

# Chapter 647

2011 EDITION

## Trademarks and Service Marks; Music Royalties

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## TRADEMARKS AND SERVICE MARKS (Generally)

**647.005 Definitions.** As used in this chapter:

(1) “Applicant” means a person that files an application to register a mark under this chapter, and the person’s legal representatives, successors or assigns.

(2) “Dilution” means an association that arises from the similarity between a mark or trade name and a famous mark, regardless of the presence or absence of competition between the owner of the famous mark and another party, actual or likely confusion, mistake, deception or actual economic injury, if the association:

(a) Impairs the distinctiveness of the famous mark, an association commonly known as dilution by blurring; or

(b) Harms the reputation of the famous mark, an association commonly known as dilution by tarnishment.

(3) “Mark” means a trademark or service mark entitled to registration under this chapter whether registered or not.

(4) “Person” means an individual, firm, partnership, corporation, association, limited liability company, union or other organization capable of suing or being sued in a court.

(5) “Registrant” means a person to whom the registration of a mark is issued under this chapter, and the person’s legal representatives, successors or assigns.

(6) “Retail value” means:

(a) For items that bear a counterfeit mark and are components of a finished product, the regular selling price of the finished product in which the component would be utilized.

(b) For items that bear a counterfeit mark other than items described in paragraph (a) of this subsection and for services that are identified by a counterfeit mark, the regular selling price of the item or service.

(7) “Service mark” means a word, name, symbol or device or a combination of words, names, symbols or devices that a person uses to identify and distinguish the person’s services, including a unique service, from another person’s services and to indicate the source of the services, even if the source is unknown.

(8) “Trademark” means a word, name, symbol or device or a combination of words, names, symbols or devices that a person uses to identify and distinguish the person’s goods, including a unique product, from another person’s goods and to indicate the

source of the goods, even if the source is unknown.

(9) “Trade name” means a name that a person uses to identify the person’s business or vocation.

(10)(a) “Use” means a bona fide use of a mark as described in ORS 647.017 in the ordinary course of trade.

(b) “Use” does not include a use of a mark made merely to reserve a right in a mark. [1961 c.497 §1; 1965 c.511 §1; 1981 c.633 §71; 1989 c.931 §1; 1999 c.722 §7; 2009 c.459 §1]

## (Registration)

**647.009 Filing, service, copying and certification fees.** The Secretary of State shall collect the fees described in ORS 56.140 for each document delivered for filing under this chapter and for process served on the Secretary of State under this chapter. The Secretary of State may collect the fees described in ORS 56.140 for copying a public record under this chapter, certifying the copy or certifying other facts of record under this chapter. [1991 c.132 §23; 1999 c.652 §17; 2009 c.459 §4]

**647.010** [Repealed by 1961 c.497 §16]

**647.015 Application for registration.** (1) Subject to the limitations set forth in this chapter, a person who uses a mark may file an application to register the mark with the Secretary of State in a manner that complies with the Secretary of State’s requirements. The application must set forth at least the following information:

(a) The name and business address of the person applying for registration. If the person is a corporation, the application must list the state of incorporation. If the person is a partnership, the application must list the state in which the partnership is organized and the names of the general partners. If the person is a limited liability company, the application must list the state in which the limited liability company was formed.

(b) 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 the goods or services and the class into which the goods or services fall.

(c) The date when the mark was first used anywhere and the date when the applicant or a predecessor in interest first used the mark in this state.

(d) A statement that:

(A) The applicant owns the mark;

(B) The mark is in use; and

(C) To the knowledge of the person that is verifying the application, no other person has registered the mark with the federal

government or in this state or has the right to use the mark or a mark that so resembles the mark as to be likely to cause confusion or mistake or to deceive when applied to the goods or services of the other person.

(2) As part of the application, the Secretary of State may require the applicant to:

(a) State whether the applicant or a predecessor in interest has filed an application to register the mark or portions or a composite of the mark with the United States Patent and Trademark Office and, if so, provide:

(A) The filing date and serial number of each application filed in connection with the mark;

(B) The status of the application; and

(C) The reasons why the mark was finally refused registration or an application did not otherwise result in a registration, if the mark was refused registration or the application did not result in a registration.

(b) Provide a drawing of the mark that complies with the Secretary of State's requirements.

(3) The applicant, a member of the firm applying or an officer of the corporation, limited liability company or association applying to register the mark shall sign and verify the application by oath, affirmation or declaration under penalty of perjury.

