

SENATE BILL NO. 511

INTRODUCED BY TURNAGE, McCALLUM

IN THE SENATE

February 14, 1979	Introduced and referred to Committee on Judiciary.
February 19, 1979	Committee recommend bill do pass. Report adopted.
February 20, 1979	Printed and placed on members' desks.
February 21, 1979	Second reading, do pass.
February 22, 1979	Considered correctly engrossed.
February 23, 1979	Third reading, passed. Transmitted to second house.

IN THE HOUSE

February 27, 1979	Introduced and referred to Committee on Judiciary.
March 15, 1979	Committee recommend bill be concurred in. Report adopted.
March 16, 1979	Second reading, concurred in.
March 20, 1979	Third reading, concurred in.

IN THE SENATE

March 21, 1979	Returned from second house. Concurred in. Sent to enrolling. Reported correctly enrolled.
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1 *Sen* BILL NO. *511*
 2 INTRODUCED BY *Fernando Melillo*
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4 A BILL FOR AN ACT ENTITLED: "AN ACT TO PROVIDE FOR THE
 5 REGISTRATION AND PROTECTION OF TRADEMARKS AND SERVICE MARKS;
 6 TO PROVIDE FOR RENEWAL AND ASSIGNMENT OF SUCH MARKS;
 7 AMENDING SECTIONS 2-6-103 AND 2-15-401, MCA; REPEALING
 8 SECTIONS 30-13-101 THROUGH 30-13-107; AND PROVIDING AN
 9 EFFECTIVE DATE."

10
 11 BE IT ENACTED BY THE LEGISLATURE OF THE STATE OF MONTANA:

12 NEW SECTION. SECTION 1. Definitions. In [sections 1
 13 through 17], unless the context requires otherwise, the
 14 following definitions apply:

15 (1) "Trademark" means any word, name, symbol, device,
 16 or any combination thereof adopted and used by a person to
 17 identify goods made or sold by him and to distinguish them
 18 from goods made or sold by others.

19 (2) "Service mark" means a mark used in the sale or
 20 advertising of services to identify the services of one
 21 person and distinguish them from the services of others.

22 (3) "Mark" means any trademark or service mark
 23 entitled to registration under [sections 1 through 17]
 24 whether registered or not.

25 (4) "Trade name" means a word, name, symbol, device,

1 or any combination thereof used by a person to identify his
 2 business, vocation, or occupation and distinguish it from
 3 the business, vocation, or occupation of others.

4 (5) "Person" means any individual, firm, partnership,
 5 corporation, association, union, or other organization.

6 (6) "Applicant" means the person filing an application
 7 for registration of a trademark under [sections 1 through
 8 17] or his legal representatives, successors, or assigns.

9 (7) "Registrant" means the person to whom the
 10 registration of a trademark under [sections 1 through 17] is
 11 issued or his legal representatives, successors, or assigns.

12 NEW SECTION. Section 2. When mark considered used in
 13 this state. For purposes of [sections 1 through 17], a mark
 14 is considered to be used in this state:

15 (1) on goods when it is placed in any manner on the
 16 goods or their containers or the displays associated
 17 therewith or on the tags or labels affixed thereto and such
 18 goods are sold or otherwise distributed in the state; and

19 (2) on services when it is used or displayed in the
 20 sale or advertising of services and the services are
 21 rendered in this state.

22 NEW SECTION. Section 3. Registrability. (1) A mark by
 23 which the goods or services of any applicant for
 24 registration may be distinguished from the goods or services
 25 of others may not be registered if it:

1 (a) comprises immoral, deceptive, or scandalous
2 matter; or

3 (b) comprises matter which may disparage or falsely
4 suggest a connection with persons, living or dead, or
5 institutions, beliefs, or national symbols or bring them
6 into contempt or disrepute; or

7 (c) comprises the flag or coat of arms or other
8 insignia of the United States, of any state or municipality,
9 or of any foreign nation or any simulation thereof; or

10 (d) comprises the name, signature, or portrait of any
11 living individual, except with his written consent; or

12 (e) comprises a mark that:

13 (i) when applied to the goods or services of the
14 applicant, is merely descriptive or deceptively
15 misdescriptive of them;

16 (ii) when applied to the goods or services of the
17 applicant is primarily geographically descriptive or
18 deceptively misdescriptive of them; or

19 (iii) is primarily merely a surname; or

20 (f) comprises a mark that so resembles a mark
21 registered in this state or a mark or trade name previously
22 used in this state by another and not abandoned as to be
23 likely, when applied to the goods or services of the
24 applicant, to cause confusion or mistake or to deceive.

25 (2) However, nothing in subsection (1)(e) prevents the

1 registration of a mark used in this state by the applicant
2 which has become distinctive of the applicant's goods or
3 services. The secretary of state may accept as evidence that
4 the mark has become distinctive, as applied to the
5 applicant's goods or services, proof of continuous use
6 thereof as a mark by the applicant in this state or
7 elsewhere for the 5 years immediately preceding the date of
8 the filing of the application for registration.

9 NEW SECTION. Section 4. Application for registration.

10 (1) Subject to the limitations set forth in [sections 1
11 through 17], a person who adopts and uses a mark in this
12 state may file in the office of secretary of state, on a
13 form to be furnished by the secretary of state, an
14 application for registration of that mark setting forth
15 information including but not limited to the following:

16 (a) the name and business address of the person
17 applying for such registration and, if a corporation, the
18 state of incorporation;

19 (b) the essential feature of the mark to be
20 registered;

21 (c) the goods or services in connection with which the
22 mark is used and the mode or manner in which the mark is
23 used in connection with such goods or services and the class
24 in which such goods or services fall;

25 (d) the date when the mark was first used anywhere and

1 the date when it was first used in this state by the
2 applicant or his predecessor in business;

3 (e) a statement that the mark is presently in use in
4 this state by the applicant; and

5 (f) a statement that the applicant is the owner of the
6 mark and that no other person has the right to use the mark
7 in this state either in the identical form thereof or in a
8 form that so nearly resembles it that it might be calculated
9 to deceive or might be mistaken for it.

10 (2) The application must be signed and verified by
11 affidavit of the applicant or a member of the firm or an
12 officer of the corporation or association applying.

13 (3) The application must be accompanied by a specimen
14 or facsimile of such mark in duplicate.

15 (4) The application for registration must be
16 accompanied by a filing fee of \$20, payable to the secretary
17 of state.

18 NEW SECTION. Section 5. Filing application and
19 issuing certificate of registration. (1) Duplicate originals
20 of an application for registration of a mark must be
21 delivered to the secretary of state. If the secretary of
22 state finds that the application complies with the
23 requirements of [sections 1 through 17], he shall, when all
24 fees have been paid as prescribed in [sections 1 through
25 17]:

1 (a) endorse on each such duplicate original the words
2 "filed for record" and the month, day, and year of the
3 filing thereof;

4 (b) file one such duplicate original in his office;
5 and

6 (c) issue a certificate of registration to which he
7 shall affix the other duplicate original.

8 (2) The certificate of registration, together with the
9 duplicate original of the application for registration of
10 mark affixed thereto, shall be returned to the applicant.

11 (3) Any certificate of registration issued by the
12 secretary of state under the provisions of this section or a
13 copy thereof duly certified by the secretary of state is
14 admissible in evidence as competent and sufficient proof of
15 the registration of such mark in any judicial proceeding in
16 any court of this state.

17 NEW SECTION. Section 6. Duration and renewal. (1)
18 Registration of a mark under [sections 1 through 17] is
19 effective for a term of 10 years from the date of
20 registration and, upon application filed within 6 months
21 prior to the expiration of such term, the registration may
22 be renewed for another 10 years.

23 (2) An application for renewal of mark registration
24 must be delivered to the secretary of state and shall set
25 forth information including but not limited to the

1 following:

- 2 (a) the name and business address of the applicant;
- 3 (b) a description of the mark; and
- 4 (c) a statement that the mark is still in use by the
- 5 applicant in this state.

6 (3) The application for renewal of mark registration

7 must be signed and verified by affidavit of the applicant.

8 (4) The application for renewal of mark registration

9 must be accompanied by a filing fee of \$20, payable to the

10 secretary of state.

11 NEW SECTION. Section 7. Filing application for

12 renewal of registration -- issuing certificate of renewal.

13 (1) Duplicate originals of an application for renewal of

14 mark registration must be delivered to the secretary of

15 state. If the secretary of state finds that the application

16 complies with the requirements of [sections 1 through 17],

17 he shall, when all fees have been paid as prescribed in

18 [sections 1 through 17]:

19 (a) endorse on each such duplicate original the words

20 "filed for record" and the month, day, and year of the

21 filing thereof;

22 (b) file one such duplicate original in his office;

23 and

24 (c) issue a certificate of registration to which he

25 shall affix the other duplicate original.

1 (2) The certificate of renewal of registration,

2 together with the duplicate original of the application for

3 renewal of registration of the mark affixed thereto, shall

4 be returned to the applicant.

