

WEST VIRGINIA
SECRETARY OF STATE
KEN HECHLER
ADMINISTRATIVE LAW DIVISION

Form #6

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JUN 12 3 20 PM '97

OFFICE OF WEST VIRGINIA
SECRETARY OF STATE

**NOTICE OF FINAL FILING AND ADOPTION OF A LEGISLATIVE RULE AUTHORIZED
BY THE WEST VIRGINIA LEGISLATURE.**

AGENCY: SECRETARY OF STATE TITLE NUMBER: 153

AMENDMENT TO AN EXISTING RULE: YES , NO

IF YES, SERIES NUMBER OF RULE BEING AMENDED: _____

TITLE OF RULE BEING AMENDED: _____

IF NO, SERIES NUMBER OF NEW RULE BEING PROPOSED: 29

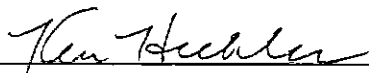
TITLE OF RULE BEING PROPOSED: TRADEMARKS AND SERVICE MARKS

THE ABOVE RULE HAS BEEN AUTHORIZED BY THE WEST VIRGINIA LEGISLATURE.

AUTHORIZATION IS CITED IN (house or senate bill number) SB 209

SECTION 64-9-2(c), PASSED ON APRIL 12, 1997

THIS RULE IS FILED WITH THE SECRETARY OF STATE. THIS RULE BECOMES EFFECTIVE ON
THE FOLLOWING DATE: JUNE 12, 1997



AUTHORIZED SIGNATURE

TITLE 153
LEGISLATIVE RULES
SECRETARY OF STATE

OCT 24 3 25 PM '98

SERIES 29
TRADEMARKS AND SERVICE MARKS

OFFICE OF THE
SECRETARY OF STATE

§153-29-1. General.

1.1. Scope. -- This legislative rule establishes the requirements for filing applications with the Secretary of State, for the approval of registration trademarks and service marks, and for the renewal, assignment, modification and cancellation of registration of those marks.

1.2. Authority. -- W. Va. Code §47-2-10.

1.3. Filing Date. --

1.4. Effective Date. --

FILED
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OFFICE OF WEST VIRGINIA
SECRETARY OF STATE

§153-29-2. Application for New Registration.

2.1. An applicant shall apply for a new registration of a trademark or service mark not previously registered in the state on the form issued by the Secretary of State.

2.2. The application shall include the following:

2.2.a. A statement that the application is for a new registration of a trademark or service mark not previously registered;

2.2.b. The name of the applicant;

2.2.c. The business address of the applicant, which shall be an address at which mail can be received;

2.2.d. The state in which the corporation or partnership is organized if the applicant is a corporation or partnership;

2.2.e. The names of the general partners if the applicant is a partnership;

2.2.f. The type of goods or services on or in connection with which the trademark or service mark is used, including whether the use relates to goods or to services, a description of the goods or services, the mode or manner in which the mark is used, and the class of those good or services, as defined in section 6 of this rule;

2.2.g. Whether the trademark or service mark for which the application is made consists of a graphic symbol only, a graphic symbol including words or letters, words or letters in a specific typography, or words or letters only, without regard to typography;

2.2.h. A brief description of the trademark or service mark;

2.2.i. The date on which the trademark or service mark was first used in connection with a product or service anywhere, and the date on which the mark was first used in connection with a product or service in West Virginia;

2.2.j. A black and white drawing or representation of the trademark or service mark, which shall be placed on the standardized Attachment 1 of the application, labeled with the name of the applicant;

2.2.j.1. The representation shall be enlarged or reduced so that the longer dimension of the mark is no less than five inches and no more than six inches; and

2.2.j.2. If the applicant desires to designate specific colors in which the mark will appear, the applicant shall supply an additional copy labeled Attachment 1A with the areas of color labeled.

2.2.k. Three specimens showing the trademark or service mark as actually used, which shall be attached and marked Attachments 2, 3, and 4, respectively;

2.2.k.1. The specimens of the mark shall be two dimensional (flat), no larger than a standard 8 1/2 by 11 inch page, and if smaller, shall be attached to a standard page.

