

Enrolled
Senate Bill 636

Sponsored by COMMITTEE ON JUDICIARY

CHAPTER

AN ACT

Relating to marks used in commerce; creating new provisions; amending ORS 647.005, 647.009, 647.015, 647.024, 647.029, 647.035, 647.045, 647.055, 647.065, 647.075, 647.085, 647.095, 647.105, 647.107 and 647.115; and declaring an emergency.

Be It Enacted by the People of the State of Oregon:

SECTION 1. ORS 647.005 is amended to read:

647.005. [(1)] As used in this chapter:

[(a)] "*Applicant*" embraces the person who applies to register a mark under this chapter, and the person's legal representatives, successors or assigns.]

[(b)] "*Mark*" includes any trademark or service mark entitled to registration under this chapter whether registered or not.]

[(c)] "*Person*" means any individual, firm, partnership, corporation, association, union or other organization.]

[(d)] "*Registrant*" embraces the person to whom the registration of a mark is issued under this chapter, and the person's legal representatives, successors or assigns.]

[(e)] "*Retail value*" means:]

[(A)] For items that bear a counterfeit mark and are components of a finished product, the regular selling price of the finished product in which the component would be utilized.]

[(B)] For all items that bear a counterfeit mark other than those described in subparagraph (A) of this paragraph and for all services that are identified by a counterfeit mark, the regular selling price of the item or service.]

[(f)] "*Trademark*" means any word, name, symbol, device or any combination thereof adopted and used by a person to identify goods made or sold by the person and to distinguish them from goods made or sold by others.]

[(g)] "*Trade name*" means a word, name, symbol, device or any combination thereof used by a person to identify the person's business, vocation or occupation and to distinguish it from the business, vocation or occupation of others.]

[(h)] "*Service mark*" means any word, name, symbol, device or any combination thereof used by a person in the sale or advertising of services to identify the person's services and to distinguish them from the services of others.]

[(2)] For the purposes of this chapter, a mark shall be deemed to be "used" in this state:]

[(a)] On goods when it is placed in any manner on the goods or their containers or the displays associated therewith or on the tags or labels affixed thereto and such goods are sold or otherwise distributed in this state; and]

[(b) On services when it is used or displayed in the sale or advertising of services and the services are rendered in this state.]

[(3) For purposes of this chapter, a mark shall be deemed to be “abandoned” in this state when either of the following occurs:]

[(a) When its use has been discontinued with intent not to resume. Intent not to resume may be inferred from the circumstances. Nonuse for two consecutive years shall be prima facie evidence of abandonment. “Use” of a mark means the bona fide use of that mark made in the ordinary course of trade and not made merely to reserve a right in a mark; or]

[(b) When any course of conduct of the registrant, including acts of omission as well as commission, causes the mark to become the generic name for the goods or services on or in connection with which it is used, or otherwise to lose its significance as a mark. Purchaser motivation shall not be a test for determining abandonment under this paragraph.]

(1) “Applicant” means a person that files an application to register a mark under this chapter, and the person’s legal representatives, successors or assigns.

(2) “Dilution” means an association that arises from the similarity between a mark or trade name and a famous mark, regardless of the presence or absence of competition between the owner of the famous mark and another party, actual or likely confusion, mistake, deception or actual economic injury, if the association:

(a) Impairs the distinctiveness of the famous mark, an association commonly known as dilution by blurring; or

(b) Harms the reputation of the famous mark, an association commonly known as dilution by tarnishment.

(3) “Mark” means a trademark or service mark entitled to registration under this chapter whether registered or not.

(4) “Person” means an individual, firm, partnership, corporation, association, limited liability company, union or other organization capable of suing or being sued in a court.

(5) “Registrant” means a person to whom the registration of a mark is issued under this chapter, and the person’s legal representatives, successors or assigns.

(6) “Retail value” means:

(a) For items that bear a counterfeit mark and are components of a finished product, the regular selling price of the finished product in which the component would be utilized.

(b) For items that bear a counterfeit mark other than items described in paragraph (a) of this subsection and for services that are identified by a counterfeit mark, the regular selling price of the item or service.

