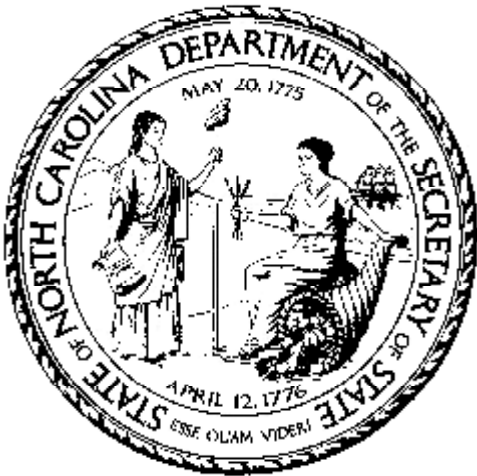


Registering a Trademark or a Service Mark in North Carolina



Elaine F. Marshall
Secretary of State

A Message from The Secretary of State of North Carolina

Each year, thousands of North Carolina businesses market their goods and services using readily identifiable corporate logos. A good logo, in fact, can be a powerful marketing tool to help lead consumers to your doorstep when they need your products or services. That is why it is so important to protect your company's logo – and its marketing image – through our trademark and service mark program.



The North Carolina Department of the Secretary of State is working to make North Carolina a world leader in trademark and service mark regulation. Our state trademark and service mark laws have changed dramatically in recent years, making it easier for businesses to register their marks. At the same time, the new laws bring North Carolina into close conformity with federal trademark and service mark regulations. If you intend to expand distribution of your products or services on a national or international scale, our trademark and service mark laws help make North Carolina a great home base for your company.

This manual should give you much of the information you will need to obtain trademark or service mark registration for your business logo in North Carolina. While the manual is written in clear, easy-to-understand language, we encourage you to seek competent legal counsel of your own choice if you are at all uncertain about the process of trademark and service mark registration. Our Trademark Section experts can help guide you through the registration process. While our staff cannot provide you with legal advice, you can call them at 919-807-2162 with non-legal questions about the mark registration process.

Trademark and service mark registration is a serious subject. It can also be a complicated process to complete. We have tried to provide you with a how-to manual which uses humor and straightforward language to make the mark registration process less intimidating and more understandable to the average business owner or corporate officer. We can be reached at:

Trademark Section
NC Department of the Secretary of State
PO Box 29622
Raleigh, NC 27626-0622

919-807-2162 phone 919-807-2215 fax
E-mail: trademark@sosnc.com

www.sosnc.com

Welcome to North Carolina's business community. Please remember that the N.C. Department of the Secretary of State is here to help you. We're your advocate in state government and we look forward to working with you!

Elaine F. Marshall

Elaine F. Marshall, Secretary of State

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Why do I need a trademark or a service mark?

You want to make it as easy as possible for your customers to find you. You also want to make it as easy as possible for them to remember you the next time they need the particular product or service you provide. Fifty years ago, people didn't have much choice when it came to purchasing consumer goods and services. They shopped at the corner market, bought gasoline and tires at the filling station down the street and deposited each week's paycheck in the bank on Main Street. Today, we have a staggering array of choice when it comes to purchasing goods and services. Thanks to the automobile, television, telephone, and personal computer, we are no longer limited to a small geographic area around our home when it comes to buying what we need or want.

The flip side of this new consumer freedom, however, is that businesses have to work much harder to attract and keep customers. One of the most powerful tools available to your business when it comes to winning the marketing battle is your company's name and logo. They make your business stand out from all its competitors, cutting through the confusion of a busy marketplace like a beacon of light on a dark, moonless night. The concept of brand marketing, which concentrates on image isn't everything, of course. You still have to provide a product that is as good as – or better than – what your competitors can offer. A memorable logo combined with a superior product or service can make a big difference in a very competitive marketplace.

Given the importance of your company's name and logo, you probably want to make sure no one else can use them. Registering them as a trademark or service mark will help provide that legal protection. A trademark protects the marketing image of the goods you or your company produce. A service mark protects the marketing image of the services you or your company provide to the general public. Both types of mark offer the same degree of legal protection.

The good news – it is not all that difficult or expensive to register a trademark of service mark in North Carolina. The Department of the Secretary of State provides a registration form that is user-friendly. You simply fill out the form correctly and submit it with three (3) original examples of your mark along with a \$75 non-refundable application processing fee for initial registration. We will process your application for mark registration and stay in contact with you through the registration process. Mark registration is a legally powerful way to protect your company's marketing image. Remember – you worked long and hard to develop a product or service that can hold its own in a competitive marketplace. Can you really afford not to protect the marketing image that identifies your product or service to your customers?

How do I register a mark?

The first step is the simplest of all – by statute you should **use** the trademark or service mark you want **before** you register it with the N. C. Department of the Secretary of State. There is no prescribed length of time that the mark must be used in North Carolina before you can register it. You will, however, have to prove that you are currently using the mark before you will be allowed to register it with the Trademark Section.

Second, make sure no one else has already registered the mark you intend to use. You can contact the Trademark Section to find out whether your mark has already been registered by someone else. However, the Trademark Section cannot guarantee or reserve a registration. Registration is subject to a complete review of the application and supporting documentation.

Third, you must file a complete, correct Application for Trademark or Service Mark Registration/Renewal along with three (3) original specimens of the mark you are registering and the \$75 mark registration fee. You do not necessarily have to have an attorney file your application, but we strongly encourage you to seek competent legal counsel of your own choice if you have any questions or concerns about registering your mark. Please be sure to fill out the Application for Trademark or Service Mark Registration/Renewal completely and correctly. You will need to provide the following information for an initial mark registration:

1. Applicant Name and Address

North Carolina law allows individuals, firms, partnerships, corporations, associations, unions and other organizations to hold trademarks and service marks. If filing for mark registration as a corporation, you must name the state in which your business is incorporated and sign a statement stating that your corporation is in good standing with that state. In addition to providing a mailing address, you will need to provide the business entity name and North Carolina street address.

When filing for a trademark, you should list the address of your principal place of business in North Carolina. You must also, when filing for a trademark registration, list the address of the place in North Carolina where the goods covered by your trademark are sold or used. If you are applying for a service mark registration, you must list the physical location in North Carolina where the services covered by the mark are provided or offered.

Remember – you can hold the mark individually or your company may hold it, but not both together. Ask yourself whom you want to control the mark and who will control the actual products or services covered by the mark. The answers to these questions should help guide you in deciding whom the applicant will be.

2. Describe Your Mark

You must provide a concise, accurate written description of your mark, including all words or graphic design. You must describe the mark as if the Trademark Section

Specialist who processes your application cannot actually see a copy of your mark. You may not write “See Attached” in reference to any specimens of the mark you submit with your application. You may, however, start your description in the blank provided on the form and continue it on a second piece of paper if the space on the form is too small to hold a complete and accurate description of the mark. Remember – you must provide three (3) original specimens of your mark along with the application. Your mark description on the application form must match the mark as it appears on your three specimens. If your description of the mark on the application form does not match the specimens, your application will be denied.

3. Describe The Specific Goods or Services The Mark Will Cover

Once again, you should provide a concise, accurate description of the goods or services, which the requested mark will cover. Please be precise! Instead of writing “clothing” or “restaurant” in the space provided on the form for product or service description, write “children’s sleepwear” or “family-style chicken and pork barbecue restaurant.” North Carolina’s trademark law authorizes the N.C. Department of the Secretary of State to establish a system of product and service classifications for mark registration. These classification schemes are included for reference in *Appendix A* of this manual. If you cannot decide which classification best fits your business, contact the Trademark Section for assistance. Once you know where your business falls within the classifications, you must list that class and its title on your application form.

4. First Use Anywhere and First Use in North Carolina

The date of first use anywhere and the date of first use in North Carolina may be two entirely separate dates, particularly if your business is already national or regional in scope. You should provide the first date (month/year) the mark was used by anyone, including you, any predecessors you may have had in your business or someone else who originally established control over the mark.

5. State That You Own The Mark

You must sign your application if you are applying for a mark as an individual or sole proprietor. If you are not applying as an individual or sole proprietor, the application must be signed by a partner, manager of limited liability company, or a corporate officer who has legal authorization to sign the application on behalf of the applicant. If your application is signed by a person acting under a power of attorney from the applicant, an original power of attorney or *certified* copy of the original power of attorney must be submitted with the application.

