

1 **REGISTRATION AND PROTECTION OF**
2 **TRADEMARKS**

3 2001 GENERAL SESSION

4 STATE OF UTAH

5 **Sponsor: Lyle W. Hillyard**

6 **This act enacts provisions relating to the registration and protection of trademarks and**
7 **repeals all former provisions. The act defines terms related to the registration and**
8 **protection of trademarks. The act establishes the authority and responsibilities of the**
9 **trademark administrator within the Division of Corporations and Commercial Code. The**
10 **act designates the requirements for a trademark to be registrable and the requirements for**
11 **application for registration. The act describes certificates of registration of trademarks. The**
12 **act designates the duration of trademark registration and procedures for renewal. The act**
13 **outlines the requirements for assignments of trademarks, changes of the names of**
14 **trademarks, and the recordation of other instruments that relate to trademarks. The act**
15 **designates that records of registered trademarks must be kept by the Utah Division of**
16 **Corporations and Commercial Code. The act outlines the procedures for cancellation of a**
17 **trademark. The act outlines the classification of goods and services related to the**
18 **administration of the act. The act establishes liability for fraudulent registration of a**
19 **trademark, infringement on a trademark, and injury to business reputation due to misuse**
20 **of a trademark, and establishes remedies. The act designates the forums for actions**
21 **regarding registration and the requirements for service on out-of-state registrants. The act**
22 **provides it does not adversely affect common law rights. The act provides for fees. The act**
23 **provides a severability clause. The act provides an effective date.**

24 This act affects sections of Utah Code Annotated 1953 as follows:

25 ENACTS:

26 **70-3a-101**, Utah Code Annotated 1953

27 **70-3a-102**, Utah Code Annotated 1953



- 28 **70-3a-103**, Utah Code Annotated 1953
- 29 **70-3a-104**, Utah Code Annotated 1953
- 30 **70-3a-105**, Utah Code Annotated 1953
- 31 **70-3a-106**, Utah Code Annotated 1953
- 32 **70-3a-107**, Utah Code Annotated 1953
- 33 **70-3a-108**, Utah Code Annotated 1953
- 34 **70-3a-109**, Utah Code Annotated 1953
- 35 **70-3a-110**, Utah Code Annotated 1953
- 36 **70-3a-111**, Utah Code Annotated 1953
- 37 **70-3a-112**, Utah Code Annotated 1953
- 38 **70-3a-113**, Utah Code Annotated 1953
- 39 **70-3a-114**, Utah Code Annotated 1953
- 40 **70-3a-115**, Utah Code Annotated 1953
- 41 **70-3a-116**, Utah Code Annotated 1953
- 42 **70-3a-117**, Utah Code Annotated 1953
- 43 **70-3a-118**, Utah Code Annotated 1953
- 44 **70-3a-119**, Utah Code Annotated 1953
- 45 **70-3a-120**, Utah Code Annotated 1953
- 46 **70-3a-121**, Utah Code Annotated 1953

47 REPEALS:

- 48 **70-3-1**, as last amended by Chapter 141, Laws of Utah 1993
- 49 **70-3-2**, as last amended by Chapter 241, Laws of Utah 1990
- 50 **70-3-3**, as last amended by Chapter 313, Laws of Utah 1994
- 51 **70-3-4**, as last amended by Chapter 66, Laws of Utah 1984
- 52 **70-3-5**, as last amended by Chapter 66, Laws of Utah 1984
- 53 **70-3-6**, as last amended by Chapter 313, Laws of Utah 1994
- 54 **70-3-7**, as last amended by Chapter 313, Laws of Utah 1994
- 55 **70-3-8**, as last amended by Chapter 156, Laws of Utah 1957
- 56 **70-3-9**, as last amended by Chapter 66, Laws of Utah 1984
- 57 **70-3-10**, as last amended by Chapter 66, Laws of Utah 1984
- 58 **70-3-11**, as last amended by Chapter 66, Laws of Utah 1984

- 59 **70-3-12**, as last amended by Chapter 66, Laws of Utah 1984
- 60 **70-3-13**, as last amended by Chapter 156, Laws of Utah 1957
- 61 **70-3-14**, as last amended by Chapter 156, Laws of Utah 1957
- 62 **70-3-15**, as last amended by Chapter 156, Laws of Utah 1957
- 63 **70-3-16**, as last amended by Chapter 66, Laws of Utah 1984
- 64 **70-3-17**, as last amended by Chapter 156, Laws of Utah 1957