(7) “Service mark” means a word, name, symbol or device or a combination of words, names, symbols or devices that a person uses to identify and distinguish the person’s services, including a unique service, from another person’s services and to indicate the source of the services, even if the source is unknown.

(8) “Trademark” means a word, name, symbol or device or a combination of words, names, symbols or devices that a person uses to identify and distinguish the person’s goods, including a unique product, from another person’s goods and to indicate the source of the goods, even if the source is unknown.

(9) “Trade name” means a name that a person uses to identify the person’s business or vocation.

(10)(a) “Use” means a bona fide use of a mark as described in section 2 of this 2009 Act in the ordinary course of trade.

(b) “Use” does not include a use of a mark made merely to reserve a right in a mark.

SECTION 2. Section 3 of this 2009 Act is added to and made a part of ORS chapter 647.

SECTION 3. (1) For purposes of this chapter, a mark is in use:

(a) On goods that are sold or transported in commerce in this state when the mark is placed in any manner on:

(A) Goods, other containers or displays associated with the goods or tags or labels affixed to the goods; or

(B) Documents associated with the goods or the sale of the goods, if the nature of the goods makes placing the mark on the items identified in subparagraph (A) of this paragraph impractical.

(b) On services that are rendered in this state when the mark is used or displayed in selling or advertising the services.

(2) A mark is abandoned if either of the following occurs:

(a) Use of the mark has been discontinued with intent not to resume the use. Intent not to resume use may be inferred from circumstances. Nonuse for two consecutive years is prima facie evidence of abandonment.

(b) A course of conduct of the owner, including a failure to act, causes the mark to lose significance as a mark.

(3) A title, character name that a person uses and other distinctive features of a radio or television program may be registered as a service mark notwithstanding that the title, name or feature or the program may advertise the goods of the sponsor.

SECTION 4. ORS 647.009 is amended to read:

647.009. The Secretary of State shall collect the fees described in ORS 56.140 for each document delivered for filing under this chapter and for process served on the Secretary of State under this chapter. The Secretary of State may collect the fees described in ORS 56.140 for copying [any] a public record under this chapter, certifying the copy or certifying [to] other facts of record under this chapter.

SECTION 5. ORS 647.015 is amended to read:

647.015. (1) Subject to the limitations set forth in this chapter, [any person who adopts and uses a mark in this state may submit for filing to 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, but not limited to, the following information:] **a person who uses a mark may file an application to register the mark with the Secretary of State in a manner that complies with the Secretary of State's requirements. The application must set forth at least the following information:**

(a) The name and business address of the person applying for [such] registration.[]; and,] **If the person is a corporation, the application must list the state of incorporation. If the person is a partnership, the application must list the state in which the partnership is organized and the names of the general partners. If the person is a limited liability company, the application must list the state in which the limited liability company was formed.**

(b) The goods or services **on or** in connection with which the mark is used, [and] **the** mode or manner in which the mark is used **on or** in connection with [such] **the** goods or services and the class [in] **into** which [such] **the** goods or services fall.

(c) The date when the mark was first used anywhere and the date when [it] **the applicant or a predecessor in interest** [was] first used **the mark** in this state [by the applicant or the predecessor of the applicant in business].

[d) A statement that the applicant believes the applicant is the owner of the mark and that no other person has the right to use such 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 therefor.]

[e) A mailing address to which the Secretary of State may mail notices.]

[f) Any additional identifying information that the Secretary of State by rule may require.]

(d) **A statement that:**

(A) **The applicant owns the mark;**

(B) **The mark is in use; and**

(C) **To the knowledge of the person that is verifying the application, no other person has registered the mark with the federal government or in this state or has the right to use the mark or a mark that so resembles the mark as to be likely to cause confusion or mistake or to deceive when applied to the goods or services of the other person.**

[(2) The application for registration shall be:]

[(a) Signed and verified by the applicant or by a member of the firm or an officer of the corporation or association applying.]

[(b) Accompanied by a specimen or facsimile of the mark.]

