

**CS FOR HOUSE BILL NO. 450(L&C)**

IN THE LEGISLATURE OF THE STATE OF ALASKA

NINETEENTH LEGISLATURE - SECOND SESSION

BY THE HOUSE LABOR AND COMMERCE COMMITTEE

Offered: 2/21/96

Referred: Judiciary

Sponsor(s): REPRESENTATIVE THERRIAULT

**A BILL**

**FOR AN ACT ENTITLED**

1 "An Act relating to trademarks; amending Rule 609, Alaska Rules of Appellate  
2 Procedure; and providing for an effective date."

3 **BE IT ENACTED BY THE LEGISLATURE OF THE STATE OF ALASKA:**

4 \* **Section 1.** INTENT. It is the intent of the legislature to provide a system of state  
5 trademark registration and protection substantially consistent with the federal system of  
6 trademark registration and protection under 15 U.S.C. 1051 et seq., 1091 et seq., 1111 et seq.  
7 (Trademark Act of 1946, as amended). To that end, the construction given the Trademark Act  
8 of 1946, as amended, should be examined as a persuasive authority for interpreting and  
9 construing AS 45.50.010 - 45.50.205 (Alaska Trademark Act).

10 \* **Sec. 2.** AS 43.20.040(a) is amended to read:

- 11 (a) In this chapter, income from sources in the state includes
  - 12 (1) income from real or tangible personal property located in the state;
  - 13 (2) income of whatever nature from a business, trade or profession
  - 14 having a business situs in the state and compensation for services rendered in the state;

1 (3) income from stocks, bonds, notes, bank deposits, and other  
2 intangible personal property having a taxable or business situs in the state;

3 (4) rentals and royalties for the use of or for the privilege of using, in  
4 the state, patents, copyrights, secret processes and formulas, **marks**  
5 [TRADEMARKS], trade brands, franchises, and other property having a taxable or  
6 business situs in the state.

7 \* **Sec. 3.** AS 45.50.010 is amended to read:

8 Sec. 45.50.010. REGISTRABILITY. A **mark** [TRADEMARK] may not be  
9 registered if it **consists of or comprises**

10 (1) [CONSISTS OF] immoral, deceptive, or scandalous matter;

11 (2) [CONSISTS OF] matter **that** [WHICH] may disparage or falsely  
12 suggest a connection with persons, living or dead, institutions, beliefs, or national  
13 symbols, or bring them into contempt [,] or disrepute;

14 (3) [CONSISTS OF] the flag, [OR] coat of arms, or other insignia of  
15 the United States, **this or another** [OR OF A] state, **a** [OR] municipality **of this or**  
16 **another state**, [OR OF] a foreign nation, or simulation of any of these;

17 (4) [CONSISTS OF] the name, signature, or portrait **identifying** [OF]  
18 a living individual, except with the written consent of the individual;

19 (5) [CONSISTS OF] a mark that,

20 (A) **when used on or in connection with goods or services of**  
21 **the applicant**, is merely descriptive or deceptively misdescriptive of **them**;  
22 [THE APPLICANT'S GOODS, OR]

23 (B) **when used on or in connection with the goods or services**  
24 **of the applicant**, is primarily geographically descriptive or deceptively  
25 misdescriptive of **them**; [THE APPLICANT'S GOODS, OR]

26 (C) is primarily merely a surname; however, this **paragraph**  
27 does not prevent the registration of a mark used [IN THE STATE] by the  
28 applicant **that** [WHICH] has become distinctive of the applicant's goods **or**  
29 **services; the commissioner may accept** [;] as evidence that the mark has  
30 become distinctive, **as used on or in connection with the applicant's goods**  
31 **or services**, [THE COMMISSIONER MAY ACCEPT] proof of continuous use

1 of the mark as a mark by the applicant in this state [OR ELSEWHERE] for the  
2 five years immediately preceding the date on which the claim of  
3 distinctiveness is made [OF THE FILING OF THE APPLICATION FOR  
4 REGISTRATION]; or

5 (6) [CONSISTS OF] a mark [TRADEMARK] that so resembles a  
6 mark [TRADEMARK] registered in the state or in the United States Patent and  
7 Trademark Office, [A TRADEMARK] or a mark [TRADE NAME] previously used  
8 [IN THIS STATE] by another and not abandoned, as to be likely, when used on or  
9 in connection with [APPLIED TO] the goods or services of the applicant, to cause  
10 confusion or mistake or to deceive.

