

MAINE STATE LEGISLATURE

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FIRST REGULAR SESSION

ONE HUNDRED AND NINTH LEGISLATURE

Legislative Document

No. 29

S. P. 43

Office of the Secretary of the Senate, January 9, 1979

Presented by Senator Collins of Knox

MAY M. ROSS Secretary of the Senate

STATE OF MAINE

IN THE YEAR OF OUR LORD NINETEEN HUNDRED
SEVENTY-NINE

AN ACT to Provide for the Registration and Protection of Trademarks.

Be it enacted by the People of the State of Maine, as follows:

Sec. 1. 10 MRSA c. 301-A is enacted to read:

CHAPTER 301-A

THE REGISTRATION AND PROTECTION OF TRADEMARKS

§ 1521. Definitions

As used in this chapter, unless the context otherwise indicates, the following terms shall have the following meanings.

1. Applicant. "Applicant" includes the person filing an application for registration of a mark under this chapter, his legal representatives, successors or assigns.

2. Mark. "Mark" includes any trademark or service mark entitled to registration under this chapter whether registered or not.

3. Person. "Person" means any individual, firm, partnership, corporation, association, union or other organization.

4. Registrant. "Registrant" includes the person to whom the registration of a trademark under this chapter is issued, his legal representatives, successors or assigns.

5. **Service mark.** "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.

6. **Trade name.** "Trade name" means a word, name, symbol, device or any combination thereof used by a person to identify his business, vocation or occupation and distinguish it from the business, vocation or occupation of others.

7. **Trademark.** "Trademark" means any word, name, symbol or device or any combination thereof adopted and used by a person to identify goods made or sold by him and to distinguish them from goods made or sold by others.

For the purposes of this chapter, a trademark shall be deemed to be used in this State 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 otherwise distributed in the State and on services when it is used or displayed in the sale or advertising of services and the services are rendered in this State.

§ 1522. Registration

1. **Registrability.** A 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;

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;

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;

D. Consists of or comprises the name, signature or portrait of any living individual, except with his written consent;

E. Consists of a mark which, when applied to the goods or services of the applicant, is merely descriptive or deceptively misdescriptive of them, or when applied to the goods or services of the applicant is primarily geographically descriptive or deceptively misdescriptive of them, or is primarily merely a surname provided, that nothing in this paragraph 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 the applicant's goods or services, proof of continuous use thereof as a mark by the applicant in this State or elsewhere for the 5 years next preceding the date of the filing of the application for registration; or

F. Consists of or comprises a mark which so resembles a mark registered in this State or a mark or trade name previously used in this State by another and not abandoned, as to be likely, when applied to the goods or services of the applicant, to cause confusion or mistake or to deceive.

2. Application for registration. Subject to the limitations set forth in this chapter, any person who adopts and uses a mark in this State may file in the office of the Secretary of State, on a form to be furnished by the Secretary of State, an application for registration of that mark setting forth, but not limited to, the following information:

A. The name and business address of the person applying for the registration and if a corporation, the state of incorporation;

B. The goods or services in connection with which the mark is used and the mode or manner in which the mark is used in connection with the goods or services and the class in which the goods or services fall;

C. The date when the mark was first used anywhere and the date when it was first used in this State by the applicant or his predecessor in business; and

D. A statement that the applicant is the owner of the mark and that no other person to the best of his knowledge and belief has the right to use the mark in this State either in the identical form thereof or in such near resemblance thereto as to be likely, when applied to the goods or services of the other person, to cause confusion or to cause mistake or to deceive.

The application shall be signed and verified by the applicant or by a member of the firm or an officer of the corporation or association applying.

The application shall be accompanied by a specimen or facsimile of the mark in triplicate.

The application for registration shall be accompanied by a filing fee of \$10, payable to the Treasurer of State.

§ 1523. Certificate of registration

Upon compliance by the applicant with the requirements of this chapter, 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 of the person claiming ownership of the mark, 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 which the mark is used, 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 this section or a copy duly certified by the Secretary of State shall be admissible in evidence as competent and sufficient proof of the registration of the mark in any action or judicial proceedings in any court of this State.