(4) The applicant as part of the application shall submit one specimen of the mark as actually used. [1961 c.497 §3; 1965 c.511 §2; 1971 c.318 §2; 1985 c.728 §84; 1991 c.132 §20; 2009 c.459 §5]

**647.017 When mark is in use; abandonment of mark.** (1) For purposes of this chapter, a mark is in use:

(a) On goods that are sold or transported in commerce in this state when the mark is placed in any manner on:

(A) Goods, other containers or displays associated with the goods or tags or labels affixed to the goods; or

(B) Documents associated with the goods or the sale of the goods, if the nature of the goods makes placing the mark on the items identified in subparagraph (A) of this paragraph impractical.

(b) On services that are rendered in this state when the mark is used or displayed in selling or advertising the services.

(2) A mark is abandoned if either of the following occurs:

(a) Use of the mark has been discontinued with intent not to resume the use. Intent not to resume use may be inferred from circumstances. Nonuse for two consecutive years is prima facie evidence of abandonment.

(b) A course of conduct of the owner, including a failure to act, causes the mark to lose significance as a mark.

(3) A title, character name that a person uses and other distinctive features of a radio or television program may be registered as a service mark notwithstanding that the title, name or feature or the program may advertise the goods of the sponsor. [2009 c.459 §3]

**647.020** [Repealed by 1961 c.497 §16]

**647.024 Rules for classes of goods and services.** (1) The Secretary of State by rule may establish classes of goods and services for convenience in the administration of this chapter. The classes that the Secretary of State establishes may not limit or extend an applicant's or registrant's rights and shall conform to the classes the United States Patent and Trademark Office has adopted to the extent practicable.

(2) A single application to register a mark may include any or all goods or services on or in connection with which the mark is actually being used.

(3) If an application includes more than one class, the Secretary of State may collect a fee under ORS 56.140 for each class. [1985 c.728 §84b (enacted in lieu of 647.025); 2009 c.459 §6]

**647.025** [1961 c.497 §9; 1965 c.511 §3; repealed by 1985 c.728 §§84a,110 (647.024 enacted in lieu of 647.025)]

**647.029 Examination of application by Secretary of State; amendment of application; refusal to register mark; priority of concurrent applications.** (1) The Secretary of State, at the Secretary of State's sole discretion, may examine an application filed under ORS 647.015 for conformity with the provisions of this chapter. This section does not require the Secretary of State to conduct an examination or investigation in connection with an application for registration.

(2) An applicant shall provide additional pertinent information the Secretary of State requests, including a description of a design that is used as a mark. The applicant or, with the applicant's authorization, the Secretary of State may amend the application to conform with the Secretary of State's requirements or as the applicant deems advisable to respond to a rejection or objection. The Secretary of State may require the applicant to submit a new application.

(3) The Secretary of State may require the applicant to disclaim an unregistrable component of a mark that is otherwise registrable. The applicant may voluntarily disclaim a component of a mark that the applicant has applied to register. An applicant's disclaimer does not prejudice or affect the applicant's or a registrant's rights that exist or arise in the matter the applicant disclaimed or the applicant's or a registrant's

rights of registration on another application if the matter the applicant disclaimed is or has become distinctive of the applicant's or registrant's goods or services.

(4) If the Secretary of State finds that an applicant is not entitled to register a mark, the Secretary of State shall notify the applicant and provide the Secretary of State's reasons for the finding. The Secretary of State shall provide the applicant with a reasonable time in which to reply or amend the application and shall examine the amended application in accordance with the provisions of this section. The applicant may continue to amend the application until:

(a) The Secretary of State in a final order refuses to register the mark; or

(b) The applicant abandons the application by failing to reply to the Secretary of State's notice or amend the application within the time the Secretary of State specifies.

(5) If the Secretary of State in a final order refuses to register a mark, the applicant may seek a writ of mandamus under ORS 34.105 to 34.240 to compel the Secretary of State to register the mark. The court may grant the writ if the applicant proves that the statements in the application are true and that the mark is otherwise entitled to registration. The court may not assess costs or award damages against the Secretary of State in an action for a writ of mandamus brought under this section.

