

## Trademark Laws: Maryland

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A Q&A guide to Maryland laws protecting trademarks. This Q&A addresses state laws governing trademark registration, infringement, dilution, counterfeiting, unfair competition, and deceptive trade practices. Answers to questions can be compared across a number of jurisdictions (see Trademark Laws: State Q&A Tool).

### State Trademark Registration Statute

#### 1. Does your state have a state trademark registration statute? If so, please:

- Identify the statute.
- Identify the state agency responsible for administering trademark applications and registrations.
- Describe the key substantive state trademark registration requirements.
- Describe the key benefits of state registration.

Maryland has a trademark registration statute that is substantially consistent with the registration provisions of the Lanham Act. The law is codified in Title 1, Subtitle 4 (Trademarks, Service Marks, and Trade Names) of the Business Regulation Article of the Maryland Code (Md. Code Ann., Bus. Reg. §§ 1-401 to 1-415).

#### State Agency

The [Maryland secretary of state](#) administers Maryland trademark regulations. It provides trademark and service mark registration forms and other information on its [website](#).

### Key Substantive Registration Requirements

#### Types of Marks Covered

The Maryland registration statute provides for registration of both:

- Trademarks.
- Service marks.

(Md. Code Ann., Bus. Reg. § 1-401(c).)

Trade names may be registered only if they are also trademarks or service marks (Md. Code Ann., Bus. Reg. § 1-404(d)).

#### Use Requirements and Intent-to-Use Applications

The Maryland registration statute:

- Provides that a mark must be in use in Maryland to be eligible for registration.
- Does not authorize intent-to-use applications.

(Md. Code Ann., Bus. Reg. § 1-404.)

#### Statutory Bars to Registration

The Maryland registration statute sets out substantially the same statutory bars to registration as those set out in Section 2 of the Lanham Act (Md. Code Ann., Bus. Reg. § 1-404(b), (c); 15 U.S.C. § 1052). For a discussion of

the Lanham Act statutory bars to registration, including provisions the US Supreme Court recently struck down as unconstitutional, see [Practice Note, Acquiring Trademark Rights and Registrations: Immoral, Scandalous, and Other Restricted Matter](#).

### Other Key Substantive Registration Requirements

To register a mark in Maryland, the applicant must complete and submit the [application form](#), including:

- The applicant's:
  - name; and
  - business address.
- If the applicant is a corporation, limited liability company, or partnership, the state of formation.
- A description of the full mark including words, if applicable.
- A description of the goods or services with which the applicant uses the mark.
- A listing of the ways the mark is being used, including on uniforms, advertising, banners, the internet, signs, vehicles, and packaging.
- Identification of the goods or service class (Md. Code Ann., Bus. Reg. § 1-405).
- The dates when the applicant or applicant's predecessor first used the mark:
  - anywhere; and
  - in Maryland.
- A statement that:
  - the applicant owns the mark;
  - no other person has the right to use the mark in Maryland; and
  - the mark is not deceptively similar to any other mark rightfully used in Maryland.
- Three specimens showing use of the mark. The specimens must not include a business paper, for example, letterhead, a business card, or business envelope.
- The applicant's signature under oath.
- A \$50 fee.

(Md. Code Ann., Bus. Reg. § 1-406.)

The Maryland secretary of state must include a full description of the mark on a certificate of registration (Md. Code Ann., Bus. Reg. § 1-409).

## Key Benefits of State Registration

### Procedural

The Maryland registration statute does not provide any evidentiary presumptions or other procedural benefits to the registrant in litigation.

### Substantive

The Maryland trademark registration statute authorizes the court to award a registrant:

- Injunctive relief.
- Profits or damages.
- Destruction of counterfeits and imitations in a defendant's possession or control.

(Md. Code Ann., Bus. Reg. § 1-414; see Question 4: Remedies.)

### 2. Indicate the term of a state trademark registration and the key registration renewal requirements.

## Registration Term

A trademark registered under the Maryland trademark registration statute:

- Has a term of ten years from the date of the registration.
- May be renewed for additional ten-year periods if the law's procedural and statutory renewal requirements are met (see Renewal Requirements).

(Md. Code Ann., Bus. Reg. § 1-410(a).)

## Renewal Requirements

A Maryland trademark registrant may renew a registration by filing a [renewal application](#) with the [Maryland secretary of state](#) within the six month period before the registration expires. The renewal application must include:

- A \$50 renewal fee.
- A statement that the mark is still in use in Maryland.
- Three different specimens or reproductions of the mark being used. The specimens must not include a business paper, for example, letterhead, a business card, or business envelope.

