

## HOUSE BILL NO. 1169

Introduced by

Representative Froseth

Senator Espgaard

(At the request of the Secretary of State)

1 A BILL for an Act to amend and reenact sections 47-22-01, 47-22-02, 47-22-03, 47-22-04,  
2 47-22-05, 47-22-06, 47-22-06.1, 47-22-07, 47-22-08, 47-22-09, 47-22-10, 47-22-11, 47-22-12,  
3 and 47-22-13 of the North Dakota Century Code, relating to registration and protection of  
4 service marks; to provide for retroactive application; and to declare an emergency.

5 **BE IT ENACTED BY THE LEGISLATIVE ASSEMBLY OF NORTH DAKOTA:**

6 **SECTION 1. AMENDMENT.** Section 47-22-01 of the North Dakota Century Code is  
7 amended and reenacted as follows:

8 **47-22-01. Definitions.** As used in this chapter, unless the context otherwise requires,  
9 the term:

- 10 1. "Applicant" embraces the person filing an application for registration of a ~~trademark~~  
11 mark under this chapter and that person's legal representatives, successors, or  
12 assigns.
- 13 2. "Mark" includes any trademark or service mark entitled to registration under this  
14 chapter whether or not registered.
- 15 3. "Person" means any individual, firm, partnership, corporation, limited liability  
16 company, association, union, or other organization.
- 17 ~~3.~~ 4. "Registrant" embraces the person to whom the registration of a ~~trademark~~ mark  
18 under this chapter is issued and that person's legal representatives, successors, or  
19 assigns.
- 20 5. "Service mark" means any word, name, symbol, or device or any combination  
21 thereof used by a person to identify and distinguish the services of one person,  
22 including a unique service, from the services of others, and to indicate the source  
23 of the services, even if that source is unknown. Titles, character names used by a  
24 person, and other distinctive features of radio or television programs may be

1           registered as service marks notwithstanding that they, or the programs, may  
2           advertise the goods of the sponsor.

3       4- 6. "Trademark" means any word, name, symbol, or device or any combination thereof  
4           adopted and used by a person to identify goods made or sold by that person and to  
5           distinguish them from goods made or sold by others.

6       For the purposes of this chapter, a trademark shall be deemed to be "used" in this state when it  
7       is placed in any manner on the goods or their containers or on the tags or labels affixed thereto  
8       and such goods are sold or otherwise distributed in this state.

9           **SECTION 2. AMENDMENT.** Section 47-22-02 of the North Dakota Century Code is  
10       amended and reenacted as follows:

11           **47-22-02. Registrability.** A ~~trademark~~ mark by which the goods or services of any  
12       applicant for registration may be distinguished from the goods or services of others shall not be  
13       registered if it:

- 14           1. Consists of or comprises immoral, deceptive, or scandalous matter;
- 15           2. Consists of or comprises matter which may disparage or falsely suggest a  
16           connection with persons, living or dead, institutions, beliefs, or national symbols, or  
17           bring them into contempt, or disrepute;
- 18           3. Consists of or comprises the flag or coat of arms or other insignia of the United  
19           States, or of any state or municipality, or of any foreign nation, or any simulation  
20           thereof;
- 21           4. Consists of or comprises the name, signature, or portrait of any living individual,  
22           except with that individual's written consent;
- 23           5. Consists of a mark which:
  - 24           a. When applied to the goods or services of the applicant, is merely descriptive  
25           or deceptively misdescriptive of them;
  - 26           b. When applied to the goods or services of the applicant is primarily  
27           geographically descriptive or deceptively misdescriptive of them; or
  - 28           c. Is primarily merely a surname provided, however, that nothing in this  
29           subsection shall prevent the registration of a mark used in this state by the  
30           applicant which has become distinctive of the applicant's goods or services.  
31           The secretary of state may accept as evidence that the mark has become

1 distinctive, as applied to the applicant's goods or services, proof of continuous  
2 use thereof as a mark by the applicant in this state or elsewhere for the five  
3 years next preceding the date of the filing of the application for registration; or

- 4 6. Consists of or comprises a ~~trademark~~ mark that resembles a ~~trademark~~ mark  
5 registered in this state or a trade name, corporate name, limited liability company  
6 name, limited liability partnership name, limited partnership name, limited liability  
7 limited partnership name, or fictitious name registered with the office of the  
8 secretary of state, as to be likely, when applied to the goods or services of the  
9 applicant, to cause confusion or mistake or to deceive.

