

STATE OF OKLAHOMA

1st Session of the 48th Legislature (2001)

SENATE BILL 584

By: Henry

AS INTRODUCED

An Act relating to trademarks and labels; amending 78 O.S. 1991, Section 21, which relates to definitions; defining terms; clarifying language; amending 78 O.S. 1991, Section 22, as amended by Section 30, Chapter 69, O.S.L. 1996 (78 O.S. Supp. 2000, Section 22), which relates to registrability of trademarks; clarifying language; amending 78 O.S. 1991, Section 23, as last amended by Section 31, Chapter 69, O.S.L. 1996 (78 O.S. Supp. 2000, Section 23), which relates to application for registration; clarifying language; allowing the Secretary of State to provide certain requirements; modifying certain requirements; providing certain application requirements; providing recourse when application is rejected; providing guidelines for concurrent applications; amending 78 O.S. 1991, Section 24, as amended by Section 32, Chapter 69, O.S.L. 1996 (78 O.S. Supp. 2000, Section 24), which relates to certification of registration; requiring certain contents in a certificate of registration; amending 78 O.S. 1991, Section 25, as amended by Section 6, Chapter 267, O.S.L. 1994 (78 O.S. Supp. 2000, Section 25), which relates to duration and renewal; modifying time period; providing requirements for renewal; amending 78 O.S. 1991, Section 26, as amended by Section 7, Chapter 267, O.S.L. 1994 (78 O.S. Supp. 2000, Section 26), which relates to assignment; clarifying language; describing requirements for change of name; allowing other related instruments to be similarly recorded; describing proof of execution; amending 78 O.S. 1991, Section 28, as amended by Section 8, Chapter 267, O.S.L. 1994 (78 O.S. Supp. 2000, Section 28), which relates to cancellation; clarifying language; providing additional causes for cancellation; amending 78 O.S. 1991, Section 29, as amended by Section 33, Chapter 69, O.S.L. 1996 (78 O.S. Supp. 2000, Section 29), which relates to classification; clarifying language; providing for codification; and providing an effective date.

BE IT ENACTED BY THE PEOPLE OF THE STATE OF OKLAHOMA:

SECTION 1. AMENDATORY 78 O.S. 1991, Section 21, is amended to read as follows:

Section 21. (A) The term "trademark" as used herein means any word, name, symbol, emblem, or device or any combination thereof ~~adopted and used by a person to identify goods made or sold or services rendered by him and to distinguish them from~~ the goods made of such person, including a unique product, from those manufactured or sold or services rendered by others, and to indicate the source of the goods, even if that source is unknown.

(B) The term "service mark" as used herein means any word, name, symbol, or device, or any combination thereof, used by a person 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 used by a person, 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.

(C) The term "mark" as used herein includes any trademark or service mark entitled to registration under this act whether registered or not.

(D) The term "trade name" means any name used by a person to identify a business or vocation of the person.

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

~~(C)~~ (F) The term "applicant" as used herein embraces the person filing an application for registration of a ~~trademark~~ mark under this act, ~~his~~ and the legal representatives, successors or assigns of the person.

~~(D)~~ (G) The term "registrant" as used herein embraces the person to whom the registration of a ~~trademark~~ mark under this act is issued, ~~his~~ and the legal representatives, successors or assigns of the person.

~~(E)~~ (H) The term "use" 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 the purposes of this act, a ~~trademark~~ mark shall be deemed to be "used" in this state (1) on goods when it is placed in any manner on the goods or ~~their~~ other 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 such the goods are sold or ~~otherwise distributed~~ transported in commerce in this state, or (2) on services when it is used or displayed in ~~any manner in connection with~~ the sale or advertising of services and the services are rendered in this state.

~~(F)~~ (I) 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 (2) consecutive years shall constitute prima facie evidence of abandonment; or

2. When any course of conduct of the owner, including acts of omission as well as commission, causes the mark to lose its significance as a mark.

