WEST VIRGINIA CODE CHAPTER 47 ARTICLE 2

WV Legislature

§47-2-1. Definitions.

As used in this article:

(1) The term “trademark” means any word, name, symbol or device or any combination thereof used by a person to identify and distinguish the goods of such person, including a unique product, from those manufactured and sold by others, and to indicate the source of the goods, even if that source is unknown.

(2) The term “service mark” means any word, name, symbol or device or any combination thereof used by a person to identify and distinguish the services of one person, including a unique service, from the services of others, and to indicate the source of the services, even if that source is unknown. Titles, character names used by a person, and other distinctive features of radio or television programs may be registered as service marks notwithstanding that they, or the programs, may advertise the goods of the sponsor.

(3) The term “mark” includes any trademark or service mark, entitled to registration under this article whether registered or not.

(4) The term “trade name” means any name used by a person to identify a business or vocation of such person.

(5) The term “person” and any other word or term used to designate the applicant or other party entitled to a benefit or privilege or rendered liable under the provisions of this article includes a juristic person as well as a natural person. The term “juristic person” includes a firm, partnership, corporation, union, association or other organization capable of suing and being sued in a court of law.

(6) The term “applicant” embraces the person filing an application for registration of a mark under this article, and the legal representatives, successors or assigns of that person.

(7) The term “registrant” as used herein embraces the person to whom the registration of a mark under this article is issued, and the legal representatives, successors or assigns of that person.

(8) The term “use” means the bona fide use of a mark in the ordinary course of trade, and not made merely to reserve a right in a mark. For the purposes of this article, a mark is considered to be in use: (A) On goods when it is placed in any manner on the goods or other containers or the displays associated therewith or on the tags or labels affixed thereto, or if the nature of the goods makes such placement impracticable, then on documents associated with the goods or their sale, and the goods are sold or transported in commerce in this state; and (B) on services when it is used or displayed in the sale or advertising of services and the services are rendered in this state.

(9) A mark is considered to be “abandoned” when either of the following occurs:

WV Legislature

(A) When its use has been discontinued with intent not to resume that use. Intent not to resume may be inferred from circumstances. Nonuse for two consecutive years shall constitute *prima facie* evidence of abandonment.

(B) 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.

(10) The term "secretary" means the Secretary of State or the designee of the secretary charged with the administration of this article.

(11) The term "dilution" means the lessening of the capacity of registrant's mark to identify and distinguish goods or services, regardless of the presence or absence of: (A) Competition between the parties; or (B) likelihood of confusion, mistake or deception.

(12) "Retail value" means:

(A) For items that bear a counterfeit mark and are components of a finished product, the regular selling price of the finished product in which the component would be utilized.

(B) For items that bear a counterfeit mark other than items described in paragraph (A) of this subdivision and for services that are identified by a counterfeit mark, the regular selling price of the item or service.

(13) "Sign" means the action of affixing a person's signature to any document or record, whether by manual, written or approved electronic means.

(14) "Signature" means any mark, symbol, facsimile or electronic mark or symbol, that depicts a person's name on any document or record, affixed to the document or record by the person with the intent to authenticate, assert, certify or agree to the matters, validity, information or attestation set forth in the document or record.

WV Legislature

§47-2-2. 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;

(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;

(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;

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

(5) Consists of a mark which, (A) when used on or in connection with the goods or services of the applicant, is merely descriptive or deceptively misdescriptive of them, or (B) when used on or in connection with the goods or services of the applicant is primarily geographically descriptive or deceptively misdescriptive of them, or (C) is primarily merely a surname: Provided, That nothing in this subdivision shall prevent the registration of a mark used 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 used on or in connection with the applicant's goods or services, proof of continuous use thereof as a mark by the applicant in this state for the five years before 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 by another and not abandoned, as to be likely, when used on or in connection with the goods or services of the applicant, to cause confusion or mistake or to deceive.

WV Legislature

§47-2-3. Application for registration.

(a) Subject to the limitations set forth in this article, any person who uses a mark may file in the office of the secretary, in a manner complying with the requirements of 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 such registration; and, if a corporation, the state of incorporation, or if a partnership, the state in which the partnership is organized and the names of the general partners, as specified by the secretary;

(2) The goods or services on or in connection with which the mark is used and the mode or manner in which the mark is used on or in connection with such goods or services and the class in which such 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 or a predecessor in interest; and

(4) A statement that the applicant is the owner of the mark, that the mark is in use, and that, to the knowledge of the person verifying the application, no other person has registered, either federally or in this state, or has the right to use such mark either in the identical form thereof or in such near resemblance thereto as to be likely, when applied to the goods or services of such other person, to cause confusion, or to cause mistake, or to deceive.

