

## CHAPTER 333

## ASSUMED NAMES, INSIGNIA, AND MARKS

	<b>ASSUMED NAMES</b>		
333.001	DEFINITIONS.	333.22	TERM OF REGISTRATION.
333.01	COMMERCIAL ASSUMED NAMES.	333.23	CONVEYANCES OF MARKS; RECORDATION, FEE, NECESSITY.
333.02	FILING OF CERTIFICATE.	333.24	SECRETARY OF STATE'S RECORD OF MARKS.
333.035	AMENDMENT OF CERTIFICATE.	333.25	CANCELLATION OF MARKS.
333.04	SECRETARY OF STATE; DUTIES, FEES.	333.26	MUST USE U.S. PATENT AND TRADEMARK OFFICE SYSTEM.
333.055	TERM OF CERTIFICATE.	333.27	IMPROPER REGISTRATION; LIABILITY.
333.06	PLEADING FAILURE TO FILE CERTIFICATE; COSTS.	333.28	IDENTICAL OR SIMILAR MARKS; LIABILITY FOR MISUSE.
333.065	PENALTY FOR VIOLATION.	333.285	DILUTION OF DISTINCTIVE FAMOUS MARK MAY BE ENJOINED.
	<b>INSIGNIA</b>	333.29	REMEDIES.
333.07	LODGES, SOCIETIES AND THE LIKE MAY REGISTER.	333.30	MARKS ACQUIRED AT COMMON LAW.
333.08	APPLICATION.	333.305	FORUM IS DISTRICT COURT; SERVICE ON NONRESIDENT REGISTRANT.
333.09	SECRETARY OF STATE TO KEEP RECORD AND INDEX.	333.31	SERVICE OF PROCESS UPON NONRESIDENT REGISTRANTS.
333.10	DUPLICATES NOT REGISTERED.	333.40	TRADEMARK; WHEN DEEMED AFFIXED.
333.11	ISSUANCE OF CERTIFICATES.	333.41	TRADEMARKS OF WORKERS' UNIONS.
333.12	FEES.	333.42	COUNTERFEITING OR DEALING IN COUNTERFEITS; HOW PUNISHED.
333.13	VIOLATIONS; PENALTIES.	333.43	REGISTRATION.
333.135	IMPROPER USE OF INSIGNIA.	333.44	FRAUDULENT REGISTRATION OR USE; PENALTY.
	<b>AQUATENNIAL</b>	333.45	ILLEGAL USE OF CERTIFICATE OF REGISTRATION.
333.14	UNAUTHORIZED USE IS A CRIME.		<b>PORTORAMA</b>
333.15	THREATENED USE MAY BE RESTRAINED.	333.50	UNAUTHORIZED USE IS A CRIME.
333.16	VESTED RIGHTS NOT AFFECTED.	333.51	THREATENED USE MAY BE RESTRAINED.
	<b>U.S. GOVERNMENT AND MILITARY NAMES</b>	333.52	VESTED RIGHTS NOT AFFECTED.
333.17	FORBIDDEN IN BUSINESS; "MARINE" EXCEPTION.		<b>MINNESOTA ZOOLOGICAL GARDEN</b>
	<b>TRADEMARKS AND SERVICE MARKS</b>	333.53	UNAUTHORIZED USE IS A CRIME.
333.18	DEFINITIONS.	333.54	THREATENED USE MAY BE RESTRAINED.
333.19	UNREGISTRABLE MATTER; COLLECTIVE AND CERTIFICATION MARKS.		
333.20	APPLICATION.		
333.21	CERTIFICATE OF REGISTRATION.		

## ASSUMED NAMES

## 333.001 DEFINITIONS.

Subdivision 1. **Scope.** As used in sections 333.001 to 333.06, the following terms shall have the meanings given, unless the context clearly indicates that a different meaning is intended.

Subd. 2. **Person.** "Person" means one or more natural persons; a limited liability company, whether domestic or foreign; a registered limited liability partnership, whether domestic or foreign; a partnership; a limited partnership; a corporation, including a foreign, domestic, or nonprofit corporation; a trust; or any other business organization.

Subd. 3. **True name.** "True name" means the true full name of the natural person, if a proprietorship; the true full name of each partner, if a partnership; the full corporate name as stated in its articles, if a corporation; the full name of the limited liability company as stated in its articles of organization or certificate of authority; the full name of the limited partnership, if a limited partnership; the full name of the registered limited liability partnership; the true full name of at least one trustee, if a trust; or the true full name of at least one beneficial owner, if any other form of business organization.

Subd. 4. **Address.** "Address" means the full residential address of each natural person, trustee or beneficial owner, limited liability company, whether domestic or foreign, registered limited liability partnership, whether domestic or foreign, or corporation, included in subdivision 3, and the address of the principal place in Minnesota where the business is conducted or transacted.

Subd. 5. **Executed.** "Executed" means signed.

Subd. 6. **Signed.** (a) "Signed" means that the signature of a person has been written on a document, as provided in section 645.44, subdivision 14, and, with respect to a document required by this chapter to be filed with the secretary of state, means that the document has been signed by a person authorized to do so by the organizational documents, bylaws, agreements, or by a resolution approved by the ultimately responsible managing entity for the business organization.

(b) A signature on a document may be a facsimile affixed, engraved, printed, placed, stamped with indelible ink, transmitted by facsimile or electronically, or in any other manner reproduced on the document.

Subd. 7. **Filed with the secretary of state.** "Filed with the secretary of state" means that a document meeting the applicable requirements of this chapter, signed and accompanied by the required filing fee, has been delivered to the secretary of state of this state. The secretary of state shall endorse on the document the word "Filed" and the month, day, and year of filing, record the document in the Office of the Secretary of State, and return a document to the person who delivered it for filing.