(J) The term "dilution" as used herein means the lessening of the capacity of a famous mark to identify and distinguish goods or services, regardless of the presence or absence of:

1. Competition between the owner of the famous mark and other parties; or

2. Likelihood of confusion, mistake or deception.

(K) The term "emblem" as referred to in ~~section~~ subsection (A) of this section shall be deemed any badge, motto, button, decoration, charm, rosette or such other insignia.

SECTION 2. AMENDATORY 78 O.S. 1991, Section 22, as amended by Section 30, Chapter 69, O.S.L. 1996 (78 O.S. Supp. 2000, Section 22), is amended to read as follows:

Section 22. A ~~trademark~~ mark by which the goods or services of any applicant for registration may be distinguished from the goods or services of others shall not be registered if it:

(a) consists of or comprises immoral, deceptive or scandalous matter; ~~or~~

(b) consists of or comprises 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~~

(c) 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; ~~or~~

(d) consists of or comprises the name, signature or portrait ~~of~~ any identifying a particular living individual, except with his by the individual's written consent; ~~or~~

(e) consists of a mark which, (1) when ~~applied to~~ used on or in connection with the goods or services of the applicant, is merely descriptive or deceptively misdescriptive of them, or (2) when ~~applied to~~ used on or in connection with the goods or services of the applicant, is primarily geographically descriptive or deceptively misdescriptive of them, or (3) is primarily merely a surname; provided, however, that nothing in this subsection shall prevent the registration of a mark used in this state by the applicant which has become distinctive of the applicant's goods or services. The Secretary of State may accept as evidence that the mark has become distinctive, as ~~applied to~~ used on or in connection

with the applicant's goods or services, proof of continuous use thereof as a mark by the applicant in this state or elsewhere for the five (5) years next preceding the date of the filing of the application for registration before the date on which the claim of distinctiveness is made; or

(f) consists of or comprises a ~~trademark~~ mark which so resembles a ~~trademark~~ mark registered in this state or a ~~trademark~~ mark or trade name previously used in this state by another and not abandoned, as to be likely, when applied to used on or in connection with the goods or services of the applicant, to cause confusion or mistake or to deceive.

SECTION 3. AMENDATORY 78 O.S. 1991, Section 23, as last amended by Section 31, Chapter 69, O.S.L. 1996 (78 O.S. Supp. 2000, Section 23), is amended to read as follows:

Section 23. A. Subject to the limitations set forth in this title, any person who ~~adopts and~~ uses a ~~trademark~~ mark in this state may file in the Office of the Secretary of State, ~~on a form to be furnished by~~ in a manner complying with the requirements of the Secretary of State, an application for registration of that ~~trademark~~ mark setting forth, but not limited to, the following information:

1. The name and business address of the person applying for the registration, and, if a corporation, the state of incorporation, or if a partnership, the state in which the partnership is organized and the names of the general partners, as specified by the Secretary of State;

2. The goods or services on or in connection with which the mark is used and the mode or manner in which the mark is used on or in connection with the goods or services and the class in which the goods or services are categorized;

3. The date when the ~~trademark~~ mark was first used anywhere and the date when it was first used in this state by the applicant or ~~his~~ a predecessor in interest business; and

4. A statement that the applicant is the owner of the ~~trademark~~ mark, that the mark is in use, and that, to the knowledge of the person verifying the application, no other person has registered, either federally or in this state, or has the right to use such ~~trademark in this state~~ mark either in the identical form thereof or in such near resemblance thereto as ~~might be calculated to deceive or to be mistaken therefor~~ to be likely, when applied to the goods or services of such other person, to cause confusion, or to cause mistake, or to deceive.

B. The Secretary of State may also require a statement as to whether an application to register the mark, or portions or a composite thereof, has been filed by the applicant or a predecessor in interest in the United States Patent and Trademark Office; and, if so, the applicant shall provide full particulars with respect thereto, including the filing date and serial number of each application, the status thereof, and, if any application was finally refused registration or has otherwise not resulted in a registration, the reasons therefor.

