

GENERAL ASSEMBLY OF NORTH CAROLINA
1991 SESSION

CHAPTER 626
HOUSE BILL 450

AN ACT TO UPDATE AND CLARIFY THE TRADEMARK REGISTRATION ACT.

The General Assembly of North Carolina enacts:

Section 1. G.S. 80-1 reads as rewritten:

"§ 80-1. Definitions.

(a) The term 'applicant' as used herein ~~embraces~~ means the person filing an application for registration of a trademark under this Article, his legal representatives, successors or assigns.

(b) The term 'mark' as used herein includes any trademark or service mark entitled to registration under this Article whether registered or not.

(c) The term 'person' as used herein means any individual, firm, partnership, corporation, association, union or other organization.

(d) The term 'registrant' as used herein ~~embraces~~ means the person to whom the registration of a trademark under this Article is issued, his legal representatives, successors or assigns.

(e) The term 'service mark' as used herein 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.

(f) The term 'trademark' as used herein means any word, name, symbol, or device or any combination thereof adopted and used by a person to identify goods ~~made or sold~~ made, sold, or distributed by him and to distinguish them from goods ~~made or sold~~ made, sold, or distributed by others.

(g) The term 'use' means the bona fide use of a mark in the State of North Carolina in the ordinary course of trade, and not merely the reservation of a right to a mark. For the purposes of this Article, a mark shall be deemed to be 'used' in this State
(i) 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~~ thereto, or if the nature of the goods makes such placement impractical, then on documents associated with the goods, and such goods are currently sold or otherwise distributed in the State, and (ii) on services when it is used or displayed in the sale or advertising of services and the services are currently being rendered in this State, State, or are being offered and are available to be rendered in this State."

Sec. 2. G.S. 80-2 reads as rewritten:

"§ 80-2. 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

- (1) Consists of or comprises immoral, deceptive or scandalous matter; or
- (2) 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
- (3) 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
- (4) Consists of or comprises the name, signature or portrait of any living individual, except with his written consent; or
- (5) Consists of a mark which (i) when applied to the goods or services of the applicant, is merely descriptive of them or merely describes one or more of the characteristics, or is deceptively misdescriptive of them, or falsely describes the nature, function, capacity, or characteristics of them, or (ii) when applied to the goods or services of the applicant, is primarily geographically descriptive or deceptively misdescriptive of them, or (iii) is primarily merely a surname; provided, however, that nothing in this subdivision (5) 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 five years preceding the date of the filing of the application for registration; or
- (6) 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."

Sec. 3. G.S. 80-3 reads as rewritten:

"§ 80-3. Application for registration.

Subject to the limitations set forth in this Article, any person who uses a mark, or any person who controls the nature and quality of the goods or services in connection with which a mark is used by another, in this State may file in the office of the Secretary of State ~~on a form to be furnished in a format to be prescribed~~ by the Secretary of State, an application for registration of that mark setting forth, but not limited to, the following information:

- (1) The name and business address of the person applying for such registration; and, if a corporation, the state of ~~incorporation;~~ incorporation. If the application for registration relates to a mark used in connection with goods, the applicant shall list either the address of the applicant's principal place of business in North Carolina or a place of distribution and usage of such goods in this State. If the application for registration relates to a mark used in connection with services, the

applicant shall list a physical location at which the services are being rendered or offered in this State;

- (2) 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 such goods or services and the class in which such goods or services fall;
- (3) The date when the mark was first used anywhere and the date when it was first used in this State by the applicant, his predecessor in business or by another under such control of applicant; and
- (4) A statement that the applicant is the owner of the mark and that to the best of his knowledge no other person except as identified by applicant has the right to use such mark in this State 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 to cause confusion, or to cause mistake, or to deceive.

The application shall be signed and verified by the ~~applicant or applicant, by a partner,~~ by a member of the ~~firm~~ firm, or an officer of the corporation or association ~~applying.~~ applying for registration. In states in which a notary is not required by law to obtain a notary's stamp or seal, an original certificate of authority of the notary issued by the appropriate State agency shall be submitted with the application. If the application is signed by a person acting pursuant to a power of attorney from the applicant, an original power of attorney or a certified copy of the power of attorney shall accompany the application.

The application shall be accompanied by ~~a specimen or facsimile of such mark in triplicate.~~ three specimens of the mark as currently used, and proof of use or distribution in this State.

The application for registration shall be accompanied by a filing fee of ~~twenty-five dollars (\$25.00),~~ fifty dollars (\$50.00), payable to the Secretary of State."

Sec. 4. G.S. 80-4 reads as rewritten:

"§ 80-4. Certificate of registration.

Upon compliance by the applicant with the requirements of this Article, 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 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 which the mark is used, a reproduction of the mark, the registration ~~date~~ date, the registration number 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 mark in any action or judicial proceedings in any court of this State."

Sec. 5. G.S. 80-5 reads as rewritten:

"§ 80-5. Duration and renewal.

Registration of a mark hereunder shall be effective for a term of 10 years from the date of registration and shall be renewable for successive terms of 10 years upon application filed within six months prior to the expiration of any term. A renewal fee of ~~ten dollars (\$10.00), thirty-five dollars (\$35.00),~~ payable to the Secretary of State, shall accompany the application for renewal of the registration. Within six months following the expiration of a term of five years from the date of registration, or the last renewal of registration of the mark, the applicant shall submit a specimen showing evidence of current use of the mark and a signed statement verifying the use of such mark on a form to be furnished by the Secretary of State. Use of the form furnished by the Secretary of State is mandatory. Failure to submit this verification and specimen showing evidence of current use shall be grounds for cancellation of the registration of the mark by the Secretary of State.