(Md. Code Ann., Bus. Reg. § 1-410(c), (e).)

### 3. Describe the key requirements for assignment of state trademark applications and registrations.

Maryland allows the assignment of state trademarks if the assignment includes either:

- The goodwill of the business using the mark.
- The part of the goodwill of the business connected with the use of and symbolized by the mark.

(Md. Code Ann., Bus. Reg. § 1-411(a).)

A trademark owner may record the assignment of the trademark by:

- Filing an [assignment form](#) with the Maryland secretary of state.
- Paying a recording fee (currently \$10).

(Md. Code Ann., Bus. Reg. § 1-411(c).)

The assignment form must:

- Include the name, address, and state of incorporation if applicable for the assignor and assignee.
- Be signed by the assignor.
- Indicate the mark to be assigned, including its Maryland registration number.
- Include a statement that the registration is being assigned with the good will of the business connected with its use or with that part of the goodwill of the business connected with the use of and symbolized by the mark.

(Md. Code Ann., Bus. Reg. § 1-411(b); see [Maryland Secretary of State: Trademark or Service Mark Assignment Form](#).)

On receipt of the assignment form, the secretary of state issues a new certificate of registration that is valid for the rest of the mark's term of registration (Md. Code Ann., Bus. Reg. § 1-411(d), (e)).

An assignment of the registration is void against a later purchaser for value without notice of the assignment unless the assignment is recorded with the secretary of state either:

- Within three months after the date of assignment.
- Before that purchase.

(Md. Code Ann., Bus. Reg. § 1-411(f).)

## State Statutory and Common Law Trademark Infringement Causes of Action

### 4. Does your state have a statute that provides a trademark infringement cause of action? If so, describe:

- The elements of the cause of action.
- The available remedies.
- Any statutory defenses or exemptions.

Maryland's trademark registration statute provides a cause of action for infringement of state-registered trademarks (Md. Code Ann., Bus. Reg. § 1-414).

### Elements of the Cause of Action

Maryland law provides state trademark registrants with an infringement cause of action against any person who, without the registrant's consent, either:

- Uses a reproduction or colorable imitation of the registered mark in connection with the sale, offering for sale, or advertising of goods or services in a manner that is likely to confuse or deceive about the origin of the goods or services.
- Applies a reproduction or colorable imitation of a registered mark to an advertisement, label, package, print, receptacle, sign, or wrapper that is intended to be used in connection with:
  - goods or services; or
  - sale or other distribution of goods or services in Maryland.

(Md. Code Ann., Bus. Reg. § 1-414(a).)

### Remedies

The following remedies are available for infringement of a mark registered in Maryland:

- Damages and disgorgement of profits where the infringing acts are committed with the intent to cause confusion or to deceive (Md. Code Ann., Bus. Reg. § 1-414(b)(2), (d)(2)).
- Injunctive relief (Md. Code Ann., Bus. Reg. § 1-414(c), (d)(1)).
- Destruction of infringing products (Md. Code Ann., Bus. Reg. § 1-414(d)(3)).

### Statutory Defenses or Exemptions

Maryland law does not provide any specific defenses or exemptions to infringement claims.

#### 5. Does your state recognize a claim for common law trademark infringement? If so, describe:

- The elements of the cause of action.
- Any significant differences between the state common law claim and a claim for infringement of an unregistered mark under Section 43(a) of the Lanham Act.

Maryland recognizes a cause of action for common law trademark infringement (see *Sea Watch Stores LLC v. Council of Unit Owners of Sea Watch Condo.*, 691 A.2d 750, 769-70 (Md. Ct. Spec. App. 1997)).

### Elements of a Cause of Action

To prevail on a common law trademark infringement claim a plaintiff must show:

- It has a valid and legally protectable mark.
- The defendant's use of a similar mark creates a likelihood of confusion.

(See *Sea Watch Stores*, 691 A.2d at 771-72.)

### Key Lanham Act Distinctions

The standards governing common law trademark infringement under Maryland law are substantially the same as those under the federal Lanham Act.

## State Anti-Dilution Law

#### 6. Does your state have an anti-dilution statute or recognize a dilution cause of action under common law? If so, please describe for any statute or common law claim:

- Whether it protects both registered and unregistered marks.
- The nature of dilution protected against, including whether the law protects against any dilution by blurring or dilution by tarnishment.
- Whether distinctiveness, strength, or fame of the trademark is required for a mark to be protected in your jurisdiction.

Maryland does not recognize a statutory or common law dilution cause of action.