C. The Secretary of State may also require that a drawing of the mark, complying with such requirements as the Secretary of State may specify, accompany the application.

D. The application shall be signed and verified (by oath, affirmation or declaration subject to perjury laws) by the applicant or by a member of the firm or an officer of the corporation or association applying.

~~C. E.~~ E. The application shall be accompanied by ~~a specimen or facsimile of such trademark~~ three specimens showing the mark as actually used.

~~D.~~ F. The application for registration shall be accompanied by a filing fee of Fifty Dollars (\$50.00), payable to the Secretary of State.

SECTION 4. NEW LAW A new section of law to be codified in the Oklahoma Statutes as Section 23.1 of Title 78, unless there is created a duplication in numbering, reads as follows:

A. Upon the filing of an application for registration and payment of the application fee, the Secretary of State shall cause the application to be examined for conformity with this act.

B. The applicant shall provide any additional pertinent information requested by the Secretary of State including a description of a design mark and may make, or authorize the Secretary of State to make, such amendments to the application as may be reasonably requested by the Secretary of State or deemed by the applicant to be advisable to respond to any rejection or objection.

C. The Secretary of State may require the applicant to disclaim an unregistrable component of a mark otherwise registrable, and an applicant may voluntarily disclaim a component of a mark sought to be registered. No disclaimer shall prejudice or affect the applicant's or registrant's rights then existing or thereafter arising in the disclaimed matter, or the applicant's or registrant's rights of registration on another application if the disclaimed matter be or shall have become distinctive of the applicant's or registrant's goods or services.

D. Amendments may be made by the Secretary of State upon the application submitted by the applicant upon the applicant's agreement, or a fresh application may be required to be submitted.

E. If the applicant is found not to be entitled to registration, the Secretary of State shall advise the applicant thereof and of the reasons therefor. The applicant shall have a reasonable period of time specified by the Secretary of State in

which to reply or to amend the application, in which event the application shall then be reexamined. This procedure may be repeated until:

1. The Secretary of State finally refuses registration of the mark; or

2. The applicant fails to reply or amend within the specified period, whereupon the application shall be deemed to have been abandoned.

F. If the Secretary of State finally refuses registration of the mark, the applicant may seek a writ of mandamus to compel the registration. The writ may be granted, but without costs to the Secretary of State, on proof that all the statements in the application are true and that the mark is otherwise entitled to registration.

G. In the instance of applications concurrently being processed by the Secretary of State seeking registration of the same or confusingly similar marks for the same or related goods or services, the Secretary of State shall grant priority to the applications in order of filing. If a prior-filed application is granted a registration, the other application or applications shall then be rejected. Any rejected applicant may bring an action for cancellation of the registration upon grounds of prior or superior rights to the mark, in accordance with the provisions of Section 28 of Title 78 of the Oklahoma Statutes.

SECTION 5. AMENDATORY 78 O.S. 1991, Section 24, as amended by Section 32, Chapter 69, O.S.L. 1996 (78 O.S. Supp. 2000, Section 24), is amended to read as follows:

Section 24. Upon compliance by the applicant with the requirements of this act, the Secretary of State shall cause a certificate of registration to be issued and delivered to the applicant. The certificate of registration shall be issued under the signature of the Secretary of State and the seal of the state,

and it shall show the name and business address and, if a corporation, the state of incorporation, or if a partnership, the state in which the partnership is organized and the name of the general partners, as specified by the Secretary of State, of the person claiming ownership of the mark, the date claimed for the first use of the mark anywhere and the date claimed for the first use of the mark in this state, the class of goods or services and a description of the goods or services on or in connection with which the ~~trademark~~ mark is used, ~~the trademark and its description a reproduction of the mark,~~ the registration date and the term of the registration.

Any certificate of registration issued by the Secretary of State under the provisions hereof or a copy thereof duly certified by the Secretary of State shall be admissible in evidence as competent and sufficient proof of the registration of such ~~trademark~~ mark in any action or judicial proceedings in any court of this state.

