



## Registration of Trademarks and Labels

### **§ 75-25-1. Definitions.**

As used in this chapter the following terms shall have the meaning indicated:

- (a)** The term “trademark” as used herein means any word, name, symbol, or device or any combination thereof used by a person to identify and distinguish the goods of such person, including a unique product, from those manufactured or sold by others, and to indicate the source of the goods, even if that source is unknown.
- (b)** The term “service mark” as used herein means any word, name, symbol or device or any combination thereof used by a person to identify and distinguish the services of one (1) person, including a unique service, from the services of others, and to indicate the source of the services, even if that source is unknown. Titles, character names used by a person and other distinctive features of radio or television programs may be registered as service marks notwithstanding that they, or the programs, may advertise the goods of the sponsor.
- (c)** The term “mark” as used herein includes any trademark or service mark entitled to registration under this chapter whether registered or not.
- (d)** The term “trade name” means any name used by a person to identify a business or vocation of such person.
- (e)** The term “person” and any other word or term used to designate the applicant or other party entitled to a benefit or privilege or rendered liable under the provisions of this chapter includes a juristic person as well as a natural person. The term “juristic person” includes a firm, partnership, corporation, union, association or other organization capable of suing and being sued in a court of law.
- (f)** The term “applicant” as used herein embraces the person filing an application for registration of a mark under this chapter, and the legal representatives, successors or assigns of such person.
- (g)** The term “registrant” as used herein embraces the person to whom the registration of a mark under this chapter is issued, and the legal representatives, successors or assigns of such person.

**(h)** The term “use” means the bona fide use of a mark in the ordinary course of trade, and not made merely to reserve a right in a mark. For the purposes of this chapter, a mark shall be deemed to be in use:

- (1)** On goods when it is placed in any manner on the goods or other containers or the displays associated therewith or on the tags or labels affixed thereto, or if the nature of the goods makes such placement impracticable, then on documents associated with the goods or their sale, and the goods are sold or transported in commerce in this 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.

**(i)** A mark shall be deemed to be “abandoned” when either of the following occurs:

- (1)** When its use had been discontinued with intent not to resume such use. Intent not to resume may be inferred from circumstances. Nonuse for two (2) consecutive years shall constitute prima facie evidence of abandonment; or
- (2)** When any course of conduct of the owner, including acts of omission as well as commission, causes the mark to lose its significance as a mark.

**(j)** The term “secretary” as used herein means the Secretary of State or the designee of the secretary charged with the administration of this chapter.

**(k)** The term “dilution” as used herein means dilution by blurring or dilution by tarnishment, regardless of the presence or absence of:

- (1)** Competition between the owner of the famous mark and other parties, or
- (2)** Actual or likely confusion, mistake, or deception, or
- (3)** Actual economic injury.

**(l)** The term “dilution by blurring” as used herein means association arising from the similarity between a mark or trade name and a famous mark that impairs the distinctiveness of the famous mark.

**(m)** The term “dilution by tarnishment” as used herein means association arising from the similarity between a mark or trade name and a famous mark that harms the reputation of the famous mark.

### **§ 75-25-3. Registrability.**

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:

- (a)** Consists of or comprises immoral, deceptive or scandalous matter; or
- (b)** 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
- (c)** Consists of or comprises the flag or coat of arms or other insignia of the United States, or of any state or municipality, or any foreign nation, or any simulation thereof; or

- (d) Consists of or comprises the name, signature or portrait identifying a particular living individual, except by the individual's written consent; or
- (e) Consists of a mark which, (1) when used on or in connection with the goods or services of the applicant, is merely descriptive or deceptively misdescriptive of them, or (2) when used on or in connection with the goods or services of the applicant is primarily geographically descriptive or deceptively misdescriptive of them, or (3) is primarily merely a surname; however, nothing in this subsection (e) shall prevent the registration of a mark used by the applicant which has become distinctive of the applicant's goods or services. The secretary may accept as evidence that the mark has become distinctive, as used on or in connection with the applicant's goods or services, proof of continuous use thereof as a mark by the applicant in this state for the five (5) years before the date on which the claim of distinctiveness is made; or
- (f) Consists of or comprises a mark which so resembles a mark registered in this state or a mark or trade name previously used by another and not abandoned, as to be likely, when used on or in connection with the goods or services of the applicant, to cause confusion or mistake or to deceive.