§ 1524. Duration and renewal

Registration of a mark shall be effective for a term of 10 years from the date of registration and, upon application filed within 6 months prior to the expiration of the term, on a form to be furnished by the Secretary of State, the registration may be renewed for a like term. A renewal fee of \$10, payable to the Treasurer of State, shall accompany the application for renewal of the registration.

A mark registration may be renewed for successive periods of 10 years in like manner.

The Secretary of State shall notify each registrant of a mark under this chapter of the necessity of renewal within the year next preceding the expiration of the 10 years from the date of registration, by writing to the last known address of the registrant.

Any registration in force on the date on which this chapter becomes effective shall expire 10 years from the date of the registration or one year after the effective date of this chapter, whichever is later, and may be renewed by filing an application with the Secretary of State on a form furnished by him and paying the renewal fee within 6 months prior to the expiration of the registration.

All applications for renewals under this chapter, whether of registrations made under this chapter or of registrations effected under any prior Act, shall include a statement that the mark is still in use in this State.

The Secretary of State shall, within 6 months after the effective date of this chapter, notify all registrants of marks under prior Acts of the date of expiration of the registrations, unless renewed in accordance with this chapter by writing to the last known address of each registrant.

§ 1525. Assignment

Any mark and its registration shall be assignable with the good will of the business in which the mark is used or with that part of the good will of the business connected with the use of and symbolized by the mark. Assignment shall be by an instrument in writing duly executed and may be recorded with the Secretary of State upon the payment of a fee of \$5 payable to the Treasurer of State. The Secretary of State, 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. An assignment of any registration under this chapter shall be void as against any subsequent purchaser for valuable consideration without notice, unless it is recorded with the Secretary of State within 3 months after the date thereof or prior to the subsequent purchase.

§ 1526. Records

The Secretary of State shall keep for public examination a record of all marks registered or renewed under this chapter.

§ 1527. Cancellation; classification

1. Cancellation required. The Secretary of State shall cancel from the register:

A. After one year from the effective date of this chapter, all registrations under prior Acts which are more than 10 years old and not renewed in accordance with this chapter;

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

C. All registrations granted under this chapter and not renewed in accordance with the chapter;

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

- (1) That the registered mark has been abandoned;
- (2) That the registrant is not the owner of the mark;
- (3) That the registration was granted improperly;
- (4) That the registration was obtained fraudulently; and

(5) 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 and not abandoned; provided, that should the registrant prove that he is the owner of a concurrent registration of his mark in the United States Patent and Trademark Office covering an area including this State, the registration shall not be cancelled; and

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

2. Classification. The following general classes of goods and services are established for convenience of administration of this chapter, but not to limit or extend the applicant's or registrant's rights and a single application for registration of a mark may include any or all goods upon which, or services with which, the mark is actually being used. If the goods or services fall in more than one class, an additional fee in the amount prescribed in section 1522, subsection 2, shall be paid for each additional class.

The classes are as follows:

A. Goods:

- (1) Chemical products used in industry, science, photography, agriculture, horticulture, forestry; artificial and synthetic resins; plastics in the form of

powders, liquids or pastes, for industrial use; natural and artificial manures; fire extinguishing compositions; tempering substances for preserving foodstuffs; tanning substances and adhesive substances used in industry;

(2) Paints, varnishes, lacquers; preservatives against rust and against deterioration of wood; coloring matters, dyestuffs; mordants; natural resins and metals in foil and powder form for painters and decorators;

(3) Bleaching preparations and other substances for laundry use; cleaning, polishing, scouring and abrasive preparations; soaps; perfumery, essential oils, cosmetics, hair lotions and dentifrices;

(4) Industrial oils and greases, other than oils and fats and essential oils; lubricants; dust laying and absorbing compositions; fuels, including motor spirit and illuminants and candles, tapers, night lights and wicks;

(5) Pharmaceutical, veterinary and sanitary substances; infants' and invalids' foods; plasters, material for bandaging; material for stopping teeth, dental wax, disinfectants and preparations for killing weeds and destroying vermin;

(6) Unwrought and partly wrought common metals and their alloys; anchors, anvils, bells, rolled and cast building materials; rails and other metallic materials for railway tracks; chains, except driving chains for vehicles; nonelectric cables and wires; locksmiths' work; metallic pipes and tubes; safes and cash boxes; steel balls; horseshoes; nails and screws; other goods in nonprecious metal not included in other classes and ores;

