

SECOND REGULAR SESSION

# HOUSE BILL NO. 1856

## 94TH GENERAL ASSEMBLY

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INTRODUCED BY REPRESENTATIVES JOHNSON (Sponsor), KUESSNER, GEORGE, WALSH, BURNETT, LOW (39), CASEY, TODD, CORCORAN, DOUGHERTY, HARRIS (23), MEADOWS, OXFORD, HARRIS (110), NORR, NASHEED, McCLANAHAN, TALBOY, VOGT, STORCH, VILLA, MEINERS, HUGHES, LAMPE, DONNELLY, GRILL, CURLS, STEVENSON, DARROUGH, WILDBERGER, SCHIEFFER, WHORTON, ROORDA, SCAVUZZO AND WALTON (Co-sponsors).

Read 1st time January 24, 2008 and copies ordered printed.

D. ADAM CRUMBLISS, Chief Clerk

4334L.01I

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### AN ACT

To repeal sections 417.011, 417.016, 417.018, 417.026, 417.031, and 417.046, RSMo, and to enact in lieu thereof seven new sections relating to trademark registrations.

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*Be it enacted by the General Assembly of the state of Missouri, as follows:*

Section A. Sections 417.011, 417.016, 417.018, 417.026, 417.031, and 417.046, RSMo, are repealed and seven new sections enacted in lieu thereof, to be known as sections 417.011, 417.016, 417.018, 417.026, 417.031, 417.046, and 417.049, to read as follows:

417.011. A mark by which the goods or services of any applicant for registration may be distinguished from the goods or services of others shall not be registered if it:

- (1) Consists of or comprises immoral, deceptive or scandalous matter; or
- (2) Consists of or comprises matter which may disparage or falsely suggest a connection with persons, living or dead, institutions, beliefs, or national symbols, or bring them into contempt, or disrepute; or
- (3) Consists of or comprises 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; or
- (4) Consists of or comprises the name, signature or portrait of any living individual, except with the written consent; or

EXPLANATION — Matter enclosed in bold-faced brackets [thus] in the above bill is not enacted and is intended to be omitted from the law. Matter in **bold-face** type in the above bill is proposed language.

11 (5) Consists of a mark which, (a) when applied to the goods or services of the applicant,  
12 is merely descriptive or deceptively misdescriptive of them, or (b) when applied to the goods or  
13 services of the applicant, is primarily geographically descriptive or deceptively misdescriptive  
14 of them, or (c) is primarily merely a surname; provided, however, that nothing in this section  
15 shall prevent the registration of a mark used in this state by the applicant which has become  
16 distinctive of the applicant's goods or services. The secretary of state may accept as evidence  
17 that the mark has become distinctive, as applied to the applicant's goods or services, proof of  
18 continuous use thereof as a mark by the applicant in the state or elsewhere for the five years next  
19 preceding the date of the filing of the application for registration; or

20 (6) Consists of or comprises a mark which so resembles a mark registered in this state,  
21 or a mark or trade name previously used in this state by another and not abandoned, as to be  
22 likely, when applied to the goods or services of the applicant, to cause confusion or mistake or  
23 to deceive. **The duty of the secretary of state under this subsection shall be limited to**  
24 **examination of its registration records.**

417.016. 1. Subject to the limitations set forth in sections 417.005 to 417.066, any  
2 person who adopts and uses a mark in this state may file in the office of the secretary of state,  
3 on a form to be authorized or furnished by the secretary of state, an application for registration  
4 of that mark setting forth, but not limited to, the following information:

5 (1) The name and business address of the person applying for such registration; and, if  
6 a corporation, the state of incorporation;

7 (2) The goods or services in connection with which the mark is used and the mode or  
8 manner in which the mark is used in connection with such goods or services and the class in  
9 which such goods or services fall;

10 (3) The date when the mark was first used anywhere and the date when it was first used  
11 in this state by the applicant or his predecessor in business, **unless an application is filed under**  
12 **subsection 2 of this section;** and

13 (4) A statement that the applicant is the owner of the mark and that no other person has  
14 the right to use such mark in this state either in the identical form thereof or in such near  
15 resemblance thereto as might be calculated to deceive or to be mistaken therefor.

16 2. **An application for registration may be filed under this section if the applicant**  
17 **provides a signed statement providing that it has a bona fide intention to use the mark in**  
18 **commerce on or in connection with the goods or services listed in the application. If the**  
19 **statement is not filed with the initial application, the statement shall allege that the**  
20 **applicant had a bona fide intention to use the mark in commerce on or in connection with**  
21 **the goods or services listed in the application as of the filing date of the application.**

22           **3.** The application shall be signed [and verified] by the applicant or by a member of the  
23 firm or an officer of the corporation or association applying.

