

AN ACT

To amend sections 1329.54, 1329.55, 1329.56, 1329.57, 1329.58, 1329.62, 1329.63, and 1329.67 of the Revised Code to revise the definitions of trademark and service mark in the Ohio Trademark Law, to modify the procedures for registering a trademark or service mark, and to make other changes to the Ohio Trademark Law.

Be it enacted by the General Assembly of the State of Ohio:

SECTION 1. That sections 1329.54, 1329.55, 1329.56, 1329.57, 1329.58, 1329.62, 1329.63, and 1329.67 of the Revised Code be amended to read as follows:

Sec. 1329.54. As used in sections 1329.54 to 1329.67 of the Revised Code:

(A) "Trademark" means any word, name, symbol, ~~or~~ device, ~~or any combination thereof of any word, name, symbol, or device, that is~~ adopted and used by a person to identify ~~goods made or sold by him, and to distinguish them from the goods made or sold by others of that person, including a unique product, from the goods of other persons, and to indicate the source of the goods, even if that source is unknown.~~

(B) "Service mark" means any word, name, symbol, device, or combination of any word, name, symbol, or device, that is adopted and used by a person to identify and distinguish the services of that person, including a unique service, from the services of other persons and to indicate the source of the services, even if that source is unknown. "Service mark" includes titles, character names used by a person, and other distinctive features of radio or television programs even if a radio or television program or a title, character name, or other distinctive feature of a radio or television program advertises the goods of the sponsor of that radio or television program.

(C) "Mark" means any trademark or service mark that is entitled to registration under sections 1329.54 to 1329.67 Of the Revised Code whether or not it is registered.

(D) "Person" means any individual, firm, partnership, limited liability

partnership, limited liability company, corporation, association, union of working men, or other organization that is capable of suing or being sued in a court of record in this state.

~~(C)~~(E) "Applicant" ~~includes~~ means the person filing an application for registration of a ~~trademark or service~~ mark under sections 1329.54 to 1329.67 of the Revised Code and ~~his~~ the person's legal representatives, successors, or assigns.

~~(D)~~(F) "Registrant" ~~includes~~ means the person to whom the registration of a ~~trademark or service~~ mark is issued; under sections 1329.54 to 1329.67 of the Revised Code and ~~his~~ the person's legal representatives, successors, or assigns.

~~(E)~~(G) "Use" means the bona fide use of a mark in the ordinary course of trade and not the making use of a mark merely to reserve a right in a mark.

(H) A trademark shall be considered "used" in this state when it either of the following applies:

(1) The trademark is placed in any manner on the goods or their containers or, on displays associated with goods or their containers, or on the tags or labels affixed to the goods or their containers, and the goods are sold or transported in commerce in this state.

(2) If the nature of goods makes the types of placement described in division (H)(1) of this section impracticable, the trademark is placed in any manner on documents associated with the goods or the sale of the goods, and the goods are sold or otherwise distributed transported in commerce in this state.

~~(F) "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 and includes without limitation the marks, names, symbols, titles, designations, slogans, character names, and distinctive features of radio or other advertising used in commerce.~~

~~(G)~~(I) A service mark shall be considered "used" in this state when ~~it~~ both of the following apply:

(1) The service mark is used to identify the services of one person and to distinguish them from the services of others and the other persons.

(2) The services of that person are sold or otherwise rendered in this state.

(J) A mark shall be considered "abandoned" when either of the following occurs:

(1) Its use has been discontinued with the intent not to resume that use. An "intent not to resume that use" may be inferred from the circumstances,

and nonuse of a mark for three consecutive years constitutes prima-facie evidence of that intent.

(2) Any course of conduct by the owner of the mark, including actions and omissions, causes the mark to lose its significance as a mark.

Sec. 1329.55. A trademark or service mark by which the goods or services of any applicant for registration may be distinguished from the goods or services of ~~others~~ other persons shall not be registered if it consists of or comprises ~~any~~ one or more of the following:

(A) Immoral, deceptive, or scandalous matter;

(B) Matter ~~which~~ that may disparage or falsely suggest a connection with ~~persons~~; living or dead persons, institutions, beliefs, or national symbols; or bring them into contempt or disrepute;

(C) The flag ~~or~~, coat of arms, or other insignia of the United States, ~~or~~ of any state or municipality, or of any foreign nation; or any simulation ~~thereof~~ of a flag, coat of arms, or other insignia of those natures;

(D) The name, signature, or portrait of any living individual, except with the individual's written consent;

(E) ~~A~~ (1) Except as provided in divisions (E)(2) and (3) of this section, a mark to which any of the following applies:

~~(1)(a)~~ When applied to used on or in connection with the goods or services of the applicant, the mark is merely descriptive or deceptively misdescriptive of ~~them~~; those goods or services.

