

Subsec. (f). Pub. L. 111-146, §3(a)(1), inserted “United States” before “Patent and Trademark Office” in two places.

Subsec. (g). Pub. L. 111-146, §3(a)(4), amended subsec. (g) generally. Prior to amendment, text read as follows: “Whenever a material mistake in a registration, incurred through the fault of the Patent and Trademark Office, is clearly disclosed by the records of the Office a certificate stating the fact and nature of such mistake, shall be issued without charge and recorded and a printed copy thereof shall be attached to each printed copy of the registration certificate and such corrected registration shall thereafter have the same effect as if the same had been originally issued in such corrected form, or in the discretion of the Director a new certificate of registration may be issued without charge. All certificates of correction heretofore issued in accordance with the rules of the Patent and Trademark Office and the registrations to which they are attached shall have the same force and effect as if such certificates and their issue had been specifically authorized by statute.”

1999—Subsecs. (a), (d) to (h). Pub. L. 106-113 substituted “Director” for “Commissioner” wherever appearing.

1998—Subsec. (a). Pub. L. 105-330 struck out second period at end of first sentence.

1988—Subsec. (b). Pub. L. 100-667, §109(1), amended subsec. (b) generally. Prior to amendment, subsec. (b) read as follows: “A certificate of registration of a mark upon the principal register provided by this chapter shall be prima facie evidence of the validity of the registration, registrant’s ownership of the mark, and of registrant’s exclusive right to use the mark in commerce in connection with the goods or services specified in the certificate, subject to any conditions and limitations stated therein.”

Subsec. (c). Pub. L. 100-667, §109(3), added subsec. (c). Former subsec. (c) redesignated (d).

Subsec. (d). Pub. L. 100-667, §109(2), (4), redesignated former subsec. (c) as (d) and substituted “prescribed fee” for “fee herein provided”. Former subsec. (d) redesignated (e).

Subsec. (e). Pub. L. 100-667, §109(2), redesignated former subsec. (d) as (e). Former subsec. (e) redesignated (f).

Subsec. (f). Pub. L. 100-667, §109(2), (5), redesignated former subsec. (e) as (f) and substituted “prescribed fee” for “fee required by law”. Former subsec. (f) redesignated (g).

Subsec. (g). Pub. L. 100-667, §109(2), redesignated former subsec. (f) as (g). Former subsec. (g) redesignated (h).

Subsec. (h). Pub. L. 100-667, §109(2), (6), redesignated former subsec. (g) as (h) and substituted “prescribed fee” for “required fee”.

1975—Subsecs. (a), (c) to (f). Pub. L. 93-596 substituted “Patent and Trademark Office” for “Patent Office”.

1962—Subsec. (a). Pub. L. 87-772 substituted “signature placed” for “name printed”, and struck out provisions requiring an attestation by an assistant commissioner or by one of the law examiners designated by the Commissioner, together with printed copies of the drawing and statement of the applicant, to be kept in books for that purpose.

Subsec. (d). Pub. L. 87-772, among other charges, removed the requirement of a fee in connection with the voluntary surrender or cancellation of a registration.

Subsec. (e). Pub. L. 87-772 substituted “an employee of the Office” for “a chief of division”, among other changes.

Subsec. (f). Pub. L. 87-772, among other changes, struck out “, signed by the Commissioner and sealed with the seal of the Patent Office” after “nature of such mistake”.

1950—Subsec. (a). Act Aug. 17, 1950, made it unnecessary to include in the certificate a statement of the applicant.

#### 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 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.

#### 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.

## § 1058. Duration, affidavits and fees

### (a) Time periods for required affidavits

Each registration shall remain in force for 10 years, except that the registration of any mark shall be canceled by the Director unless the owner of the registration files in the United States Patent and Trademark Office affidavits that meet the requirements of subsection (b), within the following time periods:

(1) Within the 1-year period immediately preceding the expiration of 6 years following the date of registration under this chapter or the date of the publication under section 1062(c) of this title.

(2) Within the 1-year period immediately preceding the expiration of 10 years following the date of registration, and each successive 10-year period following the date of registration.

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

### (b) Requirements for affidavit

The affidavit referred to in subsection (a) shall—

(1)(A) state that the mark is in use in commerce;

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

(C) be accompanied by such number of specimens or facsimiles showing current use of the

mark in commerce as may be required by the Director; and

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

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

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

(C) be accompanied by the fee prescribed by the Director.

