

# A DIGEST OF THE ILLINOIS LAW FOR THE REGISTRATION AND PROTECTION OF TRADEMARKS AND SERVICEMARKS

(765 ILCS 1036)

## REGISTRATION IS PERMISSIBLE AND NOT COMPULSORY

### TRADEMARK MEANS

Any word, name, symbol, or device or any combination thereof used by a person to identify and distinguish the goods of the 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.

### SERVICEMARK 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. Title, character names used by a person, and other distinctive features of radio or television programs may be registered as servicemarks notwithstanding that they, or the programs, may advertise the goods of the sponsor.

### APPLICATION CAN BE MADE BY

Any individual, firm, partnership, limited partnership, limited liability partnership, limited liability company, corporation, association, union or other organization owning the mark.

### TRADEMARK IS USED IN ILLINOIS WHEN

It is placed in any manner on the goods, in or their container, on tags or labels affixed to the goods or containers, or if the nature of the goods makes such placement impracticable, then on documents associated with the goods in the sale or distribution thereof in this State.

### SERVICEMARK IS USED IN ILLINOIS WHEN

It identifies a service, even though the service may be rendered in connection with the sale or distribution of goods of the owner of the mark, if the service identified by the mark is rendered or received in this State.

### TRADEMARK OR SERVICEMARK WILL BE REGISTERED UNLESS IT

- (a) Consists of or comprises immoral, deceptive or scandalous matter; or
- (b) 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
- (c) 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 simulations thereof; or
- (d) Consists of or comprises the name, signature, or portrait of any living individual, except by the individual's written consent; or
- (e) Consists of a mark which (1) when used on or in connection with the goods or services of the applicant, is merely descriptive or deceptively misdescriptive of them, or (2) when used on or in connection with the goods or services of the applicant is primarily geographically descriptive or deceptively misdescriptive of them, or (3) is primarily merely a surname; however, nothing in this subsection (e) 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 5 years before the date on which the claim of distinctiveness is made; or
- (f) 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.

### REGISTRATION IS FOR A FIVE-YEAR PERIOD

(over)

## REQUIREMENTS FOR REGISTRATION

- (1) Mark must be used in Illinois.
- (2) Application on form supplied by the Secretary of State.
- (3) Accompanied by a filing fee of \$10.00, payable to the Secretary of State.
- (4) Accompanied by three specimens showing the mark as actually used.

## REQUIREMENTS FOR RENEWAL OF REGISTRATIONS

- (1) Application for renewal on form supplied by the Secretary of State.
- (2) Affidavit stating that the mark is still in use in this State.
- (3) Accompanied by a filing fee of \$5.00 payable to the Secretary of State.
- (4) Accompanied by 3 specimens showing actual use of the mark on or in connection with the goods or services.

## ASSIGNMENT OF A REGISTRATION

- (1) Shall be on a form furnished by the Secretary of State and shall include the goodwill of the business in which the mark is used, or with the part of the goodwill of the business connected with the use of and symbolized by the mark.
- (2) Assignment may be recorded with the Secretary of State, upon payment of the recording fee of \$5.00, payable to the Secretary of State.
- (3) When the assignment is recorded, a new certificate for the remainder of the term of the registration or of the last renewal thereof shall be issued to the assignee.
- (4) An assignment of any registration under this Act 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.

## NAME AND/OR ADDRESS CHANGE

- (1) Shall be on a form furnished by the Secretary of State.
- (2) Upon payment of a \$5.00 recording fee, any registrant or applicant effecting a change of the name or address of the person to whom the mark was issued or for whom an application was filed may record a certificate of change of name or address of the registrant or applicant with the Secretary.
- (3) The Secretary may issue a new certificate of registration for the remainder of the term or the registration or last renewal thereof.

## GENERAL PROVISIONS

- (1) The Secretary of State shall keep for public examination a record of all marks registered, renewed, assigned, and documents recorded under The Trademark Registration and Protection Act.
- (2) The Secretary of State and Circuit Courts of this State have power to cancel registrations under certain specified conditions.
- (3) Nothing in this Act shall adversely affect the rights or the enforcement of rights in marks acquired in good faith at any time at common law.
- (4) The law provides a penalty for obtaining registration fraudulently and remedy for infringement of a registration.