(b) The secretary may also require a statement as to whether an application to register the mark, or portions or a composite thereof, 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 full particulars with respect thereto including the filing date and serial number of each application, the status thereof and, if any application was finally refused registration or has otherwise not resulted in a registration, the reasons therefor.

(c) The secretary may also require that a drawing of the mark, complying with such requirements as the secretary may specify, accompany the application.

(d) The application shall be signed manually in writing or electronically by the applicant or by a member of the firm or an officer of the corporation or association applying.

(e) The application shall be accompanied by three specimens showing the mark as actually used.

(f) The application shall be accompanied by the application fee payable to the Secretary of State.

WV Legislature

§47-2-4. Filing of applications.

(a) Upon the filing of 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 pertinent information requested by the secretary including a description of a design mark and may make, or authorize the secretary to make, such amendments to the application as may be reasonably requested by the secretary or deemed by applicant to be advisable to respond to any rejection or objection.

(c) The secretary may require the applicant to disclaim an unregisterable component of a mark otherwise registerable, and an applicant may voluntarily disclaim a component of a mark sought 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 be or shall have become distinctive of the applicant's or registrant's goods or services.

(d) Amendments may be made by the secretary upon the application submitted by the applicant upon applicant's agreement, or, the secretary may require that an amended application be filed.

(e) If the applicant is found not to be entitled to registration, the secretary shall advise the applicant thereof and of the reasons therefor. The applicant shall have a reasonable period of time specified by the secretary in which to reply or to amend the application, in which event the application shall then be reexamined. This procedure may be repeated until (1) the secretary finally refuses registration of the mark, or (2) the applicant fails to reply or amend within the specified period, whereupon 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 such registration. Such writ may be granted, but without costs to the secretary, on proof that all the statements in the application are true and that the mark is otherwise entitled to registration. (g) In the instance of applications concurrently being processed by the secretary seeking registration of the same or confusingly similar marks for the same or related goods or services, the secretary shall grant priority to the applications in order of filing. If a prior-filed application is granted a registration, the other application or applications shall then be rejected. Any rejected applicant may bring an action for cancellation of the registration upon grounds of prior or superior rights to the mark, in accordance with the provisions of section nine of this article.

WV Legislature

§47-2-5. Certificate of registration.

(a) 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, or if a partnership, the state in which the partnership is organized and the names of the general partners, as specified by the secretary, 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 or in connection with which the mark is used, a reproduction of the mark, the registration date and the term of the registration.

(b) 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 such mark in any actions or judicial proceedings in any court of this state.

WV Legislature

§47-2-6. Duration and renewal.

(a) A registration of 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, in a manner complying with the requirements of the secretary, the registration may be renewed for a like term from the end of the expiring term. A renewal fee, payable to the secretary, shall accompany the application for renewal of the registration.

(b) A registration may be renewed for successive periods of ten years in like manner.

(c) Any registration in force on the date on which this article becomes effective shall continue in full force and effect for the unexpired term thereof or for a term of five years from the effective date of this section, whichever shall first expire, and may be renewed by filing an application for renewal with the secretary complying with the requirements of the secretary and paying the aforementioned renewal fee therefor within six months prior to the expiration of the registration.

(d) All applications for renewal under this article, whether of registrations made under this article or of registrations effected under any prior article, shall include a verified statement that the mark has been and is still in use and include a specimen showing actual use of the mark on or in connection with the goods or services.

WV Legislature

§47-2-7. Assignments, changes of name and other instruments.

(a) Any mark and its registration hereunder shall be assignable with the good will of the business in which the mark is used, or with that part of the good will 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 the recording fee 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 such 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 the payment of the recording fee. The secretary may issue in the name of the assignee a certificate of registration of an assigned application. The secretary may issue in the name of the assignee, a new certificate or registration for the remainder of the term of the registration or last renewal thereof.

(c) Other instruments which relate to a mark registered or application pending pursuant to this article, such as, by way of example, licenses, security interests or mortgages, may be recorded in the discretion of the secretary, provided that such instrument is 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 referred to in subsections (a), (b) or (c) of this section shall be accepted for recording if it is certified by any of the parties thereto, or their successors, to be a true and correct copy of the original.

WV Legislature

§47-2-8. Records.

The secretary shall keep for public examination a record of all marks registered or renewed under this article, as well as a record of all documents recorded pursuant to section seven of this article.

WV Legislature

§47-2-9. Cancellation.

