

Topic: Trademark Registration and Enforcement

Question by: Pam Floyd

Jurisdiction: Washington

Date: 21 February 2011

Jurisdiction	Questions				
	<b>Does your office register Trademarks?</b>	<b>If yes, do you check the Federal TM database before you file a trademark?</b>	<b>What does your office do if you receive a complaint that either a trademark has been counterfeited or exists on the federal level, another state, or another country?</b>	<b>Does your office have regulatory authority, such as investigation or subpoena powers, or do you rely on your AG or local law enforcement?</b>	<b>Please cite your trademark laws for me.</b>
<b>Manitoba</b>					
<b>Corporations Canada</b>	Corporations Canada does not register trademarks. Trademarks in Canada are registered under the <i>Trade-marks Act</i> , <a href="http://laws.justice.gc.ca/en/t-13/index.html">http://laws.justice.gc.ca/en/t-13/index.html</a> , administered by the Canadian Intellectual Property Office.				

<b>Alabama</b>					
<b>Alaska</b>					
<b>Arizona</b>					
<b>Arkansas</b>					
<b>California</b>	Yes	No	The customer is informed that any person who counterfeits or infringes upon the rights of a registered mark, shall be subject to a civil action by the owner of the registered mark.	No, we do not have any regulatory authority. All actions must be accomplished through civil proceedings as outlined in California Business and Professions Code sections 14245 through 14259.	California Business and Professions Code sections 14200-14272.
<b>Colorado</b>	Yes.	No.	We advise the customer to seek legal counsel.	No. We do have the authority to issue interrogatories, but we very rarely do so.	7-70-101 through 7-70-109, C.R.S.  Also, the registrant is required to state that they are currently using the trademark in Colorado and that they believe, in good faith, that they have the right to use the trademark in connection with the goods or services identified and that the trademark does not infringe the rights of any other person in that trademark.
<b>Connecticut</b>	Yes	No	Nothing. We have no legal authority. Refer individual to own counsel.	No	Chapter 620a of the Connecticut General Statutes
<b>Delaware</b>					
<b>District of Columbia</b>	We call it "trade name".	No.	We advise customer to seek legal counsel.	For trade name we do not have power to cite the business. However,	DC CODE D. VIII, T. 47, Ch. 28, Subch. I-C

				the agency will not issue the license unless the applicant registers the trade name with us.	
<b>Florida</b>	Yes	Yes	The caller is told that the situation they describe is a private matter for the parties involved to resolve. If they are unable to reach a satisfactory agreement, it becomes a matter for the courts. The filing office does not get involved.	The Florida Division of Corporations does not have regulatory authority. Private disputes should be resolved by the parties involved. We do not push private matters off to the AG's office for resolution.	Chapter 495, F.S.
<b>Georgia</b>	Yes and service marks.	No.	We refer the individual to seek legal counsel.	No we do not.	OCGA Title 10, Article 16
<b>Hawaii</b>	Yes.	No. We use the USPTO link only to verify the correct Class number on pending TM/SM registrations in Hawaii.	We inform them on our name/mark registration review process and to whom the TM or SM is registered to.	We do not have regulatory authority.	HRS Chapter 482
<b>Idaho</b>					
<b>Illinois</b>	Yes, the State of Illinois registers both trademarks and service marks on the state level only.	No, we do not check the records of the USPTO as a basis for accepting marks in Illinois.	The Secretary of State of Illinois Trademark/Service Mark office accepts documents that meet the requirements put forth by the Illinois statutes and is a repository for such records. This office does not have any part in settling legal issues. The Registrant/owner of	No	Illinois Compiled Statutes  (765 ILCS 1036/) Trademark Registration and Protection Act