Please Note: Your application must be properly verified by a notary public. The notary must properly execute the verification and affix his or her seal in the space provided. Please make sure that all spaces in the verification have been filled in.

What are these “specimens” that I must file with my form?

It is extremely important that you provide the Trademark Section with three (3) original specimens of your mark as it is actually used when you file an Application for Trademark or Service Mark Registration/Renewal. “Original” means one of two things: 1) either it is a sample of your product with the mark on it or 2) it is a photograph of the mark on one of your products. If you are using the mark for a brand of hats, for instance, you can send us three of the hats with the trademark on them or the packaging in which they are sold. Be reasonable about sending three samples of your product with the mark on them. If you are using your trademark for a line of pianos, you should probably just send us three original and separate photographs of the trademark as it is affixed to your pianos or their packaging – the mark needs to be clearly visible. After all, we do not really have room to store three pianos and we are pretty sure you do not want to pay for the stamps to mail them to us. Original specimens of service marks include samples of marketing material used to promote the specific service or original letterhead, business cards, invoices or envelopes containing the mark as it is used to promote your specific services.

The important point to keep in mind – the two forms of “original specimens” as outlined above are the only two types we can legally accept. We cannot accept a photocopy of your original photographs, blueprint drawings of your product, faxes of your original photographs, crayon renderings by your three year-old or any of the many more or less second-hand methods of providing us with a specimen. If it is not a sample of your product with the mark on it or an original photograph, we will have to reject your application for registration. As you have probably guessed by now, this particular requirement is a major stumbling block for many individuals and businesses whose applications for trademarks or service marks would otherwise be approved.

What cannot be registered as a trademark or service mark?

Your application for trademark or service mark registration will be immediately rejected if your mark:

1. Consists of or compromises immoral, deceptive or scandalous material:

The Secretary of State’s Office reserves the right to decide what constitutes immoral, deceptive or scandalous material for the purposes of mark registration.

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:

If you think your mark may disparage or suggest a connection with a living or dead person, institution, belief, national symbol or would tend to bring one of them into contempt or disrepute, you may want to consult with competent legal counsel of your own choice before proceeding to use the mark or filing for mark protection with the North Carolina Department of the Secretary of State.

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:

This clause simply means that you should beware of trying to register any trademark that consists of, for the most part, identifiable national symbols like: the U.S. flag; foreign, state or municipal symbols; or official North Carolina symbols such as the Plott Hound – our state dog.

4. Consists of or comprises the name, signature or portrait of any living individual, except with his/her written consent:

Any trademark or service you try to register that falls under this clause will be very closely scrutinized by our staff. The burden of proof of the consent of the individual used in the mark will fall on you. You might want to provide a notarized statement from the individual to evidence consent to the use of his or her name, signature or portrait in the mark, along with a daytime telephone number where we can reach that individual.

5. Consists of a mark which, when applied to the goods or services of the applicant, is merely descriptive of them or merely describes one or more of the characteristics or is deceptively misdescriptive of them or falsely describes the nature, function, capacity or characteristics of them:

If, for example, you are trying to obtain trademark protection for your grandmother's chili recipe, which you want to mass produce and sell throughout North Carolina, and Grandma will not let you use her name and face on the packaging, you will have to come up with a trademark that is not simply a description of the chili. You would have difficulty getting a trademark for "Red Chili" or "Hot, Red Chili" because those proposed trademarks simply describe the color or spiciness of Grandma's chili. You would definitely not receive trademark protection for "Purple, Bland Chili" because it is an outright deceptive description of what is in the can, which is, in fact, red and spicy.

6. Consists of a mark which, when applied to the goods or services of the applicant, is primarily geographically descriptive or deceptively misdescriptive of them:

Grandma may be a proud native of the Tar Heel State, but that does not mean you can name your chili "North Carolina Chili." You can use a geographical description in your mark, but it cannot be the primary aspect of the mark. "Grandma's Original Spicy North Carolina Chili" might come closer to being registered because it is not a trademark which shows primary element is the geographical description "North Carolina." On the other hand, we will deny your trademark registration application if you use a geographically deceptive description in your mark. "Grandma's Original Spicy Norwegian Chili," for instance would probably be rejected for mark registration since it is misdescriptive.

7. Consists of a mark which is primarily merely a surname:

There is a loophole in this clause that may affect your application for mark registration. If your surname has become distinctive of goods or services your business provides, you may be able to register that surname as a mark for those goods and services. You will have to provide us with proof that the surname has been used consistently for at least five (5) years for the goods and services covered by the mark.

8. Consists of or comprises a mark which so resembles a mark already registered in this state or a mark or trade name previously used in this state by another entity and not abandoned:

Imitation is not the sincerest form of flattery when it comes to trademarks and service marks. The general rule of thumb is that if your proposed trademark or service mark so closely resembles another mark already registered or in use in North Carolina that it creates confusion or deceives consumers, we will not register it.

Do I have to register my mark with the federal government?

The only thing we can really tell you on this subject is that you do not need federal registration for your mark in order to obtain mark registration in North Carolina. On the other hand, registering for mark protection with the Trademark Section of the North Carolina Department of the Secretary of State does not obligate you to also file for mark protection with the federal government.

This office does reserve the right to require you to tell us whether you or your company has ever tried to register the whole mark or parts thereof with the U.S. Patent and Trademark Office (USPTO). If we do ask you whether you have ever sought federal protection for your mark, you will have to provide us with the filing date of that federal application, the serial number of the application and the current status of the federal application. If the federal application was denied or otherwise not approved for registration, you must disclose the reasons as supplied by the USPTO.

Federal mark protection may be a good idea if you intend to expand your business beyond North Carolina's geographic borders. It may be a good idea to seek federal mark protection if you are using the Internet to market your business. In either case, we recommend you seek competent legal counsel of your own choice for advice. Here are a few places where you can obtain information about federal trademark registration:

U.S. Patent and Trademark Office

1-800-786-9199

TrademarkAssistanceCenter@uspto.gov

<http://www.uspto.gov>

This is, without a doubt, the most comprehensive site on the World Wide Web when it comes to information about trademarks and service marks at the federal level. Most of the department's forms can be downloaded from its website. You can also file a trademark or service mark application online. The USPTO database is thoroughly searchable using the Internet. If you cannot find the answer to your question on the website, use the telephone number list above or the e-mail address. Remember – The USPTO does not have the resources to deal with large numbers of e-mail inquires, so be patient if you send an e-mail inquiry.

North Carolina State University D. H. Hill Library

919-515-2935

<http://www.lib.ncsu.edu/ptdl/>

The D. H. Hill Library on the N.C. State University campus in Raleigh serves as one of North Carolina's official repositories for federal documents issued since 1976. The library participates in the USPTO's Patent & Trademark Depository Library (PTDL) program. It has updated copies of the USPTO's Cassis patent and trademark search software on CD ROM. You cannot conduct searches on-line. If you decide to use the NCSU repository, we strongly recommend that you call the library in advance to find out when it is open and what rules currently are for using the library, copy charges and staff assistance, etc. Keep in mind that the trademark search can be very frustrating for someone not familiar with the USPTO's classification system. Once again, you might want to seek competent legal counsel of your own choice to perform this work.

What if I want to copyright it?

North Carolina does not currently offer statewide protection for intellectual property above and beyond what's already provided on the federal level by U.S. copyright laws. The U.S. Copyright Office's website is very comprehensive and includes detailed information about copyright protection in many other nations. Like the U. S. Patent and Trademark Office's web site, this website provides most of it forms in downloadable file formats.

U.S. Copyright Office: Library of Congress

<http://www.copyright.gov/>

U.S. Copyright Office

101 Independence Ave. S.E.

Washington, D.C. 20559-6000

(202) 707-3000 public information

What is a trade name?

A trade name is not the same thing as a trademark in North Carolina. Trade names, also known as fictitious names or assumed names, are used here for businesses that are not formally incorporated but need some kind of name to conduct business. Trade names are filed with the Register of Deeds in the county where the business is operating under N.C.G.S. §66-68. Trade names offer no legal protection for a business's marketing images and symbols and the N.C. Secretary of State does not keep records of trade names registered in the state's 100 counties.

What happens after I apply for a mark registration?

