

TITLE 48
MONOPOLIES AND TRADE PRACTICES

CHAPTER 5
REGISTRATION AND PROTECTION OF TRADEMARKS

48-501. DEFINITIONS. Whenever used in this chapter:

(1) "Abandoned" shall mean when either of the following occurs:

(a) When the use of the mark has been discontinued with intent not to resume such use. Intent not to resume may be inferred from circumstances. Nonuse for two (2) consecutive years shall constitute prima facie evidence of abandonment.

(b) 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.

(2) "Applicant" shall mean the person filing an application for registration of a mark under this act, and the legal representatives, successors, or assigns of such person.

(3) "Certification mark" shall mean any word, name, symbol or device or any combination thereof: (a) used by a person other than its owner, or (b) which its owner has a bona fide intention to permit a person other than the owner to use in commerce and files an application to register on the principal register established by this chapter to certify regional or other origin, material, mode of manufacture, quality, accuracy or other characteristics of such person's goods or services or that the work or labor on the goods or services was performed by members of a union or other organization.

(4) "Collective mark" shall mean a trademark or service mark: (a) used by the members of a cooperative, an association, or other collective group or organization; or (b) which such cooperative association or other collective group or organization has a bona fide intention to use in commerce and applies to register on the principal register established by this chapter, and includes marks indicating membership in a union, an association or other organization.

(5) "Dilution" shall mean the lessening of the capacity of registrant's mark to identify and distinguish goods or services, regardless of the presence or absence of: (a) competition between the parties, or (b) likelihood of confusion, mistake or deception.

(6) "Juristic person" shall mean a firm, partnership, corporation, limited liability company or partnership, union, association, or other organization capable of suing and being sued in a court of law.

(7) "Mark" shall mean any trademark, service mark, collective mark or certification mark entitled to registration under this act whether registered or not.

(8) "Person" shall mean the applicant or other party entitled to a benefit or privilege or rendered liable under the provisions of this act and includes a juristic person as well as a natural person.

(9) "Registrant" shall mean the person to whom the registration of a mark under this act is issued, and the legal representatives, successors or assigns of such person.

(10) "Service mark" shall mean any word, name, symbol, or device or any combination thereof used by a person to identify and distinguish the services of one (1) 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.

(11) "Trademark" shall mean any word, name, symbol, or device or any combination thereof used by a person to identify and distinguish the goods of such person, including a unique product, from those manufactured and sold by others, and to indicate the source of the goods, even if that source is unknown.

(12) "Trade name" shall mean any name used by a person to identify a business or vocation of such person.

(13) "Use" shall mean the bona fide use of a mark in the ordinary course of trade, and not made merely to reserve a right in a mark. For the purposes of this act, a mark shall be deemed to be in use: (a) 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 their sale, and the goods are sold or transported in commerce in this state; and (b) on services when it is used or displayed in the sale or advertising of services and the services are rendered in this state.

[48-501, added 1996, ch. 404, sec. 2, p. 1337; am. 1999, ch. 168, sec. 2, p. 456.]

48-502. REGISTRABILITY. (1) In order to be registered, a mark must have some element of distinctiveness, arbitrariness or uniqueness, which may be inherent to the mark or acquired through extended usage and establishment of a reputation.

(2) 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 if it:

(a) Consists of or comprises immoral, deceptive or scandalous matter; or

(b) 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; or

(c) Consists of or comprises the flag or coat of arms or other insignia of the United States, or of any state or municipality, or of any foreign nation, or any simulation thereof; or

(d) Consists of or comprises the name, signature or portrait identifying a particular living individual, except by the individual's written consent;

(e) Consists of a mark which: (i) when used on or in connection with the goods or services of the applicant, is merely descriptive or deceptively misdescriptive of them; or (ii) when 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, provided however, that nothing in this subsection shall prevent the registration of a mark used by the applicant which has become distinctive of the applicant's goods or services. The secretary of state may accept as evidence that the mark has become distinctive, as used on or in connection with the applicant's goods or services, proof of continuous use thereof as a mark by the applicant in this state for

the five (5) years before the date on which the claim of distinctiveness is made; or

(f) Consists of or comprises a mark which so resembles a mark registered in this state or a mark or trade name previously used by another and not abandoned, as to be likely, when used on or in connection with the goods or services of the applicant, to cause confusion or mistake or to deceive.

[48-502, added 1996, ch. 404, sec. 2, p. 1338.]

