

## 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 1961 AMENDMENT

Pub. L. 87-333, §3, Oct. 3, 1961, 75 Stat. 748, provided that: "This Act [amending this section and section 119 of Title 35, Patents] shall take effect on the date when the Convention of Paris for the Protection of Industrial Property of March 20, 1883, as revised at Lisbon, October 31, 1958, comes into force with respect to the United States and shall apply only to applications thereafter filed in the United States by persons entitled to the benefit of said convention, as revised at the time of such filing."

## 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.

**§ 1127. Construction and definitions; intent of chapter**

In the construction of this chapter, unless the contrary is plainly apparent from the context—

The United States includes and embraces all territory which is under its jurisdiction and control.

The word "commerce" means all commerce which may lawfully be regulated by Congress.

The term "principal register" refers to the register provided for by sections 1051 to 1072 of this title, and the term "supplemental register" refers to the register provided for by sections 1091 to 1096 of this title.

The term "person" and any other word or term used to designate the applicant or other entitled to a benefit or privilege or rendered liable under the provisions of this chapter includes a juristic person as well as a natural person. The term "juristic person" includes a firm, corporation, union, association, or other organization capable of suing and being sued in a court of law.

The term "person" also includes the United States, any agency or instrumentality thereof, or any individual, firm, or corporation acting for the United States and with the authorization and consent of the United States. The United States, any agency or instrumentality thereof, and any individual, firm, or corporation acting for the United States and with the authorization and consent of the United States, shall be subject to the provisions of this chapter in the same manner and to the same extent as any nongovernmental entity.

The term "person" also 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.

The terms "applicant" and "registrant" embrace the legal representatives, predecessors, successors and assigns of such applicant or registrant.

The term "Director" means the Under Secretary of Commerce for Intellectual Property and Director of the United States Patent and Trademark Office.

The term "related company" means any person whose use of a mark is controlled by the owner of the mark with respect to the nature and quality of the goods or services on or in connection with which the mark is used.

The terms "trade name" and "commercial name" mean any name used by a person to identify his or her business or vocation.

The term "trademark" includes any word, name, symbol, or device, or any combination thereof—

- (1) used by a person, or
- (2) which a person has a bona fide intention to use in commerce and applies to register on the principal register established by this chapter,

to identify and distinguish his or her goods, including a unique product, from those manufactured or sold by others and to indicate the source of the goods, even if that source is unknown.

The term "service mark" means any word, name, symbol, or device, or any combination thereof—

- (1) used by a person, or
- (2) which a person has a bona fide intention to use in commerce and applies to register on the principal register established by this chapter,

to identify and distinguish the services of one person, including a unique service, from the services of others and to indicate the source of the services, even if that source is unknown. Titles, character names, and other distinctive features of radio or television programs may be registered as service marks notwithstanding that they, or the programs, may advertise the goods of the sponsor.

The term "certification mark" means any word, name, symbol, or device, or any combination thereof—

- (1) used by a person other than its owner, or
- (2) which its owner has a bona fide intention to permit a person other than the owner to use in commerce and files an application to register on the principal register established by this chapter,

to certify regional or other origin, material, mode of manufacture, quality, accuracy, or other characteristics of such person's goods or services or that the work or labor on the goods or services was performed by members of a union or other organization.

The term "collective mark" means a trademark or service mark—

- (1) used by the members of a cooperative, an association, or other collective group or organization, or
- (2) which such cooperative, association, or other collective group or organization has a

bona fide intention to use in commerce and applies to register on the principal register established by this chapter,

and includes marks indicating membership in a union, an association, or other organization.

The term “mark” includes any trademark, service mark, collective mark, or certification mark.