What won't happen is an immediate registration of your application. You will be notified within a few weeks of receipt of the registration. However, it often takes several weeks of research by our staff before we can either grant or deny an application for mark registration. During the research and review period, we may need further information from you about the mark. Please be as prompt as possible in responding to these requests because doing so will help us process your application more swiftly.

We may also ask you to disclaim parts of your mark we believe to be unregistrable. We may also ask you to amend your application or resubmit your original application. If our staff determines that your mark is not entitled to a registration, we are required by law to tell you why your application was rejected. We are also required by law to provide you with a reasonable amount of time to respond to the rejection and amend the application. In that case, we will re-examine your amended application after you have responded to our reasons for rejecting the initial application. If you do not respond to our rejection or re-submit an appropriately amended application within the time specified on the rejection letter, we will officially list your application for mark registration as abandoned.

One problem that often renders marks unregistrable occurs when marks for the same or related goods and services are so similar in design and appearance that they would tend to confuse consumers. Whenever more than one application seeking registration of the same or confusingly similar marks for the same or related goods or services and processes those applications concurrently, the Secretary shall grant priority to the applications in order of filing.

If you are unable to meet the statutory requirements for mark registration as interpreted by our staff, you may still be able to get your mark registered. North Carolina law allows you to seek a writ of mandamus, a court order compelling the N.C. Department of the Secretary of State to register your mark. The writ may be granted without costs to our department once you have provided proof to the court that all the statements in your application are true and your mark is entitled to registration. We encourage you to seek competent legal counsel of your own choice if you feel that our final denial of mark registration was made in error.

What is the examination process?

Upon filing an application for registration and payment of the application fee, the Secretary of State may cause the application to be examined for conformity with Article 80 of the North Carolina General Statutes.

The applicant must provide any additional relevant information requested by the Secretary of State, including a description of a design mark, and may make, or authorize the Secretary of State to make, any amendments to the application reasonably requested by the Secretary of State or deemed by the applicant to be advisable to respond to a rejection or objection.

The Secretary of State may require the applicant to disclaim an unregistrable component of a mark otherwise registerable, and an applicant may voluntarily disclaim a component of a mark requested to be registered. No disclaimer shall prejudice or affect the applicant's or registrant's rights then existing or thereafter arising in the disclaimed matter, or the applicant's or registrant's rights of registration on another application if the disclaimed matter is distinctive of the applicant's or registrant's goods or services.

The Secretary may (i) amend the application submitted by the applicant, if the applicant consents, or (ii) require a new application be submitted.

If the Secretary of State finds that the applicant is not entitled to registration, the Secretary of State shall advise the applicant of the reasons the applicant is not entitled to registration. The applicant shall have a reasonable period of time, specified by the Secretary of State, in which to reply or to amend the application. If the applicant replies and amends the application, the Secretary shall reexamine the application. This procedure may be repeated until (i) the Secretary finally refuses registration of the mark, or (ii) the applicant fails to reply or to amend the application within the specified period. If the applicant fails to reply or to amend the application, the application shall be deemed to have been abandoned. **Should the applicant still desire to register the Trademark of Service Mark in North Carolina after abandonment, a new application and fee is required.**

What happens after my application is approved?

We will send you a Certificate of Mark Registration suitable for framing. After all, you worked hard to get this mark registered! Your Certificate of Mark Registration is legal proof that the mark described on the certificate was registered in our office. Your original certification is good for ten (10) years after the date it is granted. If you plan to renew your mark, you should file an application for renewal with the Trademark Section within six (6) months of the expiration date of the certification. A renewal requires the renewal application, the non-refundable renewal fee is \$35, and three (3) original specimens of the mark as it is used.

At the five (5) year mark, North Carolina law requires that you submit an affidavit – a signed statement verifying that the mark is still in active use along with an original specimen of the mark still being used. You must do this within six months following the fifth anniversary of the date on which your mark was originally granted or renewed. If you do not provide the specimen and signed affidavit, we are required by law to cancel your mark's registration. We are also required by law to notify you in writing in advance of the deadline for the five-year verification of your original mark approval and the ten-year renewal. We will mail notification to the registrant at his or her last known address, so please notify us in writing in the event your address changes.

In summary, what is required after the application is approved?

1. Five (5) year Affidavit of Use,
2. Ten (10) year Renewal Application, and
3. Send in a written change of address when applicable.

Once I register a mark, can I sell it to someone else?

Yes, you can. Transferring the right to use a mark to another person or business entity is called an assignment. Regardless of whether or not you receive any financial payment for assigning your mark to someone else, the transaction will have to be recorded in writing. We also very strongly recommend that people purchasing registered marks, assignees, request that the transaction be recorded with the Trademark Section. The fee for a Certificate of Assignment of the mark is \$25.

After filing the assignment, the Trademark Section will issue a certificate evidencing assignment to the assignee. The certificate will be valid for the remainder of the current term of registration. If you are the assignee of a registered mark, you can only protect your exclusive right to use that mark by filing for a Certificate of Assignment. We strongly recommend that, if you have any questions or concerns about your particular mark assignment, you retain competent legal counsel of your own choice to help guard your ownership interests in your mark.

What might cause me to lose my mark registration?

We can – and will – cancel the registration for your mark if:

1. You or your assignee requests in writing that we cancel the mark registration.
2. Your registration is not renewed on time.
3. A court finds that your mark has been abandoned or, for some reason, can no longer serve as your mark or the mark registration was granted improperly or obtained fraudulently. Court findings that the registrant was not the actual owner of the mark or that the registered mark is or has become the generic name for the goods and services for which it has been registered will also lead to cancellation of registration.
4. A court finds that your mark registration was obtained using materially false statements in the mark registration application.
5. A court finds that your registered mark is so similar to another mark already in use in North Carolina and registered with the U.S. Patent and Trademark Office that it would likely confuse or deceive consumers.
6. You do not comply with our requirements for the five-year use affidavit.
7. A court orders us to cancel your mark registration. We cannot anticipate all of the legal reasons why a court with jurisdiction over trademark or service mark matters might order a mark cancellation. We can tell you that we are obligated, under state law, to obey any such judicial orders. If you have any reason to suspect that a court might order us to cancel your mark registration, we recommend that you seek competent legal counsel of your own choice before applying for mark registration.

How do I find the classification for my particular product or service?

We have provided a list of mark classifications in *Appendix A* of this manual. If you do not see your particular good or service on that list or if you are not sure where your product or service should be classified, please contact the Trademark Section. While we try to keep the list updated with every version of this manual we release, we realize there will be times when our version of the classification categories may not match those issued by the U.S. Patent and Trademark Office. (We have the statutory authority to keep our classification scheme in harmony with the USPTO's, but we are not required to do so.)

We urge you to do your research on this particular item before filing your application for mark registration. A separate application and registration fee is required for each classification category in which you try to register your mark.

Is there any way I can get into legal trouble with my mark?

There most certainly is. Before we explain the ways you can get yourself entangled in the complexities of trademark law, let us be absolutely clear about how you can usually avoid getting into hot water with that law, either civilly or criminally – hire an attorney. If you have any concerns about registering your mark legally and complying with the law after you relieved that registration, you should seek competent legal counsel of your own choice. The Trademark Section cannot be expected to act as your legal counsel.

Here are some of the ways you can get yourself into legal trouble with the trademark laws.

1. **Fraudulent registration:** If you make any untrue statements or claims in writing or verbally in order to obtain mark registration, you will be held liable under North Carolina law for any and all damages caused to other parties by your actions. Since trademarks and service marks often mean so much monetarily in terms of a product or service’s image, any damage award against you could be substantial. Besides that, we will cancel your mark if we find out you obtained registration under false pretenses.
2. **Trademark infringement:** If you use someone else’s registered mark without their consent in order to sell, offer for sale or advertise your own goods and service, you have committed trademark infringement. If the owner of the mark can prove that you knew that, by copying their mark for your own goods or services, you would confuse or deceive the public, you could be at risk for substantial legal damages.

You could also go to prison. If, as the law says, you “knowingly and willingly” use a counterfeit mark for goods and services with a market value between \$3,000 and \$10,000, you could be found guilty of a Class I felony in North Carolina. If the goods and services marketed with the counterfeit mark exceed \$10,000 in market value, you could be convicted of a Class H felony in North Carolina. You only have to have 25 items bearing the counterfeit mark in your possession to create the legal presumption that you intended to sell them. Possession of any tool, machine or other device with the intent to use it to counterfeit a mark is a Class H felony in North Carolina.

