

No. 1998-73

AN ACT

HB 1480

Amending Title 54 (Names) of the Pennsylvania Consolidated Statutes, adding and changing definitions; making classifications; and providing for registrability and application for registration, duration and renewal, for cancellation for damages for fraudulent registration, for infringement, for injury to business or reputation and for remedies.

The General Assembly of the Commonwealth of Pennsylvania hereby enacts as follows:

Section 1. Sections 1102, 1103, 1111, 1112, 1114, 1116, 1121, 1123, 1124 and 1125 of Title 54 of the Pennsylvania Consolidated Statutes are amended to read:

§ 1102. Definitions.

The following words and phrases when used in this chapter shall have, unless the context clearly indicates otherwise, the meanings given to them in this section:

“Abandoned.” *A mark shall be deemed to be “abandoned” when either of the following occurs:*

(1) When its use has been discontinued with intent not to resume such use. Intent not to resume may be inferred from circumstances. Nonuse for two consecutive years shall constitute prima facie evidence of abandonment.

(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.

["Adopted and used."] A trademark shall be deemed to be “adopted and used” in this Commonwealth when it is placed in any manner on the goods or their containers or the displays associated therewith or on the tags or labels affixed thereto, and such goods are sold or otherwise distributed in this Commonwealth. A service mark shall be deemed to be “adopted and used” in this Commonwealth when it is used or displayed in the sale or advertising of services and the services are rendered in this Commonwealth.]

“Applicant.” Any person filing an application for registration of a mark under this chapter, or the legal representatives, successors or assigns of such person.

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

“Mark.” Includes any trademark or service mark entitled to registration under this chapter whether registered or not.

“Person.” *This word or any other word or term used to designate the applicant or other party entitled to a benefit or privilege or rendered liable under the provisions of this chapter to include a juristic person as well as a natural person. The term “juristic person” includes a firm, partnership, corporation, union, association or other organization capable of suing and being sued in a court of law.*

“Registrant.” Any person who registers a mark under this chapter, or the legal representatives, successors or assigns of such person.

“Service mark.” [A mark used in the sale or advertising of services to identify the services of one person and distinguish them from the services of others and includes, without limitation, the marks, names, symbols, titles, designations, slogans, character names and distinctive features of radio or other advertising used in commerce.] *Any word, name, symbol or devise 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.” Any word, name, symbol or device, or any combination thereof, [adopted and] used by a person to identify [goods produced, manufactured or sold by the person,] and [to] distinguish [them] *the goods of such person, including a unique product, from [goods produced,] those manufactured or sold by others and to indicate the source of the goods even if that source is unknown.*

“Trade name.” A word, name, symbol, device or any combination thereof used by a person to identify the business, vocation or occupation of the person and distinguish it from the business, vocation or occupation of others.

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

(1) *On 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 other sale and the goods are sold or transported in commerce in this Commonwealth.*

(2) *On services when it is used or displayed in the sale or advertising of services and the services are rendered in this Commonwealth.*

§ 1103. Classification.

The [following] general classes of goods and services [are] established by *the United States Patent and Trademark Office in accordance with the*

International Classification System are to be utilized for the purpose of administering this chapter. [The department may, by regulation, amend the classification established by this section if such amendment does not limit or extend the rights of any applicant or registrant.] An application for registration of a mark shall be limited to a single general class of goods or services. Nothing in this chapter shall be construed as limiting the registration of a mark to one general class. [The classes are as follows:

GOODS

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

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

(3) Bleaching preparations and other substances for laundry use; cleaning, polishing, scouring and abrasive preparations; soaps; perfumery, essential oils, cosmetics, hair lotions; dentifrices.

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

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

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

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

(8) Hand tools and instruments; cutlery, forks and spoons; side arms.

(9) Scientific, nautical, surveying and electrical apparatus and instruments (including wireless), photographic, cinematographic, optical, weighing, measuring, signalling, checking (supervision),

lifesaving and teaching apparatus and instruments; coin or counter-fed apparatus; talking machines; cash registers; calculating machines; fire extinguishing apparatus.

(10) Surgical, medical, dental and veterinary instruments and apparatus (including artificial limbs, eyes and teeth).

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

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

(13) Firearms; ammunition and projectiles; explosive substances; fireworks.

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

(15) Musical instruments (other than talking machines and wireless apparatus).