24           [3.] **4.** The application shall be accompanied by a specimen or facsimile of such mark,  
25 in triplicate, **for each class of goods or services in which the applicant would like to register**  
26 **the mark. A trademark specimen is a label, tag, or container for the goods, or a display**  
27 **associated with the goods. The secretary of state may accept another document related to**  
28 **the goods or the sale of the goods when it is not possible to place the mark on the goods or**  
29 **packaging for the goods. A service mark specimen shall show the mark as actually used**  
30 **in the sale or advertising of the services.**

31           [4.] **5.** The application for registration shall be accompanied by a fee of [fifty] **seventy-**  
32 **five dollars for each class for which the applicant would like to register the mark,** payable  
33 to the director of revenue.

34           [5.] **6.** The secretary of state may also require a statement as to whether an application  
35 to register the mark, or portions or a composite thereof, has been filed by the applicant or a  
36 predecessor in interest in the United States Patent and Trademark Office; and, if so, the applicant  
37 shall provide full particulars with respect thereof including the filing date and serial number of  
38 each application, the status thereof and, if any application was finally refused registration or has  
39 otherwise not resulted in a registration, the reasons therefor.

40           [6.] **7.** The secretary of state may also require that a drawing of the mark, complying with  
41 such requirements as the secretary of state may specify, accompany the application.

42           [7.] **8.** Upon the filing of an application for registration and payment of the application  
43 fee, the secretary of state may cause the application to be examined for conformity with sections  
44 417.005 to 417.066.

45           [8.] **9.** The applicant shall provide [any additional pertinent information requested by the]  
46 **to the** secretary of state [including] a **written** description of a design mark and may make, or  
47 authorize the secretary of state to make, such amendments to the application as may be  
48 reasonably requested by the secretary of state or deemed by the applicant to be advisable to  
49 respond to any rejection or objection.

50           [9.] **10.** The secretary of state may require the applicant to disclaim an unregistrable  
51 component of a mark otherwise registrable, and an applicant may voluntarily disclaim a  
52 component of a mark sought to be registered. No disclaimer shall prejudice or affect the  
53 applicant's or registrant's rights then existing or thereafter arising in the disclaimed matter, or the  
54 applicant's or registrant's rights of registration on another application if the disclaimed matter be  
55 or shall have become distinctive of the applicant's or registrant's goods or services.

56 [10.] 11. Amendments may be made by the secretary of state upon the application  
57 submitted by the applicant with the applicant's agreement; or a fresh application may be required  
58 to be submitted.

59 [11.] 12. If the applicant is found not to be entitled to registration, the secretary of state  
60 shall advise the applicant thereof and of the reasons therefor. The applicant shall have a  
61 reasonable period of time specified by the secretary of state in which to reply or to amend the  
62 application, in which event the application shall then be reexamined. This procedure may be  
63 repeated until:

64 (1) The secretary of state finally refuses registration of the mark; or

65 (2) The applicant fails to reply or amend within the specified period, whereupon the  
66 application shall be deemed to have been abandoned.

67 [12.] 13. If the secretary of state finally refuses registration of the mark, the applicant  
68 may seek, in the circuit court of Cole County, an extraordinary writ to compel such registration.  
69 Such injunction may be granted, but without costs to the secretary of state, on proof that all the  
70 statements in the application are true and that the mark is otherwise entitled to registration.

71 [13.] 14. In the instance of applications concurrently being processed by the secretary  
72 of state seeking registration of the same or confusingly similar marks for the same or related  
73 goods or services, the secretary of state shall grant priority to the applications in order of filing.  
74 If a prior-filed application is granted a registration, the other application or applications shall  
75 then be rejected. Any rejected applicant may bring an action for cancellation of the registration  
76 upon grounds of prior or superior rights to the mark, in accordance with the provisions of section  
77 417.041.

417.018. The secretary of state may collect an additional fee of five dollars on each and  
2 every fee required in this chapter. **If a filing pertains to multiple classes, the secretary of state**  
3 **may collect a fee of five dollars for each class so provided.** All fees collected as provided in  
4 this section shall be deposited in the state treasury and credited to the secretary of state's  
5 technology trust fund account. The provisions of this section shall expire on December 31, 2009.