The N.C. Department of the Secretary of State takes trademark counterfeiting very seriously. State law empowers the Secretary of State to work with other agencies, local police and prosecutors to investigate counterfeit cases and, when it is appropriate, vigorously prosecute them. We understand that anyone who knowingly and willingly practices trademark infringement is not likely to be deterred by the knowledge that we can and will prosecute them. What we do hope is that you will take us seriously enough to make sure that you do not ever infringe on someone else’s mark, even by mistake. Once again, the best way to protect yourself lies in securing competent legal counsel of our own choice.

What else do I need to know in order to register my mark?

First, please be patient with us. Technology upgrades are helping us process more applications in a shorter amount of time. Trademark law, however, can be very complex and it may take some time to work out any issues surrounding your application.

Second, if you have any concerns about your application for mark registration being approved, please hire competent legal counsel of your own choice. We cannot act as your legal counsel and we do not want your legal rights in any way jeopardized. The cost of representation during the mark registration process may pay off for years to come. Call your local bar association or the N.C. Bar Association's Lawyer Referral Service at **1-800-662-7660** for assistance in selecting competent legal counsel of your own choice.

Third, pay particular attention to the description of your mark, the classification category in which you want to register your mark and the specimen requirements for your application.

These three items, more than anything else, cause us to reject initial application for mark registration. If you have any questions about the mark registration please visit our website and view the Frequently Asked Questions web page. You may access the North Carolina Trademark Section website through the main page of the North Carolina Secretary of State's Home page at www.sosnc.com.

Fourth, please respect your mark and others' marks. Trademarks and Service marks are very powerful marketing tools for nearly every business in North Carolina. Make sure you keep your mark registration current and that you meet the state's reporting requirements during the time you own your mark.

Appendix A

Classification of Goods and Services for Mark Registration

The Trademark Section of the N.C. Department of the Secretary of State currently uses the following classification scheme in assigning mark registration. Please note that these categories are subject to change.

North Carolina Classification of Goods

1. **Raw or partly-prepared materials:** Items such as animal pelts, hides, leather and imitation leather; live animals including insects, live fowl and hatching eggs; ore, clay, gravel, sand and rock; packing material for forming seals or packing padding of plastic or rubber for shipping containers, hair, excelsior, etc.; plastic sheets, synthetic or natural resins; synthetic or natural rubber; seeds; straw or hay, sawdust, shavings, etc.; charcoal and solid fuels including logs; natural and synthetic fibers and textile filaments.
2. **Receptacles:** Items such as baskets, buckets, jugs, boxes, trays, canisters and cans; gas cylinders; and non-glass jars.
3. **Baggage, animal equipment, portfolios and pocketbooks:** Items such as duffel bags and knitting bags; harnesses, saddles, leashes, collars and animal blankets; horseshoes; luggage of all kinds including briefcases and trunks; wallets, purses and handbags.
4. **Abrasives and polishing materials:** Items such as abrasive cleaners, sandpaper, belts; floor and furniture oils, floor waxes; metal polishes, natural and artificial abrasives, polishing and buffing compounds, polishing and cleaning preparation combined, polishing waxes, powders, shoe polish, and steel wool.
5. **Adhesives:** Items such as adhesive sides; asphalt tile cement; any combination of adhesive with a backing or reinforcement tape or strip of paper, cloth; gasket cement; glues and mucilages; pastes and rubber cement.
6. **Chemicals and chemical compositions:** Items such as air fresheners and air deodorants; carbons (absorbing); electrocardiograph electrodes (chemical conductors for use with); brake fluid; rust inhibitors (automobile cooling system); sizing compounds; emulsifiers for use in the manufacture of goods and in the manufacture of leather and textiles; photographic chemicals; dyes for use in the manufacture of leather, fur, wood, pigment (color); preservatives for flowers or masonry; chemical additives; oxidants; preparations and chemically treated papers; agricultural pesticides; catalysts; antifreeze; fire extinguishers using chemical compounds.
7. **Cordage:** Items such as clothesline cord; rope (macramé); wire; cargo strings of metal); string; twine; baling twine; wire rope and wire rope slings.
8. **Smoker's articles:** Items such as ash trays of all forms; cigarette cases, cigar cutters; pouches; cigarette papers; lighters, flints; pipes, pipe cleaners and cigarette holders.
9. **Explosives, firearms, equipment and projectiles:** Items such as blasting caps; compounds; explosives; gelatin; paper and powder; detonators; bombs; explosive caps; fog signals; fuses used in mining; powders, primers, shells, torpedoes; fireworks; and dynamite.
10. **Fertilizers:** Items such as compost, manure; lime (agricultural); plant food and plant growth regulators, fertilizers for agricultural or domestic use; soil conditioners; potting soil.
11. **Inks and inking materials:** Items such as carbon paper; ribbons for typewriter, printers, computers, inking, label printing, and office machines; ink of all forms; inking pads; and stamp pads.
12. **Construction materials:** Items such as cement mixes; posts, cement roofing; ceramic enamel fiber insulation; concrete, concrete beams; building materials; patching compound; plaster; doors; non-metal guard rails; forms for use in casting; windows, window casements; frames, shutters; sills and frames; glass windows; insulating material; glazes; jalousies; caulking and caulking compounds; lumber; plywood; fiberboard; bricks; stones and paving stones; panels; prefabricated homes and houses; roofing materials; flashing; gutters; louvers.
13. **Hardware, plumbing and steam-fitting supplies:** Items such as cabinet hardware and store fixture parts; key rings and metal plugs; nails, screws, nuts and bolts; pipe, conduit, hose and pipe couplings, pipe and hose fittings; valves; sinks, lavatories, tubs, toilets and parts; wire, barbed wire; fencing panels; stays; posts.
14. **Metal, metal casings and forgings:** Items such as aluminum, brass, bronze, copper and nickel products in strip, sheet, wire, rods for brazing and welding; die steel; metal tubing; rails and railroad ties (metal); sheet steel; casting alloys; metal castings.
15. **Oils and greases:** Items such as gasoline, kerosene and penetrating oils; lubricants and greases; naphtha and fuel oils.
16. **Protective and decorative coatings:** Items such as paint, paint thinners, paint primer; sealer coatings; paint sealers; leather and wood stains; shellac as a surface coating; varnish; undercoatings.

