

SENATE AMENDMENTS TO SENATE BILL 636

By COMMITTEE ON JUDICIARY

May 8

- 1 On page 2 of the printed bill, delete lines 18 through 21 and insert:
- 2 “(2) ‘Dilution’ means an association that arises from the similarity between a mark or trade
3 name and a famous mark, regardless of the presence or absence of competition between the owner
4 of the famous mark and another party, actual or likely confusion, mistake, deception or actual eco-
5 nomic injury, if the association:
- 6 “(a) Impairs the distinctiveness of the famous mark, an association commonly known as dilution
7 by blurring; or
- 8 “(b) Harms the reputation of the famous mark, an association commonly known as dilution by
9 tarnishment.”.
- 10 In line 24, after “association,” insert “limited liability company,”.
- 11 In line 34, delete the second “a word” and insert “words”.
- 12 In line 35, delete “name, symbol or device” and insert “names, symbols or devices”.
- 13 In line 38, delete the second “a word” and insert “words”.
- 14 In line 39, delete “name, symbol or device” and insert “names, symbols or devices”.
- 15 On page 3, line 3, after “(1)” insert “For purposes of this chapter,”.
- 16 In line 20, delete “service marks” and insert “a service mark”.
- 17 In line 38, after the period insert “If the person is a limited liability company, the application
18 must list the state in which the limited liability company was formed.”.
- 19 On page 4, line 23, delete “a” and insert “the” and after “was” insert “finally”.
- 20 In line 28, after “corporation” insert “, limited liability company”.
- 21 In line 31, delete “three specimens” and insert “one specimen”.
- 22 In line 34, before “The” insert “(1)”.
- 23 After line 38, insert:
- 24 “(2) A single application to register a mark may include any or all goods or services on or in
25 connection with which the mark is actually being used.
- 26 “(3) If an application includes more than one class, the Secretary of State may collect a fee
27 under ORS 56.140 for each class.”.
- 28 On page 5, line 9, after “State” insert “, at the Secretary of State’s sole discretion,”.
- 29 In line 10, after the period insert “This section does not require the Secretary of State to con-
30 duct an examination or investigation in connection with an application for registration.”.
- 31 In line 40, delete “if the” and insert “when used on or in connection with goods or services
32 identified in the applications”.
- 33 In line 41, delete “Secretary of State registers both marks”.
- 34 On page 6, delete lines 27 and 28 and insert:
- 35 “(1) A mark that an applicant submits for registration may not be registered if the mark consists

1 of or comprises.”.

2 Delete line 39 and insert “(2)(a) A mark may not be registered if the mark is:”.

3 On page 7, line 2, after “distinctive” insert “, when used on or in connection with the applicant’s

4 goods or services,”.

5 In line 3, delete “claimed” and insert “made the claim”.

6 In line 7, after the period insert “The Secretary of State may issue as the certificate of regis-

7 tration a copy of the application marked with the word ‘filed.’” .

8 In line 12, after the period, insert “If the registrant is a limited liability company, the certificate

9 must show the state in which the limited liability company was formed.”.

10 In line 39, after “renewal” insert “, verified as provided in ORS 647.015 (3),”.

11 On page 8, after line 10, insert:

12 “(3) The Secretary of State, before the term of registration expires, shall notify the registrant

13 in writing at the mailing address shown for the registrant in the current records of the Secretary

14 of State that the registrant must renew the registration.”.

15 In line 21, delete “the mark and”.

16 In line 23, delete “shall” and insert “may”.

17 In line 35, after “State” insert “, at the Secretary of State’s sole discretion,”.

18 On page 9, line 3, after “or” delete “for”.

19 In line 4, delete “mark” and insert “registration”.

20 In line 20, delete “owns a mark that is concurrently regis-” and insert “has a concurrent regis-

21 tration in”.

22 In line 21, delete “tered with” and after “Office” delete “and”.

23 In line 22, after “for” delete “this state” and insert “the area covered by the concurrent regis-

24 tration”.

25 In line 37, after “not” insert “, on the person’s behalf or on behalf of another person,”.

26 On page 10, line 24, after “acted” insert “as described in subsection (1)(b) of this section”.

27 On page 11, line 11, after the period insert “If the court finds that the plaintiff acted in bad

28 faith, vexatiously, wantonly or for oppressive reasons, the court in the court’s discretion may award

29 reasonable attorney fees to the defendant.”.

30 In line 17, delete “or trade name”.

31 In line 19, delete “or trade name”.

32 In line 20, delete “or trade name”.

33 In line 21, after “mark” insert a period and delete the rest of the line and lines 22 through 25.

34 In line 26, delete “or trade name”.

35 In line 27, delete “or trade name”.

36 In line 28, delete “or trade name”.

37 In line 29, delete “or trade name” and after “consider” insert “factors such as”.

38 In line 31, delete “another person” and insert “other persons”.

39 In line 32, delete “that bear” and insert “offered under”.

40 In line 33, delete “or trade name”.

41 In line 34, delete “or trade name”.

42 In line 35, delete “or trade name”.

43 In line 38, delete “or trade name”.

44 In line 40, delete “or trade name”.

45 In line 41, delete “or trade name”.

1 In line 43, delete “or trade name”.
2 In line 45, delete “or trade name”.
3 On page 12, line 1, delete the colon and insert “a nominative or descriptive fair use or facili-
4 tation of a nominative or descriptive fair use, other than as a designation of source for the other
5 person’s own goods or services, including a use:
6 “(a) In connection with:
7 “(A) Advertising or promotion that permits consumers to compare goods or services; or
8 “(B) Identifying or parodying, criticizing or commenting upon the owner of the famous mark or
9 the goods or services of the owner of the famous mark;
10 “(b) That is noncommercial; or
11 “(c) That constitutes news reporting or news commentary.”.
12 Delete lines 2 through 12.
13 In line 17, delete “the court” and insert “a person”.
14 After line 25, insert:
15 “(3) The intent of this chapter is to provide for a system of trademark registration and pro-
16 tection substantially consistent with the system of trademark registration and protection set forth
17 in 15 U.S.C. 1051 et seq. Construction given the provisions set forth in 15 U.S.C. 1051 et seq. con-
18 stitutes persuasive authority for interpreting and construing this chapter.”.
19 Delete lines 29 and 30 and insert “2009 Act apply only to suits, proceedings or appeals com-
20 menced on or after the operative date specified in section 21 of this 2009 Act.”.
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