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SENATE BILL 605

43RD LEGISLATURE - STATE OF NEW MEXICO - FIRST SESSION, 1997

INTRODUCED BY

MICHAEL S. SANCHEZ

AN ACT

RELATING TO TRADEMARKS; ENACTING THE TRADEMARK ACT; REPEALING
AND ENACTING CERTAIN SECTIONS OF THE NMSA 1978.

BE IT ENACTED BY THE LEGISLATURE OF THE STATE OF NEW MEXICO:

Section 1. SHORT TITLE. --This act may be cited as the
"Trademark Act".

Section 2. PURPOSE AND INTENT OF ACT. --The purpose of the
Trademark Act is to provide a system of state trademark
registration and protection substantially consistent with the
federal system of trademark registration and protection under
the Trademark Act of 1946, as amended. It is the intent that
the construction given the federal act should be examined as
persuasive authority for interpreting and construing the
Trademark Act.

Section 3. DEFINITIONS. --As used in the Trademark Act:

Underscored material = new
[bracketed material] = delete

1 A. "applicant" includes the person filing an
2 application for registration of a mark under the Trademark Act
3 as well as the legal representatives, successors or assigns of
4 the person;

5 B. "dilution" means the lessening of the capacity of
6 the registrant's mark to identify and distinguish goods or
7 services regardless of the presence or absence of:

8 (1) competition between the parties; or

9 (2) the likelihood of confusion, mistake or
10 deception;

11 C. "mark" includes any trademark or service mark
12 entitled to registration under the Trademark Act whether
13 registered or not;

14 D. "person" and any other word or term used to
15 designate the applicant or other party entitled to a benefit or
16 privilege or rendered liable under the provisions of the
17 Trademark Act, includes a juristic person as well as a natural
18 person; "juristic person" includes a firm, partnership,
19 corporation, union, association or other organization capable of
20 suing and being sued in a court of law;

21 E. "registrant" includes the person to whom the
22 registration of a mark under the Trademark Act is issued as well
23 as the legal representative, successors or assigns of the
24 person;

25 F. "secretary" means the secretary of state or the

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1 secretary's designee charged with the administration of the
2 Trademark Act;

3 G. "service mark" means any word, name, symbol,
4 device or any combination of these used by a person to identify
5 and distinguish the services of one person, including a unique
6 service, from the services of other persons and to indicate the
7 source of the services, even if that source is unknown;
8 provided, titles and character names used by a person and other
9 distinctive features of radio or television programs may be
10 registered as service marks notwithstanding that they or the
11 programs may advertise the goods of the sponsor;

12 H. "trademark" means any word, name, symbol, device
13 or any combination of these used by a person to identify and
14 distinguish the goods of the person, including a unique product,
15 from those manufactured or sold by others, and to indicate the
16 source of the goods, even if that source is unknown;

17 I. "trade name" means any name used by a person to
18 identify a business or vocation of the person; and

19 J. "use" means the bona fide use of a mark in the
20 ordinary course of trade and not made merely to reserve a right
21 in the mark. For the purposes of the Trademark Act, a mark is
22 deemed to be in use:

23 (1) on goods when it is placed in any manner on
24 the goods or on the containers or the displays associated with
25 it or on the tags or labels affixed to them, or if the nature of

1 the goods makes the placement impracticable, then on documents
2 associated with the goods or their sale, and the goods are sold
3 or transported in commerce in this state; and

4 (2) on services when it is used or displayed
5 in the sale or advertising of services and the services are
6 rendered in this state.

7 Section 4. REGISTRABILITY. --

8 A. A mark by which the goods or services of any
9 applicant for registration may be distinguished from the goods
10 or services of others shall not be registered if it:

11 (1) consists of or comprises immoral, deceptive
12 or scandalous matter;

13 (2) consists of or comprises matter that may
14 disparage or falsely suggest a connection with persons living or
15 dead, institutions, beliefs or national symbols or that may
16 bring them into contempt or disrepute;

17 (3) consists of or comprises the flag, coat of
18 arms or other insignia of the United States or of any state,
19 municipality, foreign nation or any simulation of these;

20 (4) consists of or comprises the name,
21 signature or portrait identifying a particular living
22 individual, except by the individual's written consent;

23 (5) consists of a mark that:

24 (a) when used on or in connection with
25 the goods or services of the applicant, is merely descriptive or

1 deceptively misdescriptive of them;

2 (b) when used on or in connection with
3 the goods or services of the applicant, is primarily
4 geographically descriptive or deceptively misdescriptive of
5 them;

6 (c) is primarily merely a surname;
7 provided, however, nothing in this subsection shall prevent the
8 registration of a mark used by the applicant that has become
9 distinctive of the applicant's goods or services. The secretary
10 may accept as evidence that the mark has become distinctive as
11 used on or in connection with the applicant's goods or services,
12 proof of continuous use of it as a mark by the applicant in this
13 state for the five years before the date on which the claim of
14 distinctiveness is made; or

15 (d) consists of or comprises a mark that
16 so resembles a mark registered in this state or a mark or trade
17 name previously used by another and not abandoned, as to be
18 likely, when used on or in connection with the goods or services
19 of the applicant, to cause confusion or mistake or to deceive.

