

~~(a))~~ there is reason to believe that an impartial proceeding cannot be held in the county in which the proceeding was begun(~~(; or~~
~~(b) It appears that venue is incorrect under this section)).~~

NEW SECTION. Sec. 2. This act shall take effect September 1, 1989.

Passed the Senate March 6, 1989.

Passed the House April 3, 1989.

Approved by the Governor April 19, 1989.

Filed in Office of Secretary of State April 19, 1989.

CHAPTER 72

[Substitute Senate Bill No. 5733]

TRADEMARK REGISTRATION AND PROTECTION

AN ACT Relating to trademark registration and protection; amending RCW 19.77.010, 19.77.020, 19.77.030, 19.77.040, 19.77.050, 19.77.080, 19.77.110, 19.77.130, 19.77.140, 19.77.150, and 19.77.900; adding new sections to chapter 19.77 RCW; and repealing RCW 19.77.100 and 19.77.120.

Be it enacted by the Legislature of the State of Washington:

Sec. 1. Section 1, chapter 211, Laws of 1955 and RCW 19.77.010 are each amended to read as follows:

As used in this chapter:

(1) "Applicant" means the person filing an application for registration of a trademark under this chapter, his legal representatives, successors, or assigns of record with the secretary of state;

(2) The term "colorable imitation" includes any mark which so resembles a registered mark as to be likely to cause confusion or mistake or to deceive;

(3) A "counterfeit" is a spurious mark which is identical with, or substantially indistinguishable from, a registered mark;

(4) "Dilution" means the material reduction of the distinctive quality of a famous mark through use of a mark by another person, regardless of the presence or absence of (a) competition between the users of the mark, or (b) likelihood of confusion, mistake, or deception arising from that use;

(5) "Person" means any individual, firm, partnership, corporation, association, union, or other organization;

~~((3))~~ (6) "Registered mark" means a trademark registered under this chapter;

(7) "Registrant" means the person to whom the registration of a trademark under this chapter is issued, his legal representatives, successors, or assigns of record with the secretary of state;

~~((4))~~ (8) "Trademark" or "mark" means any word, name, symbol, or device or any combination thereof adopted and used by a person to identify goods made or sold by him and to distinguish them from goods made or sold

by others, and ~~((further includes without limitation a mark, name, symbol,))~~ any word, name, symbol, or device, or any combination thereof, and any title, designation, slogan, character name, and distinctive feature of radio or ~~((other advertising)) television programs~~ used in the sale or advertising of services to identify the services of one person and distinguish them from the services of others;

~~((5))~~ (9) A trademark shall be deemed to be "used" in this state when it is placed in any manner on the goods or their containers, or on tabs or labels affixed thereto, or displayed in connection with such goods, and such goods are sold or otherwise distributed in this state, or when it is used or displayed in the sale or advertising of services rendered in this state;

(10) "Trade name" shall have the same definition as under RCW 19.80.005(1);

(11) A mark shall be deemed to be "abandoned":

(a) When its use has been discontinued with intent not to resume. Intent not to resume may be inferred from circumstances. Nonuse for two consecutive years shall be prima facie abandonment; or

(b) When any course of conduct of the registrant, including acts of omission as well as commission, causes the mark to lose its significance as an indication of origin. Purchaser motivation shall not be a test for determining abandonment under this subsection.

Sec. 2. Section 2, chapter 211, Laws of 1955 and RCW 19.77.020 are each amended to read as follows:

A trademark 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 it:

(1) Consists of or comprises immoral, deceptive, or scandalous matter; or

(2) 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; or

(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; or

(4) Consists of or comprises the name, portrait, or signature identifying a particular living individual ~~((, except with his written consent))~~ who has not consented in writing to its registration; or

(5) Consists of a mark which,

(a) when applied to the goods or services of the applicant is merely descriptive or deceptively misdescriptive of them, or

