

# ORGANIZACIÓN MUNDIAL DEL COMERCIO

IP/N/1/USA/T/1

7 de junio de 1996

(96-2159)

Consejo de los Aspectos de los Derechos de Propiedad  
Intelectual relacionados con el Comercio

Original: inglés

## PRINCIPALES LEYES Y REGLAMENTOS DEDICADOS A LA PROPIEDAD INTELECTUAL NOTIFICADOS EN VIRTUD DEL PÁRRAFO 2 DEL ARTÍCULO 63 DEL ACUERDO

### Estados Unidos

En el presente documento se reproducen<sup>1</sup> los artículos 1051 a 1127 del Título 15 del Código de los Estados Unidos, notificados por los Estados Unidos en virtud de lo dispuesto en el párrafo 2 del artículo 63 del Acuerdo junto con la legislación contenida en el documento IP/N/1/USA/T/2. También se reproduce información, que los Estados Unidos han notificado, sobre algunos otros artículos del Código de los Estados Unidos y del Código de Reglamentos Federales, que protegen nombres, términos y marcas específicos, así como algunos artículos del Código de los Estados Unidos relativos a las marcas de fábrica o de comercio. Los Estados Unidos han hecho referencia también a leyes de los Estados que se refieren a las prácticas comerciales engañosas y que establecen algún tipo de protección similar a la de las marcas de fábricas o de comercio. Los Estados Unidos facilitarán un resumen de esta legislación, así como gráficos de correlación (lo que se podría llamar "mapas de carretera") de todas las principales leyes y reglamentos y "otras leyes y reglamentos de los Estados Unidos", como complemento de la notificación que han presentado en virtud de lo dispuesto en el párrafo 2 del artículo 63 (se distribuirán en el documento IP/N/1/USA/1).

---

<sup>1</sup>En inglés solamente.

*Trademark Laws and Regulations*

UNITED STATES CODE

TITLE 15—COMMERCE AND TRADE

CHAPTER 22—TRADE-MARKS

Subchapter I—The Principal Register .....	1051
Subchapter II—The Supplemental Register .....	1091
Subchapter III—General Provisions .....	1111

**TITLE 15--COMMERCE AND TRADE**

**CHAPTER 22--TRADE-MARKS**

**SUBCHAPTER I--THE PRINCIPAL REGISTER**

Sec.

- 1051. Registration of trade-marks.
- 1052. Trade-marks registrable on principal register; concurrent registration.
- 1053. Service marks registrable.
- 1054. Collective marks and certification marks registrable.
- 1055. Use by related companies affecting validity and registration.
- 1056. Disclaimer of unregistrable matter.
- 1057. Certificates of registration.
- 1058. Duration of registration.
- 1059. Renewal of registration.
- 1060. Assignment of mark; execution; recording; purchaser without notice.
- 1061. Execution of acknowledgments and verifications.
- 1062. Publication.
- 1063. Opposition to registration.
- 1064. Cancellation of registration.
- 1065. Incontestability of right to use mark under certain conditions.
- 1066. Interference; declaration by Commissioner.
- 1067. Interference, opposition, and proceedings for concurrent use registration or for cancellation; notice; Trademark Trial and Appeal Board.
- 1068. Action of Commissioner in interference, opposition, and proceedings for concurrent use registration or for cancellation.
- 1069. Application of equitable principles in inter partes proceedings.
- 1070. Appeals to Trademark Trial and Appeal Board from decisions of examiners.
- 1071. Appeal to courts.
- 1072. Registration as constructive notice of claim of ownership.

**15 U.S.C. 1051      Registration; application; payment of fees; designation of agent for service of process [Section 1]**

(a) The owner of a trademark used in commerce may apply to register his or her trademark under this Act on the principal register hereby established:

(1) By filing in the Patent and Trademark Office--

- (a) a written application, in such form as may be prescribed by the Commissioner, verified by the applicant, or by a member of the firm or an officer of the corporation or association applying, specifying applicant's domicile and citizenship, the date of applicant's first use of the mark, the date of applicant's first use of the mark in commerce, the goods on or in connection with which the mark is used and the mode or manner in which the mark is used in connection with such goods, and including a statement to the effect that the person making the verification believes himself, or the firm, corporation, or association in whose behalf he makes the verification, to be the owner of the mark sought to be registered, that the mark is in use in commerce, and that no other person, firm, corporation, or association, to the best of his knowledge and belief, has the right to use such mark in commerce either in the identical form thereof or in such near

