

Chapter 647

1981 REPLACEMENT PART (1983 reprint)

Trade and Service Marks

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CROSS REFERENCES

- Brands, marks and labels:
- Agricultural and horticultural products, Ch. 632
 - Apiary equipment, Ch. 602
 - Bread, 625.220
 - Commercial fertilizers, 633.361
 - Dairy products and substitutes, Ch. 621
 - Forest products and booming equipment, Ch. 532
 - Hazardous substances, 453.035
 - Livestock, Ch. 604
 - Particular items, Chs. 616, 648, 649, 661
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- 647.035**
- Assumed business names ineligible for registration, 648.015
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- Penalties:
- Counterfeiting or unlawfully using union label, 661.210, 661.220, 661.990
 - Interference with apiary brand or serial number, 602.150, 602.990

647.005 Definitions. (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 trade-mark 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) "Trade-mark" 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.

(f) "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.

(g) "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. [1961 c.497 §1; 1965 c.511 §1; 1981 c.633 §71]

647.010 [Repealed by 1961 c.497 §16]

647.015 Application for registration; fee. (1) Subject to the limitations set forth in this chapter, any person who adopts and uses a mark in this state may file in the office of the Corporation Commissioner, on a form to be furnished by the Corporation Commissioner, an application for registration of that mark setting forth, but not limited to, the following information:

(a) The name and business address of the person applying for such registration; and, if a corporation, the state of incorporation.

(b) The goods or services in connection with which the mark is used and mode or manner in which the mark is used in connection with such goods or services and the class in which such goods or services fall.

(c) The date when the mark was first used anywhere and the date when it was first used in this state by the applicant or his predecessor in business.

(d) A statement that the applicant believes he 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.

(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.

(c) Accompanied by a filing fee of \$10 payable to the Corporation Commissioner. [1961 c.497 §3; 1965 c.511 §2; 1971 c.318 §2]

647.020 [Repealed by 1961 c.497 §16]

647.025 Classes of goods and services.

The general classes of goods and services listed in this section are established for convenience of administration of this chapter, but not to limit or extend the applicant's or registrant's rights. 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 comprised in a single class, but in no event shall a single application include goods or services upon which the mark is being used which fall within different classes of goods or services. The classes of goods and services are as follows:

Class	Goods
1	Raw or partly prepared materials.
2	Receptacles.
3	Baggage, animal equipments, portfolios and pocketbooks.
4	Abrasives and polishing materials.
5	Adhesives.
6	Chemicals and chemical compositions.
7	Cordage.
8	Smokers' articles, not including tobacco products.
9	Explosives, firearms, equipments and projectiles.
10	Fertilizers.
11	Inks and inking materials.
12	Construction materials.

- 13 Hardware and plumbing and steamfitting supplies.
- 14 Metals and metal castings and forgings.
- 15 Oils and greases.
- 16 Paints and painters' materials.
- 17 Tobacco products.
- 18 Medicines and pharmaceutical preparations.
- 19 Vehicles.
- 20 Linoleum and oilcloth.
- 21 Electrical apparatus, machines and supplies.
- 22 Games, toys and sporting goods.
- 23 Cutlery, machinery and tools, and parts thereof.
- 24 Laundry appliances and machines.
- 25 Locks and safes.
- 26 Measuring and scientific appliances.
- 27 Horological instruments.
- 28 Jewelry and precious-metal ware.
- 29 Brooms, brushes and dusters.
- 30 Crockery, earthenware and porcelain.
- 31 Filters and refrigerators.
- 32 Furniture and upholstery.
- 33 Glassware.
- 34 Heating, lighting and ventilating apparatus.
- 35 Belting, hose, machinery packing and nonmetallic tires.
- 36 Musical instruments and supplies.
- 37 Paper and stationery.
- 38 Prints and publications.
- 39 Clothing.
- 40 Fancy goods, furnishings and notions.
- 41 Canes, parasols and umbrellas.
- 42 Knitted, netted and textile fabrics, and substitutes therefor.
- 43 Thread and yarn.
- 44 Dental, medical and surgical appliances.
- 45 Soft drinks and carbonated waters.
- 46 Foods and ingredients of foods.
- 47 Wines.
- 48 Malt beverages and liquors.
- 49 Distilled alcoholic liquors.
- 50 Merchandise not otherwise classified.
- 51 Cosmetics and toilet preparations.
- 52 Detergents and soaps.