(b) when applied to the goods or services of the applicant is primarily geographically descriptive or deceptively misdescriptive of them, or

(c) is primarily merely a surname: PROVIDED, That nothing in this subsection shall prevent the registration of a trademark used in this state by

the applicant which has become distinctive of the applicant's goods or services. The secretary of state may accept as prima facie evidence that the trademark has become distinctive, as used on or in connection with the applicant's goods or services, proof of substantially exclusive and continuous use thereof as a trademark by the applicant in this state or elsewhere in the United States for the five years next preceding the date of the filing of the application for registration; or

(6) Consists of or comprises a trademark which so resembles a trademark registered in this state, or a trademark or trade name (~~previously~~) used in this state by another prior to the date of the applicant's or applicant's predecessor's first use in this state and not abandoned, as to be likely, when applied to the goods or services of the applicant, to cause confusion or mistake or to deceive.

A trade name is not registerable under this chapter. However, if a trade name also functions as a trademark, it is registerable as a trademark.

The secretary of state shall make a determination of registerability by considering the application record and the marks previously registered and subsisting under this chapter.

Sec. 3. Section 3, chapter 211, Laws of 1955 as amended by section 181, chapter 35, Laws of 1982 and RCW 19.77.030 are each amended to read as follows:

Subject to the limitations set forth in this chapter, any person who has adopted and is using a trademark in this state may file in the office of the secretary of state, on a form to be furnished by the secretary of state, an application for registration of that trademark setting forth, but not limited to, the following information:

(1) The name and business address of the applicant, and, if the applicant is a corporation, its state of incorporation;

(2) The particular goods or services in connection with which the trademark is used and the class in which such goods or services fall;

(3) The manner in which the trademark is placed on or affixed to the goods or containers, or displayed in connection with such goods, or used in connection with the sale or advertising of the services;

(4) The date when the trademark was first used with (~~each of~~) such goods or services anywhere and the date when it was first used with (~~each of~~) such goods or services in this state by the applicant or his predecessor in business;

(5) A statement that the trademark is presently in use in this state by the applicant; (~~and~~)

(6) A statement that the applicant believes himself to be the owner of the trademark and believes that no other person has the right to use such trademark in connection with the same or similar goods or services in this state either in the identical form (~~thereof~~) or in such near resemblance

thereto as ~~((might be calculated))~~ to be likely, when used on or in connection with the goods or services of such other person, to cause confusion or mistake or to deceive ((or to be mistaken therefor)); and

(7) Such additional information or documents as the secretary of state may reasonably require.

A single application for registration of a trademark may specify all goods or services in a single class for which the trademark is actually being used, but may not specify goods or services in different classes.

The application shall be signed by the applicant individual, or by a member of the applicant firm, or by an officer of the applicant corporation, association, union or other organization.

The application shall be accompanied by three specimens or facsimiles of the trademark for at least one of the goods or services for which its registration is requested, and a filing fee of fifty dollars payable to the secretary of state.

Sec. 4. Section 4, chapter 211, Laws of 1955 and RCW 19.77.040 are each amended to read as follows:

Upon compliance by the applicant with the requirements of this chapter, the secretary of state shall issue a certificate of registration and deliver it to the applicant. The certificate of registration shall be issued under the signature of the secretary of state and the seal of the state, and it shall show the registrant's name and business address and, if the registrant is a corporation, its state of incorporation, the date claimed for the first use of the trademark anywhere, the date claimed for the first use of the trademark in this state, the particular goods or services for which the trademark is used, the class in which such goods and services fall, a reproduction of the trademark, the registration date and the term of the registration.

Any certificate of registration issued by the secretary of state under the provisions hereof or a copy thereof duly certified by the secretary of state shall be admissible ~~((in evidence as competent and sufficient proof of the registration of such trademark))~~ in any action or judicial proceeding in any court of this state as prima facie evidence of:

- (1) The validity of the registration of the trademark;
- (2) The registrant's ownership of the trademark; and
- (3) The registrant's exclusive right to use the trademark in this state in connection with the goods or services specified in the certificate, subject to any conditions and limitations stated in the certificate.