(6) If the Secretary of State is concurrently processing applications that seek to register the same mark or a mark that is likely to cause confusion or mistake or to deceive when used on or in connection with goods or services identified in the applications, the Secretary of State shall grant priority to the applications in the order in which they were filed. If the Secretary of State grants a registration for a mark on the basis of an application filed prior to other applications, the Secretary of State shall reject the other applications. A rejected applicant may bring an action to cancel the registration the Secretary of State granted on the basis that the rejected applicant had prior or superior rights to the mark. [1985 c.728 §85b; 1987 c.94 §104; 2009 c.459 §7]

**647.030** [Repealed by 1961 c.497 §16]

**647.035 Marks ineligible for registration.** (1) A mark that an applicant submits for registration may not be registered if the mark consists of or comprises:

(a) Matter that is immoral, deceptive or scandalous;

(b) Matter that may disparage, bring into contempt or disrepute or falsely suggest a

connection with a person, living or dead, an institution, a belief or a national symbol;

(c) The flag, coat of arms or other insignia of the United States, a state or municipality or a foreign nation or a simulation of the flag, coat of arms or insignia;

(d) The name or signature of or a portrait that identifies a particular living individual, unless the individual has given written consent; or

(e) A mark that so resembles a mark registered in this state, or a mark or trade name previously used and not abandoned by another person, as to be likely to cause confusion or mistake or to deceive when used on or in connection with the applicant's goods or services.

(2)(a) A mark may not be registered if the mark is:

(A) Merely descriptive or deceptively misdescriptive of the applicant's goods or services;

(B) Primarily geographically descriptive or deceptively misdescriptive of the applicant's goods or services; or

(C) Primarily merely a surname.

(b) The provisions of paragraph (a) of this subsection do not prevent the Secretary of State from registering a mark used by the applicant that has become distinctive of the applicant's goods or services. The Secretary of State may accept as evidence that the mark has become distinctive, when used on or in connection with the applicant's goods or services, proof that the applicant has used the mark continuously in this state for five years before the date on which the applicant made the claim that the mark has become distinctive of the applicant's goods or services. [1961 c.497 §2; 1965 c.511 §4; 1971 c.318 §3; 1985 c.728 §85; 2005 c.22 §450; 2009 c.459 §8]

**647.040** [Amended by 1959 c.261 §1; repealed by 1961 c.497 §16]

**647.045 Certificate of registration; contents; evidentiary effect.** (1) Upon compliance by an applicant with the requirements of this chapter, the Secretary of State shall issue and deliver a certificate of registration to the applicant. The Secretary of State may issue as the certificate of registration a copy of the application marked with the word "filed."

(2) The certificate of registration must show:

(a) The registrant's name and business address. If the registrant is a corporation, the certificate must show the state of incorporation. If the registrant is a partnership, the certificate must show the state in which the partnership is organized and the names of the general partners. If the registrant is a

limited liability company, the certificate must show the state in which the limited liability company was formed.

(b) The date the applicant claimed as the first use of the mark anywhere and the date claimed as the first use of the mark in this state.

(c) The class and description of the goods or services on or in connection with which the mark is used.

(d) A reproduction of the mark.

(e) The registration date and the term of registration.

(3) A certificate of registration issued by the Secretary of State under this chapter, or a copy of the certificate duly certified by the Secretary of State, is competent and sufficient proof of the registration of the mark in an action or proceeding brought in a court in this state. [1961 c.497 §4; 1965 c.511 §5; 1971 c.318 §4; 1985 c.728 §86; 2009 c.459 §9]

**647.050** [Repealed by 1961 c.497 §16]

**647.055 Period of registration; renewal; notice.** (1) Registration of a mark under this chapter is effective for a term of five years from the date of registration and may be renewed for successive five-year terms. The Secretary of State shall renew the registration if the registrant:

(a) Submits an application for renewal, verified as provided in ORS 647.015 (3), within 180 days before the term of registration expires;

(b) Includes with the application a statement, verified as provided in ORS 647.015 (3), that the mark has been in use and is still in use; and

(c) Includes with the application a specimen showing actual use of the mark.

(2) A registration that is effective on June 23, 2009, shall remain in effect for the remainder of the term of registration. The registration may be renewed as provided in subsection (1) of this section.

(3) The Secretary of State, before the term of registration expires, shall notify the registrant in writing at the mailing address shown for the registrant in the current records of the Secretary of State that the registrant must renew the registration. [1961 c.497 §§5,7; 1965 c.511 §6; 1971 c.318 §5; 1981 c.633 §72; 1985 c.728 §86a; 1989 c.931 §2; 1991 c.132 §21; 2009 c.459 §10]

**647.060** [Repealed by 1961 c.497 §16]

**647.065 Assignment; filing with Secretary of State; legal and evidentiary effect; public record of registrations.** (1) A mark and the registration for the mark under this chapter are assignable with the goodwill of the business in which the mark is used, or

with the part of the goodwill of the business that is connected with the use of and symbolized by the mark.