11 \* **Sec. 4.** AS 45.50.010 is amended by adding a new subsection to read:

12 (b) For purposes of this section,

13 (1) "descriptive" means a word or combination of words that describes  
14 one or more of the characteristics of the goods or services, such as, what the goods or  
15 services are, what the goods are made of, or what the goods or services are used for;  
16 however, an otherwise descriptive word or combination of words can, as a secondary  
17 meaning, become accepted as identifying the goods or services of the applicant, in  
18 which case it is no longer merely descriptive;

19 (2) "misdescriptive" means a word or combination of words that falsely  
20 describes the nature, function, or capacity of goods or services.

21 \* **Sec. 5.** AS 45.50.020 is amended to read:

22 Sec. 45.50.020. APPLICATION FOR REGISTRATION. Subject to  
23 limitations under AS 45.50.010 - 45.50.205, a [A] person who [ADOPTS AND] uses  
24 a mark [TRADEMARK] in the state may file with the commissioner  
25 [DEPARTMENT], on a form furnished by the department and in a manner  
26 complying with AS 45.50.010 - 45.50.205, an application for registration of that  
27 mark [THE TRADEMARK] setting out the following information:

28 (1) the name and business address of the registrant [PERSON  
29 APPLYING FOR REGISTRATION,] and, if the registrant is a

30 (A) corporation, the state of incorporation; or

31 (B) partnership, the state in which the partnership is

1                   **organized and the names of the general partners;**

2                   (2) the goods **or services on or** in connection with which the mark is  
3 used, the manner in which the mark is used **on or** in connection with the goods **or**  
4 **services**, and the class of the goods **or services**;

5                   (3) the date when the **mark** [TRADEMARK] was first used anywhere  
6 and the date when it was first used in this state by the applicant or **a** [THE  
7 APPLICANT'S] predecessor in **interest**; [BUSINESS; AND]

8                   (4) a statement that the applicant is the owner of the **mark, that the**  
9 **mark is in use**, [TRADEMARK] and that, **to the knowledge of the individual**  
10 **verifying the application**, no other person has the right to use the **mark**  
11 [TRADEMARK IN THIS STATE] either in the identical form or in a near  
12 resemblance to it as **to** [MIGHT] be **likely, when applied to the goods or services**  
13 **of another person, to cause confusion or mistake, or to deceive; and**

14                   **(5) a statement as to whether the applicant, or a predecessor in**  
15 **interest, has filed an application to register the mark, or portions or a composite**  
16 **of the mark, with the United States Patent and Trademark Office, and, if so,**  
17 **information regarding that application, including the filing date and serial**  
18 **number, the status of that application, whether that application was refused**  
19 **registration or otherwise did not result in a registration, and, if so, the reasons**  
20 **that application did not result in a registration** [CALCULATED TO DECEIVE OR  
21 TO BE MISTAKEN FOR IT].

22 \* **Sec. 6.** AS 45.50 is amended by adding a new section to read:

23                   Sec. 45.50.025. PROCEDURE CONCERNING APPLICATION. (a) Upon  
24 the filing of an application for registration of a mark and payment of the application  
25 fee, the commissioner shall examine the application for conformity with AS 45.50.010  
26 - 45.50.205. The commissioner may request additional information, including a  
27 description of a design mark, suggest amendments to the application, or suggest that  
28 a new application be filed. The applicant may provide the additional information  
29 requested, authorize the commissioner to make amendments to the application, or  
30 withdraw the application and file a new one to respond to a potential objection or  
31 rejection.

1 (b) As a condition of registration, the commissioner may require the applicant  
2 to disclaim an unregistrable component of a mark, or an applicant may voluntarily  
3 disclaim a component of a mark originally sought to be registered. A disclaimer under  
4 this subsection does not prejudice or affect the rights of an applicant or registrant

5 (1) in the disclaimed matter that exist at the time of the disclaimer or  
6 that arise later; or

7 (2) to register the disclaimed matter in another application if the  
8 disclaimed matter is or becomes distinctive of the applicant's or registrant's goods or  
9 services.