417.026. 1. Registration of a mark hereunder shall be effective for a term of ten years  
2 from the date of registration and, upon application filed within six months prior to the expiration  
3 of such term, on a form to be authorized or furnished by the secretary of state, the registration  
4 may be renewed for a like term. A renewal fee of [ten] **twenty** dollars, payable to the director  
5 of revenue, shall accompany the application for renewal of the registration. A mark registration  
6 may be renewed for successive periods of ten years in like manner.

7 2. The secretary of state shall notify registrants of marks hereunder of the necessity of  
8 renewal within the year next preceding the expiration of the ten years from the date of  
9 registration, by writing to the last known address of the registrants.

10           3. Any registration in force on September 28, 1973, shall expire ten years from the date  
11 of the registration or of the last renewal thereof or September 28, 1974, whichever is later, and  
12 may be renewed by filing an application with the secretary of state on a form authorized or  
13 furnished by him and paying the aforementioned renewal fee therefor within six months prior  
14 to the expiration of the registration.

15           4. All applications for renewals under sections 417.005 to 417.066 whether of  
16 registrations made under sections 417.005 to 417.066 or of registrations effected under any prior  
17 act, shall include a statement that the mark is still in use in this state.

18           5. The secretary of state shall within six months after September 28, 1973, notify all  
19 registrants of marks under previous acts of the date of expiration of such registrations unless  
20 renewed in accordance with the provisions of sections 417.005 to 417.066, by writing to the last  
21 known address of the registrants.

          417.031. 1. Any mark and its registration hereunder shall be assignable with the  
2 goodwill of the business in which the mark is used, or with that part of the goodwill of the  
3 business connected with the use of and symbolized by the mark. Assignment shall be in writing  
4 upon transmittal forms authorized or furnished by the secretary of state and may be recorded with  
5 the secretary of state upon the payment of a fee of [fifty] **seventy-five** dollars payable to the  
6 director of revenue who, upon recording of the assignment, shall issue in the name of the  
7 assignee a new certificate for the remainder of the term of the registration or of the last renewal  
8 thereof. An assignment of any registration under sections 417.005 to 417.066 shall be void as  
9 against any subsequent purchaser for valuable consideration without notice, unless it is recorded  
10 with the secretary of state within three months after the date thereof or prior to such subsequent  
11 purchase.

12           2. Any registrant or applicant effecting a change of the name of the person to whom the  
13 mark was issued or for whom an application was filed may record, upon a transmittal form  
14 authorized or furnished by the secretary of state, a certificate of change of name of the registrant  
15 or applicant with the secretary of state upon the payment of the recording fee **of seventy-five**  
16 **dollars**. The secretary of state may issue in the name of the assignee a certificate of registration  
17 of an assigned application. The secretary of state may issue in the name of the assignee, a new  
18 certificate or registration for the remainder of the term of the registration or last renewal thereof.

19           3. Acknowledgment shall be prima facie evidence of the execution of an assignment or  
20 other instrument and, when recorded by the secretary of state, the record shall be prima facie  
21 evidence of execution.

          417.046. 1. The general classes of goods and services as provided in this section are  
2 established for convenience of administration of sections 417.005 to 417.066, but not to limit  
3 or extend the applicant's or registrant's rights[, and a single application for registration of a mark

4 may include any or all goods upon which, or services with which, the mark is actually being used  
5 comprised in a single class, but in no event shall a single application include goods or services  
6 upon which the mark is being used which fall within different classes of goods or services].  
7 **Applications for registration of a mark may include any or all goods upon which, or**  
8 **services with which, the mark is actually being used, or in which the applicant has a bona**  
9 **fide intention to use.**

10       2. **In a single application, an applicant may apply to register the same mark for**  
11 **goods or services in multiple classes. The applicant shall:**

12       (1) **Specifically identify the goods or services in each class;**

13       (2) **Submit an application filing fee for each class as provided in this chapter; and**

14       (3) **Include either dates of use and one specimen for each class, or shall allege that**  
15 **the applicant has a bona fide intention to use the mark in commerce on or in connection**  
16 **with the goods or services listed in the application.**

17       3. **The classes of goods and services are as follows:**

18

19 **GOODS**

20       (1) **Chemicals used in industry, science, and photography, as well as in agriculture,**  
21 **horticulture, and forestry; unprocessed artificial resins; unprocessed plastics; manures;**  
22 **fire extinguishing compositions; tempering and soldering preparations; chemical**  
23 **substances for preserving foodstuffs; tanning substances; adhesives used in industry;**