(2) To assign the registration, a registrant must sign a written instrument. The registrant may submit the instrument to the Secretary of State for filing. After filing the instrument, the Secretary of State may issue to the assignee a certificate of registration that is effective for the remainder of the term of registration.

(3) An assignment of registration under this section is void as against a subsequent purchaser that purchases the registration for valuable consideration and without notice of the assignment unless the assignment is submitted to the Secretary of State for filing within 90 days after the assignment or before the subsequent purchase, whichever is later.

(4) A registrant or applicant for registration may submit for filing with the Secretary of State a change of name for the registration or the application. The Secretary of State may issue a certificate of registration for an assigned application in the assignee's name or may issue a certificate of registration in the assignee's name for the remainder of the term of registration.

(5) The Secretary of State, at the Secretary of State's sole discretion, may receive for filing other signed written instruments related to a mark that is registered or an application that is pending, such as licenses, security interests or mortgages.

(6) Acknowledgment is prima facie evidence of the execution of an assignment or other instrument. If the Secretary of State accepts an instrument for filing, the Secretary of State's record is prima facie evidence of the execution.

(7) The Secretary of State may accept for filing a photocopy of an instrument if a party to the instrument or a successor to the party certifies that the photocopy is a true and correct copy of the original instrument.

(8) The Secretary of State shall keep for public examination a record of all marks registered or renewed under this chapter and all documents submitted for filing under this section. [1961 c.497 §6; 1965 c.511 §7; 1971 c.318 §6; 1985 c.351 §25; 1985 c.728 §87a; 2005 c.22 §451; 2009 c.459 §11]

**647.070** [Repealed by 1961 c.497 §16]

**647.075 Cancellation of registrations.**

(1) The Secretary of State shall cancel a registration for a mark or part of a registration if:

(a) The Secretary of State receives a voluntary request from the registrant or the assignee of record to cancel the registration.

(b) The registration has not been renewed in accordance with the provisions of ORS 647.055.

(c) A court of competent jurisdiction either orders cancellation of the registration or makes any of the following findings:

(A) The registered mark has been abandoned.

(B) The registrant is not the owner of the mark.

(C) The registration was granted improperly.

(D) The registration was obtained fraudulently.

(E) The registered mark is the generic name for the goods or services or a portion of the goods or services for which the mark has been registered.

(F) The registered mark is likely to cause confusion or mistake or to deceive because of the registered mark's similarity to a mark registered with the United States Patent and Trademark Office and not abandoned before the application for the registered mark was filed under ORS 647.015.

(2) If the registrant proves that the registrant has a concurrent registration in the United States Patent and Trademark Office that covers an area that includes this state, the Secretary of State may not cancel the registration for the area covered by the concurrent registration notwithstanding a court's finding under subsection (1)(c)(F) of this section. [1961 c.497 §8; 1965 c.511 §8; 1971 c.318 §7; 1981 c.633 §73; 1985 c.728 §88; 2009 c.459 §12]

**647.077 Action to cancel mark or compel registration; Secretary of State not a party.** An action to cancel a mark registered under this chapter or an action in mandamus to compel the Secretary of State to register a mark must be brought in a circuit court in this state. An action in mandamus must be based solely on the record before the Secretary of State. In an action to cancel a mark, a person may not name the Secretary of State as a party but the court shall notify the Secretary of State and permit the Secretary of State to intervene in the proceeding. [2009 c.459 §18]

**647.080** [Repealed by 1961 c.497 §16]

**(Remedies)**

**647.085 Fraudulent registration prohibited; liability; action for damages.** (1) A person may not, on the person's behalf or on behalf of another person, apply for, obtain or maintain a filing or registration for a mark under this chapter by knowingly making a false or fraudulent representation or declaration, orally or in writing, or by other fraudulent means.

