

CHAPTER 482
TRADEMARKS, SERVICE MARKS, AND TRADE NAMES,
REGISTRATION AND PROTECTION OF

Part I. Trade Names

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§482-1 Definitions. As used in this chapter, unless the context otherwise requires:

"Abandonment" of a mark means when either of the following occurs:

- (1) When its use has been discontinued with intent not to resume such use; provided that intent not to resume may be inferred from circumstances, and nonuse for two consecutive years shall constitute prima facie evidence of abandonment; or
- (2) When any course of conduct of the owner, including acts of omission as well as commission, causes the mark to lose its significance as a mark.

"Applicant" includes the person filing an application for registration of a trade name or mark under this chapter, and the legal representatives, successors, or assigns of such person.

"Dilution" means the lessening of the capacity of a famous mark to identify and distinguish goods or services, regardless of the presence or absence of competition between the owner of the famous mark and other parties, or likelihood of confusion, mistake, or deception.

"Director" means the director of the department of commerce and consumer affairs.

"Individual" means a natural person, and includes the estate of an incompetent or deceased individual.

"Mark" includes any trademark or service mark, entitled to registration under this chapter whether registered or not.

"Partnership" includes a general partnership, limited partnership, and limited liability partnership.

"Person" and any other word or term used to designate the applicant or other party entitled to a benefit or privilege or rendered liable under this chapter, includes an individual, firm, partnership, corporation, limited liability company, union, association, estate, business trust, trust, government, governmental agency or instrumentality, two or more of any of the foregoing having a joint or common interest, or other organization capable of suing and being sued in a court of law.

"Registrant" includes the person to whom the registration of a trade name or mark under this chapter is issued, and the legal representatives, successors, or assigns of the person.

"Service mark" means any word, name, symbol, or device or any combination thereof used by a person, to identify and distinguish the services of one person, including a unique service, from the services of others, and to indicate the source of the services, even if that source is unknown. Titles, character names used by a person, and other distinctive features of radio or television programs may be registered as service marks notwithstanding that they, or the programs, may advertise the goods of the sponsor.

"Trademark" means any word, name, symbol, or device or any combination thereof used by a person to identify and distinguish the goods of the person, including a unique product, from those manufactured or sold by others, and to indicate the source of the goods, even if that source is unknown.

"Trade name" means any name used by a person to identify a business or vocation of such person.

"Use" means the bona fide use of a mark in the ordinary course of trade, and not made merely to reserve a right in a mark. For the purposes of this chapter, a mark shall be deemed to be in use:

- (1) With respect to goods when it is placed in any manner on the goods or other containers or the displays associated therewith or on the tags or labels affixed thereto; or if the nature of the goods makes such placement impracticable, then on documents associated with the goods or their sale, and the goods are sold or transported in commerce in this State; and
- (2) With respect to services when it is used or displayed in the sale or advertising of services and the services are rendered in this State. [L 1980, c 26, §1; gen ch 1985; am L 2001, c 15, §3; am L 2003, c 124, §82]

§482-2 Certificate. (a) Any person desiring to register any trade name may obtain a certificate of registration of the trade name in the manner hereinafter provided.

(b) Before any person may receive a certificate of registration of a trade name, the person shall file in the office of the director an application for the registration thereof, with a certified declaration, stating that the person is the sole and original proprietor of the trade name or the assign of the proprietor and setting forth the nature of business in which the trade name is used.

(c) Upon filing the application, the applicant shall pay to the director a fee of \$50. A special handling fee of \$20 for expediting registration of a trade name shall be assessed by the director. All special handling fees shall be credited to the compliance resolution fund established under section 26-9(o). [L 1888, c 4, §1; RL 1925, §3573; am L 1925, c 174, pt of §1; RL 1935, §7450; RL 1945, §9285; RL 1955, §204-1; HRS §482-1; am and ren L 1980, c 26, §2; am L 1983, c 153, §3; am L 1984, c 118, §6; am L 1985, c 189, §8; gen ch 1985; am L 1987, c 22, §3; am L 1996, c 181, §6; am L 1999, c 129, §19; am L 2001, c 15, §4; am L 2002, c 130, §§110, 111; am L 2003, c 124, §83]