#### **§ 75-25-5. Application for registration; requirements.**

(a) Subject to the limitations set forth in this chapter, any person who uses a mark may file in the office of the secretary, in a manner complying with the requirements of the secretary, an application for registration of that mark setting forth, but not limited to, the following information:

- (1) The name and business address of the person applying for such registration; and, if a corporation, the state of incorporation, or if a partnership or other entity, the state in which the entity is organized and the names of the general partners, owners and/or managers, as specified by the secretary;
- (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 such goods or services and the class in which such goods or services fall;
- (3) The date when the mark was first used anywhere and the date when it was first used in this state by the applicant or predecessor in interest; and
- (4) A statement that the applicant is the owner of the mark, that the mark is in use, and that, to the knowledge of the person verifying the application, no other person has registered, either federally or in this state, or has the right to use such mark either in the identical form thereof or in such near resemblance thereto as to be likely, when applied to the goods or services of such other person, to cause confusion, or to cause mistake, or to deceive.

- (b) The secretary may also require a statement as to whether an application to register the mark, or portions or a composite thereof, has been filed by the applicant or a predecessor in interest in the United States Patent and Trademark Office; and, if so, the applicant shall provide full particulars with respect thereto including the filing date and serial number of each application, the status thereof and, if any application was finally refused registration or has otherwise not resulted in a registration, the reasons therefor.
- (c) The secretary may also require that a drawing of the mark, complying with such requirements as the secretary may specify, accompany the application.
- (d) The application shall be signed and verified by oath, affirmation or declaration subject to perjury laws by the applicant or by a member of the firm or an officer of the corporation or association applying.
- (e) The application shall be accompanied by three (3) specimens showing the mark as actually used.
- (f) The application shall be accompanied by the application fee payable to the Secretary of State.

**§ 75-25-7. Examination of application for registration; requirements; effect; appeal; priority of concurrent applications for same or similar marks.**

- (a) Upon the filing of an application for registration and payment of the application fee, the secretary may cause the application to be examined for conformity with this chapter.
- (b) The applicant shall provide any additional pertinent information requested by the secretary including a description of a design mark and may make, or authorize the secretary to make, such amendments to the application as may be reasonably requested by the secretary or deemed by applicant to be advisable to respond to any rejection or objection.
- (c) The secretary may require the applicant to disclaim an unregistrable component of a mark otherwise registerable, and an applicant may voluntarily disclaim a component of a mark sought to be registered. No disclaimer shall prejudice or affect the applicant's or registrant's rights then existing or thereafter arising in the disclaimed matter, or the applicant's or registrant's rights of registration on another application if the disclaimed matter be or shall have become distinctive of the applicant's or registrant's goods or services.
- (d) Amendments may be made by the secretary upon the application submitted by the applicant upon applicant's agreement; or a fresh application may be required to be submitted.

(e) If the applicant is found not to be entitled to registration, the secretary shall advise the applicant thereof and of the reasons therefor. The applicant shall have a reasonable period of time specified by the secretary in which to reply or to amend the application, in which event the application shall then be reexamined. This procedure may be repeated until:

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

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

(f) If the secretary finally refuses registration of the mark, the applicant may appeal such refusal to the First Judicial District of the Hinds County Chancery Court. The secretary's refusal may be reversed, but without costs to the secretary, on proof that all the statements in the application are true and that the mark is otherwise entitled to registration.

