

## Part 3 Registration

### 70-3a-301 Registrability.

- (1) A mark by which the goods or services of an applicant for registration may be distinguished from the goods or services of others may not be registered if it:
- (a) consists of or comprises immoral, deceptive, or scandalous matter;
  - (b) consists of or comprises matter that may:
    - (i) disparage or falsely suggest a connection with:
      - (A) a person, living or dead;
      - (B) an institution;
      - (C) a belief; or
      - (D) a national symbol; or
    - (ii) bring an item listed in Subsection (1)(b)(i) into contempt or disrepute;
  - (c) consists of or comprises the flag or coat of arms or other insignia of:
    - (i) the United States;
    - (ii) any state;
    - (iii) any municipality;
    - (iv) any foreign nation; or
    - (v) any simulation of an item listed in Subsections (1)(c)(i) through (iv);
  - (d) consists of or comprises the name, signature, or portrait identifying a particular living individual, except by the individual's written consent;
  - (e) subject to Subsection (3), consists of a mark that:
    - (i) when used on or in connection with the goods or services of the applicant, is:
      - (A) merely descriptive of the goods or services;
      - (B) deceptively misdescriptive of the goods or services;
      - (C) primarily geographically descriptive of the goods or services; or
      - (D) primarily geographically deceptively misdescriptive of the goods or services; or
    - (ii) is primarily merely a surname;
  - (f) consists of or comprises a mark that:
    - (i) resembles:
      - (A) a mark registered in this state; or
      - (B) a mark or trade name previously used by another and not abandoned; and
    - (ii) is likely, when used on or in connection with the goods or services of the applicant, to cause confusion, mistake, or to deceive; or
  - (g) without the written consent of the United States Olympic Committee, contains or consists of:
    - (i) the symbol of the International Olympic Committee, consisting of five interlocking rings;
    - (ii) the emblem of the United States Olympic Committee, consisting of an escutcheon having a blue chief and vertically extending red and white bars on the base with five interlocking rings displayed on the chief;
    - (iii) any trademark, trade name, sign, symbol, or insignia falsely representing association with, or authorization by, the International Olympic Committee or the United States Olympic Committee;
    - (iv) the words "Olympic," "Olympiad," "Citius Altius Fortius"; or
    - (v) any combination or simulation of any item referenced in Subsections (1)(g)(i) through (iv) that:
      - (A) causes confusion or mistake;

- (B) deceives; or
  - (C) falsely suggests a connection with:
    - (I) the International Olympic Committee;
    - (II) the United States Olympic Committee; or
    - (III) any Olympic activity.
- (2)
- (a) Any actual use of an item under Subsection (1)(g)(ii) or the words or any combination of the words under Subsection (1)(g)(iv), for any lawful purpose prior to September 21, 1950, is not prohibited by this section and may be continued for the same purpose and for the same goods or services.
  - (b) Any actual use of any other trademark, trade name, sign, symbol, or insignia under Subsections (1)(g)(iii) and (iv) for any lawful purpose prior to September 21, 1950, is not prohibited by this section and may be continued for the same purpose and for the same goods or services.
- (3)
- (a) Subsections (1)(e)(i)(A) through (1)(e)(i)(C) do not prevent the registration of a mark used by the applicant that has become distinctive of the applicant's goods or services.
  - (b) For purposes of Subsection (3)(a), the division may accept as evidence that the mark has become distinctive as used on or in connection with the applicant's goods or services, proof of continuous use of the mark as a mark by the applicant in this state for the five years before the date when the claim of distinctiveness is made.

Enacted by Chapter 318, 2002 General Session

**70-3a-302 Application for registration.**

- (1)
- (a) Subject to the limitations in this chapter, any person who uses a mark may file with the division an application for registration of that mark.
  - (b) The registration described in Subsection (1)(a) shall be filed in accordance with rules:
    - (i) made by the division in accordance with Section 70-3a-201; and
    - (ii) that are consistent with this section.
  - (c) The application shall:
    - (i) state:
      - (A) the name and business address of the person applying for registration;
      - (B) if a corporation, the state of incorporation; and
      - (C) if a partnership:
        - (I) the state where the partnership is organized; and
        - (II) the names of the general partners, as specified by the division;
    - (ii) specify:
      - (A) the goods or services on or in connection with which the mark is used;
      - (B) the mode or manner in which the mark is used on or in connection with those goods or services; and
      - (C) the class defined pursuant to Section 70-3a-308 in which those goods or services fall;
    - (iii) state:
      - (A) the date when the mark was first used anywhere;
      - (B) the date when the mark was first used in this state by the applicant or a predecessor in interest;
      - (C) that the applicant is the owner of the mark;