5 (3) A mark registration may be renewed for successive

6 periods of 10 years in the manner provided for in

7 subsections (1) and (2).

8 (4) The secretary of state shall notify registrants of

9 marks of the necessity of renewal within the year

10 immediately preceding the expiration of the 10 years from

11 the date of registration, by writing to the last-known

12 address of the registrants.

13 (5) Any registration in force on July 1, 1979, expires

14 10 years from the date of the registration or from the date

15 of the last renewal thereof or on July 1, 1980, whichever is

16 later, if renewal of mark registration is not effected in

17 the manner provided for in [sections 1 through 17].

18 (6) The secretary of state shall, by January 1, 1981,

19 notify each person who registered a mark prior to July 1,

20 1980, of the date of expiration of such registration unless

21 renewed in accordance with the provisions of [sections 1

22 through 17], by writing to the last-known address of the

23 registrant.

24 NEW SECTION. Section 8. Assignment. (1) Any mark and

25 its registration under [sections 1 through 17] may be

1 assigned in conjunction with the good will of the business
 2 in which the mark is used or with that part of the good will
 3 of the business connected with the use of and symbolized by
 4 the mark for the remainder of the term of the current
 5 registration. An assignment of any registration under
 6 [sections 1 through 17] is void as against any subsequent
 7 purchaser for valuable consideration without notice unless
 8 it is recorded with the secretary of state within 3 months
 9 after the date of the assignment or prior to such subsequent
 10 purchase.

11 (2) Duplicate originals of an assignment of a mark
 12 must be delivered to the secretary of state and shall set
 13 forth information including but not limited to the
 14 following:

- 15 (a) the name and address of the assignor;
 - 16 (b) the name and address of the assignee;
 - 17 (c) the registration number of the mark; and
 - 18 (d) the date of registration.
- 19 (3) The assignment of a mark must be signed and
 20 verified by the assignor.

21 (4) The assignment of a mark must be accompanied by a
 22 filing fee of \$20, payable to the secretary of state.

23 NEW SECTION. Section 9. Filing of assignment --
 24 issuing certificate of assignment. (1) Duplicate originals
 25 of the assignment of a mark must be delivered to the

1 secretary of state. If the secretary of state finds that the
 2 assignment complies with the requirements of [sections 1
 3 through 17], he shall, when all fees have been paid as
 4 prescribed in [sections 1 through 17]:

5 (a) endorse on each such duplicate original the words
 6 "filed for record" and month, day, and year of the filing
 7 thereof;

8 (b) file one such duplicate original in his office;

9 (c) issue a certificate of assignment to which he
 10 shall affix the other duplicate original.

11 (2) The certificate of assignment, together with the
 12 duplicate original of assignment of a mark affixed thereto,
 13 shall be returned to the assignee.

14 NEW SECTION. Section 10. Records. The secretary of
 15 state shall keep for public examination a record of all
 16 marks registered or renewed under [sections 1 through 17].

17 NEW SECTION. Section 11. Cancellation. The secretary
 18 of state shall cancel from the register:

19 (1) after July 1, 1981, each registration made prior
 20 to July 1, 1980, that is more than 10 years old and not
 21 renewed in accordance with [sections 1 through 17];

22 (2) any registration concerning which the secretary of
 23 state receives a voluntary request for cancellation from the
 24 registrant or the assignee of record;

25 (3) each registration granted under [sections 1

1 through 17] and not renewed in accordance with the
2 provisions of [sections 1 through 17];

3 (4) any registration concerning which a court of
4 competent jurisdiction finds that:

- 5 (a) the registered mark has been abandoned;
- 6 (b) the registrant is not the owner of the mark;
- 7 (c) the registration was granted improperly;
- 8 (d) the registration was obtained fraudulently;
- 9 (e) the registered mark is so similar to a mark

10 currently registered by another person in the United States
11 patent and trademark office prior to the filing date of the
12 application for registration under [sections 1 through 17]
13 as to be likely to cause confusion or mistake or to deceive.
14 However, if the registrant proves that he is the owner of a
15 concurrent registration of his mark in the United States
16 patent and trademark office covering an area including this
17 state, the registration under [sections 1 through 17] may
18 not be canceled.

19 (5) a registration ordered canceled by a court of
20 competent jurisdiction on any grounds.

21 NEW SECTION. Section 12. Classification. (1) The
22 following general classes of goods and services are
23 established for convenience of administration of [sections 1
24 through 17]. This classification does not limit or extend
25 the applicant's or registrant's rights. A single application

1 for registration of a mark may include any or all goods or
2 services comprised in a single class with regard to which
3 the mark is actually being used. However, in no event may a
4 single application include goods or services that fall
5 within different classes of goods or services.

6 (2) The classes of goods are as follows:

- 7 (a) raw or partly prepared materials;
- 8 (b) receptacles;
- 9 (c) baggage, animal equipments, portfolios, and
10 pocketbooks;
- 11 (d) abrasive and polishing materials;
- 12 (e) adhesives;
- 13 (f) chemicals and chemical compositions;
- 14 (g) cordage;
- 15 (h) smokers' articles, not including tobacco products;
- 16 (i) explosives, firearms, equipment, and projectiles;
- 17 (j) fertilizers;
- 18 (k) inks and inking materials;
- 19 (l) construction materials;
- 20 (m) hardware and plumbing and steamfitting supplies;
- 21 (n) metals and metal casting and forgings;
- 22 (o) oils and greases;
- 23 (p) paints and painters' materials;
- 24 (q) tobacco products;
- 25 (r) medicines and pharmaceutical preparations;

1 (s) vehicles;
 2 (t) linoleum and oil cloth;
 3 (u) electrical apparatus, machines, and supplies;
 4 (v) games, toys, and sporting goods;
 5 (w) cutlery, machinery, and tools, and parts thereof;
 6 (x) laundry appliances and machines;
 7 (y) locks and safes;
 8 (z) measuring and scientific appliances;
 9 (aa) horological instruments;
 10 (bb) jewelry and precious metal ware;
 11 (cc) brooms, brushes, and dusters;
 12 (dd) crockery, earthenware, and porcelain;
 13 (ee) filters and refrigerators;
 14 (ff) furniture and upholstery;
 15 (gg) glassware;
 16 (hh) heating, lighting, and ventilating apparatus;
 17 (ii) belting, hose, machinery packing, and nonmetallic
 18 tires;
 19 (jj) musical instruments and supplies;
 20 (kk) paper and stationery;
 21 (ll) prints and publications;
 22 (mm) clothing;
 23 (nn) fancy goods, furnishings, and notions;
 24 (oo) canes, parasols, and umbrellas;
 25 (pp) knitted, netted, and textile fabrics, and

1 substitutes therefor;
 2 (qq) thread and yarn;
 3 (rr) dental, medical, and surgical appliances;
 4 (ss) soft drinks and carbonated waters;
 5 (tt) foods and ingredients of foods;
 6 (uu) wines;
 7 (vv) malt beverages and liquors;
 8 (ww) distilled alcoholic liquors;
 9 (xx) merchandise not otherwise classified;
 10 (yy) cosmetics and toilet preparations;
 11 (zz) detergents and soaps.
 12 (3) The classes of services are as follows:
 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 NEW SECTION. Section 13. Fraudulent registration. Any
 22 person who, for himself or on behalf of any other person,
 23 procures the filing or registration of any mark in the
 24 office of the secretary of state under the provisions of
 25 [sections 1 through 17] by knowingly making any false or

1 fraudulent representation, verbally or in writing or by any
 2 other fraudulent means, is liable to pay all damages
 3 sustained in consequence of such filing or registration.
 4 Such damages may be recovered by or on behalf of the injured
 5 party in any court of competent jurisdiction.

6 **NEW SECTION.** Section 14. Infringement. (1) Subject to
 7 the provisions of [section 17], any person is liable in a
 8 civil action brought by the lawful owner of a registered
 9 mark under [section 16] if such person:

10 (a) uses, without the consent of the registrant, any
 11 reproduction, counterfeit, copy, or colorable imitation of a
 12 mark registered under [sections 1 through 17] in connection
 13 with the sale, offering for sale, or advertising of any
 14 goods or services on or in connection with which such use is
 15 likely to cause confusion or mistake or to deceive as to the
 16 source of origin of such goods or services; or

17 (b) reproduces, counterfeits, copies, or colorably
 18 imitates any such mark and applies such reproduction,
 19 counterfeit, copy, or colorable imitation to labels, signs,
 20 prints, packages, wrappers, receptacles, or advertisements
 21 intended to be used upon or in conjunction with the sale or
 22 other distribution in this state of such goods or services.

23 (2) However, the registrant is not entitled to recover
 24 under subsection (1)(b) any profits or damages unless the
 25 acts have been committed with knowledge that such mark is

1 intended to be used to cause confusion or mistake or to
 2 deceive.

