

365.560 Repealed, 1994.

Catchline at repeal: Definitions.

History: Repealed 1994 Ky. Acts ch. 468, sec. 18, effective July 15, 1994. -- Created 1966 Ky. Acts ch. 230, sec. 1.

365.561 Legislative intent.

The General Assembly in enacting KRS 365.561 to 365.613 intends 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. The construction given the federal act shall be examined as persuasive authority for interpreting and constructing KRS 365.561 to 365.613.

Effective: July 15, 1994

History: Created 1994 Ky. Acts ch. 468, sec. 17, effective July 15, 1994.

365.563 Definitions for KRS 365.561 to 365.613.

As used in KRS 365.561 to 365.613, unless the context otherwise requires:

- (1) "Trademark" means any word, name, symbol or device including, but not limited to, a distinctive package or container of any kind, or any combination of these, used by a person to identify and distinguish the goods of that person, including a unique product, from those manufactured or sold by others, and to indicate the source of the goods, even if that source is unknown.
- (2) "Service mark" means any word, name, symbol or device or any combination of these, 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, advertise the goods of the sponsor.
- (3) "Mark" includes any trademark or service mark entitled to registration under KRS 365.561 to 365.613, whether registered or not.
- (4) "Trade name" means any name used by a person to identify his business or vocation.
- (5) "Person" and any other word or term used to designate the applicant or other party entitled to a benefit or privilege or rendered liable under the provisions of KRS 365.561 to 365.613 means a juristic person as well as a natural person. The term "juristic person" includes a firm, partnership, corporation, union, association, or other organization capable of suing and being sued in a court of law.
- (6) "Applicant" means the person filing an application for registration of a mark under KRS 365.561 to 365.613, and the legal representatives, successors, or assigns of that person.
- (7) "Registrant" means the person to whom the registration of a mark under KRS 365.561 to 365.613 is issued, and the legal representatives, successors, or assigns of that person.
- (8) "Use" means 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 KRS 365.561 to 365.613, a mark shall be deemed to be in use:
 - (a) On goods when it is placed in any manner on the goods or on containers or displays associated with the goods or on tags or labels affixed to the goods, or if the nature of the goods makes placement on the goods 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) When it is used or displayed in the sale or advertising of services and the services are rendered in this state.
- (9) A mark shall be deemed to be "abandoned" when:
 - (a) Its use has been discontinued with intent not to be resumed. Intent not to resume may be inferred from circumstances. Nonuse for two (2) consecutive

years shall constitute a rebuttable presumption of abandonment; or

(b) Any course of conduct of the owner, including acts of omission and commission, causes the mark to lose its significance as a mark.

(10) "Secretary" means the Secretary of State or the designee charged by him with the administration of KRS 365.561 to 365.613.

Effective: July 15, 1994

History: Created 1994 Ky. Acts ch. 468, sec. 1, effective July 15, 1994.

365.565 Repealed, 1994.

Catchline at repeal: Application for registration of mark -- Filing fee.

History: Repealed 1994 Ky. Acts ch. 468, sec. 18, effective July 15, 1994. -- Created 1966 Ky. Acts ch. 230, sec. 3.

365.567 Registrability.

A mark by which the goods or services of any applicant for registration may be distinguished from the goods or services of others shall not be registered pursuant to KRS 365.567 to 365.581 if it:

- (1) Consists of or comprises immoral, deceptive, or scandalous matter;
- (2) Consists of or comprises matter which may disparage or falsely suggest a connection with persons, living or dead, institutions, beliefs, or national symbols, or bring them into contempt or disrepute;
- (3) Consists of or comprises the flag or coat of arms or other insignia of the United States, any state or municipality, any foreign nation, or any simulation of the insignia;
- (4) Consists of or comprises the name, signature, or portrait of a particular living individual, except by the individual's written consent; or
- (5) Consists of a mark which when used on or in connection with the goods or services of the applicant:
 - (a) Is merely descriptive or deceptively misdescriptive of them;
 - (b) Is primarily geographically descriptive or deceptively misdescriptive of the goods or services; or
 - (c) Is primarily merely a surname.

