

---

SECOND SUBSTITUTE SENATE BILL 6276

---

State of Washington

53rd Legislature

1994 Regular Session

By Senate Committee on Ways & Means (originally sponsored by Senators Haugen, Winsley, Nelson and M. Rasmussen; by request of Secretary of State)

Read first time 02/08/94.

1 AN ACT Relating to trademarks; amending RCW 19.77.030, 19.77.050,  
2 19.77.060, 43.07.120, and 19.77.010; and adding new sections to chapter  
3 19.77 RCW.

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

5 **Sec. 1.** RCW 19.77.030 and 1989 c 72 s 3 are each amended to read  
6 as follows:

7 Subject to the limitations set forth in this chapter, any person  
8 who has adopted and is using a trademark in this state may file in the  
9 office of the secretary of state, on a form to be furnished by the  
10 secretary of state, an application for registration of that trademark  
11 setting forth, but not limited to, the following information:

12 (1) The name and business address of the applicant, and, if the  
13 applicant is a corporation, its state of incorporation;

14 (2) The particular goods or services in connection with which the  
15 trademark is used and the class in which such goods or services fall;

16 (3) The manner in which the trademark is placed on or affixed to  
17 the goods or containers, or displayed in connection with such goods, or  
18 used in connection with the sale or advertising of the services;

1 (4) The date when the trademark was first used with such goods or  
2 services anywhere and the date when it was first used with such goods  
3 or services in this state by the applicant or his predecessor in  
4 business;

5 (5) A statement that the trademark is presently in use in this  
6 state by the applicant;

7 (6) A statement that the applicant believes himself to be the owner  
8 of the trademark and believes that no other person has the right to use  
9 such trademark in connection with the same or similar goods or services  
10 in this state either in the identical form or in such near resemblance  
11 thereto as to be likely, when used on or in connection with the goods  
12 or services of such other person, to cause confusion or mistake or to  
13 deceive; and

14 (7) Such additional information or documents as the secretary of  
15 state may reasonably require.

16 A single application for registration of a trademark may specify  
17 all goods or services in a single class for which the trademark is  
18 actually being used, but may not specify goods or services in different  
19 classes.

20 The application shall be signed by the applicant individual, or by  
21 a member of the applicant firm, or by an officer of the applicant  
22 corporation, association, union or other organization.

23 The application shall be accompanied by three specimens or  
24 facsimiles of the trademark for at least one of the goods or services  
25 for which its registration is requested, and a filing fee (~~of fifty~~  
26 ~~dollars~~), as set by rule by the secretary of state, payable to the  
27 secretary of state.

28 NEW SECTION. Sec. 2. A new section is added to chapter 19.77 RCW  
29 to read as follows:

30 The exclusive right to the use of a trademark may be reserved by:

31 (1) A person intending to register a trademark under this title; or

32 (2) A domestic or foreign corporation intending to change its  
33 trademark.

34 The reservation shall be made by filing with the secretary of state  
35 an application to reserve a specified trademark or service mark,  
36 executed by or on behalf of the applicant, one copy of the trademark  
37 artwork, and fees as set by rule by the secretary of state. If the  
38 secretary of state finds that the trademark is available for use, the

1 secretary of state shall reserve the trademark for the exclusive use of  
2 the applicant for a period of one hundred eighty days. The reservation  
3 is limited to one filing.

4 **Sec. 3.** RCW 19.77.050 and 1989 c 72 s 5 are each amended to read  
5 as follows:

6 Registration of a trademark hereunder shall be effective for a term  
7 of ~~((ten))~~ six years from the date of registration. Upon application  
8 filed within six months prior to the expiration of such term, on a form  
9 to be furnished by the secretary of state requiring all the allegations  
10 of an application for original registration, the registration may be  
11 renewed for successive terms of ~~((ten))~~ six years as to the goods or  
12 services for which the trademark is still in use in this state. A  
13 renewal fee ~~((of fifty dollars))~~ as set by rule by the secretary of  
14 state, payable to the secretary of state, shall accompany each  
15 application for renewal of the registration.