65 *Be it enacted by the Legislature of the state of Utah:*

66 Section 1. Section **70-3a-101** is enacted to read:

67 **CHAPTER 3a. REGISTRATION AND PROTECTION OF TRADEMARKS ACT**

68 **70-3a-101. Title.**

69 This chapter is known as the "Registration and Protection of Trademarks Act."

70 Section 2. Section **70-3a-102** is enacted to read:

71 **70-3a-102. Intent.**

72 The intent of this chapter is to provide a system of state trademark registration and
73 protection substantially consistent with the federal system of trademark registration and protection
74 under the Trademark Act of 1946, as amended, 15 U.S.C. Section 1051, et seq. (2000). To that
75 end, the construction given the federal act should be examined as persuasive authority for
76 interpreting and construing this chapter.

77 Section 3. Section **70-3a-103** is enacted to read:

78 **70-3a-103. Definitions.**

79 As used in this chapter:

80 (1) "Abandoned mark" means either of the following:

81 (a) A mark whose use has been discontinued with no intent to resume use.

82 (i) Intent not to resume may be inferred from circumstances.

83 (ii) Nonuse for two consecutive years shall constitute prima facie evidence of
84 abandonment.

85 (b) A mark whose significance as a mark has been lost due to any course of conduct of the
86 owner, including acts of omission and commission.

87 (2) "Administrator" means the trademark administrator within the Division of
88 Corporations and Commercial Code.

89 (3) "Applicant" means the person filing an application for registration of a mark under this

90 chapter, and the legal representatives, successors, or assigns of that person.

91 (4) "Dilution" means the lessening of the capacity of a famous mark to identify and
92 distinguish goods or services, regardless of the presence or absence of:

93 (a) competition between the owner of the famous mark and other parties; or

94 (b) the likelihood of confusion, mistake, or deception.

95 (5) "Division" means the Division of Corporations and Commercial Code within the
96 Department of Commerce.

97 (6) "Juristic person" means a firm, partnership, corporation, union, association, or other
98 organization capable of suing and being sued in a court of law.

99 (7) "Mark" means any trademark or service mark entitled to registration under this chapter
100 whether registered or not.

101 (8) "Person" and any other word or term used to designate the applicant or other party
102 entitled to a benefit or privilege or rendered liable under the provisions of this chapter means a
103 juristic person or a natural person.

104 (9) "Registrant" means the person to whom the registration of a mark under this chapter
105 is issued, and the legal representatives, successors, or assigns of that person.

106 (10) (a) "Service mark" means any word, name, symbol, or device or any combination of
107 words, names, symbols, or devices used by a person:

108 (i) to identify and distinguish the services of one person, including a unique service, from
109 the services of others; and

110 (ii) to indicate the source of the services, even if that source is unknown.

111 (b) Titles, character names used by a person, and other distinctive features of radio or
112 television programs may be registered as service marks notwithstanding that they, or the programs,
113 may advertise the goods of the sponsor.

114 (11) "Trademark" means any word, name, symbol, or device or any combination of words,
115 names, symbols, or devices used by a person to identify and distinguish the goods of that person,
116 including a unique product, from those manufactured or sold by others, and to indicate the source
117 of the goods, even if that source is unknown.

118 (12) "Trade name" means any name used by a person to identify a business or vocation of
119 that person.

120 (13) "Use" means the bona fide use of a mark in the ordinary course of trade, and not made

121 merely to reserve a right in a mark. For the purposes of this chapter, a mark is considered to be
122 in use:

123 (a) on goods:

124 (i) when it is placed in any manner on the goods or other containers;

125 (ii) when it is placed in any manner on displays associated with the goods or other
126 containers;

127 (iii) when it is placed on the tags or labels affixed to the goods or other containers; or

128 (iv) if the nature of the goods makes the placements referred to in Subsections (13)(a)(i)

129 through (iii) impracticable, then on documents associated with the goods or their sale, and the
130 goods are sold or transported in commerce in this state; and

131 (b) on services:

132 (i) when it is used or displayed in the sale or advertising of services; and

133 (ii) when the services are rendered in this state.