**History:** 1978 c 698 s 3; 1982 c 496 s 6,7; 1984 c 618 s 37,38; 1992 c 517 art 1 s 32; 1995 c 128 art 3 s 21; 1997 c 10 art 4 s 19-21

### 333.01 COMMERCIAL ASSUMED NAMES.

Subdivision 1. **Certificate.** No person shall hereafter carry on or conduct or transact a commercial business in this state under any designation, name, or style, which does not set forth the true name of every person interested in such business unless such person shall file in the Office of the Secretary of State, a certificate setting forth the name and business address under which the business is conducted or transacted, or is to be conducted or transacted, and the true name of each person conducting or transacting the same, with the address of such person. The name of the business must not include any of the following phrases or their abbreviations: corporation, incorporated, limited, chartered, professional association, cooperative, limited partnership, limited liability company, professional limited liability company, limited liability partnership, or professional limited liability partnership, except to the extent that an entity filing a certificate would be authorized to use the phrase or abbreviation. The certificate shall be executed by one of the persons conducting, or intending to conduct, the business. The certificate shall be published after it has been filed with the secretary of state in a qualified newspaper in the county in which the person has a principal or registered office for two successive issues.

Subd. 2. **Intentional misrepresentation prohibited.** No person shall use an assumed or fictitious name in the conduct of its business to intentionally misrepresent its geographic origin or location.

**History:** (7346) 1911 c 271 s 1; 1959 c 658 s 1; 1978 c 698 s 2; 1984 c 618 s 39; 1988 c 682 s 43; 1995 c 128 art 3 s 22; 1997 c 222 s 53; 1999 c 133 s 7

### 333.02 FILING OF CERTIFICATE.

Persons conducting or transacting any business under any designation, name, or style referred to in section 333.01 shall, before commencing such business, file such certificate and shall publish the certificate in the manner prescribed in section 333.01.

**History:** (7347) 1911 c 271 s 2; 1959 c 658 s 2; 1984 c 618 s 40

### 333.03 [Repealed, 1978 c 698 s 9]

### 333.035 AMENDMENT OF CERTIFICATE.

Within 60 days after the occurrence of any event which makes any statement in the last previous certificate filed incorrect, an amended certificate shall be filed and the amended certificate shall be published by the person conducting the business in the same manner as

provided by section 333.01. If the amendment is made only to comply with a change in the law that occurred since the previous date of filing, publication is not required.

**History:** 1978 c 698 s 4; 1984 c 618 s 41; 1997 c 137 s 14

### 333.04 SECRETARY OF STATE; DUTIES, FEES.

The secretary of state shall keep an alphabetical list of assumed names filed pursuant to section 333.01 after August 1, 1978, together with trademarks, service marks, certification marks or collective marks filed with the secretary of state and issued pursuant to sections 333.20 and 333.21, and for the indexing and filing of the certificates shall charge the applicant a fee prescribed by section 333.055. A copy of such certificate, duly certified to by the secretary of state, shall be presumptive evidence in all courts of law in this state of the facts therein contained.

**History:** (7349) 1911 c 271 s 4; 1959 c 658 s 4; 1978 c 698 s 5

### 333.05 [Repealed, 1978 c 698 s 9]

### 333.055 TERM OF CERTIFICATE.

Subdivision 1. **Application and renewal.** Filing of a certificate hereunder shall be effective for a term of ten years from the date of filing and upon application filed within the six-month period prior to the expiration of such term or a renewal thereof, on a form prescribed by the secretary of state, the certificate may be renewed for additional ten-year terms. A renewal fee as specified herein, payable to the secretary of state, shall accompany the application for renewal.

The secretary of state shall notify each business holding a certificate hereunder of the necessity of renewal thereof by writing to the last known address of the business at least six months prior to the certificate's expiration date.

Subd. 2. **Existing certificates.** Any assumed name certificate of record in the district courts and in force on July 1, 1978 shall continue in force without the necessity of another filing under section 333.01 until July 31, 1979, at which time all such certificates shall expire unless renewed as hereinafter provided. Any certificate may be renewed by filing an application with the secretary of state on a form prescribed by the secretary and paying the renewal fee prescribed by subdivision 3 within the six month period prior to the expiration of the certificate.

Subd. 3. **Fees.** The secretary of state shall charge and collect:

- (a) For the filing of each certificate or amended certificate of an assumed name – \$25
- (b) Certificate renewal fee – \$25.

Subd. 4. **Secretary of state duties.** The secretary of state shall accept for filing all certificates and renewals thereof which comply with the provisions of sections 333.001 to 333.06 and which are accompanied by the prescribed fees, notwithstanding the fact that the assumed name disclosed therein may not be distinguishable from one or more other assumed names already filed with the secretary of state. The secretary of state shall not accept for filing a certificate that discloses an assumed name that is not distinguishable from a corporate, limited liability company, limited liability partnership, cooperative, or limited partnership name in use or reserved in this state by another or a trade or service mark registered with the secretary of state, unless there is filed with the certificate a written consent, court decree of prior right, or affidavit of nonuser of the kind required by section 302A.115, subdivision 1, clause (d). The secretary of state shall determine whether a name is distinguishable from another name for purposes of this subdivision.

**History:** 1978 c 698 s 6; 1980 c 396 s 1; 1980 c 509 s 129; 1981 c 270 s 137; 1983 c 301 s 190; 1984 c 618 s 42; 1987 c 404 s 173; 1988 c 682 s 44,45; 1989 c 292 s 17; 1989 c 335 art 1 s 210; 1995 c 128 art 3 s 23; 2002 c 311 art 4 s 4

### 333.06 PLEADING FAILURE TO FILE CERTIFICATE; COSTS.

If any person conducting a business contrary to the terms of sections 333.001 to 333.06 shall, prior to the filing of the certificate therein prescribed, commence a civil action, includ-

ing an action to recover possession of real property in any court of this state on account of any contract made by, or transaction had on behalf of the business, the defendant may plead such failure in abatement of the action; and all proceedings had in the action shall thereupon be stayed until the certificate provided for by sections 333.001 to 333.06 is duly filed, and if the defendant prevails in the action, the defendant shall also be entitled to tax \$250 costs, in addition to such other statutory costs as may be allowed by law, and, if the defendant does not prevail in the action, the defendant shall be entitled to deduct \$250 from the judgment otherwise recoverable therein and if a judgment for money is not otherwise recoverable therein, the defendant shall be entitled to tax \$250 costs. If such a person defends against a civil action, the plaintiff shall be entitled to tax \$250 costs, regardless of which party prevails upon the merits.