24       (2) **Paints, varnishes, and lacquers; preservatives against rust and against**  
25 **deterioration of wood; colorants; mordants; raw natural resins; metals in foil and powder**  
26 **form for painters, decorators, printers, and artists;**

27       (3) **[Cosmetics and cleaning preparations] Bleaching preparations and other**  
28 **substances for laundry use; cleaning, polishing, scouring, and abrasive preparations;**  
29 **soaps; perfumery; essential oils; cosmetics; hair lotions; dentifrices;**

30       (4) **[Lubricants and fuels] Industrial oils and greases; lubricants; dust absorbing,**  
31 **wetting, and binding compositions; fuels, including motor spirit; illuminants; candles;**  
32 **wicks;**

33       (5) **Pharmaceuticals, veterinary, and sanitary preparations; dietetic substances**  
34 **adapted for medical use; food for babies; plasters; material for dressings; material for**  
35 **stopping teeth; dental wax; disinfectants; preparations for destroying vermin; fungicides;**  
36 **herbicides;**

37       (6) **[Metal goods] Common metals and their alloys; metal building materials;**  
38 **transportable buildings of metal; materials of metal for railway tracks; nonelectric cables**

39 **and wires of common metal; ironmongery; small items of metal hardware; pipes and tubes**  
40 **of metal; safes; goods of common metal not included in other classes; ores;**

41 (7) [Machinery] **Machines and machine tools; motors and engines, except for land**  
42 **vehicles; machine coupling and transmission components, except for land vehicles;**  
43 **agricultural implements not hand-operated; incubators for eggs;**

44 (8) **Hand tools and hand-operated implements; cutlery; side arms; razors;**

45 (9) [Electrical and scientific apparatus] **Scientific, nautical, surveying, electric,**  
46 **photographic, cinematographic, optical, weighing, measuring, signaling, checking**  
47 **(supervision), life-saving, and teaching apparatus and instruments; apparatus for**  
48 **recording, transmission, or reproduction of sound or images; magnetic data carriers;**  
49 **recording discs; automatic vending machines and mechanisms for coin-operated**  
50 **apparatus; cash registers; calculating machines; data processing equipment and**  
51 **computers; fire extinguishing apparatus;**

52 (10) [Medical apparatus] **Surgical, medical, dental, and veterinary apparatus and**  
53 **instruments; artificial limbs, eyes, and teeth; orthopedic articles; suture materials;**

54 (11) [Environmental control apparatus] **Apparatus for lighting, heating, steam**  
55 **generating, cooking, refrigerating, drying, ventilating, water supply, and sanitary**  
56 **purposes;**

57 (12) **Vehicles and apparatus for locomotion by land, air, or water;**

58 (13) **Firearms; ammunition and projectiles; explosives; fireworks;**

59 (14) [Jewelry] **Precious metals and their alloys and goods in precious metals or**  
60 **coated therewith, not included in other classes; jewelry and precious stones; horological**  
61 **and chronometric instruments;**

62 (15) **Musical instruments;**

63 (16) [Paper goods and printed matter] **Paper, cardboard, and goods made from these**  
64 **materials, not included in other classes; printed matter; bookbinding material;**  
65 **photographs; stationery; adhesives for stationery or household purposes; artists' materials;**  
66 **paint brushes; typewriters and office requisites, except furniture; instructional and**  
67 **teaching material, except apparatus; plastic materials for packaging, not included in other**  
68 **classes; playing cards; printers' type; printing blocks;**

69 (17) **Rubber [goods], gutta-percha, gum, asbestos, mica, and goods made from these**  
70 **materials and not included in other classes; plastics in extruded form for use in**  
71 **manufacture; packing, stopping, and insulating materials; flexible pipes, not of metal;**

72 (18) **Leather [goods], imitations of leather, and goods made of these materials and**  
73 **not included in other classes; animal skins and hides; trunks and traveling bags;**  
74 **umbrellas, parasols, and walking sticks; whips, harnesses, and saddlery;**