10 **SECTION 3. AMENDMENT.** Section 47-22-03 of the North Dakota Century Code is  
11 amended and reenacted as follows:

12 **47-22-03. Application for registration.** Subject to the limitations set forth in this  
13 chapter, any person who adopts and uses a ~~trademark~~ mark in this state may file in the office of  
14 the secretary of state, on a form to be furnished by the secretary of state, an application for  
15 registration of that ~~trademark~~ mark setting forth, but not limited to, the following information:

- 16 1. The name and business address of the person applying for such registration; if a  
17 corporation, the state or country of incorporation and address of the principal place  
18 of business; if a limited partnership, the state or country of the organization and  
19 address of the principal place of business; and, if a limited liability company, the  
20 state or country of organization and the principal place of business;
- 21 2. The goods or services in connection with which the mark is used and the mode or  
22 manner in which the mark is used in connection with such goods or services and  
23 the class, or classes, in which such goods or services fall;
- 24 3. The date when the ~~trademark~~ mark was first used anywhere and the date when it  
25 was first used in this state by the applicant or the applicant's predecessor in  
26 business; and
- 27 4. A statement that the applicant is the owner of the ~~trademark~~ mark and that no  
28 other person has the right to use such ~~trademark~~ mark in this state either in the  
29 identical form thereof or in such near resemblance thereto as might be calculated  
30 to deceive or to be mistaken therefor.

1           The application must be signed by the applicant or by a member of the firm, an officer of  
2 the corporation or association, or manager of the limited liability company applying.

3           The application must be accompanied by a specimen or facsimile of such ~~trademark~~  
4 mark in duplicate.

5           The application for registration must be accompanied by a filing fee of thirty dollars for  
6 one class of goods or services and twenty dollars for each additional class, payable to the  
7 secretary of state.

8           **SECTION 4. AMENDMENT.** Section 47-22-04 of the North Dakota Century Code is  
9 amended and reenacted as follows:

10          **47-22-04. Certificate of registration.** Upon compliance by the applicant with the  
11 requirements of this chapter, the secretary of state shall cause a certificate of registration to be  
12 issued and delivered to the applicant. The certificate of registration must be issued under the  
13 signature of the secretary of state and the seal of the state, and it shall show the name and  
14 business address and, if a corporation, the state of incorporation, and, if a limited liability  
15 company, the state of organization, of the person claiming ownership of the ~~trademark~~ mark,  
16 the date claimed for the first use of the ~~trademark~~ mark anywhere and the date claimed for the  
17 first use of the ~~trademark~~ mark in this state, the class, or classes, of goods or services and a  
18 description of the goods or services on which the ~~trademark~~ mark is used, a facsimile of the  
19 ~~trademark~~ mark, the registration date, and the term of registration.

20          Any certificate of registration issued by the secretary of state under the provisions  
21 hereof or a copy thereof duly certified by the secretary of state is admissible in evidence as  
22 competent and sufficient proof of the registration of such ~~trademark~~ mark in any action or  
23 judicial proceedings in any court of this state.

24          **SECTION 5. AMENDMENT.** Section 47-22-05 of the North Dakota Century Code is  
25 amended and reenacted as follows:

26          **47-22-05. Duration and renewal.** Registration of a ~~trademark~~ mark hereunder is  
27 effective for a term of ten years from the date of registration and, upon application filed prior to  
28 the expiration of such term, on a form to be furnished by the secretary of state, the registration  
29 may be renewed in the same manner as a new application for a like term. A renewal fee of  
30 thirty dollars for one class of goods or services and twenty dollars for each additional class,

payable to the secretary of state, must accompany the application for renewal of the registration.