2.2.k.2. The specimens may be actual samples of items in use if those samples are flat and no larger than specified in this subdivision, such as letterhead, labels, printed advertising or other similar items.

2.2.k.3. The specimens may be submitted as clear photographs or copies of photographs showing the item as it is used, but any photograph shall show all or substantially all of the item on which the mark is used.

2.2.k.4. If more than one classification of use is listed in the application, at least one specimen should be included for each class, with a minimum total number of three specimens.

2.2.l. Whether an application to register the trademark or service mark, or portions or a composite of the mark has been filed by the same applicant or a predecessor in interest with the United States Patent and Trademark Office. If the mark has been filed, the applicant shall give the date filed, the serial number of the registration, if any, and whether the application is pending, approved and the date approved, or refused and the reason for refusal;

2.2.m. A statement that the applicant is the owner of the trademark or service mark for the application is made, that the mark is in use, that to the applicant's knowledge, no other person has registered the mark, either federally or in the state, or has the right to use the mark either in the identical

form thereof or in such near resemblance to it as to be likely, when applied to the goods or services of that person, to cause confusion or to cause mistake or to deceive, and that the information contained in the application is true to the best of the applicant's knowledge; and

2.2.n. The date, name, title and signature of the applicant, acknowledged before a notary public.

2.3. The applicant shall submit a complete application with all required attachments to the Secretary of State along with the fee prescribed in subdivision 7.1.a. of this rule.

§153-29-3. Review and Approval of New Registration.

3.1. Upon receipt of an application for registration, the Secretary of State shall enter the received date and determine if the application is complete.

3.1.a. The Secretary of State shall cancel the received date stamp if the application is incomplete.

3.1.b. The Secretary of State shall return an incomplete application in its entirety to the applicant within five (5) days of receipt.

3.1.c. The Secretary of State shall refund the application fee to the applicant within sixty (60) days if a complete application is not resubmitted within thirty (30) days.

3.2. The Secretary of State shall evaluate the trademark or service mark in relation to prohibitions enumerated in W. Va. Code §47-2-2, and shall reject the application if the mark:

3.2.a. Consists of or comprises immoral, deceptive or scandalous matter;

3.2.b. Consists of or comprises matter which may disparage or falsely suggest a connection with persons, living or dead, institutions, beliefs, or national symbols, or bring them into contempt or disrepute;

3.2.c. Consists of or comprises or contains 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; or

3.2.d. Consists of or comprises the name, signature or portrait identifying a particular living individual, except by the individual's specific written consent contained in an attachment to the application.

3.3. Unless the applicant provides, as an attachment to the application, proof that the trademark or service mark has become distinctive of the applicant's goods or services, and that the mark has been in continuous use in this state by the applicant for the five (5) years before the date of the application, the Secretary of State shall reject the mark if it:

3.3.a. Is merely descriptive or deceptively misdescriptive of the goods or services in connection with which the mark is used;

3.3.b. Is primarily geographically descriptive or deceptively misdescriptive of the goods or services; or

3.3.c. Is primarily a surname.

3.4. The Secretary of State shall reject the application if the mark consists of or comprises a mark registered in this state or a mark or trade name used by another and not abandoned, as to be likely, when used in connection with the goods or services of the applicant, to cause confusion or mistake or to deceive.

3.4.a. When the mark consists of or contains words or letters, the Secretary of State shall reject the application if the words or letters are the same as or deceptively similar to the name of a registered domestic corporation, foreign corporation, domestic or foreign limited partnership or limited liability partnership or domestic or foreign limited liability company authorized to do business in this state at the time of the application for registration of the mark, or the reserved or registered name of any of these businesses, unless the application is made by the business or with the written permission of the business.

3.4.b. When the mark consists primarily of graphic elements, the Secretary of State shall examine currently registered marks for similarity in type, characterization, number and positions of figures, similarity in the use of geometric shapes or lines and the number or relations of those shapes or lines, and similarity in the combination of all element types.

3.4.c. When the mark consists of a combination of words or letters and graphic elements, the Secretary of State shall first examine the similarity of the words or letters, and if the words or letters are found to be registrable, shall then examine the graphic elements. If the graphic elements are found not to be registrable, the Secretary of State shall, depending on the degree of similarity, either reject the application or notify the applicant of the elements of the mark which must be removed or changed in order for the application to be registrable.

