

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

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8 SYNOPSIS: The current Alabama trademark statute was
9 enacted in 1980 and last amended in 1988.

10 This bill would revise the current law to
11 redefine terms; would provide for renewal of
12 registration of a mark; would adopt the U.S. Patent
13 and Trademark Office classifications of goods and
14 services; would provide additional remedies when
15 dilution of a mark occurs; would increase the
16 damages for a trademark violation; and would allow
17 reasonable attorney fees.

18
19 A BILL
20 TO BE ENTITLED
21 AN ACT
22

23 To amend Sections 8-12-6, 8-12-10, 8-12-14, 8-12-17,
24 and 8-12-18 of the Code of Alabama 1975; to provide for the
25 registration and protection of trademarks; to define certain
26 terms; to provide for the renewal of registration of marks; to
27 adopt the U.S. Patent and Trademark Office classifications of

1 goods and services; to provide for additional remedies when a
2 dilution of a mark occurs; to increase the damages for a
3 trademark violation; and to allow for attorney fees.

4 BE IT ENACTED BY THE LEGISLATURE OF ALABAMA:

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

8 "§8-12-6.

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

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

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

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

19 "b. Actual or likely confusion, mistake, or
20 deception, or

21 "c. Actual economic injury.

22 "(3) DILUTION BY BLURRING. The association arising
23 from the similarity between a mark and a famous mark that
24 impairs the distinctiveness of the famous mark.

25 "(4) DILUTION BY TARNISHMENT. The association
26 arising from the similarity between a mark and a famous mark
27 that harms the reputation of the famous mark.

1 "~~(2)~~(5) MARK. Any trade name, trademark, or service
2 mark entitled to registration under this article whether
3 registered or not.

4 "~~(3)~~(6) PERSON. Any individual, firm, partnership,
5 corporation, association, union, or other organization.

6 "~~(4)~~(7) REGISTRANT. The person to whom the
7 registration of a mark under this article is issued, his legal
8 representative, successors, or assigns.

9 "~~(5)~~(8) SERVICE MARK. Any word, name, symbol,
10 character, or device, or any combination thereof and the
11 distinctive feature of radio, television, or other advertising
12 adopted and used by a person to identify services rendered or
13 offered by him and to distinguish them from the services of
14 others.

15 "~~(6)~~(9) TRADEMARK. Any word, name, symbol,
16 character, design, drawing, or device, or any combination
17 thereof adopted and used by a person to identify goods made or
18 sold by him and to distinguish them from goods made or sold by
19 others.

20 "~~(7)~~(10) TRADE NAME. A word, name, symbol,
21 character, design, drawing, device, or any combination thereof
22 adopted and used by a person to identify his business
23 (including vocation, occupation, or profession), and
24 distinguish it from the business of others.

25 "~~(8)~~(11) USED. A mark shall be deemed to be "used"
26 in this state:

1 "a. On goods or their containers or the displays
2 associated therewith or on the tags or labels affixed thereto
3 when such goods are sold or otherwise distributed in the
4 state;

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

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

10 "§8-12-10.

11 "(a) Registration of a mark under this article shall
12 be effective for a term of ~~10~~ five years from the date of
13 registration and, if the mark is then still in use, upon
14 application filed within six months prior to the expiration of
15 such term, on a form to be furnished by the Secretary of
16 State, the registration may be renewed for a like term. A
17 renewal fee of \$30, payable to the Secretary of State, shall
18 accompany the application for renewal of the registration.

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

21 "(c) The Secretary of State shall notify registrants
22 of marks under this article of the necessity of renewal within
23 the year next preceding the expiration of ~~10~~ five years from
24 the date of registration, and within the year next preceding
25 the expiration of five years from the date of any renewal of a
26 registration, by writing to the last known address (physical,
27 electronic, or otherwise) of the registrants.

1 ~~"(d) Any registration in the office of Secretary of~~
2 ~~State on January 1, 1981, shall expire one year after January~~
3 ~~1, 1981, unless registered in accordance with the provisions~~
4 ~~of this article.~~

5 "(d) Any registration in force on the effective date
6 of this amendatory act shall continue in full force and effect
7 for the unexpired term thereof and may be renewed by filing an
8 application for renewal with the Secretary of State complying
9 with the requirements of the Secretary of State and paying the
10 renewal fee therefor within six months prior to the expiration
11 of the registration.

12 "(e) All applications for renewals under this
13 article, whether of registrations made under this article or
14 of registrations effected under any prior act, shall include a
15 statement that the mark is still in use in this state.

16 ~~"(f) The Secretary of State shall, within six months~~
17 ~~after January 1, 1981, notify all existing registrants of~~
18 ~~marks which were filed in the Secretary of State's office~~
19 ~~under previous acts or by informal registration, of the date~~
20 ~~of expiration of such registrations unless registered in~~
21 ~~accordance with the provisions of this article, by writing to~~
22 ~~the last known address of the registrants.~~

23 "§8-12-14.