However, nothing in this subsection shall prevent the registration of an applicant's mark which has become distinctive of the applicant's goods or services. The Secretary may accept proof of continuous use as evidence that the mark has become distinctive if the mark has been used by the applicant in this state for the five (5) years immediately preceding the date on which the claim of distinctiveness is made; or

- (6) Consists of or comprises a mark so resembling a mark registered in this state or a mark or trade name previously used in this state by another that has not been 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.

Effective: July 15, 1994

History: Created 1994 Ky. Acts ch. 468, sec. 2, effective July 15, 1994.

365.570 Repealed, 1994.

Catchline at repeal: Certificate of registration issued when -- Effect.

History: Repealed 1994 Ky. Acts ch. 468, sec. 18, effective July 15, 1994. -- Created 1966 Ky. Acts ch. 230, sec. 4.

365.571 Application for registration.

- (1) Subject to the limitations set forth in KRS 365.561 to 365.613, any person who uses a mark in this state may file an application for registration of that mark in the office of the Secretary, in a manner prescribed by the Secretary as set out in administrative regulations promulgated by the Secretary. The filing shall include, but not be limited to, the following:
 - (a) The name and business address of the person applying for the registration and, if a corporation, the state of incorporation, or if a partnership, the state in which the partnership is organized and the names of the general partners;
 - (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 comprising the goods or services;
 - (c) The date when the mark was first used anywhere and the date when it was first used in this state by the applicant or his predecessor-in-interest; and
 - (d) A statement that the applicant is the owner of the mark, that the mark is in use in this state, and that, to the knowledge of the person verifying the application, no other person has registered, either federally or in this state, or has the right to use the mark in this state in an identical form or in such near resemblance as to be likely, when used on or in connection with the goods or services of the other person, to cause confusion or mistake, or to deceive.
- (2) The Secretary may require a statement as to whether any applications to register the mark or portions or a composite of it have been filed by the applicant or his predecessor-in-interest in the United States Patent and Trademark Office. The Secretary may require applicants who have or whose predecessors have filed with the United States Patent and Trademark Office to include the filing date and serial number of each application, the status of the application and, whether the application was finally refused registration or has otherwise not resulted in a registration and the reasons therefor.
- (3) The Secretary may also require that a drawing of the mark, complying with requirements specified by the Secretary, accompany the application.
- (4) The application shall be signed by the applicant or a person authorized to sign on behalf of the applicant. The application shall contain a statement, under oath, that the information provided is true, complete and correct. Any person who makes a material false statement which he does not believe to be true in the application shall be in violation of KRS 523.030.
- (5) The application shall be accompanied by three (3) specimens showing the mark as actually used.
- (6) The application shall be accompanied by an application fee of ten dollars (\$10), payable to the Secretary.

Effective: July 15, 1994

History: Created 1994 Ky. Acts ch. 468, sec. 3, effective July 15, 1994.

365.573 Filing of applications.

- (1) Upon the filing of an application for registration and payment of the application fee prescribed in KRS 365.571, the Secretary may cause the application to be examined for conformity with KRS 365.561 to 365.613.
- (2) The applicant shall provide any additional pertinent information requested by the Secretary, including a description of the design mark, and may make, or authorize the Secretary to make any amendments to the application as are reasonably requested by the Secretary, or deemed advisable by the applicant to respond to any rejection or objection.
- (3) The Secretary may require the applicant to disclaim exclusive rights in 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 under another application if the disclaimed matter has become distinctive of the applicant's or registrant's goods or services.
- (4) The Secretary may amend the application with the applicant's agreement or may require a substitute application to be submitted.
- (5) The Secretary shall advise the applicant if he is not entitled to registration and state the reasons for the decision. The applicant shall have a reasonable period of time as set out in administrative regulations promulgated by the Secretary, in which to reply to or amend the application, in which event the application shall then be reexamined. This procedure may be repeated until:
 - (a) The Secretary finally refuses registration of the mark; or
 - (b) The applicant fails to reply to or amend the application within the specified period, whereupon the application shall be deemed to have been withdrawn.
- (6) If the Secretary finally refuses registration of the mark, the applicant may appeal the decision to the Franklin Circuit Court. The court may summarily order the Secretary to register the mark on proof that all the statements in the application are true and that the mark is otherwise entitled to registration. The Secretary of State shall not be liable for any court costs. The court's final decision may be appealed as in other civil proceedings.
- (7) If two (2) or more applications are concurrently being processed by the Secretary seeking registration of the same or confusingly similar marks for the same or related goods or services, the Secretary shall grant priority to the applications in the order of filing. If a prior-filed application is granted a registration, the other applications shall then be rejected. Any rejected applicant may bring an action for cancellation of the registration on grounds of prior or superior rights to the mark, in accordance with the provisions of KRS 365.591.