3 **NEW SECTION.** Section 15. Injury to business
 4 reputation -- dilution. Likelihood of injury to business
 5 reputation or of dilution of the distinctive quality of a
 6 mark registered under [sections 1 through 17] or a mark
 7 valid at common law or a trade name valid at common law is
 8 grounds for injunctive relief notwithstanding the absence of
 9 competition between the parties or the absence of confusion
 10 as to the source of goods or services.

11 **NEW SECTION.** Section 16. Remedies. (1) Any owner of a
 12 mark registered under [sections 1 through 17] may proceed by
 13 suit to enjoin the manufacture, use, display, or sale of any
 14 counterfeits or imitations of the mark. Any court of
 15 competent jurisdiction may grant injunctions to restrain
 16 such manufacture, use, display, or sale as is considered by
 17 the court to be just and reasonable. The court may require
 18 the defendants to pay to such owner all profits derived from
 19 and/or all damages suffered by reason of such wrongful
 20 manufacture, use, display, or sale. The court may also order
 21 that any such counterfeits or imitations in the possession
 22 or under the control of any defendant in such case be
 23 delivered to an officer of the court or to the complainant
 24 to be destroyed.

25 (2) The enumeration in [sections 1 through 17] of any

1 right or remedy does not affect a registrant's right to
2 prosecute under any criminal law of this state.

3 NEW SECTION. Section 17. Common-law rights. Nothing
4 in [sections 1 through 17] adversely affects the rights or
5 the enforcement of rights in marks acquired at common law in
6 good faith at any time.

7 Section 18. Section 2-6-103, MCA, is amended to read:

8 "2-6-103. Filing and copying fees. (1) The secretary
9 of state, for services performed in his office, must charge
10 and collect the following fees:

11 (a) for each copy of any law, resolution, record, or
12 other document or paper on file in his office, except
13 corporate papers, 40 cents per folio or, if the copy is made
14 by any process of reproduction by photographic, photostatic,
15 or similar process, the fee shall be 50 cents per page or
16 fraction thereof;

17 (b) for affixing certificate and seal, \$2;

18 (c) for receiving and recording each official bond,
19 \$10;

20 (d) for each commission or other document signed by
21 the governor and attested by the secretary of state (pardon,
22 military commissions, and extraditions excepted), \$5;

23 ~~{e}--for-filing-each-trademark--\$5;~~

24 ~~{f}--for-filing--and--recording--each--assignment-of-a~~
25 ~~trademark--\$5;~~

1 ~~{g}~~ for issuing each certificate of record, \$5;

2 ~~{h}~~ for filing and recording miscellaneous papers,
3 records, or other documents, \$5;

4 ~~{i}~~ for filing and recording any other paper not
5 otherwise herein provided for, \$5;

6 ~~{j}~~ for filing and recording any paper, record, or
7 other document or other than a standard form when
8 recommended by the secretary of state, \$5;

9 ~~{k}~~ when a copy of any law, resolution, record, or
10 other document or paper on file in the office of the
11 secretary of state is presented for comparison and
12 certification, 10 cents per folio must be charged and
13 collected for proofreading the same.

14 (2) No member of the legislature or state or county
15 officer can be charged for any search relative to matters
16 appertaining to the duties of his office or be charged any
17 fee for a certified copy of any law or resolution passed by
18 the legislature relative to his official duties.

19 (3) Fees must be collected in advance and when
20 collected by the secretary of state must be paid to the
21 state treasurer at the end of each quarter, as provided in
22 the constitution."

23 Section 19. Section 2-15-401, MCA, is amended to read:

24 "2-15-401. Duties of secretary of state. In addition
25 to the duties prescribed by the constitution, it is the duty

1 of the secretary of state to:

2 (1) attend at every session of the legislature for the
3 purpose of receiving bills and resolutions thereof and to
4 perform such other duties as may be devolved upon him by
5 resolution of the two houses or either of them;

6 (2) keep a register of and attest the official acts of
7 the governor;

8 (3) affix the great seal, with his attestation, to
9 commissions, pardons, and other public instruments to which
10 the official signature of the governor is required;

11 (4) record in proper books all conveyances made to the
12 state and all articles of incorporation filed in his office;

13 (5) receive and record in proper books the official
14 bonds of all the state officers and then deliver the
15 originals to the state treasurer;

16 (6) take and file in his office receipts for all books
17 distributed by him and direct the county clerk of each
18 county to do the same;

19 (7) certify to the governor the names of those persons
20 who have received at any election the highest number of
21 votes for any office, the incumbent of which is commissioned
22 by the governor;

23 (8) furnish, on demand, to any person paying the fees
24 therefor, a certified copy of all or any part of any law,
25 record, or other instrument filed, deposited, or recorded in

1 his office;

2 (9) notify in writing the county attorney of the
3 proper county of the failure of any officer in his county to
4 file in his office the sworn statement of fees received by
5 such officer;

6 (10) present to the legislature, at the commencement of
7 each session thereof, a full account of all purchases made
8 and expenses incurred in furnishing fuel, lights, and
9 stationery;

10 (11) keep a fee book in which must be entered all fees,
11 commissions, and compensation of whatever nature or kind by
12 him earned, collected, or charged, with the date, name of
13 payer, paid or unpaid, and the nature of the service in each
14 case, which book must be verified annually by his affidavit
15 entered therein;

16 (12) file in his office descriptions of seals in use by
17 the different state officers and furnish such officers with
18 new seals whenever required;

19 (13) discharge the duties of member of the board of
20 examiners and of the board of land commissioners and all
21 other duties required of him by law;

22 (14) report to the governor, at the time prescribed in
23 2-7-102, a detailed account of all official actions since
24 his previous reports, accompanying the report with a
25 detailed statement, under oath, of the manner in which all

1 appropriations for his office have been expended;

1 July 1, 1980.

2 (15) ~~receivev-designatev-and-record-trademarks register~~
3 ~~marks~~ as provided in ~~30-13-103~~ [sections 1 through 17];

-End-

4 (16) distribute the bound volumes of the decisions of
5 the supreme court in the manner provided by 3-2-604;

6 (17) report annually to the legislative services
7 division of the legislative council all changes of names
8 received pursuant to 27-31-205 for publication in the
9 session laws;

10 (18) report annually to the legislative services
11 division of the legislative council all watercourse name
12 changes received pursuant to 85-2-134 for publication in the
13 session laws."

14 Section 20. Savings. This act does not affect any
15 right which matured or proceeding which was commenced prior
16 to July 1, 1980.

17 Section 21. Severability. If a part of this act is
18 invalid, all valid parts that are severable from the invalid
19 part remain in effect. If a part of this act is invalid in
20 one or more of its applications, the part remains in effect
21 in all valid applications that are severable from the
22 invalid applications.

23 Section 22. Repealer. Sections 30-13-101 through
24 30-13-107, MCA, are repealed.

25 Section 23. Effective date. This act is effective on

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Sen. Turmagne BILL NO. *511*
McKallum

INTRODUCED BY

A BILL FOR AN ACT ENTITLED: "AN ACT TO PROVIDE FOR THE REGISTRATION AND PROTECTION OF TRADEMARKS AND SERVICE MARKS; TO PROVIDE FOR RENEWAL AND ASSIGNMENT OF SUCH MARKS; AMENDING SECTIONS 2-6-103 AND 2-15-401, MCA; REPEALING SECTIONS 30-13-101 THROUGH 30-13-107; AND PROVIDING AN EFFECTIVE DATE."

BE IT ENACTED BY THE LEGISLATURE OF THE STATE OF MONTANA:

NEW SECTION. SECTION 1. Definitions. In [sections 1 through 17], unless the context requires otherwise, the following definitions apply:

(1) "Trademark" means any word, name, symbol, device, or any combination thereof adopted and used by a person to identify goods made or sold by him and to distinguish them from goods made or sold by others.

(2) "Service mark" 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.

(3) "Mark" means any trademark or service mark entitled to registration under [sections 1 through 17] whether registered or not.

(4) "Trade name" means a word, name, symbol, device,

1 or any combination thereof used by a person to identify his
2 business, vocation, or occupation and distinguish it from
3 the business, vocation, or occupation of others.

(5) "Person" means any individual, firm, partnership, corporation, association, union, or other organization.

(6) "Applicant" means the person filing an application for registration of a trademark under [sections 1 through 17] or his legal representatives, successors, or assigns.

(7) "Registrant" means the person to whom the registration of a trademark under [sections 1 through 17] is issued or his legal representatives, successors, or assigns.

NEW SECTION. Section 2. When mark considered used in this state. For purposes of [sections 1 through 17], a mark is considered to be used in this state:

(1) 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 and such goods are sold or otherwise distributed in the state; and

(2) on services when it is used or displayed in the sale or advertising of services and the services are rendered in this state.