SECTION 6. AMENDATORY 78 O.S. 1991, Section 25, as amended by Section 6, Chapter 267, O.S.L. 1994 (78 O.S. Supp. 2000, Section 25), is amended to read as follows:

Section 25. A. Registration of a ~~trademark~~ mark pursuant to the provisions of this title shall be effective for an initial term of ~~ten (10)~~ five (5) years from the date of registration and, upon application filed within six (6) months prior to the expiration of such term, on a form to be furnished by the Secretary of State, the registration may be renewed ~~for successive periods of five (5) years~~ for a like term from the end of the expiring term. A renewal fee of Twenty-five Dollars (\$25.00), payable to the Secretary of State, shall accompany the application for renewal of the registration.

B. A ~~trademark~~ mark registration may be renewed for successive periods of five (5) years in the same manner as the initial renewal.

C. Any registration in force on the date on which this act shall become effective shall continue in full force and effect for

the unexpired term thereof and may be renewed by filing an application with the Secretary of State complying with the requirements of the Secretary of State and paying the aforementioned renewal fee therefor within six (6) months prior to the expiration of the registration.

D. All applications for renewal under this act, whether of registrations made under this act or of registrations effected under any prior act, shall include a verified statement that the mark has been and is still in use and include a specimen showing actual use of the mark on or in connection with goods or services.

SECTION 7. AMENDATORY 78 O.S. 1991, Section 26, as amended by Section 7, Chapter 267, O.S.L. 1994 (78 O.S. Supp. 2000, Section 26), is amended to read as follows:

Section 26. A. Any ~~trademark~~ mark and its registration shall be assignable with the good will of the business in which the ~~trademark~~ mark is used, or with that part of the good will of the business connected with the use of and symbolized by the ~~trademark~~ mark. Assignment shall be by instruments in writing duly executed and may be recorded with the Secretary of State upon the payment of a fee of Twenty-five Dollars (\$25.00), payable to the Secretary of State who, upon recording of the assignment, shall issue in the name of the assignee a new certificate for the remainder of the term of the registration or of the last renewal thereof. An assignment of any registration pursuant to the provisions of this title shall be void as against any subsequent purchaser for valuable consideration without notice unless it is recorded with the Secretary of State within three (3) months after the date of the assignment or prior to such subsequent purchase.

B. Any registrant or applicant effecting a change of the name of the person to whom the mark was issued or for whom an application was filed may record a certificate of change of name of the registrant or applicant with the Secretary of State upon the payment

of the recording fee. The Secretary of State may issue in the name of the assignee a certificate of registration of an assigned application. The Secretary may issue in the name of the assignee, a new certificate or registration for the remainder of the term of the registration or last renewal thereof.

C. Other instruments which relate to a mark registered or application pending pursuant to this act, such as, by way of example, licenses, security interests, or mortgages, may be recorded in the discretion of the Secretary of State, provided that such instrument is in writing and duly executed.

D. Acknowledgement shall be prima facie evidence of the execution of an assignment or other instrument and, when recorded by the Secretary of State, the record shall be prima facie evidence of execution.

E. A photocopy of any instrument referred to in subsections A, B or C of this section shall be accepted for recording if it is certified by any of the parties thereto, or their successors, to be a true and correct copy of the original.