- (D) that the mark is in use; and
- (E) that to the knowledge of the person verifying the application, no other person has registered, either federally or in this state, or has the right to use that mark:
  - (I) in the mark's identical form; or
  - (II) in such near resemblance to the mark as to be likely, when applied to the goods or services of the other person, to cause confusion, mistake, or to deceive;
- (iv) be signed, including by any signature consistent with the requirement for an electronic signature under 15 U.S.C. Sec. 7001, under penalty of perjury by:
  - (A) the applicant; or
  - (B) if the applicant is not an individual:
    - (I) an officer of the applicant; or
    - (II) a partner of a partnership;
- (v) be filed with the division;
- (vi) be accompanied by two specimens showing the mark as actually used; and
- (vii) be accompanied by a fee as determined by the division in accordance with Section 70-3a-203.
- (d) In addition to the information required by Subsection (1)(c), the division may require the applicant to provide:
  - (i) a statement as to whether an application to register the mark, or portions or a composite of the mark, has been filed by the applicant or a predecessor in interest in the United States Patent and Trademark Office; or
  - (ii) a drawing of the mark, complying with the requirements the division may specify.
- (2) If the division requires the statement under Subsection (1)(d)(i), the applicant shall provide full information with respect to any application filed with the United States Patent and Trademark Office including:
  - (a) the filing date and serial number of the application;
  - (b) the status of the application; and
  - (c) if any application was finally refused registration or has otherwise not resulted in a registration, the reasons for the refusal or lack of registration.
- (3) Any materials, information, or signatures required to file an application for a mark may be provided through the database created under Section 70-3a-501.

Amended by Chapter 368, 2009 General Session

**70-3a-303 Filing of applications.**

- (1) The division may examine an application to determine whether the application conforms with this chapter if:
  - (a) the application for registration is filed under Section 70-3a-302; and
  - (b) the fee required by Section 70-3a-203 is paid.
- (2) If reasonably requested by the division or considered by the applicant to be advisable to respond to any rejection or objection, the applicant:
  - (a) shall provide any additional information requested by rule by the division, including a description of a design mark; and
  - (b) may make, or authorize the division to make, amendments to the application.
- (3)
  - (a) The division may require the applicant to disclaim an unregistrable component of a mark otherwise registrable.

- (b) An applicant may voluntarily disclaim a component of a mark for which the applicant has filed a registration application.
  - (c) A disclaimer under this Subsection (3) may not prejudice or affect the applicant's or registrant's rights:
    - (i) in the disclaimed matter:
      - (A) existing at the time of the disclaimer; or
      - (B) arising after the disclaimer; or
    - (ii) of registration on another application if the disclaimed matter is or has become distinctive of the applicant's or registrant's goods or services.
  - (d) The division may make rules consistent with this Subsection (3) to establish the requirements for an applicant to disclaim an unregistrable component of a mark that is otherwise registrable.
- (4) The division may:
- (a) amend an application filed by the applicant if the applicant agrees in writing to the amendment; or
  - (b) require the applicant to file a new application.
- (5)
- (a) If the division determines that the applicant is not qualified to register a mark, the division shall notify the applicant of:
    - (i) the refusal; and
    - (ii) the reasons for the refusal.
  - (b) The applicant shall have a reasonable period of time specified by the division, but not more than 60 days from the date of the notice under this Subsection (5) to:
    - (i) reply to the refusal; or
    - (ii) amend the application for reexamination.
  - (c) The procedure described in Subsections (5)(a) and (b) may be repeated until:
    - (i) the division finally refuses registration of the mark; or
    - (ii) the applicant fails to reply or amend within the time period specified under Subsection (5)(b).
  - (d) If the applicant fails to reply or to amend within the time period specified under Subsection (5)(b), the application is considered abandoned.
- (6) If the division finally refuses registration of the mark, the refusal shall:
- (a) be in writing; and
  - (b) notify the applicant of the applicant's right to a review of the agency action in accordance with Title 63G, Chapter 4, Administrative Procedures Act.
- (7)
- (a) An applicant may file an action to compel registration by obtaining judicial review of the final agency action in accordance with Title 63G, Chapter 4, Administrative Procedures Act.
  - (b) The division is not liable for damages in an action to compel registration.
  - (c) An action to compel registration shall only be granted on proof that:
    - (i) all the statements in the application for registration are true; and
    - (ii) the mark is otherwise entitled to registration.
- (8)
- (a) If more than one application is concurrently being processed by the division seeking registration of the same or confusingly similar marks for the same or related goods or services, the division shall grant priority to the applications in order of filing.
  - (b) If a prior-filed application is granted a registration, the division shall refuse an application filed after the prior-filed application.

