Section 1064. Cancellation of registration

A petition to cancel a registration of a mark, stating the grounds relied upon, may, upon payment of the prescribed fee, be filed as follows by any person who believes that he is or will be damaged by the registration of a mark on the principal register established by this chapter, or under the Act of March 3, 1881, or the Act of February 20, 1905:

(1) Within five years from the date of the registration of the mark under this chapter.

(2) Within five years from the date of publication under section 1062(c) of this title of a mark registered under the Act of March 3, 1881, or the Act of February 20, 1905.

(3) At any time if the registered mark becomes the generic name for the goods or services, or a portion thereof, for which it is registered, or has been abandoned, or its registration was obtained fraudulently or contrary to the provisions of section 1054 of this title or of subsection (a), (b), or (c) of section 1052 of this title for a registration under such Acts, or if the registered mark is being used by, or with the permission of, the registrant so as to misrepresent the source of the goods or services on or in connection with which the mark is used. If the registered mark becomes the generic name for less than all of the goods or services for which it is registered, a petition to cancel the registration for only those goods or services may be filed. A registered mark shall not be deemed to be the generic name of goods or services solely because such mark is also used as a name of or to identify goods or services for which it is registered, or has been abandoned, or its registration was obtained fraudulently or contrary to the provisions of section 1054 of this title or of subsection (a), (b), or (c) of section 1052 of this title for a registration under such Acts, or if the registered mark is being used by, or with the permission of, the registrant so as to misrepresent the source of the goods or services on or in connection with which the mark is used.

(4) At any time if the mark is registered under the Act of March 3, 1881, or the Act of February 20, 1905, and has not been published under the provisions of subsection (c) of section 1062 of this title.

(5) At any time in the case of a certification mark on the ground that the registrant (A) does not control, or is not able legitimately to
exercise control over, the use of such mark, or (B) engages in the production or marketing of any goods or services to which the certification mark is applied, or (C) permits the use of the certification mark for purposes other than to certify, or (D) discriminated refuses to certify or to continue to certify the goods or services of any person who maintains the standards or conditions which such mark certifies:

Provided. That the Federal Trade Commission may apply to cancel on the grounds specified in paragraphs (3) and (5) of this section any mark registered on the principal register established by this chapter, and the prescribed fee shall not be required.


REFERENCES IN TEXT
Acts March 3, 1881 and February 20, 1905, referred to in opening par. and pars. (2) and (4), are acts Mar. 3, 1881, ch. 138, 21 Stat. 552 and Feb. 20, 1905, ch. 592, 33 Stat. 724, which were repealed in so far 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 199 of this title.

PRIOR PROVISIONS

AMENDMENTS
1988—Pub. L. 100–667, § 115(1), (7), in introductory provisions, inserted “as follows” and substituted “1905—” for “1905—”, and in concluding proviso substituted “paragraphs (3) and (5)” for “subsections (c) and (e)”, par. (1), Pub. L. 100–667, § 115(2), substituted “(1) Within” for “(a) within” and “chapter.” for “chapter; or”. par. (2), Pub. L. 100–667, § 115(3), substituted “(2) Within” for “(b) within”, and “1905—” for “1905—” or. par. (3), Pub. L. 100–667, § 115(4), substituted “(3)” for “(c)” and amended text generally. Prior to amendment, text read as follows: “at any time if the registered mark becomes the common descriptive name of an article or substance, or has been abandoned, or its registration was obtained fraudulently or contrary to the provisions of section 1054 of this title or of subsections (a), (b), or (c) of section 1052 of this title for a registration hereunder, or contrary to similar prohibitory provisions of said prior acts for a registration thereunder, or if the registered mark is being used by, or with the permission of, the registrant so as to misrepresent the source of the goods or services in connection with which the mark is used. A registered mark shall not be deemed to be the common descriptive name of goods or services solely because such mark is also used as a name of or to identify a unique product or service, and that the primary significance of the registered mark to the relevant public rather than purchaser motivation shall be the test for determining whether the registered mark has become the common descriptive name of goods or services in connection with which it has been used.

1962—Pub. L. 97–247 struck out “verified” before “petition to cancel” in provision providing for filing of petitions to cancel, par. (c) substituted “assignee”, and struck out “on which the patent has expired” before “or has been abandoned”, and “has been assigned and” before “is being used by”.

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.

Finality of Judgments Prior to November 8, 1984
Section 104 of title I of Pub. L. 98–620 provided that: “Nothing in this title [amending this section and section 1127 of this title and enacting provisions set out as a note under section 1051 of this title] shall be construed to provide a basis for reopening of any final judgment entered prior to the date of enactment of this title [Nov. 8, 1984].”

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 Federal Trade Commission, with certain exceptions, to Chairman of such Commission, see Reorg. Plan No. 8 of 1950, § 1, eff. May 24, 1950, 15 F.R. 3175, 64 Stat. 1264, set out under section 41 of this title.

Restriction on Use of Funds To Cancel Registration of Trademarks
For provisions restricting the use of funds authorized to be appropriated to carry out section 41 et seq. of this title for fiscal year 1960, 1981, or 1982, for the purpose of taking any action under this section with respect to the cancellation of the registration of any mark on the ground that such mark has become the common descriptive name of an article or substance, see section 18 of Pub. L. 96–252, set out as a note under section 57c of this title.

Cross References
Interference and opposition proceedings, see section 1067 of this title.

Supplemental register, section inapplicable to trademarks on, see section 1084 of this title.

Section Referred to in Other Sections
This section is referred to in sections 1065, 1094 of this title.

§ 1065. Incontestability of right to use mark under certain conditions

Except on a ground for which application to cancel may be filed at any time under paragraphs (3) and (5) of section 1064 of this title, and except to the extent, if any, to which the use of