(2) As part of the application, the Secretary of State may require the applicant to:

(a) State whether the applicant or a predecessor in interest has filed an application to register the mark or portions or a composite of the mark with the United States Patent and Trademark Office and, if so, provide:

(A) The filing date and serial number of each application filed in connection with the mark;

(B) The status of the application; and

(C) The reasons why the mark was finally refused registration or an application did not otherwise result in a registration, if the mark was refused registration or the application did not result in a registration.

(b) Provide a drawing of the mark that complies with the Secretary of State's requirements.

(3) The applicant, a member of the firm applying or an officer of the corporation, limited liability company or association applying to register the mark shall sign and verify the application by oath, affirmation or declaration under penalty of perjury.

(4) The applicant as part of the application shall submit one specimen of the mark as actually used.

SECTION 6. ORS 647.024 is amended to read:

647.024. **(1) The Secretary of State by rule may establish [by rule] classes of goods and services for convenience in the administration of this chapter. The classes that the Secretary of State establishes [shall] may not limit or extend an applicant's or registrant's rights and shall conform to the classes the United States Patent and Trademark Office has adopted to the extent practicable [enlarge or diminish the rights of an applicant or a registrant].**

(2) A single application to register a mark may include any or all goods or services on or in connection with which the mark is actually being used.

(3) If an application includes more than one class, the Secretary of State may collect a fee under ORS 56.140 for each class.

SECTION 7. ORS 647.029 is amended to read:

647.029. *[(1) The Secretary of State shall refuse to register a mark if the Secretary of State finds that the mark so resembles either a mark not registered under this chapter or a trade name that a person other than the applicant previously has used in this state and not abandoned, as to be likely, when applied to the goods or when used in connection with the services of the applicant, to cause confusion or mistake, or to deceive. This subsection shall not be construed to require the Secretary of State to conduct any investigation.]*

[(2) Any finding that the Secretary of State makes under subsection (1) of this section shall be in writing, and each finding shall be supported by evidence of use of the mark or trade name. A refusal to register a mark under this section is a final order for purposes of ORS chapter 183.]

[(3) A copy of a registration on the Principal Register of the United States Patent and Trademark Office dated prior to the date that the applicant claims as a date of first use under ORS 647.015 is sufficient evidence to support a finding under this section. A document submitted to the Office of the Secretary of State under ORS chapter 60, 65, 70 or 648 is not evidence that a corporate name, limited partnership name or assumed business name stated in the document has been used.]

(1) The Secretary of State, at the Secretary of State's sole discretion, may examine an application filed under ORS 647.015 for conformity with the provisions of this chapter. This section does not require the Secretary of State to conduct an examination or investigation in connection with an application for registration.

(2) An applicant shall provide additional pertinent information the Secretary of State requests, including a description of a design that is used as a mark. The applicant or, with

the applicant's authorization, the Secretary of State may amend the application to conform with the Secretary of State's requirements or as the applicant deems advisable to respond to a rejection or objection. The Secretary of State may require the applicant to submit a new application.

(3) The Secretary of State may require the applicant to disclaim an unregistrable component of a mark that is otherwise registrable. The applicant may voluntarily disclaim a component of a mark that the applicant has applied to register. An applicant's disclaimer does not prejudice or affect the applicant's or a registrant's rights that exist or arise in the matter the applicant disclaimed or the applicant's or a registrant's rights of registration on another application if the matter the applicant disclaimed is or has become distinctive of the applicant's or registrant's goods or services.

(4) If the Secretary of State finds that an applicant is not entitled to register a mark, the Secretary of State shall notify the applicant and provide the Secretary of State's reasons for the finding. The Secretary of State shall provide the applicant with a reasonable time in which to reply or amend the application and shall examine the amended application in accordance with the provisions of this section. The applicant may continue to amend the application until:

(a) The Secretary of State in a final order refuses to register the mark; or

(b) The applicant abandons the application by failing to reply to the Secretary of State's notice or amend the application within the time the Secretary of State specifies.

