

# U.S. State Trademark and Unfair Competition Law

## OUTLINE AND EXPLANATORY TEXT

In each entry, summaries of the applicable law of the state are organized under the headings below. Many of the headings are self-explanatory; where helpful, additional explanatory text is provided here.

Appendix 5 contains a chart that provides quick access to basic information relevant to state trademark registration provisions of all states.

### A. State Trademark Registration Statute

1. Code Section  
State registration of trademarks.
2. Model Act Provisions  
Adoption of Model Act. Deviations from it, e.g., requirements of representation that no conflicting mark is registered in the U.S. Patent and Trademark Office.
3. Administrator  
Name, title, address and telephone number of the agency or person administering the state trademark registration statute.
4. Procedure for Applying for Registration
  - a. Forms  
Use of required forms.
  - b. Number of Copies  
How many copies of the registration form must be filed.
  - c. Fee  
Amount prescribed by statute or rule.
  - d. Specimens  
Number required; use of photocopies.
  - e. Drawing  
Whether special drawing is required.
5. Intent to Use Provision  
Whether state has an intent to use provision. Procedure and fee for reserving mark.
6. Classification  
Classification system used. Whether prescribed by statute.
7. Search Prior to Application  
If search is conducted prior to the filing of an application.
8. Search Prior to Registration  
If search is conducted prior to issuance of registration. Files and records searched (e.g., trademark registrations only; corporate names; others) and how the records are searched (by mark regardless of class; by class; for identical marks only).
9. Doing Business Requirement  
Whether doing business is required for registration.
10. Types of Marks Registrable  
Trademark, service mark, certification mark, collective mark.
11. Restrictions  
Words or terms restricted or prohibited under the statute, e.g., name of an individual, terms denoting governmental association, etc.
12. Use in State  
Whether prerequisite for registration.
13. Term of Registration  
Length of time registration is in force.
14. Renewal  
Procedure and specimens required.
15. Renewal Forms  
Separate or combined renewal and application form.
16. Other Forms  
As available.
17. Post-Registration Forms  
Use of any or all forms optional or mandatory.
18. Fees After Registration  
Fees required for actions after registration (renewal, assignment, cancellation, other) prescribed by statute or rule.
19. Use Requirement for Renewal  
Use required and provision for excusable non-use.
20. Presumptions
  - a. In Favor of Registrant  
Created by registration.

- b. b. Presumption of Doing Business  
Requirement to qualify as a foreign corporation or for purposes of personal jurisdiction.
- 21. Remedies for Infringement  
Injunctive relief; types of monetary relief available (damages, loss/profit, profits, accounting, injunction, attorneys' fees, costs, other); other remedies.
- 22. Persons Entitled to Sue  
Who may sue for infringement.

## B. Dilution

- 1. Code Section  
Statutory provision; language of Section 12 of the Model State Trademark Bill; other language used.
- 2. Judicially Created Dilution Doctrine  
Common law doctrine created by case law.
- 3. Tarnishment  
"Injury to business reputation" requirement.
- 4. Likelihood of Confusion  
Whether required.
- 5. Competition Between the Parties  
Applicable only to noncompetitive goods or services or also where the parties compete.
- 6. Fame or Distinctiveness  
Requirement of mark to be "famous" or "distinctive."
- 7. Remedies  
Injunction; damages or accounting; costs; attorney's fees; other.
- 8. Leading Cases
- 9. Extraterritorial Effect  
Court rulings on whether injunction under the state statute may have extraterritorial effect.
- 10. Preemption Cases  
Cases addressing preemption by the Lanham Act.

## C. Unfair Business Practices Acts (Little FTC Acts)

- 1. Code Section
- 2. Scope
- 3. Prohibited Activities Broad language of Section 5 of FTC Act prohibiting "unfair methods of competition or unfair deceptive trade practices"; or "all forms of fraudulent, deceptive and unfair acts"; or itemization of specific deceptive trade practices as in UDTPA with catch-all clause modeled after Section 5 of FTC Act; or one of the above together with a prohibition on unconscionable consumer sales practices based on the Uniform Consumer Sales Practices Act; or other variation.
- 4. Remedies
  - a. State Administrative Enforcement  
Action for restitution by administrator or enforcement official (e.g., consumer protection agency or attorney general) on behalf of aggrieved persons.
  - b. Criminal Enforcement  
Penalties.
  - c. Civil Penalties  
Administrative action.
  - d. Private Actions and Remedies  
Minimum dollar recoveries; double, treble and/or punitive damages; accounting; injunctive relief; costs and attorneys' fees; mandatory or permissive.
  - e. Class Actions  
By state and/or aggrieved persons.
  - f. Notice  
Prerequisite to suit, e.g., thirty-day demand for restitution; notice given by letter or included in complaint.
  - g. Standing  
Actions by competitors or limited to state or consumers.
  - h. Consumer Products  
Limitations to and definition of consumer products.
  - i. Jurisdiction of Courts
  - j. Rules
  - k. Administrative Investigative Authority  
Power to issue complaint, subpoenas, civil investigative demands, cease and desist order, and/ or to seek court injunctions.
- 5. Administrator
- 6. Leading Cases