The term “use in commerce” means the bona fide use of a mark in the ordinary course of trade, and not made merely to reserve a right in a mark. For purposes of this chapter, a mark shall be deemed to be in use in commerce—

(1) on goods when—

(A) it is placed in any manner on the goods or their containers or the displays associated therewith or on the tags or labels affixed thereto, or if the nature of the goods makes such placement impracticable, then on documents associated with the goods or their sale, and

(B) the goods are sold or transported in commerce, and

(2) on services when it is used or displayed in the sale or advertising of services and the services are rendered in commerce, or the services are rendered in more than one State or in the United States and a foreign country and the person rendering the services is engaged in commerce in connection with the services.

A mark shall be deemed to be “abandoned” if either of the following occurs:

(1) When its use has been discontinued with intent not to resume such use. Intent not to resume may be inferred from circumstances. Nonuse for 3 consecutive years shall be prima facie evidence of abandonment. “Use” of a mark means the bona fide use of such mark made in the ordinary course of trade, and not made merely to reserve a right in a mark.

(2) When any course of conduct of the owner, including acts of omission as well as commission, causes the mark to become the generic name for the goods or services on or in connection with which it is used or otherwise to lose its significance as a mark. Purchaser motivation shall not be a test for determining abandonment under this paragraph.

The term “colorable imitation” includes any mark which so resembles a registered mark as to be likely to cause confusion or mistake or to deceive.

The term “registered mark” means a mark registered in the United States Patent and Trademark Office under this chapter or under the Act of March 3, 1881, or the Act of February 20, 1905, or the Act of March 19, 1920. The phrase “marks registered in the Patent and Trademark Office” means registered marks.

The term “Act of March 3, 1881”, “Act of February 20, 1905”, or “Act of March 19, 1920”, means the respective Act as amended.

A “counterfeit” is a spurious mark which is identical with, or substantially indistinguishable from, a registered mark.

The term “domain name” means any alphanumeric designation which is registered with or assigned by any domain name registrar, domain

name registry, or other domain name registration authority as part of an electronic address on the Internet.

The term “Internet” has the meaning given that term in section 230(f)(1) of title 47.

Words used in the singular include the plural and vice versa.

The intent of this chapter is to regulate commerce within the control of Congress by making actionable the deceptive and misleading use of marks in such commerce; to protect registered marks used in such commerce from interference by State, or territorial legislation; to protect persons engaged in such commerce against unfair competition; to prevent fraud and deception in such commerce by the use of reproductions, copies, counterfeits, or colorable imitations of registered marks; and to provide rights and remedies stipulated by treaties and conventions respecting trademarks, trade names, and unfair competition entered into between the United States and foreign nations.

(July 5, 1946, ch. 540, title X, §45, 60 Stat. 443; Pub. L. 87-772, §21, Oct. 9, 1962, 76 Stat. 774; Pub. L. 93-596, §1, Jan. 2, 1975, 88 Stat. 1949; Pub. L. 98-620, title I, §103, Nov. 8, 1984, 98 Stat. 3335; Pub. L. 100-667, title I, §134, Nov. 16, 1988, 102 Stat. 3946; Pub. L. 102-542, §3(d), Oct. 27, 1992, 106 Stat. 3568; Pub. L. 103-465, title V, §521, Dec. 8, 1994, 108 Stat. 4981; Pub. L. 104-98, §4, Jan. 16, 1996, 109 Stat. 986; Pub. L. 106-43, §§4(c), 6(b), Aug. 5, 1999, 113 Stat. 219, 220; Pub. L. 106-113, div. B, §1000(a)(9) [title III, §3005, title IV, §4732(b)(1)(A)], Nov. 29, 1999, 113 Stat. 1536, 1501A-550, 1501A-583; Pub. L. 109-312, §3(e), Oct. 6, 2006, 120 Stat. 1733.)

#### REFERENCES IN TEXT

Acts March 3, 1881, February 20, 1905, and March 19, 1920, referred to in text, are acts Mar. 3, 1881, ch. 138, 21 Stat. 502; Feb. 20, 1905, ch. 592, 33 Stat. 724; and Mar. 19, 1920, ch. 104, 41 Stat. 533, 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. Act Mar. 19, 1920, had been generally classified to sections 121 to 128 of this title.

