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June 18, 1980

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ATTORNEY GENERAL OPINION No. 80- 137

The Honorable Jack H. Brier
Secretary of State
Second Floor, State Capitol
Topeka, Kansas 66612

Re: Trade-marks and Servicemarks--Registration and
Enforcement--Application for Registration

Synopsis: Typewritten or handwritten words do not constitute a facsimile of a servicemark, and the submission of such with the application for registration does not comply with the statutory requirements of K.S.A. 81-113(d).

Material changes of a mark by amendment are not allowed; thus a registrant is not permitted to amend the original mark with a new mark.

The determination of whether a trademark application is sufficient to satisfy the statutory requirements prior to the registration of such mark vests only ministerial powers in the Secretary of State. Cited herein: K.S.A. 81-112, 81-113, 81-114, 81-118, 15 U.S.C.A. 1015 et seq.

* * *

Dear Secretary Brier:

You request our opinion concerning the procedures for the registration of trade-marks and trade-names in Kansas. Three specific questions are asked: (1) Whether typewritten or handwritten words constitute a facsimile of a servicemark under the provisions of K.S.A. 81-113(d); (2) whether the registrant may amend the original mark or must a new mark be filed and the first registration cancelled; and (3) whether the provisions of K.S.A. 81-111 et seq. give the Secretary of State only ministerial powers or do these statutes allow the Secretary to use his discretion and set policy guidelines.

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The registration and enforcement of trade-marks, servicemarks and trade-names is governed by K.S.A. 81-111 et seq. K.S.A. 81-113(d) provides that the application shall be accompanied by a specimen or facsimile of such mark in triplicate. Neither the word "specimen" nor "facsimile" is contained in the definitional section of the statutes. Thus, in an attempt to ascertain the meaning of the terms, our attention is drawn to the Lanham Trade-Mark Act, 15 U.S.C.A. §§1051 et seq., the federal act relating to the registration of trade-marks, and rules and regulations related thereto.

37 C.F.R. §2.56 (1979) provides:

"Specimens. The application must include five specimens of the trademark as actually used on or in connection with the goods in commerce. The specimens shall be duplicates of the actually used labels, tags, or containers, or the displays associated therewith or portions thereof, when made of suitable flat material and of a size not to exceed 8 1/2 inches (21.6 cm.) wide and 13 inches (33.0 cm.) long."

37 C.F.R. §2.57 (1979) provides:

"Facsimiles. When, due to the mode of applying or affixing the trademark to the goods, or to the manner of using the mark on the goods, or to the nature of the mark, specimens as above stated cannot be furnished, five copies of a suitable photograph or other acceptable reproduction, not to exceed 8 1/2 inches (21.6 cm.) wide and 13 inches (33.0 cm.) long, and clearly and legibly showing the mark and all matter used in connection therewith, shall be furnished."

As we view the foregoing, it is obvious that typewritten or handwritten words normally do not constitute a facsimile of a servicemark under the federal regulations, and there is no reason or evidence to suggest the Kansas legislature intended a different meaning in 81-113(d). After all, upon compliance with application requirements, the certificate of registration is to contain a reproduction of the mark (K.S.A. 81-114), and it is difficult, if not impossible, to prepare such registration requirement relying wholly upon handwritten or typewritten words. Such representations would appear inadequate. However, we must observe that, in some cases, a handwritten or typewritten mark might be adequate for a trade or service mark when the visual effect sought by the registrant is that of a handwritten or typewritten word or graphic.

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Your second question concerns amendments of applications. Kansas law does not expressly address the question of amendments to trade-marks or servicemarks, although it permits the filing and cancellation of a mark. We presume the reason you are concerned with the question of amendment is that the cancellation and registration of a new mark may somehow place a registrant at a disadvantage vis-a-vis some other registrant with a mark similar to the proposed amended mark.

Absent a specific fact situation we cannot speculate as to the legal effect of any attempt to amend a servicemark. However, under the federal law, the question of amending a previously registered mark is addressed by the following regulations. 37 C.F.R. §2.71 (1979) provides:

"Amendments to application.