(16) Paper and paper articles, cardboard and cardboard articles; printed matter, newspapers and periodicals, books; bookbinding material; photographs; stationery, adhesive materials (stationery); artists' materials; paint brushes; typewriters and office requisites (other than furniture); instructional and teaching material (other than apparatus); playing cards; printers' type and clichés (stereotype).

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

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

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

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

(21) Small domestic utensils and containers (not of precious metal or coated therewith); combs and sponges; brushes (other than paint brushes); brush-making materials; instruments and material for cleaning purposes; steel wool; glassware, porcelain and earthenware, not included in other classes.

(22) Ropes, string, nets, tents, awnings, tarpaulins, sails, sacks; padding and stuffing materials (hair, capoc, feathers, seaweed, etc.); raw fibrous textile materials.

(23) Yarns, threads.

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

(25) Clothing, including boots, shoes and slippers.

(26) Lace and embroidery, ribbons and braid; buttons, press buttons, hooks and eyes, pins and needles; artificial flowers.

(27) Carpets, rugs, mats and matting; linoleums and other materials for covering floors; wall hangings (nontextile).

(28) Games and playthings; gymnastic and sporting articles (except clothing); ornaments and decorations for Christmas trees.

(29) Meat, fish, poultry and game; meat extracts; preserved, dried and cooked fruits and vegetables; jellies, jams; eggs, milk and other dairy products; edible oils and fats; preserves, pickles.

(30) Coffee, tea, cocoa, sugar, rice, tapioca, sago, coffee substitutes; flour and preparations made from cereals; bread, biscuits, cakes, pastry and confectionery, ices, honey, treacle; yeast, baking powder; salt, mustard; pepper, vinegar, sauces, spices; ice.

(31) Agricultural, horticultural and forestry products and grains not included in other classes; living animals; fresh fruits and vegetables; seeds; live plants and flowers; foodstuffs for animals, malt.

(32) Beer, ale and porter; mineral and aerated waters and other nonalcoholic drinks; syrups and other preparations for making beverages.

(33) Wines, spirits and liqueurs.

(34) Tobacco, raw or manufactured; smokers' articles; matches.

SERVICES

(35) Advertising and business.

(36) Insurance and financial.

(37) Construction and repair.

(38) Communication.

(39) Transportation and storage.

(40) Material treatment.

(41) Education and entertainment.

(42) Miscellaneous.]

§ 1111. 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 which:

(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, the Commonwealth of Pennsylvania, or of any other state or municipality, or of any foreign nation, or any simulation thereof.

(4) Consists of or comprises the name, signature or portrait **[of any identifying a particular]** living individual, except **[with his or her]** by the individual's written consent.

(5) Consists of a mark which:

(i) when **[applied to]** *used on or in connection with* the goods or services of the applicant is merely descriptive or deceptively misdescriptive of them;

(ii) when **[applied to]** *used on or in connection with* the goods or services of the applicant is primarily geographically descriptive or deceptively misdescriptive of them; or

(iii) is primarily merely a surname.

Nothing in this paragraph shall prevent the registration of a mark used in this Commonwealth by the applicant which has become distinctive of the goods or services of the applicant. The department may accept as evidence that the mark has become distinctive as **[applied to]** *used on or in connection with* the goods or services of the applicant, proof of continuous use thereof as a mark by the applicant in this Commonwealth[, or elsewhere,] for the five years **[next preceding]** before the date **[of the filing of the application for registration]** on which the claim of distinctiveness is made.

(6) Consists of or comprises a mark which so resembles a mark registered in this Commonwealth or a mark or trade name previously used in this Commonwealth by another and not abandoned, as to be likely, when **[applied to]** *used or in connection with* the goods or services of the applicant, to cause confusion or mistake or to deceive, unless it shall be proved to the satisfaction of the department that the person last applying for the registry of such mark is entitled thereto and is the owner thereof by right of prior adoption and use, in which case the date of the adoption shall determine the ownership, and shall be proved by verified statements of persons conversant with such dates. In case the department becomes satisfied after a hearing held as provided by section 1116(5) (relating to cancellation) that the person last applying for registry is entitled by priority of adoption and use in this Commonwealth to register such mark, it shall revoke the first registry thereof and, upon application and the payment of the fee, register the same in the name of such applicant.