24 "(a) The following general classes of goods,
25 services, and business are established for convenience of
26 administration of this article, but not to limit or extend the
27 applicant's or registrant's rights. ~~A~~ , and a single

1 application for registration of a mark may include any or all
2 goods upon which, or services or business with which, the mark
3 is actually being used ~~comprised in a single class, but in no~~
4 ~~event shall a single application include when a single~~
5 ~~application include~~ indicating the appropriate class or
6 classes of goods, services or business. When a single
7 application includes goods, services, or business upon which
8 ~~the mark is being used~~ which fall within different multiple
9 classes of goods, services, or business, the Secretary of
10 State may require payment of a fee for each class.

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

12 ~~"Goods:~~

13 ~~"(1) Chemical products used in industry, science,~~
14 ~~photography, agriculture, horticulture, forestry; artificial~~
15 ~~and synthetic resins; plastics in the form of powders,~~
16 ~~liquids, or pastes, for industrial use; manures (natural and~~
17 ~~artificial); fire extinguishing compositions; tempering~~
18 ~~substances and chemical preparations for soldering; chemical~~
19 ~~substances for preserving foodstuffs; tanning substances;~~
20 ~~adhesive substances used in industry.~~

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

25 ~~"(3) Bleaching preparations and other substances for~~
26 ~~laundry use; cleaning, polishing, scouring, and abrasive~~

1 ~~preparations; soaps; perfumery, essential oils, cosmetics,~~
2 ~~hair lotions; dentifrices.~~

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

7 ~~"(5) Pharmaceutical, veterinary, and sanitary~~
8 ~~substances; infants' and invalids' foods; plasters, material~~
9 ~~for bandaging; material for stopping teeth, dental wax,~~
10 ~~disinfectants, preparations for killing weeds and destroying~~
11 ~~vermin.~~

12 ~~"(6) Unwrought and partly wrought common metals and~~
13 ~~their alloys; anchors, anvils, bells, rolled and cast building~~
14 ~~materials; rails and other metallic materials for railway~~
15 ~~tracks; chains (except driving chains for vehicles); cables~~
16 ~~and wires (nonelectric); locksmiths' work; metallic pipes and~~
17 ~~tubes; safes and cash boxes; steel balls; horseshoes; nails~~
18 ~~and screws; other goods in nonprecious metal not included in~~
19 ~~other classes; ores.~~

20 ~~"(7) Machines and machine tools; motors (except for~~
21 ~~land vehicles); machine couplings and belting (except for land~~
22 ~~vehicles); large size agricultural implements; incubators.~~

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

25 ~~"(9) Scientific, nautical, surveying, and electrical~~
26 ~~apparatus and instruments (including wireless), photographic,~~
27 ~~cinematographic, optical, weighing, measuring, signalling,~~

1 ~~checking (supervision), lifesaving, and teaching apparatus and~~
2 ~~instruments; coin or counter-freed apparatus; talking~~
3 ~~machines; cash registers; calculating machines; fire~~
4 ~~extinguishing apparatus.~~

5 ~~"(10) Surgical, medical, dental, and veterinary~~
6 ~~instruments and apparatus (including artificial limbs, eyes,~~
7 ~~and teeth).~~

8 ~~"(11) Installations for lighting, heating, steam~~
9 ~~generating, cooking, refrigerating, drying, ventilating, water~~
10 ~~supply, and sanitary purposes.~~

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

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

15 ~~"(14) Precious metals and their alloys and goods in~~
16 ~~precious metals or coated therewith (except cutlery, forks,~~
17 ~~and spoons); jewelry, precious stones, horological and other~~
18 ~~chronometric instruments.~~

19 ~~"(15) Musical instruments (other than talking~~
20 ~~machines and wireless apparatus).~~

21 ~~"(16) Paper and paper articles, cardboard and~~
22 ~~cardboard articles; printed matter, newspaper and periodicals,~~
23 ~~books; bookbinding material; photographs; stationery, adhesive~~
24 ~~materials (stationery); artists' materials; paintbrushes;~~
25 ~~typewriters and office requisites (other than furniture);~~
26 ~~instructional and teaching material (other than apparatus);~~
27 ~~playing cards; printers' type and cliches (stereotype).~~

1 ~~"(17) Gutta-percha, india rubber, balata, and~~
2 ~~substitutes, articles made from these substances and not~~
3 ~~included in other classes; plastics in the form of sheets,~~
4 ~~blocks, and rods, being for use in manufacture; materials for~~
5 ~~packing, stopping, or insulating; asbestos, mica, and their~~
6 ~~products; hose pipes (nonmetallic).~~

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

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

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

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

1 ~~"(22) Ropes, string, nets, tents, awnings,~~
2 ~~taraulins, sails, sacks; padding and stuffing materials~~
3 ~~(hair, kapok, feathers, seaweed, etc.); raw fibrous textile~~
4 ~~materials.~~

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

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

8 ~~"(25) Clothing, including boots, shoes, and~~
9 ~~slippers.~~

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

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

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

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

23 ~~"(30) Coffee, tea, cocoa, sugar, rice, tapioca,~~
24 ~~sago, coffee substitutes; flour, and preparations made from~~
25 ~~cereals; bread, biscuits, cakes, pastry, and confectionary,~~
26 ~~ices; honey, treacle; yeast, baking powder; salt, mustard,~~
27 ~~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.~~

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

27 ~~"(43)(1) Agriculture, forestry, and fisheries.~~

1 "~~(44)~~(2) Mining.