(7) Machines and machine tools; motors, except for land vehicles; machine couplings and belting, except for land vehicles; large size agricultural implements and incubators;

(8) Hand tools and instruments; cutlery, forks and spoons and side arms;

(9) Scientific, nautical, surveying and electrical apparatus and instruments, including wireless apparatus and instruments, photographic, cinematographic, optical, weighing, measuring, signaling, checking, supervision, lifesaving and teaching apparatus and instruments; coin or counterfreed apparatus; talking machines, cash registers; calculating machines and fire extinguishing apparatus;

(10) Surgical, medical, dental and veterinary instruments and apparatus, including artificial limbs, eyes and teeth;

(11) Installations for lighting, heating, steam generating, cooking, refrigerating, drying, ventilating, water supply and sanitary purposes;

(12) Vehicles and apparatus for locomotion by land, air or water;

(13) Firearms; ammunition and projectiles; explosive substances and fireworks;

- (14) Precious metals and their alloys and goods in precious metals or coated therewith, except cutlery, forks and spoons and jewelry, precious stones, horological and other chronometric instruments;
- (15) Musical instruments, other than talking machines and wireless apparatus;
- (16) Paper, cardboard, articles of paper or of cardboard, not included in other classes; printed matter, newspapers and periodicals, books; book-binding material; photographs; stationery, adhesive stationery materials; artists' materials; paint brushes; typewriters and office requisites, other than furniture; instructional and teaching material, other than apparatus; playing cards; printers' type and stereotype cliches;
- (17) Gutta percha, india rubber, balata and substitutes, articles made from these substances and not included in other classes; plastics in the form of sheets, blocks and rods, being for use in manufacture; materials for packing, stopping or insulating; asbestos, mica and their products and nonmetallic hose pipes;
- (18) Leather and imitations of leather, and articles made from these materials and not included in other classes; skins, hides; trunks and traveling bags, umbrellas, parasols and walking sticks and whips, harness and saddlery;
- (19) Building materials, natural and artificial stone, cement, lime, mortar, plaster and gravel; pipes of earthenware of cement; road-making materials; asphalt, pitch and bitumen; portable buildings; stone monuments and chimney pots;
- (20) Furniture, mirrors, picture frames and articles, not included in other classes, of wood, cork, reeds, cane, wicker, horn, bone, ivory, whalebone, shell, amber, mother-of-pearl, meerschaum, celluloid, substitutes for all these materials or of plastics;
- (21) Small domestic utensils and containers, not of precious metals, or coated therewith; combs and sponges; brushes, other than paint brushes; brushmaking materials; instruments and material for cleaning purposes, steel wool; unworked or semiworked glass, excluding glass used in building and glassware, porcelain and earthenware, not included in other classes;
- (22) Ropes, string, nets, tents, awnings, tarpaulins, sails, sacks; padding and stuffing materials, such as hair, kapok, feathers, seaweed and raw fibrous textile materials;
- (23) Yarns and threads;
- (24) Tissue piece goods; bed and table covers and textile articles not included in other classes;
- (25) Clothing, including boots, shoes and slippers;

(26) Lace and embroidery, ribands and braid; buttons, press buttons, hooks and eyes, pins and needles and artificial flowers;

(27) Carpets, rugs, mats and matting; linoleums and other materials for covering existing floors and nontextile wall hangings;

(28) Games and playthings; gymnastic and sporting articles, except clothing and ornaments and decorations for Christmas trees;

(29) Meats, fish, poultry and game; meat extracts; preserved, dried and cooked fruits and vegetables; jellies, jams; eggs, milk and other dairy products; edible oils and fats; preserves and pickles;

(30) Coffee, tea, cocoa, sugar, rice, tapioca, sago, coffee substitutes; flour, and preparations made from cereals; bread, biscuits, cakes, pastry and confectionery, ices; honey, treacle; yeast, baking powder; salt, mustard, pepper, vinegar, sauces, spices and ice;

(31) Agricultural, horticultural and forestry products and grains not included in other classes; living animals; fresh fruits and vegetables; seeds; live plants and flowers; foodstuffs for animals and malt;

(32) Beer, ale and porter; mineral and aerated waters and other nonalcoholic drinks and syrups and other preparations for making beverages;

(33) Wines, spirits and liqueurs; and

(34) Tobacco, raw or manufactured; smokers' articles and matches; and

B. Services:

(1) Advertising and business;

(2) Insurance and financial;

(3) Construction and repair;

(4) Communication;

(5) Transportation and storage;

(6) Material treatment;

(7) Education and entertainment; and

(8) Miscellaneous.

