

REGISTRATION AND PROTECTION OF MARKS

548.1 through 548.100 Reserved.

548.101 Definitions.

As used in this chapter, unless the context otherwise requires:

1. *"Abandoned"* means the occurrence of any of the following in relation to a mark:
 - a. The use of the mark has been discontinued with intent not to resume such use. Intent not to resume may be inferred from circumstances. Nonuse for two consecutive years shall constitute prima facie evidence of abandonment.
 - b. A course of conduct of the owner of the mark, including acts of omission as well as commission, causes the mark to lose its significance as a mark.
2. *"Applicant"* means a person filing an application for registration of a mark under this chapter, and the person's legal representative, successor, or assignee.
3. *"Dilution"* means the lessening of the capacity of a mark to identify and distinguish goods or services, regardless of the presence or absence of any of the following:
 - a. Competition between parties.
 - b. Likelihood of confusion, mistake, or deception.
4. *"Mark"* means a trademark or service mark, entitled to registration under this chapter, whether registered or not.
5. *"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 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.
6. *"Registrant"* means a person to whom the registration of a mark under this chapter is issued, and the legal representative, successor, or assignee of such person.
7. *"Secretary"* means the secretary of state or the designee of the secretary charged with the administration of this chapter.
8. *"Service mark"* means a word, name, symbol, or device or any combination of a word, name, symbol, or device, used by a person to identify services and to distinguish the services of that 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 a sponsor.
9. *"Trademark"* means a word, name, symbol, or device or any combination of a word, name, symbol, or device, used by a person to identify and distinguish the goods of that person, including a unique product, from those manufactured and sold by others, and to indicate the source of the goods, even if that source is unknown.

10. "*Trade name*" means a name used by a person to identify a business or vocation of such person.

11. "*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 under any of the following circumstances:

- a. On goods sold or transported in commerce in this state when the mark is placed in any manner on the goods or containers or associated displays, or on affixed tags or labels, or if the nature of the goods makes the placement on the goods or containers impracticable, on documents associated with the goods or their sale.
- b. On services when the mark is used or displayed in the sale or advertising of services and the services are rendered in this state.

[C71, 73, 75, 77, 79, 81, § 548.1]

94 Acts, ch 1090, §1

C95, §548.101

95 Acts, ch 49, § 15; 95 Acts, ch 67, § 38, 39

548.102 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 the mark meets any of the following criteria:

1. Consists of or comprises immoral, deceptive, or scandalous matter.
2. Consists of or comprises matter which may disparage, bring into contempt or disrepute, or falsely suggest a connection with persons, living or dead, institutions, beliefs, or national symbols, or bring them into contempt, or disrepute.
3. Consists of or comprises the flag, or coat of arms, or other insignia of the United States, or of any state or municipality, or of any foreign nation, or any simulation thereof.
4. Consists of, or comprises the name, signature, or portrait identifying a particular living individual, except by the individual's written consent.
5. Consists of a mark which is one of the following:
 - a. When used on or in connection with the goods or services of the applicant, is merely descriptive or deceptively misdescriptive of the goods or services.
 - b. When used on or in connection with the goods or services of the applicant, is primarily geographically descriptive or geographically misdescriptive of the goods or services.
 - c. Is primarily merely a surname.

This subsection 5 does not 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 years before the date on which the claim for distinctiveness is made.

6. 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, so 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.

[C71, 73, 75, 77, 79, 81, § 548.2]

86 Acts, ch 1087, §1, 2; 94 Acts, ch 1090, §2

C95, §548.102

95 Acts, ch 67, § 40

548.103 Application for registration.

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

1. The name and business address of the person applying for registration; and if a corporation, the state of incorporation, or if a partnership, the state in which the partnership is organized and the names of the general partners, as specified by the secretary.
2. The goods or services on or in connection with which the mark is in use, the mode or manner in which the mark is used on or in connection with those goods or services, and the class in which such goods or services fall, as described in rules adopted by the secretary.
3. The date on which the mark was first used anywhere by the applicant or the applicant's predecessor in interest.
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 or in such resemblance to the form as to be likely, when applied to the goods or services of such other person, to cause confusion or mistake, or to deceive.

The secretary may also require a statement as to whether an application to register the mark, or portions or a composite of the mark, 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 to the filing including the filing date and serial number of each application, the status of the application and if any application was finally refused registration or has otherwise not resulted in a registration, the reasons therefor.

The secretary may also require that a drawing of the mark, complying with such requirements as the secretary may specify, accompany the application.

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.

The application shall be accompanied by a specimen showing the mark as actually used.