**(c) Deficient affidavit**

If any submission filed within the period set forth in subsection (a) is deficient, including that the affidavit was not filed in the name of the owner of the registration, the deficiency may be corrected after the statutory time period, within the time prescribed after notification of the deficiency. Such submission shall be accompanied by the additional deficiency surcharge prescribed by the Director.

**(d) Notice of requirement**

Special notice of the requirement for such affidavit shall be attached to each certificate of registration and notice of publication under section 1062(c) of this title.

**(e) Notification of acceptance or refusal**

The Director shall notify any owner who files any affidavit required by this section of the Director's acceptance or refusal thereof and, in the case of a refusal, the reasons therefor.

**(f) Designation of resident for service of process and notices**

If the owner is not domiciled in the United States, the owner may designate, by a document filed in the United States 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 last designated address, or if the owner does not designate by a document filed in the United States 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 on the Director.

(July 5, 1946, ch. 540, title I, § 8, 60 Stat. 431; Pub. L. 93-596, § 1, Jan. 2, 1975, 88 Stat. 1949; Pub. L. 97-247, § 8, Aug. 27, 1982, 96 Stat. 320; Pub. L. 100-667, title I, § 110, Nov. 16, 1988, 102 Stat. 3939; Pub. L. 105-330, title I, § 105, Oct. 30, 1998, 112 Stat. 3066; Pub. L. 106-113, div. B, § 1000(a)(9) [title IV, § 4732(b)(1)(B), (C)], Nov. 29, 1999, 113 Stat. 1536, 1501A-583; Pub. L. 107-273, div. C, title III, § 13207(b)(3), Nov. 2, 2002, 116 Stat. 1906; Pub. L. 111-146, § 3(d)(1), Mar. 17, 2010, 124 Stat. 67.)

PRIOR PROVISIONS

Act Feb. 20, 1905, ch. 592, § 12, 33 Stat. 727.

AMENDMENTS

2010—Pub. L. 111-146 amended section generally. Prior to amendment, section related to duration of registrations, affidavits of continuing use, grace period for submissions and correction of deficiencies, certain notice requirements related to affidavits, and designation of resident for service of process and notices.

2002—Subsec. (f). Pub. L. 107-273 amended subsec. (f) generally. Prior to amendment, text read as follows: "If the registrant is not domiciled in the United States, the registrant shall designate by a written document filed in the Patent and Trademark Office the name and address of some 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 Director."

1999—Subsecs. (a) to (c). Pub. L. 106-113, § 1000(a)(9) [title IV, § 4732(b)(1)(B)], substituted "Director" for "Commissioner" wherever appearing.

Subsec. (e). Pub. L. 106-113, § 1000(a)(9) [title IV, § 4732(b)(1)(B), (C)], amended subsec. (e) identically, substituting "Director" for "Commissioner".

Subsec. (f). Pub. L. 106-113, § 1000(a)(9) [title IV, § 4732(b)(1)(B)], substituted "Director" for "Commissioner".

1998—Pub. L. 105-330 amended section catchline and text generally. Prior to amendment, text consisted of subsecs. (a) to (c) relating to affidavits of continuing use, registrations published under other provisions of law, and notification of acceptance or refusal of affidavits.

1988—Subsec. (a). Pub. L. 100-667 substituted "ten" for "twenty" and "setting forth those goods or services recited in the registration on or in connection with which the mark is in use in commerce and attaching to the affidavit a specimen or facsimile showing current use of the mark, or showing that any" for "showing that said mark is in use in commerce or showing that its".

1982—Subsecs. (a), (b). Pub. L. 97-247 struck out "still" after "showing that said mark is", and inserted "in commerce" after "use".

1975—Subsecs. (a), (b). Pub. L. 93-596 substituted "Patent and Trademark Office" for "Patent Office".

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.

Pub. L. 105-330, title I, § 109(a), Oct. 30, 1998, 112 Stat. 3069, provided that: "The provisions of section 8 of the Trademark Act of 1946 [15 U.S.C. 1058], as amended by section 105 of this Act, shall apply to a registration for trademark issued or renewed for a 20-year term, if the expiration date of the registration is on or after the effective date of this Act [probably should be "this title", see section 110 of Pub. L. 105-330, set out as an Effective Date of 1998 Amendment 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.