**History:** (7352) 1911 c 271 s 7; 1959 c 658 s 5; 1978 c 698 s 7; 1984 c 618 s 43; 1986 c 444; 1988 c 682 s 46

### 333.065 PENALTY FOR VIOLATION.

A person who violates any provision of sections 333.01 to 333.06 is subject to the penalties and remedies provided in section 8.31.

The relief provided in this section is in addition to the remedies or penalties otherwise available.

**History:** 1997 c 222 s 54

## INSIGNIA

### 333.07 LODGES, SOCIETIES AND THE LIKE MAY REGISTER.

Any association, lodge, order, fraternal society, beneficial association, or fraternal and beneficial society or association, historical, military, or veterans' organization, labor union, foundation, federation, or any other society, organization, or association, degree, branch, subordinate lodge, or auxiliary thereof, whether incorporated or unincorporated, the principles and activities of which are not repugnant to the Constitution and laws of the United States or this state, may register, in the Office of the Secretary of State, a facsimile, duplicate, or description of its name, badge, motto, button, decoration, charm, emblem, rosette, or other insignia, and may, by reregistration, alter or cancel the same.

**History:** (7352-1) 1933 c 295 s 1

### 333.08 APPLICATION.

Application for such registration, alteration, or cancellation, shall be made by the chief officer or officers of the association, lodge, order, fraternal society, beneficial association, or fraternal and beneficial society or association, historical, military, or veterans' organization, labor union, foundation, federation, or any other society, organization, or association, degree, branch, subordinate lodge, or auxiliary thereof, upon blanks to be provided by the secretary of state; and such registration shall be for the use, benefit, and on behalf of all associations, degrees, branches, subordinate lodges, and auxiliaries of such association, lodge, order, fraternal society, beneficial association, or fraternal and beneficial society or association, historical, military, or veterans' organization, labor union, foundation, federation, or any other society, organization, or association, degree, branch, subordinate lodge, or auxiliary thereof, and the individual members and those thereafter to become members thereof, throughout this state.

**History:** (7352-2) 1933 c 295 s 2

### 333.09 SECRETARY OF STATE TO KEEP RECORD AND INDEX.

The secretary of state shall keep a properly indexed record of the registration provided for by sections 333.07 to 333.12, which record shall also show any altered or canceled registration.

**History:** (7352-3) 1933 c 295 s 3

**333.10 DUPLICATES NOT REGISTERED.**

No registration shall be granted or alteration permitted to any association, lodge, order, fraternal society, beneficial association, or fraternal and beneficial society or association, historical, military, or veterans' organization, labor union, foundation, federation, or any other society, organization, or association, degree, branch, subordinate lodge, or auxiliary thereof, having a name, badge, motto, button, decoration, charm, emblem, rosette, or other insignia, similar to, imitating, or so nearly resembling as to be calculated to deceive, any other name, badge, button, decoration, charm, emblem, rosette, or other insignia, already registered pursuant to the provisions of sections 333.07 to 333.12.

**History:** (7352-4) 1933 c 295 s 4

**333.11 ISSUANCE OF CERTIFICATES.**

Upon granting registration the secretary of state shall issue a certificate to the petitioners, setting forth the fact of such registration.

**History:** (7352-5) 1933 c 295 s 5; 1986 c 444

**333.12 FEES.**

The fees of the secretary of state for registration, alteration, cancellation, searches made, and certificates issued, pursuant to sections 333.07 to 333.11, shall be \$10. The fees so collected shall be paid by the secretary of state into the state treasury.

**History:** (7352-7) 1933 c 295 s 7; 1955 c 820 s 36; 1986 c 444

**333.13 VIOLATIONS; PENALTIES.**

Any person who willfully wears, exhibits, displays, prints or uses, for any purpose, the badge, motto, button, decoration, charm, emblem, rosette, or other insignia of any association or organization mentioned in section 333.07, duly registered, unless entitled to use and wear the same under the constitution and bylaws, rules, and regulations of the association or organization, is guilty of a misdemeanor; and upon conviction shall be punished by a fine of not exceeding \$100 and in default of payment committed to jail for a period of not to exceed 60 days.

**History:** (7351, 7352-6) 1911 c 271 s 6; 1933 c 295 s 6; 1980 c 396 s 2

**333.135 IMPROPER USE OF INSIGNIA.**

Every person who shall willfully wear the insignia or rosette of the Military Order of the Loyal Legion of the United States, or the badge or button of the American Legion, the Veterans of Foreign Wars, the Disabled American Veterans of the World War, or of any other veterans' organization, or any similitude thereof; or who shall willfully wear any badge, emblem, or insignia pertaining to the order of Masons, Odd Fellows, Knights of Pythias, or any other secret order or society, or any similitude thereof; or who shall use any such badge, button, or insignia to obtain aid or assistance, or who shall use the name of any such order or society for gain, unless entitled to so use the same under the constitution, bylaws, rules, and regulations of such order, is guilty of a misdemeanor.

**History:** (10462) RL s 5167; 1921 c 235 s 1; 1927 c 397; 1986 c 444; 1990 c 426 art 1 s 38; 2005 c 10 art 3 s 19

**AQUATENNIAL****333.14 UNAUTHORIZED USE IS A CRIME.**

Any person, firm, copartnership, association, society, or corporation, except as authorized by Minneapolis Aquatennial Association, who shall, with intent to acquire or obtain for personal or business purposes a benefit or advantage, assume, adopt or use in any manner the name and mark "Aquatennial" of the Minneapolis Aquatennial Association or any other

name or mark so nearly resembling the name and mark "Aquatennial" as to be calculated to deceive the public with respect to the corporation, or who, except as authorized by the corporation, shall, with intent to acquire or obtain for personal or business purposes a benefit or advantage, assume, adopt or use in any manner any other name, mark, emblem, insignia or badge, designation, or distinguishing descriptive word or phrase used by the Minneapolis Aquatennial Association in carrying out its purpose or any name, mark, emblem, insignia or badge, designation, or distinguishing descriptive word or phrase confusingly similar thereto, calculated to deceive the public with respect to the corporation, or who, except as authorized by the corporation, shall, with intent to acquire or obtain for personal or business purposes a benefit or advantage, assume, adopt or use the corporate name of the corporation, or a name so nearly resembling it as to be calculated to deceive the public with respect to the corporation, shall be guilty of a misdemeanor.