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

(1) Any registration concerning which the secretary shall receive a voluntary request for cancellation thereof from the registrant or the assignee of record;

(2) All registrations granted under this article and not renewed in accordance with the provisions hereof;

(3) Any registration concerning which a court of competent jurisdiction shall find:

(A) That the registered mark has been abandoned;

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

(F) That 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 in the United States Patent and Trademark Office prior to the date of the filing of the application for registration by the registrant hereunder, and not abandoned: Provided, That, should the registrant prove 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 this state, the registration hereunder shall not be cancelled for such area of the state; or

(4) When a court of competent jurisdiction orders cancellation of a registration on any ground.

WV Legislature

§47-2-10. Classification.

The secretary shall, by legislative rule promulgated in accordance with the provisions of chapter twenty-nine-a of this code, 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 with 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 which fall within multiple classes, the secretary may require payment of a fee for each class. To the extent practical, the classification of goods and services should conform to the classification adopted by the United States Patent and Trademark Office. Until approved by the Legislature, the secretary may effect the purposes of this section by emergency rule.

WV Legislature

§47-2-11. Fraudulent registration.

Any person who shall for himself or herself, 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, orally 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 court of competent jurisdiction.

WV Legislature

§47-2-12. Infringement.

Subject to the provisions of section sixteen of this article, any person who shall:

(1) Use, 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, distribution, 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 connection with the sale or other distribution in this state of such goods or services; then, such person shall be liable in a civil action by the registrant for any and all of the remedies provided in section fourteen of this article, except that under subdivision (b) of said section, the registrant shall not be entitled to recover profits or damages unless the acts have been committed with the intent to cause confusion or mistake or to deceive.

WV Legislature

§47-2-13. Injury to business reputation; dilution.

(a) The owner of a mark which is famous in this state shall be entitled, subject to the principles of equity, to an injunction against another's use of a mark, commencing after the owner's mark becomes famous, which causes dilution of the distinctive quality of the owner's mark, and to obtain such other relief as is provided in this section. In determining whether a mark is 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;

(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 owner's mark is used;

(6) The degree of recognition of the owner's mark in its and in the other's trading areas and channels of trade in this state; and

(7) The nature and extent of use of the same or similar mark by third parties.

(b) The owner shall be entitled only to injunctive relief in this state in an action brought under this section, unless the subsequent user wilfully intended to trade on the owner's reputation or to cause dilution of the owner's mark. If such wilful intent is proven, the owner shall also be entitled to the remedies set forth in this chapter, subject to the discretion of the court and the principles of equity.

WV Legislature

§47-2-14. Remedies.

(a) Any owner of a mark registered under this article may proceed by suit to enjoin the manufacture, use, display or sale of any counterfeits or imitations thereof and any court of competent jurisdiction may grant injunctions to restrain such manufacture, use, display or sale as may be by the said court deemed just and reasonable, and may require the defendants to pay to such owner all profits derived from and/or all damages suffered by reason of such wrongful manufacture, use, display or sale; and such court may also order that any such counterfeits or imitations in the possession or under the control of any defendant in such case be delivered to an officer of the court, or to the complainant, to be destroyed. The court, in its discretion, may enter judgment for an amount not to exceed three times such profits and damages and/or reasonable attorneys' fees of the registrant in such cases where the court finds the other party committed such wrongful acts with knowledge or in bad faith or otherwise as according to the circumstances of the case.

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

WV Legislature

§47-2-14a. Trademark counterfeiting.

(a) A person commits trademark counterfeiting if the person knowingly and with the intent to sell or distribute and without the consent of the registrant or owner uses, displays, advertises, distributes, offers for sale, sells or possesses any item that bears a counterfeit of a mark or any service that is identified by a counterfeit of a mark registered under this chapter, registered under 15 U. S. C. §1052, or under the common law with knowledge that the mark is counterfeit.

(b) For purposes of this section, a mark is counterfeit if:

(1) It is a mark that is identical to or substantially indistinguishable from a registered or common law mark; and

(2) It is used on or in connection with the same type of goods or services for which the genuine mark is registered or otherwise used.

WV Legislature

§47-2-14b. Misdemeanor trademark counterfeiting; penalty.

(a) A person commits the crime of misdemeanor trademark counterfeiting if the person commits trademark counterfeiting as described in section fourteen-a of this article and the total retail value of all of the items bearing the counterfeit mark or services that are identified by the counterfeit mark is less than $1,000.

(b) The penalty for misdemeanor trademark counterfeiting is:

(1) For a first violation, confinement in jail for not more than one year, or a fine not exceeding $2,000, or both a fine and confinement; and

(2) For each subsequent violation, confinement in jail for not more than one year, or a fine not exceeding $5,000, or both a fine and confinement.