Class Services

- 100 Miscellaneous.
- 101 Advertising and business.
- 102 Insurance and financial.
- 103 Construction and repair.
- 104 Communications.
- 105 Transportation and storage.
- 106 Material treatment.
- 107 Education and entertainment.

[1961 c.497 §9; 1965 c.511 §3]

647.030 [Repealed by 1961 c.497 §16]

647.035 Marks ineligible for registration. A mark by which the goods or services of any applicant for registration may be distinguished from the goods or services of others shall not be registered if it:

(1) Consists of or comprises immoral, deceptive or scandalous matter; or

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

(3) 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; or

(4) Consists of or comprises the name, signature or portrait of any living individual except with his written consent; or

(5) Consists of or comprises a mark which so resembles a mark registered in this state or a mark or trade name previously used in this state by another and not abandoned, as to be likely, when applied to the goods or services of the applicant, to cause confusion or mistake or to deceive; or

(6) Is the same as, or deceptively similar to, any corporate, limited partnership, reserved or registered name currently on file with the Corporation Commissioner, the Insurance Commissioner or the Superintendent of Banks, or an assumed business name registered as provided in ORS 648.010.

(7) Consists of a mark which (a) when applied to the goods or services of the applicant is merely descriptive or deceptively misdescriptive of them, or (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. However, nothing in this subsection shall prevent the registration of a mark used in this state by the applicant which has become distinctive of the applicant's goods or services. The Corporation Commissioner 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. [1961 c.497 §2; 1965 c.511 §4; 1971 c.318 §3]

647.040 [Amended by 1959 c.261 §1; repealed by 1961 c.497 §16]

647.045 Certificate of registration; evidentiary effect. (1) Upon compliance by the applicant with the requirements of this chapter, the Corporation Commissioner shall cause a certificate of registration to be issued and delivered to the applicant. The certificate of registration shall be issued under the signature of the Corporation Commissioner and the seal of the Corporation Division, State of Oregon.

(2) The certificate of registration shall show:

(a) The name and business address and, if a corporation, the state of incorporation, of the person claiming ownership of the mark.

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

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

(d) A reproduction of the mark.

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

(3) Any certificate of registration issued by the Corporation Commissioner under this chapter, or a copy thereof duly certified by the Corporation Commissioner, shall be prima facie evidence in any action or judicial proceeding in any court of this state of:

(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 certificate, subject to any conditions and limitations stated therein. [1961 c.497 §4; 1965 c.511 §5; 1971 c.318 §4]

647.050 [Repealed by 1961 c.497 §16]

647.055 Period of registration; renewal; fee; record of registrations. (1) Registration of a mark under this chapter shall be effective for a term of five years from the date of registration and, if the mark is then still in use, upon application signed and verified by the registrant and filed within six months prior to the expiration of such term, on a form to be furnished by the Corporation Commissioner, the registration may be renewed for a like term. A renewal fee of \$10 payable to the Corporation Commissioner shall accompany the application for renewal of the registration. A mark registration may be renewed for successive periods of five years in like manner.

(2) The Corporation Commissioner shall notify each registrant of a mark under this chap-

ter of the necessity of renewal within the year next preceding the expiration of the five years from the date of registration by writing to the last-known address of the registrant.

(3) Each application for a renewal under this section shall include a statement that the mark is still in use in this state.