*History: 1941 c 202 s 1*

### **333.15 THREATENED USE MAY BE RESTRAINED.**

When there shall be an actual or threatened violation of section 333.14, an application may be made to a court or justice having jurisdiction to issue an injunction, upon notice to the defendant of not less than five days, for an injunction to enjoin and restrain the actual or threatened violation; and if it shall appear to the satisfaction of the court or justice that the defendant is in fact so using or threatening to use the name and mark "AQUATENNIAL" or any other name or mark confusingly similar thereto, or any other name, mark, emblem, insignia, or badge, designation, or distinguishing descriptive word or phrase used by the corporation in carrying out its purposes or confusingly similar to any such other name, mark, emblem, insignia or badge, designation, or distinguishing descriptive word or phrase used by the corporation in carrying out its purposes, or the corporate name of the corporation or a confusingly similar name, an injunction may be issued by the court or justice enjoining and restraining such actual or threatened violation without requiring proof that any person has in fact been misled or deceived thereby.

*History: 1941 c 202 s 2*

### **333.16 VESTED RIGHTS NOT AFFECTED.**

The provisions of sections 333.14 and 333.15 shall not be deemed or construed to divest, interfere, affect, or conflict with any established or vested right or prohibit the use thereof.

*History: 1941 c 202 s 3*

## **U.S. GOVERNMENT AND MILITARY NAMES**

### **333.17 FORBIDDEN IN BUSINESS; "MARINE" EXCEPTION.**

No person, firm, corporation or association, selling or offering for sale, any commodity, shall use, or cause, or permit to be used as the name or designation, or as a part of the name or designation, of any business, any of the following words; terms or expressions, viz.: "army," "navy," "marine," "coast guard," "post exchange," "government," "G.I.," "P.X.," or any other word, term, or expression denoting the United States government, or relating to an agency or activity of the United States government, provided however, that any person, firm, corporation or association, engaged in the manufacture or sale of marine equipment, or engaged in the business of marine insurance, may use the word "marine" as a part of its business name.

Any person, firm, corporation, or association, violating the provisions of this section is guilty of a misdemeanor.

*History: 1945 c 212*

## **TRADEMARKS AND SERVICE MARKS**

### **333.18 DEFINITIONS.**

Subdivision 1. **Trademarks and service marks.** (a) The term "trademark" as used in sections 333.18 to 333.31 means any word, name, symbol, or device or any combination

thereof adopted and used by a person to identify goods made or sold by that person and to distinguish them from goods made or sold by others. Trademark includes a mark used on or in connection with the goods of one or more persons other than the owner of the mark to certify regional or other origin, material, mode of manufacture, quality, accuracy, or other characteristics of the goods or that the work or labor on the goods was performed by the members of a union or other organization. The term also includes a mark by members of a cooperative, an association, or other collective group or organization and includes marks used to indicate membership in a union, an association, or other organization.

(b) The term “service mark” as used in sections 333.18 to 333.31 means a word, name, symbol, or device or any combination thereof adopted and used by a person to identify that person’s services and to distinguish them from services of others and includes without limitation the marks, names, symbols, titles, designations, slogans, character names, and distinctive features of radio or other advertising used in commerce. Service mark includes a mark used in connection with the services of one or more persons other than the owner of the mark to certify regional or other origin, material, quality, accuracy, or other characteristics of the service or that the work or labor on the services was performed by members of a union or other organization. The term also includes a mark used by members of a cooperative, an association, or other collective group or organization and includes marks used to indicate membership in a union, an association, or other organization.

(c) The term “certification mark” means a mark used upon or in connection with the products or services of one or more persons other than the owner of the mark to certify regional or other origin, material, mode of manufacture, quality, accuracy or other characteristics of the goods or services or that the work or labor on the goods or services was performed by members of a union or other organization.

(d) The term “collective mark” means a trademark or service mark used by the members of a cooperative, an association or other collective group or organization and includes marks used to indicate membership in a union, an association or other organization.

**Subd. 2. Person.** The term “person” as used in sections 333.18 to 333.31 means any individual, firm, partnership, limited partnership, limited liability partnership, corporation, limited liability company, whether domestic or foreign, association, union or other organization.

**Subd. 3. Applicant.** The term “applicant” as used in sections 333.18 to 333.31 embraces the person filing an application for registration of a mark under sections 333.18 to 333.31, the applicant’s legal representatives, successors or assigns.

**Subd. 4. Registrant.** The term “registrant” as used in sections 333.18 to 333.31 embraces the person to whom the registration of a mark under sections 333.18 to 333.31 is issued, a legal representative, successors or assigns.

**Subd. 5. Used; adopted and used.** (1) For the purposes of sections 333.18 to 333.31, a trademark is “used” in this state when it is placed in any manner on the goods or their containers or on the tags or labels affixed to them or on displays associated with the goods and the goods are sold or otherwise distributed in this state for marketing or other legitimate business purposes.

(2) For the purpose of sections 333.18 to 333.31, a service mark is “adopted and used” when it is adopted and used in connection with the rendering, selling, or advertising of services in this state to identify the services of one person and distinguish them from the services of others, and the services are rendered for marketing or other legitimate business purposes.

**Subd. 6. Abandoned; abandonment.** For purposes of sections 333.18 to 333.31, a trademark or service mark is considered abandoned when either of the following occurs:

(1) when its use has been discontinued with intent not to resume that use. Intent not to resume use may be inferred from circumstances. Nonuse for two consecutive years constitutes prima facie evidence of abandonment; or

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

Subd. 7. **Dilution.** The term “dilution” means the lessening of the capacity of a famous mark to identify and distinguish goods and services, regardless of the presence or absence of:

- (1) competition between the owner of a famous mark and other parties; or
- (2) the likelihood of confusion, mistake, or deception.

