

TRADEMARKS & SERVICE MARKS

Annotated Code of Maryland
Business Regulation Article, Title 1, Subtitle 4



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October 2009

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ANNOTATED CODE OF MARYLAND
BUSINESS REGULATION ARTICLE

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**BUSINESS REGULATION ARTICLE,
TITLE 1.**

Subtitle 4. Trademarks, Service Marks, and Trade Names.

§ 1-401. Definitions.

(a) *In general.*— In this subtitle the following words have the meanings indicated.

(b) *Applicant.*— "Applicant" includes an assignee, legal representative, or successor of a person who submits an application for registration of a mark under this subtitle.

(c) *Mark.*— "Mark" means a name, symbol, word, or combination of 2 or more of these that a person:

(1) places on goods that the person sells or distributes, a container of the goods, a display associated with the goods, or a label or tag affixed to the goods to identify those goods that the person makes or sells and to distinguish them from goods that another person makes or sells; or

(2) displays or otherwise uses to advertise or sell services that the person performs to identify those services that the person performs and to distinguish them from services that another person performs.

(d) *Person.*— "Person" includes a governmental entity or unit or instrumentality of a governmental entity.

(e) *Registrant.*— "Registrant" includes an assignee, legal representative, or successor of a person who registers a mark under this subtitle.

(f) *Trade name.*— "Trade name" means a name, symbol, word, or combination of 2 or more of these that a person uses to identify the business or occupation of the person and to distinguish it from the business or occupation of another person.

§ 1-402. Effect of subtitle.

This subtitle does not affect adversely a right or the enforcement of a right in a mark acquired in good faith at any time at common law.

§ 1-403. Records.

The Secretary of State shall keep a public record of the marks registered under this subtitle.

§ 1-404. Registration authorized.

(a) *In general.*— If a person uses a mark in the State, the person may register the mark in accordance with this subtitle.

(b) *Exceptions.*— A person may not register a mark that:

- (1) is deceptive, immoral, or scandalous;
- (2) may disparage, falsely suggest a connection with, or bring into contempt or disrepute:
 - (i) a belief;
 - (ii) an individual, living or dead;
 - (iii) an institution; or
 - (iv) a national symbol;
- (3) is, simulates, or includes a coat of arms, flag, or other insignia of a government;
- (4) is or includes the name, portrait, or signature of a living individual, except with the written consent of the individual; or
- (5) is likely, when applied to the goods or services of the person, to confuse or deceive because the mark resembles:
 - (i) another mark registered in the State; or
 - (ii) a mark or trade name that another person has used in the State and has not abandoned.

(c) *Limited exception.*— (1) Unless the mark has become distinctive of the person's goods or services, a person may not register a mark that:

- (i) only describes or deceptively misdescribes goods or services;
- (ii) primarily describes or deceptively misdescribes the geographic origin of goods or services; or
- (iii) is primarily merely a surname.

(2) As evidence that a mark has become distinctive of the goods or services of a person, the Secretary of State may accept proof that the person has used the mark as a mark in the State or elsewhere continuously for at least 5 years immediately before the day on which the person applies for registration.

(d) *Registration of trade name prohibited.*— A person may not register a trade name that is not a mark.

§ 1-405. Classes of goods and services.

(a) *Goods.*— For convenience of administration of this subtitle, the general classes of goods under this subtitle are:

- (1) raw or partly prepared materials.
- (2) receptacles.

- (3) baggage, animal equipments, portfolios, and pocketbooks.
- (4) abrasives and polishing materials.
- (5) adhesives.
- (6) chemicals and chemical compositions.
- (7) cordage.
- (8) smokers' articles, not including tobacco products.
- (9) explosives, firearms, equipments, and projectiles.
- (10) fertilizers.
- (11) inks and inking materials.
- (12) construction materials.
- (13) hardware and plumbing and steam-fitting supplies.
- (14) metals and metal castings and forgings.
- (15) oils and greases.
- (16) paints and painters' materials.
- (17) tobacco products.
- (18) medicines and pharmaceutical preparations.
- (19) vehicles.
- (20) linoleum and oiled cloth.
- (21) electrical apparatus, machines, and supplies.
- (22) games, toys, and sporting goods.
- (23) cutlery, machinery, and tools, and parts thereof.
- (24) laundry appliances and machines.
- (25) locks and safes.
- (26) measuring and scientific appliances.
- (27) horological instruments.
- (28) jewelry and precious metalware.
- (29) brooms, brushes, and dusters.
- (30) crockery, earthenware, and porcelain.
- (31) filters and refrigerators.
- (32) furniture and upholstery.
- (33) glassware.
- (34) heating, lighting, and ventilating apparatus.
- (35) belting, hose, machinery packing, and nonmetallic tires.
- (36) musical instruments and supplies.
- (37) paper and stationery.