NEW SECTION. Section 3. Registrability. (1) A mark by which the goods or services of any applicant for registration may be distinguished from the goods or services of others may not be registered if it:

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1 (a) comprises immoral, deceptive, or scandalous
2 matter; or

3 (b) comprises matter which may disparage or falsely
4 suggest a connection with persons, living or dead, or
5 institutions, beliefs, or national symbols or bring them
6 into contempt or disrepute; or

7 (c) comprises the flag or coat of arms or other
8 insignia of the United States, of any state or municipality,
9 or of any foreign nation or any simulation thereof; or

10 (d) comprises the name, signature, or portrait of any
11 living individual, except with his written consent; or

12 (e) comprises a mark that:

13 (i) when applied to the goods or services of the
14 applicant, is merely descriptive or deceptively
15 misdescriptive of them;

16 (ii) when applied to the goods or services of the
17 applicant is primarily geographically descriptive or
18 deceptively misdescriptive of them; or

19 (iii) is primarily merely a surname; or

20 (f) comprises a mark that so resembles a mark
21 registered in this state or a mark or trade name previously
22 used in this state by another and not abandoned as to be
23 likely, when applied to the goods or services of the
24 applicant, to cause confusion or mistake or to deceive.

25 (2) However, nothing in subsection (1)(e) prevents the

1 registration of a mark used in this state by the applicant
2 which has become distinctive of the applicant's goods or
3 services. The secretary of state may accept as evidence that
4 the mark has become distinctive, as applied to the
5 applicant's goods or services, proof of continuous use
6 thereof as a mark by the applicant in this state or
7 elsewhere for the 5 years immediately preceding the date of
8 the filing of the application for registration.

9 NEW SECTION. Section 4. Application for registration.

10 (1) Subject to the limitations set forth in [sections 1
11 through 17], a person who adopts and uses a mark in this
12 state may file in the office of secretary of state, on a
13 form to be furnished by the secretary of state, an
14 application for registration of that mark setting forth
15 information including but not limited to the following:

16 (a) the name and business address of the person
17 applying for such registration and, if a corporation, the
18 state of incorporation;

19 (b) the essential feature of the mark to be
20 registered;

21 (c) the goods or services in connection with which the
22 mark is used and the mode or manner in which the mark is
23 used in connection with such goods or services and the class
24 in which such goods or services fall;

25 (d) the date when the mark was first used anywhere and

1 the date when it was first used in this state by the
2 applicant or his predecessor in business;

3 (e) a statement that the mark is presently in use in
4 this state by the applicant; and

5 (f) a statement that the applicant is the owner of the
6 mark and that no other person has the right to use the mark
7 in this state either in the identical form thereof or in a
8 form that so nearly resembles it that it might be calculated
9 to deceive or might be mistaken for it.

10 (2) The application must be signed and verified by
11 affidavit of the applicant or a member of the firm or an
12 officer of the corporation or association applying.

13 (3) The application must be accompanied by a specimen
14 or facsimile of such mark in duplicate.

15 (4) The application for registration must be
16 accompanied by a filing fee of \$20, payable to the secretary
17 of state.

18 NEW SECTION. Section 5. Filing application and
19 issuing certificate of registration. (1) Duplicate originals
20 of an application for registration of a mark must be
21 delivered to the secretary of state. If the secretary of
22 state finds that the application complies with the
23 requirements of [sections 1 through 17], he shall, when all
24 fees have been paid as prescribed in [sections 1 through
25 17]:

1 (a) endorse on each such duplicate original the words
2 "filed for record" and the month, day, and year of the
3 filing thereof;

4 (b) file one such duplicate original in his office;
5 and

6 (c) issue a certificate of registration to which he
7 shall affix the other duplicate original.

8 (2) The certificate of registration, together with the
9 duplicate original of the application for registration of
10 mark affixed thereto, shall be returned to the applicant.

11 (3) Any certificate of registration issued by the
12 secretary of state under the provisions of this section or a
13 copy thereof duly certified by the secretary of state is
14 admissible in evidence as competent and sufficient proof of
15 the registration of such mark in any judicial proceeding in
16 any court of this state.

17 NEW SECTION. Section 6. Duration and renewal. (1)
18 Registration of a mark under [sections 1 through 17] is
19 effective for a term of 10 years from the date of
20 registration and, upon application filed within 6 months
21 prior to the expiration of such term, the registration may
22 be renewed for another 10 years.

23 (2) An application for renewal of mark registration
24 must be delivered to the secretary of state and shall set
25 forth information including but not limited to the

1 following:

- 2 (a) the name and business address of the applicant;
 3 (b) a description of the mark; and
 4 (c) a statement that the mark is still in use by the
 5 applicant in this state.

6 (3) The application for renewal of mark registration
 7 must be signed and verified by affidavit of the applicant.

8 (4) The application for renewal of mark registration
 9 must be accompanied by a filing fee of \$20, payable to the
 10 secretary of state.

11 NEW SECTION. Section 7. Filing application for
 12 renewal of registration -- issuing certificate of renewal.

13 (1) Duplicate originals of an application for renewal of
 14 mark registration must be delivered to the secretary of
 15 state. If the secretary of state finds that the application
 16 complies with the requirements of [sections 1 through 17],
 17 he shall, when all fees have been paid as prescribed in
 18 [sections 1 through 17]:

19 (a) endorse on each such duplicate original the words
 20 "filed for record" and the month, day, and year of the
 21 filing thereof;

22 (b) file one such duplicate original in his office;
 23 and

24 (c) issue a certificate of registration to which he
 25 shall affix the other duplicate original.

1 (2) The certificate of renewal of registration,
 2 together with the duplicate original of the application for
 3 renewal of registration of the mark affixed thereto, shall
 4 be returned to the applicant.

5 (3) A mark registration may be renewed for successive
 6 periods of 10 years in the manner provided for in
 7 subsections (1) and (2).

8 (4) The secretary of state shall notify registrants of
 9 marks of the necessity of renewal within the year
 10 immediately preceding the expiration of the 10 years from
 11 the date of registration, by writing to the last-known
 12 address of the registrants.

13 (5) Any registration in force on July 1, 1979, expires
 14 10 years from the date of the registration or from the date
 15 of the last renewal thereof or on July 1, 1980, whichever is
 16 later, if renewal of mark registration is not effected in
 17 the manner provided for in [sections 1 through 17].

18 (6) The secretary of state shall, by January 1, 1981,
 19 notify each person who registered a mark prior to July 1,
 20 1980, of the date of expiration of such registration unless
 21 renewed in accordance with the provisions of [sections 1
 22 through 17], by writing to the last-known address of the
 23 registrant.

24 NEW SECTION. Section 8. Assignment. (1) Any mark and
 25 its registration under [sections 1 through 17] may be

1 assigned in conjunction with the good will of the business
 2 in which the mark is used or with that part of the good will
 3 of the business connected with the use of and symbolized by
 4 the mark for the remainder of the term of the current
 5 registration. An assignment of any registration under
 6 [sections 1 through 17] is void as against any subsequent
 7 purchaser for valuable consideration without notice unless
 8 it is recorded with the secretary of state within 3 months
 9 after the date of the assignment or prior to such subsequent
 10 purchase.

11 (2) Duplicate originals of an assignment of a mark
 12 must be delivered to the secretary of state and shall set
 13 forth information including but not limited to the
 14 following:

- 15 (a) the name and address of the assignor;
 - 16 (b) the name and address of the assignee;
 - 17 (c) the registration number of the mark; and
 - 18 (d) the date of registration.
- 19 (3) The assignment of a mark must be signed and
 20 verified by the assignor.
- 21 (4) The assignment of a mark must be accompanied by a
 22 filing fee of \$20, payable to the secretary of state.

23 NEW SECTION. Section 9. Filing of assignment --
 24 issuing certificate of assignment. (1) Duplicate originals
 25 of the assignment of a mark must be delivered to the

1 secretary of state. If the secretary of state finds that the
 2 assignment complies with the requirements of [sections 1
 3 through 17], he shall, when all fees have been paid as
 4 prescribed in [sections 1 through 17]:

- 5 (a) endorse on each such duplicate original the words
 6 "filed for record" and month, day, and year of the filing
 7 thereof;
- 8 (b) file one such duplicate original in his office;
- 9 (c) issue a certificate of assignment to which he
 10 shall affix the other duplicate original.

11 (2) The certificate of assignment, together with the
 12 duplicate original of assignment of a mark affixed thereto,
 13 shall be returned to the assignee.

14 NEW SECTION. Section 10. Records. The secretary of
 15 state shall keep for public examination a record of all
 16 marks registered or renewed under [sections 1 through 17].

17 NEW SECTION. Section 11. Cancellation. The secretary
 18 of state shall cancel from the register:

- 19 (1) after July 1, 1981, each registration made prior
 20 to July 1, 1980, that is more than 10 years old and not
 21 renewed in accordance with [sections 1 through 17];
- 22 (2) any registration concerning which the secretary of
 23 state receives a voluntary request for cancellation from the
 24 registrant or the assignee of record;
- 25 (3) each registration granted under [sections 1

1 through 17] and not renewed in accordance with the
2 provisions of [sections 1 through 17];

3 (4) any registration concerning which a court of
4 competent jurisdiction finds that:

- 5 (a) the registered mark has been abandoned;
- 6 (b) the registrant is not the owner of the mark;
- 7 (c) the registration was granted improperly;
- 8 (d) the registration was obtained fraudulently;
- 9 (e) the registered mark is so similar to a mark
10 currently registered by another person in the United States
11 patent and trademark office prior to the filing date of the
12 application for registration under [sections 1 through 17]
13 as to be likely to cause confusion or mistake or to deceive.
14 However, if the registrant proves that he is the owner of a
15 concurrent registration of his mark in the United States
16 patent and trademark office covering an area including this
17 state, the registration under [sections 1 through 17] may
18 not be canceled.