The application shall be accompanied by the application fee payable to the secretary.

[C97, § 5049; C24, 27, 31, 35, 39, § **9867, 9868, 9870**; C46, 50, 54, 58, 62, 66, § 548.1, 548.2, 548.4; C71, 73, 75, 77, 79, 81, §548.3]

94 Acts, ch 1090, §3

C95, §548.103

97 Acts, ch 44, §1

548.104 Filing of applications.

1. 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.
2. 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 the applicant to be advisable to respond to any rejection or objection.
3. The secretary may require the applicant to disclaim an unregistrable component of a mark otherwise registrable, and an applicant may voluntarily disclaim a component of a mark sought to be registered. A disclaimer shall not prejudice or affect the applicant's or registrant's rights existing at or after the time of disclaimer arising in the disclaimed matter, or the applicant's or registrant's rights of registration on another application if the disclaimed matter is or becomes distinctive of the applicant's or registrant's goods or services.
4. Amendments may be made by the secretary upon the application submitted by the applicant upon the applicant's agreement, or the secretary may require a new application to be submitted.
5. 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 be reexamined. This procedure may be repeated until the secretary finally refuses registration of the mark or the applicant fails to reply or amend within the specified period, whereupon the application shall be deemed to have been abandoned.
6. If the secretary finally refuses registration of the mark, the applicant may seek judicial review of the refusal in accordance with chapter 17A.
7. If the secretary is concurrently processing applications 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 an application filed earlier is granted a registration, a later application shall 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 548.109.

94 Acts, ch 1090, §4

548.105 Certificate of registration.

Upon compliance by the applicant with the requirements of this chapter, the secretary shall issue and deliver a certificate of registration to the applicant. The certificate of registration shall be issued under the signature and seal of the secretary. The certificate of registration shall show the name and business address and, if a corporation, the state of incorporation, or if a partnership, the state in which the partnership is organized and the names of the general partners, as specified by the secretary, of the person claiming ownership of the mark. The certificate of registration shall also show 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 description of the mark, the registration date, and the term of the registration.

A certificate of registration issued by the secretary under this section 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 an action or judicial proceeding in any court in this state.

[C97, § 5049; C24, 27, 31, 35, 39, § **9868, 9869**; C46, 50, 54, 58, 62, 66, §548.2, 548.3; C71, 73, 75, 77, 79, 81, § 548.4]

94 Acts, ch 1090, §5

C95, § 548.105

97 Acts, ch 44, §2

548.106 Duration and renewal.

A registration of a mark under this chapter shall be effective for a term of five years from the date of registration and, upon application filed within six months prior to the expiration of the 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 an application for renewal of registration.

A registration may be renewed for successive periods of five years in like manner.

A registration in force on the date on which this chapter shall become effective shall continue in full force and effect for the unexpired term thereof and may be renewed by filing an application for renewal with the secretary complying with the requirements of the secretary and paying the renewal fee within six months prior to the expiration of the registration.

All applicants for renewal under this chapter, whether of registration made under this chapter or of registrations effected under any prior statute, 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.

[C46, 50, 54, 58, 62, 66, § 548.6; C71, 73, 75, 77, 79, 81, § 548.5]

94 Acts, ch 1090, §6

C95, § 548.106

548.107 Assignments, changes of name, and other instruments.

1. A mark and its registration under this chapter is 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 a duly executed written instrument which may be recorded with the secretary upon the payment of a recording fee to the secretary, who, upon recording of the assignment, shall issue a new certificate in the name of the assignee for the remainder of the term of the assigned registration or of the last renewal of the registration. An assignment of a registration under this chapter shall be void as against any subsequent purchase for valuable consideration without notice, unless the assignment is recorded with the secretary within three months after the date of the assignment or prior to such subsequent purchase.

2. A 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 a certificate of registration of an assigned application in the name of the assignee. 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 of the registration.

3. 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, if such instrument is in writing and duly executed.

4. 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.

5. A photocopy of any instrument referred to in subsections 1 through 3, shall be accepted for recording if it is certified by any of the parties to the registration, or their successors, to be a true and correct copy of the original.

[C46, 50, 54, 58, 62, 66, § 548.5; C71, 73, 75, 77, 79, 81, §548.6]

94 Acts, ch 1090, §7

C95, §548.107

548.108 Records.

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 548.107.

94 Acts, ch 1090, §8

548.109 Cancellation.

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

1. A registration concerning which the secretary receives a voluntary request for cancellation from the registrant or the assignee of record.

