

70-3a-403 Injury to business reputation -- Dilution.

- (1) Subject to the principles of equity and upon the terms the court considers reasonable, the owner of a mark that is famous in this state is entitled to:
 - (a) an injunction against another person's commercial use of a mark, if the use:
 - (i) begins after the mark has become famous; and
 - (ii) causes dilution of the distinctive quality of the mark; and
 - (b) obtain other relief as is provided in this section.
- (2) To determine if a mark is famous, a court may consider factors including:
 - (a) the degree of inherent or acquired distinctiveness of the mark in this state;
 - (b) the duration and extent of use of the mark in connection with the goods and services with which the mark is used;
 - (c) the duration and extent of advertising and publicity of the mark in this state;
 - (d) the geographical extent of the trading area in which the mark is used;
 - (e) the channels of trade for the goods or services with which the mark is used;
 - (f) the degree of recognition of the mark in the trading areas and channels of trade in this state that are used by:
 - (i) the mark's owner; and
 - (ii) the person against whom the injunction is sought;
 - (g) the nature and extent of use of the same or similar mark by third parties; and
 - (h) whether the mark is the subject of:
 - (i) a state registration in this state; or
 - (ii) a federal registration:
 - (A) under the Act of March 3, 1881, c. 138, 21 Stat. 502;
 - (B) under the Act of February 20, 1905, c. 592, 33 Stat. 724; or
 - (C) on the principal register.
- (3) In an action brought under this section, the owner of a famous mark is entitled only to injunctive relief in this state, unless the person against whom the injunctive relief is sought willfully intended to:
 - (a) trade on the owner's reputation; or
 - (b) cause dilution of the famous mark.
- (4) If willful intent is proven under Subsection (3)(a) or (b), in addition to injunctive relief, the owner is entitled to the remedies set forth in Section 70-3a-404, subject to:
 - (a) the discretion of the court; and
 - (b) the principles of equity.
- (5) The following are not actionable under this section:
 - (a) fair use of a famous mark by another person in comparative commercial advertising or promotion to identify the competing goods or services of the owner of the famous mark;
 - (b) noncommercial use of the mark; and
 - (c) all forms of news reporting and news commentary.

Enacted by Chapter 318, 2002 General Session