

State of South Dakota

TRADEMARK REGISTRATION HANDBOOK



Courtesy of
Secretary of State

South Dakota Secretary of State
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Trademark Application Instructions

1. Please type or print clearly in black ink.
2. Two samples or facsimiles of the mark, no larger than eight and one-half inches by eleven inches, must accompany Trademark Applications and Renewal Applications. Samples and facsimiles are not required for Assignments.
3. The samples or facsimiles must be identical to number 4 on the application.
4. A single copy of the application should be filed.
5. The classification of goods or services required in item number 7 must be selected from the classifications listed in SDCL 37-6-12 (pages 7 through 10 of this handbook).
6. A single application may specify all goods or services in a single classification for which the Mark is actually being used, but may not specify goods or services in different classifications.
7. The application must be signed by the applicant or by a member of the firm or officer of the corporation or association applying.
8. The signature of the applicant must be notarized. The signature and seal of a Notary must appear on the form.
9. The filing fee must accompany the form. All applications received without the required fee will be returned to the sender requesting the proper fee be submitted. Please make all checks payable to the Secretary of State.
10. Mark Registration is effective for a term of four years from the date of filing, and it is renewable upon application filed within six months prior to expiration.

CHAPTER 37-6

§ 37-6-1. Definition of terms used in counterfeiting provisions.

The following definitions apply to §§ 37-6-2 and 37-6-3:

- (1) "Affixing" within the meaning of such sections is complete, whether such mark is affixed to the goods themselves, or to any box, bale, barrel, bottle, case, cask, wrapper, or other package, or vessel, or any cover or stopper thereof, in which such goods are put up;
- (2) "Goods" includes every kind of goods, wares, merchandise, compound, or preparation which may be lawfully kept or offered for sale;
- (3) "Trade-mark" includes every description of word, letter, device, emblem, stamp, imprint, brand, printed ticket, label, or wrapper, usually affixed by any mechanic, manufacturer, druggist, merchant, or tradesman to denote any goods to be goods imported, manufactured, produced, compounded, or sold by him, other than any name, word, or expression generally denoting any goods to be of some particular class or description.

§ 37-6-2. Forgery or counterfeiting of trade-mark as misdemeanor-Fraudulent use-Sale of goods under counterfeit mark.

Every person who intentionally forges or counterfeits any trade-mark usually fixed by any person to any goods of such person with intent to pass off any goods to which such forged or counterfeited trade-mark is affixed as to the goods of such person; or who, with intent to defraud keeps any dies, plate, or brand, or imitation of the trade-mark of any person for the purpose of counterfeiting the same or selling such trade-mark when counterfeited, or affixing the same to any goods and selling the same as genuine goods of the person entitled to the trade-mark; or who fraudulently uses the genuine trade-mark of another with intent to sell or offer for sale or disposal, any goods as genuine, which are not the original and genuine goods of the person to whom the trade-mark properly belongs; or who sells or keeps for sale any goods upon which any counterfeit trade-mark has been affixed, intended to represent such goods as the genuine goods of another, knowing the trade-mark to be counterfeited, is guilty of a Class 1 misdemeanor.

§ 37-6-3. Imitation of trade-mark as misdemeanor-Civil penalty.

Every person who, with intent to defraud, affixes to any goods, or to any container of goods, any label, stamp, brand, imprint, printed wrapper, ticket, or mark, which designates such goods by any word or token which is wholly or in part the same to the eye or to the ear as the word or any of the words or tokens used by any other person as his trade-mark, and every person who knowingly sells or keeps or offers for sale any such goods or containers with any such label, stamp, brand, imprint, printed wrapper, ticket, or mark affixed to or upon it, in case the person affixing such mark, or so selling, exposing, or offering for sale such goods or containers, was not the first to employ or use such words as his trade-mark, is guilty of a Class 1 misdemeanor, and in addition to the punishment prescribed therefor is liable to the party aggrieved in the penal sum of one hundred dollars for each and every offense, to be recovered by him in a civil action.