§482-3 Record, issuance and effect of certificate. (a) Upon receiving the application accompanied by the fee, the director shall cause the trade name to be recorded and shall issue to the applicant a certificate of registration. The certificate of registration shall be constructive notice to all persons of the applicant's claim of the use of the trade name throughout the State, for the term of five years from the date thereof; provided that the director shall not register any trade name which is substantially identical with any registered trade name or with the name of any corporation, partnership, limited partnership, limited liability partnership or limited liability company registered in accordance with chapters 414, 414D, 415A, 425, 425E, and 428; provided further that the trade name is continued in actual use by the applicant in this State. The acceptance of an application and issuance of a certificate of registration by the director shall not abrogate or limit any common law or other right of any person to any corporation, partnership, limited partnership, limited liability partnership, or limited liability company name, or trade name.

(b) The registration of a trade name may be renewed at any time during the period of its registration for additional five year periods by filing a renewal application within six months prior to the expiration of the current term and complying with the renewal requirements prescribed by the director. Upon filing the application for renewal, the applicant shall pay the director a fee of \$50.

(c) The director may make, amend, and repeal such rules as may be necessary to carry out the purposes of this section. [L 1888, c 4, §4; RL 1925, §3576; am L 1925, c 174, pt of §1; am L Sp 1933, c 29, §1; RL 1935, §7452; RL 1945, §9287; RL 1955, §204-3; am L Sp 1959 2d, c 1, §15; am L 1963, c 114, §3; am L 1965, c 109, §1; HRS §482-3; am L 1980, c 26, §4; am L 1982, c 204, §8; am L 1983, c 124, §17; am L 1984, c 118, §7; am L 1987, c 22, §4; am L 1988, c 141, §54; am L 1992, c 6, §8; am L 1996, c 181, §7; am L 2001, c 15, §5; am L 2002, c 40, §76, 78; am L 2003, c 124, §84 and c 210, §12; am L 2004, c 121, §50]

§482-3.5 Penalty. (a) Any person who signs and certifies as correct any application filed pursuant to this chapter, knowing the same to be false in any material particular, shall be fined not more than \$5,000.

(b) Any person who negligently but without intent to defraud signs and certifies as correct any application filed pursuant to this chapter, which application is false in any material particular, shall be guilty of a misdemeanor, and upon conviction shall be punished by a fine not exceeding \$500. [L 1975, c 60, §2]

§482-4 Certain trade names not to be adopted or used. (a) It shall be unlawful for any person to adopt or use a trade name that is substantially identical or confusingly similar to any registered trade name, or the name of any corporation, partnership, or limited liability company existing or registered, or authorized to transact business in accordance with the laws of this State, or a name the exclusive right to which is, at the time, reserved in this State.

(b) When a bona fide labor union, or association of employees has adopted a device in the form of a label, brand, mark, name, or other character for the purpose of designating the products of the members of the union or association and the device has been registered pursuant to sections 482-2 and 482-3, then it shall be unlawful for any person to adopt, print, distribute, or otherwise use the device or one so similar as to be confused therewith.

Any person, except the director, found to be in violation of this subsection may, in addition to any other penalty assessed or otherwise imposed by law, be required to pay all costs and attorney's fees incurred in seeking enforcement of this subsection, and may be ordered by the court to pay damages to the bona fide labor union or association of employees involved in such amount as may be determined by the court; provided that the damages ordered shall not be less than \$250 nor more than \$5,000. [L 1925, c 174, pt of §1; am L 1931, c 18, §1; RL 1935, §7453; RL 1945, §9288; am L 1951, c 135, §1; RL 1955, §204-4; am L Sp 1959 2d, c 1, §15; am L 1963, c 114, §3; HRS §482-4; am L 1971, c 164, §1; am L 1979, c 102, §1; am L 1980, c 26, §5; am L 1982, c 204, §8; am L 1983, c 124, §17 and c 167, §16; am L 1984, c 118, §8; am L 1985, c 270, §4; am L 1996, c 92, §17; am L 1999, c 249, §34; am L 2000, c 219, §83; am L 2001, c 15, §6; am L 2003, c 124, §85]