#### 7. For the anti-dilution law listed in Question 6, please list the elements of a cause of action, including whether a claim requires any of:

- Actual or likelihood of dilution.
- Likelihood of confusion.
- Competition between the parties.

Maryland does not recognize a statutory or common law dilution cause of action.

#### 8. For the anti-dilution law listed in Question 6, please describe any tests set out in the statute or applied by courts to assess likely or actual dilution.

Maryland does not recognize a statutory or common law dilution cause of action.

#### 9. For the anti-dilution law listed in Question 6, please describe any available remedies for violations.

Maryland does not recognize a statutory or common law dilution cause of action.

#### 10. For the anti-dilution law listed in Question 6, what statutory exemptions or defenses are available to defend against these claims?

Maryland does not recognize a statutory or common law dilution cause of action.

#### 11. For the anti-dilution law in Question 6, please describe any significant distinctions between the applicable state law and the federal Trademark Dilution Revision Act, including differences in the available remedies.

Maryland does not recognize a statutory or common law dilution cause of action.

### Anti-Counterfeiting Statute

**12. Does your state have a civil anti-counterfeiting statute with a private right of action? If so, please identify the statute and describe:**

- Standing requirements.
- Available remedies.
- Any statutory exemptions or defenses.

Maryland does not have a civil anti-counterfeiting statute with a private right of action. Maryland has a criminal statute that makes trademark counterfeiting either a felony or a misdemeanor (Md. Code Ann., Crim. Law § 8-611; see Question 19).

### State Unfair Competition and Deceptive Trade Practices Statutes

**13. Does your state have any unfair competition or deceptive trade practices statutes with a private right of action? If so, please identify the statute(s) and describe for each:**

- The types of acts or practices it prohibits.
- The standing requirements for a private action.
- The remedies available for violations.
- Any statutory exemptions or defenses to private claims.

### Maryland Consumer Protection Act: Md. Code Ann., Com. Law §§ 13-301 to 13-320

#### Prohibited Conduct

Under the Maryland Consumer Protection Act (MCPA), a person may not engage in any unfair, abusive, or deceptive trade practice in:

- The sale, lease, rental, loan, or bailment of any consumer goods, consumer realty, or consumer services.
- The offer for sale, lease, rental, loan, or bailment of consumer goods, consumer realty, or consumer services.
- The offer for sale of course credit or other educational services.

- The extension of consumer credit.
- The collection of consumer debts.
- The purchase or offer for purchase of consumer goods or consumer realty from a consumer by a merchant whose business includes paying off consumer debt in connection with the purchase of any consumer goods or consumer realty from a consumer.

(Md. Code Ann., Com. Law § 13-303.)

“Consumer goods” and “consumer services” are those that are “primarily for personal, household, family, or agricultural purposes” (Md. Code Ann., Com. Law § 13-101(d)(1)).

Unfair, abusive, or deceptive trade practices include, but are not limited to, any:

- False, falsely disparaging, or misleading oral or written statement, visual description, or other representation of any kind that has the capacity, tendency, or effect of deceiving or misleading consumers.
- Representation that:
  - consumer goods, realty, or services have a sponsorship, approval, accessory, characteristic, ingredient, use, benefit, or quantity that they do not have;
  - a merchant has a sponsorship, approval, status, affiliation, or connection that the merchant does not have;
  - deteriorated, altered, reconditioned, reclaimed, or secondhand consumer goods are original or new; or
  - consumer goods, realty, or services are of a particular standard, quality, grade, style, or model that they are not.
- Failure to state a material fact if the failure deceives or tends to deceive.
- Deception, fraud, false pretense, false premise, misrepresentation, or knowing concealment, suppression, or omission of any material fact with the intent that a consumer rely on it in connection with:
  - the promotion or sale of any consumer goods, realty, or service;
  - a contract or other agreement for the evaluation, perfection, marketing, brokering, or promotion of an invention; or
  - the later performance of a merchant regarding an agreement of sale, lease, or rental.

(Md. Code Ann., Com. Law § 13-301.)

### Standing Requirements for a Private Action

Any person injured by the prohibited conduct has a private right of action (Md. Code Ann., Com. Law § 13-408(a)).

“Person” is defined broadly and includes:

- Individuals.
- Corporations.
- Business trusts.
- Statutory trusts.
- Estates.
- Trusts.
- Partnerships.
- Associations.
- Two or more persons having a joint or common interest.
- Any other legal or commercial entity.

(Md. Code Ann., Com. Law § 13-101(h).)