134 Section 4. Section **70-3a-104** is enacted to read:

135 **70-3a-104. Rulemaking authority of administrator.**

136 In accordance with this chapter, the administrator has rulemaking authority to:

137 (1) under Subsection 70-3a-106(1), establish filing requirements for applications for
138 registration of a mark;

139 (2) under Section 70-3a-107(2), establish what information, in addition to that contained
140 in the application, is pertinent and needed to process an application for registration under Section
141 70-3a-106;

142 (3) under Subsection 70-3a-107(3), establish requirements for an applicant to disclaim an
143 unregistrable component of a mark otherwise registrable;

144 (4) under Subsection 70-3a-109, determine the amount of renewal fees in conformance
145 with the process established in Section 63-38-3.2;

146 (5) under section 70-3a-120, prescribe fees payable for the various application and
147 recording fees and for related services; and

148 (6) establish a classification of goods and services for convenience of administration of
149 this chapter, but not to limit or extend the applicant or registrant's rights.

150 Section 5. Section **70-3a-105** is enacted to read:

151 **70-3a-105. Registrability.**

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

154 (1) consists of or comprises immoral, deceptive, or scandalous matter;
155 (2) consists of or comprises matter which may disparage or falsely suggest a connection
156 with persons, living or dead, institutions, beliefs, or national symbols, or bring them into contempt,
157 or disrepute;

158 (3) consists of or comprises the flag or coat of arms or other insignia of the United States,
159 any state or municipality, any foreign nation, or any simulation thereof;

160 (4) consists of or comprises the name, signature, or portrait identifying a particular living
161 individual, except by the individual's written consent;

162 (5) consists of a mark that:

163 (a) when used on or in connection with the goods or services of the applicant, is merely
164 descriptive or deceptively not descriptive of them;

165 (b) when used on or in connection with the goods or services of the applicant is primarily
166 geographically descriptive or deceptively not descriptive of them; or

167 (c) is primarily merely a surname, provided, however, that nothing in this Subsection (5)
168 prevents the registration of a mark used by the applicant that has become distinctive of the
169 applicant's goods or services. The administrator may accept as evidence that the mark has become
170 distinctive, as used on or in connection with the applicant's goods or services, proof of continuous
171 use of the mark as a mark by the applicant in this state for the five years before the date when the
172 claim of distinctiveness is made; or

173 (6) consists of or comprises a mark that resembles a mark registered in this state or a mark
174 or trade name previously used by another and not abandoned, as to be likely, when used on or in
175 connection with the goods or services of the applicant, to cause confusion, mistake, or to deceive.

176 Section 6. Section **70-3a-106** is enacted to read:

177 **70-3a-106. Application for registration.**

178 (1) Subject to the limitations set forth in this chapter, any person who uses a mark may file
179 in the office of the administrator, in a manner complying with the requirements of the
180 administrator, an application for registration of that mark including the following information:

181 (a) (i) the name and business address of the person applying for registration;
182 (ii) if a corporation, the state of incorporation; and

183 (iii) if a partnership, the state where the partnership is organized and the names of the
184 general partners, as specified by the administrator;

185 (b) (i) the goods or services on or in connection with which the mark is used;

186 (ii) the mode or manner in which the mark is used on or in connection with those goods
187 or services; and

188 (iii) the class in which those goods or services fall;

189 (c) (i) the date when the mark was first used anywhere; and

190 (ii) the date when the mark was first used in this state by the applicant or a predecessor in
191 interest; and

192 (d) a statement:

193 (i) that the applicant is the owner of the mark;

194 (ii) that the mark is in use; and

195 (iii) that to the knowledge of the person verifying the application, no other person has
196 registered, either federally or in this state, or has the right to use that mark either in the mark's
197 identical form or in such near resemblance to the mark as to be likely, when applied to the goods
198 or services of the other person, to cause confusion, mistake, or to deceive.

199 (2) The administrator may also require a statement as to whether an application to register
200 the mark, or portions or a composite of the mark, has been filed by the applicant or a predecessor
201 in interest in the United States Patent and Trademark Office. If so, the applicant shall provide full
202 particulars with respect to the additional application including:

203 (a) the filing date and serial number of each application;

204 (b) the status of the application; and

205 (c) if any application was finally refused registration or has otherwise not resulted in a
206 registration, the reasons for the refusal or lack of registration.

207 (3) The administrator may also require that a drawing of the mark, complying with the
208 requirements the administrator may specify, accompany the application.