(5) If the Secretary of State in a final order refuses to register a mark, the applicant may seek a writ of mandamus under ORS 34.105 to 34.240 to compel the Secretary of State to register the mark. The court may grant the writ if the applicant proves that the statements in the application are true and that the mark is otherwise entitled to registration. The court may not assess costs or award damages against the Secretary of State in an action for a writ of mandamus brought under this section.

(6) If the Secretary of State is concurrently processing applications that seek to register the same mark or a mark that is likely to cause confusion or mistake or to deceive when used on or in connection with goods or services identified in the applications, the Secretary of State shall grant priority to the applications in the order in which they were filed. If the Secretary of State grants a registration for a mark on the basis of an application filed prior to other applications, the Secretary of State shall reject the other applications. A rejected applicant may bring an action to cancel the registration the Secretary of State granted on the basis that the rejected applicant had prior or superior rights to the mark.

SECTION 8. ORS 647.035 is amended to read:

647.035. [(1) *The Secretary of State may not register as a mark any word, phrase, symbol, device or combination thereof if it:*]

[(a) *Consists of or comprises immoral, deceptive or scandalous matter;*]

[(b) *Consists of or comprises matter that may disparage or falsely suggest a connection with persons living or dead, institutions, beliefs or national symbols, or bring them into contempt or disrepute;*]

[(c) *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;*]

[(d) *Consists of or comprises the name, signature or portrait of any living individual except with the individual's written consent;*]

[(e) *Consists of or comprises a mark that so resembles a mark registered in this state as to be likely, when applied to the goods or services of the applicant, to cause confusion or mistake or to deceive;* or]

[(f) *Consists of a word, phrase, symbol, device or combination thereof that:*]

[(A) *When applied to the goods or services of the applicant is merely descriptive or deceptively misdescriptive of them;*]

[(B) When applied to the goods or services of the applicant is primarily geographically descriptive or deceptively misdescriptive of them; or]

[(C) Is primarily merely a surname.]

[(2) Nothing in subsection (1)(f) of this section shall prevent the registration of a mark used in this state by the applicant that 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.]

(1) A mark that an applicant submits for registration may not be registered if the mark consists of or comprises:

(a) Matter that is immoral, deceptive or scandalous;

(b) Matter that may disparage, bring into contempt or disrepute or falsely suggest a connection with a person, living or dead, an institution, a belief or a national symbol;

(c) The flag, coat of arms or other insignia of the United States, a state or municipality or a foreign nation or a simulation of the flag, coat of arms or insignia;

(d) The name or signature of or a portrait that identifies a particular living individual, unless the individual has given written consent; or

(e) A mark that so resembles a mark registered in this state, or a mark or trade name previously used and not abandoned by another person, as to be likely to cause confusion or mistake or to deceive when used on or in connection with the applicant's goods or services.

(2)(a) A mark may not be registered if the mark is:

(A) Merely descriptive or deceptively misdescriptive of the applicant's goods or services;

(B) Primarily geographically descriptive or deceptively misdescriptive of the applicant's goods or services; or

(C) Primarily merely a surname.

(b) The provisions of paragraph (a) of this subsection do not prevent the Secretary of State from registering a mark used by the applicant that has become distinctive of the applicant's goods or services. The Secretary of State may accept as evidence that the mark has become distinctive, when used on or in connection with the applicant's goods or services, proof that the applicant has used the mark continuously in this state for five years before the date on which the applicant made the claim that the mark has become distinctive of the applicant's goods or services.

SECTION 9. ORS 647.045 is amended to read:

647.045. (1) Upon compliance by *[the]* an applicant with the requirements of this chapter, the Secretary of State~~[:]~~ **shall issue and deliver a certificate of registration to the applicant. The Secretary of State may issue as the certificate of registration a copy of the application marked with the word "filed."**

(2) The certificate of registration must show:

(a) The registrant's name and business address. If the registrant is a corporation, the certificate must show the state of incorporation. If the registrant is a partnership, the certificate must show the state in which the partnership is organized and the names of the general partners. If the registrant is a limited liability company, the certificate must show the state in which the limited liability company was formed.