- (c) An applicant refused under this Subsection (8) may bring an action for cancellation of the registration upon grounds of prior or superior rights to the mark.

Amended by Chapter 368, 2009 General Session

**70-3a-304 Certification of registration.**

- (1) If an applicant fully complies with this chapter, the division shall:
  - (a) certify the registration; and
  - (b) provide to the applicant documentation that the registration is certified.
- (2) The documentation described in Subsection (1) shall:
  - (a) be affixed to the application of the applicant; or
  - (b) include the information that is required to be in an application under Subsections 70-3a-302(1)(c)(i) through (iii).
- (3) The following are admissible in evidence as competent and sufficient proof of the registration of the particular mark in any action or judicial proceeding in any court of this state:
  - (a) the documentation described in Subsection (1)(b) that is provided by the division; or
  - (b) a copy of the documentation described in Subsection (1)(b) if the copy is certified by the division.
- (4) Documentation of the certification of an electronically registered mark shall be provided through the database created under Section 70-3a-501.

Amended by Chapter 258, 2008 General Session

**70-3a-305 Duration and renewal.**

- (1) The registration of a mark under this chapter expires five years after the date the division certifies the registration under Section 70-3a-304.
- (2) A registration may be renewed for an additional five years from the date a registration expires if the registrant:
  - (a) files an application with the division:
    - (i) no sooner than six months before the expiration of the registration and no later than six months after the expiration of the registration; and
    - (ii) in accordance with the requirements made by rule by the division:
      - (A) pursuant to Section 70-3a-201; and
      - (B) consistent with this section; and
  - (b) pays a renewal fee determined by the division in accordance with Section 70-3a-203.
- (3) If a registrant complies with this section, the registrant may renew a mark at the expiration of each five-year term.
- (4)
  - (a) A registration in effect before May 6, 2002:
    - (i) shall continue in full force and effect for the registration's unexpired term; and
    - (ii) may be renewed by:
      - (A) filing an application for renewal with the division:
        - (I) within the time prescribed in Subsection (2)(a)(i); and
        - (II) in accordance with rules made by the division pursuant to Section 70-3a-201; and
      - (B) paying the required renewal fee determined by the division in accordance with Section 70-3a-203.
  - (b) If a registration in effect before May 6, 2002, is renewed in accordance with this Subsection (4), the registration shall be renewed for a term of five years.

- (5) Any application for renewal under this chapter, whether a registration made under this chapter or a registration made under a prior Utah statute, shall include:
- (a) a verified statement that the mark has been and is still in use; and
  - (b)
    - (i) a specimen showing actual use of the mark on or in connection with the goods or services; or
    - (ii) a verified statement that the mark has not changed.

Amended by Chapter 58, 2012 General Session

**70-3a-306 Assignments -- Changes of name -- Other instruments -- Security interests -- Acknowledgments.**

- (1)
- (a) A mark and the mark's registration under this chapter is assignable with:
    - (i) the good will of the business in which the mark is used; or
    - (ii) that part of the good will of the business connected with the use of and symbolized by the mark.
  - (b) An assignment under this section:
    - (i) shall be:
      - (A) in writing; and
      - (B) properly executed; and
    - (ii) may be filed with the division by:
      - (A) filing a form provided by the division; and
      - (B) paying of a fee determined by the division in accordance with Section 70-3a-203.
  - (c) Upon the filing of an assignment, the division shall certify that the assignment has been filed.
  - (d) An assignment of any registration under this chapter is void as against any subsequent purchaser for valuable consideration without notice, unless the assignment is filed with the division:
    - (i) within three months after the date of the assignment; or
    - (ii) before the subsequent purchase.
- (2) Any registrant or applicant may change the name of the person or business to whom the mark is issued or for whom an application is filed by:
- (a) filing two copies of a certificate of change of name of the registrant or applicant with the division; and
  - (b) paying of a fee determined by the division in accordance with Section 70-3a-203.
- (3)
- (a) A person may file another instrument that relates to a mark registered or application pending under this chapter:
    - (i) in the discretion of the division; and
    - (ii) if the instrument is:
      - (A) in writing; and
      - (B) properly executed.
  - (b) An instrument that may be filed under this Subsection (3) includes:
    - (i) a license;
    - (ii) a security interest; or
    - (iii) a mortgage.
- (4) An acknowledgment by the assignor or person whose interest in a mark is adversely effected by the instrument:

- (a) is prima facie evidence of the execution of an assignment or other instrument; and
- (b) when filed by the division, is prima facie evidence of execution of the assignment or other instrument.