(4) The Corporation Commissioner shall keep for public examination a record of all marks registered or renewed under this chapter. [1961 c.497 §§5, 7, 1965 c.511 §6; 1971 c.318 §5; 1981 c.633 §72]

647.060 [Repealed by 1961 c.497 §16]

647.065 Assignment of registered mark; fee. Any mark and its registration under this chapter shall be assignable with the good will of the business in which the mark is used, or with that part of the good will of the business connected with the use of and symbolized by the mark. Assignment shall be by instruments in writing duly executed and may be recorded with the Corporation Commissioner upon the payment of a fee of \$10 payable to the Corporation Commissioner who, upon recording of the assignment, shall issue in the name of the assignee a new certificate for the remainder of the term of the registration or of the last renewal thereof. An assignment of any registration under this chapter shall be void as against any subsequent purchaser for valuable consideration without notice unless it is recorded with the Corporation Commissioner within three months after the date thereof or prior to such subsequent purchase. [1961 c.497 §6; 1965 c.511 §7; 1971 c.318 §6]

647.070 [Repealed by 1961 c.497 §16]

647.075 Cancellation of registrations. The Corporation Commissioner shall cancel from the register:

(1) Any registration concerning which the Corporation Commissioner receives a voluntary request for cancellation thereof from the registrant or the assignee of record.

(2) Any registration granted under this chapter and not renewed in accordance with the provisions of this chapter.

(3) Any registration when a court of competent jurisdiction orders cancellation of such registration on any ground.

(4) Any registration concerning which a court of competent jurisdiction finds that the:

(a) Registered mark has been abandoned.

(b) Registrant is not the owner of the mark.

(c) Registration was granted improperly.

(d) Registration was obtained fraudulently.

[1961 c.497 §8; 1965 c.511 §8; 1971 c.318 §7; 1981 c.633 §73]

647.080 [Repealed by 1961 c.497 §16]

647.085 Fraudulent registration prohibited; liability. (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 Corporation Commissioner 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.

(2) A person who violates subsection (1) of this section is liable to pay all damages sustained in consequence of such filing or registration, to be recovered in any court of competent jurisdiction by or on behalf of the party injured thereby. [1961 c.497 §10; 1965 c.511 §9, 1971 c.318 §8; 1981 c.633 §73a]

647.090 [Repealed by 1961 c.497 §16]

647.095 Liability for infringement of mark; limitation. (1) Subject to the provisions of ORS 647.115 and subsection (2) of this section, a person is liable to a civil action by the owner of a registered mark for any or all of the remedies provided in ORS 647.105 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 paragraph (b) of subsection (1) 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. [1961 c.497 §11; 1965 c.511 §10]

647.100 [Repealed by 1961 c.497 §16]

647.105 Remedies for infringement.

(1) Any owner of a mark registered under this chapter may proceed by suit to enjoin the manufacture, use, display or sale of any counterfeits or imitations thereof and any court of competent jurisdiction may:

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

(b) Require the defendants to pay to such owner all profits derived from or all damages suffered by reason of such wrongful manufacture, use, display or sale, or both such profits and damages; and

(c) Order that any such counterfeits or imitations in the possession or under the control of any defendant in such case, be delivered to an officer of the court, or to the complainant, to be destroyed.

(2) The enumeration of any right or remedy in this chapter does not affect a registrant's right to prosecute under any penal law of this state. [1961 c.497 §12; 1965 c.511 §11]

647.107 Grounds for injunctive relief.

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. [1971 c.122 §2]

647.110 [Repealed by 1961 c.497 §16]

647.115 Effect of chapter on marks acquired at common law. Nothing in this chapter shall adversely affect the rights or the enforcement of rights in marks acquired in good faith at any time at common law. [1961 c.497 §14; 1965 c.511 §12]

647.120 [Repealed by 1961 c.497 §16]

647.130 [Repealed by 1961 c.497 §16]

647.990 [Repealed by 1961 c.497 §16]