(b) The date the applicant claimed as the first use of the mark anywhere and the date claimed as the first use of the mark in this state.

(c) The class and description of the goods or services on or in connection with which the mark is used.

(d) A reproduction of the mark.

(e) The registration date and the term of registration.

[(a) Shall file the original application; and]

[(b) Shall issue and return to the person who submitted the application a certificate of registration.]

(2) *The Secretary of State may designate the copy of the application marked "filed" to be the certificate of registration.*

(3) *[Any] A certificate of registration issued by the Secretary of State under this chapter, or a copy [thereof] of the certificate duly certified by the Secretary of State, [shall be prima facie evidence in any action or judicial proceeding in any court of this state of:] is competent and sufficient proof of the registration of the mark in an action or proceeding brought in a court in this state.*

[(a) The validity of the registration of the mark.]

[(b) Registrant's ownership of the mark.]

[(c) Registrant's exclusive right to use the mark in trade within the state in connection with the goods or services specified in the application.]

SECTION 10. ORS 647.055 is amended to read:

647.055. (1) Registration of a mark under this chapter *[shall be]* **is** effective for a term of five years from the date of registration and may be renewed for successive five-year terms. *[The registration shall be renewed if the mark is still in use and the registrant submits a signed and verified application on a form to be furnished by the Secretary of State within 90 days prior to the expiration of the term of registration.]* **The Secretary of State shall renew the registration if the registrant:**

(a) Submits an application for renewal, verified as provided in ORS 647.015 (3), within 180 days before the term of registration expires;

(b) Includes with the application a statement, verified as provided in ORS 647.015 (3), that the mark has been in use and is still in use; and

(c) Includes with the application a specimen showing actual use of the mark.

[(2) The Secretary of State shall notify each registrant of a mark under this chapter of the necessity of renewal at least 90 days prior to the expiration of the term of registration by writing to the address shown for the registrant in the current records of the Office of the Secretary of State.]

[(3) Each application for a renewal under this section shall include:]

[(a) A statement that the mark is still in use in this state;]

[(b) A mailing address to which the Secretary of State may mail notices; and]

[(c) Additional information that the Secretary of State by rule may require.]

[(4) The Secretary of State shall keep for public examination a record of all marks registered or renewed under this chapter.]

(2) A registration that is effective on the effective date of this 2009 Act shall remain in effect for the remainder of the term of registration. The registration may be renewed as provided in subsection (1) of this section.

(3) The Secretary of State, before the term of registration expires, shall notify the registrant in writing at the mailing address shown for the registrant in the current records of the Secretary of State that the registrant must renew the registration.

SECTION 11. ORS 647.065 is amended to read:

647.065. (1) *[Any] A mark and [its] the registration for the mark under this chapter [shall be] are* assignable with the goodwill of the business in which the mark is used, or with *[that] the* part of the goodwill of the business **that is** connected with the use of and symbolized by the mark. *[Assignment shall be by instruments in writing and signed and may be submitted for filing to the Office of the Secretary of State. The Secretary of State, upon filing the assignment, shall notify the assignee of the filing of the assignment. An assignment of any registration under this chapter shall be void as against any subsequent purchaser for valuable consideration without notice unless it is submitted for filing to the Office of the Secretary of State within three months after the date thereof or prior to such subsequent purchase.]*

(2) To assign the registration, a registrant must sign a written instrument. The registrant may submit the instrument to the Secretary of State for filing. After filing the instrument, the Secretary of State may issue to the assignee a certificate of registration that is effective for the remainder of the term of registration.

(3) An assignment of registration under this section is void as against a subsequent purchaser that purchases the registration for valuable consideration and without notice of the assignment unless the assignment is submitted to the Secretary of State for filing within 90 days after the assignment or before the subsequent purchase, whichever is later.

(4) A registrant or applicant for registration may submit for filing with the Secretary of State a change of name for the registration or the application. The Secretary of State may issue a certificate of registration for an assigned application in the assignee's name or may issue a certificate of registration in the assignee's name for the remainder of the term of registration.