Registration of a trademark under this chapter shall be constructive notice of the registrant's claim of ownership of the trademark throughout this state.

Sec. 5. Section 5, chapter 211, Laws of 1955 as amended by section 182, chapter 35, Laws of 1982 and RCW 19.77.050 are each amended to read as follows:

Registration of a trademark hereunder shall be effective for a term of ten years from the date of registration. Upon application filed within six months prior to the expiration of such term, on a form to be furnished by the secretary of state requiring all the allegations of an application for original registration, the registration may be renewed for successive terms of ten years as to the goods or services for which the trademark is still in use in this state. A renewal fee of fifty dollars, payable to the secretary of state, shall accompany each application for renewal of the registration.

The secretary of state shall notify registrants of trademarks hereunder or their agents for service of record with the secretary of state of the necessity of renewal within the year, but not less than six months, next preceding the expiration of the unexpired original or renewed term by writing to the last known address of the registrants or their agents according to the files of the secretary of state. Neither the secretary of state's failure to notify a registrant nor the registrant's nonreceipt of a notice under this section shall extend the term of a registration or excuse the registrant's failure to renew a registration.

~~((Any registration in force on September 1, 1955 shall expire five years from the date of the registration or one year after September 1, 1955, whichever date is later, and may be renewed as provided for renewing registrations under this chapter. A separate renewal application is required for goods in each class.~~

~~The secretary of state shall, within six months after September 1, 1955, notify all registrants of trademarks under previous acts of the date of expiration of their registrations by writing to the last known address of the registrants according to the files of the secretary of state, unless such registrations have been renewed in accordance with the provisions of this chapter.))~~

Sec. 6. Section 8, chapter 211, Laws of 1955 and RCW 19.77.080 are each amended to read as follows:

The secretary of state shall cancel from the register:

~~(1) ((After one year from September 1, 1955, all registrations under prior acts which are more than five years old and not renewed in accordance with this chapter;~~

~~(2)) Any registration concerning which the secretary of state shall receive a voluntary written request for cancellation thereof from the registrant;~~

~~((3)) (2) All expired registrations not renewed under this chapter;~~

~~((4)) (3) Any registration concerning which ((a final decree of a court of competent jurisdiction, upon filing of a certified copy of such decree with the secretary of state, shall adjudge)) a court of competent jurisdiction has rendered a final judgment against the registrant, which has become unappealable, canceling the registration or finding that:~~

~~(a) ((That)) The registered trademark has been abandoned; ((or))~~

(b) ~~((That))~~ The registrant under this chapter or under a prior act is not the owner of the trademark; ((or))

(c) ~~((That))~~ The registration was granted ((improperly; or)) contrary to the provisions of this chapter;

(d) ~~((That))~~ The registration was obtained fraudulently; ((or))

(e) ~~((That the registration be canceled on any ground))~~ The registered trademark has become incapable of serving as a trademark; or

(f) The registered trademark is so similar to a trademark 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 hereunder, and not abandoned, as to be likely to cause confusion or mistake or to deceive: PROVIDED, That such finding was made on petition of such other person and that should the registrant prove that he or she is the owner of a concurrent registration of the trademark in the United States patent and trademark office covering an area including this state, the registration hereunder shall not be canceled.