§§482-5 Penalty. Any person using such substantially identical or confusingly similar trade name as set forth in section 482-4, shall be fined not more than \$1,000. [L 1925, c 174, pt of §1; RL 1935, §7454; RL 1945, §9289; RL 1955, §204-5; HRS §482-5; am L 1980, c 26, §6; am L 2001, c 15, §7; am L 2003, c 124, §86]

§482-6 Revocation of certificate; nonuse. (a) If any trade name is not used by the registrant in accordance with the declaration in this State for a period of three hundred sixty-five consecutive days, the certificate of registration shall be subject to revocation.

(b) Any person desiring such revocation shall file a verified petition in the office of the director, setting forth facts indicating such nonuse for a period of three hundred sixty-five consecutive days immediately preceding the date of the filing of the petition. The petitioner, at the petitioner's expense, shall notify the registrant of the hearing in the manner prescribed by the director and section 91-9.5, and the registrant shall be given the opportunity of a full hearing in accordance with chapter 91.

(c) After granting an opportunity for hearing to the petitioner and the registrant, the director shall grant or deny the petition for revocation, as the facts shall warrant. [L Sp 1933, c 29, pt of §2; RL 1935, §7455; RL 1945, §9290; am L 1947, c 163, pt of §1; RL 1955, §204-6; am L Sp 1959 2d, c 1, §15; am L 1963, c 114, §3; HRS §482-6; am L 1980, c 26, §7; am L 1982, c 204, §8; am L 1983, c 124, §17; gen ch 1985; am L 2001, c 15, §8; am L 2003, c 124, §87]

§482-7 Application of law; reissue on nonuser. (a) Sections 482-1 to 482-9 are applicable to all registrations filed in the office of the director; the intent being that all trade names not used by the applicant in this State may be immediately reissued to such applicant who is actually using the same.

(b) The fact that a trade name has not been used in this State for a period of one year shall be prima facie proof of the fact that the same has not been used elsewhere for such period. [L Sp 1933, c 29, pt of §2; RL 1935, §7456; RL 1945, §9291; RL 1955, §204-7; am L Sp 1959 2d, c 1, §15; am L 1963, c 114, §3; HRS §482-7; am L 1980, c 26, §8; am L 1982, c 204, §8; am L 1983, c 124, §17; am L 2001, c 15, §9; am L 2003, c 124, §88; am L 2004, c 121, §51]

§482-8 Revocation of certificate; ownership. (a) Any person claiming to be the owner of a trade name for which a certificate of registration pursuant to this chapter has been issued to any other person shall file a verified petition in the office of the director for the revocation of the registration of such trade name. The petition shall set forth facts in support of the ownership by such petitioner of such trade name and in support of the claim of the petitioner that the certificate of registration should be revoked.

(b) The petitioner shall, at the petitioner's expense, notify the registrant of the hearing in the manner prescribed by the director and section 91-9.5 and the registrant shall be given the opportunity of a hearing in accordance with chapter 91.

(c) After granting an opportunity for hearing to the petitioner and the registrant, the director shall grant or deny the petition for revocation, as the facts shall warrant. [L 1941, c 75, §1(7456-A); RL 1945, §9292; RL 1955, §204-8; am L Sp 1959 2d, c 1, §15; am L 1963, c 114, §3; HRS §482-8; am L 1980, c 26, §9; am L 1982, c 204, §8; am L 1983, c 124, §17; gen ch 1985; am L 2001, c 15, §10; am L 2003, c 124, §89]

§482-8.5 Administrative order of abatement for infringement of trade name. (a) Any individual or sole proprietor with a currently registered trade name in this State claiming that the name of any entity registered or authorized to transact business under the laws of this State is substantially identical to, or confusingly similar to, its trade name may file a petition with the director for an administrative order of abatement to address the infringement of its trade name. The petition shall set forth the facts and authority that support the petitioner's claim that further use of the name should be abated. The petitioner, at the petitioner's expense, shall notify the registrant of the hearing in the manner prescribed by chapter 91 and the registrant shall be given an opportunity to respond to the petition at the hearing. The notice shall be made and the hearing held in accordance with the contested case provisions of chapter 91.