209 (4) The application shall be signed and verified by oath by the applicant or by a member
210 of the firm or an officer of the corporation or association applying.

211 (5) The application shall be accompanied by three specimens showing the mark as actually
212 used.

213 (6) The application shall be accompanied by an application fee payable to the Division of

214 Corporations and Commercial Code as determined by the division in conformance with the process
215 established in Section 63-38-3.2.

216 Section 7. Section **70-3a-107** is enacted to read:

217 **70-3a-107. Filing of applications.**

218 (1) Upon the filing of an application for registration under Section 70-3a-106 and payment
219 of the application fee under Subsection 70-3a-106(6), the administrator shall examine the
220 application for conformity with this chapter.

221 (2) The applicant shall provide any additional pertinent information requested by the
222 administrator, including a description of a design mark, and may make, or authorize the
223 administrator to make, amendments to the application as may be reasonably requested by the
224 administrator or considered by the applicant to be advisable to respond to any rejection or
225 objection.

226 (3) The administrator may require the applicant to disclaim an unregistrable component
227 of a mark otherwise registrable, and an applicant may voluntarily disclaim a component of a mark
228 sought to be registered. A disclaimer may not prejudice or affect the applicant or registrant's rights
229 then existing or thereafter arising in the disclaimed matter, or the applicant or registrant's rights
230 of registration on another application if the disclaimed matter is or has become distinctive of the
231 applicant or registrant's goods or services.

232 (4) Amendments may be made by the administrator upon the application submitted by the
233 applicant upon the applicant agreement or a new application may be required to be submitted.

234 (5) If the administrator determines that the applicant is not qualified to register a mark, the
235 administrator shall advise the applicant of the refusal and of the reasons for the refusal. The
236 applicant shall have a reasonable period of time specified by the administrator to reply or to amend
237 the application for reexamination. This procedure may be repeated until:

238 (a) the administrator finally refuses registration of the mark; or

239 (b) the applicant fails to reply or amend within the specified period, in which case the
240 application shall be considered abandoned.

241 (6) If the administrator finally refuses registration of the mark, the applicant may request
242 an agency review through the executive director of the division. The writ may be granted, without
243 costs to the administrator, on proof that all the statements in the application are true and that the
244 mark is otherwise entitled to registration.

245 (7) If applications are concurrently being processed by the administrator seeking
246 registration of the same or confusingly similar marks for the same or related goods or services, the
247 administrator shall grant priority to the applications in order of filing. If a prior-filed application
248 is granted a registration, the other application or applications shall then be rejected. Any rejected
249 applicant may bring an action for cancellation of the registration upon grounds of prior or superior
250 rights to the mark.

251 Section 8. Section **70-3a-108** is enacted to read:

252 **70-3a-108. Certificate of registration.**

253 (1) If an applicant fully complies with the requirements of this chapter, the administrator
254 shall issue a certificate of registration to the applicant.

255 (2) The certificate of registration under Subsection (1) shall be issued under the signature
256 of the administrator and the seal of the state, and shall show:

257 (a) (i) the name and business address;

258 (ii) if a corporation, the state of incorporation;

259 (iii) if a partnership, the state in which the partnership is organized; and

260 (iv) the names of the general partners, as specified by the administrator, of the person
261 claiming ownership of the mark;

262 (b) the date claimed for the first use of the mark anywhere;

263 (c) the date claimed for the first use of the mark in this state;

264 (d) the class of goods or services;

265 (e) a description of the goods or services on or in connection with which the mark is used;

266 (f) a reproduction of the mark;

267 (g) the registration date; and

268 (h) the term of the registration.

269 (3) Any certificate of registration issued by the administrator under the provisions of this
270 section or a copy of that certificate duly certified by the administrator is admissible in evidence as
271 competent and sufficient proof of the registration of the particular mark in any actions or judicial
272 proceedings in any court of this state.

273 Section 9. Section **70-3a-109** is enacted to read:

274 **70-3a-109. Duration and renewal.**

275 (1) The registration of a mark under this chapter is effective for a term of five years after

276 the date of registration.

277 (2) The registration may be renewed for an additional five-year term from the end of the
278 expiring term upon application filed within six months prior to the expiration of the initial
279 five-year term, in a manner complying with the requirements of the administrator. A renewal fee,
280 payable to the Division of Corporations and Commercial Code and determined by the division in
281 conformance with the process established in Section 63-38-3.2, shall accompany the application
282 for renewal of the registration. In the same manner, a registration may be renewed for successive
283 periods of five years.

