

1 HB165
2 115717-3
3 By Representatives Canfield and Black
4 RFD: Judiciary
5 First Read: 12-JAN-10

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ENROLLED, An Act,

To amend Sections 8-12-6, 8-12-10, 8-12-14, 8-12-17, and 8-12-18 of the Code of Alabama 1975; to provide for the registration and protection of trademarks; to define certain terms; to provide for the renewal of registration of marks; to adopt the U.S. Patent and Trademark Office classifications of goods and services; to provide for additional remedies when a dilution of a mark occurs; to increase the damages for a trademark violation; and to allow for attorney fees.

BE IT ENACTED BY THE LEGISLATURE OF ALABAMA:

Section 1. Sections 8-12-6, 8-12-10, 8-12-14, 8-12-17, and 8-12-18 of the Code of Alabama 1975, are amended to read as follows:

"§8-12-6.

"As used in this article, the following terms shall have the following meanings, respectively, unless the context clearly indicates otherwise:

"(1) APPLICANT. The person filing an application for registration of a mark under this article, his legal representative, successors, or assigns.

"(2) DILUTION. Dilution by blurring or dilution by tarnishment, regardless of the presence or absence of:

"a. Competition between the owner of the famous mark and other parties, or

1 "b. Actual or likely confusion, mistake, or
2 deception, or

3 "c. Actual economic injury.

4 "(3) DILUTION BY BLURRING. The association arising
5 from the similarity between a mark and a famous mark that
6 impairs the distinctiveness of the famous mark.

7 "(4) DILUTION BY TARNISHMENT. The association
8 arising from the similarity between a mark and a famous mark
9 that harms the reputation of the famous mark.

10 ~~"(2)~~ (5) MARK. Any trade name, trademark, or service
11 mark entitled to registration under this article whether
12 registered or not.

13 ~~"(3)~~ (6) PERSON. Any individual, firm, partnership,
14 corporation, association, union, or other organization.

15 ~~"(4)~~ (7) REGISTRANT. The person to whom the
16 registration of a mark under this article is issued, his legal
17 representative, successors, or assigns.

18 ~~"(5)~~ (8) SERVICE MARK. Any word, name, symbol,
19 character, or device, or any combination thereof and the
20 distinctive feature of radio, television, or other advertising
21 adopted and used by a person to identify services rendered or
22 offered by him and to distinguish them from the services of
23 others.

24 ~~"(6)~~ (9) TRADEMARK. Any word, name, symbol,
25 character, design, drawing, or device, or any combination

1 thereof adopted and used by a person to identify goods made or
2 sold by him and to distinguish them from goods made or sold by
3 others.

4 "~~(7)~~ (10) TRADE NAME. A word, name, symbol,
5 character, design, drawing, device, or any combination thereof
6 adopted and used by a person to identify his business
7 (including vocation, occupation, or profession), and
8 distinguish it from the business of others.

9 "~~(8)~~ (11) USED. A mark shall be deemed to be "used"
10 in this state:

11 "a. On goods or their containers or the displays
12 associated therewith or on the tags or labels affixed thereto
13 when such goods are sold or otherwise distributed in the
14 state;

15 "b. In connection with services when it is used or
16 displayed in the sale or advertising of services and the
17 services are rendered in this state; and

18 "c. In connection with a business when it identifies
19 the business to persons in this state.

20 "§8-12-10.

21 "(a) Registration of a mark under this article shall
22 be effective for a term of ~~10~~ five years from the date of
23 registration and, if the mark is then still in use, upon
24 application filed within six months prior to the expiration of
25 such term, on a form to be furnished by the Secretary of

1 State, the registration may be renewed for a like term. A
2 renewal fee of \$30, payable to the Secretary of State, shall
3 accompany the application for renewal of the registration.

4 "(b) A mark registration may be renewed for
5 successive periods of ~~10~~ five years in like manner.

6 "(c) The Secretary of State shall notify registrants
7 of marks under this article of the necessity of renewal within
8 the year next preceding the expiration of ~~10~~ five years from
9 the date of registration, and within the year next preceding
10 the expiration of five years from the date of any renewal of a
11 registration, by writing to the last known address (physical,
12 electronic, or otherwise) of the registrants.

13 ~~"(d) Any registration in the office of Secretary of~~
14 ~~State on January 1, 1981, shall expire one year after January~~
15 ~~1, 1981, unless registered in accordance with the provisions~~
16 ~~of this article.~~

17 "(d) Any registration in force on the effective date
18 of this amendatory act shall continue in full force and effect
19 for the unexpired term thereof and may be renewed by filing an
20 application for renewal with the Secretary of State complying
21 with the requirements of the Secretary of State and paying the
22 renewal fee therefor within six months prior to the expiration
23 of the registration.