(b) In addition to any other remedy or sanction allowed by law, the order of abatement may:

(1) Allow the entity to retain its registered name, but require the entity to:

- (A) Register a new trade name with the director; and
- (B) Transact business in this State under the new trade name; or

(2) Require the entity to change its registered name, and to:

- (A) Register a new trade name with the director; and
- (B) Transact business in this State under the new trade name.

If the entity fails to comply with the order of abatement within sixty days, the director may involuntarily dissolve or terminate the entity, or cancel or revoke the entity's registration or certificate of authority after the time to appeal has lapsed and no appeal has been timely filed. The director shall mail notice of the dissolution, termination, or cancellation to the entity at its last known mailing address. The entity shall wind up its affairs in accordance with this chapter or chapter 414, 414D, 415A, 425, 425E, or 428, as applicable.

(c) Any person aggrieved by the director's order under this section may obtain judicial review in accordance with chapter 91 by filing a notice of appeal in circuit court within thirty days after the issuance of the director's order. Review of any final decision of the circuit court shall be governed by chapter 602. [L 2002, c 130, §7; am L 2003, c 124, §90 and c 210, §13]

§482-9 Appeal. Any person aggrieved by any action of the director under this chapter in issuing or revoking a certificate of registration of a trade name or in denying an application, within thirty days after the action by the director, or if no order has been entered either granting or denying the application within four months after the filing of the application, may commence proceedings to obtain judicial review thereof by the circuit court of the first circuit by filing in the court a notice of appeal. Proceedings for review by the supreme court may be had and taken in the same manner as is provided for a review of a judgment of a circuit court. [L 1941, c 75, §1(7456-B); RL 1945, §9293; RL 1955, §204-9; am L 1965, c 96, §132; HRS §482-9; am L 1980, c 26, §10; am L 1982, c 204, §8; am L 1983, c 124, §17; am L 2001, c 15, §11; am L 2003, c 124, §91]

§§482-10 to 12 REPEALED. L 2003, c 124, §§107 to 109.

PART II. TRADEMARKS AND SERVICE MARKS

§482-21 Registrability. 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;
- (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 identifying a particular living individual, except by the individual's written consent;
- (5) Consists of a mark that:
 - (A) When used on or in connection with the goods or services of the applicant, is merely descriptive or deceptively misdescriptive of them;
 - (B) When used on or in connection with the goods or services of the applicant is primarily geographically descriptive or deceptively misdescriptive of them; or
 - (C) Is primarily a surname;

provided that nothing in this paragraph shall prevent the registration of a mark used by the applicant which has become distinctive of the applicant's goods or services. The director may accept as evidence that the mark has become distinctive as used on or in connection with the applicant's goods or services, proof of continuous use thereof as a mark by the applicant in this State for the five years before the date on which the claim of distinctiveness is made; or

- (6) Consists of a mark which so resembles a mark registered in this State or a mark or trade name previously used by another and not abandoned, as to be likely, when used on or in connection with the goods or services of the applicant, to cause confusion or mistake or to deceive. [L 2001, c 15, pt of §1; am L 2003, c 124, §92]

§482-22 Application for registration. (a) Subject to the limitations set forth in this part, any person who uses a mark may file in the office of the director, in a manner complying with the requirements of the director, an application for registration of that mark setting forth at least the following information:

(1) The name and business address of the person or entity applying for such registration and the state of organization or incorporation, or if a partnership, the state in which the partnership is formed;

(2) The goods or services on or in connection with which the mark is used, the mode or manner in which the mark is used on or in connection with such goods or services, and the class in which such goods or services fall;

(3) The date when the mark was first used anywhere, and the date when it was first used in this State by the applicant or a predecessor in interest; and

(4) A statement that the applicant is the owner of the mark, the mark is in use, and to the knowledge of the person verifying the application, no other person has registered, either federally or in this State, or has the right to use, the mark either in the identical form thereof or in such near resemblance thereto as to be likely, when applied to the goods or services of the other person, to cause confusion, to cause mistake, or to deceive.

