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CLIENT ALERT

New Massachusetts Trademark Law

Massachusetts amended its trademark law on August 2, 2006 by adopting the Model State Trademark Bill (MSTB). Below is a summary of the most important changes to the law and how such changes might affect your business:

1. Treble damages for Willful Infringement. This is a powerful remedy. It is recommended that you use the Massachusetts system for your marks even if they are eligible for federal registration because this remedy is not available under the federal system.
2. Conformity with federal law and other state laws. The new law in many respects mirrors more closely the federal trademark law, and instructs Massachusetts courts to look at the vast body of federal trademark law to resolve Massachusetts cases. This should help to eliminate some of the interpretation problems some companies have experienced in the state courts. In addition, as 30 states have now adopted this version of the MSTB, and 49 states have adopted some version of the MSTB (Wisconsin is the lone hold-out), there should be greater conformity and predictability for companies operating and enforcing or defending their marks in different states under state trademark rights.
3. Stricter Application and Renewal Requirements.
 - The Secretary of State (SOS) may now require Applicants to disclaim descriptive terms or even forgo state registration entirely for descriptive marks. This is a good incentive to be as creative as possible when inventing trademarks, as not even state registration will be available in most cases for descriptive marks.
 - Applicants will need to submit 3 specimens showing the use of the mark.
 - Applicants must state that to their knowledge no one else has already registered a confusingly similar mark.

- The SOS may, in addition, require applicants to disclose whether the U.S. Patent & Trademark Office has refused registration of the mark and why.
- Registrants must now renew at 5 years instead of 10 and must submit a specimen when renewing. This will help to eliminate inactive marks from the register and ensure that companies may use the state system to enforce only marks actually in use in commerce.

These changes will make it more difficult for companies to apply and be granted a registration, but will help ensure that only distinctive marks actually used in commerce are protected. Again, as this law more closely resembles the federal law, the state trademark system should also become predictable.

Registrants registered before August 2, 2006 will have the previous term of ten years before having to renew. However, upon renewal, all Registrants must comply with the new statement of use and specimen of use requirements. Trademark owners may also continue to rely on their common law trademark rights.

If you have any questions regarding the amended law, please contact Stacey Friends at (617) 570-3578 or sfriends@riw.com.