§ 37-6-4. Definition of terms used in mark registration law.

Terms used in §§ 37-6-4 to 37-6-27, inclusive, mean:

- (1) "Applicant," embraces the person filing an application for registration of a mark under § 37-6-5, the person's legal representatives, successors, or assigns;
- (2) "Emblem," any badge, motto, button, decoration, charm, rosette, or such other insignia;
- (3) "Mark," includes any trademark or service mark entitled to registration under §§ 37-6-4 to 37-6-27, inclusive, whether registered or not;
- (4) "Person," any individual, firm, partnership, limited liability company, corporation, association, union or other organization;
- (5) "Registrant," the person to whom the registration of a mark under § 37-6-13 is issued, the person's legal representatives, successors, or assigns;
- (6) "Service mark," a mark used in the sale or advertising of services to identify the services of one person and distinguish them from the services of others;
- (7) A service mark is "used" if it is used or displayed in the sale or advertising of services and the services are rendered in this state;
- (8) "Trademark," any word, name, symbol, emblem, or device or any combination thereof adopted and used by a person to identify goods made or sold by such person and to distinguish them from goods made or sold by others;
- (9) For the purposes of §§ 37-6-4 to 37-6-27, inclusive, a trade mark is "used" if it is placed in any manner on the goods or their containers or on the tags or labels affixed thereto and such goods are sold or otherwise distributed in this state.

§ 37-6-5. Application to secretary of state for registration of mark - Contents and signature of application- Facsimile-Filing fee.

Subject to the limitations set forth in §§ 37-6-6 to 37-6-11, inclusive, any person who adopts and uses a mark in this state may file in the Office of the Secretary of State, on a form to be furnished by the secretary of state, an application for registration of that mark setting forth the following information:

- (1) The name and business address of the person applying for the registration; and, if a corporation, the state of incorporation;
- (2) The goods or services in connection with which the mark is used and the mode or manner in which the mark is used in connection with the goods or services and the class in which the goods fall;
- (3) The date when the mark was first used anywhere and the date when it was first used in this state by the applicant or the applicant's predecessor in business; and

- (4) A statement that the applicant is the owner of the mark and that no other person has the right to use the mark in this state either in the identical form thereof or in such near resemblance thereto as might be calculated to deceive or to be mistaken therefore.

The application shall be signed under oath by the applicant or by a member of the firm or an officer of the corporation or association applying. The application shall be accompanied by a specimen or facsimile of the mark in duplicate no larger than eight and one-half inches by eleven inches. The application for registration shall be accompanied by a filing fee of one hundred twenty-five dollars, payable to the secretary of state.

§ 37-6-5.1. Superseded.

§ 37-6-6. Mark containing immoral, deceptive or scandalous matter not registrable.

A mark by which the goods or services of any applicant for registration may be distinguished from the goods or services of others shall not be registered if it consists of or comprises immoral, deceptive, or scandalous matter.

§ 37-6-7. Mark disparaging or suggesting connection with persons, institutions, beliefs or national symbols not registrable.

A mark by which the goods or services of any applicant for registration may be distinguished from the goods of others shall not be registered if it 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.

§ 37-6-8. Mark using or simulating flags or governmental insignia not registrable.

A mark by which the goods or services of any applicant for registration may be distinguished from the goods or services of others shall not be registered if it 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 simulation thereof.

§ 37-6-9. Mark identified with living persons not registrable except by consent.

A mark by which the goods or services of any applicant for registration may be distinguished from the goods or services of others shall not be registered if it consists of or comprises the name, signature or portrait of any living individual, except with his written consent.

§ 37-6-10. Deceptive and merely descriptive marks not registrable-Marks made distinctive by previous use.

