

L. 93-596, §1, Jan. 2, 1975, 88 Stat. 1949; Pub. L. 100-667, title I, §112, Nov. 16, 1988, 102 Stat. 3939; Pub. L. 105-330, title I, §107, Oct. 30, 1998, 112 Stat. 3068; Pub. L. 106-43, §6(a), Aug. 5, 1999, 113 Stat. 220; Pub. L. 106-113, div. B, §1000(a)(9) [title IV, §4732(b)(1)(B)], Nov. 29, 1999, 113 Stat. 1536, 1501A-583; Pub. L. 107-273, div. C, title III, §13207(b)(5), Nov. 2, 2002, 116 Stat. 1907.)

PRIOR PROVISIONS

Act Feb. 20, 1905, ch. 592, §10, 33 Stat. 727.

AMENDMENTS

2002—Subsecs. (a), (b). Pub. L. 107-273 amended subsecs. (a) and (b) generally, in subsec. (a) substituting pars. (1) to (5) for substantially identical undesignated provisions, and in subsec. (b) adding provisions relating to service on Director if assignee does not designate name and address of a person resident in the United States on whom may be served notices or process.

1999—Pub. L. 106-43, §6(a)(2), (3), which directed the amendment of this section by substituting “mark.” for “mark,” in the first sentence and striking out a second period at the end of the third sentence, could not be executed because “mark,” and the second period did not appear subsequent to amendment by Pub. L. 105-330. See 1998 Amendment note below.

Subsec. (a). Pub. L. 106-113, §1000(a)(9) [title IV, §4732(b)(1)(B)], substituted “Director” for “Commissioner” in last sentence.

Pub. L. 106-43, §6(a)(1), which directed the amendment of the penultimate sentence of this section by substituting “assignment” for “subsequent purchase”, was executed by making the substitution for “subsequent purchase” in two places in the penultimate sentence of subsec. (a), after “date of the” and “prior to the”, to reflect the probable intent of Congress.

Subsec. (b). Pub. L. 106-113, §1000(a)(9) [title IV, §4732(b)(1)(B)], substituted “Director” for “Commissioner” in last sentence.

1998—Pub. L. 105-330 amended section catchline and text generally. Prior to amendment, text read as follows:

“A registered mark or a mark for which application to register has been filed shall be assignable with the goodwill of the business in which the mark is used, or with that part of the goodwill of the business connected with the use of and symbolized by the mark.. However, no application to register a mark under section 1051(b) of this title shall be assignable prior to the filing of the verified statement of use under section 1051(d) of this title, except to a successor to the business of the applicant, or portion thereof, to which the mark pertains, if that business is ongoing and existing. In any assignment authorized by this section it shall not be necessary to include the goodwill of the business connected with the use of and symbolized by any other mark used in the business or by the name or style under which the business is conducted. Assignments shall be by instruments in writing duly executed. Acknowledgment shall be prima facie evidence of the execution of an assignment and when recorded in the Patent and Trademark Office the record shall be prima facie evidence of execution. An assignment shall be void as against any subsequent purchaser for a valuable consideration without notice, unless it is recorded in the Patent and Trademark Office within three months after the date thereof or prior to such subsequent purchase. A separate record of assignments submitted for recording hereunder shall be maintained in the Patent and Trademark Office.

“An assignee not domiciled in the United States shall be subject to and comply with the provisions of section 1051(e) of this title.”

1988—Pub. L. 100-667 substituted “. However, no application to register a mark under section 1051(b) of this title shall be assignable prior to the filing of the verified statement of use under section 1051(d) of this

title, except to a successor to the business of the applicant, or portion thereof, to which the mark pertains, if that business is ongoing and existing. In any assignment authorized by this section” for “and in any such assignment” in first par., and “1051(e)” for “1051(d)” in last par.

1975—Pub. L. 93-596 substituted “Patent and Trademark Office” for “Patent Office”.

1962—Pub. L. 87-772 substituted provisions which require a separate record of assignments to be kept in the Patent Office, for provisions which required the Commissioner to keep such record, and eliminated provisions permitting the cancellation of any assigned registration at any time if the registered mark is being used by, or with the permission of, the assignee so as to misrepresent the source of the goods or services in connection with which the mark is used.

EFFECTIVE DATE OF 1999 AMENDMENT

Amendment by Pub. L. 106-113 effective 4 months after Nov. 29, 1999, see section 1000(a)(9) [title IV, §4731] of Pub. L. 106-113, set out as a note under section 1 of Title 35, Patents.

EFFECTIVE DATE OF 1998 AMENDMENT

Amendment by Pub. L. 105-330 effective on the date that is 1 year after Oct. 30, 1998, see section 110 of Pub. L. 105-330, set out as a note under section 1051 of this title.

For provisions relating to applicability of amendment by Pub. L. 105-330 to applications for registration of trademarks, see section 109(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.

EFFECTIVE DATE OF 1975 AMENDMENT

Amendment by Pub. L. 93-596 effective Jan. 2, 1975, see section 4 of Pub. L. 93-596, set out as a note under section 1111 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.

TRANSFER OF FUNCTIONS

For transfer of functions of other officers, employees, and agencies of Department of Commerce, with certain exceptions, to Secretary of Commerce, with power to delegate, see Reorg. Plan No. 5 of 1950, §§1, 2, eff. May 24, 1950, 15 F.R. 3174, 64 Stat. 1263, set out in the Appendix to Title 5, Government Organization and Employees.