48-503. APPLICATION FOR REGISTRATION. Subject to the limitations set forth in this act, any person who uses a mark may file in the office of the secretary of state, in a form prescribed by the secretary of state, an application for registration of that mark setting forth, but not limited to, the following information:

(1) The name and business address of the person applying for such registration; and, if a corporation, limited liability company or partnership, the state of domestication, and if a partnership, the names of the general partners, as specified by the secretary of state;

(2) The goods or services on or in connection with which the mark is used and 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 state by the applicant or a predecessor in interest; and

(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 registered, in this state, or has the right to use such mark either in the identical form thereof or in such near resemblance thereto as to be likely, when applied to the goods or services of such other person, to cause confusion, or to cause mistake, or to deceive.

The secretary of state may also require a statement as to 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.

The application shall be signed by the applicant or by a member of the firm or an officer of the corporation or association applying.

The application shall be accompanied by a drawing or one (1) specimen showing the mark as actually used, complying with such requirements as the secretary of state may specify.

The application shall be accompanied by the application fee payable to the secretary of state.

[48-503, added 1996, ch. 404, sec. 2, p. 1339.]

48-504. FILING OF APPLICATIONS. (1) Upon the receipt of an application for registration and payment of the application fee, the secretary of state shall cause the application to be examined for conformity with this chapter.

(2) The applicant shall provide any additional pertinent information requested by the secretary of state including a description of a design mark

and may make, or authorize the secretary of state to make, such amendments to the application as may be reasonably requested by the secretary of state or deemed by the applicant to be advisable to respond to any rejection or objection.

(3) The secretary of state may require the applicant to disclaim an unregistrable component of a mark otherwise registrable, and an applicant may voluntarily disclaim a component of a mark sought to be registered. No disclaimer shall prejudice or affect the applicant's or registrant's rights then existing or thereafter arising in the disclaimed matter, or the applicant's or registrant's rights of registration on another application if the disclaimed matter is distinctive of the applicant's or registrant's goods or services.

(4) Amendments may be made by the secretary of state upon the application submitted by the applicant upon the applicant's agreement, or the secretary of state may require a fresh application.

(5) If the applicant is found not to be entitled to registration, the secretary of state shall advise the applicant thereof and of the reasons therefor. The applicant shall have a reasonable period of time specified by the secretary of state in which to reply or to amend the application, in which event the application shall then be reexamined. This procedure may be repeated until: (a) the secretary of state finally refuses registration of the mark; or (b) the applicant fails to reply or amend within the specified period, whereupon the application shall be deemed to have been abandoned.

(6) If the secretary of state finally refuses registration of the mark, the applicant may appeal the denial of such registration to the district court in and for Ada county. The court may compel registration of the mark, but without cost to the secretary of state, on proof that all the statements in the application are true and that the mark is otherwise entitled to registration.

(7) In the instance of applications concurrently being processed by the secretary of state which seek registration of the same or confusingly similar marks for the same or related goods or services, the secretary of state shall grant priority to the applications in order of filing. If a prior-filed application is granted a registration, the other application or applications shall then be rejected. Any rejected applicant may bring an action for cancellation of the registration upon grounds of prior or superior rights to the mark, in accordance with the provisions of section [48-509](#), Idaho Code.

[48-504, added 1996, ch. 404, sec. 2, p. 1339; am. 2012, ch. 322, sec. 1, p. 881.]

48-505. CERTIFICATE OF REGISTRATION. Upon compliance by the applicant with the requirements of this act, the secretary of state shall cause a certificate of registration to be issued and delivered to the applicant. The certificate of registration shall be issued under the signature of the secretary of state and the seal of the state, and it shall show the name and business address and, for a corporation, limited liability company or partnership, the state of domestication, and if a partnership, the names of the general partners, as specified by the secretary of state, of the person claiming ownership of the mark, the date claimed for the first use of the mark anywhere and the date claimed for the first use of the mark in this state, the class of goods or services and a description of the goods or services on or in

connection with which the mark is used, a reproduction of the mark, the registration date and the term of the registration.

Any certificate of registration issued by the secretary of state under the provisions hereof or a copy thereof duly certified by the secretary of state shall be admissible in evidence as competent and sufficient proof of the registration of such mark in any actions or judicial proceedings in any court of this state.

[48-505, added 1996, ch. 404, sec. 2, p. 1340.]

48-506. DURATION AND RENEWAL. (1) A registration of mark hereunder shall be effective for a term of ten (10) years from the date of registration and, upon application filed within six (6) months prior to the expiration of such term in a manner complying with the rules of the secretary of state, the registration may be renewed for a like term from the end of the expiring term.