(b) The director may also require a statement as to whether an application to register the mark, or portions or a composite thereof, has been filed by the applicant or a predecessor in interest in the United States Patent and Trademark Office; and, if so, the applicant shall fully disclose the filing date and serial number of each application, the status of the application, and if any application was finally refused registration or has otherwise not resulted in a registration, the reasons therefor.

(c) The director may also require that a drawing of the mark accompany the application and comply with requirements the director may specify in rules.

(d) The application shall be signed and verified by the applicant, a member of the firm, or an officer of the corporation or association applying. The application shall be accompanied by one specimen per class of goods or services showing the mark as actually used on or in conjunction with such goods or services and the application fee payable to the director. [L 2001, c 15, pt of §1; am L 2003, c 124, §93]

§482-23 Filing of applications; appeal. (a) Upon the filing of an application for registration and payment of the application fee, the director shall cause the application to be examined for conformity with this part.

(b) The applicant shall provide any additional pertinent information requested by the director including a description of a design mark and may make, or authorize the director to make, such amendments to the application as may be reasonably requested by the director or deemed by the applicant to be advisable to respond to any rejection or objection.

(c) The director may require the applicant to disclaim an unregistrable component of a mark otherwise registrable, and an applicant may voluntarily disclaim a component of a mark sought to be registered. No disclaimer shall prejudice or affect the applicant's or registrant's rights in the disclaimed matter, or the applicant's or registrant's rights of registration in another application if the disclaimed matter is or will become distinctive of the applicant's or registrant's goods or services.

(d) If the application for registration of a mark is denied, the director shall notify the applicant of the denial and the reasons for the denial. An applicant may appeal the director's denial of an application for registration of a mark in accordance with section 91-13.1.

(e) Applications concurrently being processed by the director and seeking registration of the same or confusingly similar marks for the same or related goods or services shall be reviewed in the order that they are filed. If an earlier-filed application is granted registration, the other applications seeking registration of the same or confusingly similar marks for the same or related goods or services shall be rejected. Any rejected applicant may bring an action for cancellation of the registration upon grounds of prior or superior rights to the mark, in accordance with section 482-28. [L 2001, c 15, pt of §1; am L 2003, c 124, §94]

§482-24 Certificate of registration. (a) Upon compliance by the applicant with the requirements of this part, the director shall issue a certificate of registration to the applicant.

(b) The original or a copy certified by the director of a certificate of registration issued under this part shall be admissible in evidence as sufficient proof of the registration of a mark in any action or judicial proceeding in any court of this State. [L 2001, c 15, pt of §1; am L 2003, c 124, §95]

§482-25 Duration and renewal. (a) The registration of a mark shall be effective for a term of five years from the date of registration. A renewal fee, payable to the director, shall accompany the application for renewal of the registration.

(b) A registration may be renewed for successive periods of five years by filing a renewal application within six months prior to the expiration of the current term, complying with the renewal requirements prescribed by this chapter and paying the appropriate renewal fee.

(c) Any registration in effect on July 1, 2003, shall continue in full force and effect for the unexpired term thereof and may be renewed by filing an application for renewal with the director in accordance with this section.

(d) All applications for renewal under this part shall include a verified statement that the mark has been and is still in use, and include a specimen showing actual use of the mark on or in connection with the goods or services for each class of goods and services. [L 2001, c 15, pt of §1; am L 2003, c 124, §96]

§482-26 Assignment; change of name. (a) The registration of a mark shall be assignable with the goodwill of the business in which the mark is used, or with that part of the goodwill of the business connected with the use of and symbolized by the mark. An assignment shall be executed in writing and may be recorded by filing an application with the director and paying an appropriate recording fee. Upon recording of the assignment, the director shall issue a new certificate for the remainder of the term of the registration or of the last renewal thereof in the name of the new assignee. An assignment of a registration of a mark under this section shall be void against a subsequent purchaser for valuable consideration without notice, unless the assignment is recorded with the director within three months after the date thereof or prior to the subsequent purchase.