## D. Uniform Deceptive Trade Practices Act

- 1. State Statute  
Adoption of UDTPA or a variation thereof.
- 2. Standing  
Competitors; consumers; public agencies; class actions allowed; other.
- 3. Remedies  
Injunctions; monetary relief; attorney's fees; costs; other.
- 4. Standard for Granting Relief  
Remedies as discretionary or mandatory. Whether finding of willfulness, intent or other aggravation is required for an award of attorney's fees or other relief.
- 5. Leading Cases

## E. Trademark Counterfeiting

- 1. Specific Statutes  
Statutes separate from state trademark, uniform deceptive trade practices, or unfair business practices acts specifically directed to preventing counterfeiting of trademarked goods.
- 2. Definition

- a. Registration Requirement  
State; federal; other states covered; unregistered marks.
- b. Identity of Type of Goods  
Requirement of being substantially identical in visual appearance.
- 3. Who Can Sue  
Mark owner; public administrative agency; public criminal prosecutor; purchasers, customers or consumers; individually or by class action.
- 4. Remedies
- 5. Civil Ex parte seizure; injunctive relief; actual damages; punitive damages; multiple damages; statutory damages (e.g., specific amount per infringing item); seizure and destruction of goods or materials for reproducing mark; award of infringer's profits; attorneys' fees; costs; others.
- 6. Criminal  
Maximum sentence; maximum fine; other.
- 7. Protective Provisions for Defendants  
Protective orders for business records; attorney's fees, costs or damages for wrongful seizure; other.

## F. False Advertising

- 1. Statute  
Separate statute (apart from trademark registration anti-dilution, uniform deceptive trade practices or unfair business practices acts) specifically addressed to false advertising or false representations to the public in the sale of goods.
- 2. Prohibited Practices
- 3. Limitations  
E.g., sale of consumer goods.
- 4. Who Can Sue  
Public agency; consumers; competitors.
- 5. Remedies  
Injunction; actual damages; multiple or punitive damages; attorney's fees and costs; other.
- 6. Leading Cases

## G. Corporate Name Reservation Prior to Incorporation

- 1. Statute
- 2. Reservation
  - a. Time Period.
  - b. Renewal.
  - c. Fee.
  - d. Prerequisite to Incorporation.
- 3. Conflicting Names  
Provision for qualification of foreign corporation in the event of conflict with domestic or other corporation qualified to do business under same name.
- 4. Restrictions on Use of "Corp." and Similar Terms
- 5. Required or Authorized Use of "Corp." or Similar Term
- 6. Search Provision Re conflict with corporate names previously registered.
- 7. Policy Regarding Identical Words Policy of state administrator with respect to identical words in corporate names.
- 8. Substantive Rights  
Substantive rights that arise under state law as to trademark or service mark protection as a result of incorporating under a specific name.
- 9. Prohibited Terms  
Prohibitions on any specific types of words in corporate names (e.g., army, navy, U.S., federal, state).
- 10. Administrative Agency  
Name, address and telephone number of agency or person responsible for corporate registrations.
- 11. Forms
- 12. Fees

## H. Trade Name Registration (Fictitious Name Statutes)

- 1. Purpose  
E.g., to identify the owner of a proprietorship, partnership or corporation operating under an assumed name.
- 2. Entities Required to File  
Individuals, partnerships, joint ventures, trusts and corporations operating under assumed name.
- 3. Limited Partnerships  
Whether limited partnerships which have filed under state limited partnership act are required to register assumed names.
- 4. Where to File  
With clerk of court, or secretary of state, or special registrar, in county of principal place of business, or all counties in which business is conducted under assumed name, or only with central state registration office. The name, address and telephone number of the responsible person or agency representing a centralized file.
- 5. Fees  
Amount and to whom payable.
- 6. Publication  
Requirements of length of time and placement.
- 7. Foreign Corporations  
Applicability to, with or without place of business in the state.
- 8. Civil Penalties Upon failure to file, e.g., inability to file suit, fines, etc.
- 9. Criminal Penalties Upon failure to file, e.g., misdemeanor.
- 10. Certificate
- 11. Renewal or Deletion
- 12. Substantive Rights  
As created by the use of the name.
- 13. Search  
Means of, prior to registration.
- 14. Agent Required for service of process designated.
- 15. Mail Registration

