

SENATE BILL REPORT

SB 5122

As Passed Senate, February 21, 2003

Title: An act relating to trademark registration.

Brief Description: Revising provisions of the state trademark law.

Sponsors: Senators Johnson, Kline and Esser.

Brief History:

Committee Activity: Judiciary: 1/29/03 [DP].

Passed Senate: 2/21/03, 46-0.

SENATE COMMITTEE ON JUDICIARY

Majority Report: Do pass.

Signed by Senators McCaslin, Chair; Esser, Vice Chair; Brandland, Hargrove, Haugen, Johnson, Kline, Roach and Thibaudeau.

Staff: Jinnah Rose-McFadden (786-7421)

Background: A trademark is any word, name, symbol, or device adopted or used by a person to identify the goods made or sold by that person and to distinguish them from goods made or sold by others. Registration of a trademark provides the registered user with exclusive use of that trademark and protects against infringements upon the user's rights. A trademark may be registered with: 1) the U.S. Trademark and Patent Office, for the broadest protection; 2) the Washington Secretary of State's Office, for a trademark used exclusively within the state or region; or 3) both the federal office and the state office.

RCW 19.77 sets out Washington's trademark registration law. Washington's law is modeled after the Model State Trademark Bill (MSTB). Versions of the MSTB form the foundation of state trademark law in 46 states. Over the years, Washington's law has been amended several times in light of MSTB revisions. In 2001 the Washington State Trademark Review Committee was assembled to review recent MSTB revisions. After comparing the revised MSTB to both federal and state trademark law, the committee determined that some sections of RCW 19.77 were outdated and unclear. The committee proposes adopting uniform provisions from the MSTB and conforming Washington law more closely to federal law.

Summary of Bill: RCW 19.77 is amended to adopt uniform provisions from the revised Model State Trademark Bill and more closely parallel federal trademark laws.

Key amendments include the following:

- 1) The definition of trademark abandonment is modified. Non-use of a trademark for three consecutive years, rather than two, constitutes prima facie evidence of trademark abandonment;

2) The term for which a trademark is registered to a user is reduced from six years to five years;

3) The current classification of goods and services is deleted. The Secretary of State is authorized to establish and regulate new classifications. The statute directs the secretary to conform, as much as possible, Washington's classifications to the classifications used by the United States Patent and Trademark Office; and

4) Court ordered remedies available to litigants in trademark registration cases are clarified. A court may order attorneys' fees and, where the court finds a showing of bad faith, treble damages.

Appropriation: None.

Fiscal Note: Not requested.

Effective Date: Ninety days after adjournment of session in which bill is passed.

Testimony For: In 2001, a Trademark Review Committee, comprised of leading state trademark attorneys and the Secretary of State's Office, was assembled to review Washington's trademark law in light of revisions made to the Model State Trademark Bill (MSTB). The MSTB was written by the International Trademark Association and is periodically revised to keep pace with current legal trends. Washington State trademark law is based on the original MSTB and has been amended several times to maintain uniformity with MSTB revisions.

The Trademark Review Committee met monthly, over an 18-month period, to compare MSTB revisions to current state and federal law. The committee concluded that amendments to Washington's trademark law would be helpful in clarifying certain provisions. The purpose of these amendments are twofold: (1) to make Washington law uniform with other states and the MSTB; and (2) to conform Washington law to federal law, particularly in the area of trademark dilution. Uniformity of language provides clarity and efficiency, because it allows Washington courts to draw on federal case law that has interpreted identical language.

Testimony Against: None.

Testified: Paul Swanson, WSBA Intellectual Property Section, Chair of the Trademark Review Committee (pro).