(b) Any registrant may change the name of the person to whom the mark is issued by filing an application to change the name of the registrant with the director and paying the appropriate fee. The director shall issue a new certificate of registration in the name of the registrant. [L 2001, c 15, pt of §1]

§482-27 Records. The director shall maintain a record of all marks registered or renewed under this part, including a record of all marks recorded pursuant to section 482-26. [L 2001, c 15, pt of §1]

§482-28 Cancellation. The director shall cancel the registration of a mark if the director receives a request for cancellation from the registrant or assignee of record or when a court of competent jurisdiction orders cancellation of a registration. [L 2001, c 15, pt of §1; am L 2003, c 124, §97]

§482-28.5 Revocation of a mark. (a) Any person claiming to be the owner of a trademark or service mark for which a certificate of registration has been issued to another person pursuant to this part may file a verified petition in the office of the director for the revocation of the registration of the mark on the basis that:

- (1) The registered mark has been abandoned;
- (2) The registered mark has not been used by the registrant in accordance with the declaration either in this State or elsewhere in the United States for a period of three hundred sixty-five consecutive days and has not been registered in the name of the registrant in the United States Patent and Trademark Office;
- (3) The registration was granted improperly;
- (4) The registration was obtained fraudulently;
- (5) The registered mark is or has become the generic name for the goods or services, or a portion thereof, for which it has been registered; or
- (6) The registered mark is so similar, as to be likely to cause confusion or mistake or to deceive, to a mark registered by another person in the United States Patent and Trademark Office prior to the date of filing the application for registration under this part; provided that if a registrant proves that the registrant is the owner of a concurrent registration of a mark registered in the United States Patent and Trademark Office that covers an area including this State, the registration shall not be revoked for such an area.

The petition shall set forth facts in support of the petitioner's ownership of the mark and the claim for revocation.

(b) The petitioner, at the petitioner's expense, shall notify the registrant of the hearing in the manner prescribed by the director and section 91-9.5, and the registrant shall be given the opportunity of a full hearing in accordance with chapter 91.

(c) After granting an opportunity for hearing to the petitioner and the registrant, the director shall grant or deny the petition for revocation, as the facts shall warrant. [L 2003, c 124, §4]

§482-29 Classification. The director to the extent practical shall establish a classification of goods and services corresponding to the classification adopted by the United States Patent and Trademark Office for convenience of administration of this part, but not to limit or extend the applicant's or registrant's rights, and a single application for registration of a mark shall be submitted for each appropriate class and such goods upon which or each service with which the mark is actually being used, together with the application fee. [L 2001, c 15, pt of §1; am L 2003, c 124, §98]

§482-30 Fraudulent registration. Any person who knowingly makes a false or fraudulent representation or declaration in registration documents filed with the director shall be liable for all damages sustained as a result of the registration documents as determined by a court of competent jurisdiction. [L 2001, c 15, pt of §1]

§482-31 Infringement. Subject to section 482-35, any person who:

(1) Uses, without the consent of the registrant, any reproduction, counterfeit, copy, or colorable imitation of a mark registered under this part in connection with the sale, distribution, offering for sale, or advertising of any goods or services on or in 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

(2) Reproduces, counterfeits, copies, or colorably imitates a mark registered under this part and applies such reproduction, counterfeit, copy, or colorable imitation to labels, signs, prints, packages, wrappers, receptacles, or advertisements intended to be used on or in connection with the sale or other distribution in this State of such goods or services;

shall be liable in a civil action by the registrant for any and all of the damages and remedies provided in section 482-33; provided that under paragraph (2) the registrant shall not be entitled to recover profits or damages unless the acts have been committed with the intent to cause confusion, mistake, or to deceive. [L 2001, c 15, pt of §1]