19 (5) a registration ordered canceled by a court of
20 competent jurisdiction on any grounds.

21 NEW SECTION. Section 12. Classification. (1) The
22 following general classes of goods and services are
23 established for convenience of administration of [sections 1
24 through 17]. This classification does not limit or extend
25 the applicant's or registrant's rights. A single application

1 for registration of a mark may include any or all goods or
2 services comprised in a single class with regard to which
3 the mark is actually being used. However, in no event may a
4 single application include goods or services that fall
5 within different classes of goods or services.

6 (2) The classes of goods are as follows:

- 7 (a) raw or partly prepared materials;
- 8 (b) receptacles;
- 9 (c) baggage, animal equipments, portfolios, and
10 pocketbooks;
- 11 (d) abrasive and polishing materials;
- 12 (e) adhesives;
- 13 (f) chemicals and chemical compositions;
- 14 (g) cordage;
- 15 (h) smokers' articles, not including tobacco products;
- 16 (i) explosives, firearms, equipment, and projectiles;
- 17 (j) fertilizers;
- 18 (k) inks and inking materials;
- 19 (l) construction materials;
- 20 (m) hardware and plumbing and steamfitting supplies;
- 21 (n) metals and metal casting and forgings;
- 22 (o) oils and greases;
- 23 (p) paints and painters' materials;
- 24 (q) tobacco products;
- 25 (r) medicines and pharmaceutical preparations;

1 (s) vehicles;
 2 (t) linoleum and oil cloth;
 3 (u) electrical apparatus, machines, and supplies;
 4 (v) games, toys, and sporting goods;
 5 (w) cutlery, machinery, and tools, and parts thereof;
 6 (x) laundry appliances and machines;
 7 (y) locks and safes;
 8 (z) measuring and scientific appliances;
 9 (aa) horological instruments;
 10 (bb) jewelry and precious metal ware;
 11 (cc) brooms, brushes, and dusters;
 12 (dd) crockery, earthenware, and porcelain;
 13 (ee) filters and refrigerators;
 14 (ff) furniture and upholstery;
 15 (gg) glassware;
 16 (hh) heating, lighting, and ventilating apparatus;
 17 (ii) belting, hose, machinery packing, and nonmetallic
 18 tires;
 19 (jj) musical instruments and supplies;
 20 (kk) paper and stationery;
 21 (ll) prints and publications;
 22 (mm) clothing;
 23 (nn) fancy goods, furnishings, and notions;
 24 (oo) canes, parasols, and umbrellas;
 25 (pp) knitted, netted, and textile fabrics, and

1 substitutes therefor;
 2 (qq) thread and yarn;
 3 (rr) dental, medical, and surgical appliances;
 4 (ss) soft drinks and carbonated waters;
 5 (tt) foods and ingredients of foods;
 6 (uu) wines;
 7 (vv) malt beverages and liquors;
 8 (ww) distilled alcoholic liquors;
 9 (xx) merchandise not otherwise classified;
 10 (yy) cosmetics and toilet preparations;
 11 (zz) detergents and soaps.
 12 (3) The classes of services are as follows:
 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 NEW SECTION. Section 13. Fraudulent registration. Any
 22 person who, for himself or on behalf of any other person,
 23 procures the filing or registration of any mark in the
 24 office of the secretary of state under the provisions of
 25 [sections 1 through 17] by knowingly making any false or

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1 fraudulent representation, verbally or in writing or by any
 2 other fraudulent means, is liable to pay all damages
 3 sustained in consequence of such filing or registration.
 4 Such damages may be recovered by or on behalf of the injured
 5 party in any court of competent jurisdiction.

6 NEW SECTION. Section 14. Infringement. (1) Subject to
 7 the provisions of [section 17], any person is liable in a
 8 civil action brought by the lawful owner of a registered
 9 mark under [section 16] if such person:

10 (a) uses, without the consent of the registrant, any
 11 reproduction, counterfeit, copy, or colorable imitation of a
 12 mark registered under [sections 1 through 17] in connection
 13 with the sale, offering for sale, or advertising of any
 14 goods or services on or in connection with which such use is
 15 likely to cause confusion or mistake or to deceive as to the
 16 source of origin of such goods or services; or

17 (b) reproduces, counterfeits, copies, or colorably
 18 imitates any such mark and applies such reproduction,
 19 counterfeit, copy, or colorable imitation to labels, signs,
 20 prints, packages, wrappers, receptacles, or advertisements
 21 intended to be used upon or in conjunction with the sale or
 22 other distribution in this state of such goods or services.

23 (2) However, the registrant is not entitled to recover
 24 under subsection (1)(b) any profits or damages unless the
 25 acts have been committed with knowledge that such mark is

1 intended to be used to cause confusion or mistake or to
 2 deceive.

3 NEW SECTION. Section 15. Injury to business
 4 reputation -- dilution. Likelihood of injury to business
 5 reputation or of dilution of the distinctive quality of a
 6 mark registered under [sections 1 through 17] or a mark
 7 valid at common law or a trade name valid at common law is
 8 grounds for injunctive relief notwithstanding the absence of
 9 competition between the parties or the absence of confusion
 10 as to the source of goods or services.

11 NEW SECTION. Section 16. Remedies. (1) Any owner of a
 12 mark registered under [sections 1 through 17] may proceed by
 13 suit to enjoin the manufacture, use, display, or sale of any
 14 counterfeits or imitations of the mark. Any court of
 15 competent jurisdiction may grant injunctions to restrain
 16 such manufacture, use, display, or sale as is considered by
 17 the court to be just and reasonable. The court may require
 18 the defendants to pay to such owner all profits derived from
 19 and/or all damages suffered by reason of such wrongful
 20 manufacture, use, display, or sale. The court may also order
 21 that any such counterfeits or imitations in the possession
 22 or under the control of any defendant in such case be
 23 delivered to an officer of the court or to the complainant
 24 to be destroyed.

25 (2) The enumeration in [sections 1 through 17] of any

1 right or remedy does not affect a registrant's right to
2 prosecute under any criminal law of this state.

3 NEW SECTION. Section 17. Common-law rights. Nothing
4 in [sections 1 through 17] adversely affects the rights or
5 the enforcement of rights in marks acquired at common law in
6 good faith at any time.

7 Section 18. Section 2-6-103, MCA, is amended to read:

8 "2-6-103. Filing and copying fees. (1) The secretary
9 of state, for services performed in his office, must charge
10 and collect the following fees:

11 (a) for each copy of any law, resolution, record, or
12 other document or paper on file in his office, except
13 corporate papers, 40 cents per folio or, if the copy is made
14 by any process of reproduction by photographic, photostatic,
15 or similar process, the fee shall be 50 cents per page or
16 fraction thereof;

17 (b) for affixing certificate and seal, \$2;

18 (c) for receiving and recording each official bond,
19 \$10;

20 (d) for each commission or other document signed by
21 the governor and attested by the secretary of state (pardon,
22 military commissions, and extraditions excepted), \$5;

23 ~~(e) for filing each trademark, \$5;~~

24 ~~(f) for filing and recording each assignment of a~~
25 ~~trademark, \$5;~~

1 ~~(g)(e)~~ for issuing each certificate of record, \$5;
2 ~~(h)(f)~~ for filing and recording miscellaneous papers,
3 records, or other documents, \$5;

4 ~~(i)(g)~~ for filing and recording any other paper not
5 otherwise herein provided for, \$5;

6 ~~(j)(h)~~ for filing and recording any paper, record, or
7 other document or other than a standard form when
8 recommended by the secretary of state, \$5;

9 ~~(k)(i)~~ when a copy of any law, resolution, record, or
10 other document or paper on file in the office of the
11 secretary of state is presented for comparison and
12 certification, 10 cents per folio must be charged and
13 collected for proofreading the same.

14 (2) No member of the legislature or state or county
15 officer can be charged for any search relative to matters
16 appertaining to the duties of his office or be charged any
17 fee for a certified copy of any law or resolution passed by
18 the legislature relative to his official duties.

19 (3) Fees must be collected in advance and when
20 collected by the secretary of state must be paid to the
21 state treasurer at the end of each quarter, as provided in
22 the constitution."

