

STATE OF OKLAHOMA

2nd Session of the 43rd Legislature (1992)

SENATE BILL NO. 777

BY: RUBOTTOM

AS INTRODUCED

AN ACT RELATING TO TRADEMARKS AND LABELS; AMENDING 78

O.S. 1991, SECTION 31, WHICH RELATES TO
INFRINGEMENT ON TRADEMARK; CLARIFYING LANGUAGE;
CREATING CAUSE OF ACTION FOR DILUTION OF CERTAIN
FAMOUS MARK AND PROVIDING REMEDIES; STATING FACTORS
TO BE CONSIDERED BY COURT IN DETERMINING IF MARK IS
FAMOUS; PROVIDING ADDITIONAL REMEDIES IF WILFUL
INTENT IS PROVEN; BARRING CERTAIN ACTION UNDER
CERTAIN CONDITION; STATING USES NOT CONSIDERED TO
DILUTE MARK; AND PROVIDING AN EFFECTIVE DATE.

BE IT ENACTED BY THE PEOPLE OF THE STATE OF OKLAHOMA:

SECTION 1. AMENDATORY 78 O.S. 1991, Section 31, is
amended to read as follows:

Section 31. A. Subject to the provisions of Section ~~13~~ hereof
33 of this title, any person who shall:

~~(a) use~~ 1. Use, without the consent of the registrant, any
reproduction, counterfeit, copy~~r~~ or colorable imitation of a
trademark registered under ~~this act~~ Section 21 et seq. of this title
in connection with the sale, offering for sale~~r~~ or advertising of

any goods 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

~~(b) reproduce~~ 2. Reproduce, counterfeit, copy or colorably imitate any such trademark and apply 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;

shall be liable to a civil action by the owner of such registered trademark for any or all of the remedies provided in Section ~~12~~ hereof 32 of this title, except that under ~~subsection (b) hereof~~ paragraph 2 of this subsection the registrant shall not be entitled to recover profits or damages unless the acts have been committed with knowledge that such trademark is intended to be used to cause confusion or mistake or to deceive.

B. 1. The owner of a famous mark registered and in good standing on the principal register of the United States Trademark Office shall be entitled, subject to the principles of equity, taking into account, among other things, the good faith use of an individual's name or an indication of geographic origin, to an injunction against another person's use in commerce of a mark, commencing after the registrant's mark becomes famous, which causes dilution of the distinctive quality of the registrant's mark, and to obtain such other relief as is provided for in this subsection. In determining whether a mark is famous and has distinctive quality, a court shall weigh the following and other relevant factors:

- a. whether the mark is inherently distinctive or has become distinctive through substantially exclusive and continuous use,
- b. whether the duration and extent of use of the mark are substantial,

- c. whether the duration and extent of advertising and publicity of the mark are substantial,
- d. whether the geographic extent of the trading area in which the mark is used is substantial,
- e. whether the mark has substantial renown in its and the other person's trading area and channels of trade, and
- f. whether the same or similar marks are being used substantially by third parties.

2. The registrant shall be entitled only to injunctive relief in an action brought under this subsection, unless the subsequent user willfully intended to trade on the registrant's reputation or to cause dilution of the registrant's mark. If such wilful intent is proven, the registrant shall also be entitled to the remedies set forth in Section 32 of this title, subject to the discretion of the court and the principles of equity.

3. Ownership of a valid registration on the principal register of the United States Trademark Office shall be a complete bar to an action brought by another person under this subsection.

4. Notwithstanding paragraph 2 of this subsection, the following uses shall not be considered to dilute a mark:

- a. comparative advertising, product evaluation, editorial comment or political statement, or
- b. parody or satire when used in noncommercial situations.

SECTION 2. This act shall become effective September 1, 1992.

43-2-1612

JY