Despite the MCPA’s broad definition of “person,” courts have interpreted the statute to protect only actual consumers, and not persons merely challenging the business practices of their competitors (see *Penn-Plax, Inc. v. L. Schultz, Inc.*, 988 F. Supp. 906, 909-11 (D. Md. 1997) (interpreting Maryland law)).

A “consumer” is defined as an actual or prospective purchaser, lessee, or recipient of consumer goods, consumer services, consumer realty, or consumer credit (Md. Code Ann., Com. Law § 13-101(c)(1)).

### Remedies

Successful plaintiffs may be awarded:

- Damages.
- Reasonable attorneys’ fees.

(Md. Code Ann., Com. Law § 13-408(a), (b).)

### Statutory Exemptions or Defenses to Private Claims

The MCPA does not apply to:

- Certain professional services providers.
- A public service company regulated by the Public Service Commission.

- A television or radio broadcasting station or a publisher or printer, regarding advertising the sale of the goods or services of another entity, absent knowledge by the broadcaster, publisher, or printer of a violation of the Act.

(Md. Code Ann., Com. Law § 13-104.)

### 14. For each statute listed in Question 13, please describe the elements of a cause of action.

#### Maryland Consumer Protection Act: Md. Code Ann., Com. Law §§ 13-301 to 13-320

To prove unfair or deceptive practices under the Maryland Consumer Protection Act, a consumer bringing a private action must show:

- An unfair or deceptive practice or misrepresentation.
- Plaintiff’s actual reliance on the practice or misrepresentation.
- Actual injury resulting from reliance on the practice or misrepresentation.

(*Stewart v. Bierman*, 859 F. Supp. 2d 754, 768-69 (D. Md. 2012) (interpreting Maryland law).)

### 15. For each statute listed in Question 13, please describe the statute’s applicability to trademark infringement and dilution claims.

#### Maryland Consumer Protection Act: Md. Code Ann., Com. Law §§ 13-301 to 13-320

The Maryland Consumer Protection Act (MCPA) only provides a cause of action for consumers, not for competitors. The US District Court for the District of Maryland, interpreting Maryland law, held that a business cannot maintain trademark infringement claims under the MCPA. (*Pasternak & Fidis, P.C. v. Recall Total Info. Mgmt., Inc.*, 95 F. Supp. 3d 886, 907 (D. Md. 2015).)

Maryland does not recognize a statutory or common law dilution cause of action.

### 16. Please identify the principal common law unfair competition causes of action in your state that are available to trademark owners and for each cause of action describe:

- The elements of the cause of action.
- Any significant distinctions between claims under state common law and claims under the Section 43(a) of the Lanham Act.

Maryland courts recognize two main types of common law unfair competition applicable to trademarks:

- **Confusion.** Confusion occurs when:
  - one party uses a trade name identical or so similar to the name of a previously established business; and
  - “the similarity is such as would be likely to mislead purchasers of ordinary prudence and caution into the belief that the goods are those of the business rival.”(*Edmondson Vill. Theatre v. Einbinder*, 116 A.2d 377, 380-81 (Md. 1955).)
- **Misappropriation.** Misappropriation involves unfair trade practices where a party appropriates the time, labor, and money of another, but does not require consumer confusion (*GAI Audio of N.Y., Inc. v. Columbia Broad. Sys., Inc.*, 340 A.2d 736, 747 (Md. Ct. Spec. App. 1975)).

### Elements of a Common Law Unfair Competition Cause of Action

#### Confusion

Although many claims for unfair competition involve a deceptive act, most Maryland courts do not construe the tort so narrowly. Instead, to state a claim for unfair competition the plaintiff must show that the defendant damaged or jeopardized another’s business by unfair methods of any sort. (*Paccar Inc. v. Elliot Wilson Capitol Trucks LLC*, 905 F. Supp. 2d 675, 691 (D. Md. 2012) (interpreting Maryland law).)

The most common type of unfair competition claim is one based on a deceptive act. For this claim, a plaintiff must show that:

- Either:
  - the defendant committed deceptive acts by holding out goods of one dealer as goods of another; or

- the mark has acquired distinctiveness.

- The defendant later received a profit that it would not have received but for the deception.

(*Ledo Pizza Sys., Inc. v. Singh*, 2014 WL 3810524, at \*6 (D. Md. July 31, 2014) (citing *Edmondson Vill. Theatre*, 116 A.2d at 381 and *Mascaro v. Snelling & Snelling of Balt., Inc.*, 243 A.2d 1, 10-11 (Md. 1968)).)