§ 1061. Execution of acknowledgments and verifications

Acknowledgments and verifications required under this chapter may be made before any person within the United States authorized by law to administer oaths, or, when made in a foreign country, before any diplomatic or consular officer of the United States or before any official authorized to administer oaths in the foreign country concerned whose authority is proved by a certificate of a diplomatic or consular officer of the United States, or apostille of an official designated by a foreign country which, by treaty or convention, accords like effect to apostilles of designated officials in the United States, and shall be valid if they comply with the laws of the state or country where made.

(July 5, 1946, ch. 540, title I, §11, 60 Stat. 432; Pub. L. 97-247, §14(c), Aug. 27, 1982, 96 Stat. 321.)

PRIOR PROVISIONS

Acts Feb. 20, 1905, ch. 592, §2, 33 Stat. 724; Feb. 18, 1909, ch. 144, 35 Stat. 627.

AMENDMENTS

1982—Pub. L. 97-247 substituted “is” for “shall be” after “whose authority”, and inserted “, or apostille of an official designated by a foreign country which, by treaty or convention, accords like effect to apostilles of designated officials in the United States”.

EFFECTIVE DATE OF 1982 AMENDMENT

Amendment by Pub. L. 97-247 effective Aug. 27, 1982, see section 17(a) of Pub. L. 97-247, set out as a note under section 41 of Title 35, Patents.

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.

§ 1062. Publication

(a) Examination and publication

Upon the filing of an application for registration and payment of the prescribed fee, the Director shall refer the application to the examiner in charge of the registration of marks, who shall cause an examination to be made and, if on such examination it shall appear that the applicant is entitled to registration, or would be entitled to registration upon the acceptance of the statement of use required by section 1051(d) of this title, the Director shall cause the mark to be published in the Official Gazette of the Patent and Trademark Office: *Provided*, That in the case of an applicant claiming concurrent use, or in the case of an application to be placed in an interference as provided for in section 1066 of this title the mark, if otherwise registrable, may be published subject to the determination of the rights of the parties to such proceedings.

(b) Refusal of registration; amendment of application; abandonment

If the applicant is found not entitled to registration, the examiner shall advise the applicant thereof and of the reasons therefor. The applicant shall have a period of six months in which to reply or amend his application, which shall then be reexamined. This procedure may be repeated until (1) the examiner finally refuses registration of the mark or (2) the applicant fails for a period of six months to reply or amend or appeal, whereupon the application shall be deemed to have been abandoned, unless it can be shown to the satisfaction of the Director that the delay in responding was unintentional, whereupon such time may be extended.

(c) Republication of marks registered under prior acts

A registrant of a mark registered under the provisions of the Act of March 3, 1881, or the Act of February 20, 1905, may, at any time prior to the expiration of the registration thereof, upon the payment of the prescribed fee file with the Director an affidavit setting forth those goods stated in the registration on which said mark is in use in commerce and that the registrant

claims the benefits of this chapter for said mark. The Director shall publish notice thereof with a reproduction of said mark in the Official Gazette, and notify the registrant of such publication and of the requirement for the affidavit of use or nonuse as provided for in subsection (b) of section 1058 of this title. Marks published under this subsection shall not be subject to the provisions of section 1063 of this title.

(July 5, 1946, ch. 540, title I, §12, 60 Stat. 432; Pub. L. 87-772, §7, Oct. 9, 1962, 76 Stat. 770; Pub. L. 93-596, §1, Jan. 2, 1975, 88 Stat. 1949; Pub. L. 100-667, title I, §113, Nov. 16, 1988, 102 Stat. 3940; Pub. L. 105-330, title I, §104, Oct. 30, 1998, 112 Stat. 3066; Pub. L. 106-113, div. B, §1000(a)(9) [title IV, §4732(b)(1)(B)], Nov. 29, 1999, 113 Stat. 1536, 1501A-583.)

REFERENCES IN TEXT

Acts March 3, 1881 and February 20, 1905, referred to in subsec. (c), 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.

PRIOR PROVISIONS

Acts Feb. 20, 1905, ch. 592, §6, 33 Stat. 726; Mar. 2, 1907, ch. 2573, §2, 34 Stat. 1252.

AMENDMENTS

1999—Pub. L. 106-113 substituted “Director” for “Commissioner” wherever appearing.

1998—Subsec. (b). Pub. L. 105-330 substituted “unintentional” for “unavoidable” in last sentence.

1988—Subsec. (a). Pub. L. 100-667 substituted “prescribed fee” for “fee herein provided”, and “entitled to registration, or would be entitled to registration upon the acceptance of the statement of use required by section 1051(d) of this title, the” for “entitled to registration, the”.

1975—Subsec. (a). Pub. L. 93-596 substituted “Patent and Trademark Office” for “Patent Office”.

1962—Subsec. (a). Pub. L. 87-772 inserted proviso permitting publication of the mark in the case of an applicant claiming concurrent use, or an application to be placed in an interference, if such mark is otherwise registrable, subject to the determination of the rights of the parties.

Subsec. (c). Pub. L. 87-772 inserted “Marks published under” before “this subsection shall not be subject”.

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