

N.D.A.G. Letter to Meier (March 23, 1987)

March 23 1987

Honorable Ben Meier
Secretary of State
State Capitol
Bismarck, North Dakota 58505

Dear Secretary of State Meier:

Thank you for your letter of February 27, 1987, regarding the procedure that should be followed when the owner of a registered trademark changes its name.

As you state in your letter, Dickinson State College is the owner of a "Business Challenge" registered trademark. Recently, the State Board of Higher Education changed the name of Dickinson State College to State University of North Dakota - Dickinson (SUND - Dickinson). As a result of its name change, SUND - Dickinson wants to file its new name as the current owner of the "Business Challenge" trademark.

N.D.C.C. Ch. 47-22 sets forth the trademark registration provisions. A trademark is defined as any word, name, symbol, or device or any combination thereof adopted and used by an individual or an organization to identify goods made or sold by the individual or organization and to distinguish them from goods made or sold by others. N.D.C.C. § 47-22-01(1). The purpose of a trademark is to point out distinctly the origin or ownership of the article to which it is affixed, to secure to one the fruit of his industry and skill when he has been instrumental in bringing into market a superior article of merchandise, and to prevent fraud and imposition. 74 Am. Jur.2d, Trademarks and Tradenames, §1 (1974).

Under the state trademark registration law, the precise issue that you raise is not addressed. However, the issue of a change in the ownership of a registered trademark is addressed in N.D.C.C. § 47-22-06 which provides, in pertinent part, as follows:

47-22-06. ASSIGNMENT.--Any trademark and its registration hereunder shall be assignable with the good will of the business in which the trademark is used, or with that part of the good will of the business connected with the use of and symbolized by the trademark. Assignment shall be by instruments in writing duly executed and may be recorded with the secretary of state upon the payment of a fee of five dollars payable to the secretary of state 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. . . . [Emphasis supplied.]

An assignment is not required here because there is no change in ownership. But clearly a change in the ownership of a registered trademark may be filed with the Secretary of

State. Upon receipt of the \$5.00 filing fee and proof of change in ownership, the Secretary of State is required to issue a new certificate for the remainder of the 10-year term of the trademark registration.

The primary purpose in interpreting statutes is to ascertain and carry out the legislative intent so expressed. Novak v. Novak, 24 N.W.2d 20 (N.D. 1946). The clear intent of the Legislature is that the name of the current owner of a registered trademark may be filed with the Secretary of State.

Therefore, it is my opinion that when the owner of a registered trademark changes its name, the resulting new name of the trademark owner may be filed with the secretary of State. It is my further opinion that the procedure set forth in N.D.C.C. § 47-22-06 should be followed when filing the name change. However, if the trademark owner's resulting name change affects the contents of the trademark itself, the trademark owner would be required to file a new trademark registration.

Sincerely,

Nicholas J. Spaeth

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