20 B. A mark is deemed to be abandoned when either of
21 the following occurs:

22 (1) when its use has been discontinued with
23 intent not to resume that use. Intent not to resume may be
24 inferred from circumstances; nonuse for two consecutive years
25 shall constitute prima facie evidence of abandonment; or

1 (2) when any course of conduct of the owner,
2 including acts of omission as well as commission, causes the
3 mark to lose its significance as a mark.

4 Section 5. APPLICATION OF REGISTRATION. --

5 A. Subject to the limitations set forth in the
6 Trademark Act, any person who uses a mark may file in the office
7 of the secretary on a form prescribed by the secretary an
8 application for registration of that mark setting forth, but not
9 limited to, the following information:

10 (1) the name and business address of the person
11 applying for the registration; and if a corporation, the state
12 of incorporation; if a partnership, the state in which the
13 partnership is organized and the names of the general partners,
14 as specified by the secretary;

15 (2) the goods or services on or in connection
16 with which the mark is used and the mode or manner in which the
17 mark is used on or in connection with the goods or services and
18 the class in which the goods or services fall;

19 (3) the date when the mark was first used
20 anywhere and the date when it was first used in this state by
21 the applicant or a predecessor in interest;

22 (4) a written description of the mark; and

23 (5) a statement that the applicant is the owner
24 of the mark, that the mark is in use and that, to the knowledge
25 of the person verifying the application, no other person has

1 registered, either federally or in this state, or has the right
2 to use the mark either in the identical form of it or in the
3 near resemblance thereto as to be likely, when applied to the
4 goods or services of the other person, to cause confusion,
5 mistake or to deceive.

6 B. The secretary may also require a statement as to
7 whether an application to register the mark or portions of it or
8 a composite of it, has been filed by the applicant or a
9 predecessor in interest in the United States patent and
10 trademark office; and, if so, the applicant shall provide full
11 particulars with respect to it including the filing date, serial
12 number of each application, its status and, if any application
13 was finally refused registration or has otherwise not resulted
14 in a registration, the reason for the refusal or for not being
15 registered.

16 C. The secretary may also require that a drawing of
17 the mark or three specimens showing the mark as it is actually
18 used accompany the application and that it complies with the
19 requirements specified by the secretary.

20 D. The application shall be signed and verified by
21 oath, affirmation or declaration subject to perjury laws by the
22 applicant or by a member of the firm or an officer of the
23 corporation or association applying for registration.

24 E. The application shall be accompanied by a fee of
25 twenty-five dollars (\$25.00) for each application.

1 Section 6. FILING OF APPLICATION. --

2 A. Upon the filing of an application for
3 registration and payment of the application fee, the secretary
4 may cause the application to be examined for conformity with the
5 Trademark Act.

6 B. The applicant shall provide any additional
7 pertinent information requested by the secretary, including a
8 description of a design mark and may make, or authorize the
9 secretary to make, any reasonable amendments to the application
10 as may be requested by the secretary or deemed by the applicant
11 to be advisable to respond to any objection or rejection of the
12 application.

13 C. The secretary may require the applicant to
14 disclaim an unregistrable component of a mark that would
15 otherwise be registrable, and an applicant may voluntarily
16 disclaim a component of a mark sought to be registered. No
17 disclaimer shall prejudice or affect the applicant's or
18 registrant's rights then existing or thereafter arising in the
19 disclaimed matter or the applicant's or registrant's rights of
20 registration on another application if the disclaimed matter is
21 or becomes distinctive of the applicant's or registrant's goods
22 or services.

23 D. The secretary may amend the application upon the
24 applicant's written agreement, or the secretary may require a
25 new application to be submitted.

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1 E. If the applicant is found not to be entitled to
2 registration, the secretary shall advise the applicant of the
3 reasons for non-registration. The applicant shall have a
4 reasonable period of time as specified by the secretary in which
5 to reply or to amend the application for reexamination. This
6 procedure may be repeated until the secretary makes a final
7 refusal of registration of the mark or the applicant fails to
8 reply or amend the application within the period specified by
9 the secretary, in which case the application shall be deemed to
10 have been abandoned.