10 (c) If an applicant is found not to be entitled to registration of a mark, the  
11 commissioner shall notify the applicant and inform the applicant of the reasons for the  
12 finding. The commissioner shall give the applicant a reasonable period of time in  
13 which to reply or amend the application. If a reply or amendment is delivered to the  
14 commissioner within the designated period, the commissioner shall reexamine the  
15 application. Before making a final decision, an application may be amended and  
16 reexamined as many times as the commissioner determines to be necessary. However,  
17 if the applicant fails to reply or amend the application within the period designated by  
18 the commissioner, the application is considered abandoned.

19 (d) When the commissioner makes a final decision on the application, the  
20 commissioner shall notify the applicant in writing of the decision and that the decision  
21 is final, setting out the reasons for the decision if the application is disapproved. The  
22 applicant may appeal the commissioner's final decision to the superior court, which  
23 shall hear the matter de novo. The court may enter judgment setting aside, modifying,  
24 remanding, or affirming the decision.

25 (e) If the commissioner receives more than one application for registration of  
26 the same or a confusingly similar mark for the same or related goods or services, the  
27 commissioner shall grant the registration to the applicant who first filed the original  
28 application if the application otherwise qualifies for registration. A rejected applicant  
29 may bring an action in superior court for cancellation of the registration upon the  
30 grounds of prior or superior rights to the mark.

31 \* **Sec. 7.** AS 45.50.030 is amended to read:

1           Sec. 45.50.030. FORM OF APPLICATION. The application shall be signed  
2 and verified by the applicant or by a member of the firm or an officer of the  
3 corporation, partnership, or association applying. The application shall be  
4 accompanied by **three specimens showing the actual use of the mark on or in**  
5 **connection with the goods or services** [A SPECIMEN OR FACSIMILE OF THE  
6 TRADEMARK IN TRIPLICATE].

7 \* **Sec. 8.** AS 45.50.040 is amended to read:

8           Sec. 45.50.040. FILING FEE. The application for registration shall be  
9 accompanied by a filing fee **established by the department by regulation** [OF \$10  
10 PAYABLE TO THE DEPARTMENT OF COMMERCE AND ECONOMIC  
11 DEVELOPMENT].

12 \* **Sec. 9.** AS 45.50.050 is amended to read:

13           Sec. 45.50.050. FORM AND CONTENTS OF CERTIFICATE OF  
14 REGISTRATION. Upon compliance by the applicant with the requirements of  
15 **AS 45.50.010 - 45.50.205** [AS 45.50.010 - 45.50.200], the commissioner shall issue  
16 and deliver a certificate of registration to the applicant. The certificate of registration  
17 shall be issued under the signature of the commissioner and the seal of the state. The  
18 certificate must show

19                   (1) the name and business address [AND, IF A CORPORATION, THE  
20 STATE OF INCORPORATION,] of the **registrant and, if that registrant is a**

21                                   **(A) corporation, the state of incorporation; or**

22                                   **(B) partnership, the state in which the partnership is**  
23 **organized and the names of the general partners** [; PERSON CLAIMING  
24 OWNERSHIP OF THE TRADEMARK];

25                   (2) the date claimed for the first use of the **mark** [TRADEMARK]  
26 anywhere and the date claimed for the first use of the **mark** [TRADEMARK] in this  
27 state;

28                   (3) the class of goods **or services** and a description of the goods **or**  
29 **services** on **or in connection with** which the **mark** [TRADEMARK] is used;

30                   (4) a reproduction of the **mark** [TRADEMARK];

31                   (5) the registration date; and

1 (6) the term of the registration.

2 \* **Sec. 10.** AS 45.50.060 is amended to read:

3 Sec. 45.50.060. CERTIFICATE OF REGISTRATION AS EVIDENCE. A  
4 certificate of registration issued by the **commissioner** [DEPARTMENT] under  
5 **AS 45.50.010 - 45.50.205** [THE PROVISIONS OF AS 45.50.010 - 45.50.200] or a  
6 copy of it certified by the commissioner is admissible in evidence as competent and  
7 sufficient proof of the registration of the **mark** [TRADEMARK] in an action or  
8 judicial proceeding in the state.