(2) A person that violates subsection (1) of this section is liable to pay all damages sustained in consequence of the filing or registration. The party injured by the filing or registration may bring an action for damages in a court of competent jurisdiction. [1961 c.497 §10; 1965 c.511 §9; 1971 c.318 §8; 1981 c.633 §73a; 2009 c.459 §13]

**647.090** [Repealed by 1961 c.497 §16]

**647.095 Prohibited acts; liability.** (1) A person may not:

(a) Use without the registrant's consent and in connection with a sale, distribution, offer for sale or advertisement of goods or services a reproduction, counterfeit, copy or colorable imitation of a mark registered under this chapter if the use is likely to cause confusion or mistake or to deceive as to the origin of the goods or services; or

(b) Apply a mark described in paragraph (a) of this subsection to a label, sign, print, package, wrapper, receptacle or advertisement intended for use in connection with the sale or distribution of goods or services within this state.

(2) A person that acts as described in subsection (1) of this section is liable for the remedies provided in ORS 647.105 in a civil action brought by the registrant, except that the registrant may not recover profits or damages from the person unless the person acted as described in subsection (1)(b) of this section with the intent to cause confusion or mistake or to deceive. [1961 c.497 §11; 1965 c.511 §10; 1985 c.566 §1; 2009 c.459 §14]

**647.100** [Repealed by 1961 c.497 §16]

**647.105 Remedies for infringement.** (1) An owner of a mark registered under this chapter may proceed in a civil action to seek an injunction against the manufacture, use, display or sale of a counterfeit or imitation of the mark. A court of competent jurisdiction may:

(a) Grant injunctions to restrain the manufacture, use, display or sale as the court deems just and reasonable;

(b) Require the defendant to pay to the owner all profits the defendant derived and all damages the owner suffered from the manufacture, use, display or sale; and

(c) Order counterfeits or imitations in the defendant's possession or under the defendant's control to be delivered to an officer of the court or the owner to be destroyed.

(2) If the court finds that the defendant acted in bad faith, with knowledge or otherwise according to the circumstances of the case, the court in the court's discretion may enter a judgment in an amount not to exceed three times the sum of the defendant's profits and the owner's damages and reasonable at-

torney fees. If the court finds that the plaintiff acted in bad faith, vexatiously, wantonly or for oppressive reasons, the court in the court's discretion may award reasonable attorney fees to the defendant. [1961 c.497 §12; 1965 c.511 §11; 1985 c.566 §2; 2009 c.459 §15]

**647.107 Grounds for injunctive relief; famous marks.** (1) Subject to the principles of equity, the owner of a mark that is famous and distinctive in this state, inherently or through acquired distinctiveness, is entitled to an injunction against another person's commercial use of the mark if:

(a) The other person's use began after the mark became famous; and

(b) The use is likely to cause dilution of the famous mark.

(2) A mark is famous if the general consuming public of this state or of a geographic area within this state widely recognizes the mark as a designation of the source of the mark owner's goods or services. In determining whether a mark is famous, a court may consider factors such as:

(a) The duration, extent and geographic reach of advertising and publicity of the mark in this state by the owner or by other persons;

(b) The amount, volume and geographic extent of sales of goods or services offered under the mark in this state;

(c) The extent to which the mark is actually recognized in this state; and

(d) Whether the mark is registered in this state, appears on the principal register created under the Trademark Act of 1946, 60 Stat. 427, 15 U.S.C. 1051 et seq., or is otherwise registered under federal law.

(3) In an action brought under this section, the owner of a famous mark is entitled to injunctive relief throughout the geographic area in which the court finds that the mark became famous before the other person began the other person's use of the mark. The court may not order injunctive relief outside this state.

(4) If the court finds that the other person willfully intended to cause dilution of the famous mark, the owner is entitled to the remedies provided in this chapter, subject to the court's discretion and the principles of equity.

(5) An owner of a famous mark may not bring an action for another person's use if the use is a nominative or descriptive fair use or facilitation of a nominative or descriptive fair use, other than as a designation of source for the other person's own goods or services, including a use:

(a) In connection with:

(A) Advertising or promotion that permits consumers to compare goods or services; or

(B) Identifying or parodying, criticizing or commenting upon the owner of the famous mark or the goods or services of the owner of the famous mark;

(b) That is noncommercial; or

(c) That constitutes news reporting or news commentary. [1971 c.122 §2; 2009 c.459 §16]

**647.110** [Repealed by 1961 c.497 §16]

**647.111 Seizure of counterfeit goods in infringement proceeding; liability for wrongful seizure; undertaking.** (1) In a civil action under ORS 647.105, upon motion by the plaintiff with or without notice to the defendant, the court may order seizure of the counterfeit goods from any person manufacturing, displaying for sale or selling the goods if the plaintiff shows good cause and a probability of success on the merits and posts an undertaking under subsection (6) of this section.