(g) In the instance of applications concurrently being processed by the secretary seeking registration of the same or confusingly similar marks for the same or related goods or services, the secretary shall grant priority to the applications in order of filing. If a prior-filed application is granted a registration, the other application or applications shall then be rejected. Any rejected applicant may bring an action for cancellation of the registration upon grounds of prior or superior rights to the mark, in accordance with the provisions of Section 75-25-17.

#### **§ 75-25-9. Issuance and delivery of certificate of registration; admissibility in evidence.**

Upon compliance by the applicant with the requirements of this chapter, the secretary 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 and the seal of the state, and it shall show the name and business address and, if a corporation, the state of incorporation, or if a partnership or other entity, the state in which the partnership or other entity is organized and the names of the general partners, owners, and/or managers, as specified by the secretary, of the person claiming ownership of the mark, the date claimed for the first use of the mark anywhere and the date claimed for the first use of the mark in this state, the class of goods or services and a description of the goods or services on or in connection with which the mark is used, a reproduction of the mark, the registration date and the term of the registration.

Any certificate of registration issued by the secretary under the provisions hereof or a copy thereof duly certified by the secretary shall be admissible in evidence as competent and sufficient proof of the registration of such mark in any actions or judicial proceedings in any court of this state.

#### **§ 75-25-11. Duration and renewal.**

**(a)** A registration of a mark hereunder shall be effective for a term of five (5) years from the date of registration and, upon application filed within six (6) months prior to the expiration of such term, in a manner complying with the requirements of the secretary, the registration may be renewed for a like term from the end of the expiring term. A renewal fee, payable to the secretary, shall accompany the application for renewal of the registration.

**(b)** A registration may be renewed for successive periods of five (5) years in like manner.

**(c)** All applications for renewal, whether of registrations made under this chapter or of registrations effected under any prior act, shall include a verified statement that the mark has been and is still in use and include a specimen showing actual use of the mark on or in connection with the goods or services.

#### **§ 75-25-13. Assignment; requirements.**

**(a)** Any mark and its registration hereunder shall be assignable with the good will of the business in which the mark is used, or with that part of the good will of the business connected with the use of and symbolized by the mark. Assignment shall be by instruments in writing duly executed and may be recorded with the secretary upon the payment of the recording fee, payable to the secretary, who, upon recording of the assignment, shall issue in the name of the assignee a new certificate for the remainder of the term of the registration or of the last renewal thereof. An assignment of any registration under this chapter shall be void as against any subsequent purchaser for valuable consideration without notice, unless it is recorded with the secretary within three (3) months after the date thereof or prior to such subsequent purchase.

**(b)** Any registrant or applicant effecting a change of the name of the person to whom the mark was issued or for whom an application was filed may record a certificate of change of name of the registrant or applicant with the secretary upon the payment of the recording fee. The secretary may issue in the name of the assignee a certificate of registration of an assigned application. The secretary may issue in the name of the assignee, a new certificate or registration for the remainder of the term of the registration or last renewal thereof.

**(c)** Other instruments which relate to a mark registered or application pending pursuant to this chapter, such as, by way of example, licenses, security interests or mortgages, may be recorded in the discretion of the secretary, provided that such instrument is in writing and duly executed.

**(d)** Acknowledgment shall be prima facie evidence of the execution of an assignment or other instrument and, when recorded by the secretary, the record shall be prima facie evidence of execution.

(e) A photocopy of any instrument referred to in subsections (a), (b), or (c) above, shall be accepted for recording if it is certified by any of the parties thereto, or their successors, to be a true and correct copy of the original.

**§ 75-25-15. Record of marks registered or renewed, or documents recorded.**

The secretary shall keep for public examination a record of all marks registered or renewed under this chapter, as well as a record of all documents recorded pursuant to Section 75-25-13.