17. **Tobacco products:** Items such as tobacco in general as well as chewing, smokeless and flavorings for; snuffs; cigarettes, cigars and cigarillos.
18. **Medicines and pharmaceutical preparations:** Items such as antiseptics, antibiotic creams, tablets and ointments; fungicides for agricultural and domestic use; hormones; vitamin and mineral supplements; food, herbal, nutritional and dietary supplements; medicated lotions; medicated skin-care preparations; analgesic or medicated lip balm; acne treatment or medications; pharmaceutical preparations.
19. **Vehicles:** Items such as airplanes, boats, automobiles, trucks, buses, bicycles, motorcycles and parts therefore; baby carriages; personal watercraft; strollers; parachutes; hang gliders; railroad cars; trailers; dollies; wagons; and mobile homes.
20. **Linoleum and oiled cloth:** Items such as linoleum flooring, vinyl and plastic tiles; vinyl and plastic wall coverings; oilcloths; carpet padding.
21. **Electrical apparatus, machines, supplies and consumer electronic goods:** Items such as electric motors for machines; capacitors; ceramic insulators; insulating tape; cathode ray tubes; batteries and battery chargers; light switches; light bulbs; light dimmers; lighting fixtures; fluorescence; electric track lighting units; computer cables; computer chips; electrical cables; flashlights; lamps and lamp shades; warning lights; generators; alternators; circuit boards, circuit breakers; telephones and telephone receivers; cellular telephones; television sets and antennas; radios; electric stoves; blenders; vacuum cleaners; microscopes; video tapes; video recorders; voltage surge protectors and suppressors; switches and switch plates; facsimile machines; receivers; satellites; laser scanners and lasers not used for medical use; UPC scanners and other bar-code scanners .
22. **Games, toys and sporting goods:** Items such as amusement park equipment, coin-operated machines and games of skill; bowling equipment, billiard and pool tables; children's toy furniture; dolls, balls, rubber and plastic toys, skates, skis, skate boards, snow boards and surf boards; fishing tackle and artificial bait; exercise equipment; mechanical toys; playing cards, games and parts; puzzles; tents; inflatable swimming pools.
23. **Cutlery, machinery tools and parts:** Items such as centrifuges and centrifugal pumps; grinders, grinding wheels and grindstones; lathes; mills and milling machines; earth moving machines, namely graders, loaders, sarifiers and scrapers; electric pencil sharpeners; fire extinguishers; garbage disposals; garden hoses; gardening tools, namely trowels, weeding forks, spades, and hoes; lawn mowers; blowers for lawn debris; tractors; milking machines; die-cutting or stamping machines; diesel engines for machines; cookie paper or pizza cutters; staples and staple removers; pumps; pocket knives; shears and shearing machines; shredders; pulleys; chucks for power drills; sewing machines; power tools; spreaders; sprayers; dishwashers.
24. **Laundry appliances and machines:** Items such as ironing boards; electric, flat or steam irons; washing machines for clothes; washing boards; clothes pins.
25. **Locks and safes:** Items such as lockboxes; metal locks and keys therefore; ash or money boxes; safes; door chains; padlocks; key chains; key blanks; key and key cylinders (door hardware, namely).
26. **Measuring and scientific equipment:** Items such as video monitors; video camcorders; camera cases, film, tripods, filters and photographic cameras; radar and radar detectors; sonars; calipers; measuring cups and spoons; adding machines and cash registers; gas and water meters; microfiche; metal detectors; microscopes; microwave ovens for laboratory use; computer discs or diskettes; computer hardware including mouse, keyboard, modem, interface boards; film projectors and projection screens; laboratory glassware; scales; levels; gasoline pumps; recorders; optical cables; mirrors; filters and scanners; eyeglass lenses and frames; safety markers, harnesses and goggles; safety cones.
27. **Horological instruments:** Items such as watches and watch fobs, chains, movements, stop watches and parts therefore; clocks, clock radios, alarm clocks and parts therefore; sundials, chronometers and chronographs.
28. **Jewelry and precious metalware:** Items such as jewelry, costume jewelry and jewelry boxes; lapel pins, brooches; cuff links; ID bracelets; trophies of precious metal; sterling silver tableware; and other items fashioned from precious metals.
29. **Brooms, brushes and dusters:** Items such as brushes; brooms; mops; window and furniture dusters; paint roller covers; paint trays; paint stirrers and applicators; polishing cloths and gloves; toothbrushes.
30. **Crockery, earthenware and porcelain:** Items such as china ornaments; pottery, vases; porcelain eggs.
31. **Filters and refrigerators:** Items such as ice chip machines; freezers and walk-in freezers, refrigerators and refrigerator cabinets; water filters; water coolers.
32. **Furniture and upholstery:** Items such as bedroom furniture; box springs and mattresses; children's furniture; cushions, sofas and hassocks; file cabinets, storage files and racks for storage; living room furniture; mirrors and easels; office furniture; outdoor furniture; reclining chairs and sofa beds; tables, desks and office chairs.
33. **Glassware:** Items such as cut, blown and cast glass; crystal prisms; plate glass for cars or vehicle windows; glass granules; glass rods, panes or panels; glass bowls; bulbs and beverage ware.
34. **Heating, lighting and ventilation apparatus:** Items such as air conditioning equipment; kilns; fireplace equipment; heat transfer apparatus; heat treating equipment; heaters and heat pumps; clothes dryers; light sticks; non-electric lights; radiation-type furnaces and room heaters; steam appliances; wood-burning stoves; oil lanterns; radiators (electric and steam); steam generators; stoves; solar collectors and solar heating panels.
35. **Belting, hoses, machinery packing and non-metallic tires:** Items such as clutch and brake facings; conveyer and transmission belting; rubber hoses, packings, gaskets and washers; tires, tire patches and inner tubes; rubber

bands; joint, graphite, plastic and asbestos packing for pipes, gaskets, plumps, valves, shipping containers and for forming seals; rubber and fiber washers

36. **Musical instruments and supplies:** Items such as harmonicas; percussion, wind and stringed instruments; phonographs, records and record players; pianos and organs; synthesizers; audio cassettes; digital audio tapes and tape players; compact discs; dictation machines.
37. **Paper and stationery:** Items such as binders and ledger books; mimeograph and copier paper; continuous-feed and laser printer computer papers; unprinted labels; paper wrappers, paper towels and scratch pads; pens, crayons, pencils, erasers, chalk and magic markers; wallpaper, cleaning and toilet tissue paper; waxed paper, printing paper and sketch paper.
38. **Prints and publications:** Items such as dictionaries, booklets; exposed photo prints and transparencies; greeting cards; decals; pamphlets, books and manuals; art and graphic reproductions; news columns and cartoons, newspaper supplements; newsletters; printed labels; reports and advertising material; publications fixed in electronic media; software; wall calendars; medical ID cards.
39. **Clothing:** Items such as blouses, skirts and sweaters; dresses, suits, skirts, coats, topcoats, overcoats and vests; earmuffs; fur coats, capes, stoles and hats; hosiery; insulated garments, gloves, aprons and jackets; raincoats, swimwear and diapers; shoes, slippers, suspenders, garters and belts; sleepwear, lingerie, underwear, etc.
40. **Fancy goods, furnishings and notions:** Items such as braids, shoe laces; buttons, buckles and snap fasteners; elastic tape; hair pins and clips; hand-sewing needles, pins, crochet and knitting needles; sewing kits; shoe horns; clothing hooks as well as hooks and eyes.
41. **Canes, parasols and umbrellas:** Items such as umbrellas and parts therefore; canes and cane handles; walking sticks.
42. **Knitted, netted and textile fabrics and substitutes:** Items such as bedsheets, blankets, comforters and pillow cases; fabrics such as cottons, polyester, nylon, gauze, woolens, rayon, acetate; curtains; rugs and carpets; upholstery fabrics, draperies and slip covers.
43. **Threads and yarns:** Items such as threads of all kinds, including silk, cotton and synthetic sewing threads; yarns of all kinds.
44. **Dental, medical and surgical appliances:** Items such as dentures; bridges and crowns; dental instruments; pacifiers; diagnostic apparatus; medical x-ray equipment; eye droppers and eye patches; hospital beds and invalid lifts; prosthetic and orthopedic devices; orthodontic appliances; respirators and resuscitators; stretchers and crutches; surgical instruments and devices; computer-aided tomography (CAT) scanners, magnetic resonance imaging (MRI) scanners; lasers used for medical purposes.
45. **Soft drinks and carbonated waters:** Items such as non-alcoholic carbonated beverages; spring waters; soda water; soft drinks; lemonades and lemonade syrup; and other fruit-based or artificially-flavored beverages.
46. **Foods and food ingredients:** Items such as animal feeds; breads, cookies, pies, rolls, cakes and other baked goods; cake, bread, biscuit and roll mixes; four and corn meal; candies, fruits, confections and chewing gum; canned fruits, vegetables, sauces, meats and meat substitutes; cereals and hominy grits; cider and grape juice; coffee, tea and dried milk; dehydrated soups, sauces, puddings and gelatin; fish, shrimp and lobster; food colors and preservatives; frozen fruits, juices, meats, vegetables, etc.; honey, syrup, jams and jellies; peanut butter; pet foods; salad dressings, spices, seasonings and yeast shortenings and vegetable oils; seafood.
47. **Wines:** Items such as wines used for cooking and aperitif, wine cocktails, wine coolers and wine in general. Other items are hard cider, sherry, vermouth, champagne and port wines.
48. **Malt beverages and liquors:** Items such as ale and porter; beer; stout; and malt liquors.
49. **Distilled alcoholic liquors:** Items such as cordials and rum; alcoholic cocktails; gin, vodka; brandy and brandy spirits; whiskey; specialty liqueurs.
50. **Merchandise not otherwise classified:** Items such as artificial plants, Christmas trees and ornaments; sculptures; tarpaulins; dressmaker dummies; hangers; shoe trees and mannequins; miscellaneous kits; plaques; pennants and flags.
51. **Cosmetics and toiletries:** Items such as bath salts, oils, etc.; tooth pastes, powders and creams; mouthwashes; personal deodorants; hair spray and preparations, tints, dressings, creams and lotions; lipstick, eye makeup; perfumes, colognes and toilet waters; shave creams and depilatories; skin creams, lotions, face and body powders.
52. **Detergents and soaps:** Items such as cleaner preparations; cleaning concentrates; floor cleaners; soaps and shampoos; detergent solvents; skin soaps.