24 "(e) All applications for renewals under this
25 article, whether of registrations made under this article or

1 of registrations effected under any prior act, shall include a
 2 statement that the mark is still in use in this state.

3 ~~"(f) The Secretary of State shall, within six months~~
 4 ~~after January 1, 1981, notify all existing registrants of~~
 5 ~~marks which were filed in the Secretary of State's office~~
 6 ~~under previous acts or by informal registration, of the date~~
 7 ~~of expiration of such registrations unless registered in~~
 8 ~~accordance with the provisions of this article, by writing to~~
 9 ~~the last known address of the registrants.~~

10 "§8-12-14.

11 "(a) The following general classes of goods,
 12 services, and business are established for convenience of
 13 administration of this article, but not to limit or extend the
 14 applicant's or registrant's rights. ~~A , and a single~~
 15 application for registration of a mark may include any or all
 16 goods upon which, or services or business with which, the mark
 17 is actually being used ~~comprised in a single class, but in no~~
 18 ~~event shall a single application include when a single~~
 19 ~~application include~~ indicating the appropriate class or
 20 classes of goods, services or business. When a single
 21 application includes goods, services, or business ~~upon which~~
 22 ~~the mark is being used~~ which fall within different multiple
 23 classes of goods, services, or business, the Secretary of
 24 State may require payment of a fee for each class.

25 ~~"(b) The said classes are as follows:~~

1 "Goods:

2 "~~(1) Chemical products used in industry, science,~~
3 ~~photography, agriculture, horticulture, forestry; artificial~~
4 ~~and synthetic resins; plastics in the form of powders,~~
5 ~~liquids, or pastes, for industrial use; manures (natural and~~
6 ~~artificial); fire extinguishing compositions; tempering~~
7 ~~substances and chemical preparations for soldering; chemical~~
8 ~~substances for preserving foodstuffs; tanning substances;~~
9 ~~adhesive substances used in industry.~~

10 "~~(2) Paints, varnishes, lacquers; preservatives~~
11 ~~against rust and against deterioration of wood; coloring~~
12 ~~matters, dyestuffs; mordants; natural resins; metals in foil~~
13 ~~and powder form for painters and decorators.~~

14 "~~(3) Bleaching preparations and other substances for~~
15 ~~laundry use; cleaning, polishing, scouring, and abrasive~~
16 ~~preparations; soaps; perfumery, essential oils, cosmetics,~~
17 ~~hair lotions; dentifrices.~~

18 "~~(4) Industrial oils and greases (other than oils~~
19 ~~and fats and essential oils); lubricants; dust laying and~~
20 ~~absorbing compositions; fuels (including motor spirit) and~~
21 ~~illuminants; candles, tapers, night-lights, and wicks.~~

22 "~~(5) Pharmaceutical, veterinary, and sanitary~~
23 ~~substances; infants' and invalids' foods; plasters, material~~
24 ~~for bandaging; material for stopping teeth, dental wax,~~

1 ~~disinfectants, preparations for killing weeds and destroying~~
2 ~~vermin.~~

3 ~~"(6) Unwrought and partly wrought common metals and~~
4 ~~their alloys, anchors, anvils, bells, rolled and cast building~~
5 ~~materials; rails and other metallic materials for railway~~
6 ~~tracks; chains (except driving chains for vehicles); cables~~
7 ~~and wires (nonelectric); locksmiths' work; metallic pipes and~~
8 ~~tubes; safes and cash boxes; steel balls; horseshoes; nails~~
9 ~~and screws; other goods in nonprecious metal not included in~~
10 ~~other classes; ores.~~

11 ~~"(7) Machines and machine tools; motors (except for~~
12 ~~land vehicles); machine couplings and belting (except for land~~
13 ~~vehicles); large size agricultural implements; incubators.~~

14 ~~"(8) Hand tools and instruments; cutlery, forks, and~~
15 ~~spoons; side arms.~~

16 ~~"(9) Scientific, nautical, surveying, and electrical~~
17 ~~apparatus and instruments (including wireless), photographic,~~
18 ~~cinematographic, optical, weighing, measuring, signalling,~~
19 ~~checking (supervision), lifesaving, and teaching apparatus and~~
20 ~~instruments; coin or counter-freed apparatus; talking~~
21 ~~machines; cash registers; calculating machines; fire~~
22 ~~extinguishing apparatus.~~