## **I. State Statutory and/or Common Law Unfair Competition or Passing Off Provisions**

1. Statutory Section  
General state statute prohibiting unfair competition, imitation of (unregistered) names and marks or passing off apart from state trademark, anti-dilution, deceptive trade practices or unfair business practices statutes.
2. Derivation  
Derivation of the statute, if known, e.g., codification of common law or state equity practice.
3. Intent  
Whether intent to deceive is an element of a cause of action. What showing is required, e.g., knowledge of prior use by another; material misrepresentation, etc.
4. Defenses  
Partial or complete
5. Remedies  
Injunction; actual damages; profits; punitive damages; attorneys' fees and costs; other.
6. Common Law Action for Unfair Competition State court recognition of common law action for un-fair competition, imitation of (unregistered) trade names and trademarks or passing off
7. Elements of a Common Law Cause of Action
8. Remedies As available for common law infringement.
9. Leading Cases

## **J. Statutes of Special Application and Personal Name Statutes**

1. Special Statutory Sections  
Statutes which apply to particular industries or particular types of marks e.g., names of unions, eleemosynary organizations, wineries, dairy industry, etc. Activities prohibited. Remedies available.
2. Use of Personal Name  
Statutes (apart from provisions of trade mark registration statute) prohibiting use of name of living or deceased individual for commercial purposes. Whether rights created survive the individual's death if name commercially exploited in life; if name not commercially exploited in life. Civil and/ or criminal penalties provided in the statute. Leading cases.

## **K. Right of Publicity**

1. Recognition  
By courts of the state (or federal courts construing state law) of common law right of publicity.
2. Applicable Statute  
State statute which is either specifically concerned with right of publicity or has been construed to encompass such a right.
3. Elements of Cause of Action
4. Survivability Whether right of publicity survives the death of the owner if exploited during the owner's life; if not exploited during the owner's life .
5. Term of Survival  
Number of years that such rights survive.
6. Secondary Meaning Requirement
7. Remedies  
Injunction; damages; punitive damages; other.
8. Limitations  
Upon enforcement of rights of publicity.

## **L. Criminal Statutes**

1. Statutory Provision  
Unauthorized use of trade names or trademarks. Practices prohibited. Maximum penalties: fines; imprisonment; offense as misdemeanor or felony. References to violations of any civil statutory sections.

## **M. Trade Disparagement or Trade Libel**

1. Statute or Common Law Doctrine  
State statute or common law doctrine prohibiting trade libel or trade disparagement.
2. Elements of Cause of Action  
E.g., intent, knowing falsity special damages.
3. Presumptions
4. Remedies  
As prescribed or through applied general tort damages principles.
5. Punitive Damages
6. Single Publication Applicable rule.  
Repetition as constituting an additional offense.
7. Defenses Partial or complete.

## **N. Franchising or Business Opportunity Statutes**

1. Statute  
Governing the sale or offering for sale of franchises or business opportunities.
2. Registration  
Registration or filing with a state agency required under the act. Nature of the filing and identity of the agency.
3. Forms
4. Fees
5. Approval Procedure  
Examination or approval procedure conducted.
6. Bond  
Posting of a bond or other security required.
7. Waiting Period For review.
8. Penalties

- For non-filing or non-disclosure.
- 9. Required Disclosures
- 10. Standing to Sue
  - Purchasers; state agency.
- 11. Remedies
  - For non-disclosure, false representations, failure to perform in accordance with representations or other violations.
- 12. Contract Requirements
  - Provisions governing contracts .
- 13. Exceptions
  - From registration or disclosure requirements.
- 14. Registered Marks Exception
  - Exceptions for licenses of registered trademarks or service marks. Whether state registration is sufficient.
- 15. Federal Registration
  - Required either by statute or administrative procedure to qualify for statutory exemption.
- 16. Use of UFOC
  - Whether statute or related regulations governing franchise sales permit the use of the Uniform Franchise Offering Circular (UFOC). Variations required or allowed.
- 17. Other Forms
  - Formats for the offering statement (including the FTC format) required or permitted.
- 18. Amendment
  - Procedure for amending filings to reflect material changes in the information contained in the offering statement.
- 19. Other Franchise Regulations
  - Areas regulated including advertising; terminations; renewals; waiting periods.
- 20. Liability of Franchisor for Torts of Franchisee
  - Whether courts have addressed the question of the extent a franchisor's or trademark licensor's liability for torts of the franchisee or licensee. State of the law and citation of leading cases.