9 \* **Sec. 11.** AS 45.50.070 is amended to read:

10 Sec. 45.50.070. DURATION AND RENEWAL. Registration of a **mark**  
11 [TRADEMARK] is effective for a term of **five** [10] years from the date of registration.  
12 Upon application filed within six months before the expiration of the term **in a**  
13 **manner complying with the requirements of the commissioner** [, ON A FORM  
14 FURNISHED BY THE DEPARTMENT], the registration may be renewed for an  
15 additional term of **five** [10] years.

16 \* **Sec. 12.** AS 45.50.070 is amended by adding a new subsection to read:

17 (b) An application for renewal of a registration must include a verified  
18 statement that the mark has been used and is still in use. Three specimens showing  
19 actual use of the mark on or in connection with the goods or services shall be  
20 submitted with the renewal application.

21 \* **Sec. 13.** AS 45.50.080 is amended to read:

22 Sec. 45.50.080. FEE FOR RENEWAL OF REGISTRATION. A renewal fee  
23 **established by the department by regulation** [OF \$10] shall accompany the  
24 application for renewal of the registration.

25 \* **Sec. 14.** AS 45.50.090 is amended to read:

26 Sec. 45.50.090. ADDITIONAL TERMS OF RENEWAL. A [TRADEMARK]  
27 registration **of a mark** may be renewed for successive periods of **five** [10] years in the  
28 manner provided in AS 45.50.070 and 45.50.080.

29 \* **Sec. 15.** AS 45.50.100 is amended to read:

30 Sec. 45.50.100. NOTIFICATION OF EXPIRATION OF REGISTRATION  
31 PERIOD. The commissioner shall notify each registrant of the necessity of renewal

1 at least six months [WITHIN THE YEAR] preceding the expiration [OF THE 10  
2 YEARS FROM THE] date of the registration. Notification shall be by writing to the  
3 last known address of the registrant.

4 \* **Sec. 16.** AS 45.50.120 is amended to read:

5 Sec. 45.50.120. ASSIGNMENT. (a) A mark [TRADEMARK] and its  
6 registration are assignable with the goodwill of the business in which the mark  
7 [TRADEMARK] is used, or with that part of the goodwill of the business connected  
8 with the use of and symbolized by the mark [TRADEMARK].

9 (b) An assignment shall be in writing and may be filed [RECORDED] with  
10 the commissioner [DEPARTMENT] upon the payment of a fee established by [OF  
11 \$2, PAYABLE TO] the department by regulation. The commissioner shall file  
12 [RECORD] the assignment [,] and shall issue in the name of the assignee a new  
13 certificate for the remainder of the term of the registration.

14 (c) An assignment of registration is void as against a subsequent purchaser for  
15 valuable consideration without notice, unless it is filed [RECORDED] with the  
16 commissioner [DEPARTMENT] within three months after the date of the assignment  
17 or before the subsequent purchase.

18 \* **Sec. 17.** AS 45.50 is amended by adding a new section to read:

19 Sec. 45.50.125. NAME CHANGE AND OTHER FILINGS. (a) The name of  
20 a registrant or applicant may be changed by filing the change of name with the  
21 commissioner on a form furnished by the department that has been signed and verified  
22 by the registrant or applicant and paying a filing fee established by the department by  
23 regulation. The commissioner shall issue in the changed name of a registrant an  
24 amended certificate of registration.

25 (b) Other signed and verified instruments that relate to a registered mark or  
26 an application for registration of a mark may be filed at the discretion of the  
27 commissioner upon payment of a filing fee established by regulation of the department.

28 (c) A photocopy of an instrument shall be accepted by the commissioner for  
29 filing if it is certified by a party to the instrument or a successor of a party to be a true  
30 and correct copy of the original and if the commissioner would have accepted the  
31 original for filing under (a) or (b) of this section.

1 (d) Acknowledgment is prima facie evidence for the commissioner of the  
2 execution of an assignment, change of name, or other instrument related to a registered  
3 mark or to registration of a mark. When the instrument is filed by the commissioner,  
4 the filing is prima facie evidence of execution of the instrument for all other purposes.

