

mark for such goods or services, or to the owner's right to register the same or to keep the same on the register; and

(2) there is no proceeding involving said rights pending in the United States Patent and Trademark Office or in a court and not finally disposed of; and

(3) an affidavit is filed with the Director within one year after the expiration of any such five-year period setting forth those goods or services stated in the registration on or in connection with which such mark has been in continuous use for such five consecutive years and is still in use in commerce, and other matters specified in paragraphs (1) and (2) hereof; and

(4) no incontestable right shall be acquired in a mark which is the generic name for the goods or services or a portion thereof, for which it is registered.

Subject to the conditions above specified in this section, the incontestable right with reference to a mark registered under this chapter shall apply to a mark registered under the Act of March 3, 1881, or the Act of February 20, 1905, upon the filing of the required affidavit with the Director within one year after the expiration of any period of five consecutive years after the date of publication of a mark under the provisions of subsection (c) of section 1062 of this title.

The Director shall notify any registrant who files the above-prescribed affidavit of the filing thereof.

(July 5, 1946, ch. 540, title I, §15, 60 Stat. 433; Pub. L. 87-772, §10, Oct. 9, 1962, 76 Stat. 771; Pub. L. 93-596, §1, Jan. 2, 1975, 88 Stat. 1949; Pub. L. 97-247, §10, Aug. 27, 1982, 96 Stat. 320; Pub. L. 100-667, title I, §116, Nov. 16, 1988, 102 Stat. 3941; 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. 111-146, §3(b), Mar. 17, 2010, 124 Stat. 67; Pub. L. 116-260, div. Q, title II, §225(e)(1), Dec. 27, 2020, 134 Stat. 2207.)

AMENDMENT OF SECTION

Pub. L. 116-260, div. Q, title II, §225(e)(1), (g), Dec. 27, 2020, 134 Stat. 2207, 2208, provided that, effective upon the expiration of the 1-year period beginning on Dec. 27, 2020, and applicable to any mark registered before, on, or after that effective date, this section is amended by striking "paragraphs (3) and (5)" and inserting "paragraphs (3), (5), and (6)". See 2020 Amendment note below.

REFERENCES IN TEXT

Acts March 3, 1881 and February 20, 1905, referred to in text, 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.

AMENDMENTS

2020—Pub. L. 116-260 substituted "paragraphs (3), (5), and (6)" for "paragraphs (3) and (5)" in introductory provisions.

2010—Pub. L. 111-146, §3(b)(1), substituted "right of the owner" for "right of the registrant" in introductory provisions.

Par. (1). Pub. L. 111-146, §3(b)(2), amended par. (1) generally. Prior to amendment, par. (1) read as follows:

"there has been no final decision adverse to registrant's claim of ownership of such mark for such goods or services, or to registrant's right to register the same or to keep the same on the register; and".

Par. (2). Pub. L. 111-146, §3(b)(3), inserted "United States" before "Patent and Trademark Office".

1999—Pub. L. 106-113 substituted "Director" for "Commissioner" in par. (3) and in two places in concluding provisions.

1988—Pub. L. 100-667, in introductory provisions, substituted "paragraphs (3) and (5)" for "subsections (c) and (e)", in par. (3) "paragraphs" for "subsections", and in par. (4) "the generic name for the goods or services or a portion thereof, for which it is registered" for "the common descriptive name of any article or substance, patented or otherwise".

1982—Pub. L. 97-247 substituted "registration" for "the publication" in provision preceding par. (1).

1975—Par. (2). Pub. L. 93-596 substituted "Patent and Trademark Office" for "Patent Office".

1962—Pub. L. 87-772 substituted "(c) and (e) of section 1064" for "(c) and (d) of section 1064" in provision preceding par. (1), and struck out "or trade name" after "in a mark" in par. (4).

EFFECTIVE DATE OF 2020 AMENDMENT

Amendment by Pub. L. 116-260 effective upon the expiration of the 1-year period beginning on Dec. 27, 2020, and applicable to any mark registered before, on, or after that effective date, see section 225(g) of div. Q of Pub. L. 116-260, set out as a note under section 1064 of this title.

