Mississippi Secretary of State
2008 Business Reform Committees
Minutes of the Trademarks Committee
July 8, 2008

The second meeting of the Trademarks Committee was called to order on Tuesday, July 8, 2008 at 11:00 A.M. at the Office of the Secretary of State, 700 North Street, Jackson, Mississippi. A list of the persons who were present in person or by telephone is attached at Exhibit A.

Minutes; Introduction and Purpose of Meeting

The Committee's first act was to approve the minutes of the June 17 meeting. Chairman Hise noted that the purpose of the second Committee meeting was to analyze the 2007 revisions to the Model State Trademark Bill (MSTB), and to determine whether those revisions should be adopted and incorporated into Mississippi's trademark laws.

Recent Changes to the Model Act

Doug Jennings, Senior Attorney for the Secretary of State's Division of Policy & Research, discussed the 2007 revisions to the MSTB. These provisions include:

- Amendments to the definition of trademark dilution to incorporate two forms of dilution, namely, "blurring" and "tarnishment." Current Mississippi law does not address this distinction.
  - The revised MSTB defines dilution by blurring as the "association arising from the similarity between a mark or trade name and a famous mark that impairs the distinctiveness of the famous mark."
  - The bill defines dilution by tarnishment as the "association arising from the similarity between a mark or trade name and a famous mark that harms the reputation of the famous mark."
- A new "likelihood of dilution" standard for plaintiffs alleging trademark dilution. Mississippi law currently requires a plaintiff to prove actual dilution of a registered state trademark. Under the revised MSTB, a plaintiff would be required only to show a likelihood of dilution of a mark.
- "Fair use" provisions which immunize parties from liability if they use a mark to compare goods and services, to parody a mark owner, or make other noncommercial uses of a mark. These provisions do not appear in Mississippi's current trademark laws.

Mr. Jennings added that Massachusetts and Texas have conferred certain evidentiary benefits upon owners of state trademarks. Both states' laws provide that a state trademark registration serves as proof of the mark's validity, and also as constructive notice that the mark owner has the exclusive right to use the mark within the state. Jennings asked the group to consider whether Mississippi should add similar provisions to its trademark laws to benefit the owners of registered state marks.

Request for Vote on Adopting the MSTB's Dilution Provisions

The Chairman asked for a vote from the group with respect to (1) adopting the MSTB's definitions of blurring and tarnishment, and (2) adopting the MSTB's likelihood of dilution provisions. After discussion, the group voted unanimously to adopt both.

Action on Fair Use Provisions Tabled

Next, the Chairman asked for a vote on whether to adopt the MSTB's fair use provisions. The members voted to table the issue in order to further research why fair use provisions are not present in Mississippi's current trademark laws, and also to determine how these provisions relate to product disparagement issues.

Action on Appeals Provisions Tabled

In addition, discussion of the process of appealing the refusal of a state trademark registration was tabled for further research into the possibility of having the Secretary of State handle appeals via an administrative hearing.

Overview of the Right of Publicity

Mr. Jennings noted that the right of publicity is very similar to a trademark right in the sense that was an intellectual property right that can be sold or licensed. Furthermore, he explained that the right of publicity was the right to a person's image or likeness for commercial purposes. Mr. Jennings opined that the right of publicity differs from the traditional right to privacy in that right-of-publicity cases focus on commercial loss, while traditional right-of-privacy cases focus on hurt feelings and mental anguish. Jennings noted that while the Mississippi Supreme Court has recognized a common-law right to publicity, the right has not been addressed by the state legislature.

The group discussed the effects that adopting a right of publicity statute would have on businesses such as casinos. Chairman Hise suggested contacting casinos in order to determine the potential effects of adopting such a law.

Adjournment

Chairman Hise adjourned the meeting at 12:30 P.M.

Respectfully Submitted,

Cheryn Baker
Assistant Secretary of State
Division of Policy and Research

Exhibit A

In Attendance:
Stephen Carmody
Jason Dean
Danny Drake
Jerome Hafter
John Healy
Dan Hise (Chairman)
Thomas Maley
Peter Marks
Jim Mingee
Ravi Raju
Whit Rayner
Bobby Thompson
Otis Tims (by telephone)

Secretary of State Staff:
Cory Wilson, Chief of Staff
Cheryn Baker, Assistant Secretary of State, Policy & Research
Tom Riley, Assistant Secretary of State, Business Services
Doug Jennings, Senior Attorney, Policy & Research
Phillips Strickland, Division Coordinator, Policy & Research
Brian Bledsoe, Intern, Policy & Research