*Trademark Laws and Regulations*

resemblance thereto as to be likely, when used on or in connection with the goods of such other person, to cause confusion, or to cause mistake, or to deceive: Provided, that in the case of every application claiming concurrent use the applicant shall state exceptions to his claim of exclusive use, in which he shall specify, to the extent of his knowledge, any concurrent use by others, the goods on or in connection with which and the areas in which each concurrent use exists, the periods of each use, and the goods and area for which the applicant desires registration;

- (b) a drawing of the mark; and
- (c) such number of specimens or facsimiles of the mark as used as may be required by the Commissioner.
- (2) By paying in the Patent and Trademark Office the prescribed fee.
- (3) By complying with such rules or regulations, not inconsistent with law, as may be prescribed by the Commissioner.

(b) A person who has a bona fide intention, under circumstances showing the good faith of such person, to use a trademark in commerce may apply to register the trademark under this Act on the principal register hereby established:

- (1) By filing in the Patent and Trademark Office--
  - (a) a written application, in such form as may be prescribed by the Commissioner, verified by the applicant, or by a member of the firm or an officer of the corporation or association applying, specifying applicant's domicile and citizenship, applicant's bona fide intention to use the mark in commerce, the goods on or in connection with which the applicant has a bona fide intention to use the mark and the mode or manner in which the mark is intended to be used on or in connection with such goods, including a statement to the effect that the person making the verification believes himself or herself, or the firm, corporation, or association in whose behalf he or she makes the verification, to be entitled to use the mark in commerce, and that 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, to cause confusion, or to cause mistake, or to deceive; however, except for applications filed pursuant to §44, no mark shall be registered until the applicant has met the requirements of subsection (d) of this section; and
  - (b) a drawing of the mark.
- (2) By paying in the Patent and Trademark Office the prescribed fee.
- (3) By complying with such rules or regulations, not inconsistent with law, as may be prescribed by the Commissioner.

(c) At any time during examination of an application filed under subsection (b), an applicant who has made use of the mark in commerce may claim the benefits of such use for purposes of this Act, by amending his or her application to bring it into conformity with the requirements of subsection (a).

(d)(1) Within six months after the date on which the notice of allowance with respect to a mark is issued under §13(b)(2) to an applicant under subsection (b) of this section, the applicant shall file in the Patent and Trademark Office, together with such number of specimens or facsimiles of the mark as used in commerce as may be required by the Commissioner and payment of the prescribed fee, a verified statement that the mark is in use in commerce and specifying the date of the applicant's first use of the mark in commerce, those goods or services specified in the notice of allowance on or in connection with which the mark is used in commerce, and the mode or manner in which the mark is used on or in connection with such goods or services. Subject to examination and acceptance of the

*Trademark Laws and Regulations*

statement of use, the mark shall be registered in the Patent and Trademark Office, a certificate of registration shall be issued for those goods or services recited in the statement of use for which the mark is entitled to registration, and notice of registration shall be published in the Official Gazette of the Patent and Trademark Office. Such examination may include an examination of the factors set forth in subsections (a) through (e) of §2. The notice of registration shall specify the goods or services for which the mark is registered.

- (2) The Commissioner shall extend, for one additional 6-month period, the time for filing the statement of use under paragraph (1), upon written request of the applicant before the expiration of the 6-month period provided in paragraph (1). In addition to an extension under the preceding sentence, the Commissioner may, upon a showing of good cause by the applicant, further extend the time for filing the statement of use under paragraph (1) for periods aggregating not more than 24 months, pursuant to written request of the applicant made before the expiration of the last extension granted under this paragraph. Any request for an extension under this paragraph shall be accompanied by a verified statement that the applicant has a continued bona fide intention to use the mark in commerce and specifying those goods or services identified in the notice of allowance on or in connection with which the applicant has a continued bona fide intention to use the mark in commerce. Any request for an extension under this paragraph shall be accompanied by payment of the prescribed fee. The Commissioner shall issue regulations setting forth guidelines for determining what constitutes good cause for purposes of this paragraph.
- (3) The Commissioner shall notify any applicant who files a statement of use of the acceptance or refusal thereof and, if the statement of use is refused, the reasons for the refusal. An applicant may amend the statement of use.
- (4) The failure to timely file a verified statement of use under this subsection shall result in abandonment of the application.

(e) If the applicant is not domiciled in the United States he 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 him or mailing to him 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 Commissioner.