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 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, 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.

§ 1066. Interference; declaration by Director

Upon petition showing extraordinary circumstances, the Director may declare that an interference exists when application is made for the registration of a mark which so resembles a mark previously registered by another, or for the registration of which another has previously made application, as to be likely when used on

or in connection with the goods or services of the applicant to cause confusion or mistake or to deceive. No interference shall be declared between an application and the registration of a mark the right to the use of which has become incontestable.

(July 5, 1946, ch. 540, title I, §16, 60 Stat. 434; Pub. L. 87-772, §11, Oct. 9, 1962, 76 Stat. 771; Pub. L. 97-247, §11, Aug. 27, 1982, 96 Stat. 321; Pub. L. 100-667, title I, §117, Nov. 16, 1988, 102 Stat. 3941; Pub. L. 106-113, div. B, §1000(a)(9) [title IV, §4732(b)(1)(B)], Nov. 29, 1999, 113 Stat. 1536, 1501A-583.)

PRIOR PROVISIONS

Act Feb. 20, 1905, ch. 592, §7, 33 Stat. 726.

AMENDMENTS

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

1988—Pub. L. 100-667 substituted “used on or in connection with the goods or services” for “applied to the goods or when used in connection with the services”.

1982—Pub. L. 97-247 substituted “Upon petition showing extraordinary circumstances, the Commissioner may declare that an interference exists when application is made for the registration of a mark which so resembles a mark previously registered by another, or for the registration of which another has previously made application, as to be likely when applied to the goods or when used in connection with the services of the applicant to cause confusion or mistake or to deceive” for “Whenever application is made for the registration of a mark which so resembles a mark previously registered by another, or for the registration of which another has previously made application, as to be likely when applied to the goods or when used in connection with the services of the applicant to cause confusion or mistake or to deceive, the Commissioner may declare that an interference exists”.

1962—Pub. L. 87-772 struck out “purchasers” after “or to deceive”.

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.

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§ 1066a. Ex parte expungement

(a) Petition

Notwithstanding sections 1057(b) and 1072 of this title, and subsections (a) and (b) of section

1115 of this title, any person may file a petition to expunge a registration of a mark on the basis that the mark has never been used in commerce on or in connection with some or all of the goods or services recited in the registration.

(b) Contents of petition

A petition filed under subsection (a), together with any supporting documents, shall—

(1) identify the registration that is the subject of the petition;

(2) identify each good or service recited in the registration for which it is alleged that the mark has never been used in commerce;

(3) include a verified statement that sets forth—

(A) the elements of the reasonable investigation the petitioner conducted to determine that the mark has never been used in commerce on or in connection with the goods and services identified in the petition; and

(B) any additional facts that support the allegation that the mark has never been used in commerce on or in connection with the identified goods and services;

(4) include any supporting evidence on which the petitioner relies; and

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

(c) Initial determination; institution

(1) Prima facie case determination, institution, and notification

The Director shall, for each good or service identified under subsection (b)(2), determine whether the petition sets forth a prima facie case of the mark having never been used in commerce on or in connection with each such good or service, institute an ex parte expungement proceeding for each good or service for which the Director determines that a prima facie case has been set forth, and provide a notice to the registrant and petitioner of the determination of whether or not the proceeding was instituted. Such notice shall include a copy of the petition and any supporting documents and evidence that were included with the petition.

(2) Reasonable investigation guidance

The Director shall promulgate regulations regarding what constitutes a reasonable investigation under subsection (b)(3) and the general types of evidence that could support a prima facie case that a mark has never been used in commerce, but the Director shall retain the discretion to determine whether a prima facie case is set out in a particular proceeding.

(3) Determination by Director

Any determination by the Director whether or not to institute a proceeding under this section shall be final and non-reviewable, and shall not prejudice any party's right to raise any issue and rely on any evidence in any other proceeding, except as provided in subsection (j).

(d) Ex parte expungement procedures

The procedures for ex parte expungement shall be the same as the procedures for examination