- 75 (19) Nonmetallic building materials; **nonmetallic rigid pipes for building; asphalt,**  
76 **pitch, and bitumen; nonmetallic transportable buildings; monuments, not of metal;**
- 77 (20) Furniture [and articles not otherwise classified] , **mirrors, and picture frames;**  
78 **goods of wood, cork, reed, cane, wicker, horn, bone, ivory, whalebone, shell, amber,**  
79 **mother-of-pearl, meerschaum and substitutes for all these materials, or of plastics;**
- 80 (21) [Housewares and glass] **Household or kitchen utensils and containers not of**  
81 **precious metal or coated therewith; combs and sponges; brushes, except paint brushes;**  
82 **brush-making material; articles for cleaning purposes; steel wool; unworked or semi-**  
83 **worked glass, except glass used in building; glassware, porcelain, and earthenware not**  
84 **included in other classes;**
- 85 (22) [Cordage and fibers] **Ropes, strings, nets, tents, awnings, tarpaulins, sails, sacks,**  
86 **and bags not included in other classes; padding and stuffing materials, except of rubber**  
87 **or plastics; raw fibrous textile materials;**
- 88 (23) Yarns and threads **for textile use;**
- 89 (24) [Fabrics] **Textiles and textile goods, not included in other classes; beds and**  
90 **table covers;**
- 91 (25) Clothing, footwear, and headgear;
- 92 (26) [Fancy goods] **Lace and embroidery; ribbons and braid; buttons, hooks, and**  
93 **eyes; pins and needles; artificial flowers;**
- 94 (27) [Floor coverings] **Carpets, rugs, mats, and matting; linoleum and other**  
95 **materials for covering existing floors; nontextile wall hangings;**
- 96 (28) [Toys and sporting goods] **Games and playthings; gymnastics and sporting**  
97 **articles not included in other classes; decorations for Christmas trees;**
- 98 (29) [Meats and processed foods] **Meat, fish, poultry, and game; meat extracts;**  
99 **preserved, dried, and cooked fruits and vegetables; jellies, jams, and fruit sauces; eggs,**  
100 **milk, and milk products; edible oils and fats;**
- 101 (30) [Staple foods] **Coffee, tea, cocoa, sugar, rice, tapioca, sago, and artificial coffee;**  
102 **flour and preparations made from cereals, bread, pastry and confectionary; ices; honey;**  
103 **treacle; yeast; baking powder; salt; mustard; vinegar; sauces (condiments); spices;**
- 104 (31) [Natural agricultural products] **Agricultural, horticultural, and forestry products**  
105 **and grains not included in other classes; live animals; fresh fruits and vegetables; seeds,**  
106 **natural plants, and flowers; foodstuffs for animals; malt;**
- 107 (32) [Light beverages] **Beers; mineral and aerated waters and other nonalcoholic**  
108 **drinks; fruit drinks and fruit juices; syrups and other preparations for making beverages;**
- 109 (33) [Wines and spirits] **Alcoholic beverages, except beer; and**
- 110 (34) [Smokers' articles] **Tobacco; smokers' articles; matches.**



111

112 SERVICES

113 (35) [Advertising and business] **Advertising; business management; business**  
114 **administration; office functions;**

115 (36) [Insurance and financial] **Insurance; financial affairs; monetary affairs; real**  
116 **estate affairs;**

117 (37) [Construction and repair] **Building construction; repair; installation services;**

118 (38) [Communications] **Telecommunications;**

119 (39) [Transportation and storage] **Transport; packaging and storage of goods; travel**  
120 **arrangement;**

121 (40) [Material treatment] **Treatment of materials;**

122 (41) Education [and entertainment and] ; **providing of training; entertainment;**  
123 **sporting and cultural activities;**

124 (42) [Miscellaneous] **Scientific and technological services, research, and design**  
125 **relating thereto; industrial analysis and research services; design and development of**  
126 **computer hardware; legal services;**

127 (43) **Services for providing food and drink; temporary accommodations;**

128 (44) **Medical services; veterinary services; hygienic and beauty care for human**  
129 **beings or animals; agriculture, horticulture, and forestry services; and**

130 (45) **Personal and social services rendered by others to meet the needs of**  
131 **individuals; security services for the protection of property and individuals.**

417.049. The secretary of state shall promulgate rules to implement the provisions  
2 of this chapter. Any rule or portion of a rule, as that term is defined in section 536.010,  
3 RSMo, that is created under the authority delegated in this section shall become effective  
4 only if it complies with and is subject to all of the provisions of chapter 536, RSMo, and,  
5 if applicable, section 536.028, RSMo. This chapter and chapter 536, RSMo, are  
6 nonseverable and if any of the powers vested with the general assembly pursuant to  
7 chapter 536, RSMo, to review, to delay the effective date, or to disapprove and annul a rule  
8 are subsequently held unconstitutional, then the grant of rulemaking authority and any  
9 rule proposed or adopted after August 28, 2008, shall be invalid and void.

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