(2) If the plaintiff makes a motion without notice to the defendant for an order for seizure and the court determines from the motion that there is good reason for proceeding without notice to the defendant, the court may waive the requirement of notice and order seizure of the counterfeit goods.

(3) Any person from whom seizure is effected by order of the court under this section shall be served with the order at the time of the seizure. The order of seizure shall set forth:

(a) The date or dates on which the seizure is ordered to take place;

(b) A description of the counterfeit goods to be seized;

(c) The identity of the person or description of the authority of the person who will seize the counterfeit goods;

(d) A description of the location or locations at which seizure is to occur; and

(e) A hearing date not more than 10 court days after the last date on which seizure is ordered at which any person from whom goods are seized may appear and seek release of the seized goods.

(4) If the plaintiff causes seizure of goods that are not counterfeit, the plaintiff shall be liable for the following damages, costs and expenses:

(a) Any damages proximately caused by the seizure of goods that are not counterfeit to any person having a financial interest in the seized goods.

(b) Costs incurred by any person in defending against seizure of noncounterfeit goods.



(c) Expenses, including reasonable attorney defending against the seizure of any noncounterfeit or noninfringing goods, upon a showing that the plaintiff acted in bad faith in causing the seizure to occur.

(d) Punitive damages, if warranted.

(5) A person seeking a recovery under subsection (4) of this section may join any surety on an undertaking posted under subsection (6) of this section. Any judgment of liability shall bind the person liable under subsection (4) of this section and the surety jointly and severally, but the liability of the surety shall be limited to the amount of the undertaking.

(6) The court shall set the amount of the undertaking required by subsection (1) of this section in accordance with the recovery of damages, costs and expenses under subsection (4) of this section that would be likely if the court ultimately were to determine that the goods seized were not counterfeit.

(7) Any person entitled to recover under subsection (4) of this section, within 30 days after the date of seizure, may object to the undertaking on the ground that the surety or the amount of undertaking is insufficient.

(8) The motion filed pursuant to subsection (1) of this section shall include a statement:

(a) Advising the person from whom the goods are seized that the undertaking has been filed;

(b) Informing the person of the right to object to the undertaking on the ground that the surety or the amount of the undertaking is insufficient; and

(c) Advising the person from whom the goods are seized that the objection to the undertaking must be made within 30 days after the date of seizure. [1985 c.566 §4]

**647.115 Effect of chapter on marks or trade names acquired at common law; effect of civil remedies on criminal statutes; intent and construction of chapter.**

(1) The provisions of this chapter do not adversely affect the rights or the enforcement of rights in marks or trade names acquired in good faith at any time at common law.

(2) The enumeration of a right or remedy in this chapter does not affect the right of a registrant to prosecute under a penal law of this state.

(3) The intent of this chapter is to provide for a system of trademark registration and protection substantially consistent with the system of trademark registration and protection set forth in 15 U.S.C. 1051 et seq. Construction given the provisions set forth in 15 U.S.C. 1051 et seq. constitutes persuasive authority for interpreting and constru-

ing this chapter. [1961 c.497 §14; 1965 c.511 §12; 1985 c.566 §5; 1985 c.728 §89; 2009 c.459 §19]

**647.120** [Repealed by 1961 c.497 §16]

**647.125** [1985 c.566 §6; repealed by 1999 c.722 §9]

**647.130** [Repealed by 1961 c.497 §16]

**647.135 Trademark counterfeiting.** (1) A person commits trademark counterfeiting if the person knowingly and with the intent to sell or distribute and without the consent of the registrant uses, displays, advertises, distributes, offers for sale, sells or possesses any item that bears a counterfeit of a mark or any service that is identified by a counterfeit of a mark registered under this chapter or registered under this chapter or registered under 15 U.S.C. 1052 with knowledge that the mark is counterfeit.

(2) For purposes of this section, a mark is counterfeit if:

(a) It is a mark that is identical to or substantially indistinguishable from a registered mark; and

(b) It is used on or in connection with the same type of goods or services for which the genuine mark is registered.