§ 1112. Application for registration.

(a) General rule.—Subject to the limitations set forth in this chapter, any person who has adopted and used a mark in this Commonwealth may file in the department an application for registration of that mark, setting forth the following information:

(1) The name of the person applying for such registration, the residence, location or place of business of the applicant, and, if a

corporation, the jurisdiction of incorporation, *or, if a partnership, the state in which the partnership is organized and the names of the general partners.*

(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 Commonwealth by the applicant or the predecessor in **[business of the applicant]** *interest.*

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

(4.1) 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 provide full particulars with respect thereto, including the filing date and serial number of each application, the status thereof and, if any application was finally refused registration or has otherwise not resulted in a registration, the reasons therefor.

(5) Such other information necessary to the administration of this chapter as the department may specify by regulation.

(b) Facsimile.—The application shall be accompanied by a facsimile of such mark.

(b.1) Application fee.—The application shall be accompanied by the fee specified in 15 Pa.C.S. § 153(a) (relating to fee schedule).

(c) Cross reference.—See 15 Pa.C.S. § 134 (relating to docketing statement).

§ 1114. Duration and renewal.

(a) General rule.—Registration of a mark under this chapter shall be effective for a term of **[ten]** *five* years from the date of registration and, upon application for renewal filed within six months prior to the expiration of such term, the registration may be renewed for a like term *from the end of the expiring term.* A mark registration may be renewed for successive periods of **[ten]** *five* years in like manner. All applications for renewals shall include a statement that the mark is still in use in this Commonwealth~~.~~ *and include a specimen showing actual use of the mark on or in conjunction with the goods or services. Any registration in force on the date on which the amendment to this section shall become effective shall continue in full*

force and effect for the unexpired term thereof and may be renewed by filing an application of renewal in accordance with this subsection.

(b) Cross reference.—See 15 Pa.C.S. § 134 (relating to docketing statement).

§ 1116. Cancellation.

(a) General rule.—The department shall cancel from the register under this chapter:

(1) All registrations under this chapter which are [**more than ten years old and**] not renewed in accordance with this chapter.

(2) Any registration concerning which the department shall receive an application for cancellation thereof from the registrant or the assignee of record.

(3) Any registration concerning which a court of competent jurisdiction shall find:

(i) That the registered mark has been abandoned.

(ii) That the registrant is not the owner of the mark.

(iii) That the registration was granted improperly.

(iv) That the registration was obtained fraudulently.

(iv.1) That the mark is or has become the generic name for the goods or services or a portion thereof for while it has been registered.

(v) That 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 the filing of the application for registration by the registrant under this chapter or former provisions of law and not abandoned, except that if the registrant proves that the registrant is the owner of a concurrent registration of the mark in the United States Patent and Trademark Office, covering an area including this Commonwealth, the registration under this chapter shall not be cancelled.

(4) When a court of competent jurisdiction shall order cancellation of a registration on any ground.

(5) Any registration in the following circumstances:

(i) Where an applicant, by verified statement or other good and sufficient evidence, shall prove to the satisfaction of the department that the applicant is entitled by virtue of prior [**adoption and**] use to any mark theretofore registered in the department.

(ii) In the case of a corporation having filed articles of dissolution or a decree of dissolution, any person may, at any time at least three years thereafter, present a petition to the department setting forth such fact.

(iii) In the case of a person not having filed articles of dissolution or a decree of dissolution, but having discontinued or gone out of the business to which such registration is pertinent.

(iv) When a registered mark has been abandoned or discontinued for a period of at least five years subsequent to registration and such abandonment and nonuse still persists.

In all circumstances enumerated in this paragraph, any person may present a petition for cancellation to the department. The petition shall set forth the pertinent facts relative thereto, and shall contain proof of service of notice of the petition on the person in whose name the registration is recorded, and asking that such registration be cancelled. The department shall fix a time to hear the parties concerned in the matter, and shall send, by certified mail, a notice of hearing to the person in whose name such registration is recorded. If, after hearing, the department is satisfied of the truth of the facts alleged in the petition in accordance with the provisions of this paragraph, it shall cancel the registration.

(b) Cross reference.—See 15 Pa.C.S. § 134 (relating to docketing statement).

§ 1121. Damages for fraudulent registration.