A ~~trademark~~ registration may be renewed for successive periods of ten years in like manner.

The secretary of state shall notify registrants of ~~trademarks~~ hereunder of the necessity of renewal within ninety days preceding the expiration of the ten years from the date of registration by writing to the last known address of the registrants.

**SECTION 6. AMENDMENT.** Section 47-22-06 of the North Dakota Century Code is amended and reenacted as follows:

**47-22-06. Assignment.** Any ~~trademark~~ mark and its registration hereunder shall be assignable with the goodwill of the business in which the ~~trademark~~ mark is used, or with that part of the goodwill of the business connected with the use of and symbolized by the ~~trademark~~ mark. Assignment must be made by the assignor on forms provided by the secretary of state setting forth the name and business address of the assignor and the assignee, the ~~trademark~~ mark certificate number, and the class or classes of goods or services on which the ~~trademark~~ mark will appear. The assignment must be filed by the secretary of state upon the payment of a fee of thirty dollars 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 chapter is 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.

**SECTION 7. AMENDMENT.** Section 47-22-06.1 of the North Dakota Century Code is amended and reenacted as follows:

**47-22-06.1. Change of name or address of registrant.** Any registrant that effects a name change must record that name change with the secretary of state. The secretary of state must record the name change upon the payment of a fee of thirty dollars and filing of the following:

1. A notarized statement reciting the name change if the registrant is an individual.
2. A certificate of fact reciting the name change duly authenticated by the proper officer of the state or country if the registrant is a corporation, limited liability

company, limited partnership, limited liability partnership, or limited liability limited partnership incorporated or organized in another state or country and does not have a certificate of authority to transact business in North Dakota.

3. An amendment or application for amended certificate of authority for a registrant that is a corporation, limited liability company, limited partnership, limited liability partnership, or limited liability limited partnership registered with the secretary of state.

The secretary of state shall issue a certificate in the new name of the registrant for the remainder of the term of the registration or of the last renewal thereof.

A registrant must notify the secretary of state ~~in writing~~ when effecting a change of address. A corporate annual report or limited partnership renewal filed by the secretary of state that reflects a change of address of the principal place of business of a registrant may serve as such notice.

**SECTION 8. AMENDMENT.** Section 47-22-07 of the North Dakota Century Code is amended and reenacted as follows:

**47-22-07. Records.** The secretary of state shall keep for public examination a record of all ~~trademarks~~ marks registered or renewed under this chapter.

**SECTION 9. AMENDMENT.** Section 47-22-08 of the North Dakota Century Code is amended and reenacted as follows:

**47-22-08. Cancellation.** The secretary of state shall cancel from the register:

1. Any registration concerning which the secretary of state shall receive a voluntary written and signed request for cancellation thereof from the registrant or the assignee of record.
2. All registrations granted under this chapter and not renewed in accordance with the provisions hereof.
3. Any registration concerning which a state district court shall find any of the following:
  - 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 registration ~~trademark~~ mark is so similar, as to be likely to cause confusion or mistake or to deceive, to a ~~trademark~~ mark registered by another person in the United States patent office, prior to the date of the filing of the application for registration by the registrant hereunder, and not abandoned; provided, however, that should the registrant prove that the registrant is the owner of a concurrent registration of the registrant's ~~trademark~~ mark in the United States patent office covering an area including this state, the registration hereunder shall not be canceled.

4. When a district court shall order cancellation of a registration on any ground.

5. Any ~~trademark~~ mark whose registered owner is a corporation, limited liability company, limited partnership, limited liability partnership, or limited liability limited partnership that has ceased to exist for six months.

**SECTION 10. AMENDMENT.** Section 47-22-09 of the North Dakota Century Code is amended and reenacted as follows:

**47-22-09. 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 ~~trademark~~ mark may include any or all goods upon which, or services with which, the ~~trademark~~ mark is actually being used.

The said classes are as follows:

1. Goods.

a. Raw or partly prepared materials.

~~2.~~ b. Receptacles.

~~3.~~ c. Baggage, animal equipment, portfolios, and pocketbooks.