(5) The Secretary of State, at the Secretary of State's sole discretion, may receive for filing other signed written instruments related to a mark that is registered or an application that is pending, such as licenses, security interests or mortgages.

(6) Acknowledgement is prima facie evidence of the execution of an assignment or other instrument. If the Secretary of State accepts an instrument for filing, the Secretary of State's record is prima facie evidence of the execution.

(7) The Secretary of State may accept for filing a photocopy of an instrument if a party to the instrument or a successor to the party certifies that the photocopy is a true and correct copy of the original instrument.

(8) The Secretary of State shall keep for public examination a record of all marks registered or renewed under this chapter and all documents submitted for filing under this section.

SECTION 12. ORS 647.075 is amended to read:

647.075. (1) The Secretary of State shall cancel a registration [of] **for a mark or part of a registration if [when]:**

(a) The Secretary of State receives a voluntary request from the registrant or the assignee of record to cancel the registration.

(b) The registration has not been renewed in accordance with the provisions of ORS 647.055.

(c) A court of competent jurisdiction either orders cancellation of the registration or [finds that] **makes any of the following findings:**

(A) The registered mark has been abandoned.

(B) The registrant is not the owner of the mark.

(C) The registration was granted improperly.

(D) The registration was obtained fraudulently.

(E) **The registered mark is the generic name for the goods or services or a portion of the goods or services for which the mark has been registered.**

(F) **The registered mark is likely to cause confusion or mistake or to deceive because of the registered mark's similarity to a mark registered with the United States Patent and Trademark Office and not abandoned before the application for the registered mark was filed under ORS 647.015.**

(2) **If the registrant proves that the registrant has a concurrent registration in the United States Patent and Trademark Office that covers an area that includes this state, the Secretary of State may not cancel the registration for the area covered by the concurrent registration notwithstanding a court's finding under subsection (1)(c)(F) of this section.**

[2] *The Secretary of State may cancel a registration of a mark when, after providing the registrant with an opportunity for a hearing, the Secretary of State makes a written finding that:]*

[a] *The registered mark has been abandoned.]*

[b] *The registrant is not the owner of the mark.]*

[c] *The registration was obtained fraudulently.]*

[d] *The Secretary of State filed the registration in error.]*

[3] *The Secretary of State's cancellation of a registration under this section is a final order within the meaning of ORS 183.480 to 183.497.]*

SECTION 13. ORS 647.085 is amended to read:

647.085. [(1) No person shall procure or maintain on behalf of the person or any other person the filing or registration of any mark in the Office of the Secretary of State under the provisions of this chapter, by knowingly making any false or fraudulent representation or declaration, orally or in writing, or by any other fraudulent means.]

(1) A person may not, on the person's behalf or on behalf of another person, apply for, obtain or maintain a filing or registration for a mark under this chapter by knowingly making a false or fraudulent representation or declaration, orally or in writing, or by other fraudulent means.

(2) A person [who] that violates subsection (1) of this section is liable to pay all damages sustained in consequence of [such] the filing or registration[.]. The party injured by the filing or registration may bring an action for damages in a court of competent jurisdiction. [to be recovered in any court of competent jurisdiction by or on behalf of the party injured thereby.]

SECTION 14. ORS 647.095 is amended to read:

647.095. [(1) Subject to the provisions of ORS 647.115 and subsection (2) of this section, a person is subject to a civil action by the owner of a registered mark for any or all of the remedies provided in ORS 647.105 and 647.111 if such person:]

[(a) Uses, without the consent of the registrant, any reproduction, counterfeit, copy or colorable imitation of a mark registered under this chapter in connection with the sale, offering for sale or advertising of any goods or services 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 or services; or]

[(b) Reproduces, counterfeits, copies or colorably imitates any such mark and applies 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.]

[(2) The registrant is not entitled to recover profits or damages under subsection (1)(b) of this section unless the acts have been committed with knowledge that such mark is intended to be used to cause confusion or mistake or to deceive.]