Subd. 8. **Generic.** The term “generic” means that the registered mark is no longer considered by the public to identify exclusively the goods or services of the markholder as described in the application for the mark.

**History:** 1959 c 600 s 1; 1986 c 444; 1992 c 517 art 1 s 33; 1998 c 315 s 1

### 333.19 UNREGISTRABLE MATTER; COLLECTIVE AND CERTIFICATION MARKS.

Subdivision 1. **Registration prohibition.** A trademark or service mark by which the goods or services of any applicant for registration may be distinguished from the goods or services of others must 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 of this insignia; or
- (4) consists of or comprises the name, signature or portrait of any living individual, except with written consent; or
- (5) consists of a mark which, (i) when applied to the goods or used to identify the services of the applicant, is merely descriptive or deceptively misdescriptive of them, or (ii) when applied to the goods or used to identify the 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 clause (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 of state may accept as evidence that the mark has become distinctive, as applied to the applicant's goods or used to identify the services, proof of substantially exclusive and continuous use as a mark by the applicant in this state for the five years next preceding the date of the filing of the application for registration; or

(6) consists of or comprises a mark which so resembles a mark registered in this state or a corporate, limited liability company, limited liability partnership, cooperative, or limited partnership name in use or reserved in this state by another, 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 used to identify the services of the applicant, to cause confusion or mistake or to deceive. The secretary of state may require the applicant to obtain affidavits by both the applicant and by the holder of the previously registered name or mark in making this determination.

Subd. 2. **Registration of collective and certification marks.** Subject to the provisions relating to the registration of trademarks and service marks, so far as they are applicable, collective and certification marks, used in this state, shall be registrable under sections 333.18 to 333.31, in the same manner and with the same effect as are trademarks and service marks, by persons, and nations, states, municipalities, and the like, exercising legitimate control over the use of the marks sought to be registered, even though not possessing an industrial or commercial establishment, and when registered they shall be entitled to the protection provided herein in the case of trademarks or service marks, except when used so as to represent falsely that the owner or a user thereof makes or sells the goods or performs the services on or in connection with which such mark is used.

**History:** 1959 c 600 s 2; 1981 c 270 s 138; 1984 c 618 s 44; 1986 c 444; 1998 c 315 s 2; 1999 c 133 s 8



**333.20 APPLICATION.**

Subdivision 1. **Authorization and contents.** Subject to the limitations set forth in sections 333.18 to 333.31, any person who adopts and uses a trademark or a service mark in this state may file in the Office of the Secretary of State, on a form to be furnished by the secretary of state, an application for registration of that mark setting forth the following information:

(1) the name and business address of the person applying for such registration; and, if a business entity, the state of registration;

(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) a description of the mark;

(4) the date when the mark was first used in this state by the applicant or a predecessor in interest; and

(5) the applicant's statement of belief that the applicant is the owner of the mark and that no other person has the right to use such mark in this state either in the identical form thereof or in such near resemblance thereto as might be calculated to deceive or to be mistaken therefor and the mark is in use.

Subd. 2. **Signing and verification.** The application shall be signed as provided in section 645.44, subdivision 14, and verified by the individual applicant or, for business entity applicants, by a person with authority to sign on behalf of the business entity.

Subd. 3. **Specimen or facsimile of mark.** The application shall be accompanied by a single specimen or facsimile of such mark.

Subd. 4. **Filing fee.** The application for registration shall be accompanied by a filing fee of \$50, payable to the secretary of state.

**History:** 1959 c 600 s 3; 1969 c 1148 s 63; 1983 c 301 s 191; 1986 c 444; 1988 c 682 s 47; 1989 c 335 art 1 s 211; 1992 c 517 art 1 s 34; 1993 c 48 s 8; 1993 c 369 s 116; 1998 c 315 s 3,4

**333.21 CERTIFICATE OF REGISTRATION.**

Subdivision 1. **Issuance.** Upon a finding by the secretary of state that the mark and application for registration comply with the requirements of sections 333.18 to 333.31, and that the class indicated, if any, in which the mark is to be registered is not clearly incorrect, the secretary of state 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 of state and the seal of the state, and shall show the registrant's name, the date claimed for the first use of the mark in this state, the class of goods or services, and the registration date.

Subd. 2. **Evidentiary effect.** Any certificate of registration issued by the secretary of state or a copy duly certified by the secretary of state 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 and shall be prima facie evidence of registrant's ownership and exclusive right to use the mark on or in connection with the goods or services described in the certificate.

**History:** 1959 c 600 s 4; 1984 c 618 s 45; 1986 c 444; 1992 c 517 art 1 s 35; 1995 c 128 art 3 s 24; 1998 c 315 s 5

**333.22 TERM OF REGISTRATION.**

Subdivision 1. **Application and renewal.** Registration of a mark hereunder shall be effective for a term of ten years from the date of registration and, upon application filed within six months prior to the expiration of such term or a renewal thereof, on a form to be furnished by the secretary of state, the registration may be renewed for additional ten-year terms provided that the mark is in use by the applicant at the time of the application for renewal and that there are no intervening rights. A renewal fee of \$25 payable to the secretary of state shall accompany the application for renewal of the registration.

Subd. 2. **Renewal notice.** The secretary of state shall notify each registrant of a mark hereunder of the necessity of renewal thereof by writing to the last known address of the registrant approximately six months prior to the registration's expiration date.

Subd. 3. **Existing registrations; terms.** Any registration in force on the date on which Laws 1959, chapter 600 shall become effective, shall expire two years after and may be renewed by filing an application with the secretary of state on a form furnished by the secretary of state and paying the aforementioned renewal fee therefor within six months prior to the expiration of the registration provided the mark is in use at the time of application for renewal and there are no intervening rights.

Subd. 4. **Existing registrations; expiration notice.** The secretary of state shall, within six months after the date on which Laws 1959, chapter 600 shall become effective notify all registrants of trademarks under previous acts of the date of expiration of such registrations, unless renewed in accordance with the provisions of sections 333.18 to 333.31, by writing to the last known address of the registrants.

