

By: Senator(s) Albritton

To: Judiciary, Division A

SENATE BILL NO. 2641

1 AN ACT TO CONFORM MISSISSIPPI'S TRADEMARK ACT TO THE 2007  
 2 REVISION OF THE INTERNATIONAL TRADEMARK ASSOCIATION'S MODEL STATE  
 3 TRADEMARK ACT; TO AMEND SECTION 75-25-1, MISSISSIPPI CODE OF 1972,  
 4 TO REVISE DEFINITIONS; TO AMEND SECTIONS 75-23-3, 75-25-5,  
 5 75-25-7, 75-25-11, 75-25-13, 75-25-17 AND 75-25-19, MISSISSIPPI  
 6 CODE OF 1972, TO CONFORM; TO AMEND SECTION 75-25-25, MISSISSIPPI  
 7 CODE OF 1972, TO REVISE REMEDIES AVAILABLE TO THE OWNER OF A MARK;  
 8 TO AMEND SECTIONS 75-25-27 AND 75-25-29, MISSISSIPPI CODE OF 1972,  
 9 TO CONFORM; TO CODIFY SECTION 75-25-35, MISSISSIPPI CODE OF 1972,  
 10 TO PROVIDE FOR SEVERABILITY; TO CODIFY SECTION 75-25-37,  
 11 MISSISSIPPI CODE OF 1972, TO SPECIFY THE EFFECTIVE DATE OF THE  
 12 ACT; AND FOR RELATED PURPOSES.

13 BE IT ENACTED BY THE LEGISLATURE OF THE STATE OF MISSISSIPPI:

14 **SECTION 1.** Section 75-25-1, Mississippi Code of 1972, is  
 15 amended as follows:

16 75-25-1. As used in this chapter the following terms shall  
 17 have the meaning indicated:

18 (a) The term "trademark" as used herein means any word,  
 19 name, symbol, or device or any combination thereof \* \* \* used by a  
 20 person to identify and distinguish the goods of such person \* \* \*,  
 21 including a unique product, from those manufactured or sold by  
 22 others, and to indicate the source of the goods, even if that  
 23 source is unknown.

24 (b) The term "service mark" as used herein means any  
 25 word, name, symbol or device or any combination thereof used by a  
 26 person to identify and distinguish the services of one (1) person,  
 27 including a unique service, from the services of others, and to  
 28 indicate the source of the services, even if that source is  
 29 unknown. Titles, character names used by a person and other  
 30 distinctive features of radio or television programs may be



31 registered as service marks notwithstanding that they, or the  
32 programs, may advertise the goods of the sponsor.

33 (c) The term "mark" as used herein includes any  
34 trademark or service mark entitled to registration under this  
35 chapter whether registered or not.

36 (d) The term "trade name" means any name used by a  
37 person to identify a business or vocation of such person.

38 (e) The term "person" and any other word or term used  
39 to designate the applicant or other party entitled to a benefit or  
40 privilege or rendered liable under the provisions of this chapter  
41 includes a juristic person as well as a natural person. The term  
42 "juristic person" includes a firm, partnership, corporation,  
43 union, association or other organization capable of suing and  
44 being sued in a court of law.

45 (f) The term "applicant" as used herein embraces the  
46 person filing an application for registration of a mark under this  
47 chapter, and the legal representatives, successors or assigns of  
48 such person.

49 (g) The term "registrant" as used herein embraces the  
50 person to whom the registration of a mark under this chapter is  
51 issued, and the legal representatives, successors or assigns of  
52 such person.

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

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



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

66 (i) A mark shall be deemed to be "abandoned" when  
67 either of the following occurs:

68 (1) When its use had been discontinued with intent  
69 not to resume such use. Intent not to resume may be inferred from  
70 circumstances. Nonuse for two (2) consecutive years shall  
71 constitute prima facie evidence of abandonment; or

72 (2) When any course of conduct of the owner,  
73 including acts of omission as well as commission, causes the mark  
74 to lose its significance as a mark.

75 (j) The term "secretary" as used herein means the  
76 Secretary of State or the designee of the secretary charged with  
77 the administration of this chapter.