(1) A person may not:

(a) Use without the registrant's consent and in connection with a sale, distribution, offer for sale or advertisement of goods or services a reproduction, counterfeit, copy or colorable imitation of a mark registered under this chapter if the use is likely to cause confusion or mistake or to deceive as to the origin of the goods or services; or

(b) Apply a mark described in paragraph (a) of this subsection to a label, sign, print, package, wrapper, receptacle or advertisement intended for use in connection with the sale or distribution of goods or services within this state.

(2) A person that acts as described in subsection (1) of this section is liable for the remedies provided in ORS 647.105 in a civil action brought by the registrant, except that the registrant may not recover profits or damages from the person unless the person acted as described in subsection (1)(b) of this section with the intent to cause confusion or mistake or to deceive.

SECTION 15. ORS 647.105 is amended to read:

647.105. (1) [Any] **An** owner of a mark registered under this chapter may proceed in a civil action to **seek an injunction against** *[obtain any remedy or combination of remedies provided in this section against any person who engages in]* the manufacture, use, display or sale of *[any counterfeits or imitations]* **a counterfeit or imitation** of the mark. [Any] **A** court of competent jurisdiction may:

(a) Grant injunctions to restrain [such] the manufacture, use, display or sale as [may be by] the court [deemed] deems just and reasonable;

(b) [and shall] Require the defendant to pay to the owner [the greater of \$10,000 or the sum of:] all profits the defendant derived and all damages the owner suffered from the manufacture, use, display or sale; and

(c) Order counterfeits or imitations in the defendant's possession or under the defendant's control to be delivered to an officer of the court or the owner to be destroyed.

[(a) An amount not to exceed three times the profits derived by the defendant from the wrongful manufacture, use, display or sale; and]

[(b) An amount not to exceed three times all damages suffered by the owner because of the wrongful manufacture, use, display or sale.]

[(2) If the court under this section determines that a mark is counterfeit:]

[(a) The court may order the destruction of all such counterfeit marks, all means of making the marks and all goods, articles or other matter bearing the marks that are in the possession or control of the court or any party to the action; or]

[(b) Upon consent of the owner of the mark, the court may dispose of the materials after the counterfeit mark is obliterated, if obliteration does not destroy the materials bearing the mark, by ordering their transfer to any governmental entity, the owner of the mark, a charitable organization or any appropriate private person other than the person from whom the materials were obtained.]

[(3) The court under this section also may order seizure of the counterfeit goods in the manner provided in ORS 647.111.]

(2) If the court finds that the defendant acted in bad faith, with knowledge or otherwise according to the circumstances of the case, the court in the court's discretion may enter a judgment in an amount not to exceed three times the sum of the defendant's profits and the owner's damages and reasonable attorney fees. If the court finds that the plaintiff acted in bad faith, vexatiously, wantonly or for oppressive reasons, the court in the court's discretion may award reasonable attorney fees to the defendant.

SECTION 16. ORS 647.107 is amended to read:

647.107. [Likelihood of injury to business reputation or of dilution of the distinctive quality of a mark registered under ORS 647.015, or a mark valid at common law, or a trade name valid at common law, shall be a ground for injunctive relief notwithstanding the absence of competition between the parties or the absence of confusion as to the source of goods or services.]

(1) Subject to the principles of equity, the owner of a mark that is famous and distinctive in this state, inherently or through acquired distinctiveness, is entitled to an injunction against another person's commercial use of the mark if:

(a) The other person's use began after the mark became famous; and

(b) The use is likely to cause dilution of the famous mark.

(2) A mark is famous if the general consuming public of this state or of a geographic area within this state widely recognizes the mark as a designation of the source of the mark owner's goods or services. In determining whether a mark is famous, a court may consider factors such as:

(a) The duration, extent and geographic reach of advertising and publicity of the mark in this state by the owner or by other persons;

(b) The amount, volume and geographic extent of sales of goods or services offered under the mark in this state;

(c) The extent to which the mark is actually recognized in this state; and

(d) Whether the mark is registered in this state, appears on the principal register created under the Trademark Act of 1946, 60 Stat. 427, 15 U.S.C. 1051 et seq., or is otherwise registered under federal law.

