shall have jurisdiction to enforce said injunction, as provided in this chapter, as fully as if the injunction had been granted by the district court in which it is sought to be enforced. The clerk of the court or judge granting the injunction shall, when required to do so by the court before which application to enforce said injunction is made, transfer without delay to said court a certified copy of all papers on file in his office upon which said injunction was granted.

**(c) Notice to Director**

It shall be the duty of the clerks of such courts within one month after the filing of any action, suit, or proceeding involving a mark registered under the provisions of this chapter to give notice thereof in writing to the Director setting forth in order so far as known the names and addresses of the litigants and the designating number or numbers of the registration or registrations upon which the action, suit, or proceeding has been brought, and in the event any other registration be subsequently included in the action, suit, or proceeding by amendment, answer, or other pleading, the clerk shall give like notice thereof to the Director, and within one month after the judgment is entered or an appeal is taken the clerk of the court shall give notice thereof to the Director, and it shall be the duty of the Director on receipt of such notice forthwith to endorse the same upon the file wrapper of the said registration or registrations and to incorporate the same as a part of the contents of said file wrapper.

**(d) Civil actions arising out of use of counterfeit marks**

(1)(A) In the case of a civil action arising under section 1114(1)(a) of this title or section

220506 of title 36 with respect to a violation that consists of using a counterfeit mark in connection with the sale, offering for sale, or distribution of goods or services, the court may, upon ex parte application, grant an order under subsection (a) of this section pursuant to this subsection providing for the seizure of goods and counterfeit marks involved in such violation and the means of making such marks, and records documenting the manufacture, sale, or receipt of things involved in such violation.

(B) As used in this subsection the term “counterfeit mark” means—

(i) a counterfeit of a mark that is registered on the principal register in the United States Patent and Trademark Office for such goods or services sold, offered for sale, or distributed and that is in use, whether or not the person against whom relief is sought knew such mark was so registered; or

(ii) a spurious designation that is identical with, or substantially indistinguishable from, a designation as to which the remedies of this chapter are made available by reason of section 220506 of title 36;

but such term does not include any mark or designation used on or in connection with goods or services of which the manufacture<sup>1</sup> or producer was, at the time of the manufacture or production in question authorized to use the mark or designation for the type of goods or services so manufactured or produced, by the holder of the right to use such mark or designation.

(2) The court shall not receive an application under this subsection unless the applicant has given such notice of the application as is reasonable under the circumstances to the United States attorney for the judicial district in which such order is sought. Such attorney may participate in the proceedings arising under such application if such proceedings may affect evidence of an offense against the United States. The court may deny such application if the court determines that the public interest in a potential prosecution so requires.

(3) The application for an order under this subsection shall—

(A) be based on an affidavit or the verified complaint establishing facts sufficient to support the findings of fact and conclusions of law required for such order; and

(B) contain the additional information required by paragraph (5) of this subsection to be set forth in such order.

(4) The court shall not grant such an application unless—

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

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

(i) an order other than an ex parte seizure order is not adequate to achieve the purposes of section 1114 of this title;

<sup>1</sup> So in original. Probably should be “manufacturer”.