5 \* **Sec. 18.** AS 45.50.130 is amended to read:

6 Sec. 45.50.130. COMMISSIONER TO KEEP RECORD OF REGISTRATION.

7 The commissioner shall keep for public examination a record of all **marks**  
8 [TRADEMARKS] registered or renewed under **AS 45.50.010 - 45.50.205 and a**  
9 **record of all instruments filed under AS 45.50.125** [AS 45.50.010 - 45.50.200].

10 \* **Sec. 19.** AS 45.50.140 is amended to read:

11 Sec. 45.50.140. CANCELLATION. The commissioner shall cancel **in whole**  
12 **or in part** [FROM THE REGISTER]

13 (1) [EACH REGISTRATION UNDER A PREVIOUS LAW THAT IS  
14 MORE THAN FIVE YEARS OLD AND NOT RENEWED IN ACCORDANCE  
15 WITH AS 45.50.010 - 45.50.200;

16 (2)] a registration **for which the commissioner receives a voluntary**  
17 **written request for cancellation from** [REQUESTED BY] the registrant or the  
18 assignee of **record** [RECORDS TO BE CANCELED];

19 **(2)** [(3)] each registration [UNDER AS 45.50.010 - 45.50.200] that  
20 **expires and** is not renewed **under AS 45.50.070 and 45.50.090;**

21 **(3)** [(4)] a registration found by a court to be

22 (A) abandoned; [,]

23 (B) not owned by the registrant; [,]

24 (C) granted improperly; [,]

25 (D) obtained fraudulently; [, OR]

26 (E) so similar, as to be likely to cause confusion or mistake or  
27 to deceive, to a **mark** [TRADEMARK] registered by another person in the  
28 United States Patent **and Trademark** Office, before the date of filing of the  
29 application for registration by the registrant under **AS 45.50.010 - 45.50.205**  
30 [AS 45.50.010 - 45.50.200], and not abandoned; however, if the registrant  
31 proves that the registrant is the owner of a concurrent registration of the **mark**

1 [TRADEMARK] in the United States Patent **and Trademark** Office covering  
2 an area including this state, the registration may not be canceled; **or**

3 **(F) the generic name for all or a portion of the goods or**  
4 **services for which the mark has been registered;**

5 **(4) [(5)]** when a court orders cancellation of a registration on any  
6 ground.

7 \* **Sec. 20.** AS 45.50.140 is amended by adding a new subsection to read:

8 (b) For purposes of (a) of this section, registration of a mark is abandoned  
9 when use of the mark has been discontinued and the registrant has no intent to resume  
10 its use, or when the mark loses its significance as a mark due to action or failure to  
11 act by the registrant. The intent not to resume the use of a mark may be inferred from  
12 circumstances. No use of a mark by the registrant for at least a 24-month period  
13 constitutes prima facie evidence that its registration has been abandoned.

14 \* **Sec. 21.** AS 45.50.150 is amended to read:

15 Sec. 45.50.150. CLASSIFICATION. The **department shall by regulation**  
16 **establish a classification** [FOLLOWING GENERAL CLASSES] of goods **and**  
17 **services** [ARE ESTABLISHED] for convenience of administration of **AS 45.50.010 -**  
18 **45.50.205** [AS 45.50.010 - 45.50.200]. However, **the classification does** [THEY DO]  
19 not limit or extend the applicant's or registrant's rights, and a single application for  
20 registration of a **mark** [TRADEMARK] may include [ANY OR] all goods upon  
21 which, **or services with which,** the **mark** [TRADEMARK] is actually being used  
22 comprised in a single class, but in no event may a single application include goods **or**  
23 **services** upon which the **mark** [TRADEMARK] is being used **that** [WHICH] fall  
24 within different classes of goods **or services.** **To the extent practical, the**  
25 **classification of goods and services should conform to the classification adopted**  
26 **by the United States Patent and Trademark Office** [. THE CLASSES ARE  
27 AS FOLLOWS:

28 (1) ABRASIVES AND POLISHING MATERIALS;

29 (2) ADHESIVES;

30 (3) BAGGAGE, ANIMAL EQUIPMENT, PORTFOLIOS, AND  
31 POCKETBOOKS;