~~4.~~ d. Abrasives and polishing materials.

~~5.~~ e. Adhesives.

~~6.~~ f. Chemicals and chemical compositions.

~~7.~~ g. Cordage.

~~8.~~ h. Smokers' articles, not including tobacco products.

~~9.~~ i. Explosives, firearms, equipments, and projectiles.

~~10.~~ j. Fertilizers.

Fifty-eighth  
Legislative Assembly

- |    |                |            |  |
|----|----------------|------------|--|
| 1  | <del>41.</del> | <u>k.</u>  | Inks and inking materials.                               |
| 2  | <del>42.</del> | <u>l.</u>  | Construction materials.                                  |
| 3  | <del>43.</del> | <u>m.</u>  | Hardware and plumbing and steam-fitting supplies.        |
| 4  | <del>44.</del> | <u>n.</u>  | Metals and metal castings and forgings.                  |
| 5  | <del>45.</del> | <u>o.</u>  | Oils and greases.  |
| 6  | <del>46.</del> | <u>p.</u>  | Paints and painters' materials.                          |
| 7  | <del>47.</del> | <u>q.</u>  | Tobacco products.  |
| 8  | <del>48.</del> | <u>r.</u>  | Medicines and pharmaceutical preparations.               |
| 9  | <del>49.</del> | <u>s.</u>  | Vehicles.  |
| 10 | <del>20.</del> | <u>t.</u>  | Linoleum and oiled cloth.                                |
| 11 | <del>21.</del> | <u>u.</u>  | Electrical apparatus, machines, and supplies.            |
| 12 | <del>22.</del> | <u>v.</u>  | Games, toys, and sporting goods.                         |
| 13 | <del>23.</del> | <u>w.</u>  | Cutlery, machinery, and tools, and parts thereof.        |
| 14 | <del>24.</del> | <u>x.</u>  | Laundry appliances and machines.                         |
| 15 | <del>25.</del> | <u>y.</u>  | Locks and safes.   |
| 16 | <del>26.</del> | <u>z.</u>  | Measuring and scientific appliances.                     |
| 17 | <del>27.</del> | <u>aa.</u> | Horological instruments.                                 |
| 18 | <del>28.</del> | <u>bb.</u> | Jewelry and precious-metal ware.                         |
| 19 | <del>29.</del> | <u>cc.</u> | Brooms, brushes, and dusters.                            |
| 20 | <del>30.</del> | <u>dd.</u> | Crockery, earthenware, and porcelain.                    |
| 21 | <del>31.</del> | <u>ee.</u> | Filters and refrigerators.                               |
| 22 | <del>32.</del> | <u>ff.</u> | Furniture and upholstery.                                |
| 23 | <del>33.</del> | <u>gg.</u> | Glassware.   |
| 24 | <del>34.</del> | <u>hh.</u> | Heating, lighting, and ventilating apparatus.            |
| 25 | <del>35.</del> | <u>ii.</u> | Belting, hose, machinery packing, and nonmetallic tires. |
| 26 | <del>36.</del> | <u>jj.</u> | Musical instruments and supplies.                        |
| 27 | <del>37.</del> | <u>kk.</u> | Paper and stationery.                                    |
| 28 | <del>38.</del> | <u>ll.</u> | Prints and publications.                                 |
| 29 | <del>39.</del> | <u>mm.</u> | Clothing.  |
| 30 | <del>40.</del> | <u>nn.</u> | Fancy goods, furnishings, and notions.                   |
| 31 | <del>41.</del> | <u>oo.</u> | Canes, parasols, and umbrellas.                          |



- 1        ~~42.~~ pp.    Knitted, netted, and textile fabrics, and substitutes therefor.
- 2        ~~43.~~ qq.    Thread and yarn.
- 3        ~~44.~~ rr.    Dental, medical, and surgical appliances.
- 4        ~~45.~~ ss.    Soft drinks and carbonated waters.
- 5        ~~46.~~ tt.    Foods and ingredients of foods.
- 6        ~~47.~~ uu.    Wines.
- 7        ~~48.~~ vv.    Malt beverages and liquors.
- 8        ~~49.~~ ww.    Distilled alcoholic liquors.
- 9        ~~50.~~ xx.    Merchandise not otherwise classified.
- 10       ~~51.~~ yy.    Cosmetics and toilet preparations.
- 11       ~~52.~~ zz.    Detergents and soaps.