#### Misappropriation

To prevail on a common law unfair competition claim based on misappropriation, a plaintiff must show:

- Time, labor, and money spent by the plaintiff in the creation of the thing misappropriated.
- A competitive relationship between the plaintiff and the defendant.
- Commercial damage to the plaintiff.

(*GAI Audio*, 340 A.2d at 747.)

#### Key Lanham Act Distinctions

Unlike the Lanham Act, a successful claim for unfair competition under Maryland common law does not require confusion based on the use of another’s mark. The United States District Court for the District of Maryland, analyzing Maryland law, acknowledged that a claim can be based on a substantial interference with the ability of others to compete on the merits of their products or actions that otherwise conflict with accepted principles of public policy recognized by statute or common law (*Paccar*, 905 F. Supp. 2d at 692-93 (D. Md. 2012) (citing Restatement (Third) of Unfair Competition § 1 (1995))).

### Other Significant State Statutory and Common Law Trademark-Related Claims

17. Please describe any significant statutory or common law causes of action in your state available to trademark owners that are not already described in the preceding questions (for example, false advertising and trade libel).

### Slender of Title

Maryland recognizes the common law cause of action for slander of title (*Beane v. McMullen*, 291 A.2d 37, 48-49 (Md. 1972)).

To state a claim for slander of title, a plaintiff must show:

- A false statement that is derogatory to the plaintiff's title to its property, the title's quality, or to the plaintiff's business in general.
- The false statement was communicated to someone else.
- Malice.
- Special damages.

(*Rounds v. Md.-Nat'l Capital Park & Planning Comm'n*, 109 A.3d 639, 663 (Md. 2015), reconsideration denied (Mar. 27, 2015); *Beane*, 291 A.2d at 49.)

### Unjust Enrichment

To prevail on a common law unjust enrichment claim, a plaintiff must show:

- It conferred a benefit on the defendant.
- The defendant appreciated or knew of the benefit.
- The defendant accepted the benefit under circumstances where it would be inequitable for the defendant to retain the benefit without payment.

(*Mass Transit Admin. v. Granite Constr. Co.*, 471 A.2d 1121, 1125 (Md. Ct. Spec. App. 1984).)

**18. For each statute or common law claim identified in Questions 4, 5, 6, 12, and 13, identify any applicable statute of limitations and how it is calculated.**

### Statutory and Common Law Trademark Infringement

There are no specific statutes of limitations for Maryland statutory and common law infringement claims. However, state courts in Maryland may apply laches against claims for damages in trademark infringement actions where there is inexcusable and unreasonable delay that

prejudices the defendant (*Mid S. Bldg. Supply of Md., Inc. v. Guardian Door & Window, Inc.*, 847 A.2d 463, 485 (Md. Ct. Spec. App. 2004)).

### Dilution

Maryland does not recognize a statutory or common law dilution cause of action.

### Counterfeiting

Maryland does not have a civil anti-counterfeiting statute.

### Unfair Competition and Deceptive Trade Practices

Claims based on the Maryland Consumer Protection Act are subject to a three-year limitations period (*Walton v. Network Sols.*, 110 A.3d 756, 767 (Md. Ct. Spec. App. 2015)).

## State Criminal Trademark Laws

**19. Does your state have any criminal trademark protection statutes? If so, please identify the statute and describe the offense.**

### Trademark Counterfeiting: Md. Code Ann., Crim. Law § 8-611

In Maryland, it is a crime to willfully manufacture, produce, display, advertise, distribute, offer for sale, sell, or possess with the intent to sell or distribute goods or services that the person knows bear or are identified by a counterfeit mark (Md. Code Ann., Crim. Law § 8-611(b)).

Violators of Maryland's counterfeiting laws are subject to:

- A felony charge, if the aggregate retail value of the goods or services is \$1,500 or more, resulting in either or both:

- imprisonment for up to ten years; or
- a fine up to \$10,000.

(Md. Code Ann., Crim. Law § 8-611(c).)



- A misdemeanor charge, if the aggregate retail value of the goods or services is less than \$1,500, resulting in either or both:
  - imprisonment of up to one year; or
  - a fine up to \$1,000.(Md. Code Ann., Crim. Law § 8-611(d).)
- Forfeiture of all counterfeit goods (Md. Code Ann., Crim. Law § 8-611(c), (d)). Goods bearing a counterfeit mark are subject to seizure by a law enforcement officer (Md. Code Ann., Crim. Law § 8-611(f)).

## Pending Legislation

### 20. Please describe any legislation pending in your state that would materially impact civil trademark enforcement and protection.

There is no relevant legislation pending in Maryland.

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