11 F. The secretary shall grant priority to the
12 applications in order of filing. In the case of any application
13 rejected because of a prior-filed application of the same or
14 confusingly similar mark for the same or related goods or
15 services, the applicant may bring an action for cancellation of
16 the registration on grounds of prior or superior rights to the
17 mark as provided in Section 11 of the Trademark Act.

18 Section 7. CERTIFICATE OF REGISTRATION. --

19 A. Upon compliance by the applicant with the
20 requirements of the Trademark Act, the secretary shall issue and
21 deliver a certificate of registration to the applicant. The
22 certificate of registration shall be issued under the signature
23 of the secretary and the seal of the state, and it shall show:

- 24 (1) the name and business address;
25 (2) if a corporation, limited liability company

Underscored material = new
[bracketed material] = delete

1 or partnership, the state of incorporation, or if a partnership,
2 the state in which the partnership is organized;

3 (3) the date claimed for the first use of the
4 mark anywhere;

5 (4) the date claimed for the first use of the
6 mark in New Mexico;

7 (5) the class and description of goods or
8 services on or in connection with which the mark is used; and

9 (6) the registration date and the term of
10 registration.

11 B. A certificate of registration issued by the
12 secretary or a copy of the certificate of registration duly
13 certified by the secretary shall be admissible in evidence as
14 competent and sufficient proof of the registration of the mark
15 in any actions or judicial proceedings in this state.

16 Section 8. DURATION AND RENEWAL. --

17 A. A registration of a mark is effective for ten
18 years from the date of registration. An application for renewal
19 shall be filed within six months prior to its expiration in the
20 manner required by the secretary. The renewed registration
21 shall be effective for ten years from the date of expiration of
22 the original registration. The application for renewal shall be
23 accompanied by the renewal fee. A registration of a mark may be
24 renewed for successive periods of ten years as provided in this
25 section.

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1 B. All applications for renewal, whether of
2 registrations made under the Trademark Act or of registrations
3 made under any act prior to the effective date of that act,
4 shall include a verified statement that the mark has been and is
5 still in use and include a specimen showing actual use of the
6 mark on or in connection with the goods or services.

7 Section 9. ASSIGNMENTS--CHANGES OF NAME AND OTHER
8 INSTRUMENTS.--

9 A. A mark and its representation shall be assignable
10 with the good will of the business in which the mark is used, or
11 with that part of the good will of the business connected with
12 the use of and symbolized by the mark. The assignment shall be
13 by instruments in writing duly executed and may be recorded with
14 the secretary upon payment of a twenty-five dollar (\$25.00)
15 recording fee. The secretary, upon recording the assignment,
16 shall issue in the name of the assignee a new certificate for
17 the remainder of the term of the registration or the last
18 renewal of the registration. An assignment of a registration
19 shall be void as against any subsequent purchaser for valuable
20 consideration without notice unless it is recorded with the
21 secretary within three months after its date or unless it is
22 recorded prior to the subsequent purchase.

23 B. A registrant or applicant effecting a change of
24 the name of the person to whom the mark was issued or for whom
25 an application was filed may record a certificate of change of

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[bracketed material] = delete

1 name of the registrant or applicant with the secretary upon
2 payment of the recording fee specified in Subsection A of this
3 section. The secretary may issue to the owner a certificate of
4 amendment of registration for the remainder of the term of
5 registration or the last renewal of that registration.

6 C. Other instruments that relate to a mark
7 registered or a pending application include licenses, security
8 interests or mortgages, and they may be recorded in the
9 discretion of the secretary provided the instrument is in
10 writing and has been duly executed.

11 D. Acknowledgment shall be prima facie evidence of
12 the execution of an assignment or other instrument and, when
13 recorded by the secretary, the record shall be prima facie
14 evidence of execution. A photocopy of an instrument specified
15 in this section shall be accepted for recording if it is
16 certified by any of the parties thereto or their successors.

17 Section 10. RECORDS. --The secretary shall keep for public
18 examination a record of all marks registered or renewed under
19 the Trademark Act and a record of all documents recorded
20 pursuant to Section 9 of the Trademark Act.