23 ~~"(10) Surgical, medical, dental, and veterinary~~
24 ~~instruments and apparatus (including artificial limbs, eyes,~~
25 ~~and teeth).~~

1 ~~"(11) Installations for lighting, heating, steam~~
2 ~~generating, cooking, refrigerating, drying, ventilating, water~~
3 ~~supply, and sanitary purposes.~~

4 ~~"(12) Vehicles; apparatus for locomotion by land,~~
5 ~~air, or water.~~

6 ~~"(13) Firearms, ammunition, and projectiles;~~
7 ~~explosive substances; fireworks.~~

8 ~~"(14) Precious metals and their alloys and goods in~~
9 ~~precious metals or coated therewith (except cutlery, forks,~~
10 ~~and spoons); jewelry, precious stones, horological and other~~
11 ~~chronometric instruments.~~

12 ~~"(15) Musical instruments (other than talking~~
13 ~~machines and wireless apparatus).~~

14 ~~"(16) Paper and paper articles, cardboard and~~
15 ~~cardboard articles; printed matter, newspaper and periodicals,~~
16 ~~books; bookbinding material; photographs; stationery, adhesive~~
17 ~~materials (stationery); artists' materials; paintbrushes;~~
18 ~~typewriters and office requisites (other than furniture);~~
19 ~~instructional and teaching material (other than apparatus);~~
20 ~~playing cards; printers' type and cliches (stereotype).~~

21 ~~"(17) Gutta-percha, india rubber, balata, and~~
22 ~~substitutes, articles made from these substances and not~~
23 ~~included in other classes; plastics in the form of sheets,~~
24 ~~blocks, and rods, being for use in manufacture; materials for~~

1 ~~packing, stopping, or insulating; asbestos, mica, and their~~
 2 ~~products; hose pipes (nonmetallic).~~

3 ~~"(18) Leather and imitations of leather, and~~
 4 ~~articles made from these materials and not included in other~~
 5 ~~classes; skins, hides; trunks and travelling bags; umbrellas,~~
 6 ~~parasols, and walking sticks; whips, harness, and saddlery.~~

7 ~~"(19) Building materials, natural and artificial~~
 8 ~~stone, cement, lime, mortar, plaster, and gravel; pipes of~~
 9 ~~earthenware or cement; road-making materials; asphalt, pitch,~~
 10 ~~and bitumen; portable buildings; stone monuments; chimney~~
 11 ~~pots.~~

12 ~~"(20) Furniture, mirrors, picture frames; articles~~
 13 ~~(not included in other classes) of wood, cork, reeds, cane,~~
 14 ~~wicker, horn, bone, ivory, whalebone, shell, amber,~~
 15 ~~mother-of-pearl, meerschaum, celluloid, substitutes for all~~
 16 ~~these materials, or of plastics.~~

17 ~~"(21) Small domestic utensils and containers (not of~~
 18 ~~precious metals, or coated therewith); combs and sponges;~~
 19 ~~brushes (other than paintbrushes); brush-making materials;~~
 20 ~~instruments and material for cleaning purposes; steel wool;~~
 21 ~~unworked or semiworked glass (excluding glass used in~~
 22 ~~building); glassware, porcelain, and earthenware, not included~~
 23 ~~in other classes.~~

24 ~~"(22) Ropes, string, nets, tents, awnings,~~
 25 ~~tarpsaulins, sails, sacks; padding and stuffing materials~~

1 ~~(hair, kapok, feathers, seaweed, etc.); raw fibrous textile~~
 2 ~~materials.~~

3 ~~"(23) Yarns, threads.~~

4 ~~"(24) Tissues (piece goods); bed and table covers;~~
 5 ~~textile articles not included in other classes.~~

6 ~~"(25) Clothing, including boots, shoes, and~~
 7 ~~slippers.~~

8 ~~"(26) Lace and embroidery, ribands and braid;~~
 9 ~~buttons, press buttons, hooks and eyes, pins and needles;~~
 10 ~~artificial flowers.~~

11 ~~"(27) Carpets, rugs, mats, and matting; linoleums~~
 12 ~~and other materials for covering existing floors; wall~~
 13 ~~hangings (nontextile).~~

14 ~~"(28) Game and playthings; gymnastic and sporting~~
 15 ~~articles (except clothing); ornaments and decorations for~~
 16 ~~Christmas trees.~~