284 (3) Any registration in force before April 30, 2001, shall continue in full force and effect
285 for the registration's unexpired term. The registration may be renewed by filing an application for
286 renewal with the administrator in compliance with the requirements of the administrator, and
287 paying the required renewal fee within six months before the expiration of the registration.

288 (4) All applications for renewal under this chapter, whether of registrations made under
289 this chapter or of registrations effected under any prior act, shall include:

290 (a) a verified statement that the mark has been and is still in use; and

291 (b) a specimen showing actual use of the mark on or in connection with the goods or
292 services.

293 Section 10. Section **70-3a-110** is enacted to read:

294 **70-3a-110. Assignments -- Changes of name -- Other instruments.**

295 (1) (a) Any mark and its registration under this chapter is assignable with the good will of
296 the business in which the mark is used, or with that part of the good will of the business connected
297 with the use of and symbolized by the mark.

298 (b) Assignments must be in writing, duly executed, and may be recorded with the
299 administrator upon the payment of a recording fee payable to the Division of Corporations and
300 Commercial Code and determined by the division in conformance with the process established in
301 Section 63-38-3.2.

302 (c) Upon recording of an assignment, the administrator shall issue in the name of the
303 assignee a new certificate for the remainder of the term of the registration or of the last renewal
304 of the registration.

305 (d) An assignment of any registration under this chapter is void as against any subsequent
306 purchaser for valuable consideration without notice, unless the assignment is recorded with the

307 administrator within three months after the date of the assignment or prior to the subsequent
308 purchase.

309 (2) (a) Any registrant or applicant effecting a change of the name of the person to whom
310 the mark was issued or for whom an application was filed may record a certificate of change of
311 name of the registrant or applicant with the administrator upon the payment of a recording fee.

312 (b) The administrator may issue, in the name of the assignee, a certificate of registration
313 of an assigned application.

314 (c) The administrator may issue, in the name of the assignee, a new certificate or
315 registration for the remainder of the term of the registration or last renewal of the registration.

316 (3) Other instruments that relate to a mark registered or application pending under this
317 chapter, such as licenses, security interests, or mortgages, may be recorded in the discretion of the
318 administrator, provided that the instrument is in writing and duly executed.

319 (4) Acknowledgment is prima facie evidence of the execution of an assignment or other
320 instrument and, when recorded by the administrator, the record is prima facie evidence of
321 execution.

322 (5) A photocopy of any instrument referred to in Subsections (1) through (3) shall be
323 accepted for recording if it is certified by any of the parties to the instrument, or their successors,
324 to be a true and correct copy of the original.

325 Section 11. Section **70-3a-111** is enacted to read:

326 **70-3a-111. Records.**

327 The administrator shall keep for public examination a record of all marks registered or
328 renewed under this chapter, and a record of all documents recorded under Section 70-3a-110.

329 Section 12. Section **70-3a-112** is enacted to read:

330 **70-3a-112. Cancellation.**

331 The administrator shall cancel from the register, in whole or in part:

332 (1) any registration for which the administrator receives a voluntary request for the
333 registration's cancellation from the registrant or the assignee of record;

334 (2) all registrations granted under this chapter and not renewed in accordance with the
335 chapter's provisions;

336 (3) any registration for which a court of competent jurisdiction finds that:

337 (a) the registered mark has been abandoned;

- 338 (b) the registrant is not the owner of the mark;
339 (c) the registration was granted improperly;
340 (d) the registration was obtained fraudulently;
341 (e) the mark is or has become the generic name for the goods or services, or a portion of
342 the goods or services, for which the mark has been registered; or
343 (f) the registered mark is so similar, as to be likely to cause confusion, mistake, or to
344 deceive, to a mark registered by another person in the United States Patent and Trademark Office
345 prior to the date of the filing of the application for registration by the registrant, and not
346 abandoned; provided, however, that, if the registrant proves the registrant is the owner of a
347 concurrent registration of a mark in the United States Patent and Trademark Office covering an
348 area including this state, the registration under this chapter may not be cancelled for that particular
349 area of the state; or
350 (4) when a court of competent jurisdiction orders cancellation of a registration on any
351 ground.