3.5. If the Secretary of State rejects the application or notifies the applicant of required changes, the Secretary of State shall notify the applicant of the reason for the rejection or required changes.

3.5.a. Upon rejection of a mark, the applicant has thirty (30) days in which to reply to the Secretary of State or to amend the application, and upon receipt of a reply or an amended application, the Secretary of State shall reexamine the mark.

3.5.b. If the applicant fails to respond to the rejection of the mark within the time allowed in subsection 3.6. of this rule, the Secretary of State shall consider the application to be abandoned.

3.5.c. The Secretary of State may finally refuse the application after two (2) periods of attempted amendment which do not result in an acceptable mark.

3.6. Upon acceptance of the application for registration, the Secretary of State shall enter the effective date of the registration, assign a registration number, and issue a certificate of registration.

§153-29-4. Renewal of Registration.

4.1. The registration of a trademark or service mark registered prior to July 1, 1996, expires on June 30, 2001, as provided in W. Va. Code §47-2-6(c), unless renewed before that date.

4.2. The registration of a mark first registered after July 1, 1996, expires ten (10) years following the effective date of registration.

4.3. The Secretary of State may attempt to notify current registrants of an impending registration expiration and provide forms for the application for renewal of a mark, but the registrant is responsible for obtaining the proper form and submitting a complete application for renewal in a timely manner.

4.4. The application shall be submitted on the forms prescribed by the Secretary of State.

4.5. The applicant may submit the application for renewal within the six (6) months immediately before the expiration of the current registration.

4.5.a. The Secretary of State shall return an application for renewal submitted more than six (6) months before the expiration of the registration; except that:

4.5.b. A registrant holding a mark registered before July 1, 1996, may apply for renewal under the provisions of the new law at any time before the expiration of the previous registration on June 30, 2001.

4.6. Upon the receipt of a complete application for renewal, including a verified statement that the mark has been and is still in use, and the submission of the required fee as provided in subdivision 7.1.2. of this rule, the Secretary of State shall issue a certificate of registration renewal.

§153-29-5. Assignments, Changes and Cancellation.

5.1. A registrant may assign the trademark or service mark to another person, record a change of name, or record other instruments relating to the mark or pending application. To assign the mark, the registrant or assignee shall file an instrument in writing signed by the registrant and notarized, either as an original document or a photocopy certified by any of the parties as a true and correct copy of the original. The filing shall be accompanied by the required fee as provided in subdivision 7.1.3. of this rule.

5.2. A registrant may record an assignment of the mark to another person with the Secretary of State, and the secretary shall issue in the name of the assignee or successor in interest a new certificate for the remainder of the term of the registration or renewal.

5.3. A registrant or applicant whose name is changed during the period of registration or application may record a certificate of change of name with the Secretary of State.

5.4. Upon filing the change of name, the Secretary of State shall issue a registrant a certificate for the remainder of the term in the new name, and shall attach the change of name to the application.

5.5. The registrant or successor in interest may voluntarily cancel the registration of a mark upon filing of an request signed by the registrant or authorized representative of the registrant or successor in interest and acknowledged before a notary public, providing the request is accompanied by the required fee as provided in subdivision 7.1.3. of this rule.

§153-29-6. Classification of Goods and Services.

6.1. Goods shall be classified according the system established by the United States Patent and Trademark Office, as follows:

6.1.a. Chemicals products used in industry, science, photography, agriculture, horticulture, forestry; artificial and synthetic resins; plastics in the form of powders, liquids or pastes for industrial use; manures (natural and artificial); fire extinguishing compositions; tempering substances and chemical preparations for soldering; chemical substances for preserving foodstuffs; tanning substances; and adhesive substances used in industry;

6.1.b. Paints, varnishes, lacquers; preservatives against rust and against deterioration of wood; coloring matters and dyestuffs; mordants; natural resins; and metals in foil and powder form for painters and decorators;

6.1.c. Bleaching preparations and other substances for laundry use; cleaning, polishing, scouring and abrasive preparations; soaps; perfumery, essential oils, cosmetics, hair lotions; and dentifrices;