A mark by which the goods or services of any applicant for registration may be distinguished from the goods or services of others may not be registered if it consists of a mark which:

- (1) When applied to the goods or services of the applicant, is merely descriptive or deceptively misdescriptive of them; or
- (2) When applied to 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 section prevents the registration of a mark used in this state by the applicant which has become distinctive of the applicant's goods or services. The secretary of state may accept as evidence that the mark has become distinctive, as applied to the applicant's goods or services, proof of continuous use thereof as a mark by the applicant in this state or elsewhere for the five years next preceding the date of the filing of the application for registration.

§ 37-6-11. Mark similar to previously used marks not registrable.

A mark by which the goods or services of any applicant for registration may be distinguished from the goods of others shall not be registered if it consists of or comprises a mark which so resembles a mark registered in this state or a mark or trade name previously used in this state by another and not abandoned, as to be likely, when applied to the goods or services of the applicant, to cause confusion or mistake or to deceive.

§ 37-6-12. Classification of goods and services for mark registration-Registration limited to single class.

The following general classes of goods and services are established for the convenience of the administration of §§ 37-6-4 to 37-6-27, inclusive, but not to limit or extend the applicant's or registrant's rights. A single application for registration of a mark may include any goods or services upon which the mark is actually being used which are comprised in a single class, but a single application may not include goods or services which fall within different classes of goods or services. The classes of goods are as follows:

- (1) Chemical products used in industry, science, photography, agriculture, horticulture, forestry; artificial and synthetic resins; plastics in the form of powders, liquids or pastes, for industrial use; manures (natural and artificial); fire extinguishing compositions; tempering substances and chemical preparations for soldering; chemical substances for preserving foodstuffs; tanning substances; adhesive substances used in industry;
- (2) Paints, varnishes, lacquers; preservatives against rust and against deterioration of wood; colouring matters, dyestuffs; mordants; natural resins; metals in foil and powder form for painters and decorators;
- (3) Bleaching preparations and other substances for laundry use; cleaning, polishing, scouring, and abrasive preparations; soaps; perfumery, essential oils, cosmetics, hair lotions; dentifrices;
- (4) Industrial oils and greases (other than oils and fats and essential oils); lubricants; dust laying and absorbing compositions; fuels (including motor spirit) and illuminants; candles, tapers, night lights, and wicks;
- (5) Pharmaceutical, veterinary, and sanitary substances; infants' and invalids' foods; plasters, material for bandaging; material for stopping teeth, dental wax, disinfectants; preparations for killing weeds and destroying vermin;

- (6) Unwrought and partly wrought common metals and their alloys; anchors, anvils, bells, rolled and cast building materials; rails and other metallic materials for railway tracks; chains (except driving chains for vehicles); cables and wires (nonelectric); locksmith's work; metallic pipes and tubes; safes and cash boxes; steel balls; horseshoes; nails and screws; other goods in nonprecious metal not included in other classes; ores;
- (7) Machines and machine tools; motors (except for land vehicles); machine couplings and belting (except for land vehicles); large size agricultural implements; incubators;
- (8) Hand tools and instruments; cutlery, forks, and spoons; side arms;
- (9) Scientific, nautical, surveying, and electrical apparatus and instruments (including wireless), photographic, cinematographic, optical, weighing, measuring, signaling, checking (supervision), lifesaving, and teaching apparatus and instruments; coin or counterfeit apparatus; talking machines; cash registers; calculating machines; fire extinguishing apparatus;
- (10) Surgical, medical, dental, and veterinary instruments and apparatus (including artificial limbs, eyes, and teeth);
- (11) Installations for lighting, heating, steam generating, cooking, refrigerating, drying, ventilating, water supply, and sanitary purposes;
- (12) Vehicles; apparatus for locomotion by land, air, or water;
- (13) Firearms; ammunition and projectiles; explosive substances; fireworks;
- (14) Precious metals and their alloys and goods in precious metals or coated therewith (except cutlery, forks, and spoons); jewelry, precious stones, horological, and other chronometric instruments;
- (15) Musical instruments (other than talking machines and wireless apparatus);
- (16) Paper and paper articles, cardboard and cardboard articles; printed matter, newspaper and periodicals, books; bookbinding material; photographs; stationery, adhesive materials (stationery); artists' materials; paint brushes; typewriters and office requisites (other than furniture); instructional and teaching material (other than apparatus); playing cards; printers' type and clichés (stereotype);
- (17) Gutta percha, India rubber, balata, and substitutes, articles made from these substances and not included in other classes; plastics in the form of sheets, blocks, and rods, used in manufacture; materials for packing, stopping or insulating; asbestos, mica, and their products; hose pipes (nonmetallic);
- (18) Leather and imitations of leather, and articles made from these materials and not included in other classes; skins, hides; trunks and traveling bags; umbrellas, parasols, and walking sticks; whips, harness, and saddlery;