**History:** 1959 c 600 s 5; 1969 c 1148 s 64; 1986 c 444; 1988 c 682 s 48; 1989 c 335 art 1 s 212; 1993 c 369 s 117

### 333.23 CONVEYANCES OF MARKS; RECORDATION, FEE, NECESSITY.

The secretary of state shall record written conveyances of any mark along with that part of the goodwill of the business in connection with which the mark is used, and of the corresponding application or registration which is presented for recording along with a payment of a fee of \$15 and 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. An assignment of any registration under sections 333.18 to 333.31 shall be void as against any subsequent purchaser for valuable consideration without notice unless it is filed with the secretary of state within three months after the date of the assignment or before the subsequent purchase.

**History:** 1959 c 600 s 6; 1969 c 1148 s 65; 1986 c 444; 1988 c 682 s 49; 1989 c 335 art 1 s 213; 1998 c 315 s 6

### 333.24 SECRETARY OF STATE'S RECORD OF MARKS.

The secretary of state shall keep for public examination a record of all marks filed or renewed under sections 333.18 to 333.31 according to the classification set forth in sections 333.18 to 333.31. The record of registration is constructive notice of registrant's claim of ownership of the mark registered.

**History:** 1959 c 600 s 7; 1998 c 315 s 7

### 333.25 CANCELLATION OF MARKS.

Subdivision 1. **Secretary of state's authority.** The secretary of state shall cancel from the register:

(1) after two years from the effective date of Laws 1959, chapter 600, all registrations under prior acts which are not renewed according to sections 333.18 to 333.31;

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

(3) all registrations filed under sections 333.18 to 333.31 and not renewed according to its provisions;

(4) in compliance with an order of a district court, any registration concerning which the court shall find that:

(i) the registered mark has been abandoned;

(ii) the registrant is not the owner of the mark;

(iii) the registration was filed improperly;

(iv) the registration was obtained fraudulently;

(v) the mark is or has become the generic name for the goods or services, or a portion of the goods or services, for which it has been registered; or

(vi) the registered mark is so similar, as to be likely to cause confusion or mistake or to deceive, to a mark registered by another person previously in this state or in the United States Patent and Trademark Office, before the date of the filing of the application for registration by the registrant under sections 333.18 to 333.31, and not abandoned; provided, however, that should the registrant prove that the registrant is the prior user of the mark or the owner of a concurrent registration of the mark in the United States Patent and Trademark Office covering an area including this state, the registration shall not be canceled; or

(5) a registration when a district court shall order cancellation of the registration on any ground.

Subd. 2. **Exception.** No registration shall be canceled after the mark has had substantially exclusive and continuous use by the registrant for five years following the registration of the mark except for the reasons set forth in subdivision 1, clauses (1), (2), and (3) and clause (4), items (i), (ii), and (iv), or unless a mark has been registered in this state before use of registrant's mark or a mark has been registered in the United States Patent and Trademark Office with the publication date of it before the date of use of registrant's mark, which marks when used on or in connection with the goods or services of the respective registrants would be likely to cause confusion, mistake, or deception, or unless the mark is the common descriptive name of any article, substance, or service.

**History:** 1959 c 600 s 8; 1986 c 444; 1998 c 315 s 8

### 333.26 MUST USE U.S. PATENT AND TRADEMARK OFFICE SYSTEM.

For convenience of administration of sections 333.18 to 333.31, but not to limit or extend the applicant's or registrant's rights, the secretary of state shall adopt the classification system in effect in the United States Patent and Trademark Office, and shall revise this classification system to conform with the United States Patent and Trademark Office system as and if changes are made in that system. A single application for registration of a mark may include any or all goods or services with which the mark is actually being used comprised in a single class, but in no event shall a single application include goods or service with which the mark is being used which fall within different classes.

**History:** 1959 c 600 s 9; 1998 c 315 s 9

### 333.27 IMPROPER REGISTRATION; LIABILITY.

Persons who shall for themselves, or on behalf of any other person, procure the filing or registration of any mark in the Office of the Secretary of State 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 such filing or registration, to be recovered by or on behalf of the party injured thereby in any district court.

**History:** 1959 c 600 s 10; 1986 c 444

### 333.28 IDENTICAL OR SIMILAR MARKS; LIABILITY FOR MISUSE.

Subject to the provisions of section 333.30 any person who shall (a) use without the consent of the registrant any mark on or in connection with rendering of services, selling, offering for sale, or advertising of any goods or services, which mark is identical to or so similar to the registered mark as to be likely to cause confusion or mistake on the part of a purchaser of the goods or services or to deceive such a purchaser as to the source or origin of the goods or services; or (b) 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 of such goods or the sale or rendering of services: shall be liable to a civil action by the owner of such registered mark for any or all of the remedies provided in section 333.29, except that under subsection (b) hereof the registrant shall not be entitled to

recover profits or damages unless the acts have been committed with knowledge that such mark is intended to be used to cause confusion or mistake or to deceive.

**History:** 1959 c 600 s 11

### 333.285 DILUTION OF DISTINCTIVE FAMOUS MARK MAY BE ENJOINED.

(a) The owner of a mark that is famous in this state may, subject to the principles of equity and upon terms the court considers reasonable: seek an injunction against another person's commercial use of a mark or trade name, if the use begins after the mark has become famous and causes dilution of the distinctive quality of the mark; and obtain other relief as provided in this section.

In determining whether a mark is distinctive and famous, a court may consider factors such as, but not limited to:

- (1) the degree of inherent or acquired distinctiveness of the mark in this state;
- (2) the duration and extent of use of the mark in connection with the goods and services with which the mark is used;
- (3) the duration and extent of advertising and publicity of the mark in this state;
- (4) the geographical extent of the trading area in which the mark is used;
- (5) the channels of trade for the goods or services with which the mark is used;
- (6) the degree of recognition of the mark in the trading areas and channels of trade in this state used by the mark's owner and the person against whom the injunction is sought;
- (7) the nature and extent of use of the same or similar mark by third parties; and
- (8) whether the mark is the subject of a state registration in this state, or a federal registration under the Act of March 3, 1881, or under the Act of February 20, 1905, or on the principal register.