21 Section 11. CANCELLATION. --The secretary shall cancel from
22 the register, in whole or in part:

23 A. a registration where the secretary shall receive
24 a voluntary request for cancellation from the registrant or the
25 assignee of record;

1 B. a registration granted under the Trademark Act
2 and not renewed in accordance with its provisions;

3 C. a registration of which a court of competent
4 jurisdiction finds that:

5 (1) the registered mark has been abandoned;

6 (2) the registrant is not the owner of the
7 mark;

8 (3) the registration was granted improperly;

9 (4) the registration was obtained fraudulently;

10 (5) the mark is or has become the generic name
11 for the goods or services or a portion of them, for which it has
12 been registered; or

13 (6) the registered mark is so similar as to
14 likely cause confusion or mistake or to deceive, to a mark
15 registered by another person in the United States patent and
16 trademark office prior to the date of the filing of the
17 application for registration by the registrant and not
18 abandoned; or

19 D. when a court of competent jurisdiction orders the
20 cancellation of a registration on any ground.

21 Section 12. CLASSIFICATION. -- The secretary shall by
22 regulation establish a classification of goods and services for
23 convenience of administration of the Trademark Act but not to
24 limit or extend the applicant's or registrant's rights. A
25 single application for registration of a mark may include any or

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1 all goods upon which, or services with which, the mark is
2 actually being used indicating the appropriate class or classes
3 of goods or services. When a single application includes goods
4 or services that fall within multiple classes, the secretary
5 shall require payment of twenty-five dollars (\$25.00) for each
6 class. As far as practical the classification of goods and
7 services should conform to the classification adopted by the
8 United States patent and trademark office.

9 Section 13. FRAUDULENT REGISTRATION. --A person who, for
10 himself on or behalf of any other person, procures the filing or
11 registration of any mark in the office of the secretary by
12 knowingly making any false or fraudulent representation or
13 declaration, orally or in writing or by any other fraudulent
14 means, shall be liable to pay all damages sustained as a
15 consequence of that filing or registration recoverable by or on
16 behalf of the injured party in any court of competent
17 jurisdiction.

18 Section 14. FEES. --The secretary shall charge twenty-five
19 dollars (\$25.00) for the various applications and filing fees
20 required by the Trademark Act and for related services. The
21 fees required by the Trademark Act are not refundable.

22 Section 15. REPEAL. --Sections 57-3-1, 57-3-2 and 57-3-4
23 through 57-3-12 NMSA 1978 (being Laws 1969, Chapter 142, Section
24 1, Laws 1959, Chapter 345, Sections 1 and 2, Laws 1969, Chapter
25 142, Section 2, Laws 1959, Chapter 345, Sections 3 and 4, Laws

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1 1969, Chapter 142, Sections 4 through 7 and Laws 1959, Chapter
2 345, Section 6, as amended) are repealed.

3 Section 16. SEVERABILITY. -- If any part or application of
4 the Trademark Act is held invalid, the remainder or its
5 application to other situations or persons shall not be
6 affected.

7 Section 17. APPLICABILITY. -- Any registration of a mark in
8 force upon the effective date of the Trademark Act shall
9 continue in effect for the remainder of its unexpired term and
10 may be renewed under the provisions of that act within six
11 months prior to the expiration specified in its registration.
12 The provisions of the Trademark Act shall not affect any
13 application, suit, proceeding or appeal pending on the effective
14 date of the Trademark Act.

15 Section 18. EFFECTIVE DATE. -- The effective date of the
16 provisions of this act is July 1, 1997.

1 FORTY-THIRD LEGISLATURE

2 FIRST SESSION, 1997

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6 March 15, 1997

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8 Mr. President:

9
10 Your JUDICIARY COMMITTEE, to whom has been referred

11
12 SENATE PUBLIC AFFAIRS COMMITTEE SUBSTITUTE FOR
13 SENATE BILL 605

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16 has had it under consideration and reports same with
17 recommendation that it DO PASS.

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19 Respectfully submitted,

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25 Fernando R. Macias, Chairman

Adopted _____ Not Adopted _____
(Chief Clerk) (Chief Clerk)

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Date _____

The roll call vote was 6 For 0 Against

Yes: 6

No: 0

Excused: Tsosie, Vernon

Absent: None

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State of New Mexico
House of Representatives

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FORTY-THIRD LEGISLATURE
FIRST SESSION, 1997

March 21, 1997

Mr. Speaker:

**Your CONSUMER AND PUBLIC AFFAIRS COMMITTEE, to
whom has been referred**

**SENATE PUBLIC AFFAIRS COMMITTEE SUBSTITUTE FOR
SENATE BILL 605**

**has had it under consideration and reports same with
recommendation that it DO PASS.**

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FORTY-THIRD LEGISLATURE
FIRST SESSION, 1997

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Respectfully submitted,

Gary King, Chairman

Adopted _____ Not Adopted _____
(Chief Clerk) (Chief Clerk)

Date _____

The roll call vote was 6 For 0 Against

Yes: 6

Excused: Rios, Sandel, Vaughn, Vigil

Absent: None

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[bracketed material] = delete