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SENATE BILL 5122

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State of Washington                      58th Legislature                      2003 Regular Session

By Senators Johnson, Kline and Esser

Read first time 01/15/2003. Referred to Committee on Judiciary.

1            AN ACT Relating to trademark registration; amending RCW 19.77.010,  
2 19.77.020, 19.77.050, 19.77.140, 19.77.150, and 19.77.160; adding a new  
3 section to chapter 19.77 RCW; and repealing RCW 19.77.110.

4 BE IT ENACTED BY THE LEGISLATURE OF THE STATE OF WASHINGTON:

5            **Sec. 1.** RCW 19.77.010 and 1994 c 60 s 6 are each amended to read  
6 as follows:

7            ((As used in)) The definitions in this section apply throughout  
8 this chapter((+)) unless the context clearly requires otherwise.

9            (1) "Alien" when used with reference to a person means a person who  
10 is not a citizen of the United States((+)).

11            (2) "Applicant" means the person filing an application for  
12 registration of a trademark under this chapter, his or her legal  
13 representatives, predecessors, successors, or assigns of record with  
14 the secretary of state((+)).

15            (3) "Domestic" when used with reference to a person means a person  
16 who is a citizen of the United States((+)).

17            (4) The term "colorable imitation" includes any mark which so  
18 resembles a registered mark as to be likely to cause confusion or  
19 mistake or to deceive((+)).

1 (5) A "counterfeit" is a spurious mark which is identical with, or  
2 substantially indistinguishable from, a registered mark((+)).

3 (6) "Dilution" means the ~~((material reduction of the distinctive  
4 quality of a famous mark))~~ lessening of the capacity of a famous mark  
5 to identify and distinguish goods or services through use of a mark by  
6 another person, regardless of the presence or absence of (a)  
7 competition between the ~~((users of the mark))~~ owner of the famous mark  
8 and other parties, or (b) likelihood of confusion, mistake, or  
9 deception arising from that use((+)).

10 (7) "Person" means any individual, firm, partnership, corporation,  
11 association, union, or other organization((+)) capable of suing and  
12 being sued in a court of law.

13 (8) "Registered mark" means a trademark registered under this  
14 chapter((+)).

15 (9) "Registrant" means the person to whom the registration of a  
16 trademark under this chapter is issued, his or her legal  
17 representatives, successors, or assigns of record with the secretary of  
18 state((+)).

19 (10) "Trademark" or "mark" means any word, name, symbol, or device  
20 or any combination thereof adopted and used by a person to identify  
21 goods made or sold by him or her and to distinguish them from goods  
22 made or sold by others, and any word, name, symbol, or device, or any  
23 combination thereof, and any title, designation, slogan, character  
24 name, and distinctive feature of radio or television programs, used by  
25 a person in the sale or advertising of services to identify the  
26 services ~~((of one person and))~~ provided by him or her and to  
27 distinguish them from the services of others((+)).

28 (11) A trademark shall be deemed to be "used" in this state when it  
29 is placed in the ordinary course of trade and not merely to reserve a  
30 right in a mark in any manner on the goods or their containers, or on  
31 tabs or labels affixed thereto, or displayed in connection with such  
32 goods, and such goods are sold or otherwise distributed in this state,  
33 or when it is used or displayed in the sale or advertising of services  
34 rendered in this state((+)).

35 (12) "Trade name" ~~((shall have the same definition as under RCW~~  
36 ~~19.80.005(1)+))~~ means any name used by a person to identify a business  
37 or vocation of such a person.

38 (13) A mark shall be deemed to be "abandoned":

1 (a) When its use has been discontinued with intent not to resume  
2 such use. Intent not to resume may be inferred from circumstances.  
3 Nonuse for ~~((two))~~ three consecutive years shall be prima facie  
4 evidence of abandonment; or

5 (b) When any course of conduct of the registrant, including acts of  
6 omission as well as commission, causes the mark to become the generic  
7 name for the goods or services or causes the mark to lose its  
8 significance as an indication of source or origin. Purchaser  
9 motivation shall not be a test for determining abandonment under this  
10 subsection.