2 "~~(45)~~(3) Construction.

3 "~~(46)~~(4) Manufacturing, nondurable goods.

4 "~~(47)~~(5) Manufacturing, durable goods.

5 "~~(48)~~(6) Transportation, communications, and other
6 public utilities.

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

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

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

12 "~~(52)~~(10) Retail trade - department, variety,
13 miscellaneous general merchandise, grocery, dairy products,
14 retail bakery, and food stores.

15 "~~(53)~~(11) Retail trade - motor vehicle dealers, auto
16 and home supply stores, gasoline service stations, and
17 miscellaneous vehicle dealers.

18 "~~(54)~~(12) Retail trade - apparel, accessory, and
19 shoe stores.

20 "~~(55)~~(13) Retail trade - furniture, home
21 furnishings, household appliances, T.V. and radio stores.

22 "~~(56)~~(14) Retail trade - eating and drinking places,
23 drugstores, and liquor stores.

24 "~~(57)~~(15) Retail trade - sporting goods, bicycles,
25 and hobby stores.

26 "~~(58)~~(16) Retail trade - book, stationery, jewelry,
27 sewing, needlework, and piece-goods stores.

1 "~~(59)~~(17) Retail trade - mail-order houses, vending
2 machine operators, and direct selling establishments, fuel and
3 ice dealers, and retail florists.

4 "~~(60)~~(18) Retail trade - miscellaneous.

5 "~~(61)~~(19) Finance, insurance, and real estate.

6 "~~(62)~~(20) Business and repair services.

7 "~~(63)~~(21) Personal services.

8 "~~(64)~~(22) Entertainment and recreation services.

9 "~~(65)~~(23) Professional and related services.

10 "~~(66)~~(24) Public administration.

11 "~~(67)~~(25) Miscellaneous.

12 "§8-12-17.

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

20 "(a) Subject to the principles of equity, the owner
21 of a mark which is famous and distinctive, inherently or
22 through acquired distinctiveness, in this state shall be
23 entitled to an injunction against another person's commercial
24 use of a mark, if such use begins after the famous mark has
25 become famous and is likely to cause dilution of the famous
26 mark, and to obtain such other relief as is provided in this
27 section.

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

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

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

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

14 "(4) Whether the mark is the subject of a state
15 registration in this state, or a federal registration under
16 the Act of March 3, 1881, or under the Act of February 20,
17 1905, or on the principal register under the Trademark Act of
18 1946, as amended.

19 "(c) In an action brought under this section, the
20 owner of a famous mark shall be entitled to injunctive relief
21 throughout the geographic area in which the mark is found to
22 have become famous prior to commencement of the junior use,
23 but not beyond the borders of this state. If the person
24 against whom the injunctive relief is sought willfully
25 intended to cause dilution of the famous mark, then the owner
26 shall also be entitled to the remedies set forth in this

1 chapter, subject to the discretion of the court and the
2 principles of equity.

3 "(d) The following shall not be actionable under
4 this section:

5 "(1) Any fair use, including a nominative or
6 descriptive fair use, or facilitation of such fair use, of a
7 famous mark by another person other than as a designation of
8 source for the person's own goods or services or business,
9 including use in connection with:

10 "a. Advertising or promotion that permits consumers
11 to compare goods or services or businesses; or

12 "b. Identifying and parodying, criticizing, or
13 commenting upon the famous mark owner or the goods or services
14 or business of the famous mark owner.

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

17 "§8-12-18.

18 "(a) Any owner of a mark registered under this
19 article may proceed by suit to enjoin the manufacture, use,
20 display, or sale of any counterfeits or imitations thereof and
21 any court of competent jurisdiction may grant injunctions to
22 restrain such manufacture, use, display, or sale as may be by
23 the said court deemed just and reasonable, and may require the
24 defendants to pay to such owner all profits derived from
25 and/or all damages suffered by reason of such wrongful
26 manufacture, use, display, or sale, and to pay the costs of
27 the action; ~~and such.~~ In assessing profits, the owner shall be

1 required to prove defendant's sales only; defendant must prove
2 all elements of cost or deduction claimed. The court may also
3 order that any such counterfeits or imitations in the
4 possession or under the control of any defendant in such case,
5 be delivered to an officer of the court, or to the
6 complainant, to be destroyed.

7 "(b) In assessing damages the court may enter
8 judgment, according to the circumstances of the case, for any
9 sum above the amount found as actual damages, up to a trebling
10 of such amount. If the court shall find that the amount of the
11 recovery based on profits is either inadequate or excessive,
12 the court may in its discretion enter judgment for such sum as
13 the court shall find to be just, according to the
14 circumstances of the case. Such sum in either of the above
15 circumstances shall constitute compensation and not a penalty.

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

18 "(1) To a prevailing owner in such cases when the
19 court finds the defendant willfully intended infringement or
20 dilution.

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

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

26 Section 2. This act shall become effective January
27 1, 2011.