§ 1528. Fraudulent registration

Any person who shall for himself, or on behalf of any other person, procure the filing or registration of any mark in the office of the Secretary of State under this section, by knowingly making any false or fraudulent representation or declaration, verbally or in writing, or by any other fraudulent means, shall be liable to pay all damages sustained in consequence of the filing or registration, to be recovered by or on behalf of the party injured in any court of competent jurisdiction.

§ 1529. Infringement

Subject to section 1532, any person who shall:

1. Use without consent of copy of a registered mark in connection with sale of goods or services. Use, without the consent of the registrant, any reproduction, counterfeit, copy or colorable imitation of a mark registered under this chapter in connection with the sale, offering for sale or advertising of any goods or services on or in connection with which use is likely to cause confusion or mistake to deceive as to the source of origin of the goods or services; or

2. Reproduce and apply a mark in conjunction with sale of goods or services. Reproduce, counterfeit, copy or colorably imitate any mark and apply the reproduction, counterfeit, copy or colorable imitation to labels, signs, prints, packages, wrappers, receptacles or advertisements intended to be used upon or in conjunction with the sale or other distribution in this State of the goods or services;

shall be liable to a civil action by the owner of the registered mark for any or all of the remedies provided in section 1531, except that under subsection 2 the registrant shall not be entitled to recover profits or damages unless the acts have been committed with knowledge that the mark is intended to be used to cause confusion or mistake or to deceive.

§ 1530. Injury to business reputation; dilution

Likelihood of injury to business reputation or of dilution of the distinctive quality of a mark registered under this chapter, or a mark valid at common law, or a trade name valid at common law, shall be a ground for injunctive relief notwithstanding the absence of competition between the parties or the absence of confusion as to the source of goods or services.

§ 1531. Remedies

Any owner of a mark registered under this chapter may proceed by suit to enjoin the manufacture, use, display or sale of any counterfeits or imitations and the Superior Court may grant injunctions to restrain the manufacture, use, display or sale as may be by the court deemed just and reasonable and may require the defendants to pay to the owner all profits derived from all damages suffered by reason of the wrongful manufacture, use, display or sale and the court may also order that any counterfeits or imitations in the possession or under the control of any defendant in the case, be delivered to an officer of the court or to the complainant to be destroyed.

The owner of the mark may elect, at any time before final judgment is rendered, to recover instead of actual damages or profits an award of statutory damages with respect to any one mark for which any one defendant is liable individually or for which any 2 or more defendants are liable jointly and severally in the amount of \$2,000.

In the event that, prior to the action being commenced, the owner has given the defendant written notice of his ownership and registration of the mark and the defendant, after receipt of the notice, continues the manufacture, use, display or sale of the challenged mark, the Superior Court shall award to the prevailing owner his costs and reasonable attorneys' fees incurred or expended in the action.

The enumeration of any right or remedy shall not affect a registrant's right to prosecute under any penal law of this State.

§ 1532. Common law rights

Nothing in this chapter shall adversely affect the rights or the enforcement of rights in marks acquired in good faith at common law at any time before or after the enactment of this chapter.

Sec. 2. 10 MRSA c. 301, as amended, is repealed.

Sec. 3. 10 MRSA c. 303, as amended, is repealed.

Sec. 4. 10 MRSA c. 311 is repealed.

Sec. 5. 10 MRSA c. 313, as amended, is repealed.

Sec. 6. 26 MRSA c. 17, as amended, is repealed.

Sec. 7. Effective date. This Act shall become effective 90 days after adjournment of the Legislature, provided, that registrations under prior Acts shall be entitled to all the rights, privileges and remedies provided by the Acts until such time as the registrations expire, are canceled or are renewed under the provisions of this Act and the repeal shall be without prejudice to any judicial or administrative proceeding pending at the time of the repeal which shall proceed to final determination pursuant to and in accordance with the Act under which it was commenced.

STATEMENT OF FACT

The purpose of this bill is to provide for the registration and protection of trademarks.