- (19) Building materials, natural and artificial stone, cement, lime, mortar, plaster, and gravel; pipes of earthenware or cement; roadmaking materials; asphalt, pitch, and bitumen; portable buildings; stone monuments; chimney pots;
- (20) Furniture, mirrors, picture frames; articles (not included in other classes) of wood, cork, reeds, cane, wicker, horn, bone, ivory, whalebone, shell, amber, mother-of-pearl, meerschaum, celluloid, substitutes for all these materials, or of plastics;
- (21) Small domestic utensils and containers (not of precious metals, or coated therewith); combs and sponges; brushes (other than paint brushes); brushmaking materials; instruments and material for cleaning purposes, steel wool; unworked or semi-worked glass (excluding glass used in building); glassware, porcelain and earthenware, not included in other classes;
- (22) Ropes, string, nets, tents, awnings, tarpaulins, sails, sacks; padding and stuffing materials (hair, kapok, feathers, seaweed, etc.); raw fibrous textile materials;
- (23) Yarns, threads;
- (24) Tissues (piece goods); bed and table covers; textile articles not included in other classes;
- (25) Clothing, including boots, shoes, and slippers;
- (26) Lace and embroidery, ribands, and braid; buttons, press buttons, hooks and eyes, pins and needles; artificial flowers;
- (27) Carpets, rugs, mats, and matting; linoleums and other materials for covering existing floors; wall hangings (nontextile);
- (28) Games and playthings; gymnastic and sporting articles (except clothing); ornaments and decorations for Christmas trees;
- (29) Meats, fish, poultry, and game; meat extracts; preserved, dried, and cooked fruits and vegetables; jellies, jams; eggs, milk, and other dairy products; edible oils and fats; preserves, pickles;
- (30) Coffee, tea, cocoa, sugar, rice, tapioca, sago, coffee substitutes; flour and preparations made from cereals; bread, biscuits, cakes, pastry and confectionary, ices; honey, treacle; yeast, baking powder; salt, mustard, pepper, vinegar, sauces, spices; ice;
- (31) Agricultural, horticultural, and forestry products and grains not included in other classes; living animals; fresh fruits and vegetables; seeds; live plants and flowers; food-stuffs for animals, malt;
- (32) Beer, ale, and porter; mineral and aerated waters and other nonalcoholic drinks; syrups and other preparations for making beverages;
- (33) Wines, spirits, and liqueurs; and
- (34) Tobacco, raw or manufactured; smokers' articles; matches;

The classes of services are as follows:

- (35) Advertising and business;
- (36) Insurance and financial;
- (37) Construction and repair;
- (38) Communication;
- (39) Transportation and storage;
- (40) Material treatment;
- (41) Education and entertainment;
- (42) Computer, scientific, and legal;
- (43) Hotels and restaurants;
- (44) Medical, beauty, and agricultural; and
- (45) Personal.

§ 37-6-13. Certificate of registration issued by secretary of state-Contents.

Upon compliance by the applicant with the requirements of §§ 37-6-5 to 37-6-12, inclusive, the secretary of state shall cause a certificate of registration to be issued and delivered to the applicant. The certificate of registration shall be issued under the signature of the secretary of state and the seal of the state, and it shall show the name and business address and, if a corporation, the state of incorporation, of the person claiming ownership of the mark, the date claimed for the first use of the mark anywhere and the date claimed for the first use of the mark in this state, the class of goods and a description of the goods on which or services for which the mark is used, a reproduction of the mark, the registration date and the term of the registration.