(2) A renewal fee, payable to the secretary of state, shall accompany the application for renewal of the registration. When a renewal application includes goods or services which fall within multiple classes, the secretary of state may require payment of a fee for each class.

(3) A registration may be renewed for successive periods of ten (10) years in like manner and the secretary of state shall issue a certificate of renewal.

(4) Any registration in force on the date on which this act shall become effective shall continue in full force and effect for the unexpired term thereof and may be renewed by filing an application for renewal with the secretary of state in compliance with the rules of the secretary of state upon payment of the renewal fee within six (6) months prior to the expiration of the registration.

(5) All applications for renewal under this act, whether of registrations made under this act or of registrations effected under any prior act, shall include a statement that the mark has been and is still in use.

[48-506, added 1996, ch. 404, sec. 2, p. 1341; am. 2005, ch. 273, sec. 1, p. 841.]

48-507. ASSIGNMENTS, AMENDMENTS, CHANGES OF NAME AND OTHER INSTRUMENTS. (1) Any mark and its registration hereunder shall be assignable with the good will of the business in which the mark is used, or with that part of the good will of the business connected with the use of and symbolized by the mark. Assignment shall be by instruments in writing duly executed and may be filed with the secretary of state on a form provided by the secretary of state, upon the payment of the fee provided in section [48-517](#), Idaho Code, payable to the secretary of state who, upon filing of the assignment, shall issue in the name of the assignee a new certificate for the remainder of the term of the registration or of the last renewal thereof. An assignment of any registration under this act shall be void as against any subsequent purchaser for valuable consideration without notice, unless it is filed with the secretary of state within three (3) months after the date thereof or prior to such subsequent purchase.

(2) Any registrant or applicant effecting a change of the name of the person to whom the mark was issued or for whom an application was filed may file an application for amendment with the secretary of state upon the payment of the filing fee. The secretary of state may issue to the owner a cer-

tificate of amendment of registration for the remainder of the term of the registration or last renewal thereof.

(3) Other instruments which relate to a mark registered or application pending pursuant to this act, such as, by way of example, licenses, security interests or mortgages, may be filed in the discretion of the secretary of state pursuant to rule, provided that such instrument is in writing and duly executed.

(4) Acknowledgment shall be prima facie evidence of the execution of an assignment or other instrument and, when filed by the secretary of state, the record shall be prima facie evidence of execution.

(5) A photocopy of any instrument referred to in subsection (1), (2), or (3) of this section, shall be accepted for filing.

[48-507, added 1996, ch. 404, sec. 2, p. 1341.]

48-508. RECORDS. The secretary of state shall keep for public examination a record of all marks registered or renewed under this act, as well as a record of all documents filed pursuant to section [48-507](#), Idaho Code, until disposed of in accordance with [chapter 57, title 67](#), Idaho Code.

[48-508, added 1996, ch. 404, sec. 2, p. 1342.]

48-509. CANCELLATION. The secretary of state shall cancel from the register, in whole or in part:

(1) Any registration concerning which the secretary of state receives a voluntary request for cancellation from the registrant or the assignee of record;

(2) All registrations granted under this act and not renewed in accordance with the provisions of this chapter;

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

(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 mark is or has become the generic name for the goods or services, or a portion thereof, for which it was registered;

(f) 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 this state prior to the date of the filing of the application for registration by the registrant hereunder, and not abandoned; or

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

[48-509, added 1996, ch. 404, sec. 2, p. 1342.]

48-510. CLASSIFICATION. The secretary of state shall use the international classification of goods and services for convenience of administration of this act, but not to limit or extend the applicant's or registrant's rights, and a single application for registration of a mark may include any or all goods upon which, or services with which, the mark is actually being used indicating the appropriate class or classes of goods or services. When a single application includes goods or services which fall within multiple classes, the secretary of state may require payment

of a fee for each class. To the extent practicable, the classification of goods and services shall conform to the classification adopted by the United States patent and trademark office. Applications for renewal shall be filed using the international classification of goods and services. A renewed registration shall be issued by the secretary of state, under the international classification of goods and services, if such renewal would not expand the registrant's rights.

[48-510, added 1996, ch. 404, sec. 2, p. 1342; am. 2012, ch. 322, sec. 2, p. 882.]

48-511. FRAUDULENT REGISTRATION. Any person who shall for himself, or on behalf of any other person, procure the filing or registration of any mark in the office of the secretary of state under the provisions of this chapter, by knowingly making any false or fraudulent representation or declaration, 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.