SECTION 8. AMENDATORY 78 O.S. 1991, Section 28, as amended by Section 8, Chapter 267, O.S.L. 1994 (78 O.S. Supp. 2000, Section 28), is amended to read as follows:

Section 28. A. The Secretary of State shall cancel from the register:

~~1. After one (1) year from the effective date of this act, all registrations under prior acts which are more than ten (10) years old and not renewed in accordance with this act;~~

~~2.~~ Any registration concerning which the Secretary of State shall receive a voluntary request for cancellation thereof from the registrant or the assignee of record;

~~3.~~ 2. All registrations granted under this act and not renewed in accordance with the provisions hereof;

4. 3. Any registration concerning which a court of competent jurisdiction shall find:

- a. that the registered ~~trademark~~ mark has been abandoned,
- b. that the registrant is not the owner of the ~~trademark~~ mark,
- c. that the registration was granted improperly,
- d. that the registration was obtained fraudulently,
- e. that the mark is or has become the generic name for the goods or services, or a portion thereof, for which it has been registered, or
- f. that the registered mark is so similar, as to be likely to cause confusion or mistake or to deceive, to a mark registered by another person in the United States Patent and Trademark Office prior to the date of the filing of the application for registration by the registrant according to this act, and not abandoned; provided that, should the registrant prove that the registrant is the owner of a concurrent registration of a mark in the United States Patent and Trademark Office covering an area including this state, the registration shall not be canceled for such area of the state; and

5. 4. When a court of competent jurisdiction shall order cancellation of a registration on any ground.

B. At the time of filing a cancellation, a fee in the amount of Twenty-five Dollars (\$25.00) shall be paid to the Secretary of State.

SECTION 9. AMENDATORY 78 O.S. 1991, Section 29, as amended by Section 33, Chapter 69, O.S.L. 1996 (78 O.S. Supp. 2000, Section 29), is amended to read as follows:

Section 29. The following general classes of goods and services are established for convenience of administration of this act, but

not to limit or extend the applicant's or registrant's rights, and a single application for registration of a ~~trademark~~ mark may include any or all goods upon which or services with which the ~~trademark~~ mark is actually being used indicating the appropriate class or classes of goods or services. When a single application includes goods or services which fall within multiple classes, the Secretary of State shall require payment of a fee for each class.

The said classes are as follows:

(a) Goods:

1. Raw or partly prepared materials,
2. Receptacles,
3. Baggage, animal equipments, portfolios, and pocketbooks,
4. Abrasives and polishing materials,
5. Adhesives,
6. Chemicals and chemical compositions,
7. Cordage,
8. Smokers' articles, not including tobacco products,
9. Explosives, firearms, equipments, and projectiles,
10. Fertilizers,
11. Inks and inking materials,
12. Construction materials,
13. Hardware and plumbing and steamfitting supplies,
14. Metals and metal castings and forgings,
15. Oils and greases,
16. Paints and painters' materials,
17. Tobacco products,
18. Medicines and pharmaceutical preparations,
19. Vehicles,
20. Linoleum and oiled cloth,
21. Electrical apparatus, machines, and supplies,
22. Games, toys, and sporting goods,

23. Cutlery, machinery, and tools, and parts thereof,
24. Laundry appliances and machines,
25. Locks and safes,
26. Measuring and scientific appliances,
27. Horological instruments,
28. Jewelry and precious metalware,
29. Brooms, brushes, and dusters,
30. Crockery, earthenware, and porcelain,
31. Filters and refrigerators,
32. Furniture and upholstery,
33. Glassware,
34. Heating, lighting, and ventilating apparatus,
35. Belting, hose, machinery packing, and nonmetallic
tires,
36. Musical instruments and supplies,
37. Paper and stationery,
38. Prints and publications,
39. Clothing,
40. Fancy goods, furnishings, and notions,
41. Canes, parasols, and umbrellas,
42. Knitted, netted and textile fabrics, and substitutes
therefor,
43. Thread and yarn,
44. Dental, medical, and surgical appliances,
45. Soft drinks and carbonated waters,
46. Foods and ingredients of foods,
47. Merchandise not otherwise classified,
48. Cosmetics and toilet preparations, and
49. Detergents and soaps,

(b) Services:

100. Miscellaneous,
101. Advertising and business,

- 102. Insurance and financial,l
- 103. Construction and repair,l
- 104. Communication,l
- 105. Transportation and storage,l
- 106. Material treatment,l and
- 107. Education and entertainment.

SECTION 10. This act shall become effective November 1, 2001.

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