§ 37-6-14. Effective period of mark registration-Renewal-Notice before expiration.

Registration of a mark under § 37-6-13 is effective for a term of four years from the date of registration. Upon application filed within six months prior to the expiration of the term, on a form to be furnished by the secretary of state, the registration may be renewed for a like term. A renewal fee of one hundred twenty-five dollars, payable to the secretary of state, shall accompany the application for renewal of the registration. A mark registration may be renewed for successive periods of four years in like manner.

§ 37-6-15. Omitted.

§ 37-6-16. Civil liability for damages from fraudulent mark registration.

Any person who shall for himself, or on behalf of any other person, procure the filing or registration of a mark in the Office of the Secretary of State under the provisions of § 37-6-5 or 37-6-13, by knowingly making any false or fraudulent representation or declaration, verbally or in writing, or by any other fraudulent means, shall be liable to pay all damages sustained in consequence of such filing or registration, to be recovered by or on behalf of the party injured thereby in any court of competent jurisdiction.

§ 37-6-17. Assignment of mark and registration with good will-Recording and new certificate-Fee-Validity of assignment against subsequent purchaser.

A mark and its registration under § 37-6- 13 is assignable with the good will of the business in which the mark is used, or with that part of the good will of the business connected with the use of and symbolized by the mark. 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 one hundred twenty-five dollars payable to the secretary of state. Upon recording of the assignment, the secretary of state 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. An assignment of any registration under § 37-6-13 is void as against any subsequent purchaser for valuable consideration without notice unless it is recorded with the secretary of state within three months after the date thereof or prior to the subsequent purchase.

§ 37-6-18. Cancellation of registration on request.

The secretary of state shall cancel from the register any registration concerning which the secretary of state shall receive a voluntary request for cancellation thereof from the registrant or the assignee of record.

§ 37-6-19. Cancellation of registration on court findings.

The secretary of state shall cancel from the register any registration concerning which a court of competent jurisdiction shall find

- (1) That the registered mark has been abandoned;
- (2) That the registrant is not the owner of the mark;
- (3) That the registration was granted improperly; or
- (4) That the registration was obtained fraudulently.

§ 37-6-20. Cancellation of registration on court order.

The secretary of state shall cancel from the register when a court of competent jurisdiction shall order cancellation of a registration on any ground.

§ 37-6-21. Cancellation of registrations not renewed.

The secretary of state shall cancel from the register all registrations granted under § 37-6-13 and not renewed in accordance with the provisions of § 37-6-14.

§ 37-6-22. Public record of registered marks.

The secretary of state shall keep for public examination a record of all marks registered or renewed under §§ 37-6-13 and 37-6-14.

§ 37-6-23. Omitted

§ 37-6-24. Proceedings to enjoin counterfeits or imitations of registered mark-Circuit court jurisdiction-Damages-Destruction of counterfeits or imitations.

Any owner of a mark registered under § 37-6-13 may proceed by suit to enjoin the manufacture, use, display or sale of any counterfeits or imitations thereof. The circuit court may grant injunctions to restrain such manufacture, use, display or sale as may be by the court deemed just and reasonable, and may require the defendants to pay to such owner all profits derived from and/or all damages suffered by reason of such wrongful manufacture, use, display or sale. The court may also order that any such counterfeits or imitations in the possession or under the control of any defendant in such case, be delivered to an officer of the court, or to the complainant, to be destroyed. The enumeration of any right or remedy in this section shall not affect a registrant's right to prosecute under any penal law of this state.

§ 37-6-25. Civil action against person using counterfeit or imitation of registered mark.

Subject to the provisions of § 37-6-27, any person who shall use, without the consent of the registrant, any reproduction, counterfeit, copy, or colorable imitation of a mark registered under § 37-6-13 in connection with the sale, offering for sale, or advertising of any goods on or in connection with which such use is likely to cause confusion or mistake or to deceive as to the source of origin of such goods, shall be liable to a civil action by the owner of such registered mark for any or all of the remedies provided in § 37-6-24.