Effective: July 15, 1994

History: Created 1994 Ky. Acts ch. 468, sec. 4, effective July 15, 1994.

365.575 Repealed, 1994.

Catchline at repeal: Marks not to be registered.

History: Repealed 1994 Ky. Acts ch. 468, sec. 18, effective July 15, 1994. -- Created 1966 Ky. Acts ch. 230, sec. 2.

365.577 Certificate of registration.

- (1) Upon the applicant's compliance with the requirements of KRS 365.561 to 365.613, the Secretary 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 and the seal of the state, and it shall show the registrant's name and business address and, if the registrant is a corporation, the state of incorporation, or if a partnership, the state in which the partnership is organized, the names of the general partners, the person claiming ownership of the mark, the date claimed for the first use of the mark anywhere, the date claimed for the first use of the mark in this state, the class of goods or services, 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.
- (2) Any certificate of registration issued pursuant to this section or a copy of the certificate duly certified by the Secretary shall be admissible in evidence as competent and sufficient proof of the registration of the mark in any actions or judicial proceedings in any court of this state.

Effective: July 15, 1994

History: Created 1994 Ky. Acts ch. 468, sec. 5, effective July 15, 1994.

365.580 Repealed, 1994.

Catchline at repeal: Mark not to include different classes of goods.

History: Repealed 1994 Ky. Acts ch. 468, sec. 18, effective July 15, 1994. -- Created 1966 Ky. Acts ch. 230, sec. 10.

365.581 Duration and renewal.

- (1) A registration of a mark pursuant to KRS 365.561 to 365.613 shall be effective for a term of five (5) years from the date of registration and, may be renewed for a like term upon application filed within six (6) months prior to the expiration of the term, in a manner complying with the requirements of the Secretary as set out in administrative regulation. A renewal fee of five dollars (\$5), payable to the Secretary, shall accompany the application for renewal of the registration.
- (2) A registration may be renewed for successive periods of five (5) years in this manner.
- (3) The Secretary of State shall notify registrants of the necessity of renewing their registrations at least six (6) months prior to their pending expiration by writing to the last known address of the registrants.
- (4) Any registration in effect on July 15, 1994, shall continue in effect for the remainder of the unexpired term and may be renewed by filing an application for renewal with the Secretary, if the application for renewal complies with the requirements of the Secretary as set out in administrative regulations and is accompanied by the renewal fee prescribed in subsection (1) of this section and submitted within six (6) months prior to the expiration of the registration.
- (5) All applications for renewal pursuant to this section, whether of registrations made under KRS 365.561 to 365.613 or of registrations effected under any prior state law, shall include a verified statement that the mark has been and is still in use, and include a specimen showing actual use of the mark on or in connection with the goods or services.

Effective: July 15, 1994

History: Created 1994 Ky. Acts ch. 468, sec. 6, effective July 15, 1994.

365.583 Assignments, changes of name, and other instruments.

- (1) Any mark and its registration or application pursuant to KRS 365.561 to 365.613 shall be assignable with the goodwill of the business in which the mark is used, or with that part of the goodwill of the business connected with the use of and symbolized by the mark. An assignment shall be in writing, duly executed, and may be recorded with the Secretary upon the payment to the Secretary of a recording fee of five dollars (\$5). The Secretary shall issue in the name of the assignee of a registration a new certificate for the remainder of the term of the registration or renewal period. An assignment of any registration shall be void as against any subsequent purchaser for valuable consideration without notice, unless it is recorded with the Secretary within three (3) months after the date of the assignment or prior to the subsequent purchase.
- (2) Any registrant or applicant may record a certificate of change of name of the registrant or applicant with the Secretary upon the payment of the recording fee prescribed in subsection (1) of this section. The Secretary may issue in the name of the assignee a certificate of registration of an assigned application or a new certificate or registration for the remainder of the term of the registration or last renewal.
- (3) Other instruments relating to a registered mark or a pending application for registration, for example, licenses, security interests, or mortgages, may be recorded in the discretion of the Secretary, if the instrument is in writing and duly executed.
- (4) Acknowledgement shall constitute a rebuttable presumption that an assignment or other instrument was executed and, when recorded by the Secretary, that record shall constitute a rebuttable presumption of execution.
- (5) A photocopy of any instrument referred to in subsections (1), (2), or (3) of this section shall be accepted for recording if it is certified by any of the parties to the instrument or their successors as a true and correct copy of the original.

