Chapter 647

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Trademarks 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
- Pesticides, Ch. 634

647.095

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 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) "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.

(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.

(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. [1961 c.497 §1; 1965 c.511 §1; 1981 c.633 §71; 1989 c.931 §1]

647.009 Filing, service and copying fees. (1) The Secretary of State shall collect the following fees for the documents delivered for filing:

	Document	Fee
(a)	Application for registration	$ 20
(b)	Renewals	$ 20
(c)	Assignments	$ 10
(d)	Cancellation of registration	$ 10

(2) The Secretary of State by rule may establish fees, in addition to those provided for in subsection (1) of this section, for:

(a) Copying any public records maintained by the Office of Secretary of State and relating to trade and service marks, and for certifying the copy.

(b) Certifying to facts of record, pursuant to this chapter. [1991 c.132 §23]

647.010 [Repealed by 1961 c.497 §16]

647.015 Application for registration. (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) 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 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.

(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. [1961 c.497 §3; 1965 c.511 §2; 1971 c.318 §2; 1985 c.728 §84; 1991 c.132 §20]

647.020 [Repealed by 1961 c.497 §16]

647.024 Rules regarding classes of goods and services. The Secretary of State 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 not enlarge or diminish the rights of an applicant or a registrant. [1985 c.728 §84b (enacted in lieu of 647.025)]

647.025 [1961 c.497 §9; 1965 c.511 §3; repealed by 1985 c.728 §§84a, 110 (647.024 enacted in lieu of 647.025)]

647.029 Refusal to register mark; grounds; form of refusal. (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 183.310 to 183.550.

(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. [1985 c.728 §85b; 1987 c.94 §104]

647.030 [Repealed by 1961 c.497 §16]

647.035 Marks ineligible for registration. The Secretary of State shall not register as a mark any word, phrase, symbol, device or combination thereof if it:

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

(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;

(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;

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

(5) Consists of or comprises a mark which 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

(6) Consists of a word, phrase, symbol, device or combination thereof 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 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. [1961 c.497 §2; 1965 c.511 §4; 1971 c.318 §3; 1985 c.728 §85]

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 Secretary of State:

(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 certificate of registration issued by the Secretary of State under this chapter, or a copy thereof 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:

(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. [1961 c.497 §4; 1965 c.511 §5; 1971 c.318 §4; 1985 c.728 §86]

647.050 [Repealed by 1961 c.497 §16]

647.055 Period of registration; renewal; 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 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.

(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. [1961 c.497 §§5, 7; 1965 c.511 §6; 1971 c.318 §5; 1981 c.633 §72; 1985 c.728 §86a; 1989 c.931 §2; 1991 c.132 §21]

647.060 [Repealed by 1961 c.497 §16]

647.065 Assignment of mark; procedure. 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, 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. [1961 c.497 §6; 1965 c.511 §7; 1971 c.318 §6; 1985 c.351 §25; 1985 c.728 §87a]

647.070 [Repealed by 1961 c.497 §16]

647.075 Cancellation of registrations. (1) The Secretary of State shall cancel a registration of a mark 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:

(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.

(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. [1961 c.497 §8; 1965 c.511 §8; 1971 c.318 §7; 1981 c.633 §73; 1985 c.728 §88]

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 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.

(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 Civil action for infringement; limitation on recovery. (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 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; 1985 c.566 §1]

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 in a civil action to 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 of the mark. Any court of competent jurisdiction may grant injunctions to restrain such manufacture, use, display or sale as may be by the court deemed just and reasonable and shall require the defendant to pay to the owner the greater of $10,000 or the sum of:

(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. [1961 c.497 §12; 1965 c.511 §11; 1985 c.566 §2]

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]

647.111 Seizure of counterfeit goods in infringement proceeding; liability for wrongful seizure; undertaking. (1) In a civil action under ORS 647.105, upon motion by the plaintiff with or without notice to the defendant, the court may order seizure of the counterfeit goods from any person manufacturing, displaying for sale or selling the goods if the plaintiff shows good cause and a probability of success on the merits and posts an undertaking under subsection (6) of this section.

(2) If the plaintiff makes a motion without notice to the defendant for an order for seizure and the court determines from the motion that there is good reason for proceeding without notice to the defendant, the court may waive the requirement of notice and order seizure of the counterfeit goods.

(3) Any person from whom seizure is effected by order of the court under this section shall be served with the order at the time of the seizure. The order of seizure shall set forth:

(a) The date or dates on which the seizure is ordered to take place;

(b) A description of the counterfeit goods to be seized;

(c) The identity of the person or description of the authority of the person who will seize the counterfeit goods;

(d) A description of the location or locations at which seizure is to occur; and

(e) A hearing date not more than 10 court days after the last date on which seizure is ordered at which any person from

whom goods are seized may appear and seek release of the seized goods.