Pub. L. 105-330, title I, § 109(c), Oct. 30, 1998, 112 Stat. 3069, provided that: "The provisions of section 8 of the Trademark Act of 1946 [15 U.S.C. 1058], as amended by section 105 of this Act, shall apply to the filing of an af-

fidavit if the sixth or tenth anniversary of the registration, or the sixth anniversary of publication of the registration under section 12(c) of the Trademark Act of 1946 [15 U.S.C. 1062(c)], for which the affidavit is filed is on or after the effective date of this Act [probably should be "this title", see section 110 of Pub. L. 105-330, set out as an Effective Date of 1998 Amendment 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 1982 AMENDMENT

Amendment by Pub. L. 97-247 effective six months after Aug. 27, 1982, see section 17(c) of Pub. L. 97-247, set out as a note under section 294 of Title 35, Patents.

#### 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, and saving clause, 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.

#### REFERENCES TO TRADEMARK ACT OF 1946

Pub. L. 105-330, title I, § 102, Oct. 30, 1998, 112 Stat. 3064, provided that: "For purposes of this title [see Short Title of 1998 Amendment note set out under section 1051 of this title], the Act entitled 'An Act to provide for the registration and protection of trademarks used in commerce, to carry out the provisions of certain international conventions, and for other purposes', approved July 5, 1946 (15 U.S.C. 1051 et seq.), shall be referred to as the 'Trademark Act of 1946'."

#### PENDING APPLICATIONS

Act July 5, 1946, ch. 540, title XI, § 51, as added Nov. 16, 1988, Pub. L. 100-667, title I, § 135, 102 Stat. 3948, provided that: "All certificates of registration based upon applications for registration pending in the Patent and Trademark Office on the effective date of the Trademark Law Revision Act of 1988 [see Effective Date of 1988 Amendment note set out under section 1051 of this title] shall remain in force for a period of 10 years."

### § 1059. Renewal of registration

#### (a) Period of renewal; time for renewal

Subject to the provisions of section 1058 of this title, each registration may be renewed for periods of 10 years at the end of each successive 10-year period following the date of registration upon payment of the prescribed fee and the filing of a written application, in such form as may be prescribed by the Director. Such application may be made at any time within 1 year before the end of each successive 10-year period for which the registration was issued or renewed, or it may be made within a grace period of 6 months after the end of each successive 10-year period, upon payment of a fee and surcharge pre-

scribed therefor. If any application filed under this section is deficient, the deficiency may be corrected within the time prescribed after notification of the deficiency, upon payment of a surcharge prescribed therefor.

#### (b) Notification of refusal of renewal

If the Director refuses to renew the registration, the Director shall notify the registrant of the Commissioner's<sup>1</sup> refusal and the reasons therefor.

#### (c) Designation of resident for service of process and notices

If the registrant is not domiciled in the United States the registrant may designate, by a document filed in the United States 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, or if the registrant does not designate by a document filed in the United States 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 on the Director.

(July 5, 1946, ch. 540, title I, § 9, 60 Stat. 431; Pub. L. 87-772, § 5, Oct. 9, 1962, 76 Stat. 770; Pub. L. 100-667, title I, § 111, Nov. 16, 1988, 102 Stat. 3939; Pub. L. 105-330, title I, § 106, Oct. 30, 1998, 112 Stat. 3067; Pub. L. 106-113, div. B, § 1000(a)(9) [title IV, § 4732(b)(1)(B), (C)], Nov. 29, 1999, 113 Stat. 1536, 1501A-583; Pub. L. 107-273, div. C, title III, § 13207(b)(4), Nov. 2, 2002, 116 Stat. 1907.)

#### PRIOR PROVISIONS

Act Feb. 20, 1905, ch. 592, § 12, 33 Stat. 727.

#### AMENDMENTS

2002—Subsec. (c). Pub. L. 107-273 amended subsec. (c) generally. Prior to amendment, text read as follows: "If the registrant is not domiciled in the United States, the registrant shall designate by a written document filed in the Patent and Trademark Office the name and address of some 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 Director."

1999—Subsec. (a). Pub. L. 106-113, § 1000(a)(9) [title IV, § 4732(b)(1)(B)], substituted "Director" for "Commissioner".

Subsec. (b). Pub. L. 106-113, § 1000(a)(9) [title IV, § 4732(b)(1)(B), (C)], amended subsec. (b) identically, substituting "Director" for "Commissioner" in two places.

Subsec. (c). Pub. L. 106-113, § 1000(a)(9) [title IV, § 4732(b)(1)(B)], substituted "Director" for "Commissioner".

1998—Pub. L. 105-330 amended section catchline and text generally. Prior to amendment, text consisted of subsecs. (a) to (c) relating to period of renewal and

<sup>1</sup> So in original. Probably should be "Director's".