17 ~~"(29) Meats, fish, poultry, and game; meat extracts;~~
 18 ~~preserved, dried, and cooked fruits and vegetables; jellies,~~
 19 ~~jams; eggs, milk, and other dairy products; edible oils and~~
 20 ~~fats; preserves, pickles.~~

21 ~~"(30) Coffee, tea, cocoa, sugar, rice, tapioca,~~
 22 ~~sago, coffee substitutes; flour, and preparations made from~~
 23 ~~cereals; bread, biscuits, cakes, pastry, and confectionary;~~
 24 ~~ices; honey, treacle; yeast, baking powder; salt, mustard,~~
 25 ~~pepper, vinegar, sauces, spices; ice.~~

1 ~~"(31) Agricultural, horticultural, and forestry~~
2 ~~products and grains not included in other classes; living~~
3 ~~animals; fresh fruits and vegetables; seeds; live plants and~~
4 ~~flowers; foodstuffs for animals, malt.~~

5 ~~"(32) Beer, ale, and porter; mineral and aerated~~
6 ~~waters and other nonalcoholic drinks; syrups and other~~
7 ~~preparations for making beverages.~~

8 ~~"(33) Wines, spirits, and liqueurs.~~

9 ~~"(34) Tobacco, raw or manufactured; smokers'~~
10 ~~articles; matches.~~

11 ~~Services:~~

12 ~~"(35) Advertising and business.~~

13 ~~"(36) Insurance and financial.~~

14 ~~"(37) Construction and repair.~~

15 ~~"(38) Communication.~~

16 ~~"(39) Transportation and storage.~~

17 ~~"(40) Material treatment.~~

18 ~~"(41) Education and entertainment.~~

19 ~~"(42) Miscellaneous.~~

20 ~~"Business:~~

21 ~~"(b) The classification of goods and services shall~~
22 ~~be the classification of goods and services adopted by the~~
23 ~~United States Patent and Trademark Office, as amended from~~
24 ~~time to time, except that nothing in this subsection shall~~
25 ~~prevent the registration of a trade name.~~

1 "(c) The classification of businesses is as follows:

2 "~~(43)~~ (1) Agriculture, forestry, and fisheries.

3 "~~(44)~~ (2) Mining.

4 "~~(45)~~ (3) Construction.

5 "~~(46)~~ (4) Manufacturing, nondurable goods.

6 "~~(47)~~ (5) Manufacturing, durable goods.

7 "~~(48)~~ (6) Transportation, communications, and other
8 public utilities.

9 "~~(49)~~ (7) Wholesale trade, nondurable goods.

10 "~~(50)~~ (8) Wholesale trade, durable goods.

11 "~~(51)~~ (9) Retail trade - lumber and building
12 materials, hardware, nurseries and garden stores, and mobile
13 home dealers.

14 "~~(52)~~ (10) Retail trade - department, variety,
15 miscellaneous general merchandise, grocery, dairy products,
16 retail bakery, and food stores.

17 "~~(53)~~ (11) Retail trade - motor vehicle dealers, auto
18 and home supply stores, gasoline service stations, and
19 miscellaneous vehicle dealers.

20 "~~(54)~~ (12) Retail trade - apparel, accessory, and
21 shoe stores.

22 "~~(55)~~ (13) Retail trade - furniture, home
23 furnishings, household appliances, T.V. and radio stores.

24 "~~(56)~~ (14) Retail trade - eating and drinking places,
25 drugstores, and liquor stores.

1 "~~(57)~~ (15) Retail trade - sporting goods, bicycles,
2 and hobby stores.

3 "~~(58)~~ (16) Retail trade - book, stationery, jewelry,
4 sewing, needlework, and piece-goods stores.

5 "~~(59)~~ (17) Retail trade - mail-order houses, vending
6 machine operators, and direct selling establishments, fuel and
7 ice dealers, and retail florists.

8 "~~(60)~~ (18) Retail trade - miscellaneous.

9 "~~(61)~~ (19) Finance, insurance, and real estate.

10 "~~(62)~~ (20) Business and repair services.

11 "~~(63)~~ (21) Personal services.

12 "~~(64)~~ (22) Entertainment and recreation services.

13 "~~(65)~~ (23) Professional and related services.

14 "~~(66)~~ (24) Public administration.

15 "~~(67)~~ (25) Miscellaneous.

16 "§8-12-17.