**15 U.S.C. 1052 Trademarks registrable on the principal register; concurrent registration [Section 2]**

No trademark by which the goods of the applicant may be distinguished from the goods of others shall be refused registration on the principal register on account of its nature unless it--

- (a) Consists of or comprises immoral, deceptive, or scandalous matter; or matter which may disparage or falsely suggest a connection with persons, living or dead, institutions, beliefs, or national symbols, or bring them into contempt, or disrepute; or a geographical indication which, when used on or in connection with wines or spirits, identifies a place other than the origin of the goods and is first used on or in connection with wines or spirits by the applicant on or after one year after the date on which the WTO Agreement (as defined in section 2(9) of the Uruguay Round Agreements Act) enters into force with respect to the United States.
- (b) Consists of or comprises the flag or coat of arms or other insignia of the United States, or of any State or municipality, or of any foreign nation, or any simulation thereof.
- (c) Consists of or comprises a name, portrait, or signature identifying a particular living individual except by his written consent, or the name, signature, or portrait of a deceased President of the United States during the life of his widow, if any, except by the written consent of the widow.
- (d) Consists of or comprises a mark which so resembles a mark registered in the Patent and Trademark Office, or a mark or trade name previously used in the United States by another and not abandoned, as to be likely, when used on or in connection with the goods of the applicant, to cause

*Trademark Laws and Regulations*

confusion, or to cause mistake, or to deceive: Provided, That if the Commissioner determines that confusion, mistake, or deception is not likely to result from the continued use by more than one person of the same or similar marks under conditions and limitations as to the mode or place of use of the marks or the goods on or in connection with which such marks are used, concurrent registrations may be issued to such persons when they have become entitled to use such marks as a result of their concurrent lawful use in commerce prior to

- (1) the earliest of the filing dates of the applications pending or of any registration issued under this Act;
- (2) July 5, 1947, in the case of registrations previously issued under the Act of March 3, 1881, or February 20, 1905, and continuing in full force and effect on that date; or
- (3) July 5, 1947, in the case of applications filed under the Act of February 20, 1905, and registered after July 5, 1947.

Use prior to the filing date of any pending application or a registration shall not be required when the owner of such application or registration consents to the grant of a concurrent registration to the applicant. Concurrent registrations may also be issued by the Commissioner when a court of competent jurisdiction has finally determined that more than one person is entitled to use the same or similar marks in commerce. In issuing concurrent registrations, the Commissioner shall prescribe conditions and limitations as to the mode or place of use of the mark or the goods on or in connection with which such mark is registered to the respective persons.

- (e) Consists of a mark which
  - (1) when used on or in connection with the goods of the applicant is merely descriptive or deceptively misdescriptive of them,
  - (2) when used on or in connection with the goods of the applicant is primarily geographically descriptive of them, except as indications of regional origin may be registrable under §4,
  - (3) when used on or in connection with the goods of the applicant is primarily geographically deceptively misdescriptive of them, or
  - (4) is primarily merely a surname.

(f) Except as expressly excluded in paragraphs (a), (b), (c), (d) and (e)(3) of this section, nothing herein shall prevent the registration of a mark used by the applicant which has become distinctive of the applicant's goods in commerce. The Commissioner may accept as prima facie evidence that the mark has become distinctive, as used on or in connection with the applicant's goods in commerce, proof of substantially exclusive and continuous use thereof as a mark by the applicant in commerce for the five years before the date on which the claim of distinctiveness is made. Nothing in this section shall prevent the registration of a mark which, when used on or in connection with the goods of the applicant, is primarily geographically deceptively misdescriptive of them, and which became distinctive of the applicant's goods in commerce before the date of the enactment of the North American Free Trade Agreement Implementation Act.

#### **15 U.S.C. 1053      Service marks registrable [Section 3]**

Subject to the provisions relating to the registration of trademarks, so far as they are applicable, service marks shall be registrable, in the same manner and with the same effect as are trademarks, and when registered they shall be entitled to the protection provided herein in the case of trademarks. Applications and procedure under this section shall conform as nearly as practicable to those prescribed for the registration of trademarks.

#### **15 U.S.C. 1054      Collective marks and certification marks registrable [Section 4]**

Subject to the provisions relating to the registration of trademarks, so far as they are applicable, collective and certification marks, including indications of regional origin, shall be registrable under this Act, in the same manner and with the same effect as are trademarks, by persons, and nations, States, municipalities, and the like, exercising legitimate control over the use of the marks sought to be registered, even though not possessing an industrial or commercial establishment, and when