(3) A person does not commit trademark counterfeiting if the person has adopted and lawfully used the same or a confusingly similar mark in the rendition of like services or the manufacture of like goods in this state from a date before the effective date of registration of the service mark or trademark and continues to use the mark after the effective date of registration. [1999 c.722 §2]

**647.140 Trademark counterfeiting in third degree; penalty.** (1) A person commits the crime of trademark counterfeiting in the third degree if the person commits trademark counterfeiting as described in ORS 647.135 and:

(a) The total number of items bearing the counterfeit mark is not more than 100; or

(b) The total retail value of all of the items bearing the counterfeit mark or services that are identified by the counterfeit mark is not more than \$1,000.

(2) Trademark counterfeiting in the third degree is a Class A misdemeanor. Notwithstanding ORS 161.655, if the person convicted under this section is a corporation, the maximum fine that may be imposed is \$100,000. [1999 c.722 §3]

**647.145 Trademark counterfeiting in second degree; penalty.** (1) A person commits the crime of trademark counterfeiting in the second degree if the person:

(a) Commits trademark counterfeiting as described in ORS 647.135 and:

(A) Has one prior conviction for trademark counterfeiting in any degree;

(B) The total number of items bearing the counterfeit mark is more than 100 but less than 1,000; or

(C) The total retail value of all of the items bearing the counterfeit mark or services that are identified by the counterfeit mark is more than \$1,000 but less than \$10,000.

(b) Knowingly manufactures or produces with intent to sell or distribute any item that bears a counterfeit mark or any service that is identified by a counterfeit mark.

(2) Trademark counterfeiting in the second degree is a Class C felony. However, notwithstanding ORS 161.655, if the person is convicted under:

(a) Subsection (1)(a)(A) of this section and is a corporation, the maximum fine that may be imposed is \$200,000.

(b) Subsection (1)(b) of this section and the person has one prior conviction for trademark counterfeiting in any degree and is a corporation, the maximum fine that may be imposed is \$200,000. [1999 c.722 §4]

**647.150 Trademark counterfeiting in first degree; penalty.** (1) A person commits the crime of trademark counterfeiting in the first degree if the person commits trademark counterfeiting as described in ORS 647.135 or 647.145 (1)(b) and:

(a) Has two or more prior convictions for trademark counterfeiting in any degree;

(b) The total number of items bearing the counterfeit mark is 1,000 or more; or

(c) The total retail value of all of the items bearing the counterfeit mark or services that are identified by the counterfeit mark is \$10,000 or more.

(2) Trademark counterfeiting in the first degree is a Class B felony. [1999 c.722 §5]

**647.155 Seizure, forfeiture and disposal.** (1) The following are subject to seizure and forfeiture in the same manner as the proceeds of prohibited conduct under ORS chapter 131A:

(a) All raw materials and equipment that are used, or intended for use, in providing, manufacturing and delivering items bearing a counterfeit mark or services identified by a counterfeit mark;

(b) All conveyances that are used, or intended for use, to transport items bearing a counterfeit mark;

(c) All books, records, computers and data that are used or intended for use in the production, manufacture, sale or delivery of items bearing a counterfeit mark or services identified by a counterfeit mark; and

(d) All moneys, negotiable instruments, balances in deposit or other accounts, secu-

rities or other things of value furnished or intended to be furnished by any person in the course of activity constituting a violation of ORS 647.140, 647.145 or 647.150.

(2) Items bearing a counterfeit mark are subject to seizure and disposition as provided in ORS 133.525 to 133.703. However, if the registrant so requests, the agency holding the seized items shall release the seized items to the registrant or make such other disposition as the registrant directs. If the registrant does not direct disposition of the seized items, the agency shall destroy the items. [1999 c.722 §6; 2001 c.780 §§17,17a; 2009 c.78 §60]

### ROYALTIES FOR NONDRAMATIC MUSICAL WORKS

**647.700 Definitions for ORS 647.700 to 647.730.** As used in ORS 647.700 to 647.730, unless the context requires otherwise:

(1) "Copyright owner" means the owner of a copyright of a nondramatic musical or similar work recognized and enforceable under the copyright laws of the United States pursuant to title 17 of the United States Code (P.L. 94-553, 17 U.S.C. 101 et seq.).

(2) "Nondramatic" means the public performance of a recorded, broadcast or live musical work. "Nondramatic" does not include the performance of a dramatic work, including a play.

(3) "Performing rights society" means an association or corporation that licenses the public performances of nondramatic musical works on behalf of copyright owners, including but not limited to:

(a) The American Society of Composers, Authors and Publishers (ASCAP);

(b) Broadcast Music, Inc. (BMI); and

(c) The Society of European Stage Authors and Composers (SESAC).