12        2.    Services.

- 13            a.    Miscellaneous.
- 14            b.    Advertising and business.
- 15            c.    Insurance and financial.
- 16            d.    Construction and repair.
- 17            e.    Communications.
- 18            f.    Transportation and storage.
- 19            g.    Material treatment.
- 20            h.    Education and entertainment.

21        **SECTION 11. AMENDMENT.** Section 47-22-10 of the North Dakota Century Code is  
22 amended and reenacted as follows:

23        **47-22-10. Fraudulent registration.** Any person who shall for that person, or on behalf  
24 of any other person, procure the filing or registration of any ~~trademark~~ mark in the office of the  
25 secretary of state under the provisions hereof, by knowingly making any false or fraudulent  
26 representation or declaration, verbally or in writing, or by any other fraudulent means, shall be  
27 liable to pay all damages sustained in consequence of such filing or registration, to be  
28 recovered by or on behalf of the party injured thereby in any court of competent jurisdiction.

29        **SECTION 12. AMENDMENT.** Section 47-22-11 of the North Dakota Century Code is  
30 amended and reenacted as follows:

1           **47-22-11. Infringement.** Subject to the provisions of section 47-22-13, any person  
2 who shall:

- 3           1. Use, without the consent of the registrant, any reproduction, counterfeit, copy, or  
4 colorable imitation of a ~~trademark~~ mark registered under this chapter in connection  
5 with the sale, offering for sale, or advertising of any goods or services on or in  
6 connection with which such use is likely to cause confusion or mistake or to  
7 deceive as to the source of origin of such goods or services; or
- 8           2. Reproduce, counterfeit, copy, or colorably imitate any such ~~trademark~~ mark and  
9 apply such reproduction, counterfeit, copy, or colorable imitation to labels, signs,  
10 prints, packages, wrappers, receptacles, or advertisements intended to be used  
11 upon or in connection with the sale or other distribution in this state of such goods  
12 or services;

13 shall be liable to a civil action by the owner of such registered ~~trademark~~ mark for any or all of  
14 the remedies provided in section 47-22-12, except that under subsection 2 the registrant shall  
15 not be entitled to recover profits or damages unless the acts have been committed with  
16 knowledge that such ~~trademark~~ mark is intended to be used to cause confusion or mistake or to  
17 deceive.

18           **SECTION 13. AMENDMENT.** Section 47-22-12 of the North Dakota Century Code is  
19 amended and reenacted as follows:

20           **47-22-12. Remedies.** Any owner of a ~~trademark~~ mark registered under this chapter  
21 may proceed by suit to enjoin the manufacture, use, display, or sale of any counterfeits or  
22 imitations thereof and any court of competent jurisdiction may grant injunctions to restrain such  
23 manufacture, use, display, or sale as may be by the said court deemed just and reasonable,  
24 and may require the defendants to pay to such owner all profits derived from or all damages  
25 suffered by reason of such wrongful manufacture, use, display, or sale, or either, and such  
26 court may also order that any such counterfeits or imitations in the possession or under the  
27 control of any defendant in such case, be delivered to an officer of the court, or to the  
28 complainant, to be destroyed.

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

1           **SECTION 14. AMENDMENT.** Section 47-22-13 of the North Dakota Century Code is  
2 amended and reenacted as follows:

3           **47-22-13. Common-law rights.** Nothing herein shall adversely affect the rights or the  
4 enforcement of rights in ~~trademarks~~ marks acquired in good faith at any time at common law.

5           **SECTION 15. RETROACTIVE APPLICATION OF ACT.** This Act is retroactive and  
6 applies to any registration on file with the secretary of state on the effective date of this Act.

7           **SECTION 16. EMERGENCY.** This Act is declared to be an emergency measure.