23 Section 19. Section 2-15-401, MCA, is amended to read:

24 "2-15-401. Duties of secretary of state. In addition
25 to the duties prescribed by the constitution, it is the duty

1 of the secretary of state to:

2 (1) attend at every session of the legislature for the
3 purpose of receiving bills and resolutions thereof and to
4 perform such other duties as may be devolved upon him by
5 resolution of the two houses or either of them;

6 (2) keep a register of and attest the official acts of
7 the governor;

8 (3) affix the great seal, with his attestation, to
9 commissions, pardons, and other public instruments to which
10 the official signature of the governor is required;

11 (4) record in proper books all conveyances made to the
12 state and all articles of incorporation filed in his office;

13 (5) receive and record in proper books the official
14 bonds of all the state officers and then deliver the
15 originals to the state treasurer;

16 (6) take and file in his office receipts for all books
17 distributed by him and direct the county clerk of each
18 county to do the same;

19 (7) certify to the governor the names of those persons
20 who have received at any election the highest number of
21 votes for any office, the incumbent of which is commissioned
22 by the governor;

23 (8) furnish, on demand, to any person paying the fees
24 therefor, a certified copy of all or any part of any law,
25 record, or other instrument filed, deposited, or recorded in

1 his office;

2 (9) notify in writing the county attorney of the
3 proper county of the failure of any officer in his county to
4 file in his office the sworn statement of fees received by
5 such officer;

6 (10) present to the legislature, at the commencement of
7 each session thereof, a full account of all purchases made
8 and expenses incurred in furnishing fuel, lights, and
9 stationery;

10 (11) keep a fee book in which must be entered all fees,
11 commissions, and compensation of whatever nature or kind by
12 him earned, collected, or charged, with the date, name of
13 payer, paid or unpaid, and the nature of the service in each
14 case, which book must be verified annually by his affidavit
15 entered therein;

16 (12) file in his office descriptions of seals in use by
17 the different state officers and furnish such officers with
18 new seals whenever required;

19 (13) discharge the duties of member of the board of
20 examiners and of the board of land commissioners and all
21 other duties required of him by law;

22 (14) report to the governor, at the time prescribed in
23 2-7-102, a detailed account of all official actions since
24 his previous reports, accompanying the report with a
25 detailed statement, under oath, of the manner in which all

1 appropriations for his office have been expended;

2 (15) ~~receive, designate and record trademarks register~~
3 ~~marks~~ as provided in ~~30-13-103~~ [sections 1 through 17];

4 (16) distribute the bound volumes of the decisions of
5 the supreme court in the manner provided by 3-2-604;

6 (17) report annually to the legislative services
7 division of the legislative council all changes of names
8 received pursuant to 27-31-205 for publication in the
9 session laws;

10 (18) report annually to the legislative services
11 division of the legislative council all watercourse name
12 changes received pursuant to 85-2-134 for publication in the
13 session laws.*

14 Section 20. Savings. This act does not affect any
15 right which matured or proceeding which was commenced prior
16 to July 1, 1980.

17 Section 21. Severability. If a part of this act is
18 invalid, all valid parts that are severable from the invalid
19 part remain in effect. If a part of this act is invalid in
20 one or more of its applications, the part remains in effect
21 in all valid applications that are severable from the
22 invalid applications.

23 Section 22. Repealer. Sections 30-13-101 through
24 30-13-107, MCA, are repealed.

25 Section 23. Effective date. This act is effective on

1 July 1, 1980.

-End-

58511

1 SENATE BILL NO. 511
 2 INTRODUCED BY TURNAGE, McCALLUM
 3
 4 A BILL FOR AN ACT ENTITLED: "AN ACT TO PROVIDE FOR THE
 5 REGISTRATION AND PROTECTION OF TRADEMARKS AND SERVICE MARKS;
 6 TO PROVIDE FOR RENEWAL AND ASSIGNMENT OF SUCH MARKS;
 7 AMENDING SECTIONS 2-6-103 AND 2-15-401, MCA; REPEALING
 8 SECTIONS 30-13-101 THROUGH 30-13-107; AND PROVIDING AN
 9 EFFECTIVE DATE."

10
 11 BE IT ENACTED BY THE LEGISLATURE OF THE STATE OF MONTANA:
 12 NEW SECTION. SECTION 1. Definitions. In [sections 1
 13 through 17], unless the context requires otherwise, the
 14 following definitions apply:

15 (1) "Trademark" means any word, name, symbol, device,
 16 or any combination thereof adopted and used by a person to
 17 identify goods made or sold by him and to distinguish them
 18 from goods made or sold by others.

19 (2) "Service mark" means a mark used in the sale or
 20 advertising of services to identify the services of one
 21 person and distinguish them from the services of others.

22 (3) "Mark" means any trademark or service mark
 23 entitled to registration under [sections 1 through 17]
 24 whether registered or not.

25 (4) "Trade name" means a word, name, symbol, device,

1 or any combination thereof used by a person to identify his
 2 business, vocation, or occupation and distinguish it from
 3 the business, vocation, or occupation of others.

4 (5) "Person" means any individual, firm, partnership,
 5 corporation, association, union, or other organization.

6 (6) "Applicant" means the person filing an application
 7 for registration of a trademark under [sections 1 through
 8 17] or his legal representatives, successors, or assigns.

9 (7) "Registrant" means the person to whom the
 10 registration of a trademark under [sections 1 through 17] is
 11 issued or his legal representatives, successors, or assigns.

12 NEW SECTION. Section 2. When mark considered used in
 13 this state. For purposes of [sections 1 through 17], a mark
 14 is considered to be used in this state:

15 (1) on goods when it is placed in any manner on the
 16 goods or their containers or the displays associated
 17 therewith or on the tags or labels affixed thereto and such
 18 goods are sold or otherwise distributed in the state; and

19 (2) on services when it is used or displayed in the
 20 sale or advertising of services and the services are
 21 rendered in this state.

22 NEW SECTION. Section 3. Registrability. (1) A mark by
 23 which the goods or services of any applicant for
 24 registration may be distinguished from the goods or services
 25 of others may not be registered if it:

1 (a) comprises immoral, deceptive, or scandalous
2 matter; or

3 (b) comprises matter which may disparage or falsely
4 suggest a connection with persons, living or dead, or
5 institutions, beliefs, or national symbols or bring them
6 into contempt or disrepute; or

7 (c) comprises the flag or coat of arms or other
8 insignia of the United States, of any state or municipality,
9 or of any foreign nation or any simulation thereof; or

10 (d) comprises the name, signature, or portrait of any
11 living individual, except with his written consent; or

12 (e) comprises a mark that:

13 (i) when applied to the goods or services of the
14 applicant, is merely descriptive or deceptively
15 misdescriptive of them;

16 (ii) when applied to the goods or services of the
17 applicant is primarily geographically descriptive or
18 deceptively misdescriptive of them; or

19 (iii) is primarily merely a surname; or

20 (f) comprises a mark that so resembles a mark
21 registered in this state or a mark or trade name previously
22 used in this state by another and not abandoned as to be
23 likely, when applied to the goods or services of the
24 applicant, to cause confusion or mistake or to deceive.

25 (2) However, nothing in subsection (1)(e) prevents the

1 registration of a mark used in this state by the applicant
2 which has become distinctive of the applicant's goods or
3 services. The secretary of state may accept as evidence that
4 the mark has become distinctive, as applied to the
5 applicant's goods or services, proof of continuous use
6 thereof as a mark by the applicant in this state or
7 elsewhere for the 5 years immediately preceding the date of
8 the filing of the application for registration.

9 NEW SECTION. Section 4. Application for registration.

10 (1) Subject to the limitations set forth in [sections 1
11 through 17], a person who adopts and uses a mark in this
12 state may file in the office of secretary of state, on a
13 form to be furnished by the secretary of state, an
14 application for registration of that mark setting forth
15 information including but not limited to the following:

16 (a) the name and business address of the person
17 applying for such registration and, if a corporation, the
18 state of incorporation;

19 (b) the essential feature of the mark to be
20 registered;

21 (c) the goods or services in connection with which the
22 mark is used and the mode or manner in which the mark is
23 used in connection with such goods or services and the class
24 in which such goods or services fall;

25 (d) the date when the mark was first used anywhere and

1 the date when it was first used in this state by the
2 applicant or his predecessor in business;

3 (e) a statement that the mark is presently in use in
4 this state by the applicant; and

5 (f) a statement that the applicant is the owner of the
6 mark and that no other person has the right to use the mark
7 in this state either in the identical form thereof or in a
8 form that so nearly resembles it that it might be calculated
9 to deceive or might be mistaken for it.

10 (2) The application must be signed and verified by
11 affidavit of the applicant or a member of the firm or an
12 officer of the corporation or association applying.

13 (3) The application must be accompanied by a specimen
14 or facsimile of such mark in duplicate.

15 (4) The application for registration must be
16 accompanied by a filing fee of \$20, payable to the secretary
17 of state.

18 NEW SECTION. Section 5. Filing application and
19 issuing certificate of registration. (1) Duplicate originals
20 of an application for registration of a mark must be
21 delivered to the secretary of state. If the secretary of
22 state finds that the application complies with the
23 requirements of [sections 1 through 17], he shall, when all
24 fees have been paid as prescribed in [sections 1 through
25 17]:

1 (a) endorse on each such duplicate original the words
2 "filed for record" and the month, day, and year of the
3 filing thereof;

4 (b) file one such duplicate original in his office;
5 and

6 (c) issue a certificate of registration to which he
7 shall affix the other duplicate original.

