

New Massachusetts Trademark Law

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In August 2006 The Commonwealth of Massachusetts joined 29 other states when it enacted a version of the Model State Trademark Bill (the “Model Bill”). The new statute, G.L.c. 110H, which replaced the Commonwealth’s current 30-year-old trademark law when it became effective on October 29, 2006, provides a legal framework more consistent with trademark laws in other states and the federal Lanham Act. Some of the most significant changes include the following:

A. The term of registration has been reduced from ten to five years. The shorter term will eliminate a number of “deadwood” registrations from the list, making them available to new users. This is similar to the federal practice of requiring that registrants file an affidavit of continued use between the fifth and sixth anniversaries of registration.

B. State registrations may now be canceled for genericness; that is, a mark that has become a generic term for the product or service for which it is used may be canceled.

C. The Secretary of State may now require an applicant to provide a statement as to whether the applicant has previously sought to register the mark with the U.S. Patent and Trademark Office, and if the application has been refused, to provide the reasons why. This will help the Secretary of State’s office to make a determination whether to reject the application on the grounds of mere descriptiveness; geographical descriptiveness; or likelihood of confusion, mistake or deception. Applicants will also be required to attest that, to the applicant’s knowledge, no other person has registered, either federally or in this state, an identical mark or a mark likely to cause confusion, mistake or deception.

D. State registration owners will now be entitled to seek multiple damages and attorney’s fees for infringement of a registered mark that is committed knowingly or in bad faith.

E. Courts construing the Massachusetts statute may now consider judicial construction of the federal Lanham Act as persuasive authority, to the extent the statutory language is consistent. This will provide Massachusetts courts with a large and well-established body of case law in deciding trademark cases.

F. The new statute provides the Secretary of State’s office with a greater role in the processing and review of trademark applications. New fee structures, forms, rules, regulations and procedures will be posted soon on the Secretary of State’s website,

www.sec.ma.us/cor/coridx.htm. It is expected that trademark applications will now receive a higher degree of substantive review than in the past.

Finally, the new trademark law departs from the Model Bill in that it preserves the long-standing antidilution provisions of the prior Massachusetts statute. Those provisions, which cover “likelihood of injury to business reputation” as well as “dilution of the distinctive quality of a mark,” are broader than the Lanham Act provisions, thus affording additional protection to a state registrant seeking injunctive relief against potential infringers.

The new Massachusetts trademark statute provides businesses in the Commonwealth with a modernized trademark registration system featuring greater predictability and stronger remedies. In particular, local businesses have been given a more attractive alternative for protecting their valuable trademarks and service marks.