(3) In an action brought under this section, the owner of a famous mark is entitled to injunctive relief throughout the geographic area in which the court finds that the mark became famous before the other person began the other person's use of the mark. The court may not order injunctive relief outside this state.

(4) If the court finds that the other person willfully intended to cause dilution of the famous mark, the owner is entitled to the remedies provided in this chapter, subject to the court's discretion and the principles of equity.

(5) An owner of a famous mark may not bring an action for another person's use if the use is a nominative or descriptive fair use or facilitation of a nominative or descriptive fair use, other than as a designation of source for the other person's own goods or services, including a use:

(a) In connection with:

(A) Advertising or promotion that permits consumers to compare goods or services; or

(B) Identifying or parodying, criticizing or commenting upon the owner of the famous mark or the goods or services of the owner of the famous mark;

(b) That is noncommercial; or

(c) That constitutes news reporting or news commentary.

SECTION 17. Section 18 of this 2009 Act is added to and made a part of ORS chapter 647.

SECTION 18. An action to cancel a mark registered under this chapter or an action in mandamus to compel the Secretary of State to register a mark must be brought in a circuit court in this state. An action in mandamus must be based solely on the record before the Secretary of State. In an action to cancel a mark, a person may not name the Secretary of State as a party but the court shall notify the Secretary of State and permit the Secretary of State to intervene in the proceeding.

SECTION 19. ORS 647.115 is amended to read:

647.115. (1) [Nothing in] **The provisions of** this chapter [shall] **do not** adversely affect the rights or the enforcement of rights in marks or trade names acquired in good faith at any time at common law.

(2) The enumeration of [any] a right or remedy in this chapter does not affect the right of a registrant to prosecute under [any] a penal law of this state.

(3) **The intent of this chapter is to provide for a system of trademark registration and protection substantially consistent with the system of trademark registration and protection set forth in 15 U.S.C. 1051 et seq. Construction given the provisions set forth in 15 U.S.C. 1051 et seq. constitutes persuasive authority for interpreting and construing this chapter.**

SECTION 20. Sections 3 and 18 of this 2009 Act and the amendments to ORS 647.005, 647.009, 647.015, 647.024, 647.029, 647.035, 647.045, 647.055, 647.065, 647.075, 647.085, 647.095, 647.105, 647.107 and 647.115 by sections 1, 4, 5, 6, 7, 8, 9, 10, 11, 12, 13, 14, 15, 16 and 19 of this 2009 Act apply only to suits, proceedings or appeals commenced on or after the operative date specified in section 21 of this 2009 Act.

SECTION 21. (1) Sections 3 and 18 of this 2009 Act and the amendments to ORS 647.005, 647.009, 647.015, 647.024, 647.029, 647.035, 647.045, 647.055, 647.065, 647.075, 647.085, 647.095, 647.105, 647.107 and 647.115 by sections 1, 4, 5, 6, 7, 8, 9, 10, 11, 12, 13, 14, 15, 16 and 19 of this 2009 Act become operative January 1, 2010.

(2) The Secretary of State may take any action before January 1, 2010, that is necessary to enable the Secretary of State to exercise, on and after January 1, 2010, all of the duties, functions and powers conferred on the Secretary of State by sections 3 and 18 of this 2009 Act and the amendments to ORS 647.005, 647.009, 647.015, 647.024, 647.029, 647.035, 647.045, 647.055, 647.065, 647.075, 647.085, 647.095, 647.105, 647.107 and 647.115 by sections 1, 4, 5, 6, 7, 8, 9, 10, 11, 12, 13, 14, 15, 16 and 19 of this 2009 Act.

SECTION 22. This 2009 Act being necessary for the immediate preservation of the public peace, health and safety, an emergency is declared to exist, and this 2009 Act takes effect on its passage.

Passed by Senate May 12, 2009

.....
Secretary of Senate

.....
President of Senate

Passed by House June 3, 2009

.....
Speaker of House

Received by Governor:

.....M,....., 2009

Approved:

.....M,....., 2009

.....
Governor

Filed in Office of Secretary of State:

.....M,....., 2009

.....
Secretary of State