~~(2)(b)~~ When applied to used on or in connection with the goods or services of the applicant, the mark is primarily geographically descriptive or deceptively misdescriptive of ~~them~~; those goods or services.

~~(3) Is (c)~~ The mark is primarily merely a surname; ~~provided, that nothing in division.~~

(2) Division (E) of this section shall does not prevent the registration of a mark used in this state by the applicant which if that mark has become distinctive of the applicant's goods or services. The secretary of state may accept as evidence that the mark has become distinctive, as applied to used on or in connection with the applicant's goods or services, proof of substantially exclusive and continuous use thereof of the mark as a mark by the applicant in this state or elsewhere for the five years next preceding the date of the filing of the application for registration.

(3) Division (E)(1) of this section does not prevent the registration of a mark that, when used on or in connection with the goods or services of the applicant, is primarily geographically deceptively misdescriptive of the goods or services if the mark became distinctive of the applicant's goods or services in commerce prior to December 8, 1993, the date of enactment of

the "North American Free Trade Agreement Implementation Act," 107 Stat. 2057 (1993), 19 U.S.C. 3301 ET SEQ.

(F) A trademark or service mark ~~which~~ that so resembles a trademark or service mark registered in this state or a trademark, or service mark, ~~corporate name, limited liability company name, limited liability partnership name, limited partnership name, or trade name~~ previously used in this state by another person and not abandoned by that person, as likely, when ~~applied to~~ used on or in connection with the goods or services of the applicant, to cause confusion or mistake or to deceive;

(G) ~~A~~ (1) Except as provided in division (G)(2) of this section, a trademark or service mark ~~which~~ that so resembles a trademark or service mark registered in the United States patent and trademark office by another person and not abandoned by that person, or a trademark or service mark that is the subject of a pending intent to use application filed in the United States patent and trademark office by another person, as to be likely, when ~~applied to~~ used on or in connection with the goods or services of the applicant, to cause confusion or mistake or to deceive; ~~provided, that should.~~

(2) If the applicant prove ~~proves~~ proves that the applicant is the owner of a concurrent registration in the United States patent and trademark office of the applicant's trademark or service mark covering an area including this state, the applicant may register the applicant's trademark or service mark in accordance with ~~this section~~ sections 1329.54 to 1329.67 Of the Revised Code.

Sec. 1329.56. (A) Subject to the limitations set forth in sections 1329.54 to 1329.67 of the Revised Code, any person who adopts and uses a trademark or service mark in this state may file in the office of the secretary of state, on a form to be prescribed by the secretary of state, an application for registration of that trademark or service mark ~~setting~~ that sets forth, but is not limited to, the following information:

~~(A)~~(1) The name and business address of the person applying for the registration; ~~and,~~ if the person is a corporation, the state of its incorporation; if the person is a partnership or limited liability partnership, the state in which the partnership is organized and the names of the general partners; and, if the person is a limited liability company, the state of its organization;

~~(B)~~(2) The goods or services on or in connection with which the mark is used ~~and,~~ the mode or manner in which the mark is used on or in connection with the goods or services, and the class in which the goods or services fall;

~~(C)~~(3) The date when the ~~trademark or service~~ mark was first used anywhere and the date when it was first used in this state by the applicant or the applicant's predecessor in business interest;

~~(D)~~(4) A statement that the applicant is the owner of the ~~trademark or service mark~~, that the mark is in use, and that, to the knowledge of the person verifying the application, no other person has the right to use the ~~trademark or service mark~~ in the state either in the identical form ~~thereof~~ of the mark, or in ~~such~~ near resemblance ~~thereto~~ to the mark, as ~~might be calculated to deceive or be mistaken therefor~~ to be likely, when used on or in connection with the goods or services of another person, to cause confusion or mistake or to deceive;

~~(E)~~(5) A statement that, to the knowledge of the person verifying the application, no other person has a registration or a pending intent to use application of the same or a confusingly similar ~~trademark or service mark~~ in the United States patent and trademark office for the same or similar goods or services or a statement that the applicant is the owner of a concurrent registration in the United States patent and trademark office of the applicant's ~~trademark or service mark~~ covering an area including this state.

(B) The application shall be signed and verified by the applicant, by an authorized representative, OR BY AN OFFICER of the firm, limited liability company, limited liability partnership, general partnership, or limited partnership, ~~or by an officer of the corporation, union, or association applying, or other organization that is the applicant.~~

(C) The application shall be accompanied by a specimen of the ~~trademark or service mark~~ as actually used and shall contain a brief description of the ~~trademark or service mark~~ as it appears on the specimen.

(D) The application ~~for registration~~ shall be accompanied by a filing fee of twenty dollars; that is payable to the secretary of state.