16 The secretary of state shall notify registrants of trademarks  
17 hereunder or their agents for service of record with the secretary of  
18 state of the necessity of renewal within the year, but not less than  
19 six months, next preceding the expiration of the unexpired original or  
20 renewed term by writing to the last known address of the registrants or  
21 their agents according to the files of the secretary of state. Neither  
22 the secretary of state's failure to notify a registrant nor the  
23 registrant's nonreceipt of a notice under this section shall extend the  
24 term of a registration or excuse the registrant's failure to renew a  
25 registration.

26 **Sec. 4.** RCW 19.77.060 and 1982 c 35 s 183 are each amended to read  
27 as follows:

28 Any trademark and its registration or application for registration  
29 hereunder shall be assignable with the good will of the business in  
30 which the trademark is used, or with that part of the good will of the  
31 business connected with the use of and symbolized by the trademark. An  
32 assignment by an instrument in writing duly executed and acknowledged,  
33 or the designation of a legal representative, successor, or agent for  
34 service shall be recorded by the secretary of state on request when  
35 accompanied by a fee ~~((of ten dollars))~~, as set by rule by the  
36 secretary of state, payable to the secretary of state. On request,  
37 upon recording of the assignment and payment of a further fee of five

1 dollars, the secretary of state shall issue in the name of the assignee  
2 a new certificate for the remainder of the unexpired original or  
3 renewal term of the registration. An assignment of any registration or  
4 application for registration under this chapter shall be void as  
5 against any subsequent purchaser for a valuable consideration without  
6 notice, unless it is recorded with the secretary of state within three  
7 months after the date thereof or prior to such subsequent purchase.

8 **Sec. 5.** RCW 43.07.120 and 1993 c 269 s 15 are each amended to read  
9 as follows:

10 (1) The secretary of state shall establish by rule and collect the  
11 fees in this subsection:

12 (a) For a copy of any law, resolution, record, or other document or  
13 paper on file in the secretary's office;

14 (b) For any certificate under seal;

15 (c) For filing and recording trademark;

16 (d) For each deed or patent of land issued by the governor;

17 (e) For recording miscellaneous records, papers, or other  
18 documents.

19 (2) The secretary of state may adopt rules under chapter 34.05 RCW  
20 establishing reasonable fees for the following services rendered under  
21 Title 23B RCW, chapter 18.100, 19.77, 23.86, 23.90, 24.03, 24.06,  
22 24.12, 24.20, 24.24, 24.28, 24.36, or 25.10 RCW:

23 (a) Any service rendered in-person at the secretary of state's  
24 office;

25 (b) Any expedited service;

26 (c) The electronic or facsimile transmittal of information from  
27 corporation records or copies of documents;

28 (d) The providing of information by micrographic or other reduced-  
29 format compilation;

30 (e) The handling of checks, drafts, or credit or debit cards upon  
31 adoption of rules authorizing their use for which sufficient funds are  
32 not on deposit; and

33 (f) Special search charges.

34 (3) To facilitate the collection of fees, the secretary of state  
35 may establish accounts for deposits by persons who may frequently be  
36 assessed such fees to pay the fees as they are assessed. The secretary  
37 of state may make whatever arrangements with those persons as may be  
38 necessary to carry out this section.

1 (4) The secretary of state may adopt rules for the use of credit or  
2 debit cards for payment of fees.

3 (5) No member of the legislature, state officer, justice of the  
4 supreme court, judge of the court of appeals, or judge of the superior  
5 court shall be charged for any search relative to matters pertaining to  
6 the duties of his or her office; nor may such official be charged for  
7 a certified copy of any law or resolution passed by the legislature  
8 relative to his or her official duties, if such law has not been  
9 published as a state law.