[48-511, added 1996, ch. 404, sec. 2, p. 1343.]

48-512. INFRINGEMENT. Subject to the provisions of section [48-516](#), Idaho Code, 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 act in connection with the sale, distribution, offering for sale, or advertising of any goods or services on or in connection with which such use is 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 upon or in connection with the sale or other distribution in this state of such goods or services, shall be liable in a civil action by the registrant for any and all of the remedies provided in section [48-514](#), Idaho Code, except that under this subsection the registrant shall not be entitled to recover profits or damages unless the acts have been committed with the intent to cause confusion or mistake or to deceive.

[48-512, added 1996, ch. 404, sec. 2, p. 1343.]

48-513. INJURY TO BUSINESS REPUTATION -- DILUTION. The owner of a mark which is famous in this state shall be entitled, subject to the principles of equity, to an injunction against another's use of a mark, commencing after the owner's mark becomes famous, which causes dilution of the distinctive quality of the owner's mark, and to obtain such other relief as is provided in this section. In determining whether a mark is 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 state;

(2) The duration and extent of use of the mark in connection with the goods and services;

(3) The duration and extent of advertising and publicity of the mark in this state;

(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 owner's mark is used;

(6) The degree of recognition of the owner's mark in its and in the other's trading areas and channels of trade in this state; and

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

The owner shall be entitled only to injunctive relief in this state in an action brought under this section, unless the subsequent user willfully intended to trade on the owner's reputation or to cause dilution of the owner's mark. If such willful intent is proven, the owner shall also be entitled to the other remedies provided in this chapter, subject to the discretion of the court and the principles of equity.

[48-513, added 1996, ch. 404, sec. 2, p. 1343.]

48-514. REMEDIES. Any owner of a mark registered under this act 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 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. The court may also order that any such counterfeits or imitations in the possession or under the control of any defendant in the 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 (3) times such profits and damages and may award reasonable attorney's fees and costs of suit to the prevailing party in such cases where the court finds the other party committed the wrongful acts with knowledge or in bad faith or otherwise, as the circumstances of the case may warrant.

The enumeration of any right or remedy herein shall not affect a registrant's right to prosecute under any criminal law of this state.

[48-514, added 1996, ch. 404, sec. 2, p. 1344.]

48-515. FORUM FOR ACTIONS REGARDING REGISTRATION -- SERVICE ON OUT-OF-STATE REGISTRANTS. (1) Actions to require cancellation of a mark registered pursuant to this act or to appeal the denial of registration of a mark pursuant to this act shall be brought in the district court in and for Ada county. In an action to compel registration, the proceeding shall be based solely upon the record before the secretary of state. In an action for cancellation, the secretary of state shall not be made a party to the proceeding but shall be notified of the filing of the complaint by the clerk of the court in which it is filed and shall be given the right to intervene in the action.

(2) In any action brought against a nonresident registrant, service may be effected upon the secretary of state as agent for service of the registrant in accordance with the procedures established for service upon nonresident corporations and business entities under the Idaho rules of civil procedure.

[48-515, added 1996, ch. 404, sec. 2, p. 1344.]

48-516. COMMON LAW RIGHTS. Nothing herein shall adversely affect the rights or the enforcement of rights in marks acquired in good faith at any time at common law.

[48-516, added 1996, ch. 404, sec. 2, p. 1344.]

48-517. FEES. The secretary of state shall charge thirty dollars (\$30.00) for the various applications and filing fees required in this chapter and for related services. The application fee payable herein shall be refunded if the registration for a mark is not granted.

[48-517, added 1996, ch. 404, sec. 2, p. 1345; am. 1999, ch. 211, sec. 2, p. 563.]

48-518. TIME OF TAKING EFFECT -- REPEAL OF PRIOR ACTS -- INTENT OF ACT. This act shall be in force and effect on July 1, 1996, but shall not affect any suit, proceeding or appeal then pending. All acts relating to marks and parts of any other acts inconsistent herewith are hereby repealed on the effective date of this act, provided that as to any application, suit, proceeding or appeal, and for that purpose only, pending at the time this act takes effect the repeal shall be deemed not to be effective until final determination of said pending application, suit, proceeding or appeal.

The intent of this act is to provide a system of state trademark registration and protection substantially consistent with the federal system of trademark registration and protection under the trademark act of 1946, as amended. To that end, the construction given the federal act should be examined as persuasive authority for interpreting and construing this act.

[48-518, added 1996, ch. 404, sec. 2, p. 1345.]