78 (k) The term "dilution" as used herein means dilution  
79 by blurring or dilution by tarnishment, regardless of the presence  
80 or absence of:

81 (1) Competition between the owner of the famous  
82 mark and other parties, or

83 (2) Actual or likely confusion, mistake, or  
84 deception, or

85 (3) Actual economic injury.

86 (1) The term "dilution by blurring" as used herein  
87 means association arising from the similarity between a mark or  
88 trade name and a famous mark that impairs the distinctiveness of  
89 the famous mark.

90 (m) The term "dilution by tarnishment" as used herein  
91 means association arising from the similarity between a mark or  
92 trade name and a famous mark that harms the reputation of the  
93 famous mark.

94 **SECTION 2.** Section 75-25-3, Mississippi Code of 1972, is  
95 amended as follows:



96           75-25-3. A mark by which the goods or services of any  
97 applicant for registration may be distinguished from the goods or  
98 services of others shall not be registered if it:

99           (a) Consists of or comprises immoral, deceptive or  
100 scandalous matter; or

101           (b) Consists of or comprises matter which may disparage  
102 or falsely suggest a connection with persons, living or dead,  
103 institutions, beliefs, or national symbols, or bring them into  
104 contempt, or disrepute; or

105           (c) Consists of or comprises the flag or coat of arms  
106 or other insignia of the United States, or of any state or  
107 municipality, or any foreign nation, or any simulation thereof; or

108           (d) Consists of or comprises the name, signature or  
109 portrait identifying a particular living individual, except by the  
110 individual's written consent; or

111           (e) Consists of a mark which, (1) when used on or in  
112 connection with the goods or services of the applicant, is merely  
113 descriptive or deceptively misdescriptive of them, or (2) when  
114 used on or in connection with the goods or services of the  
115 applicant is primarily geographically descriptive or deceptively  
116 misdescriptive of them, or (3) is primarily merely a  
117 surname; \* \* \* however, \* \* \* nothing in this subsection (e) shall  
118 prevent the registration of a mark used by the applicant which has  
119 become distinctive of the applicant's goods or services. The  
120 secretary may accept as evidence that the mark has become  
121 distinctive, as used on or in connection with the applicant's  
122 goods or services, proof of continuous use thereof as a mark by  
123 the applicant in this state for the five (5) years before the date  
124 on which the claim of distinctiveness is made; or

125           (f) Consists of or comprises a mark which so resembles  
126 a mark registered in this state or a mark or trade name previously  
127 used \* \* \* by another and not abandoned, as to be likely, when



128 used on or in connection with the goods or services of the  
129 applicant, to cause confusion or mistake or to deceive.

130 **SECTION 3.** Section 75-25-5, Mississippi Code of 1972, is  
131 amended as follows:

132 75-25-5. (a) Subject to the limitations set forth in this  
133 chapter, any person who uses a mark may file in the office of the  
134 secretary, in a manner complying with the requirements of the  
135 secretary, an application for registration of that mark setting  
136 forth, but not limited to, the following information:

137 (1) The name and business address of the person  
138 applying for such registration; and, if a corporation, the state  
139 of incorporation, or if a partnership or other entity, the state  
140 in which the entity is organized and the names of the general  
141 partners, owners and/or managers, as specified by the secretary;

142 (2) The goods or services on or in connection with  
143 which the mark is used and the mode or manner in which the mark is  
144 used on or in connection with such goods or services and the class  
145 in which such goods or services fall;

146 (3) The date when the mark was first used anywhere and  
147 the date when it was first used in this state by the applicant or  
148 predecessor in interest; and

149 (4) A statement that the applicant is the owner of the  
150 mark, that the mark is in use, and that, to the knowledge of the  
151 person verifying the application, no other person has registered,  
152 either federally or in this state, or has the right to use such  
153 mark either in the identical form thereof or in such near  
154 resemblance thereto as to be likely, when applied to the goods or  
155 services of such other person, to cause confusion, or to cause  
156 mistake, or to deceive.

157 (b) The secretary may also require a statement as to whether  
158 an application to register the mark, or portions or a composite  
159 thereof, has been filed by the applicant or a predecessor in  
160 interest in the United States Patent and Trademark Office; and, if



161 so, the applicant shall provide full particulars with respect  
162 thereto including the filing date and serial number of each  
163 application, the status thereof and, if any application was  
164 finally refused registration or has otherwise not resulted in a  
165 registration, the reasons therefor.