			the mark may seek his/her own legal counsel as disputes are settled with the parties involved and their attorneys.		
<b>Indiana</b>					
<b>Iowa</b>					
<b>Kansas</b>	Yes	We do not check the Federal TM database, but require the customer to tell us on our filing form that the mark is registered or is being registered Federally, as well as they sign a statement under penalty of perjury that to their knowledge no one else has filed federally or has rights to the mark.	Our office like Ohio does not have the authority to settle a dispute about a trademark conflict, we suggest they seek private legal counsel.	We do not have authority but we can refer issues to the AG's office.	K.S.A. 81-202-81-220 and 81-301.
<b>Kentucky</b>					
<b>Louisiana</b>	Yes	No	It is a matter for the courts.	AG's office	<a href="http://www.legis.state.la.us/lss/lss.asp?doc=104224">http://www.legis.state.la.us/lss/lss.asp?doc=104224</a>
<b>Maine</b>	Yes	No	Maine has not received any complaints	No, only ministerial duties.	<a href="http://www.mainelegislature.org/legis/statutes/10/title10ch301-Asec0.html">http://www.mainelegislature.org/legis/statutes/10/title10ch301-Asec0.html</a>
<b>Maryland</b>					
<b>Massachusetts</b>					
<b>Michigan</b>	Yes	No	We would recommend they contact an attorney.	The Corporation Division is an administrative agency and not an enforcement agency. The Attorney General's office is the enforcement	Michigan Public Act 242 of 1969. The link to the statute is: <a href="http://legislature.mi.gov/doc.aspx?mcl-Act-242-of-1969">http://legislature.mi.gov/doc.aspx?mcl-Act-242-of-1969</a>

				agency for the statutes administered by the Corporation Division.	
<b>Minnesota</b>	Yes	No	These are matters for the private parties. There is no trademark-specific state enforcement. The Attorney General has consumer fraud oversight and if the counterfeiting results in such, they could pursue it	OSS has no regulatory authority. The AG has that authority	Minnesota Statutes, sections 333.18 to 333.31 at: <a href="https://www.revisor.mn.gov/statutes/?id=333">https://www.revisor.mn.gov/statutes/?id=333</a>
<b>Mississippi</b>					
<b>Missouri</b>	Yes	No	Advise them the SOS has no authority in the matter and that they may wish to seek the advice of legal counsel.	SOS has no authority.	Trademarks are found in Chapter 417 of the Missouri Statutes, <a href="http://www.moga.mo.gov/statutes/c417.htm">http://www.moga.mo.gov/statutes/c417.htm</a>
<b>Montana</b>	Montana registers Trademarks and Service Marks	We do not check the Federal TM database, the customer is responsible for checking the database	Our office does not have the authority to settle disputes concerning trademark conflicts. We suggest that the customer seek their legal counsel as damages may be recovered by or on behalf of the injured party in any court of competent jurisdiction.	The Montana Secretary of State does not have regulatory authority	Trademark laws may be found in Title 30, Chapter 13, Part 3, Montana Code Annotated.
<b>Nebraska</b>	Yes	No	Advise them the SOS has no authority in the matter and that they may wish to seek the advice of legal counsel.	NO authority ----we would rely on our AG	Beginning at 87-126 to 87-144 <a href="http://uniweb.legislature.ne.gov/laws/browse-chapters.php?chapter=87">http://uniweb.legislature.ne.gov/laws/browse-chapters.php?chapter=87</a>
<b>Nevada</b>	Yes	No	Advise customer to	No, for trademark	<a href="http://www.leg.state.nv.us/">http://www.leg.state.nv.us/</a>