Sec. 1329.57. Upon compliance by the applicant with the requirements of sections 1329.54 to 1329.67 of the Revised Code, the secretary of state shall cause a certificate of registration to be issued and delivered to the applicant. The certificate of registration shall be issued under the signature ~~of the secretary of state~~ and the seal of the secretary of state, and it shall show the name and business address and, if a corporation, the state of incorporation, or, if a partnership or limited liability partnership, the state in which the partnership is organized and the names of the general partners, or, if a limited liability company, the state of organization, of the person claiming ownership of the trademark or service mark, the date claimed for the first use of the trademark or service mark anywhere and, the date claimed for the first use of the trademark or service mark in Ohio this state, the class of goods or services and the description of the goods or services on or in connection with which the trademark or service mark is used, the

tration date, and the term of the registration. One specimen or facsimile of the trademark or service mark supplied under section 1329.56 of the Revised Code shall be attached to and made a part of the certificate of registration.

Any certificate of registration issued by the secretary of state or a copy of the certificate duly certified by the secretary of state shall be admissible in evidence in any action or proceeding in any court of record in this state as competent and sufficient proof of the registration of the trademark or service mark ~~in any action or judicial proceedings in any court of Ohio.~~

Sec. 1329.58. Registration of a trademark or service mark under sections 1329.54 to 1329.67 of the Revised Code shall be effective for a term of ten years from the date of registration ~~and, upon~~. Upon the filing of an application filed within six months prior to the expiration of ~~such that~~ term; on a form furnished by the secretary of state, the registrant may renew the registration ~~may be renewed~~ at the end of each ten-year period for a like similar term. A renewal fee of ten dollars; that is payable to the secretary of state; shall accompany the renewal application ~~for renewal of the registration~~. The renewal application shall require the applicant to state that the mark still is in use in this state.

~~The secretary of state shall notify the registrants of trademarks or service marks of the necessity of renewal within the year next preceding the expiration of the ten years from the date of registration by writing to the last known address of the registrants.~~

Sec. 1329.62. The secretary of state shall cancel from the register the following types of registrations:

(A) Any registration ~~that~~ the secretary of state receives a voluntary request in writing, on a form prescribed by the secretary of state, for cancellation of the registration from the registrant or the assignee of record;

(B) Any registration that is granted under sections 1329.54 to 1329.67 of the Revised Code; and that is not renewed in accordance with ~~the provisions thereof~~ those sections;

(C) Any registration ~~that the secretary of state~~ CONCERNING WHICH A COURT OF COMPETENT JURISDICTION finds either of the following applies:

(1) The registration was granted improperly;

(2) A trademark or service mark is or has become the generic name for the goods or services, or a portion of the goods or services, for which the mark is or has been registered.

(D) Any registration ordered canceled by a court of competent jurisdiction on any ground.

Sec. 1329.63. The secretary of state shall establish for convenience of administration a classification of goods or services that is in conformity with the classification established by the commissioner of patents and trademarks under 15 U.S.C. 1112, ~~for convenience of administration,~~ but that does not limit or extend the applicant's or registrant's rights. A single application for registration of a ~~trade-mark~~ trademark or service mark may include any or all goods and services comprised in a single class ~~upon~~ on or in connection with which the ~~trade-mark~~ trademark or service mark is actually being used, but ~~in no event shall~~ a single application shall not include goods or services ~~which that~~ fall within different classes ~~upon~~ on or in connection with which the ~~trade-mark~~ trademark or service mark is being used.

Sec. 1329.67. ~~Nothing herein shall~~ sections 1329.54 to 1329.67 ~~Of the Revised Code do not~~ adversely affect the rights or the enforcement of rights in ~~trade-marks~~ trademarks or service marks acquired in good faith ~~at any time~~ at common law prior to any of the following times:

(A) Prior to another person's registration in this state of a trademark or service mark, with the registrant having a subsequent first use date;

(B) Prior to another person's registration in the United States patent and trademark office of a trademark or service mark, with the other person having a subsequent first use date;

(C) Prior to another person's registration in the United States patent and trademark office of a trademark or service mark, with the other person having a subsequent priority date.

SECTION 2. That existing sections 1329.54, 1329.55, 1329.56, 1329.57, 1329.58, 1329.62, 1329.63, and 1329.67 of the Revised Code are hereby repealed.

Speaker _____ of the House of Representatives.

President _____ of the Senate.

Passed _____, 20____

Approved _____, 20____

Governor.

The section numbering of law of a general and permanent nature is complete and in conformity with the Revised Code.

Director, Legislative Service Commission.

Filed in the office of the Secretary of State at Columbus, Ohio, on the
____ day of _____, A. D. 20____.

Secretary of State.

File No. _____ Effective Date _____