(3) If the person convicted under this section is a firm, partnership, corporation, union, association or other organization capable of suing and being sued in a court of law, the maximum fine that may be imposed is $10,000.

WV Legislature

§47-2-14c. Felony trademark counterfeiting; penalty.

(a) A person commits the crime of felony trademark counterfeiting if the person commits trademark counterfeiting as described in section fourteen-a of this article and the total retail value of all of the items bearing the counterfeit mark or services that are identified by the counterfeit mark is $1,000 or greater.

(b) The penalty for felony trademark counterfeiting is:

(1) Confinement in a state correctional facility for no less than one year nor more than five years or a fine not exceeding $10,000, or both a fine and confinement.

(2) If the person convicted under this section is a firm, partnership, corporation, union, association or other organization capable of suing and being sued in a court of law, the maximum fine that may be imposed is $20,000.

WV Legislature

§47-2-14d. Seizure, forfeiture and disposal.

(a) The following are subject to seizure and forfeiture in the same manner as the items referenced in section seven hundred three, article seven, chapter sixty-a of this code:

(1) All raw materials and equipment that are used, or intended for use, in providing, manufacturing and delivering items bearing a counterfeit mark or services identified by a counterfeit mark;

(2) All conveyances, including aircraft, vehicles or vessels, which are used, or are intended for use, to transport items bearing a counterfeit mark, except that:

(A) A conveyance used by any person as a common carrier in the transaction of business as a common carrier shall not be forfeited under this section unless it appears that the person owning the conveyance is a consenting party or privy to a violation of this article;

(B) A conveyance shall not be forfeited under the provisions of this article if the person owning the conveyance establishes that he or she neither knew, nor had reason to know, that the conveyance was being employed or was likely to be employed in a violation of this article; and

(C) A bona fide security interest or other valid lien in any conveyance shall not be forfeited under the provisions of this article, unless the state proves by a preponderance of the evidence that the holder of the security interest or lien either knew, or had reason to know, that the conveyance was being used or was likely to be used in a violation of this article;

(3) All books, records, computers and data that are used or intended for use in the production, manufacture, sale or delivery of items bearing a counterfeit mark or services identified by a counterfeit mark; and

(4) All moneys, negotiable instruments, balances in deposit or other accounts, securities or other things of value furnished or intended to be furnished by any person in the course of activity constituting a violation of sections fourteen-b, fourteen-c and fourteen-d of this article.

(b) Items bearing a counterfeit mark are subject to seizure and disposition as provided in section seven, article one-a, chapter sixty-two of this code. However, if the registrant or owner so requests, the agency holding the seized items shall release the seized items to the registrant or owner or make such other disposition as the registrant or owner directs. If the registrant or owner does not direct disposition of the seized items, the agency shall destroy the items.

WV Legislature

§47-2-15. Forum for actions regarding registration; service on out-of-state registrants.

(a) Actions to require cancellation of a mark registered pursuant to this article or in mandamus to compel registration of a mark pursuant to this article shall be brought in the circuit court of Kanawha County. In an action in mandamus, the proceeding shall be based solely upon the record before the secretary. In an action for cancellation, the secretary 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 any action brought against a nonresident registrant, service may be effected by service upon the registrant in accordance with the provisions of this code and the rules of civil procedure which prescribe the manner in which service upon nonresidents may be obtained.

WV Legislature

§47-2-16. 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.

WV Legislature

§47-2-17. Fees.

(a) The secretary shall charge the following fees for services provided pursuant to the provisions of this article:

(1) For an application fee and for a renewal fee, $50; and

(2) For recording any instrument specified in section seven of this article, $25.

(b) One half of each fee shall be deposited in the state fund, general revenue and one half of the fee shall be deposited in the service fees and collections account established by section two, article one, chapter fifty-nine of this code for the operation of the office of the Secretary of State. Any balance remaining on June 30, 2001, in the existing special revenue account entitled "trademarks" as established by chapter two hundred forty-nine, acts of the Legislature, 1996 regular session, shall be transferred to the service fees and collections account established by section two, article one, chapter fifty-nine of this code for the operation of the office of the Secretary of State. The Secretary of State shall dedicate sufficient resources from that fund or other funds to provide the services required in this article.

WV Legislature

§47-2-18. Severability.

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.

WV Legislature

§47-2-19. Time of taking effect -- repeal of prior articles; intent of article.

(a) This article is effective July 1, 1996, but shall not affect any suit, proceeding or appeal then pending.

(b) The intent 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," as the same has been amended on the effective date of this article. To that end, the construction given the federal act should be examined as persuasive authority for interpreting and construing this article.

WV Legislature