**§ 75-25-17. Cancellation.**

The secretary shall cancel from the register, in whole or in part:

(a) Any registration concerning which the secretary shall receive a voluntary request for cancellation thereof from the registrant or the assignee of record;

(b) All registrations granted under this chapter and not renewed in accordance with the provisions hereof;

(c) Any registration concerning which a court of competent jurisdiction shall find:

(1) That the registered mark has been abandoned,

(2) That the registrant is not the owner of the mark,

(3) That the registration was granted improperly,

(4) That the registration was obtained fraudulently,

(5) That the mark is or has become the generic name for the goods or services, or a portion thereof, for which it has been registered,

(6) That the registered mark is so similar, as to be likely to cause confusion or mistake, or to deceive, to a mark registered by another person in the United States Patent and Trademark Office prior to the date of the filing of the application for registration by the registrant hereunder, and not abandoned; provided, however, that, should the registrant prove that the registrant is the owner of a concurrent registration of a mark in the United States Patent and Trademark Office covering an area including this state, the registration hereunder shall not be cancelled for such area of the state; or

(d) When a court of competent jurisdiction shall order cancellation of a registration on any ground.

**§ 75-25-19. Classification.**

The secretary shall by regulation establish a classification of goods and services for convenience of administration of this chapter, but not to limit or extend the applicant's or registrant's rights, and a single application for registration of a mark may include any or all goods upon which, or services with which, the mark is actually

being used indicating the appropriate class or classes of goods or services. When a single application includes goods or services which fall within multiple classes, the secretary may require payment of a fee for each class. To the extent practical, the classification of goods and services should conform to the classification adopted by the United States Patent and Trademark Office.

**§ 75-25-21. Fraudulent filing or registration; liability.**

Any person who shall for himself or herself, or on behalf of any other persons, procure the filing or registration of any mark in the office of the secretary under the provisions hereof, by knowingly making any false or fraudulent representation or declaration, orally or in writing, or by any other fraudulent means, shall be liable to pay all damages sustained in consequence of such filing or registration, to be recovered by or on behalf of the party injured thereby in any court of competent jurisdiction.

**§ 75-25-23. Liability for infringement; limitations.**

Subject to the provisions of Section 75-25-31 hereof, any person who shall:

- (a) Use, without the consent of the registrant, any reproduction, counterfeit, copy, or colorable imitation of a mark registered under this chapter, in connection with the sale, distribution, offering for sale, or advertising of any goods or services on or in connection with which such use is likely to cause confusion or mistake or to deceive as to the source of origin of such goods or services; or
- (b) Reproduce, counterfeit, copy or colorably imitate any such mark and apply such reproduction, counterfeit, copy or colorable imitation to labels, signs, prints, packages, wrappers, receptacles, or advertisements intended to be used upon or in connection with the sale or other distribution in this state of such goods or services; shall be liable in a civil action by the registrant for any and all of the remedies provided in Section 75-25-27 hereof, except that under paragraph (b) hereof the registrant shall not be entitled to recover profits or damages unless the acts have been committed with the intent to cause confusion or mistake or to deceive.

**§ 75-25-25. Owner of famous mark entitled to injunction against another's commercial use of the famous mark; "famous" defined; geographic limitations of injunctive relief; permitted uses of famous mark.**

- (a) Subject to the principles of equity, the owner of a mark which is famous and distinctive, inherently or through acquired distinctiveness, in this state shall be entitled to an injunction against another person's commercial use of a mark or trade name, if such use begins after the mark has become famous and is likely to cause dilution of the famous mark, and to obtain such other relief as is provided in this section.

**(b)** A mark is famous if it is widely recognized by the general consuming public of this state or a geographic area in this state as a designation of source of the goods or services of the mark's owner. In determining whether a mark is famous, a court may consider factors such as, but not limited to:

- (1)** The duration, extent, and geographic reach of advertising and publicity of the mark in this state, whether advertised or publicized by the owner or third parties;
- (2)** The amount, volume, and geographic extent of sales of goods or services offered under the mark in this state;
- (3)** The extent of actual recognition of the mark in this state; and
- (4)** Whether the mark is the subject of a state registration in this state, or a federal registration under the Act of March 3, 1881, or under the Act of February 20, 1905, or on the principal register under the Trademark Act of 1946, as amended.