#### PRIOR PROVISIONS

Acts Feb. 20, 1905, ch. 592, §29, 33 Stat. 731; June 10, 1938, ch. 332, §5, 52 Stat. 639.

#### AMENDMENTS

2006—Pub. L. 109-312 struck out par. defining “dilution” after par. defining “abandoned”.

1999—Pub. L. 106-113, §1000(a)(9) [title IV, §4732(b)(1)(A)], substituted par. defining “Director” for par. which read as follows: “The term ‘Commissioner’ means the Commissioner of Patents and Trademarks.”

Pub. L. 106-113, §1000(a)(9) [title III, §3005], inserted pars. defining “domain name” and “Internet” after par. defining “counterfeit”.

Pub. L. 106-43, §6(b), substituted “trademarks” for “trade-marks” in last undesignated par.

Pub. L. 106-43, §4(c), between pars. defining “person” inserted: “The term ‘person’ also includes the United States, any agency or instrumentality thereof, or any individual, firm, or corporation acting for the United States and with the authorization and consent of the United States. The United States, any agency or instrumentality thereof, and any individual, firm, or corporation acting for the United States and with the authorization and consent of the United States, shall be subject to the provisions of this chapter in the same

manner and to the same extent as any nongovernmental entity.”

1996—Pub. L. 104-98 inserted par. defining “dilution” after par. defining “abandoned”.

1994—Pub. L. 103-465 amended par. defining “abandoned” generally. Prior to amendment, par. read as follows: “A mark shall be deemed to be ‘abandoned’ when either of the following occurs:

“(1) When its use has been discontinued with intent not to resume such use. Intent not to resume may be inferred from circumstances. Nonuse for two consecutive years shall be prima facie evidence of abandonment. ‘Use’ of a mark means the bona fide use of that mark made in the ordinary course of trade, and not made merely to reserve a right in a mark.

“(2) When any course of conduct of the owner, including acts of omission as well as commission, causes the mark to become the generic name for the goods or services on or in connection with which it is used or otherwise to lose its significance as a mark. Purchaser motivation shall not be a test for determining abandonment under this paragraph.”

1992—Pub. L. 102-542 inserted after fourth undesignated par. “The term ‘person’ also 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—Pub. L. 100-667, §134(1), amended par. defining “related company” generally. Prior to amendment, par. read as follows: “The term ‘related company’ means any person who legitimately controls or is controlled by the registrant or applicant for registration in respect to the nature and quality of the goods or services in connection with which the mark is used.”

Pub. L. 100-667, §134(2), amended par. defining “trade name” and “commercial name” generally. Prior to amendment, par. read as follows: “The terms ‘trade name’ and ‘commercial name’ include individual names and surnames, firm names and trade names used by manufacturers, industrialists, merchants, agriculturists, and others to identify their businesses, vocations, or occupations; the names or titles lawfully adopted and used by persons, firms, associations, corporations, companies, unions, and any manufacturing, industrial, commercial, agricultural, or other organizations engaged in trade or commerce and capable of suing and being sued in a court of law.”

Pub. L. 100-667, §134(3), amended par. defining “trademark” generally. Prior to amendment, par. read as follows: “The term ‘trademark’ includes any word, name, symbol, or device or any combination thereof adopted and used by a manufacturer or merchant to identify and distinguish his goods, including a unique product, from those manufactured or sold by others and to indicate the source of the goods, even if that source is unknown.”

Pub. L. 100-667, §134(4), amended par. defining “service mark” generally. Prior to amendment, par. read as follows: “The term ‘service mark’ means a mark used in the sale or advertising of services to identify and distinguish the services of one person, including a unique service, from the services of others and to indicate the source of the services, even if that source is unknown. Titles, character names and other distinctive features of radio or television programs may be registered as service marks notwithstanding that they, or the programs, may advertise the goods of the sponsor.”