The Secretary of State shall notify registrants of marks hereunder 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 registrants.

The Secretary of State shall notify registrants of marks hereunder of the necessity of submitting evidence of current use of the mark after five years from the date of registration or of the last renewal of registration of the mark, by writing to the last known address of the registrants within the year preceding the due date for such submission.

Registration of marks obtained under previous acts shall be continued in force for the full 10-year term which is in effect October 1, 1991, without the necessity of submitting evidence of current use of the mark during such term.

~~Any registration in force on January 1, 1968, shall expire 10 years from the date of the registration or of the last renewal thereof hereunder or two years after January 1, 1968, whichever is later, and may be renewed by filing an application with the Secretary of State and paying the aforementioned renewal fee therefor within six months prior to the expiration of the registration. Until so expired, such registration shall be subject to and shall be entitled to the benefits of the provisions of this Article.~~

All applications for renewals under this Article, whether of registrations made under this Article or of registrations affected under any prior act, shall be filed with the Secretary of State ~~on a form to be furnished by him in a format prescribed by the Secretary of State~~ specifying the information called for by G.S. 80-3 and shall include a statement that the mark is still in use in this ~~State.~~ State, setting forth those goods or services recited in the registration in connection with which the mark is still in use. The registration shall be renewed only as to such goods and services.

~~The Secretary of State shall notify each registrant of marks under previous acts of the date of expiration of such registrations unless renewed in accordance with the provisions of this Article, by writing to the last known address of the registrants at least six months prior to the date of expiration thereof under the provisions of this Article."~~

Sec. 6. G.S. 80-6 reads as rewritten:

"§ 80-6. Assignment.

Any mark and its registration hereunder shall be assignable with the goodwill of the business in which the mark is used, or with that part of the goodwill of the business

connected with the use of and symbolized by the 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 ~~ten dollars (\$10.00)~~ 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 under this Article shall be void as against any subsequent purchaser for valuable consideration without notice, unless it is recorded with the Secretary of State within three months after the date thereof or prior to such subsequent purchase."

Sec. 7. G.S. 80-7 reads as rewritten:

"§ 80-7. Records.

The Secretary of State shall keep for public examination all assignments recorded under G.S. 80-6 and a record of all marks registered or renewed under this Article. The Secretary of State shall collect the following fees for copying, comparing, and certifying a copy of any filed document relating to a trademark or service mark:

- (1) Five dollars (\$5.00) for the certificate, and
- (2) One dollar (\$1.00) per page for copying or comparing a copy to the original.

The Secretary of State shall collect a recording fee of ten dollars (\$10.00) for recording name changes of corporate registrants and for recording transfers of the registration of any mark by merger or consolidation if the articles of merger or consolidation are records not on file in the Corporate Division of the Department of the Secretary of State."

Sec. 8. G.S. 80-8 reads as rewritten:

"§ 80-8. Cancellation.

The Secretary of State shall cancel from the register:

- (1) ~~After two years from January 1, 1968, all registrations under prior acts which are more than 10 years old and not renewed in accordance with this Article;~~
- (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) All registrations granted under this Article and not renewed in accordance with the provisions hereof;
- (4) Any registration concerning which a court of competent jurisdiction shall find
 - a. That the registered mark has been abandoned or has become incapable of serving as a mark;
 - b. That the registrant is not the owner of the mark;
 - c. That the registration was granted improperly;
 - d. That the registration was obtained ~~fraudulently.~~ fraudulently;
- (5) Any registration when a court of competent jurisdiction shall order cancellation ~~thereof.~~ thereof;

- (6) Any registration for which compliance with the five-year evidence of use requirement of G.S. 80-5 has not been effected; or
- (7) Any registration which was obtained by means of false statements in the application for registration."

Sec. 9. G.S. 80-9 reads as rewritten:

"§ 80-9. Classification.

The following general classes of goods and services are established for convenience of administration of this Article, 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 for which, the mark is actually being used comprised in a single class, but in no event shall a single application include goods or services upon or for which the mark is being used which fall within different classes of goods or services. The Secretary of State shall have the right to amend the classes herein established to conform the same to the classification established for the United States Patent Office as from time to time amended.

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 steam-fitting supplies.
 - 14. Metals and metal castings and forgings.
 - 15. Oils and greases.
 - 16. Protective and decorative coatings.
 - 17. Tobacco products.
 - 18. Medicines and pharmaceutical preparations.
 - 19. Vehicles.
 - 20. Linoleum and oiled cloth.
 - 21. Electrical apparatus, machines, computer hardware, video tapes, 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.~~ appliances and computer software.
27. Horological instruments.
28. Jewelry and precious-metal ware.
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. Wines.
48. Malt beverages and liquors.
49. Distilled alcoholic liquors.
50. Merchandise not otherwise classified.
51. Cosmetics and toilet preparations.
52. Detergents and soaps.

(b) Services. –

100. Miscellaneous.
101. Advertising and business.
102. Insurance and financial.
103. Construction and repair.
104. Communications.
105. Transportation and storage.
106. Material treatment.
107. Education and entertainment."

Sec. 10. This act becomes effective October 1, 1991.

In the General Assembly read three times and ratified this the 10th day of July, 1991.

James C. Gardner
President of the Senate

Daniel Blue, Jr.
Speaker of the House of Representatives