11 **Sec. 2.** RCW 19.77.020 and 1989 c 72 s 2 are each amended to read  
12 as follows:

13 (1) A trademark by which the goods or services of any applicant for  
14 registration may be distinguished from the goods or services of others  
15 shall not be registered if it:

16 ~~((1))~~ (a) Consists of or comprises immoral, deceptive, or  
17 scandalous matter; or

18 ~~((2))~~ (b) Consists of or comprises matter which may disparage or  
19 falsely suggest a connection with persons, living or dead,  
20 institutions, beliefs, or national symbols, or bring them into contempt  
21 or disrepute; or

22 ~~((3))~~ (c) Consists of or comprises the flag or coat of arms or  
23 other insignia of the United States, or of any state or municipality,  
24 or of any foreign nation, or any simulation thereof; or

25 ~~((4))~~ (d) Consists of or comprises the name, portrait, or  
26 signature identifying a particular living individual who has not  
27 consented in writing to its registration; or

28 ~~((5) Consists of a mark which,~~  
29 ~~(a) when applied to the goods or services of the applicant is~~  
30 ~~merely descriptive or deceptively misdescriptive of them, or~~

31 ~~(b) when applied to the goods or services of the applicant is~~  
32 ~~primarily geographically descriptive or deceptively misdescriptive of~~  
33 ~~them, or~~

34 ~~(c) is primarily merely a surname: PROVIDED, That nothing in this~~  
35 ~~subsection shall prevent the registration of a trademark used in this~~  
36 ~~state by the applicant which has become distinctive of the applicant's~~  
37 ~~goods or services. The secretary of state may accept as prima facie~~

1 ~~evidence that the trademark has become distinctive, as used on or in~~  
2 ~~connection with the applicant's goods or services, proof of~~  
3 ~~substantially exclusive and continuous use thereof as a trademark by~~  
4 ~~the applicant in this state or elsewhere in the United States for the~~  
5 ~~five years next preceding the date of the filing of the application for~~  
6 ~~registration; or~~

7 (6)) (e) Consists of or comprises a trademark which so resembles  
8 a trademark registered in this state, or a trademark or trade name used  
9 in this state by another prior to the date of the applicant's or  
10 applicant's predecessor's first use in this state and not abandoned, as  
11 to be likely, when applied to the goods or services of the applicant,  
12 to cause confusion or mistake or to deceive.

13 (2) Registration under this title does not constitute prima facie  
14 evidence that a mark is not merely descriptive, deceptively  
15 misdescriptive, or geographically descriptive or deceptively  
16 misdescriptive of the goods or services with which it is used, or is  
17 not primarily merely a surname, unless the applicant has made  
18 substantially exclusive and continuous use thereof as a trademark in  
19 this state or elsewhere in the United States for the five years next  
20 preceding the date of the filing of the application for registration.

21 (3) A trade name is not registrable under this chapter. However,  
22 if a trade name also functions as a trademark, it is registrable as a  
23 trademark.

24 (4) The secretary of state shall make a determination of  
25 registerability by considering the application record and the marks  
26 previously registered and subsisting under this chapter.

27 **Sec. 3.** RCW 19.77.050 and 1994 c 60 s 3 are each amended to read  
28 as follows:

29 Registration of a trademark hereunder shall be effective for a term  
30 of ((~~six~~)) five years from the date of registration. Upon application  
31 filed within six months prior to the expiration of such term, on a form  
32 to be furnished by the secretary of state requiring all the allegations  
33 of an application for original registration, the registration may be  
34 renewed for successive terms of ((~~six~~)) five years as to the goods or  
35 services for which the trademark is still in use in this state. A  
36 renewal fee as set by rule by the secretary of state, payable to the

1 secretary of state, shall accompany each application for renewal of the  
2 registration.