North Carolina Classification of Services

100. Miscellaneous

- A. Hotels and motels
- B. Convenience stores
- C. Child care services
- D. Dental services
- E. Employment services, data processing and printing
- F. Flowers, balloons, gifts, telegrams, musical dancers, etc.
- G. Government services; promotions of cities and towns
- H. Health care services and facilities; Emergency Medical Technician certification
- I. Interior design and decorating
- J. Cosmetology, hair, nails, etc.
- K. Charitable organizations
- L. Landscaping
- M. Miscellaneous services not otherwise classified
- N. Night clubs and entertainment services
- O. Consulting services and hypnosis clinics
- P. Photographic and camera services; art sales
- Q. Framing services
- R. Restaurants
- S. Spa, tanning and diet services
- T. Real estate, building, surveying, etc.
- U. Union labels; membership services
- V. Veterinary services; animal-related services and boarding
- W. Recreation
- X. Janitorial
- Y. Religious; funeral, burial and cremation

101. Advertising and business services:

- A. Computer sales, service, supplies and consulting
- B. Convenience stores, grocery stores, gourmet food stores, etc.
- D. Clothing sales and dry cleaning
- E. Employment services, data processing and printing
- F. Flowers, balloons, gifts, telegrams, musical dancers and crafts
- G. Auto sales and repairs, rentals, supplies and oil jobbers
- H. Health care, drug stores and medical supplies
- I. Interior design, carpet sales and installation, furniture, etc.
- J. Cosmetology, makeup, nails, hair, etc.
- L. Landscaping, plant sales, etc.
- M. Miscellaneous services not otherwise classified
- N. Advertising agencies, promotion agencies, sign rentals
- P. Photo, camera and art sales
- Q. Jewelry sales
- R. Video rentals and sales; book, music and electronic consumer goods sales
- S. Spa, tanning, diet services and modeling
- T. Real estate, building, surveying, mobile home sales
- U. Membership service for clubs and associations; funeral, burial and cremation services
- V. Veterinary, animal-related and pet board services
- W. Recreational equipment sales, sporting goods and recreational vehicle sales.
- X. Janitorial, chimney sweeps
- Z. Credit card discount buying services; insurance and financial services

102. Financial and insurance: Services such as banking and credit agencies; pawn brokers and bonding agents; security and commodity brokerage; insurance sales agents; insurance underwriting.

103. Construction and repair: Services such as highway construction and repair; building construction; construction machinery, tools and materials sales and rental; custom tailoring and fabric reweaving; dry cleaning and laundry; electrical services; construction inspection; interior decoration; maintenance of tools and equipment; auto sales and maintenance; auto service stations; painting, including automotive painting; pest control in buildings; jewelry and watch repairs; chimney sweeps; drain and sewer cleaning services; window washing; janitorial building care; servicing and refueling of building and heating equipment.

104. **Communications:** Services such as cable television and broadcasting; radio broadcasting; cellular telephone and paging services; telephone, telegraph, teleprinter and leased-line communications services; World Wide Web information and Web site maintenance services; commercial e-mail services.
105. **Transportation and storage:** Services such as messenger services; packing and storing goods; air, rail, road or water transport of goods; trailer, auto and truck rentals; taxicab service for disabled persons; bus, rail, air or water transport of passengers; oil, gas and petrochemical transport and storage; travel agencies and travel guide services.
106. **Material treatment:** Services such as dyeing; lens grinding; metal machining and casting; metal plating and soldering; photofinishing; textile fabric finishing; weed control by chemical treatment.
107. **Education and entertainment:** Services such as historic material collection; genealogical research; study and correspondence courses; music, dance, martial arts, sports and theatrical instruction; equitation and riding instruction; museum displays, lectures and demonstrations; drill team organizations; play, concert, operatic and other live performances and production; radio and television programs; book and videotape rentals; Internet access and content provision; amusement center rides; athletic, academic and band booster organizations.

**N.C.G.S. Chapter 80
Trademarks, Brands, etc.**

Article 1.

Trademark Registration Act.

§ 80-1. Definitions.

(a) The term "applicant" as used herein means the person filing an application for registration of a trademark under this Article, the person's legal representatives, successors or assigns.

(b) The term "mark" as used herein includes any trademark or service mark entitled to registration under this Article whether registered or not.

(c) The term "person" as used herein means any individual, firm, partnership, corporation, association, union or other organization.

(d) The term "registrant" as used herein means the person to whom the registration of a trademark under this Article is issued, the person's legal representatives, successors or assigns.

(d1) The term "Secretary" as used herein means the Secretary of State or the designee of the Secretary charged with the administration of this Article.

(e) The term "service mark" as used herein means a mark used in the sale or advertising of services to identify the services of one person and distinguish them from the services of others.

(f) The term "trademark" as used herein means any word, name, symbol, or device or any combination thereof adopted and used by a person to identify goods made, sold, or distributed by him and to distinguish them from goods made, sold, or distributed by others.

(g) The term "use" means the bona fide use of a mark in the State of North Carolina in the ordinary course of trade, and not merely the reservation of a right to a mark. For the purposes of this Article, a mark shall be deemed to be "used" in this State (i) on goods when it is placed in any manner on the goods or their containers or the displays associated therewith or on the tags or labels affixed thereto, or if the nature of the goods makes placement impractical, then on documents associated with the goods, and the goods are currently sold or otherwise distributed in the State, and (ii) on services when it is used or displayed in the sale or advertising of services and the services are currently being rendered in this State, or are being offered and are available to be rendered in this State.

(h) A mark shall be deemed to be "abandoned" when either of the following occurs:

- (1) When its use has been discontinued with intent not to resume its use. Intent not to resume may be inferred from circumstances. Nonuse for three consecutive years shall constitute prima facie evidence of abandonment.
- (2) When any course of conduct of the owner, including acts of omission as well as commission, causes the mark to lose its significance as a mark. (1903, c. 271; Rev., s. 3012; C.S., s. 3971; 1941, c. 255, s. 1; 1967, c. 1007, s. 1; 1991, c. 626, s. 1; 1997-476, s. 1.)

§ 80-1.1. Purpose.

The purpose of this Article 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, 15 U.S.C. § 1051, et seq., as amended. The construction given the federal act should be examined as persuasive authority for interpreting and construing this Article. (1997-476, s. 2.)

§ 80-2. 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 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, signature or portrait of any living individual, except with his written consent; or
- (5) Consists of a mark which (i) when applied to the goods or services of the applicant, is merely descriptive of them or merely describes one or more of the characteristics, or is deceptively misdescriptive of them, or falsely describes the nature, function, capacity, or characteristics of them, or (ii) when applied to the goods or services of the applicant, is primarily geographically descriptive or deceptively misdescriptive of them, or (iii) is primarily merely a surname; provided, however, that nothing in this subdivision (5) shall prevent the registration of a mark used in this State 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 applied to the applicant's goods or services, proof of continuous use thereof as a mark by the applicant in this State for the five years preceding the date on which the claim of distinctiveness is made; or
- (6) Consists of or comprises a mark which so resembles a mark registered in this State or a mark or trade name previously used in this State by another 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. (1903, c. 271; Rev., ss. 3012, 3017; C.S., ss. 3971, 3976; 1941, c. 255, s. 1; 1967, c. 1007, s. 1; 1991, c. 626, s. 2; 1997-476, s. 3.)

§ 80-3. Application for registration.

(a) Subject to the limitations set forth in this Article, any person who uses a mark, or any person who controls the nature and quality of the goods or services in connection with which a mark is used by another, in this State may file in the office of the Secretary in a format to be prescribed by the Secretary, an application for registration of that mark setting forth, but not limited to, the following information:

- (1) The name and business address of the person applying for registration; and, if a corporation, the state of incorporation. If the application for registration relates to a mark used in connection with goods, the applicant shall list either the address of the applicant's principal place of business in North Carolina or a place of distribution and usage of the goods in this State. If the application for registration relates to a mark used in connection with services, the applicant shall list a physical location at which the services are being rendered or offered in this State;
- (2) The goods or services in connection with which the mark is used and the mode or manner in which the mark is used in connection with the goods or services and the class in which the goods or services fall;
- (3) The date when the mark was first used anywhere and the date when it was first used in this State by the applicant, the applicant's predecessor in business or by another under the control of the applicant; and
- (4) A statement that the applicant is the owner of the mark, that the mark is in use, and that to the best of the knowledge of the person verifying the application, no other person has registered in this State, or has the right to use the mark in this State either in the identical form thereof or in such near resemblance thereto as to be likely, when applied to the goods or services of the other person, to cause confusion, or to cause mistake, or to deceive.