Any person who shall, for himself *or herself* or on behalf of any other person, procure the filing or registration of any mark in the department under this chapter by knowingly making any false or fraudulent representation or declaration, [verbally] *orally* or in writing, or by any other fraudulent means, shall be liable to pay all damages sustained in consequence of such filing or registration, to be recovered by or on behalf of the party injured thereby in any court of competent jurisdiction.

§ 1123. Infringement.

(a) General rule.—Subject to the provisions of section 1126 (relating to common law rights), any person who shall:

(1) use, without the consent of the registrant, any reproduction, counterfeit, copy or colorable imitation of a mark registered under this chapter in connection with the sale, offering for sale or advertising of any goods or services in a manner likely to cause confusion or mistake or to deceive as to the source of origin of such goods or services; or

(2) reproduce, counterfeit, copy or colorably imitate any such mark and apply such reproduction, counterfeit, copy or colorable imitation to labels, signs, prints, packages, wrappers, receptacles or advertisements intended to be used in connection with the sale or other distribution in this Commonwealth of such goods or services;

shall be liable to a civil action by the [owner of such registered mark] *registrant* for any or all of the remedies provided in section 1125 (relating to remedies), except that under paragraph (2) the registrant shall not be entitled to recover profits or damages unless the acts have been committed with [knowledge that such mark is intended to be used] *the intent* to cause confusion or mistake or to deceive.

(b) Exception.—The provisions of subsection (a) shall not apply to any advertising agency, publisher of newspapers, magazines or other advertising

media accepting authorization for the reproduction or copy of any such mark innocently and in good faith in the usual course of business.

§ 1124. Injury to business or reputation; dilution.

[Likelihood of injury to business reputation or of dilution of the distinctive quality of a mark registered under this chapter, or a mark valid at common law, or a trade name valid at common law, shall be a ground for injunctive relief notwithstanding the absence of competition between the parties or the absence of confusion as to the source of goods or services.]

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

(1) *The degree of inherent or acquired distinctiveness of the mark in this Commonwealth.*

(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 Commonwealth.*

(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 Commonwealth used by the mark's owner and the person against whom the injunction is sought.*

(7) *The nature and extent of use of the same or similar marks by third parties.*

(8) *Whether the mark is the subject of a registration in this Commonwealth or a Federal registration under the act of March 3, 1881 (21 Stat. 502) or the act of February 20, 1905 (33 Stat. 724), repealed by the Trademark Act of 1946 (60 Stat. 427, 15 U.S.C. § 1051 et seq.), or on the principal register.*

In an action brought under this section, the owner of a famous mark shall be entitled only to injunctive relief in this Commonwealth unless the person against whom the injunctive relief is sought willfully intended to trade on the owner's reputation or to cause dilution of the famous mark. If such willful 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. The following shall not be actionable under this section:

(1) 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.

(2) Noncommercial use of a mark.

(3) All forms of news reporting and news commentary.

§ 1125. Remedies.

(a) General rule.—Any owner of a mark registered under this chapter may proceed by suit to enjoin the manufacture, use, display or sale of any counterfeits or imitations thereof, and any court of competent jurisdiction may grant injunctions to restrain such manufacture, use, display or sale as may be by the court deemed just and reasonable, and may, except as provided in section 1123 (relating to infringement), require the defendants to pay to such owner all profits derived from and all damages suffered by reason of such wrongful manufacture, use, display or sale, and such court may also order that any such counterfeits or imitations in the possession or under the control of any defendant in such case be delivered to an officer of the court or to the complainant to be destroyed. *The court, in its discretion, may enter judgment for an amount not to exceed three times such profits and damages and/or reasonable attorney fees of the prevailing party in such cases where the court finds the other party committed such wrongful acts with knowledge or in bad faith or otherwise as according to the circumstances of the case.*

(b) Exception.—No owner of such a mark shall have such right of injunction against an advertising agency, publisher of newspapers, magazines or other advertising media accepting authorization for the reproduction or copy of any such mark innocently and in good faith in the usual course of business.

(c) Criminal prosecutions unaffected.—The enumeration of any right or remedy in this chapter shall not affect the right of a registrant to prosecute under Title 18 (relating to crimes and offenses).

Section 2. This act shall take effect in 60 days.

APPROVED—The 18th day of June, A.D. 1998.

THOMAS J. RIDGE