3 The secretary of state shall notify registrants of trademarks  
4 hereunder or their agents for service of record with the secretary of  
5 state of the necessity of renewal within the year, but not less than  
6 six months, next preceding the expiration of the unexpired original or  
7 renewed term by writing to the last known address of the registrants or  
8 their agents according to the files of the secretary of state. Neither  
9 the secretary of state's failure to notify a registrant nor the  
10 registrant's nonreceipt of a notice under this section shall extend the  
11 term of a registration or excuse the registrant's failure to renew a  
12 registration.

13 NEW SECTION. **Sec. 4.** A new section is added to chapter 19.77 RCW  
14 to read as follows:

15 The secretary of state must adopt by rule a classification of goods  
16 and services for convenience of administration of this chapter, but not  
17 to limit or extend the applicant's or registrant's rights, and a single  
18 application for registration of a mark may include any or all goods  
19 upon which, or services with which, the mark is actually being used  
20 indicating the appropriate class or classes of goods or services. When  
21 a single application includes goods or services that fall within  
22 multiple classes, the secretary of state may require payment of a fee  
23 for each class. To the extent practical, the classification of goods  
24 and services should conform to the classification adopted by the United  
25 States patent and trademark office.

26 **Sec. 5.** RCW 19.77.140 and 1989 c 72 s 9 are each amended to read  
27 as follows:

28 (1) Subject to the provisions of RCW 19.77.900 any person who  
29 shall:

30 (a) Use, without the consent of the registrant, any reproduction,  
31 counterfeit, copy, or colorable imitation of a trademark registered  
32 under this chapter in connection with the sale, offering for sale, or  
33 advertising of any goods or services on or in connection with which  
34 such use is likely to cause confusion or mistake or to deceive as to  
35 the source or origin of such goods or services; or

1 (b) Reproduce, counterfeit, copy or colorably imitate any such  
2 trademark and apply such reproduction, counterfeit, copy or colorable  
3 imitation to labels, signs, prints, packages, wrappers, receptacles, or  
4 advertisements intended to be used upon or in connection with the sale  
5 or other distribution of goods or services in this state on or in  
6 connection with which such use is likely to cause confusion, or to  
7 cause mistake, or to deceive as to the source or origin of such goods  
8 or services

9 shall be liable to a civil action by the registrant for any or all of  
10 the remedies provided in RCW 19.77.150, except that under (b) of this  
11 subsection the registrant shall not be entitled to recover profits or  
12 damages unless the acts have been committed with (~~knowledge that such~~  
13 ~~imitation is intended to be used~~) the intent to cause confusion or  
14 mistake((~~τ~~)) or to deceive.

15 (2) In determining whether, under this chapter, there is a  
16 likelihood of confusion, mistake, or deception between marks when used  
17 in association with goods or services, the court shall consider all  
18 relevant factors, including, but not limited to the following:

19 (a) The similarity or dissimilarity of the marks in their  
20 entireties to appearance, sound, meaning, connotation, and commercial  
21 impression;

22 (b) The similarity or dissimilarity of the goods or services and  
23 nature of the goods and services;

24 (c) The similarity or dissimilarity of trade channels;

25 (d) The conditions under which sales are made and buyers to whom  
26 sales are made;

27 (e) The fame of the marks;

28 (f) The number and nature of similar marks in use on similar goods  
29 or services;

30 (g) The nature and extent of any actual confusion;

31 (h) The length of time during and conditions under which there has  
32 been concurrent use without evidence of actual confusion;

33 (i) The variety of goods or services on which each of the marks is  
34 or is not used;

35 (j) The nature and extent of potential confusion, i.e., whether de  
36 minimis or substantial;

37 (k) Any other established fact probative of the effect of use.