17 "~~Likelihood of injury to business reputation or of~~
18 ~~dilution of the distinctive quality of a mark registered under~~
19 ~~this article, or a mark valid at common law, including a trade~~
20 ~~name valid at common law, shall be a ground for injunctive~~
21 ~~relief notwithstanding the absence of competition between the~~
22 ~~parties or the absence of confusion as to the source of goods~~
23 ~~or services.~~

24 "(a) Subject to the principles of equity, the owner
25 of a mark which is famous and distinctive, inherently or

1 through acquired distinctiveness, in this state shall be
 2 entitled to an injunction against another person's commercial
 3 use of a mark, if such use begins after the famous mark has
 4 become famous and is likely to cause dilution of the famous
 5 mark, and to obtain such other relief as is provided in this
 6 section.

7 "(b) A mark is famous if it is widely recognized by
 8 the general consuming public of this state or a significant
 9 geographic area in this state as a designation of source of
 10 the goods or services or the business of the mark's owner. In
 11 determining whether a mark is famous, a court may consider
 12 factors such as, but not limited to:

13 "(1) The duration, extent, and geographic reach of
 14 advertising and publicity of the mark in this state, whether
 15 advertised or publicized by the owner or third parties.

16 "(2) The amount, volume, and geographic extent of
 17 sales offered under the mark in this state.

18 "(3) The extent of actual recognition of the mark in
 19 this state or a significant geographic area in this state.

20 "(4) Whether the mark is the subject of a state
 21 registration in this state, or a federal registration under
 22 the Act of March 3, 1881, or under the Act of February 20,
 23 1905, or on the principal register under the Trademark Act of
 24 1946, as amended.

1 "(c) In an action brought under this section, the
2 owner of a famous mark shall be entitled to injunctive relief
3 throughout the geographic area in which the mark is found to
4 have become famous prior to commencement of the junior use,
5 but not beyond the borders of this state. If the person
6 against whom the injunctive relief is sought willfully
7 intended to cause dilution of the famous mark, then the owner
8 shall also be entitled to the remedies set forth in this
9 chapter, subject to the discretion of the court and the
10 principles of equity.

11 "(d) The following shall not be actionable under
12 this section:

13 "(1) Any fair use, including a nominative or
14 descriptive fair use, or facilitation of such fair use, of a
15 famous mark by another person other than as a designation of
16 source for the person's own goods or services or business,
17 including use in connection with:

18 "a. Advertising or promotion that permits consumers
19 to compare goods or services or businesses; or

20 "b. Identifying and parodying, criticizing, or
21 commenting upon the famous mark owner or the goods or services
22 or business of the famous mark owner.

23 "(2) Noncommercial use of the mark and all forms of
24 news reporting and news commentary.

25 "§8-12-18.

1 "(a) Any owner of a mark registered under this
2 article may proceed by suit to enjoin the manufacture, use,
3 display, or sale of any counterfeits or imitations thereof and
4 any court of competent jurisdiction may grant injunctions to
5 restrain such manufacture, use, display, or sale as may be by
6 the said court deemed just and reasonable, and may require the
7 defendants to pay to such owner all profits derived from
8 and/or all damages suffered by reason of such wrongful
9 manufacture, use, display, or sale, and to pay the costs of
10 the action; ~~and such.~~ In assessing profits, the owner shall be
11 required to prove defendant's sales only; defendant must prove
12 all elements of cost or deduction claimed. The court may also
13 order that any such counterfeits or imitations in the
14 possession or under the control of any defendant in such case,
15 be delivered to an officer of the court, or to the
16 complainant, to be destroyed.

17 "(b) In assessing damages the court may enter
18 judgment, according to the circumstances of the case, for any
19 sum above the amount found as actual damages, up to a trebling
20 of such amount. If the court shall find that the amount of the
21 recovery based on profits is either inadequate or excessive,
22 the court may in its discretion enter judgment for such sum as
23 the court shall find to be just, according to the
24 circumstances of the case. Such sum in either of the above
25 circumstances shall constitute compensation and not a penalty.

1 "(c) The court, in its discretion, may award
2 reasonable attorney fees as follows:

3 "(1) To a prevailing owner in such cases when the
4 court finds the defendant willfully intended infringement or
5 dilution.

6 "(2) To a prevailing defendant in such cases as the
7 Alabama Litigation Accountability Act provides.

8 "~~(b)~~ (d) The enumeration of any right or remedy in
9 this article shall not affect a ~~registrant's~~ owner's right to
10 prosecute under any penal law of this state."

11 Section 2. This act shall become effective January
12 1, 2011.

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Speaker of the House of Representatives

President and Presiding Officer of the Senate

House of Representatives

I hereby certify that the within Act originated in
and was passed by the House 26-JAN-10.

Greg Pappas
Clerk

Senate

22-APR-10

Passed