- 1 (4) BELTING, HOSE, MACHINERY PACKING, AND  
2 NONMETALLIC TIRES;
- 3 (5) BROOMS, BRUSHES, AND DUSTERS;
- 4 (6) CANES, PARASOLS, AND UMBRELLAS;
- 5 (7) CHEMICALS AND CHEMICAL COMPOSITIONS;
- 6 (8) CLOTHING;
- 7 (9) CONSTRUCTION MATERIALS;
- 8 (10) CORDAGE;
- 9 (11) COSMETICS AND TOILET PREPARATIONS;
- 10 (12) CROCKERY, EARTHENWARE, AND PORCELAIN;
- 11 (13) CUTLERY, MACHINERY, AND TOOLS, AND PARTS  
12 THEREOF;
- 13 (14) DENTAL, MEDICAL, AND SURGICAL APPLIANCES;
- 14 (15) DETERGENTS AND SOAPS;
- 15 (16) DISTILLED ALCOHOLIC LIQUORS;
- 16 (17) ELECTRICAL APPARATUS, MACHINES AND SUPPLIES;
- 17 (18) EXPLOSIVES, FIREARMS, EQUIPMENT, AND PROJECTILES;
- 18 (19) FANCY GOODS, FURNISHINGS, AND NOTIONS;
- 19 (20) FERTILIZERS;
- 20 (21) FILTERS AND REFRIGERATORS;
- 21 (22) FOODS AND INGREDIENTS OF FOODS;
- 22 (23) FURNITURE AND UPHOLSTERY;
- 23 (24) GAMES, TOYS, AND SPORTING GOODS;
- 24 (25) GLASSWARE;
- 25 (26) HARDWARE AND PLUMBING AND STEAMFITTING  
26 SUPPLIES;
- 27 (27) HEATING, LIGHTING, AND VENTILATING APPARATUS;
- 28 (28) HOROLOGICAL INSTRUMENTS;
- 29 (29) INKS AND INKING MATERIALS;
- 30 (30) JEWELRY AND PRECIOUS METALWARE;
- 31 (31) KNITTED, NETTED AND TEXTILE FABRICS, AND

- 1           SUBSTITUTES FOR THEM;
- 2                           (32) LAUNDRY APPLIANCES AND MACHINES;
- 3                           (33) LINOLEUM AND OILED CLOTH;
- 4                           (34) LOCKS AND SAFES;
- 5                           (35) MALT BEVERAGES AND LIQUORS;
- 6                           (36) MEASURING AND SCIENTIFIC APPLIANCES;
- 7                           (37) MEDICINES AND PHARMACEUTICAL PREPARATIONS;
- 8                           (38) METALS AND METAL CASTINGS AND FORGINGS;
- 9                           (39) MUSICAL INSTRUMENTS AND SUPPLIES;
- 10                          (40) OILS AND GREASES;
- 11                          (41) PAINTS AND PAINTERS' MATERIALS;
- 12                          (42) PAPER AND STATIONERY;
- 13                          (44) RAW OR PARTLY PREPARED MATERIALS;
- 14                          (45) RECEPTACLES;
- 15                          (46) SMOKERS' ARTICLES, NOT INCLUDING TOBACCO
- 16           PRODUCTS;
- 17                          (47) SOFT DRINKS AND CARBONATED WATERS;
- 18                          (48) THREAD AND YARN;
- 19                          (49) TOBACCO PRODUCTS;
- 20                          (50) VEHICLES;
- 21                          (51) WINES;
- 22                          (52) MERCHANDISE NOT OTHERWISE CLASSIFIED].

23   \* **Sec. 22.** AS 45.50.160 is amended to read:

24                          Sec. 45.50.160. FRAUDULENT REGISTRATION. A person who, **for the**

25                          **person or on behalf of another,** procures the filing or registration of a **mark under**

26                          **AS 45.50.010 - 45.50.205** [TRADEMARK WITH THE DEPARTMENT,] by

27                          knowingly making a false or fraudulent representation or declaration, **orally**

28                          [VERBALLY] or in writing, or by **another** [ANY OTHER] fraudulent means, is liable

29                          to pay all damages sustained in consequence of the filing or registration, which may

30                          be recovered by **or on behalf of** the party injured **in any court.**

31   \* **Sec. 23.** AS 45.50.170 is amended to read:

1           Sec. 45.50.170. INFRINGEMENT. A [SUBJECT TO AS 45.50.190, A]  
2 person is liable in a civil action by the **registrant** [OWNER OF THE REGISTERED  
3 TRADEMARK] for the remedies provided in AS 45.50.180 [,] if the person

4           (1) uses, without the consent of the registrant, a reproduction,  
5 counterfeit, copy, or colorable imitation of a **mark** [TRADEMARK] registered under  
6 AS 45.50.010 - 45.50.205 [AS 45.50.010 - 45.50.200] in connection with the sale,  
7 **distribution**, offering for sale, or advertising of goods **or services** on or in connection  
8 with which the use is likely to cause confusion or mistake or to deceive as to the  
9 source of origin of the goods **or services**; or

10           (2) reproduces, counterfeits, copies, or colorably imitates the **mark**  
11 [TRADEMARK] and applies the reproduction, counterfeit, copy, or colorable imitation  
12 to labels, signs, prints, packages, wrappers, receptacles, or advertisements intended to  
13 be used upon or in conjunction with the sale or distribution in this state of the goods  
14 **or services**; except that under this paragraph the registrant may not recover profits or  
15 damages unless the acts are committed with [KNOWLEDGE THAT] the **intent**  
16 [TRADEMARK IS INTENDED TO BE USED] to cause confusion or mistake or to  
17 deceive.

18 \* **Sec. 24.** AS 45.50.180(a) is amended to read:

19           (a) A registrant [THE OWNER OF A TRADEMARK REGISTERED  
20 UNDER AS 45.50.010 - 45.50.200] may enjoin the manufacture, use, display, or sale  
21 of a counterfeit or imitation of the **registrant's mark** [TRADEMARK].

22 \* **Sec. 25.** AS 45.50.180(b) is amended to read:

23           (b) The court may grant an injunction to restrain the manufacture, use, display,  
24 or sale, and may require the defendant to pay to the **registrant either** [OWNER] the  
25 profits derived from or the damages suffered by reason of the wrongful manufacture,  
26 use, display, or sale, or both. The court may also order that the counterfeit or  
27 imitation in the possession or under the control of a defendant be delivered to an  
28 officer of the court, or to the complainant, to be destroyed. **The court may also enter**  
29 **judgement for punitive damages in an amount not to exceed three times the**  
30 **profits, damages, and reasonable attorney fees of the prevailing party.**

31 \* **Sec. 26.** AS 45.50.180 is amended by adding new subsections to read:

1 (d) A registrant that owns a mark that is famous in the state is entitled to an  
2 injunction against another's dilution of the mark. If the user of the famous mark  
3 wilfully intended to trade on the registrant's reputation or to cause dilution of the  
4 mark, the registrant is also entitled to remedies set out in (b) of this section. In  
5 determining whether a mark is famous, a court may consider any factor, including the  
6 (1) degree of inherent or acquired distinctiveness of the mark in the  
7 state;  
8 (2) duration and extent of use of the mark in connection with the goods  
9 and services;  
10 (3) duration and extent of advertising and publicity of the mark in the  
11 state;  
12 (4) geographical extent of the trading area in which the mark is used;  
13 (5) channels of trade for the goods or services with which the mark is  
14 used;  
15 (6) degree of recognition in the state of the mark in the registrant's  
16 trading area and channel of trade, and in the user's trading area and channel of trade;  
17 and  
18 (7) nature and extent of use of the same or similar mark by other  
19 persons.

20 (e) For purposes of (d) of this section, "dilution" means the use of a word,  
21 symbol, or device, or a combination of one or more of these, in a manner that deprives  
22 or reduces the distinctiveness of a mark.