Sec. 7. Section 11, chapter 211, Laws of 1955 and RCW 19.77.110 are each amended to read as follows:

~~((The following general classes of goods are established for the convenient administration of this chapter, but do not limit or extend the applicant's or registrant's rights:~~

- ~~(1) Raw or partly prepared materials:~~
- ~~(2) Receptacles:~~
- ~~(3) Baggage, animal equipment, 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, equipment 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 metal ware.~~
- ~~(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.)~~

The International Classification of Goods and Services to Which Trademarks Are Applied, as adopted in accordance with the Nice Agreement of 1957, as amended, shall be used for the convenient administration of this chapter. Such classification shall not be deemed to limit or extend the applicant's or registrant's rights. The short titles of such classifications are as follows:

- (1) Chemicals.
- (2) Paints.
- (3) Cosmetics and cleaning preparation.
- (4) Lubricants and fuels.
- (5) Pharmaceuticals.
- (6) Metal goods.
- (7) Machinery.
- (8) Hand tools.
- (9) Electrical and scientific apparatus.
- (10) Medical apparatus.

- (11) Environmental control apparatus.
- (12) Vehicles.
- (13) Firearms.
- (14) Jewelry.
- (15) Musical instruments.
- (16) Paper goods and printed matter.
- (17) Rubber goods.
- (18) Leather goods.
- (19) Nonmetallic building materials.
- (20) Furniture and articles not otherwise classified.
- (21) Housewares and glass.
- (22) Cordage and fibers.
- (23) Yarns and threads.
- (24) Fabrics.
- (25) Clothing.
- (26) Fancy goods.
- (27) Floor coverings.
- (28) Toys and sporting goods.
- (29) Meats and processed foods.
- (30) Staple foods.
- (31) Natural agricultural products.
- (32) Light beverages.
- (33) Wines and spirits.
- (34) Smokers' articles.
- (35) Advertising and business.
- (36) Insurance and financial.
- (37) Construction and repair.
- (38) Communication.
- (39) Transportation and storage.
- (40) Material treatment.
- (41) Education and entertainment.
- (42) Miscellaneous.

Sec. 8. Section 13, chapter 211, Laws of 1955 and RCW 19.77.130 are each amended to read as follows:

Any person who shall for himself, or on behalf of any other person, procure the registration of any trademark by the secretary of state under the provisions of this chapter, by knowingly making any false or fraudulent representation or declaration, or by any other fraudulent means, shall be liable to pay all damages sustained in consequence of such registration, to be recovered by or on behalf of the party injured thereby in any court of competent jurisdiction, together with costs of such action including reasonable attorneys' fees.

Sec. 9. Section 14, chapter 211, Laws of 1955 and RCW 19.77.140 are each amended to read as follows:

(1) Subject to the provisions of RCW 19.77.900 any person who shall:

~~((1))~~ (a) Use, without the consent of the registrant, any reproduction, counterfeit, copy, or colorable imitation of a trademark registered under this chapter in connection with the sale, 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))~~; or

~~((2))~~ (b) Reproduce, counterfeit, copy or colorably imitate any such trademark 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 of goods or services in this state~~((:))~~ on or in connection with which such use is likely to cause confusion, or to cause mistake, or to deceive

shall be liable to a civil action by the registrant for any or all of the remedies provided in RCW 19.77.150, except that under ~~((subdivision (2) of this section))~~ (b) of this subsection the registrant shall not be entitled to recover profits or damages unless the acts have been committed with knowledge that such ~~((use))~~ imitation is intended to be used to cause confusion or mistake, or to deceive.

(2) In determining whether, under this chapter, there is a likelihood of confusion, mistake, or deception between marks when used in association with goods or services, the court shall consider all relevant factors, including, but not limited to the following:

(a) The similarity or dissimilarity of the marks in their entireties to appearance, sound, meaning, connotation, and commercial impression;

(b) The similarity or dissimilarity of the goods or services and nature of the goods and services;

(c) The similarity or dissimilarity of trade channels;

(d) The conditions under which sales are made and buyers to whom sales are made;

(e) The fame of the marks;

(f) The number and nature of similar marks in use on similar goods or services;

(g) The nature and extent of any actual confusion;

(h) The length of time during and conditions under which there has been concurrent use without evidence of actual confusion;

(i) The variety of goods or services on which each of the marks is or is not used;

(j) The nature and extent of potential confusion, i.e., whether de minimis or substantial;

(k) Any other established fact probative of the effect of use.