166 (c) The secretary may also require that a drawing of the  
167 mark, complying with such requirements as the secretary may  
168 specify, accompany the application.

169 (d) The application shall be signed and verified by oath,  
170 affirmation or declaration subject to perjury laws by the  
171 applicant or by a member of the firm or an officer of the  
172 corporation or association applying.

173 (e) The application shall be accompanied by three (3)  
174 specimens showing the mark as actually used.

175 (f) The application shall be accompanied by the application  
176 fee payable to the Secretary of State.

177 **SECTION 4.** Section 75-25-7, Mississippi Code of 1972, is  
178 amended as follows:

179 75-25-7. (a) Upon the filing of an application for  
180 registration and payment of the application fee, the secretary may  
181 cause the application to be examined for conformity with this  
182 chapter.

183 (b) The applicant shall provide any additional pertinent  
184 information requested by the secretary including a description of  
185 a design mark and may make, or authorize the secretary to make,  
186 such amendments to the application as may be reasonably requested  
187 by the secretary or deemed by applicant to be advisable to respond  
188 to any rejection or objection.

189 (c) The secretary may require the applicant to disclaim an  
190 unregisterable component of a mark otherwise registerable, and an  
191 applicant may voluntarily disclaim a component of a mark sought to  
192 be registered. No disclaimer shall prejudice or affect the  
193 applicant's or registrant's rights then existing or thereafter



194 arising in the disclaimed matter, or the applicant's or  
195 registrant's rights of registration on another application if the  
196 disclaimed matter be or shall have become distinctive of the  
197 applicant's or registrant's goods or services.

198 (d) Amendments may be made by the secretary upon the  
199 application submitted by the applicant upon applicant's agreement;  
200 or a fresh application may be required to be submitted.

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

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

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

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

218 (g) In the instance of applications concurrently being  
219 processed by the secretary seeking registration of the same or  
220 confusingly similar marks for the same or related goods or  
221 services, the secretary shall grant priority to the applications  
222 in order of filing. If a prior-filed application is granted a  
223 registration, the other application or applications shall then be  
224 rejected. Any rejected applicant may bring an action for  
225 cancellation of the registration upon grounds of prior or superior



226 rights to the mark, in accordance with the provisions of Section  
227 75-25-17.

228 **SECTION 5.** Section 75-25-11, Mississippi Code of 1972, is  
229 amended as follows:

230 75-25-11. (a) A registration of a mark hereunder shall be  
231 effective for a term of five (5) years from the date of  
232 registration and, upon application filed within six (6) months  
233 prior to the expiration of such term, in a manner complying with  
234 the requirements of the secretary, the registration may be renewed  
235 for a like term from the end of the expiring term. A renewal fee,  
236 payable to the secretary, shall accompany the application for  
237 renewal of the registration.

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

240 \* \* \*

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

247 **SECTION 6.** Section 75-25-13, Mississippi Code of 1972, is  
248 amended as follows:

249 75-25-13. (a) Any mark and its registration hereunder shall  
250 be assignable with the good will of the business in which the mark  
251 is used, or with that part of the good will of the business  
252 connected with the use of and symbolized by the mark. Assignment  
253 shall be by instruments in writing duly executed and may be  
254 recorded with the secretary upon the payment of the recording fee,  
255 payable to the secretary, who, upon recording of the assignment,  
256 shall issue in the name of the assignee a new certificate for the  
257 remainder of the term of the registration or of the last renewal  
258 thereof. An assignment of any registration under this chapter





259 shall be void as against any subsequent purchaser for valuable  
260 consideration without notice, unless it is recorded with the  
261 secretary within three (3) months after the date thereof or prior  
262 to such subsequent purchase.