(4) "Proprietor" means the owner of a retail establishment, restaurant, inn, bar, tavern, sports or entertainment facility or any other similar place of business or professional office located in this state in which the public may assemble and in which nondramatic musical works or similar copyrighted works may be performed, broadcast or otherwise transmitted for the enjoyment of members of the public there assembled.

(5) "Royalty" or "royalties" means the fees payable to a copyright owner or performing rights society for the public performance of nondramatic musical works or other similar works. [1997 c.236 §1]

**Note:** 647.700 to 647.730 were enacted into law by the Legislative Assembly but were not added to or made a part of ORS chapter 647 or any series therein by legislative action. See Preface to Oregon Revised Statutes for further explanation.

**647.705 Requirements for performing rights societies.** A performing rights society shall not enter into, or offer to enter into, a contract for the payment of royalties by a proprietor unless the performing rights society agrees to provide to the proprietor upon request at the proprietor's place of business, by electronic means or otherwise:

(1) Information as to whether specific copyrighted musical works are in the repertoire of the performing rights society;

(2) The opportunity to review the most current available list of the performing rights society's members or affiliates; and

(3) The schedule of rates and terms of the royalties to be collected under the contract, including any sliding scale or schedule for any increase or decrease of the rates for the duration of the contract. [1997 c.236 §2]

**Note:** See note under 647.700.

**647.710 Requirements for contracts for payment of royalties.** Every contract for the payment of royalties between a proprietor and a performing rights society executed, issued or renewed in this state shall be:

(1) In writing;

(2) Signed by the parties; and

(3) Written to include, at a minimum, the following information:

(a) The proprietor's name and business address and the name and location of each place of business to which the contract applies;

(b) The name of the performing rights society;

(c) The duration of the contract; and

(d) The schedule of rates and terms of the royalties to be collected under the contract, including any sliding scale or schedule for any increase or decrease of the rates for the duration of the contract. [1997 c.236 §3]

**Note:** See note under 647.700.

**647.715 Prohibited conduct.** (1) A performing rights society or any agent or employee thereof shall not:

(a) Enter onto the premises of a proprietor's business for the purpose of discussing or inquiring about a contract for the payment of royalties with the proprietor or the proprietor's employees, without first providing identification to the proprietor or the proprietor's employees and making known to them the purpose of the discussion or inquiry;

(b) Engage in any coercive conduct, act or practice that is substantially disruptive to a proprietor's business;

(c) Use or attempt to use any unfair or deceptive act or practice in negotiating with a proprietor; or

(d) Fail to comply with or fulfill the obligations imposed by ORS 647.705 and 647.710.

(2) Nothing in ORS 647.700 to 647.730 shall be construed to prohibit a performing rights society from conducting investigations to determine the existence of music use by a proprietor or informing a proprietor of the proprietor's obligation under the copyright laws of the United States pursuant to title 17 of the United States Code (P.L. 94-553, 17 U.S.C. 101 et seq.). [1997 c.236 §4]

**Note:** See note under 647.700.

**647.720 Action for damages; injunction.** In the event of a violation of ORS 647.705, 647.710 or 647.715, any person may bring an action to recover actual damages and reasonable attorney fees or seek an injunction or any other remedy available at law or in equity. [1997 c.236 §5]

**Note:** See note under 647.700.

**647.725 Relationship to other laws.** The rights, remedies and prohibitions contained in ORS 647.700 to 647.730 shall be in addition to and cumulative to any other right, remedy or prohibition accorded by common law, federal law or the statutes of this state, and nothing contained in ORS 647.700 to 647.730 shall be construed to deny, abrogate or impair any common law or statutory right, remedy or prohibition. [1997 c.236 §6]

**Note:** See note under 647.700.

**647.730 Applicability of ORS 647.700 to 647.730.** ORS 647.700 to 647.730 do not apply to contracts between copyright owners or performing rights societies and broadcasters licensed by the Federal Communications Commission or to contracts with cable television operators, cable television programmers or other similar transmission services. ORS 647.700 to 647.730 do not apply to musical works performed in synchronization with an audiovisual film or tape. [1997 c.236 §7]

**Note:** See note under 647.700.

**647.990** [Repealed by 1961 c.497 §16]

**647.991** [1985 c.566 §7; repealed by 1999 c.722 §9]