"(a) The application may be amended to correct informalities, or to avoid objections made by the Patent and Trademark Office, or for other reasons arising in the course of examination. No amendments to the dates of use will be permitted unless such changes are supported by affidavit or declaration in accordance with §2.20 by the applicant and by such showing as may be required by the examiner.

"(b) Additions to the specification of goods or services will not be permitted unless the mark was in actual use on all of the goods or services proposed to be added by the amendment at the time the application was filed and unless the amendment is accompanied by additional specimens (or facsimiles) and by a supplemental affidavit or declaration in accordance with §2.20 by the applicant in support thereof.

"(c) Amendment of the verification or declaration will not be permitted. If that filed with the application be faulty or defective, a substitute or supplemental verification or declaration in accordance with §2.20 must be filed."

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37 C.F.R. §2.72 provides:

"§2.72 Amendments to description or drawing.

"Amendments to the description or drawing of the mark may be permitted only if warranted by the specimens (or facsimiles) as originally filed, or supported by additional specimens (or facsimiles) and a supplemental affidavit or declaration in accordance with §2.20 alleging that the mark shown in the amended drawing was in actual use prior to the filing date of the application. Amendments may not be made if the nature of the mark is changed thereby."

Under these federal regulations, an application may be amended to correct informalities, or to avoid objections made by the registrar, or for other reasons arising in the course of examination of the application. However, material changes by amendment are not allowed, and a registrant is not permitted to amend a registered mark with a new mark. As previously noted, Kansas law does not contemplate the right of a registrant to amend a mark and, in fact, provides only for cancellation and registration of the new mark. Thus, Kansas law, so interpreted, would be consistent with the federal framework, and therefore, we find no reason to imply a right to amend a mark absent a specific grant of legislative authority.

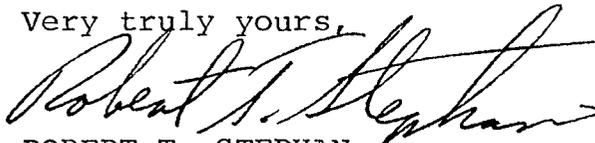
With regard to your final question, generally, the provisions of K.S.A. 81-111 et seq. give the Secretary of State ministerial powers. K.S.A. 81-112 and 81-118 deal with registrability and cancellation, respectively. K.S.A. 81-114 provides the Secretary of State shall cause the certificate of registration to be issued upon compliance by the applicant with the statutory requirements. K.S.A. 81-118 provides for cancellation by the Secretary only in three instances: 1) voluntary request therefor from registrant; 2) no renewal in accordance with statute; 3) pursuant to court order. The Secretary makes an initial decision as to registrability of a mark based upon considerations set out in K.S.A. 81-112. A determination of whether a particular application complies with statutory requirements is a purely ministerial act. Likewise, a cancellation request does not involve the exercise of discretion by the Secretary of State. Thus, the Secretary of State is not authorized by law to exercise discretion with regard to the registration of trade marks, and is limited to determining compliance of applications with the statutory requirements.

Therefore, in summary, it is our opinion that typewritten or handwritten words do not constitute a facsimile of a servicemark,

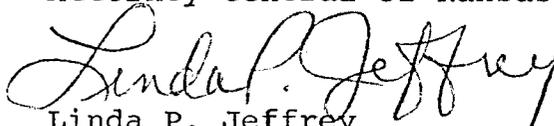
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and the submission of such with the application for registration does not comply with the statutory requirements of K.S.A. 81-113(d). Further, in our judgment material changes by amendment are not allowed; thus, a registrant is not permitted to amend the original mark with a new mark. Finally, we believe that the power to determine whether a trademark application is sufficient to satisfy the statutory requirements, prior to the registration of such mark, is ministerial in nature, vesting no significant discretion in the Secretary of State.

Very truly yours,



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RTS:LPJ:phf