Pub. L. 100-667, §134(5), amended par. defining “certification mark” generally. Prior to amendment, par. read as follows: “The term ‘certification mark’ means a mark used upon or in connection with the products or services of one or more persons other than the owner of the mark to certify regional or other origin, material, mode of manufacture, quality, accuracy or other characteristics of such goods or services or that the work or labor on the goods or services was performed by members of a union or other organization.”

Pub. L. 100-667, §134(6), amended par. defining “collective mark” generally. Prior to amendment, par. read as follows: “The term ‘collective mark’ means a trademark or service mark used by the members of a cooperative, an association or other collective group or organization and includes marks used to indicate membership in a union, an association or other organization.”

Pub. L. 100-667, §134(7), amended par. defining “mark” generally. Prior to amendment, par. read as follows: “The term ‘mark’ includes any trademark, service mark, collective mark, or certification mark entitled to registration under this chapter whether registered or not.”

Pub. L. 100-667, §134(8), substituted par. defining “use in commerce” for former par. which read as follows: “For the purposes of this chapter a mark shall be deemed to be used in commerce (a) on goods when it is placed in any manner on the goods or their containers or the displays associated therewith or on the tags or labels affixed thereto and the goods are sold or transported in commerce and (b) on services when it is used or displayed in the sale or advertising of services and the services are rendered in commerce, or the services are rendered in more than one State or in this and a foreign country and the person rendering the services is engaged in commerce in connection therewith.” and par. providing when a mark is deemed abandoned for former par. which read as follows: “A mark shall be deemed to be ‘abandoned’—

“(a) When its use has been discontinued with intent not to resume. Intent not to resume may be inferred from circumstances. Nonuse for two consecutive years shall be prima facie abandonment.

“(b) When any course of conduct of the registrant, including acts of omission as well as commission, causes the mark to lose its significance as an indication of origin. Purchaser motivation shall not be a test for determining abandonment under this subparagraph.”

1984—Pub. L. 98-620, §103(1), in definition of “trademark” substituted “trademark” for “trade-mark”, and substituted “identify and distinguish his goods, including a unique product, from those manufactured or sold by others and to indicate the source of the goods, even if that source is unknown” for “identify his goods and distinguish them from those manufactured or sold by others”.

Pub. L. 98-620, §103(2), in definition of “service mark” substituted “The term ‘service mark’ means a mark used in the sale or advertising of services to identify and distinguish the services of one person, including a unique service, from the services of others and to indicate the source of the services, even if that source is unknown” for “The term ‘service mark’ means a mark used in the sale or advertising of services to identify the services of one person and distinguish them from the services of others”.

Pub. L. 98-620, §103(3), in subpar. (b) of par. relating to when a mark shall be deemed to be “abandoned”, inserted “Purchaser motivation shall not be a test for determining abandonment under this subparagraph.”

1975—Pub. L. 93-596 substituted “Patent and Trademark Office” for “Patent Office” in two places and “Commissioner of Patents and Trademarks” for “Commissioner of Patents” in definition of “Commissioner”.

1962—Pub. L. 87-772 substituted, “predecessors,” for “and” in definition of “applicant” and “registrant”, “Titles, character names and other distinctive features of radio or television programs may be registered as service marks notwithstanding that they, or the programs, may advertise the goods of the sponsor” for “and includes without limitation the marks, names, symbols, titles, designations, slogans, character names, and distinctive features of radio or other advertising used in commerce”, in definition of “service mark”, inserted “or the services are rendered in more than one State or in this and a foreign country and the person rendering the services is engaged in commerce in connection therewith” in fifteenth paragraph relating to use in commerce, struck out “purchasers” after “deceive” in definition of “colorable imitation”, and sub-

stituted “commerce” for “commence” in last par. relating to the intent of the chapter.