			seek private legal counsel.	filings. We do have a fraudulent filing statute, but we have not yet had a case involving a false or fraudulent trademark, nor do we expect any.	<a href="http://NRS/NRS-600.html">NRS/NRS-600.html</a>
<b>New Hampshire</b>	Yes	No	We inform them that we are a filing office and not an enforcement agency. They will need to seek recourse in the courts.	No, recording only.	<a href="http://www.gencourt.state.nh.us/rsa/html/NHTOC/NHTOC-XXXI-350-A.htm">http://www.gencourt.state.nh.us/rsa/html/NHTOC/NHTOC-XXXI-350-A.htm</a>
<b>New Jersey</b>					
<b>New Mexico</b>					
<b>New York</b>					
<b>North Carolina</b>	Yes.	Yes.	We advise them to seek legal counsel and proceed through the courts for a resolution	Local Law Enforcement	<a href="http://www.ncleg.net/gascripts/Statutes/StatutesTOC.pl?Chapter=0080">http://www.ncleg.net/gascripts/Statutes/StatutesTOC.pl?Chapter=0080</a> N.C.G.S. Chapter 80
<b>North Dakota</b>	Yes	No	The Secretary of State does not have authority to resolve these issues; these are civil matters to be resolved by the respective parties or the courts.	The Secretary of State does not have regulatory authority. Conflicts are resolved by the respective parties or the courts	North Dakota Century Code, Chapter 47-22 <a href="http://www.legis.nd.gov/ce/ncode/T47C22.pdf">http://www.legis.nd.gov/ce/ncode/T47C22.pdf</a>
<b>Ohio</b>	Yes, both trademarks and service marks.	We do not check the Federal TM database, but require the customer to check the database and verify on our filing form that the mark is available	Our office does not have the authority to settle a dispute about a trademark conflict, therefore, we suggest that the customer seek private legal counsel	We do not have regulatory authority, but issues can be referred to the Attorney General's Office, specifically the Consumer Protection Division	Our Trademark laws are in Ohio Revised Code Sections 1329.54-.99. ( <a href="http://codes.ohio.gov/orc/1329">http://codes.ohio.gov/orc/1329</a> )
<b>Oklahoma</b>					

<b>Oregon</b>	Yes. Oregon adopted a version of the Model State Trademarks Bill in 2009.	No.	We have not had such a complaint, but we do have the authority to inquire further, if we wish. In general, we tell people with disagreements to settle the matter in the proper venue (usually court) and show us the court finding.	We have some investigatory authority, but are not required to conduct an investigation or examination, and in practice, we would rely on other authorities, such as the USPTO or a court.	<a href="#">Oregon Revised Statute Ch. 647</a>
<b>Pennsylvania</b>					
<b>Rhode Island</b>					
<b>South Carolina</b>					
<b>South Dakota</b>					
<b>Tennessee</b>					
<b>Texas</b>	Yes	No	SOS has no administrative authority to take action. A suit to cancel a state registration may be filed by a person who believes the person will be damaged by a state registration. See §16.25 Tex. Bus. & Com. Code	SOS does not have regulatory authority. Private cause of action for infringement or counterfeiting. See §16.26 Tex. Bus. & Com. Code.	<a href="#">Chapter 16</a> of the Texas Business & Commerce Code.
<b>Utah</b>					
<b>Vermont</b>					
<b>Virginia</b>					
<b>Washington</b>					
<b>West Virginia</b>					
<b>Wisconsin</b>					
<b>Wyoming</b>					

**Additional comments:**

As a follow-up to your question, Montana does have the following language on our Trademark form.

The applicant states, under penalty of perjury, 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 the mark, either federally or in this state, or has the right to use the mark either in the identical form or in a form that so nearly resembles the mark as to be likely, when applied to the goods or services of the other person, to cause confusion, to cause mistake, or to deceive.

**Full text of email:**

All,

I have been asked to do some research on trademark registration programs in the other states. I would really appreciate any information that you all may have. My questions are:

1. Does your office register Trademarks?
2. If yes, do you check the Federal TM database before you file a trademark?
3. What does your office do if you receive a complaint that either a trademark has been counterfeited or exists on the federal level, another state, or another country?
4. Does your office have regulatory authority, such as investigation or subpoena powers, or do you rely on your AG or local law enforcement?
5. Please cite your trademark laws for me.

Thanks everyone for any and all information. I will be happy to put this in a summary and send it out when completed.

Pam

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