10 **Sec. 6.** RCW 19.77.010 and 1989 c 72 s 1 are each amended to read  
11 as follows:

12 As used in this chapter:

13 (1) "Alien" when used with reference to a person means a person who  
14 is not a citizen of the United States;

15 (2) "Applicant" means the person filing an application for  
16 registration of a trademark under this chapter, his legal  
17 representatives, successors, or assigns of record with the secretary of  
18 state;

19 ~~((2))~~ (3) "Domestic" when used with reference to a person means  
20 a person who is a citizen of the United States;

21 (4) The term "colorable imitation" includes any mark which so  
22 resembles a registered mark as to be likely to cause confusion or  
23 mistake or to deceive;

24 ~~((3))~~ (5) A "counterfeit" is a spurious mark which is identical  
25 with, or substantially indistinguishable from, a registered mark;

26 ~~((4))~~ (6) "Dilution" means the material reduction of the  
27 distinctive quality of a famous mark through use of a mark by another  
28 person, regardless of the presence or absence of (a) competition  
29 between the users of the mark, or (b) likelihood of confusion, mistake,  
30 or deception arising from that use;

31 ~~((5))~~ (7) "Person" means any individual, firm, partnership,  
32 corporation, association, union, or other organization;

33 ~~((6))~~ (8) "Registered mark" means a trademark registered under  
34 this chapter;

35 ~~((7))~~ (9) "Registrant" means the person to whom the registration  
36 of a trademark under this chapter is issued, his legal representatives,  
37 successors, or assigns of record with the secretary of state;

1       (~~(8)~~) (10) "Trademark" or "mark" means any word, name, symbol, or  
2 device or any combination thereof adopted and used by a person to  
3 identify goods made or sold by him and to distinguish them from goods  
4 made or sold by others, and any word, name, symbol, or device, or any  
5 combination thereof, and any title, designation, slogan, character  
6 name, and distinctive feature of radio or television programs used in  
7 the sale or advertising of services to identify the services of one  
8 person and distinguish them from the services of others;

9       (~~(9)~~) (11) A trademark shall be deemed to be "used" in this state  
10 when it is placed in any manner on the goods or their containers, or on  
11 tabs or labels affixed thereto, or displayed in connection with such  
12 goods, and such goods are sold or otherwise distributed in this state,  
13 or when it is used or displayed in the sale or advertising of services  
14 rendered in this state;

15       (~~(10)~~) (12) "Trade name" shall have the same definition as under  
16 RCW 19.80.005(1);

17       (~~(11)~~) (13) A mark shall be deemed to be "abandoned":

18       (a) When its use has been discontinued with intent not to resume.  
19 Intent not to resume may be inferred from circumstances. Nonuse for  
20 two consecutive years shall be prima facie abandonment; or

21       (b) When any course of conduct of the registrant, including acts of  
22 omission as well as commission, causes the mark to lose its  
23 significance as an indication of origin. Purchaser motivation shall  
24 not be a test for determining abandonment under this subsection.

25       NEW SECTION. Sec. 7. A new section is added to chapter 19.77 RCW  
26 to read as follows:

27       Damages or equitable relief of any nature may not be awarded in any  
28 pending or future legal procedure in favor of an alien person against  
29 a domestic person on account of the domestic person's use of a  
30 trademark or trade name in this state that is employed by the alien  
31 person outside of the United States, absent proof that:

32       (1) The alien person had commenced to employ the trademark or trade  
33 name in connection with the sale of its goods or services within the  
34 United States prior to the time the domestic person commenced to use  
35 the trademark or trade name in this state; or

36       (2) That the trademark was registered by the United States patent  
37 and trademark office or reserved by the secretary of state to the alien  
38 person at the time the domestic person commenced to use it. This

1 section applies regardless of the nature of the claim asserted and  
2 whether the claim upon which any such relief is sought arises by  
3 statute, under the common law, or otherwise.

--- END ---