352 Section 13. Section **70-3a-113** is enacted to read:

353 **70-3a-113. Classification.**

354 (1) Under 70-3a-104(6), the administrator shall establish by rule a classification of goods
355 and services for convenience of administration of this chapter.

356 (2) A single application for registration of a mark may include any or all goods upon
357 which, or services with which, the mark is actually being used indicating the appropriate class or
358 classes of goods or services.

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

361 (4) To the extent practical, the classification of goods and services should conform to the
362 classification adopted by the United States Patent and Trademark Office.

363 Section 14. Section **70-3a-114** is enacted to read:

364 **70-3a-114. Fraudulent registration.**

365 Any person who procures for himself, or on behalf of any other person, the filing or
366 registration of any mark in the office of the administrator under the provisions of this chapter, by
367 knowingly making any false or fraudulent representation or declaration, orally or in writing, or by
368 any other fraudulent means, is civilly liable to pay all damages sustained in consequence of the

369 filing or registration, to be recovered by or on behalf of the party injured by the registration in any
370 court of competent jurisdiction.

371 Section 15. Section **70-3a-115** is enacted to read:

372 **70-3a-115. Infringement.**

373 (1) Subject to the provisions of Section 70-3a-119, any person is liable in a civil action
374 brought by the registrant for any and all of the remedies provided in Section 70-3a-117, subject to
375 Subsection (2), if that person:

376 (a) uses, without the consent of the registrant, any reproduction, counterfeit, copy, or
377 colorable imitation of a mark registered under this chapter in connection with the sale, distribution,
378 offering for sale, or advertising of any goods or services on or in connection with which that use
379 is likely to cause confusion, mistake, or to deceive as to the source of origin of those goods or
380 services; or

381 (b) reproduces, counterfeits, copies or colorably imitates any mark and applies the
382 reproduction, counterfeit, copy or colorable imitation to labels, signs, prints, packages, wrappers,
383 receptacles, or advertisements intended to be used upon or in connection with the sale or other
384 distribution in this state of goods or services.

385 (2) Under Subsection (1)(b), the registrant is not entitled to recover profits or damages
386 unless the act has been committed with the intent to cause confusion, mistake, or to deceive.

387 Section 16. Section **70-3a-116** is enacted to read:

388 **70-3a-116. Injury to business reputation -- Dilution.**

389 (1) The owner of a mark that is famous in this state is entitled, subject to the principles of
390 equity and upon such terms as the court seems reasonable, to an injunction against another person's
391 commercial use of a mark or trade name, if the use begins after the mark has become famous and
392 causes dilution of the distinctive quality of the mark, and to obtain other relief as is provided in
393 this section.

394 (2) To determine if a mark is famous, a court may consider factors including:

395 (a) the degree of inherent or acquired distinctiveness of the mark in this state;

396 (b) the duration and extent of use of the mark in connection with the goods and services
397 with which the mark is used;

398 (c) the duration and extent of advertising and publicity of the mark in this state;

399 (d) the geographical extent of the trading area in which the mark is used;

400 (e) the channels of trade for the goods or services with which the mark is used;

401 (f) the degree of recognition of the mark in the trading areas and channels of trade in this
402 state used by the mark's owner and the person against whom the injunction is sought;

403 (g) the nature and extent of use of the same or similar mark by third parties; and

404 (h) whether the mark is the subject of a state registration in this state, or a federal

405 registration under the Act of March 3, 1881, c. 138, 21 Stat. 502, or under the Act of February 20,
406 1905, c. 592, 33 Stat. 724, or on the principal register.

407 (3) In an action brought under this section, the owner of a famous mark is entitled only to
408 injunctive relief in this state, unless the person against whom the injunctive relief is sought
409 willfully intended to:

410 (a) trade on the owner's reputation; or

411 (b) cause dilution of the famous mark.

412 (4) If willful intent is proven under either Subsection (3)(a) or (b), the owner is also
413 entitled to the remedies set forth in Section 70-3a-117, subject to the discretion of the court and
414 the principles of equity.

415 (5) The following are not actionable under this section:

416 (a) fair use of a famous mark by another person in comparative commercial advertising
417 or promotion to identify the competing goods or services of the owner of the famous mark;

418 (b) noncommercial use of the mark; and

419 (c) all forms of news reporting and news commentary.