(b) In an action brought under this section, the owner of a famous mark is entitled only to injunctive relief in this state, unless the person against whom the injunctive relief is sought willfully intended to trade on the owner's reputation or to cause dilution of the famous mark. If willful intent is proven, the owner is entitled to the remedies in this chapter, subject to the discretion of the court and the principles of equity.

(c) The following are not actionable under this section:

- (1) fair use of a famous mark by another person in comparative commercial advertising or promotion to identify the competing goods or services of the owner of the famous mark;
- (2) noncommercial use of the mark; and
- (3) all forms of news reporting and news commentary.

**History:** 1998 c 315 s 10

### 333.29 REMEDIES.

Subdivision 1. **Injunctive relief; money judgment.** An owner of a mark registered under sections 333.18 to 333.31 may bring an action to enjoin the manufacture, use, display, or sale of any counterfeits or imitations of the mark, and a court of competent jurisdiction may grant injunctions to restrain the manufacture, use, display, or sale as the court considers just and reasonable. The court may require the defendants to pay to the owner either or both of the following: (1) all profits derived from the wrongful manufacture, use, display, or sale; or (2) all damages suffered by reason of the wrongful manufacture, use, display, or sale. The court may also order that counterfeits or imitations in the possession or under the control of a defendant be delivered to an officer of the court, or to the complainant, to be destroyed. The court, in its discretion, may enter judgment for an amount not to exceed three times the profits and damages and reasonable attorneys' fees of the prevailing party if the court finds the other party committed the wrongful acts with knowledge or in bad faith or otherwise as according to the circumstances of the case.

Subd. 2. **Other penal law.** The enumeration of any right or remedy herein shall not affect a registrant's right to prosecute under any penal law of this state.

**History:** 1959 c 600 s 12; 1998 c 315 s 11

**333.30 MARKS ACQUIRED AT COMMON LAW.**

Nothing herein shall adversely affect a person's rights or the enforcement of the rights in a mark acquired in good faith at any time at common law, except that the rights as against the registrant of the same or confusingly similar mark are limited to the areas of the person's use established prior to the registration date and areas in which the person's mark has become known prior to the registration date.

**History:** 1959 c 600 s 13; 1986 c 444

**333.305 FORUM IS DISTRICT COURT; SERVICE ON NONRESIDENT REGISTRANT.**

(a) Actions to require cancellation of a mark registered according to sections 333.18 to 333.31 or in mandamus to compel registration of a mark according to sections 333.18 to 333.31 shall be brought in the district court. In an action in mandamus, the proceeding shall be based solely upon the record before the secretary of state. In an action for cancellation, the secretary of state shall not be made a party to the proceeding but shall be notified of the filing of the complaint by the clerk of the court in which it is filed and shall be given the right to intervene in the action.

(b) In an action brought against a nonresident registrant, service may be effected upon the secretary of state as agent for service of the registrant according to the procedures established for service upon nonresident corporations and business entities under section 5.25.

**History:** 1998 c 315 s 12

**333.31 SERVICE OF PROCESS UPON NONRESIDENT REGISTRANTS.**

Service in duplicate of any paper relating to a nonresident's registration under sections 333.18 to 333.31, on the secretary of state, shall constitute service on said nonresident registrant. The secretary of state shall forward one copy of such paper to said registrant at the registrant's last known address.

**History:** 1959 c 600 s 16; 1986 c 444

**333.40 TRADEMARK; WHEN DEEMED AFFIXED.**

A trademark shall be deemed to be affixed to any goods, wares, merchandise, mixture, preparation, or compound, when it is in any manner placed in or upon either the article itself, or a box, bale, barrel, bottle, case, cask, or other vessel or package, or a cover, wrapper, stopper, brand, label, or other thing in, by, or with which the goods are packed, enclosed, or otherwise prepared for sale or disposition.

**History:** (10345) RL s 5071

**333.41 TRADEMARKS OF WORKERS' UNIONS.**

When any person, or any association or union of workers, shall have adopted or used any label, trademark, term, design, device, or form of advertisement for the purpose of designating, making known, or distinguishing any product of labor as having been made, produced, prepared, packed, or put on sale by such person, association, or union, or by a member thereof, it shall be unlawful to counterfeit or imitate the same, or to use, sell, offer for sale, or in any way utter or circulate, any counterfeit or imitation of any such label, trademark, term, design, device, or form of advertisement.

**History:** (10346) RL s 5072; 1986 c 444

**333.42 COUNTERFEITING OR DEALING IN COUNTERFEITS; HOW PUNISHED.**

Every person who shall counterfeit or imitate any such label, trademark, term, design, device, or form of advertisement, or shall sell, offer for sale, or in any way utter or circulate any counterfeit or imitation thereof; or who shall keep or possess, with intent that the same

shall be sold or disposed of, any product of labor to or upon which any such counterfeit or imitation is attached, affixed, or impressed; or who shall knowingly sell or dispose of any product of labor contained in any box, case, can, or package to or upon which any such counterfeit or imitation is attached, affixed, or impressed; or who shall possess, with intent that the same shall be sold or disposed of, any product of labor in any box, case, can, or package to which or upon which any such counterfeit or imitation is attached, affixed, or impressed, shall be punished by imprisonment in the county jail for not more than three months, or by a fine of not more than \$100.

**History:** (10347) RL s 5073; 1986 c 444

### **333.43 REGISTRATION.**

Every such label, trademark, term, device, design, or form of advertisement may be filed for record in the Office of the Secretary of State on payment of a fee of \$10 each. In so filing the same, two copies, counterparts, or facsimiles thereof, shall be left with such secretary, together with a sworn statement specifying the names of the persons, association, or union in whose behalf the same is filed, the class and description of the goods or products of labor to which it is or is intended to be appropriated, that the party in whose behalf the same is filed has the sole right to its use, and that the counterparts or facsimiles filed are correct. No label, trademark, term, design, device, or form of advertisement shall be so filed or recorded which could reasonably be mistaken for one theretofore filed.