- (38) prints and publications.
- (39) clothing.
- (40) fancy goods, furnishings and notions.
- (41) canes, parasols, and umbrellas.
- (42) knitted, netted and textile fabrics, and substitutes therefor.
- (43) thread and yarn.
- (44) dental, medical, and surgical appliances.
- (45) soft drinks and carbonated waters.
- (46) foods and ingredients of foods.
- (47) wines.
- (48) malt beverages and liquors.
- (49) distilled alcoholic liquors.
- (50) merchandise not otherwise classified.
- (51) cosmetics and toilet preparations.
- (52) detergents and soaps.

(b) *Services.*— For convenience of administration of this subtitle, the general classes of services under this subtitle are:

- (53) miscellaneous.
- (54) advertising and business.
- (55) insurance and financial.
- (56) construction and repair.
- (57) communications.
- (58) transportation and storage.
- (59) material treatment.
- (60) education and entertainment.

(c) *Effect of classification.*— The classification of goods and services in this section does not limit or extend the rights of an applicant or registrant.

§ 1-406. Applications for registration.

(a) *In general.*— An applicant for registration of a mark shall:

- (1) submit to the Secretary of State:
 - (i) an application on the form that the Secretary of State provides; and
 - (ii) 3 specimens or reproductions of the mark; and
- (2) pay to the Secretary of State a fee of \$50.

(b) *Signature required.*— An application shall be signed, under oath:

- (1) for an individual, by the individual;
- (2) for a partnership, by a partner; or
- (3) for a corporation or association, by an officer of the corporation or association.

(c) *Contents of application.*— In addition to any other information required on an application form, the form shall require:

- (1) the name of the applicant;
- (2) the business address of the applicant;
- (3) for an applicant that is a corporation, the state of incorporation;
- (4) the goods or services with which the applicant uses the mark;
- (5) the way the applicant uses the mark with the goods or services;
- (6) the class under § 1-405 of this subtitle to which the goods or services belong;
- (7) the date when the applicant or the applicant's predecessor in business:
 - (i) first used the mark anywhere; and
 - (ii) first used the mark in the State; and
- (8) a statement that:
 - (i) the applicant owns the mark;
 - (ii) another person does not have the right to use the mark in the State; and
 - (iii) the mark is not deceptively similar to a mark that another person has a right to use in the State.

(d) *Scope of single application.*— A single application for registration of a mark:

- (1) may cover use of the mark with any number of goods or services in a single class; but
- (2) may not cover use of the mark with goods or services in different classes.

§ 1-407. Hearings.

(a) *Opportunity for hearing.*— Before denying registration of a mark, the Secretary of State shall give the applicant an opportunity for an informal hearing before the Secretary of State or the Secretary's designee.

(b) *Denial of registration of mark is not contested case.*— The denial of registration of a mark is not a contested case under Title 10, Subtitle 2 of the State Government Article.

§ 1-408. Repealed.

§ 1-409. Issuance and contents of certificate of registration.

(a) *Issuance.*— The Secretary of State shall register the mark of and issue a certificate of registration to each applicant who meets the requirements of this subtitle.

(b) *Contents.*— The Secretary of State shall include on each certificate of registration:

- (1) the signature of the Secretary of State, under the seal of the Secretary of State;
- (2) the name of the registrant;
- (3) the business of the registrant;
- (4) the address of the registrant;
- (5) for a registrant that is a corporation, the state of incorporation;
- (6) the date that the registrant claims to have first used the mark anywhere;
- (7) the date that the registrant claims to have first used the mark in the State;
- (8) a description of the goods or services with which the registrant uses the mark;
- (9) the class under § 1-405 of this subtitle to which the goods or services belong;
- (10) a reproduction of the mark;
- (11) the date of registration; and
- (12) the term of registration.

§ 1-410. Term and renewal of registration.

(a) *Term of registration.*— Unless registration of a mark is renewed for a 10-year term as provided in this section, the registration expires on the tenth anniversary of its effective date.

(b) *Renewal notice.*— Within 1 year before registration of a mark expires, the Secretary of State shall mail to the registrant, at the last known address of the registrant:

- (1) a renewal application form; and
- (2) a notice that states:
 - (i) the date on which the current registration expires;
 - (ii) the date by which the Secretary of State must receive the renewal application for the renewal to be issued and mailed before the registration expires; and
 - (iii) the amount of the renewal fee.

(c) *Application for renewal.*— Before the registration of a mark expires, the registrant periodically may renew it for an additional 10-year term if, within 6 months before the expiration of the term of the registration:

- (1) the registrant submits to the Secretary of State a renewal application on the form that the Secretary of State provides;

- (2) the registrant states in the renewal application that the mark is still in use in the State;
- (3) the mark otherwise is entitled to be registered; and
- (4) the registrant pays to the Secretary of State a renewal fee of \$50.