6.1.d. Industrial oils and greases (other than oils and fats and essential oils); lubricants; dust laying and absorbing compositions; fuels (including motor spirit) and illuminants; and candles, tapers, night lights and wicks;

6.1.e. Pharmaceutical, veterinary, and sanitary substances; infants' and invalids' food; plasters and material for bandaging; material for stopping teeth, dental wash and disinfectants; and preparations for killing weeds and destroying vermin;

6.1.f. Unwrought and partly wrought common metals and their alloys; anchors, anvils, bells, and rolled and cast building materials; rails and other metallic materials for railway tracks; chains (except driving chains for vehicles); cables and wires (nonelectric); locksmiths' work; metallic pipes and tubes; safes and cash boxes; steel balls; horseshoes; nails and screws; other goods in nonprecious metal not included in other classes; and ores;

6.1.g. Machines and machine tools; motors (except for land vehicles); machine couplings and belting (except for land vehicles); large size agricultural implements; and incubators;

6.1.h. Hand tools and instruments; cutlery, forks, and spoons; and side arms;

6.1.i. Scientific, nautical, surveying and electrical apparatus and instruments (including wireless), photographic, cinematographic, optical, weighing, measuring, signaling, checking (supervision), life-saving and teaching apparatus and instruments; coin or counter feed apparatus; talking machines; cash registers; calculating machines; and fire extinguishing apparatus;

6.1.j. Surgical, medical, dental, and veterinary instruments and apparatus (including artificial limbs, eyes and teeth);

6.1.k. Installations for lighting, heating, steam generating, cooking, refrigerating, drying, ventilating, water supply, and sanitary purposes;

6.1.l. Vehicles; and apparatus for locomotion by land, air or water;

6.1.m. Firearms; ammunition and projectiles; explosive substances; and fireworks;

6.1.n. Precious metals and their alloys and goods in precious metals or coated with precious metals (except cutlery, forks and spoons); and jewelry, precious stones, horological and other chronometric instruments;

6.1.o. Musical instruments (other than talking machines and wireless apparatus);

6.1.p. Paper and paper articles, cardboard and cardboard articles; printed matter, newspaper and periodicals, and books; bookbinding material; photographs; stationery, adhesive materials (stationery); artists' materials; paint brushes; typewriters and office requisites (other than furniture); instructional and teaching material (other than apparatus); playing cards; printers' type and clichés (stereotype);

6.1.q. Gutta percha, india rubber, balata and substitutes, and articles made from these substances and not included in other classes; plastics in the form of sheets, blocks and rods, for use in manufacture; materials for packing, stopping or insulating; asbestos, mica and their products; and hose pipes (nonmetallic);

6.1.r. Leather and imitations of leather, and articles made from these materials and not included in other classes; skins, and hides; trunks and traveling bags; umbrellas, parasols and walking sticks; and whips, harness and saddlery;

6.1.s. Building materials, natural and artificial stone, cement, lime, mortar, plaster and gravel; pipes of earthenware or cement; road making materials; asphalt, pitch and bitumen; portable buildings; stone monuments; and chimney pots;

6.1.t. Furniture, mirrors, and picture frames; and articles (not included in other classes) of wood, cork, reeds, cane, wicker, horn, bone, ivory, whalebone, shell, amber, mother-of-pearl, meerschaum celluloid, and substitutes for all these materials, or of plastics;

6.1.u. Small domestic utensils and containers (not of precious metals, or coated with precious metals); combs and sponges; brushes (other than paint brushes); brush making materials; instruments and material for cleaning purposes, and steel wool; unworked or semi-worked glass (excluding glass used in building); and glassware, porcelain and earthenware, not included in other classes;

6.1.v. Ropes, string, nets, tents, awnings, tarpaulins, sails, and sacks; padding and stuffing materials (hair, kapok, feathers, seaweed, etc.); and raw fibrous textile materials;

6.1.w. Yarns and threads;

6.1.x. Tissues (piece goods); bed and table covers; and textile articles not included in other classes;

6.1.y. Clothing, including boots, shoes and slippers;