**History:** (10348) RL s 5074; 1955 c 820 s 49

### **333.44 FRAUDULENT REGISTRATION OR USE; PENALTY.**

Persons who shall, for themselves, or on behalf of any other person, association, or union, procure the filing of any label, trademark, term, design, device, or form of advertisement with such secretary under the foregoing provisions by any fraudulent means, and every person who shall use the name or seal of any such person, association, or union, or officer thereof, in or with reference to the sales of goods or products of labor, not being authorized to use the same, shall be guilty of a misdemeanor.

**History:** (10349) RL s 5075; 1986 c 444

### **333.45 ILLEGAL USE OF CERTIFICATE OF REGISTRATION.**

Such secretary shall deliver to the person, association, or union filing any such label, trademark, term, design, device, or form of advertisement such number of certificates of the record thereof as shall be applied for, on payment of a fee of \$2 for each certificate, and such certificates shall in all cases be prima facie evidence of the adoption of such label, trademark, term, design, device, or form of advertisement. Every person who, without authority of the owner thereof, shall use or display the genuine label, trademark, term, design, device, or form of advertisement of any such person, association, or union, shall be guilty of a misdemeanor.

**History:** (10350) RL s 5076; 1955 c 820 s 50

## **PORTORAMA**

### **333.50 UNAUTHORIZED USE IS A CRIME.**

Any person, firm, copartnership, association, society, or corporation, except as authorized by the Duluth Jaycees who shall, with intent to acquire or obtain for personal or business purposes a benefit or advantage, assume, adopt or use in any manner the name and mark "portorama" or any other name or mark so nearly resembling the name and mark "portorama" as to be calculated to deceive the public with respect to the "portorama," or who, except as authorized by the Duluth Jaycees, shall, with intent to acquire or obtain for personal or business purposes a benefit or advantage, assume, adopt or use in any manner any other name, mark, emblem, insignia or badge, designation, or distinguishing descriptive word or

phrase used by the Duluth Jaycees in carrying out its purposes relating to the "portorama" or any name, mark, emblem, insignia or badge, designation, or distinguishing descriptive word or phrase confusingly similar thereto, calculated to deceive the public with respect to the "portorama," or who, except as authorized by the Duluth Jaycees, shall, with intent to acquire or obtain for personal or business purposes a benefit or advantage, assume, adopt or use the name "portorama," or a name so nearly resembling it as to be calculated to deceive the public with respect to the "portorama," shall be guilty of a misdemeanor.

**History:** 1967 c 224 s 1

### **333.51 THREATENED USE MAY BE RESTRAINED.**

When there shall be an actual or threatened violation of section 333.50, an application may be made to a court having jurisdiction to issue an injunction, upon notice to the defendant of not less than five days, for an injunction to enjoin and restrain the actual or threatened violation; and if it shall appear to the satisfaction of the court or justice that the defendant is in fact so using or threatening to use the name and mark "portorama" or any other name or mark confusingly similar thereto, or any other name, mark, emblem, insignia, or badge, designation, or distinguishing descriptive word or phrase used by the Duluth Jaycees in carrying out its purposes relating to the "portorama" or confusingly similar to any other name, mark, emblem, insignia or badge, designation, or distinguishing descriptive word or phrase used by the Duluth Jaycees in carrying out its purposes relating to the "portorama," an injunction may be issued by the court enjoining and restraining the actual or threatened violation without requiring proof that any person has in fact been misled or deceived thereby.

**History:** 1967 c 224 s 2

### **333.52 VESTED RIGHTS NOT AFFECTED.**

The provisions of sections 333.50 and 333.51 shall not be deemed or construed to divest, interfere, affect, or conflict with any established or vested right or prohibit the use thereof.

**History:** 1967 c 224 s 3; 1969 c 6 s 42

## **MINNESOTA ZOOLOGICAL GARDEN**

### **333.53 UNAUTHORIZED USE IS A CRIME.**

Any person, firm, partnership, association, society, or corporation, not authorized by the Minnesota Zoological Board who, with intent to acquire or obtain for personal or business purposes a benefit or advantage, assumes, adopts or uses the name "Minnesota Zoological Garden," the trademark thereof or any other name or mark so nearly resembling the name "Minnesota Zoological Garden" or the trademark thereof as to be calculated to deceive or mislead the public with respect to the Minnesota Zoological Garden, or who, except as authorized by the Minnesota Zoological Board, with intent to acquire or obtain for personal or business purposes a benefit or advantage, assumes, adopts or uses any other name, mark, logo, emblem, insignia or badge, designation, or distinguishing descriptive word or phrase used by the Minnesota Zoological Board in carrying out its purposes relating to the Minnesota Zoological Garden or any name, mark, logo, emblem, insignia or badge, designation, or distinguishing descriptive word or phrase confusingly similar thereto, calculated to deceive or mislead the public with respect to the Minnesota Zoological Garden, shall be guilty of a misdemeanor.

**History:** 1980 c 433 s 2

### **333.54 THREATENED USE MAY BE RESTRAINED.**

When there is an actual or threatened violation of section 333.53, an application may be made to a court having jurisdiction to enjoin and restrain the actual or threatened violation; and if it appears to the satisfaction of the court that the defendant is in fact using or threaten-

# MINNESOTA STATUTES 2006

11545

ASSUMED NAMES, INSIGNIA, AND MARKS

333.54

ing to use the name "Minnesota Zoological Garden" or the trademark thereof or any other name or mark confusingly similar, or any other name, mark, logo, emblem, insignia or badge, designation, or distinguishing descriptive word or phrase used by the Minnesota Zoological Board in carrying out its purposes relating to Minnesota Zoological Garden or confusingly similar to any other name, mark, logo, emblem, insignia or badge, designation, or distinguishing descriptive word or phrase used by the Minnesota Zoological Board in carrying out its purposes relating to the Minnesota Zoological Garden, the court may enjoin and restrain the actual or threatened violation without requiring proof that any person has in fact been misled or deceived thereby.

**History:** 1980 c 433 s 3