**(c)** In an action brought under this section, the owner of a famous mark shall be entitled to injunctive relief throughout the geographic area in which the mark is found to have become famous prior to commencement of the junior use, but not beyond the borders of this state. If the person against whom the injunctive relief is sought willfully intended to cause dilution of the famous mark, then the owner shall also be entitled to the remedies set forth in this chapter, subject to the discretion of the court and the principles of equity.

**(d)** The following shall not be actionable under this section:

- (1)** Any fair use, including a nominative or descriptive fair use, or facilitation of such fair use, of a famous mark by another person other than as a designation of source for the person's own goods or services, including use in connection with:
  - (A)** Advertising or promotion that permits consumers to compare goods or services; or
  - (B)** Identifying and parodying, criticizing, or commenting upon the famous mark owner or the goods or services of the famous mark owner;
- (2)** Noncommercial use of the mark; and
- (3)** All forms of news reporting and news commentary.

#### **§ 75-25-27. Remedies against counterfeits or imitations.**

**(a)** Any owner of a mark registered under this chapter may proceed by suit to enjoin the manufacture, use, display or sale of any counterfeits or imitations thereof and any court of competent jurisdiction may grant injunctions to restrain such manufacture, use, display or sale as may be by the said court deemed just and reasonable, and may require the defendants to pay to such owner all profits derived from and/or all damages suffered by reason of such wrongful manufacture, use, display or sale; and such court may also order

that any such counterfeits or imitations in the possession or under the control of any defendant in such case be delivered to an officer of the court, or to the complainant, to be destroyed. The court, in its discretion, may enter judgment for an amount not to exceed three (3) times such profits and damages and/or reasonable attorneys' fees of the prevailing party in such cases where the court finds the other party committed such wrongful acts with knowledge or in bad faith or otherwise as according to the circumstances of the case.

**(b)** The enumeration of any right or remedy herein shall not affect a registrant's right to prosecute under any penal law of this state.

#### **§ 75-25-29. Actions for cancellation.**

**(a)** Actions to require cancellation of a mark registered pursuant to this chapter or to appeal the secretary's refusal to register a mark pursuant to this chapter shall be brought in the First Judicial District of the Hinds County Chancery Court. In an appeal of the secretary's refusal to register a mark, the proceeding shall be based solely upon the record before the secretary. In an action for cancellation, the secretary shall not be made a party to the proceeding but shall be notified of the filing of the complaint by the clerk of the court and shall be given the right to intervene in the action.

**(b)** In any action brought against a nonresident registrant, service may be effected by any means authorized by the Mississippi Rules of Civil Procedure.

#### **§ 75-25-31. Good faith acquisition of marks.**

Nothing herein shall adversely affect the rights or the enforcement of rights in marks acquired in good faith at any time at common law.

#### **§ 75-25-33. Fees.**

Fees required by this chapter shall be submitted to the secretary and shall not be refundable. The amount of such fees shall be as follows:

Resident Application	\$ 50.00
Nonresident Application	\$ 60.00
Resident Renewal	\$ 50.00
Nonresident Renewal	\$ 60.00
Assignment	\$ 50.00

**§ 75-25-35. Severability.**

If any provision of this chapter, or the application of such provision to any person or circumstances is held invalid, the remainder of this chapter shall not be affected thereby.

**§ 75-25-37. Legislative intent; construction.**

The intent of this chapter is to provide a system of state trademark registration and protection substantially consistent with the federal system of trademark registration and protection under the Trademark Act of 1946, as amended. To that end, the construction given the federal act should be examined as persuasive authority for interpreting and construing this chapter.