1       **Sec. 6.** RCW 19.77.150 and 1989 c 72 s 11 are each amended to read  
2 as follows:

3       Any registrant may proceed by suit to enjoin the manufacture, use,  
4 display, or sale of any counterfeits or colorable imitations of a  
5 trademark registered under this chapter, and any court of competent  
6 jurisdiction may grant an injunction to restrain such manufacture, use,  
7 display, or sale as may be by the said court deemed just and  
8 reasonable, and may require the defendants to pay to such registrant  
9 all profits derived from and/or all damages suffered by reason of such  
10 wrongful manufacture, use, display, or sale; and such court may also  
11 order that any such counterfeits or colorable imitations in the  
12 possession or under the control of any defendant in such case be  
13 delivered to an officer of the court, or to the registrant, to be  
14 destroyed.   (~~In exceptional cases the court may award to the~~  
15 ~~prevailing party the costs of the suit including reasonable attorneys'~~  
16 ~~fees.))   The court, in its discretion, may enter judgment awarding  
17 reasonable attorneys' fees and/or an amount not to exceed three times  
18 such profits and damages in such cases where the court finds the other  
19 party committed the wrongful acts in bad faith or otherwise as  
20 according to the circumstances of the case.~~

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

23       **Sec. 7.** RCW 19.77.160 and 1989 c 72 s 10 are each amended to read  
24 as follows:

25       (1) The owner of a ((famous)) mark that is famous in this state  
26 shall be entitled, subject to the principles of equity and upon such  
27 terms as the court deems reasonable, to an injunction against another  
28 person's commercial use in this state of a mark, commencing after the  
29 mark becomes famous, which causes dilution of the distinctive quality  
30 of the mark, and to obtain such other relief as is provided in this  
31 section. In determining whether a mark is famous and has distinctive  
32 quality, a court shall consider all relevant factors, including, but  
33 not limited to the following:

34       (~~(1) Whether the mark is inherently distinctive or has become~~  
35 ~~distinctive through substantially exclusive and continuous use)) (a)  
36 The degree or inherent or acquired distinctiveness of the mark in this  
37 state;~~

1       ~~((2) Whether))~~ (b) The duration and extent of use of the mark  
2 ~~((are substantial))~~ in connection with the goods or services with which  
3 the mark is used;

4       ~~((3) Whether))~~ (c) The duration and extent of advertising and  
5 publicity of the mark ((are substantial)) in this state;

6       ~~((4) Whether))~~ (d) The geographical extent of the trading area in  
7 which the mark is used ((is substantial));

8       ~~((5) Whether the mark has substantial renown in its and in the~~  
9 ~~other person's trading areas and channels of trade; and~~

10       ~~(6) Whether substantial use of the same or similar marks is being~~  
11 ~~made by third parties))~~ (e) The channels of trade for the goods or  
12 services with which the mark is used;

13       (f) The degree of recognition of the mark in the trading areas and  
14 channels of trade in this state used by the mark's owner and the person  
15 against whom the injunction is sought;

16       (g) The nature and extent of use of the same or similar marks by  
17 third parties; and

18       (h) Whether the mark is the subject of state registration in this  
19 state or United States registration.

20       (2) The owner shall be entitled only to injunctive relief in an  
21 action brought under this section, unless the subsequent user willfully  
22 intended to trade on the ((registrant's)) owner's reputation or to  
23 cause dilution of the owner's mark. If such willful intent is proven,  
24 the owner shall also be entitled to the remedies set forth in this  
25 chapter, subject to the discretion of the court and the principles of  
26 equity.

27       (3) The following are not actionable under this section:

28       (a) Fair use of a famous mark by another person in comparative  
29 commercial advertising or promotion to identify competing goods or  
30 services of the owner of the famous mark;

31       (b) Noncommercial use of a famous mark; and

32       (c) All forms of reporting and news commentary.

33       NEW SECTION. Sec. 8. RCW 19.77.110 (Classification of goods) and  
34 1989 c 72 s 7 & 1955 c 211 s 11 are each repealed.

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