#### EFFECTIVE DATE OF 1999 AMENDMENT

Amendment by section 1000(a)(9) [title III, §3005] of 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.

Amendment by section 1000(a)(9) [title IV, §4732(b)(1)(A)] of 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 1994 AMENDMENT

Amendment by Pub. L. 103–465 effective one year after the date on which the WTO Agreement enters into force with respect to the United States [Jan. 1, 1995], see section 523 of Pub. L. 103–465, set out as a note under section 1052 of this title.

#### EFFECTIVE DATE OF 1992 AMENDMENT

Amendment by Pub. L. 102–542 effective with respect to violations that occur on or after Oct. 27, 1992, see section 4 of Pub. L. 102–542, set out as a note under section 1114 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.

### § 1128. Repealed. Pub. L. 110–403, title III, § 305(a)(1), Oct. 13, 2008, 122 Stat. 4270

Section, Pub. L. 106–58, title VI, §653, Sept. 29, 1999, 113 Stat. 480; Pub. L. 106–113, div. B, §1000(a)(9) [title IV, §4741(b)(1)], Nov. 29, 1999, 113 Stat. 1536, 1501A–586; Pub. L. 108–447, div. B, title II, §210, Dec. 8, 2004, 118 Stat. 2884, established the National Intellectual Property Law Enforcement Coordination Council.

#### EFFECTIVE DATE OF REPEAL

Pub. L. 110–403, title III, §305(a)(1), Oct. 13, 2008, 122 Stat. 4270, provided that the repeal of this section is effective upon confirmation of the Intellectual Property Enforcement Coordinator by the Senate and publication of such appointment in the Congressional Record. The Senate confirmed the first Intellectual Property Enforcement Coordinator on Dec. 3, 2009, as reflected in that day’s Congressional Record. See 155 Cong. Rec. 29389 (2009).

### § 1129. Transferred

#### CODIFICATION

Section, Pub. L. 106–113, div. B, §1000(a)(9) [title III, §3002(b)], Nov. 29, 1999, 113 Stat. 1536, 1501A–548, which

related to cyberpiracy protections for individuals, was transferred to section 8131 of this title.

## SUBCHAPTER IV—THE MADRID PROTOCOL

### § 1141. Definitions

In this subchapter:

#### (1) Basic application

The term “basic application” means the application for the registration of a mark that has been filed with an Office of a Contracting Party and that constitutes the basis for an application for the international registration of that mark.

#### (2) Basic registration

The term “basic registration” means the registration of a mark that has been granted by an Office of a Contracting Party and that constitutes the basis for an application for the international registration of that mark.

#### (3) Contracting Party

The term “Contracting Party” means any country or inter-governmental organization that is a party to the Madrid Protocol.

#### (4) Date of recordal

The term “date of recordal” means the date on which a request for extension of protection, filed after an international registration is granted, is recorded on the International Register.

#### (5) Declaration of bona fide intention to use the mark in commerce

The term “declaration of bona fide intention to use the mark in commerce” means a declaration that is signed by the applicant for, or holder of, an international registration who is seeking extension of protection of a mark to the United States and that contains a statement that—

(A) the applicant or holder has a bona fide intention to use the mark in commerce;

(B) the person making the declaration believes himself or herself, or the firm, corporation, or association in whose behalf he or she makes the declaration, to be entitled to use the mark in commerce; and

(C) no other person, firm, corporation, or association, to the best of his or her knowledge and belief, has the right to use such mark in commerce either in the identical form of the mark or in such near resemblance to the mark as to be likely, when used on or in connection with the goods of such other person, firm, corporation, or association, to cause confusion, mistake, or deception.

#### (6) Extension of protection

The term “extension of protection” means the protection resulting from an international registration that extends to the United States at the request of the holder of the international registration, in accordance with the Madrid Protocol.

#### (7) Holder of an international registration

A “holder” of an international registration is the natural or juristic person in whose name