Effective: July 15, 1994

History: Created 1994 Ky. Acts ch. 468, sec. 7, effective July 15, 1994.

365.585 Repealed, 1994.

Catchline at repeal: Duration of registration -- Renewal -- Fee.

History: Repealed 1994 Ky. Acts ch. 468, sec. 18, effective July 15, 1994. -- Created 1966 Ky. Acts ch. 230, sec. 5.

365.587 Records.

The Secretary shall keep for public examination a record of all marks registered, renewed, or recorded under KRS 365.561 to 365.613.

Effective: July 15, 1994

History: Created 1994 Ky. Acts ch. 468, sec. 8, effective July 15, 1994.

365.590 Repealed, 1994.

Catchline at repeal: Assignment of marks -- Fee -- Recording, effect.

History: Repealed 1994 Ky. Acts ch. 468, sec. 18, effective July 15, 1994. -- Created 1966 Ky. Acts ch. 230, sec. 6.

365.591 Cancellation.

The Secretary shall cancel from the register, in whole or in part:

- (1) Any registration concerning which the Secretary receives a voluntary request for cancellation from the registrant or the assignee of record;
- (2) All registrations granted under KRS 365.561 to 365.613 and not renewed in accordance with those provisions;
- (3) Any registration concerning which a court of competent jurisdiction has found:
 - (a) That the registered mark has been abandoned;
 - (b) That the registrant is not the owner of the mark;
 - (c) That the registration was granted improperly;
 - (d) That the registration was obtained fraudulently;
 - (e) That the mark is or has become the generic name for the goods or services, or a portion of the goods or services for which it has been registered; or
 - (f) That the registered mark is so similar to a mark registered by another person in the United States Patent and Trademark Office prior to the date of the filing of the registrant's application and not abandoned as to likely cause confusion or mistake, or to deceive. If the registrant proves that he is the owner of a concurrent registration of a mark in the United States Patent and Trademark Office covering an area including this state, the registration granted pursuant to KRS 365.561 to 365.613 shall not be canceled for that area of the state; or
- (4) Any registration for which a court of competent jurisdiction orders cancellation on any ground.

Effective: July 15, 1994

History: Created 1994 Ky. Acts ch. 468, sec. 9, effective July 15, 1994.

365.593 Classification.

The Secretary shall promulgate administrative regulations establishing a system for classifying goods and services for purposes of administering KRS 365.561 to 365.613. This system shall not limit or extend the applicant's or registrant's rights. An 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 falling in multiple classes, the Secretary may require payment of the application fee of ten dollars (\$10) for each class. To the extent practical, the classification of goods and services shall conform to the classification adopted by the United States Patent and Trademark Office.

Effective: July 15, 1994

History: Created 1994 Ky. Acts ch. 468, sec. 10, effective July 15, 1994.

365.595 Repealed, 1994.

Catchline at repeal: Public record of marks.

History: Repealed 1994 Ky. Acts ch. 468, sec. 18, effective July 15, 1994. -- Created 1966 Ky. Acts ch. 230, sec. 7.

365.597 Fraudulent registration.

Any person who on behalf of himself or any other person, procures the filing or registration of any mark in the office of the Secretary pursuant to KRS 365.561 to 365.613 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 adjudged injured by any court of competent jurisdiction.

Effective: July 15, 1994

History: Created 1994 Ky. Acts ch. 468, sec. 11, effective July 15, 1994.

365.600 Repealed, 1994.

Catchline at repeal: Cancellation of registrations, when authorized.

History: Repealed 1994 Ky. Acts ch. 468, sec. 18, effective July 15, 1994. -- Created 1966 Ky. Acts ch. 230, sec. 9.