Amended by Chapter 258, 2008 General Session

**70-3a-307 Cancellation.**

- (1) The division shall cancel, in whole or in part:
  - (a) a registration of mark for which the division receives a voluntary request for the registration's cancellation from:
    - (i) the registrant; or
    - (ii) the assignee of record;
  - (b) a registration of a mark:
    - (i) granted under this chapter; and
    - (ii) not renewed in accordance with the chapter;
  - (c) a registration of a mark for which a court of competent jurisdiction finds that:
    - (i) the registered mark has been abandoned;
    - (ii) the registrant is not the owner of the mark;
    - (iii) the registration was granted improperly;
    - (iv) the registration was obtained fraudulently;
    - (v) the mark is or has become the generic name for the goods or services, or a portion of the goods or services, for which the mark has been registered; or
    - (vi) subject to Subsection (2), the mark is so similar, as to be likely to cause confusion, mistake, or to deceive, to a mark:
      - (A) registered by another person in the United States Patent and Trademark Office prior to the date of the filing of the application for registration by the registrant; and
      - (B) not abandoned; or
  - (d) when a court of competent jurisdiction orders cancellation of a registration on any ground.
- (2) Notwithstanding Subsection (1)(c)(vi), if the registrant proves the registrant is the owner of a concurrent registration of a mark in the United States Patent and Trademark Office covering an area including this state, the registration under this chapter may not be cancelled for that particular area of the state.

Enacted by Chapter 318, 2002 General Session

**70-3a-308 Classification.**

- (1)
  - (a) Except as provided in Subsection (1)(b), in administering this chapter, the division shall for the purposes of classifying:
    - (i) goods, use the general classes of goods designated in 37 C.F.R. 6.1; and
    - (ii) services, use the general classes of services designated in 37 C.F.R. 6.1.
  - (b) If the United States Patent and Trademark Office does not use the classifications described in Subsection (1)(a), to the extent practical, the classification of goods and services under this section should conform to the classification adopted by the United States Patent and Trademark Office.
- (2) A single application for registration of a mark may include any or all goods upon which, or services with which, the mark is actually being used if it indicates the appropriate one or more classes of goods or services.

- (3) When a single application includes goods or services that fall within multiple classes, the division may require payment of a fee for each class.

Enacted by Chapter 318, 2002 General Session

**70-3a-309 Cybersquatting.**

- (1)
- (a) A person is liable in a civil action by the owner of a mark, including a personal name, which is a mark for purposes of this section, if, without regard to the goods or services of the person or the mark's owner, the person:
- (i) has a bad faith intent to profit from the mark, including a personal name; and
  - (ii) for any length of time registers, acquires, traffics in, or uses a domain name in, or belonging to any person in, this state that:
    - (A) in the case of a mark that is distinctive at the time of registration of the domain name, is identical or confusingly similar to the mark;
    - (B) in the case of a famous mark that is famous at the time of registration of the domain name, is identical or confusingly similar to or dilutive of the mark; or
    - (C) is a trademark, word, or name protected by reason of 18 U.S.C. Sec. 706 or 36 U.S.C. Sec. 220506.
- (b)
- (i) In determining whether a person has a bad faith intent described in Subsection (1)(a), a court may consider all relevant factors, including:
    - (A) the trademark or other intellectual property rights of the person, if any, in the domain name;
    - (B) the extent to which the domain name consists of the legal name of the person or a name that is otherwise commonly used to identify that person;
    - (C) the person's prior use, if any, of the domain name in connection with the bona fide offering of any goods or services;
    - (D) the person's bona fide noncommercial or fair use of the mark in a site accessible under the domain name;
    - (E) the person's intent to divert consumers from the mark owner's online location to a site accessible under the domain name that could harm the goodwill represented by the mark, either for commercial gain or with the intent to tarnish or disparage the mark, by creating a likelihood of confusion as to the source, sponsorship, affiliation, or endorsement of the site;
    - (F) the person's offer to transfer, sell, or otherwise assign, or solicitation of the purchase, transfer, or assignment of the domain name to the mark owner or any third party for financial gain without having used, or having an intent to use, the domain name in the bona fide offering of any goods or services, or the person's prior conduct indicating a pattern of such conduct;
    - (G) the person's provision of material and misleading false contact information when applying for the registration of the domain name, the person's intentional failure to maintain accurate contact information, or the person's prior conduct indicating a pattern of such conduct;
    - (H) the person's registration or acquisition of multiple domain names that the person knows are identical or confusingly similar to another's mark that is distinctive at the time of registration of the domain names, or is dilutive of another's famous mark that is famous