2. A registration granted under this chapter and not renewed in accordance with this chapter.

3. A registration concerning which a district court finds any of the following:

a. That the registered mark has been abandoned.

b. That the registrant is not the owner of the mark.

c. That the registration was granted improperly.

d. That the registration was obtained fraudulently.

e. That the mark has become the generic name for the goods or services, or a portion of the goods or services, for which the mark has been registered.

f. 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 under this chapter, and not abandoned. However, if the registrant proves 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 under this chapter shall not be canceled for such area of the state.

4. A registration ordered canceled by a court on any ground.

[C71, 73, 75, 77, 79, 81, § 548.7]

94 Acts, ch 1090, §9

C95, § 548.109

548.110 Classification.

The secretary shall by rule establish a classification of goods and services for convenience in the administration of this chapter, but not 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. If 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.

[C71, 73, 75, 77, 79, 81, § 548.8]

94 Acts, ch 1090, §10

C95, §548.110

548.111 Fraudulent registration.

A person who, either on the person's own behalf or on behalf of any other person, procures the filing or registration of a mark in the office of the secretary under this chapter by knowingly making any false or fraudulent representation or declaration, orally or in writing, or by any other fraudulent means, is liable for the damages sustained in consequence of the filing or registration to be recovered by or on behalf of the party injured in district court.

[C71, 73, 75, 77, 79, 81, § 548.9]

94 Acts, ch 1090, §11

C95, §548.111

548.112 Infringement.

Subject to section 548.116, a person shall not do any of the following:

1. 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.

2. 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.

The person shall be liable in a civil action by the registrant for any or all of the remedies provided in section 548.114, except that under subsection 2, 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.

[C97, § 5051; C24, 27, 31, 35, 39, § **9874**; C46, 50, 54, 58, 62, 66, 71, 73, 75, 77, 79, 81, § 548.10]

94 Acts, ch 1090, §12

C95, § 548.112

548.113 Injury to business reputation dilution.

The owner of a mark which is famous in this state shall be entitled, subject to the principles of equity, to an injunction against another's use of a mark, commencing after the owner's mark becomes famous, which causes dilution of the distinctive quality of the owner's mark, and to obtain such other relief as is provided in this section. In determining whether a mark is famous, a court may consider factors such as, but not limited to:

1. The degree of inherent or acquired distinctiveness of the mark in this state.
2. The duration and extent of use of the mark in connection with the goods and services.
3. The duration and extent of advertising and publicity of the mark in this state.
4. The geographical extent of the trading area in which the mark is used.
5. The channels of trade for the goods or services with which the owner's mark is used.
6. The degree of recognition of the owner's mark in its and in the other's trading areas and channels of trade in this state.
7. The nature and extent of use of the same or similar mark by third parties.

The owner shall be entitled only to injunctive relief in this state in an action brought under this section, unless the subsequent user willfully intended to trade on the owner's reputation or to cause dilution of the owner's mark. If such willful intent is proven, 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.

94 Acts, ch 1090, §13

548.114 Remedies.

The 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 of the mark and any court may grant injunctions to restrain such manufacture, use, display, or sale as the court deems just and reasonable, and may require the defendants to pay to such owner all profits derived from or all damages suffered by reason of such wrongful manufacture, use, display, or sale. The court may also order that any counterfeits or imitations in the possession or under the control of a defendant 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 times such profits and damages and reasonable attorneys' fees of the prevailing party in 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.

The enumeration of any right or remedy in this section shall not affect a registrant's right to prosecute under any penal law of this state.

[C97, § 5050, 5051; C24, 27, 31, 35, 39, § **98719873, 9875**; C46, 50, 54, 58, 62, 66, § 548.7548.9, 548.11; C71, 73, 75, 77, 79, 81, § 548.11]

94 Acts, ch 1090, §14

C95, §548.114

548.115 Forum for actions regarding registration service on out-of-state registrants.

1. Actions to require cancellation of a mark registered pursuant to this chapter shall be brought in district court. 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 district court in which it is filed and shall be given the right to intervene in the action.

2. In an action brought against a nonresident registrant, service may be effected upon the secretary as agent for service of the registrant in accordance with the procedures established for service upon nonresident corporations and business entities under section 617.3.

94 Acts, ch 1090, §15

548.116 Common law rights.

This chapter shall not adversely affect the rights or the enforcement of rights in marks acquired in good faith at any time at common law.

94 Acts, ch 1090, §16

548.117 Fees.

The secretary shall by rule adopted pursuant to chapter 17A prescribe the fees payable for the various applications and recording fees and for related services. Unless specified by the secretary, the fees payable pursuant to this chapter are not refundable.

94 Acts, ch 1090, §17