(4) If the plaintiff causes seizure of goods that are not counterfeit, the plaintiff shall be liable for the following damages, costs and expenses:

(a) Any damages proximately caused by the seizure of goods that are not counterfeit to any person having a financial interest in the seized goods.

(b) Costs incurred by any person in defending against seizure of noncounterfeit goods.

(c) Expenses, including reasonable attorney defending against the seizure of any noncounterfeit or noninfringing goods, upon a showing that the plaintiff acted in bad faith in causing the seizure to occur.

(d) Punitive damages, if warranted.

(5) A person seeking a recovery under subsection (4) of this section may join any surety on an undertaking posted under subsection (6) of this section. Any judgment of liability shall bind the person liable under subsection (4) of this section and the surety jointly and severally, but the liability of the surety shall be limited to the amount of the undertaking.

(6) The court shall set the amount of the undertaking required by subsection (1) of this section in accordance with the recovery of damages, costs and expenses under subsection (4) of this section that would be likely if the court ultimately were to determine that the goods seized were not counterfeit.

(7) Any person entitled to recover under subsection (4) of this section, within 30 days after the date of seizure, may object to the undertaking on the ground that the surety or the amount of undertaking is insufficient.

(8) The motion filed pursuant to subsection (1) of this section shall include a statement:

(a) Advising the person from whom the goods are seized that the undertaking has been filed;

(b) Informing the person of the right to object to the undertaking on the ground that the surety or the amount of the undertaking is insufficient; and

(c) Advising the person from whom the goods are seized that the objection to the undertaking must be made within 30 days after the date of seizure. [1985 c.566 §4]

647.115 Effect of chapter on marks or trade names required at common law; effect of civil remedies on criminal statutes. (1) Nothing in this chapter shall 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 right or remedy in this chapter does not affect the right of a registrant to prosecute under any penal law of this state. [1961 c.497 §14; 1965 c.511 §12; 1985 c.566 §5; 1985 c.728 §89]

647.120 [Repealed by 1961 c.497 §16]

647.125 Selling of counterfeit of a mark; authority of court to order destruction and disposition of counterfeit. (1) A person commits the offense of manufacturing or selling a counterfeit of a mark if the person, without consent of the registrant, manufactures or sells any counterfeit of a mark registered under this chapter or registered under 15 U.S.C. §1052 with knowledge that the mark is counterfeit.

(2) If the court in any prosecution brought under this section determines that a mark is counterfeit, the court:

(a) 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 defendant; or

(b) Upon consent of the owner of the mark, may dispose of the materials after the obliteration of the counterfeit mark, if obliteration does not destroy the materials bearing the mark, by ordering their transfer to any governmental entity, any charitable organization or the owner of the registered trade-mark.

(3) For purposes of this section, a mark is counterfeit if:

(a) It is a mark that is identical with or substantially indistinguishable from a registered mark; and

(b) It is used on or in connection with the same type of goods or services for which the genuine mark is registered.

(4) This section shall not be enforced against any person who has adopted and lawfully used the same or confusingly similar mark in the rendition of like services or the manufacture of like goods in this state from a date before the effective date of registration of the service mark or trademark and who continues to use the mark after the effective date of registration. [1985 c.566 §6]

647.130 [Repealed by 1961 c.497 §16]

647.990 [Repealed by 1961 c.497 §16]

PENALTIES

647.991 Penalty for violation of 647.125. (1) The offense described in ORS 647.125, manufacturing or selling a counterfeit of a mark, is punishable as a Class A misdemeanor, except that, notwithstanding ORS 161.635 and 161.655:

(a) If the offense is committed by an individual, the maximum fine that may be imposed for commission of the offense is $5,000 for a first conviction and $50,000 for a second or subsequent conviction.

(b) If the offense is committed by a corporation, the maximum fine that may be imposed for the commission of the offense is $100,000 for a first conviction and $200,000 for a second or subsequent conviction.

(2) The offense described in ORS 647.125, manufacturing or selling a counterfeit of a mark, is punishable as a Class C felony if the person committing the offense has been convicted of committing the offense at least once before, the person caused personal injury or death to another person because the other person relied on the counterfeited item for its intended purpose and the product causing the injury or death reached the other person without substantial change in the condition in which it was made or sold. However, notwithstanding ORS 161.655, if the person is a corporation, the maximum fine that may be imposed for the commission of the offense is $200,000. [1985 c.566 §7]