(b) The application shall be signed and verified by the applicant, by a partner, by a member of the firm, or an officer of the corporation or association applying for registration. In states in which a notary is not required by law to obtain a notary's stamp or seal, an original certificate of authority of the notary issued by the appropriate State agency shall be submitted with the application. If the application is signed by a person acting

pursuant to a power of attorney from the applicant, an original power of attorney or a certified copy of the power of attorney shall accompany the application.

The application shall be accompanied by three specimens of the mark as currently used and by a filing fee of seventy-five dollars (\$75.00), payable to the Secretary.

(c) The Secretary may require a statement as to whether an application to register the mark, or portions or a component 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 any relevant information required by the Secretary, including the filing date and serial number of the application and the status of the application. If any application was finally refused registration or has otherwise not resulted in a registration, the Secretary may require the applicant to provide in the statement the reason the application was not registered. The Secretary may also require that a drawing of the mark accompany the application in a form specified by the Secretary. (1903, c. 271, s. 3; Rev., s. 3014; C.S., s. 3973; 1935, c. 60; 1941, c. 255, s. 2; 1967, c. 1007, s. 1; 1983, c. 713, s. 49; 1991, c. 626, s. 3; 1997-476, s. 4; 2002-126, s. 29A.36.)

§ 80-3.1. Examination of application.

(a) Upon filing an application for registration and payment of the application fee, the Secretary may cause the application to be examined for conformity with this Article.

(b) The applicant shall provide any additional relevant information requested by the Secretary, including a description of a design mark, and may make, or authorize the Secretary to make, any amendments to the application reasonably requested by the Secretary or deemed by the applicant to be advisable to respond to a rejection or objection.

(c) 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 requested to be registered. No disclaimer shall prejudice or affect the applicant's or registrant's rights then existing or thereafter arising in the disclaimed matter, or the applicant's or registrant's rights of registration on another application if the disclaimed matter is distinctive of the applicant's or registrant's goods or services.

(d) The Secretary may (i) amend the application submitted by the applicant, if the applicant consents, or (ii) require a new application be submitted.

(e) If the Secretary finds that the applicant is not entitled to registration, the Secretary shall advise the applicant of the reasons the applicant is not entitled to registration. The applicant shall have a reasonable period of time, specified by the Secretary, in which to reply or to amend the application. If the applicant replies and amends the application, the Secretary shall reexamine the application. This procedure may be repeated until (i) the Secretary finally refuses registration of the mark, or (ii) the applicant fails to reply or to amend the application within the specified period. If the applicant fails to reply or to amend the application, the application shall be deemed to have been abandoned.

(f) If the Secretary finally refuses registration of the mark, the applicant may seek a writ of mandamus to compel registration. The writ may be granted, without costs to the Secretary, on proof that all the statements in the application are true and that the mark is entitled to registration.

(g) When the Secretary receives more than one application seeking registration of the same or confusingly similar marks for the same or related goods or services and processes those applications concurrently, the Secretary shall grant priority to the applications in order of filing. If a previously filed application is granted a registration, any other application shall then be rejected. A rejected applicant may bring an action for cancellation of the registration on grounds of prior or superior rights to the mark, in accordance with the provisions of this Article. (1997-476, s. 5.)

§ 80-4. Certificate of registration.

Upon compliance by the applicant with the requirements of this Article, the Secretary shall cause a certificate of registration to be issued and delivered to the applicant. The certificate of registration shall be issued under the signature of the Secretary and the seal of

the State, and it shall show the name and business address and, if a corporation, the state of incorporation, of the person claiming ownership of the mark, 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 which the mark is used, a reproduction of the mark, the registration date, the registration number and the term of the registration.

Any certificate of registration issued by the Secretary under the provisions hereof or a copy thereof duly certified by the Secretary shall be admissible in evidence as competent and sufficient proof of the registration of the mark in any action or judicial proceedings in any court of this State. (1903, c. 271, s. 4; Rev., s. 3015; C.S., s. 3974; 1967, c. 1007, s. 1; 1991, c. 626, s. 4; 1997-476, s. 6).

§ 80-5. Duration and renewal.

Registration of a mark hereunder shall be effective for a term of 10 years from the date of registration and shall be renewable for successive terms of 10 years upon application filed within six months prior to the expiration of any term. A renewal fee of thirty-five dollars (\$35.00), payable to the Secretary, shall accompany the application for renewal of the registration. Within six months following the expiration of a term of five years from the date of registration, or the last renewal of registration of the mark, the applicant shall submit a specimen showing evidence of current use of the mark and a signed statement verifying the use of such mark on a form to be furnished by the Secretary of State. Use of the form furnished by the Secretary of State is mandatory. Failure to submit this verification and specimen showing evidence of current use shall be grounds for cancellation of the registration of the mark by the Secretary of State.

The Secretary of State shall notify registrants of marks hereunder of the necessity of renewal within the year next preceding the expiration of the 10 years from the date of registration, by writing to the last known address of the registrants.

The Secretary of State shall notify registrants of marks hereunder of the necessity of submitting evidence of current use of the mark after five years from the date of registration or of the last renewal of registration of the mark, by writing to the last known address of the registrants within the year preceding the due date for such submission.

Registration of marks applied for under previous acts shall be continued in force for the full 10-year term without the necessity of submitting evidence of current use of the mark during the term.

All applications for renewals under this Article, whether of registrations made under this Article or of registrations effected under any prior act, shall be filed with the Secretary in a format prescribed by the Secretary specifying the information called for by G.S. 80-3 and shall include a statement that the mark is still in use in this State, setting forth those goods or services recited in the registration in connection with which the mark is still in use. The registration shall be renewed only as to the goods and services. (1967, c. 1007, s. 1; 1991, c. 626, s. 5; 1997-476, s. 7.)

§ 80-6. Assignment.

(a) Any mark and its registration hereunder shall be assignable with the goodwill of the business in which the mark is used, or with that part of the goodwill of the business connected with the use of and symbolized by the mark. Assignment shall be by instruments in writing duly executed and may be recorded with the Secretary upon the payment of a fee of twenty-five dollars (\$25.00), payable to the Secretary who, upon recording of the assignment, shall issue in the name of the assignee a new certificate for the remainder of the term of the registration or of the last renewal thereof. An assignment of any registration under this Article shall be void as against any subsequent purchaser for valuable consideration without notice, unless it is recorded with the Secretary within three months after the date thereof or prior to subsequent purchase.

(b) Any 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 payment of the

recording fee required under G.S. 80-7. 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 for the remainder of the term of the registration or for the last renewal of the registration.

(c) Other instruments that relate to a mark registered or application pending pursuant to this Article, including licenses, security interests, and mortgages, may be recorded in the discretion of the Secretary, upon payment of the recording fee required under G.S. 80-7. Instruments authorized under this subsection shall be in writing and duly executed.

(d) 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.

(e) A photocopy of any instrument referenced in subsection (a), (b), or (c) of this section shall be accepted for recording if it is certified by any party to the instrument, or the party's successor, to be a true and correct copy of the original. (Rev., s. 3016; C.S., s. 3975; 1967, c. 1007, s. 1; 1991, c. 626, s. 6; 1997-476, s. 8.)

§ 80-7. Records.

The Secretary shall keep for public examination all assignments recorded under G.S. 80-6 and a record of all marks registered or renewed under this Article. The Secretary shall collect the following fees for copying, comparing, and certifying a copy of any filed document relating to a trademark or service mark:

- (1) Five dollars (\$5.00) for the certificate, and
- (2) One dollar (\$1.00) per page for copying or comparing a copy to the original.

The Secretary shall collect a recording fee of ten dollars (\$10.00) for recording name changes of corporate registrants and for recording transfers of the registration of any mark by merger or consolidation if the articles of merger or consolidation are records not on file in the Corporate Division of the Department of the Secretary of State. (1967, c. 1007, s. 1; 1991, c. 626, s. 7; 1997-476, s. 9.)