§482-32 Injury to business reputation; dilution. (a) The owner of a mark which is famous in this State shall be entitled, subject to the principles of equity and upon such terms as a court deems reasonable, to an injunction against another person's commercial use of a mark or trade name, if the use begins after the mark has become famous and causes dilution of the distinctive quality of the famous mark, and to obtain such other relief as provided in this part. In determining whether a mark is distinctive and famous, a court may consider but shall not be limited to factors such as:

- (1) The degree of inherent or acquired distinctiveness of the mark in this State;
- (2) The duration and extent of use of the mark in connection with the goods and services with which the mark is used;
- (3) The duration and extent of advertising and publicity of the mark in this State;
- (4) The geographical extent of the trading area in which the mark is used;
- (5) The channels of trade for the goods or services with which the mark is used;
- (6) The degree of recognition of the mark in the trading areas and channels of trade in this State used by the owner of the mark and the person against whom the injunction is sought;
- (7) The nature and extent of the use of the same or a similar mark by third parties; and
- (8) Whether the mark is registered in this State, or federally under the Act of March 3, 1881, or under the Act of February 20, 1905, or on the principal register.

(b) In any action brought under this section, the owner of a famous mark shall be entitled only to injunctive relief in this State, unless the person against whom the injunctive relief is sought wilfully intended to trade on the owner's reputation or to cause dilution of the famous mark. If wilful intent is proven, the owner shall also be entitled to the remedies set forth in this chapter, subject to the discretion of the court and the principles of equity.

(c) The fair use of a famous mark by another person in comparative commercial advertising or promotion to identify the competing goods or services of the owner of the famous mark, the noncommercial use of the mark, and all forms of news reporting and news commentary shall not be actionable under this section. [L 2001, c 15, pt of §1]

§482-33 Remedies. (a) The owner of a mark registered under this part may proceed by suit to enjoin the manufacture, use, display, or sale of any counterfeits or imitations of the mark, and any court of competent jurisdiction may grant injunctions to restrain such manufacture, use, display, or sale as the court deems just and reasonable, and may require the defendants to pay the owner all profits derived from and all damages suffered by reason of such wrongful manufacture, use, display, or sale; and the court may also order that any counterfeits or imitations in the possession or under the control of any defendant in the case be delivered to an officer of the court, or to the owner, to be destroyed. The court, in its discretion, may enter judgment for an amount not to exceed three times the lost profits and damages incurred by the owner, and award reasonable attorneys' fees to the owner when the court finds that the defendants committed the wrongful acts knowingly or in bad faith.

(b) The enumeration of any right or remedy under this part shall not adversely affect a registrant's right to pursue criminal penalties under other laws of this State. [L 2001, c 15, pt of §1]

§482-34 Forum for actions regarding registration; service on out of state registrants. (a) An action to require cancellation of a mark registered under this part shall be brought in circuit court. In an action for cancellation, the director shall not be made a party to the proceeding but shall be notified of the filing of the complaint by the clerk of the court in which it is filed and shall have the right to intervene in the action.

(b) In any action brought against a registrant that is a nonresident of this State, service may be effected pursuant to sections 634-35 and 634-36. [L 2001, c 15, pt of §1]

§482-35 Common law rights. Nothing herein shall adversely affect the rights or the enforcement of rights in marks acquired in good faith at any time at common law. [L 2001, c 15, pt of §1]

§482-36 Fees. The application fee to register a mark shall be \$50 for each class of goods or services. A special handling fee of \$20 for expediting the registration of a mark shall be assessed by the director for each class of goods or services. All special handling fees shall be credited to the compliance resolution fund established under section 26-9(o). Unless otherwise specified by the director, these fees shall not be refundable. [L 2001, c 15, pt of §1; am L 2003, c 124, §99]

§482-37 Severability. If any provision of this part is deemed to be invalid, the remaining provisions of this chapter shall continue to be effective. [L 2001, c 15, pt of §1]