420 Section 17. Section **70-3a-117** is enacted to read:

421 **70-3a-117. Remedies.**

422 (1) Any owner of a mark registered under this chapter may proceed by suit to enjoin the
423 manufacture, use, display, or sale of any counterfeits or imitations of the mark and any court of
424 competent jurisdiction may grant injunctions to restrain the manufacture, use, display, or sale as
425 may be considered by the court just and reasonable.

426 (2) A court may require the defendants to pay the owner all profits derived from the
427 wrongful manufacture, use, display, or sale of a registered mark or all damages suffered because
428 of the wrongful manufacture, use, display, or sale of a registered mark.

429 (3) A court may also order that any counterfeits or imitations of a registered mark in the
430 possession or under the control of any defendant in an action be delivered to an officer of the court.

431 or to the complainant, to be destroyed.

432 (4) A court may enter judgment for an amount not to exceed three times the profits and
433 damages or reasonable attorneys' fees, or both, of the prevailing party in actions where the court
434 finds the other party committed the wrongful acts with knowledge, in bad faith, or otherwise as
435 according to the circumstances of the case.

436 (5) The enumeration of any right or remedy in this section does not affect a registrant's
437 right to prosecute under any penal law of this state.

438 Section 18. Section **70-3a-118** is enacted to read:

439 **70-3a-118. Forum for actions regarding registration -- Service on out-of-state**
440 **registrants.**

441 (1) Actions requiring cancellation of a mark registered under this chapter shall be brought
442 in a district court.

443 (a) In an action for cancellation, the administrator may not be made a party to the
444 proceeding but shall be notified of the filing of the complaint by the clerk of the court in which the
445 complaint is filed and shall be given the right to intervene in the action.

446 (b) In an action in mandamus, the proceeding shall be based solely upon the record before
447 the administrator.

448 (2) In any action brought against a nonresident registrant, service may be effected upon
449 the nonresident registrant in accordance with the procedures established for service upon
450 nonresident corporations and business entities under Section 16-10a-1511.

451 Section 19. Section **70-3a-119** is enacted to read:

452 **70-3a-119. Common law rights.**

453 Nothing in this chapter shall adversely affect the rights or the enforcement of rights in
454 marks acquired in good faith at any time at common law.

455 Section 20. Section **70-3a-120** is enacted to read:

456 **70-3a-120. Fees.**

457 The administrator shall, in conformance with the process established in Section 63-38-3.2,
458 prescribe the fees payable for the various applications and recording fees and for related services.
459 Unless specified by the administrator, the fees payable under this chapter are not refundable.

460 Section 21. Section **70-3a-121** is enacted to read:

461 **70-3a-121. Severability.**

462 If any provision of this chapter, or the application of any provision of this chapter, to any
463 person or circumstance is held invalid, the remainder of this chapter shall not be affected by that
464 holding.

465 Section 22. **Repealer.**

466 This act repeals:

467 Section **70-3-1, Definitions.**

468 Section **70-3-2, When trademark or service mark not to be registered.**

469 Section **70-3-3, Application for registration of trademark or service mark -- Contents**

470 **-- Fee.**

471 Section **70-3-4, Certification of registration -- Issuance -- Contents.**

472 Section **70-3-5, Certificate of registration or copy -- Admissibility as evidence.**

473 Section **70-3-6, Term of registration -- Renewal -- Renewal fee -- Notification of**

474 **necessity of renewal.**

475 Section **70-3-7, Assignment -- Recording -- Fee -- Effect of recording.**

476 Section **70-3-8, Accepting or requiring security for return of container bearing**

477 **trademark or service mark.**

478 Section **70-3-9, Public record.**

479 Section **70-3-10, Cancellation of registration.**

480 Section **70-3-11, Classes of goods.**

481 Section **70-3-12, False or fraudulent representation or declaration in registration --**

482 **Liability for damages.**

483 Section **70-3-13, Damages for unlawful use or copying.**

484 Section **70-3-14, Injunctive relief.**

485 Section **70-3-15, Common-law trademarks or service marks.**

486 Section **70-3-16, Effect on trademarks or service marks now on file.**

487 Section **70-3-17, Act not to affect pending actions.**

488 Section 23. **Effective date.**

489 This act takes effect April 30, 2001, but is not intended to affect any suit, proceeding, or
490 appeal then pending.

Legislative Review Note
as of 2-19-01 4:08 PM

A limited legal review of this legislation raises no obvious constitutional or statutory concerns.

Office of Legislative Research and General Counsel