

CRS Abstract and Digest:

Abstract

(from Congressional Research Service, Library of Congress)

Amends the trademark law (the Lanham Act) to create an intent-to-use application system for trademarks and to conform such law with judicial interpretations and contemporary marketing practices.

Digest

(from Congressional Research Service, Library of Congress)

10/19/88 (Measure passed House, amended)

Title I: Trademark Law Revision

Trademark Law Revision Act of 1988 - Amends the Lanham Act to permit a person who has a bona fide intention to use a trademark in commerce to apply to register the trademark. (Current law provides only for registration of a trademark already in use in commerce.) Requires that such trademark actually be used in commerce before it becomes a registered trademark.

States that an application on an intent-to-use basis constitutes constructive use of the mark which must be resolved either through ultimate registration or other disposition before a later application for the same mark may be registered. Sets forth a filing schedule under which applicants must submit a verified statement of use regarding the mark's initial use in commerce and the goods or services with which it shall be connected.

Provides for the examination of applications for registration submitted on the basis of intent-to-use. Sets forth procedures for such applications.

Permits concurrent registrations by consent regardless of filing dates. Modifies the time period within which proof of a mark's distinctiveness may be offered.

Eliminates the separate register for service marks. Eliminates the separate register for collective and certification marks, permitting the use of the former to indicate that their owners perform the connected service or sell the goods associated with such marks.

States that when the first use of a mark is made by a related company (a licensee), then that use will inure to the benefit of the applicant or registrant. Provides that the filing of an application to register a mark on the principal register constitutes constructive use of such mark (thus conferring a nationwide right of priority subject to certain exceptions).

Halves the terms of registration and renewal to ten years each. Requires the deletion of marks where in the sixth year of registration the registrant does not file the required affidavit of use. Prohibits the assignment of an intent-to-use application prior to registration unless such application is assigned to the applicant's successor in business.

Modifies conditions under which a mark becomes subject to cancellation because it has become a generic name (formerly called "common descriptive name").

Grants the Trademark Trial and Appeal Board authority to limit or modify the goods or services identified in a registration or application to avoid the likelihood of confusion and to determine trademark ownership rights when they are at variance with the register. Limits when final judgments in administrative proceedings may be entered in intent-to-use

cases to the time such mark is registered if the applicant cannot prevail without establishing constructive use.

Eliminates the one year use requirement for applying to register a mark on the supplemental register and states that the use of such register does not constitute an admission that the mark has not acquired distinctiveness. States that an injunction against future transmission of electronic communication is the only remedy available to persons injured by innocent infringement or misrepresentation committed by persons engaged solely in the business of disseminating electronic communications. Makes any person who makes misrepresentations in commercial advertising or promotion liable in a civil action to any plaintiff who believes she or he has been damaged by such misrepresentation.

Requires applicants for registration of marks in the United States based on foreign registration to state a bona fide intention to use such mark in commerce.

Modifies definitions under such Act to reflect the creation of the intent-to-use system. Amends the definition of use in commerce to require bona fide use in the ordinary course of trade, and not merely to reserve a right to a mark.

Provides that registration certificates based on applications pending in the Patent and Trademark Office on the effective date of this Act shall remain in force for a ten-year period.

#### Title II: Satellite Home Viewer Act

Satellite Home Viewer Act of 1988 - Amends the copyright law to require statutory licensing of secondary transmissions of a primary transmission made by a superstation or a network station if such secondary transmission is made by a satellite carrier to the public (or to a distributor to the public) for private viewing for a charge.

Limits such network station statutory licensing requirement to secondary transmissions to unserved households.

Requires a satellite carrier that makes secondary transmissions of a primary transmission by a network station to submit to such network (or its affiliate) a subscriber information list for purposes of monitoring compliance by the satellite carrier. Declares that noncompliance with such reporting and payment requirements is actionable as an act of infringement, as is the secondary transmission by a satellite carrier of a primary transmission made by a network station to a subscriber who does not reside in an unserved household.

Prohibits the carrier from altering such transmission or discriminating against a distributor.

Requires the satellite carrier to deposit semiannually with the Register of Copyrights both royalty fees and a statement of account. Requires distribution of such fees to a copyright owner according to the accounting and specified procedures. Requires the Copyright Royalty Tribunal to conduct a proceeding to determine distribution if a controversy exists.

Requires voluntary negotiation of fees or fees set by compulsory arbitration if no voluntary agreement is filed with the Copyright Office. Authorizes judicial review of decisions of the Tribunal concerning the adoption or rejection of the arbitration.

Amends the Communications Act of 1934 to direct the Federal Communications Commission, within 120 days after the effective date of this Act, to initiate a combined inquiry and rulemaking proceeding to determine the feasibility of imposing syndicated exclusivity rules about the delivery

of syndicated programming for private viewing similar to certain other Commission rules about syndicated exclusivity and cable television. Requires adoption of such rules if feasible. Subjects violators of such rules to specified penalties.

Requires the Commission to report to the Congress, within one year after the effective date of this Act, about any existing discrimination of the sort addressed by this Act.

Requires the Commission to initiate an inquiry concerning the need for a universal encryption standard that permits decryption of satellite cable programming intended for private viewing. Prescribes inquiry guidelines. Doubles the fines and maximum imprisonment terms for willful violations, and raises from \$250 to \$1,000 the minimum statutory damages which a court may award an aggrieved party. Establishes maximum fines and imprisonment terms for persons knowingly engaged in transactions involving devices used primarily to assist in the unauthorized decryption of satellite cable programming (or any other proscribed activity).

Terminates this Act on December 31, 1994.