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.
   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. 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. Judically 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
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.
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 unfair 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
   E.g., intent, knowing falsity special damages.

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.


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.