8 (2) The certificate of registration, together with the
9 duplicate original of the application for registration of
10 mark affixed thereto, shall be returned to the applicant.

11 (3) Any certificate of registration issued by the
12 secretary of state under the provisions of this section or a
13 copy thereof duly certified by the secretary of state is
14 admissible in evidence as competent and sufficient proof of
15 the registration of such mark in any judicial proceeding in
16 any court of this state.

17 NEW SECTION. Section 6. Duration and renewal. (1)
18 Registration of a mark under [sections 1 through 17] is
19 effective for a term of 10 years from the date of
20 registration and, upon application filed within 6 months
21 prior to the expiration of such term, the registration may
22 be renewed for another 10 years.

23 (2) An application for renewal of mark registration
24 must be delivered to the secretary of state and shall set
25 forth information including but not limited to the

1 following:

- 2 (a) the name and business address of the applicant;
- 3 (b) a description of the mark; and
- 4 (c) a statement that the mark is still in use by the
5 applicant in this state.
- 6 (3) The application for renewal of mark registration
7 must be signed and verified by affidavit of the applicant.
- 8 (4) The application for renewal of mark registration
9 must be accompanied by a filing fee of \$20, payable to the
10 secretary of state.

11 NEW SECTION. Section 7. Filing application for
12 renewal of registration -- Issuing certificate of renewal.

13 (1) Duplicate originals of an application for renewal of
14 mark registration must be delivered to the secretary of
15 state. If the secretary of state finds that the application
16 complies with the requirements of [sections 1 through 17],
17 he shall, when all fees have been paid as prescribed in
18 [sections 1 through 17]:

- 19 (a) endorse on each such duplicate original the words
20 "filed for record" and the month, day, and year of the
21 filing thereof;
- 22 (b) file one such duplicate original in his office;
23 and
- 24 (c) issue a certificate of registration to which he
25 shall affix the other duplicate original.

1 (2) The certificate of renewal of registration,
2 together with the duplicate original of the application for
3 renewal of registration of the mark affixed thereto, shall
4 be returned to the applicant.

5 (3) A mark registration may be renewed for successive
6 periods of 10 years in the manner provided for in
7 subsections (1) and (2).

8 (4) The secretary of state shall notify registrants of
9 marks of the necessity of renewal within the year
10 immediately preceding the expiration of the 10 years from
11 the date of registration, by writing to the last-known
12 address of the registrants.

13 (5) Any registration in force on July 1, 1979, expires
14 10 years from the date of the registration or from the date
15 of the last renewal thereof or on July 1, 1980, whichever is
16 later, if renewal of mark registration is not effected in
17 the manner provided for in [sections 1 through 17].

18 (6) The secretary of state shall, by January 1, 1981,
19 notify each person who registered a mark prior to July 1,
20 1980, of the date of expiration of such registration unless
21 renewed in accordance with the provisions of [sections 1
22 through 17], by writing to the last-known address of the
23 registrant.

24 NEW SECTION. Section 8. Assignment. (1) Any mark and
25 its registration under [sections 1 through 17] may be

1 assigned in conjunction with the good will of the business
 2 in which the mark is used or with that part of the good will
 3 of the business connected with the use of and symbolized by
 4 the mark for the remainder of the term of the current
 5 registration. An assignment of any registration under
 6 [sections 1 through 17] is void as against any subsequent
 7 purchaser for valuable consideration without notice unless
 8 it is recorded with the secretary of state within 3 months
 9 after the date of the assignment or prior to such subsequent
 10 purchase.

11 (2) Duplicate originals of an assignment of a mark
 12 must be delivered to the secretary of state and shall set
 13 forth information including but not limited to the
 14 following:

- 15 (a) the name and address of the assignor;
 - 16 (b) the name and address of the assignee;
 - 17 (c) the registration number of the mark; and
 - 18 (d) the date of registration.
- 19 (3) The assignment of a mark must be signed and
 20 verified by the assignor.

21 (4) The assignment of a mark must be accompanied by a
 22 filing fee of \$20, payable to the secretary of state.

23 **NEW_SECTION.** Section 9. Filing of assignment --
 24 issuing certificate of assignment. (1) Duplicate originals
 25 of the assignment of a mark must be delivered to the

1 secretary of state. If the secretary of state finds that the
 2 assignment complies with the requirements of [sections 1
 3 through 17], he shall, when all fees have been paid as
 4 prescribed in [sections 1 through 17]:

5 (a) endorse on each such duplicate original the words
 6 "filed for record" and month, day, and year of the filing
 7 thereof;

8 (b) file one such duplicate original in his office;

9 (c) issue a certificate of assignment to which he
 10 shall affix the other duplicate original.

11 (2) The certificate of assignment, together with the
 12 duplicate original of assignment of a mark affixed thereto,
 13 shall be returned to the assignee.

14 **NEW_SECTION.** Section 10. Records. The secretary of
 15 state shall keep for public examination a record of all
 16 marks registered or renewed under [sections 1 through 17].

17 **NEW_SECTION.** Section 11. Cancellation. The secretary
 18 of state shall cancel from the register:

19 (1) after July 1, 1981, each registration made prior
 20 to July 1, 1980, that is more than 10 years old and not
 21 renewed in accordance with [sections 1 through 17];

22 (2) any registration concerning which the secretary of
 23 state receives a voluntary request for cancellation from the
 24 registrant or the assignee of record;

25 (3) each registration granted under [sections 1

1 through 17] and not renewed in accordance with the
2 provisions of [sections 1 through 17];

3 (4) any registration concerning which a court of
4 competent jurisdiction finds that:

- 5 (a) the registered mark has been abandoned;
- 6 (b) the registrant is not the owner of the mark;
- 7 (c) the registration was granted improperly;
- 8 (d) the registration was obtained fraudulently;
- 9 (e) the registered mark is so similar to a mark
10 currently registered by another person in the United States
11 patent and trademark office prior to the filing date of the
12 application for registration under [sections 1 through 17]
13 as to be likely to cause confusion or mistake or to deceive.
14 However, if the registrant proves that he is the owner of a
15 concurrent registration of his mark in the United States
16 patent and trademark office covering an area including this
17 state, the registration under [sections 1 through 17] may
18 not be canceled.

19 (5) a registration ordered canceled by a court of
20 competent jurisdiction on any grounds.

21 NEW SECTION. Section 12. Classification. (1) The
22 following general classes of goods and services are
23 established for convenience of administration of [sections 1
24 through 17]. This classification does not limit or extend
25 the applicant's or registrant's rights. A single application

1 for registration of a mark may include any or all goods or
2 services comprised in a single class with regard to which
3 the mark is actually being used. However, in no event may a
4 single application include goods or services that fall
5 within different classes of goods or services.

6 (2) The classes of goods are as follows:

- 7 (a) raw or partly prepared materials;
- 8 (b) receptacles;
- 9 (c) baggage, animal equipments, portfolios, and
10 pocketbooks;
- 11 (d) abrasive and polishing materials;
- 12 (e) adhesives;
- 13 (f) chemicals and chemical compositions;
- 14 (g) cordage;
- 15 (h) smokers' articles, not including tobacco products;
- 16 (i) explosives, firearms, equipment, and projectiles;
- 17 (j) fertilizers;
- 18 (k) inks and inking materials;
- 19 (l) construction materials;
- 20 (m) hardware and plumbing and steamfitting supplies;
- 21 (n) metals and metal casting and forgings;
- 22 (o) oils and greases;
- 23 (p) paints and painters' materials;
- 24 (q) tobacco products;
- 25 (r) medicines and pharmaceutical preparations;

1 (s) vehicles;
 2 (t) linoleum and oil cloth;
 3 (u) electrical apparatus, machines, and supplies;
 4 (v) games, toys, and sporting goods;
 5 (w) cutlery, machinery, and tools, and parts thereof;
 6 (x) laundry appliances and machines;
 7 (y) locks and safes;
 8 (z) measuring and scientific appliances;
 9 (aa) horological instruments;
 10 (bb) jewelry and precious metal ware;
 11 (cc) brooms, brushes, and dusters;
 12 (dd) crockery, earthenware, and porcelain;
 13 (ee) filters and refrigerators;
 14 (ff) furniture and upholstery;
 15 (gg) glassware;
 16 (hh) heating, lighting, and ventilating apparatus;
 17 (ii) belting, hose, machinery packing, and nonmetallic
 18 tires;
 19 (jj) musical instruments and supplies;
 20 (kk) paper and stationery;
 21 (ll) prints and publications;
 22 (mm) clothing;
 23 (nn) fancy goods, furnishings, and notions;
 24 (oo) canes, parasols, and umbrellas;
 25 (pp) knitted, netted, and textile fabrics, and

1 substitutes therefor;
 2 (qq) thread and yarn;
 3 (rr) dental, medical, and surgical appliances;
 4 (ss) soft drinks and carbonated waters;
 5 (tt) foods and ingredients of foods;
 6 (uu) wines;
 7 (vv) malt beverages and liquors;
 8 (ww) distilled alcoholic liquors;
 9 (xx) merchandise not otherwise classified;
 10 (yy) cosmetics and toilet preparations;
 11 (zz) detergents and soaps.
 12 (3) The classes of services are as follows:
 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 NEW SECTION. Section 13. Fraudulent registration. Any
 22 person who, for himself or on behalf of any other person,
 23 procures the filing or registration of any mark in the
 24 office of the secretary of state under the provisions of
 25 [sections 1 through 17] by knowingly making any false or

1 fraudulent representation, verbally or in writing or by any
 2 other fraudulent means, is liable to pay all damages
 3 sustained in consequence of such filing or registration.
 4 Such damages may be recovered by or on behalf of the injured
 5 party in any court of competent jurisdiction.