23 \* **Sec. 27.** AS 45.50.200 is amended to read:

24 Sec. 45.50.200. DEFINITIONS. In AS 45.50.010 - 45.50.205, [AS 45.50.010 -  
25 45.50.200]

26 (1) "applicant" means the person filing an application for registration  
27 of a **mark** [TRADEMARK], or a legal representative, successor, or assign of that  
28 person;

29 (2) **"certification mark" means a mark used upon or in connection**  
30 **with the goods or services of one or more persons other than the registrant to**  
31 **certify national or other origin, material, mode of manufacture, quality, accuracy,**

1 or other characteristics of the goods or services or that the work or labor on the  
2 goods or services was performed by members of a union or other organization;

3 (3) "collective mark" means a trademark or service mark used by  
4 the members of a cooperative, an association or other collective group or  
5 organization and includes marks used to indicate membership in a union, an  
6 association, or other organization;

7 (4) "commissioner" means the commissioner of commerce and  
8 economic development;

9 (5) [(3)] "department" means the Department of Commerce and  
10 Economic Development;

11 (6) "mark" [(4) "PERSON"] means a certification mark, a collective  
12 mark, a service mark, or a trademark;

13 (7) [AN INDIVIDUAL, FIRM, PARTNERSHIP, CORPORATION,  
14 ASSOCIATION, UNION OR OTHER ORGANIZATION;

15 (5)] "registrant" means the person to whom the registration of a mark  
16 [TRADEMARK] is issued, or a legal representative, successor, or assign of that  
17 person;

18 (8) "service mark" means a word, symbol, design, or a combination  
19 of one or more of these that identifies the services of a person;

20 (9) [(6)] "trademark" means a word, symbol, or design, or a  
21 combination of one or more of these, used by a person to identify its goods and  
22 distinguish them from those of another;

23 (10) "use" or "used" means the bona fide use of a mark in the  
24 ordinary course of trade, and not made merely to reserve a right in the mark; a  
25 mark is deemed to be in use on goods when it is placed in any manner on the  
26 goods, on the goods' container, on tags or labels affixed to the goods, on displays  
27 associated with the goods, or, if the nature of the goods makes other types of  
28 placement impracticable, on documents associated with the goods or with the sale  
29 of the goods when they are sold or transported in commerce in this state; a mark  
30 is deemed to be in use on services when it is displayed in the sale or advertising  
31 of services that are performed in this state;

1                                   **(11) "verified" means that a document has been certified to be true**  
2                                   **as provided in AS 09.63.040** [NAME, SYMBOL, OR DEVICE OR COMBINATION  
3                                   OF ANY OF THESE ADOPTED AND USED BY A PERSON TO IDENTIFY  
4                                   GOODS MADE OR SOLD BY THE PERSON AND TO DISTINGUISH THEM  
5                                   FROM GOODS MADE OR SOLD BY OTHERS;

6                                   (7) A TRADEMARK IS "USED" IN THIS STATE WHEN IT IS  
7                                   PLACED IN ANY "USED" MANNER ON GOODS OR THEIR CONTAINERS OR  
8                                   ON THE TAGS OR LABELS AFFIXED TO GOODS, WHEN THE GOODS ARE  
9                                   SOLD OR DISTRIBUTED IN THE STATE].

10       \* **Sec. 28.** AS 45.50 is amended by adding a new section to article 1 to read:  
11                                   Sec. 45.50.205. SHORT TITLE. AS 45.50.010 - 45.50.205 may be cited as  
12                                   the Alaska Trademark Act.

13       \* **Sec. 29.** AS 45.50.180(c) and 45.50.190 are repealed.

14       \* **Sec. 30.** AS 45.50.025(d), added by sec. 6 of this Act, amends Alaska Rule of Appellate  
15       Procedure 609 by requiring a de novo hearing on appeals under AS 45.50.025.

16       \* **Sec. 31.** TRANSITION. The amendments made to AS 45.50.010 - 45.50.200 by this Act  
17       do not apply to an application, suit, proceeding or appeal pending on the effective date of this  
18       Act. Notwithstanding the amendments made to AS 45.50.070 - 45.50.090 in secs. 11 - 14 of  
19       this Act, a registration or renewal of a registration that is in effect on the effective date of this  
20       Act remains in effect for the full term that existed on the date of the registration or renewal.

21       \* **Sec. 32.** AUTHORIZATION TO ADOPT REGULATIONS. The Department of  
22       Commerce and Economic Development may adopt regulations to implement this Act;  
23       however, the regulations may not be effective before the effective date of this Act.

24       \* **Sec. 33.** Sections 1 - 31 of this Act take effect January 1, 1997.

25       \* **Sec. 34.** Section 32 of this Act takes effect immediately under AS 01.10.070(c).