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

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

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

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

285 **SECTION 7.** Section 75-25-17, Mississippi Code of 1972, is  
286 amended as follows:

287 75-25-17. The secretary shall cancel from the register, in  
288 whole or in part:

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



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

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

296                   (1) That the registered mark has been abandoned,

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

299                   (3) That the registration was granted improperly,

300                   (4) That the registration was obtained

301 fraudulently,

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

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

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

317           **SECTION 8.** Section 75-25-19, Mississippi Code of 1972, is  
318 amended as follows:

319           75-25-19. The secretary shall by regulation establish a  
320 classification of goods and services for convenience of  
321 administration of this chapter, but not to limit or extend the  
322 applicant's or registrant's rights, and a single application for  
323 registration of a mark may include any or all goods upon which, or  
324 services with which, the mark is actually being used indicating



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

331 **SECTION 9.** Section 75-25-25, Mississippi Code of 1972, is  
332 amended as follows:

333 75-25-25. (a) Subject to the principles of equity, the  
334 owner of a mark which is famous and distinctive, inherently or  
335 through acquired distinctiveness, in this state shall be entitled  
336 to an injunction against another person's commercial use of a mark  
337 or trade name, if such use begins after the mark has become famous  
338 and is likely to cause dilution of the famous mark, and to obtain  
339 such other relief as is provided in this section.

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

345 (1) The duration, extent, and geographic reach of  
346 advertising and publicity of the mark in this state, whether  
347 advertised or publicized by the owner or third parties;

348 (2) The amount, volume, and geographic extent of sales  
349 of goods or services offered under the mark in this state;

350 (3) The extent of actual recognition of the mark in  
351 this state; and

352 (4) Whether the mark is the subject of a state  
353 registration in this state, or a federal registration under the  
354 Act of March 3, 1881, or under the Act of February 20, 1905, or on  
355 the principal register under the Trademark Act of 1946, as  
356 amended.



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

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

368 (1) Any fair use, including a nominative or descriptive  
369 fair use, or facilitation of such fair use, of a famous mark by  
370 another person other than as a designation of source for the  
371 person's own goods or services, including use in connection with:

372 (A) Advertising or promotion that permits  
373 consumers to compare goods or services; or

374 (B) Identifying and parodying, criticizing, or  
375 commenting upon the famous mark owner or the goods or services of  
376 the famous mark owner;

377 (2) Noncommercial use of the mark; and

378 (3) All forms of news reporting and news commentary.

379 **SECTION 10.** Section 75-25-27, Mississippi Code of 1972, is  
380 amended as follows:

381 75-25-27. (a) Any owner of a mark registered under this  
382 chapter may proceed by suit to enjoin the manufacture, use,  
383 display or sale of any counterfeits or imitations thereof and any  
384 court of competent jurisdiction may grant injunctions to restrain  
385 such manufacture, use, display or sale as may be by the said court  
386 deemed just and reasonable, and may require the defendants to pay  
387 to such owner all profits derived from and/or all damages suffered  
388 by reason of such wrongful manufacture, use, display or sale; and  
389 such court may also order that any such counterfeits or imitations



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

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

401 **SECTION 11.** Section 75-25-29, Mississippi Code of 1972, is  
402 amended as follows:

403 75-25-29. (a) Actions to require cancellation of a mark  
404 registered pursuant to this chapter or to appeal the secretary's  
405 refusal to register a mark pursuant to this chapter shall be  
406 brought in the First Judicial District of the Hinds County  
407 Chancery Court. In an appeal of the secretary's refusal to  
408 register a mark, the proceeding shall be based solely upon the  
409 record before the secretary. In an action for cancellation, the  
410 secretary shall not be made a party to the proceeding but shall be  
411 notified of the filing of the complaint by the clerk of the court  
412 and shall be given the right to intervene in the action.

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

416 **SECTION 12.** The following shall be codified as Section  
417 75-25-35, Mississippi Code of 1972:

418 75-25-35. If any provision of this chapter, or the  
419 application of such provision to any person or circumstances is  
420 held invalid, the remainder of this chapter shall not be affected  
421 thereby.



422           **SECTION 13.** The following shall be codified as Section  
423 75-25-37, Mississippi Code of 1972:

424           75-25-37. The intent of this chapter is to provide a system  
425 of state trademark registration and protection substantially  
426 consistent with the federal system of trademark registration and  
427 protection under the Trademark Act of 1946, as amended. To that  
428 end, the construction given the federal act should be examined as  
429 persuasive authority for interpreting and construing this chapter.

430           **SECTION 14.** This act shall take effect and be in force from  
431 and after July 1, 2009, but shall not affect any application,  
432 suit, proceeding or appeal then pending.