6.1.z. Lace and embroidery, ribands, and braid; buttons, press buttons, hooks and eyes, and pins and needles; and artificial flowers;

6.1.aa. Carpets, rugs, mats and matting; linoleums and other materials for covering existing floors; and wall hangings (nontextile);

6.1.bb. Games and playthings; gymnastic and sporting articles (except clothing); and ornaments and decorations for Christmas trees;

6.1.cc. Meats, fish, poultry and game; meat extracts; preserved, and dried and cooked fruits and vegetables; jellies, jams; eggs, milk and other dairy products; edible oils and fats; and preserves and pickles;

6.1.dd. Coffee, tea, cocoa, sugar, rice, tapioca, sago and coffee substitutes; flour and preparations made from cereals; bread, biscuits, cakes, pastry and confectionery and ices; honey and treacle; yeast and baking powder; salt, mustard, pepper, vinegar, sauces and spices; and ice;

6.1.ee. Agricultural, horticultural and forestry products and grains not included in other classes; living animals; fresh fruits and vegetables; seeds; live plants and flowers; and foodstuffs for animals and malt;

6.1.ff. Beer, ale and porter; mineral and aerated waters and other nonalcoholic drinks; and syrups and other preparations for making beverages;

6.1.gg. Wines, spirits and liqueurs; and

6.1.hh. Tobacco, raw or manufactured; smokers' articles; and matches.

6.2. Services shall be classified according the system established by the United States Patent and Trademark Office, as follows:

6.2.a. Advertising and business;

6.2.b. Insurance and financial;

6.2.c. Construction and repair;

6.2.d. Communication;

6.2.e. Transportation and storage;

6.2.f. Material treatment;

6.2.g. Education and entertainment; and

6.2.h. Miscellaneous.

§153-29-7. Fees.

7.1. The fees for filing documents under this rule as provided by W. Va. Code §47-2-17 are:

7.1.a. For registration of a new trademark or service mark involving not more than two classifications, fifty dollars, and for each additional classification, fifty dollars;

7.1.b. For renewal of a previously registered trademark or service mark involving not more than two classifications, fifty dollars, and for each additional classification, fifty dollars;

7.1.3. For recording any assignment, change of name, other document, or cancellation as provided in section 5 of this rule, twenty-five dollars.

7.2. All fees shall be made payable to the Secretary of State.

KEN HECHLER
Secretary of State

MARY P. RATLIFF
Deputy Secretary of State

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(Plus all the volunteer
help we can get)

TO: MARY RATLIFF

AGENCY: SECRETARY OF STATE

FROM: JUDY COOPER, DIRECTOR, ADMINISTRATIVE LAW DIVISION

DATE: September 5, 1997

OFFICE OF WEST VIRGINIA
SECRETARY OF STATE

SEP 15 2 44 PM '97

FILED

THE ATTACHED RULE FILED BY YOUR AGENCY HAS BEEN ENTERED INTO OUR COMPUTER SYSTEM. PLEASE REVIEW, PROOF AND RETURN IT WITH ANY CORRECTIONS. IF THERE ARE NO CORRECTIONS, PLEASE SIGN THIS MEMO AND RETURN IT TO THIS OFFICE. YOU WILL BE SENT A FINAL VERSION OF THE RULE FOR YOUR RECORDS.

PLEASE RETURN EITHER THE CORRECTED RULE OR THIS FORM WITHIN TEN (10) WORKING DAYS OF THE DATE YOU RECEIVED THIS REQUEST. CALL IF YOU HAVE ANY QUESTIONS.

SERIES: 29 TITLE: 153 SECRETARY OF STATE

* THE ATTACHED RULE HAS BEEN REVIEWED AND IS CORRECT.

SIGNED: _____

TITLE OF PERSON SIGNING: _____

DATE: _____

* THE ATTACHED RULE HAS BEEN REVIEWED AND NEEDS CORRECTING. THE CORRECTIONS HAVE BEEN MARKED.

SIGNED: Mary P. Ratliff

TITLE OF PERSON SIGNING: Deputy

DATE: 9/15/97

NOTE: IF YOU ARE NOT THE PERSON WHO HANDLES THIS RULE, PLEASE FORWARD TO THE CORRECT PERSON.