at the time of registration of the domain names, without regard to the goods or services of the person or the mark owner; and

- (I) the extent to which the mark incorporated in the person's domain name registration is or is not distinctive and famous.
  - (ii) Bad faith intent described in Subsection (1)(a) may not be found in any case in which the court determines that the person believed and had reasonable grounds to believe that the use of the domain name was a fair use or otherwise lawful.
  - (c) In a civil action involving the registration, trafficking, or use of a domain name under this section, a court may order the forfeiture or cancellation of the domain name or the transfer of the domain name to the owner of the mark.
  - (d)
    - (i) A person is liable for using a domain name under Subsection (1)(a) only if that person is the domain name registrant or that registrant's authorized licensee, affiliate, domain name registrar, domain name registry, or other domain name registration authority that knowingly assists a violation of this chapter by the registrant.
    - (ii) A person may not be held liable under this section absent a showing of bad faith intent to profit from the registration or maintenance of the domain name.
    - (iii) For purposes of this section, a "showing of bad faith intent to profit" shall be interpreted in the same manner as under 15 U.S.C. Sec. 1114(2)(D)(iii).
  - (e) As used in this section, the term "traffics in" refers to transactions that include sales, purchases, loans, pledges, licenses, exchanges of currency, and any other transfer for consideration or receipt in exchange for consideration.
- (2)
- (a) The owner of a mark registered with the U.S. Patent and Trademark Office or under this chapter may file an in rem civil action against a domain name in the district court if the owner is located in the state and if:
    - (i) the domain name violates any right of the owner of a mark registered in the Patent and Trademark Office or registered under this chapter; and
    - (ii) the court finds that the owner:
      - (A) is not able to obtain personal jurisdiction over a person who would be a defendant in a civil action under Subsection (1); or
      - (B) through due diligence was not able to find a person who would be a defendant in a civil action under Subsection (1) by:
        - (I) sending a notice of the alleged violation and intent to proceed under this Subsection (2)
          - (a) to the registrant of the domain name at the postal and e-mail address provided by the registrant to the registrar; and
          - (II) publishing notice of the action as the court may direct promptly after filing the action.
  - (b) Completion of the actions required by Subsection (2)(a)(ii) constitutes service of process.
  - (c) In an in rem action under this Subsection (2), a domain name is considered to be located in the judicial district in which:
    - (i) the domain name registrar, registry, or other domain name authority that registered or assigned the domain name is located; or
    - (ii) documents sufficient to establish control and authority regarding the disposition of the registration and use of the domain name are deposited with the court.
  - (d)
    - (i) The remedies in an in rem action under this Subsection (2) are limited to a court order for the forfeiture or cancellation of the domain name or the transfer of the domain name to the owner of the mark.

- (ii) Upon receipt of written notification of a filed, stamped copy of a complaint filed by the owner of a mark in the district court under this Subsection (2), the domain name registrar, domain name registry, or other domain name authority shall:
  - (A) expeditiously deposit with the court documents sufficient to establish the court's control and authority regarding the disposition of the registration and use of the domain name to the court; and
  - (B) not transfer, suspend, or otherwise modify the domain name during the pendency of the action, except upon order of the court.
- (iii) The domain name registrar or registry or other domain name authority is not liable for injunctive or monetary relief under this section, except in the case of bad faith or reckless disregard, which includes a willful failure to comply with a court order.
- (3) The civil actions and remedies established by Subsection (1) and the in rem action established in Subsection (2) do not preclude any other applicable civil action or remedy.
- (4) The in rem jurisdiction established under Subsection (2) does not preclude any other jurisdiction, whether in rem or personal.

Enacted by Chapter 200, 2010 General Session