6 **NEW_SECTION.** Section 14. Infringement. (1) Subject to
 7 the provisions of [section 17], any person is liable in a
 8 civil action brought by the lawful owner of a registered
 9 mark under [section 16] if such person:

10 (a) uses, without the consent of the registrant, any
 11 reproduction, counterfeit, copy, or colorable imitation of a
 12 mark registered under [sections 1 through 17] in connection
 13 with the sale, offering for sale, or advertising of any
 14 goods or services on or in connection with which such use is
 15 likely to cause confusion or mistake or to deceive as to the
 16 source of origin of such goods or services; or

17 (b) reproduces, counterfeits, copies, or colorably
 18 imitates any such mark and applies such reproduction,
 19 counterfeit, copy, or colorable imitation to labels, signs,
 20 prints, packages, wrappers, receptacles, or advertisements
 21 intended to be used upon or in conjunction with the sale or
 22 other distribution in this state of such goods or services.

23 (2) However, the registrant is not entitled to recover
 24 under subsection (1)(b) any profits or damages unless the
 25 acts have been committed with knowledge that such mark is

1 intended to be used to cause confusion or mistake or to
 2 deceive.

3 **NEW_SECTION.** Section 15. Injury to business
 4 reputation -- dilution. Likelihood of injury to business
 5 reputation or of dilution of the distinctive quality of a
 6 mark registered under [sections 1 through 17] or a mark
 7 valid at common law or a trade name valid at common law is
 8 grounds for injunctive relief notwithstanding the absence of
 9 competition between the parties or the absence of confusion
 10 as to the source of goods or services.

11 **NEW_SECTION.** Section 16. Remedies. (1) Any owner of a
 12 mark registered under [sections 1 through 17] may proceed by
 13 suit to enjoin the manufacture, use, display, or sale of any
 14 counterfeits or imitations of the mark. Any court of
 15 competent jurisdiction may grant injunctions to restrain
 16 such manufacture, use, display, or sale as is considered by
 17 the court to be just and reasonable. The court may require
 18 the defendants to pay to such owner all profits derived from
 19 and/or all damages suffered by reason of such wrongful
 20 manufacture, use, display, or sale. The court may also order
 21 that any such counterfeits or imitations in the possession
 22 or under the control of any defendant in such case be
 23 delivered to an officer of the court or to the complainant
 24 to be destroyed.

25 (2) The enumeration in [sections 1 through 17] of any

1 right or remedy does not affect a registrant's right to
2 prosecute under any criminal law of this state.

3 ~~NEW SECTION.~~ Section 17. Common-law rights. Nothing
4 in [sections 1 through 17] adversely affects the rights or
5 the enforcement of rights in marks acquired at common law in
6 good faith at any time.

7 Section 18. Section 2-6-103, MCA, is amended to read:
8 "2-6-103. Filing and copying fees. (1) The secretary
9 of state, for services performed in his office, must charge
10 and collect the following fees:

11 (a) for each copy of any law, resolution, record, or
12 other document or paper on file in his office, except
13 corporate papers, 40 cents per folio or, if the copy is made
14 by any process of reproduction by photographic, photostatic,
15 or similar process, the fee shall be 50 cents per page or
16 fraction thereof;

17 (b) for affixing certificate and seal, \$2;

18 (c) for receiving and recording each official bond,
19 \$10;

20 (d) for each commission or other document signed by
21 the governor and attested by the secretary of state (pardon,
22 military commissions, and extraditions excepted), \$5;

23 ~~(e) for filing each trademark, \$5;~~

24 ~~(f) for filing and recording each assignment of a~~
25 ~~trademark, \$5;~~

1 ~~(g)(1)~~ for issuing each certificate of record, \$5;

2 ~~(h)(1)~~ for filing and recording miscellaneous papers,
3 records, or other documents, \$5;

4 ~~(i)(1)~~ for filing and recording any other paper not
5 otherwise herein provided for, \$5;

6 ~~(j)(1)~~ for filing and recording any paper, records, or
7 other document or other than a standard form when
8 recommended by the secretary of state, \$5;

9 ~~(k)(1)~~ when a copy of any law, resolution, record, or
10 other document or paper on file in the office of the
11 secretary of state is presented for comparison and
12 certification, 10 cents per folio must be charged and
13 collected for proofreading the same.

14 (2) No member of the legislature or state or county
15 officer can be charged for any search relative to matters
16 appertaining to the duties of his office or be charged any
17 fee for a certified copy of any law or resolution passed by
18 the legislature relative to his official duties.

19 (3) Fees must be collected in advance and when
20 collected by the secretary of state must be paid to the
21 state treasurer at the end of each quarter, as provided in
22 the constitution."

23 Section 19. Section 2-15-401, MCA, is amended to read:

24 "2-15-401. Duties of secretary of state. In addition
25 to the duties prescribed by the constitution, it is the duty

1 of the secretary of state to:

2 (1) attend at every session of the legislature for the
3 purpose of receiving bills and resolutions thereof and to
4 perform such other duties as may be devolved upon him by
5 resolution of the two houses or either of them;

6 (2) keep a register of and attest the official acts of
7 the governor;

8 (3) affix the great seal, with his attestation, to
9 commissions, pardons, and other public instruments to which
10 the official signature of the governor is required;

11 (4) record in proper books all conveyances made to the
12 state and all articles of incorporation filed in his office;

13 (5) receive and record in proper books the official
14 bonds of all the state officers and then deliver the
15 originals to the state treasurer;

16 (6) take and file in his office receipts for all books
17 distributed by him and direct the county clerk of each
18 county to do the same;

19 (7) certify to the governor the names of those persons
20 who have received at any election the highest number of
21 votes for any office, the incumbent of which is commissioned
22 by the governor;

23 (8) furnish, on demand, to any person paying the fees
24 therefor, a certified copy of all or any part of any law,
25 record, or other instrument filed, deposited, or recorded in

1 his office;

2 (9) notify in writing the county attorney of the
3 proper county of the failure of any officer in his county to
4 file in his office the sworn statement of fees received by
5 such officer;

6 (10) present to the legislature, at the commencement of
7 each session thereof, a full account of all purchases made
8 and expenses incurred in furnishing fuel, lights, and
9 stationery;

10 (11) keep a fee book in which must be entered all fees,
11 commissions, and compensation of whatever nature or kind by
12 him earned, collected, or charged, with the date, name of
13 payer, paid or unpaid, and the nature of the service in each
14 case, which book must be verified annually by his affidavit
15 entered therein;

16 (12) file in his office descriptions of seals in use by
17 the different state officers and furnish such officers with
18 new seals whenever required;

19 (13) discharge the duties of member of the board of
20 examiners and of the board of land commissioners and all
21 other duties required of him by law;

22 (14) report to the governor, at the time prescribed in
23 2-7-102, a detailed account of all official actions since
24 his previous reports, accompanying the report with a
25 detailed statement, under oath, of the manner in which all

1 appropriations for his office have been expended;

1 July 1, 1980.

2 (15) ~~receiver-designate-and-record-trademarks register~~
3 marks as provided in ~~30-13-103~~ [sections 1 through 17];

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4 (16) distribute the bound volumes of the decisions of
5 the supreme court in the manner provided by 3-2-604;

6 (17) report annually to the legislative services
7 division of the legislative council all changes of names
8 received pursuant to 27-31-205 for publication in the
9 session laws;

10 (18) report annually to the legislative services
11 division of the legislative council all watercourse name
12 changes received pursuant to 85-2-134 for publication in the
13 session laws."

14 Section 20. Savings. This act does not affect any
15 right which matured or proceeding which was commenced prior
16 to July 1, 1980.

17 Section 21. Severability. If a part of this act is
18 invalid, all valid parts that are severable from the invalid
19 part remain in effect. If a part of this act is invalid in
20 one or more of its applications, the part remains in effect
21 in all valid applications that are severable from the
22 invalid applications.

23 Section 22. Repealer. Sections 30-13-101 through
24 30-13-107, MCA, are repealed.

25 Section 23. Effective date. This act is effective on