NEW SECTION. Sec. 10. A new section is added to chapter 19.77 RCW to read as follows:

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

(1) Whether the mark is inherently distinctive or has become distinctive through substantially exclusive and continuous use;

(2) Whether the duration and extent of use of the mark are substantial;

(3) Whether the duration and extent of advertising and publicity of the mark are substantial;

(4) Whether the geographical extent of the trading area in which the mark is used is substantial;

(5) Whether the mark has substantial renown in its and in the other person's trading areas and channels of trade; and

(6) Whether substantial use of the same or similar marks is being made by third parties.

The owner shall be entitled only to injunctive relief in an action brought under this section, unless the subsequent user willfully intended to trade on the registrant'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.

Sec. 11. Section 15, chapter 211, Laws of 1955 and RCW 19.77.150 are each amended to read as follows:

Any registrant may proceed by suit to enjoin the manufacture, use, display, or sale of any counterfeits or colorable imitations of a trademark registered under this chapter, and any court of competent jurisdiction may grant an injunction to restrain such manufacture, use, display, or sale as may be by the said court deemed just and reasonable, and may require the defendants to pay to such registrant all profits derived from and/or all damages suffered by reason of such wrongful manufacture, use, display, or sale; and such court may also order that any such counterfeits or colorable imitations in the possession or under the control of any defendant in such case be delivered to an officer of the court, or to the registrant, to be destroyed. In exceptional cases the court may award to the prevailing party the costs of the suit including reasonable attorneys' fees.

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

Sec. 12. Section 16, chapter 211, Laws of 1955 and RCW 19.77.900 are each amended to read as follows:

Nothing herein shall adversely affect the rights or the enforcement of rights in trademarks acquired in good faith ((at any time)) at common law prior to registration under this chapter; however, during any period subsequent to the effective date of this act when the registration of a mark under this chapter is in force and the registrant has not abandoned the trademark, no common law rights as against the registrant may be acquired.

NEW SECTION. Sec. 13. A new section is added to chapter 19.77 RCW to read as follows:

It is the intent of the legislature that, in construing this chapter, the courts be guided by the interpretation given by the federal courts to the federal trademark act of 1946, as amended, 15 U.S.C., Secs. 1051, et seq.

NEW SECTION. Sec. 14. A new section is added to chapter 19.77 RCW to read as follows:

This act applies prospectively only and not retroactively. The rights and obligations of this act shall accrue upon the effective date of this act to all prior trademark registrations then in effect, and the provisions of this act shall not apply to any cause of action arising prior to the effective date of this act.

NEW SECTION. Sec. 15. The following acts or parts of acts are each repealed:

(1) Section 10, chapter 211, Laws of 1955, section 65, chapter 81, Laws of 1971, section 185, chapter 35, Laws of 1982, section 23, chapter 202, Laws of 1988 and RCW 19.77.100; and

(2) Section 12, chapter 211, Laws of 1955 and RCW 19.77.120.

Passed the Senate March 6, 1989.

Passed the House April 4, 1989.

Approved by the Governor April 19, 1989.

Filed in Office of Secretary of State April 19, 1989.

CHAPTER 73

[Senate Bill No. 5771]

RENTS—PERFECTION OF SECURITY INTEREST BY RECORDING ASSIGNMENT

AN ACT Relating to the assignment of rents; and amending RCW 7.28.230.

Be it enacted by the Legislature of the State of Washington:

Sec. 1. Section 498, page 130, Laws of 1869 as last amended by section 1, chapter 122, Laws of 1969 ex. sess. and RCW 7.28.230 are each amended to read as follows:

(1) A mortgage of any interest in real property shall not be deemed a conveyance so as to enable the owner of the mortgage to recover possession of the real property, without a foreclosure and sale according to law: PROVIDED, That nothing in this section shall be construed as any limitation