(d) *Issuance of renewal.*— The Secretary of State shall renew the registration of and issue a renewal certificate to each registrant who meets the requirements of this section.

§ 1-411. Assignment.

(a) *Authorized.*— A mark and its registration may be assigned with:

- (1) the good will of the business that uses the mark; or
- (2) that part of the good will of the business connected with the mark.

(b) *Manner of assignment.*— The assignment shall be by a written, signed instrument.

(c) *Recording an assignment.*— A person may record the assignment of registration of a mark by:

- (1) submitting the instrument of assignment to the Secretary of State; and
- (2) paying to the Secretary of State a fee of \$10.

(d) *Issuance of certificate.*— The Secretary of State shall record an assignment of the registration of a mark and issue a new certificate of registration in the name of the assignee to each person who meets the requirements of this section.

(e) *Term of assignment.*— The term of assignment is the rest of the term of registration of the mark.

(f) *Rights of subsequent purchaser.*— An assignment of the registration of a mark under this subtitle is void against a subsequent purchaser for valuable consideration without notice of the assignment unless the assignment is recorded with the Secretary of State:

- (1) within 3 months after the date of the assignment; or
- (2) before the subsequent purchase.

§ 1-412. Cancellation of registration.

(a) *In general.*— The Secretary of State shall cancel a registration of a mark if:

- (1) the registrant asks that it be canceled;
- (2) the registrant fails to renew it;
- (3) a court of competent jurisdiction orders that it be canceled on any ground; or
- (4) a court of competent jurisdiction finds that:
 - (i) the mark is abandoned;

- (ii) the registrant does not own the mark;
- (iii) the registration was granted improperly; or
- (iv) the registration was obtained fraudulently.

(b) *Registration in patent office.*— (1) Subject to paragraph (2) of this subsection, the Secretary of State shall cancel the registration of a mark if a court of competent jurisdiction finds the mark to be likely to confuse or deceive because it resembles a mark that:

- (i) was registered by another person in the United States Patent Office before the date the registrant applied for registration under this subtitle; and
- (ii) is not abandoned.

(2) The Secretary of State may not cancel the registration of a mark if the registrant proves that:

- (i) the registrant holds a concurrent registration of the mark in the United States Patent Office; and
- (ii) the registration in the United States Patent Office covers an area that includes the State.

§ 1-413. Fraudulent registration.

A person who, for the person or for another, applies to register or registers a mark under this subtitle by knowingly making a false or fraudulent representation, orally or in writing, or by other fraudulent means is liable for any damages sustained as a result of the application or registration.

§ 1-414. Infringement.

(a) *In general.*— Subject to § 1-402 of this subtitle, a person may not:

(1) use, without the consent of the registrant, a reproduction or colorable imitation of a mark registered under this subtitle in connection with the sale, offering for sale, or advertising of goods or services if the use is likely to confuse or deceive about the origin of the goods or services; or

(2) reproduce or colorably imitate a mark registered under this subtitle and apply the reproduction or colorable imitation to an advertisement, label, package, print, receptacle, sign, or wrapper that is intended to be used:

- (i) with goods or services; or
- (ii) in conjunction with the sale or other distribution of goods or services in the State.

(b) *Civil liability.*— (1) A person who violates this section is liable in a civil action to a registrant for any remedy provided in this section.

(2) A registrant may recover profits or damages from a person who violates subsection (a)(2) of this section only if the person intended that the mark be used to confuse or deceive.

(c) *Injunction authorized.*— A registrant may sue to enjoin the display, manufacture, sale, or use of a reproduction or colorable imitation of a mark of the registrant.

(d) *Judicial remedies.*— A court of competent jurisdiction may:

(1) grant an injunction to restrain the display, manufacture, sale, or use of a reproduction or colorable imitation of a registered mark;

(2) require the defendant to pay to the registrant for the wrongful display, manufacture, sale, or use of a reproduction or colorable imitation of a mark:

(i) any profit that the defendant derived;

(ii) any damages that the registrant suffered; or

(iii) both; and

(3) require the defendant to deliver to an officer of the court or to the registrant, for destruction, any reproduction or colorable imitation of the mark that is in the possession or under the control of the defendant.

§ 1-415. Fraudulent use or imitation of trade names.

(a) *Prohibited.*— Except as provided in subsection (b) of this section, a person may not, with intent to defraud, do business in the State under or imitate a name, title, or trade name that is the same as, or similar to, that used by another person already doing business in the State.

(b) *Exception.*— This section does not apply to individuals with similar names.

(c) *Penalty.*— A person who violates this section is guilty of a misdemeanor and, on conviction, is subject to a fine not exceeding \$100 for each day that the offense is committed.