§ 37-6-26. Civil action against person counterfeiting or imitating registered mark-Knowledge required to recover profits or damages.

Subject to the provisions of § 37-6-27, any person who shall reproduce, counterfeit, copy, or colorably imitate any mark registered under § 37-6-13 and apply such reproduction, counterfeit, copy, or colorable imitation to labels, signs, prints, packages, wrappers, receptacles, or advertisements intended to be used upon or in conjunction with the sale or other distribution in this state of such goods or services shall be liable to a civil action by the owner of such registered mark for any or all of the remedies provided in § 37-6-24, except that the registrant shall not be entitled to recover profits or damages unless the acts have been committed with knowledge that the mark is intended to be used to cause confusion or mistake or to deceive.

§ 37-6-27. Common-law rights in marks preserved.

Nothing in §§ 37-6-4 to 37-6-26, inclusive, shall adversely affect the right or the enforcement of rights in marks acquired in good faith at any time at common law.

§ 37-6-28. Recording of container markings by register of deeds-Unlawful use of container covered by recording as petty offense.

Each register of deeds shall, on the application of any person domiciled within his county or any corporation organized under the laws of this state engaged in the manufacturing, bottling, or selling of soda water, mineral water, aerated waters, unfermented cider, milk, cream, or other nonintoxicating beverages in casks, kegs, barrels, jugs, bottles, boxes, or other containers, record in a book suitable for the purpose a description of the names, brands, or trade-marks used by such person or corporation for marking any container in which any such beverages are sold or kept for sale, which book shall be and remain a public record in his office. It shall thereupon be a petty offense for any person, without the written consent of the owner, to fill any such container for the purpose of sale, or to sell, dispose of, buy, or traffic in, or destroy the same, whether filled or not.

§ 37-6-29. Use or possession of marked and registered container prima facie unlawful-Search warrant.

The use by any person other than the rightful owner, without such owner's consent, of any container, or the possession thereof by any junk dealer or dealer in any such container, the same being marked or stamped and registered as required in § 37-6-28, shall be prima facie evidence that such use, sale, or possession is unlawful, and a search warrant may be procured for the discovery and seizure thereof.

§ 37-6-30. Obliteration of registered container mark as misdemeanor.

Any person who intentionally obliterates, injures or destroys the names, marks, or brands affixed to any cask, keg, barrel, jug, bottle, box, or other container used or intended to be used for the purpose specified in § 37-6-28, and not his property, is guilty of a Class 2 misdemeanor.

§ 37-6-31. Nonresidents entitled to protection of containers.

Any person residing out of the state, or any corporation organized under the laws of any other state or territory, engaged in the business mentioned in § 37-6-28, shall be entitled to the privilege and protection of §§ 37-6-28 to 37-6-30, inclusive, if he or it shall cause the record to be made, as provided in § 37-6-28, in the office of the register of deeds of the county or counties where he, or it, or his, or its duly authorized agents have their place of business within this state.

§ 37-6-32. Civil penalty for unauthorized refilling or trafficking in registered containers.

Whenever any person engaged in manufacturing, bottling, or selling in bottle, soda, mineral water, cider, or other nonalcoholic beverage, has filed and published in the manner authorized by law, a description of a name, mark, or label usually stamped by him on the bottles containing such beverage, every other person who without the written consent of such manufacturer or dealer refills with any beverage, whether genuine or otherwise, with the intent to sell the same, any bottles stamped with such name, mark, or label, and every person who sells, disposes of, purchases, or traffics in such bottles; or who keeps any such bottles with intent so to refill or use or sell them, without written consent of the manufacturer so to do, is liable to a penalty of fifty cents for each and every bottle so kept, filled, sold, bought, disposed of, or trafficked in, for the first offense, and five dollars on each bottle for every subsequent offense.

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