§ 80-8. Cancellation.

The Secretary shall cancel from the register, in whole or in part:

- (1) Repealed by Session Laws 1991, c. 626, s. 8.
- (2) Any registration concerning which the Secretary shall receive a voluntary request for cancellation thereof from the registrant or the assignee of record.
- (3) All registrations granted under this Article and not renewed in accordance with the provisions hereof.
- (4) Any registration concerning which a court of competent jurisdiction shall find:
 - a. That the registered mark has been abandoned or has become incapable of serving as a mark;
 - 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 registration is for a mark that is or has become the generic name for the goods or services for which it has been registered or for a portion of the goods or services for which it has been registered;
 - f. That the registration was obtained by means of materially false statements in the application for registration; or
 - g. That the registration is so similar to another mark used in the State as to be likely to cause confusion or mistake or to deceive if (i) the other mark was registered by another person in the United States Patent and Trademark Office prior to the date of the applicant's first use of the mark that is the subject of the application for registration, and (ii) the other mark has not been 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 the entire State, the registration shall not be cancelled.
- (5) Any registration when a court of competent jurisdiction shall order cancellation thereof.

- (6), (7) Repealed by Session Laws 1997-476, s. 10. (1967, c. 1007, s. 1; 1991, c. 626, s. 8; 1997-476, s. 10.)

§ 80-9. Classification.

The Secretary shall establish a classification of goods and services for convenience of administration of this Article, but not to 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 for which, the mark is actually being used indicating the appropriate class or classes of goods or services. When a single application includes goods or services that fall within multiple classes, the Secretary may require payment of a fee for each class. The Secretary may amend the classes herein established to conform them to the classification established for the United States Patent and Trademark Office as from time to time amended. (1967, c. 1007, s. 1; 1991, c. 626, s. 9; 1997-476, s. 11.)

§ 80-10. Fraudulent registration.

Any person who shall for himself, or on behalf of any other person, procure the filing or registration of any mark in the office of the Secretary under the provisions hereof, by knowingly making any false or fraudulent representation or declaration, verbally or in writing, or by any other fraudulent means, shall be liable to pay all damages sustained in consequence of filing or registration, to be recovered by or on behalf of the party injured thereby in any court of competent jurisdiction. (1903, c. 271, s. 5; Rev., s. 3018; C.S., s. 3977; 1967, c. 1007, s. 1; 1997-476, s. 12.)

§ 80-11. Infringement.

Subject to the provisions of G.S. 80-13, any person who shall

- (1) Use in this State without the consent of the registrant, any reproduction, counterfeit, copy, or colorable imitation of a mark registered under this Article 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) 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 conjunction with the sale or other distribution in this State of such goods or services; shall be liable to a civil action by the owner of such registered mark for any or all of the remedies provided in G.S. 80-12, except that under subdivision (2) hereof the registrant shall not be entitled to recover profits or damages or any penalty unless the acts have been committed with knowledge that such mark is intended to be used to cause confusion or mistake or to deceive. (1903, c. 271, s. 6; Rev., s. 3019; C.S., s. 3978; 1967, c. 1007, s. 1.)

§ 80-11.1. Criminal use of counterfeit trademark.

(a) For purposes of this section:

- (1) "Counterfeit mark" means a mark that is used in connection with the sale or offering for sale of goods or services that are identical to or substantially indistinguishable from the goods or services with which the mark is used or registered, and the use of which is likely to cause confusion, mistake, or deception, with the use occurring without authorization of the:
 - a. Owner of the registered mark, and is identical to or substantially indistinguishable from a mark that is registered on the principal register of the United States Patent and Trademark Office or with the Trademark Division of the Department of the Secretary of State; or
 - b. Owner of the unregistered mark and is identical to or substantially indistinguishable from symbols, signs, emblems, insignias, trademarks, trade names, or words protected by section 110 of the Amateur Sports Act of 1978 (Title 36, U.S.C. § 380).
- (2) "Retail sales value" means the value computed by multiplying the number of items having a counterfeit mark used thereon or in connection therewith, by the retail price at which a similar item having a mark used thereon or in connection therewith, the use of which is authorized by the owner, is offered for sale to the public.

(b) Any person who knowingly and willfully (i) uses or causes to be used a counterfeit mark on or in connection with goods or services intended for sale or (ii) has possession, custody, or control of goods having a counterfeit mark used thereon or in connection therewith, that are intended for sale, shall be punished as follows:

- (1) If the goods or services having a counterfeit mark used thereon or in connection therewith, or on or in connection with which the person intends to use a counterfeit mark, have a retail sales value not exceeding three thousand dollars (\$3,000), the person is guilty of a Class 2 misdemeanor;
- (2) If the goods or services having a counterfeit mark used thereon or in connection therewith, or on or in connection with which the person intends to use a counterfeit mark, have a retail sales value exceeding three thousand dollars (\$3,000) but not exceeding ten thousand dollars (\$10,000), the person is guilty of a Class I felony; and
- (3) If the goods or services having a counterfeit mark used thereon or in connection therewith, or on or in connection with which the person intends to use a counterfeit mark, have a retail sales value exceeding ten thousand dollars (\$10,000), the person is guilty of a Class H felony.

The possession, custody, or control of more than 25 items having a counterfeit mark used thereon or in connection therewith creates a presumption that the person having possession, custody, or control of the items intended to sell those items.

(c) Any person who knowingly (i) uses any object, tool, machine, or other device to produce or reproduce a counterfeit mark or (ii) has possession, custody, or control of any object, tool, machine, or device with intent to produce or reproduce a counterfeit mark, is guilty of a Class H felony.

(d) Any personal property, including any item, object, tool, machine, device, or vehicle of any kind, employed as an instrumentality in the commission of, or in aiding or abetting in the commission of a violation of subsection (b) or (c) of this section, is subject to seizure and forfeiture and shall be disposed of in accordance with the provisions of Article 2 of Chapter 15 of the General Statutes.

(e) For purposes of enforcing this section, the Department of the Secretary of State's law enforcement agents have statewide jurisdiction. These law enforcement agents may assist local law enforcement agencies in their investigations and may initiate and carry out, in coordination with local law enforcement agencies, investigations of violations of this section. These law enforcement agents have all of the powers and authority of law enforcement officers when executing arrest warrants. These agents shall be authorized to have fictitious licenses, license tags, and registrations, pursuant to G.S. 20-39(h) or G.S. 14-250, for the purpose of conducting criminal investigations.

(f) The Secretary of State may refer any available evidence concerning violations of this section to the proper district attorney, who may, with or without such a reference, institute the appropriate criminal proceedings.

The attorneys employed by the Secretary of State shall be available to prosecute or assist in the prosecution of criminal cases when requested to do so by a district attorney and the Secretary of State approves.

(g) Pursuant to an agreement between the departments, the Secretary of State may refer any available evidence concerning violations of this section to the Secretary of Revenue for purposes of determining the obligations of the violators of this section to the State under the provisions of Chapter 105 of the General Statutes. (1995, c. 436, s. 1.)

§ 80-12. Violation a deceptive or unfair trade practice.

A violation of G.S. 80-10 or G.S. 80-11 constitutes a violation of G.S. 75-1.1. (1903, c. 271, s. 8; Rev., s. 3021; C.S., s. 3980; 1941, c. 255, s. 3; 1967, c. 1007, s. 1; 1995, c. 436, s. 2.)

§ 80-13. Common-law rights.

Nothing herein shall adversely affect the rights or the enforcement of rights in marks acquired in good faith at any time at common law. (1967, c. 1007, s. 1.)

§ 80-14. Severability of Article.

If any provision hereof, or the application of such provision to any person or circumstance is held invalid, the remainder of this Article shall not be affected thereby.
(1967, c. 1007, s. 1.)

Appendix C

Trademarks and Service Marks Schedule of Fees

Initial Registration Fee – per application	\$75.00
Affidavit (5 year)	No Fee
Renewal Fee – per mark.....	\$35.00
Assignment Fee – per assignment.....	\$25.00
Name Change Fee – per change.....	\$10.00
Copies – per page.....	\$1.00
Certified Copy.....	\$5.00

Appendix D

Trademark/Service Mark Registration & Renewal Form with Instructions