365.601 Infringement.

Subject to the provisions of KRS 365.611, any person who:

- (1) Uses, without the consent of the registrant, any reproduction, counterfeit, copy, or colorable imitation of a mark registered under KRS 365.561 to 365.613, or under KRS 365.560 to 365.625 prior to their repeal, in connection with the sale, distribution, offering for sale, or advertising of any goods or services which is likely to cause confusion or mistake or to deceive as to the source or origin of the goods or services; or
- (2) Reproduces, makes, counterfeits, copies or colorably imitates any mark and applies the 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 the goods or services;

shall be liable in a civil action by the registrant for any of the remedies provided in KRS 365.603, except that under subsection (2) of this section, 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.

Effective: July 15, 1994

History: Created 1994 Ky. Acts ch. 468, sec. 12, effective July 15, 1994.

365.603 Remedies.

- (1) Any owner of a mark registered under KRS 365.561 to 365.613, or under KRS 365.560 to 365.625 prior to their repeal, may seek to enjoin the manufacture, use, display, or sale of any counterfeits or imitations of the mark in any court of competent jurisdiction. The court may require the defendants to pay to that owner all profits derived from or all damages suffered by reason of the wrongful manufacture, use, display, or sale of the mark. The court may also order that any counterfeits or imitations in the possession or under the control of the defendant be delivered to an officer of the court or the complainant or be destroyed. The court may enter judgment for an amount not to exceed three (3) times the profits or damages, and may require reasonable attorney's fees to be paid to the prevailing party if the court finds the other party committed the wrongful acts with knowledge or in bad faith or otherwise according to the circumstances of the case.
- (2) Any right or remedy granted pursuant to KRS 365.561 to 365.613 shall not affect a registrant's right to pursue any remedies available to him under any criminal laws of this state.

Effective: July 15, 1994

History: Created 1994 Ky. Acts ch. 468, sec. 13, effective July 15, 1994.

365.605 Repealed, 1994.

Catchline at repeal: Revolving fund for fees.

History: Repealed 1994 Ky. Acts ch. 468, sec. 18, effective July 15, 1994. --Created 1966 Ky. Acts ch. 230, sec. 8.

365.607 Forum for actions regarding registration -- Service on out-of-state registrants.

- (1) Actions to require cancellation of a mark registered pursuant to KRS 365.561 to 365.613 or to compel registration of a mark pursuant to KRS 365.561 to 365.613 shall be brought in the Franklin Circuit Court. In an action to compel registration, the proceeding shall be based solely upon the record before the Secretary. In an action for cancellation, the Secretary shall not be made a party to the proceeding but shall be notified of the filing of the complaint by the clerk of the Franklin Circuit Court 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 as agent for service of the registrant in accordance with the procedures established for service upon nonresident corporations and business entities under KRS 454.210(3).

Effective: July 15, 1994

History: Created 1994 Ky. Acts ch. 468, sec. 14, effective July 15, 1994.

365.610 Repealed, 1994.

Catchline at repeal: Procuring registration by fraud, liability.

History: Repealed 1994 Ky. Acts ch. 468, sec. 18, effective July 15, 1994. -- Created 1966 Ky. Acts ch. 230, sec. 11.

365.611 Common law rights.

Nothing set out in KRS 365.561 to 365.613 shall adversely affect the rights or the enforcement of rights in marks acquired in good faith at any time at common law.

Effective: July 15, 1994

History: Created 1994 Ky. Acts ch. 468, sec. 15, effective July 15, 1994.

365.613 Fees not refundable.

Unless otherwise specified in KRS 365.561 to 365.613 and regulations promulgated pursuant to those sections, the fees payable under KRS 365.561 to 365.613 are not refundable.

Effective: July 15, 1994

History: Created 1994 Ky. Acts ch. 468, sec. 16, effective July 15, 1994.

365.615 Repealed, 1994.

Catchline at repeal: Unauthorized use or counterfeiting of mark, liability.

History: Repealed 1994 Ky. Acts ch. 468, sec. 18, effective July 15, 1994. -- Created 1966 Ky. Acts ch. 230, sec. 12.

365.620 Repealed, 1994.

Catchline at repeal: Restraint of use or counterfeit of mark.

History: Repealed 1994 Ky. Acts ch. 468, sec. 18, effective July 15, 1994. -- Created 1966 Ky. Acts ch. 230, sec. 13.

365.625 Repealed, 1994.

Catchline at repeal: Common-law rights enforceable.

History: Repealed 1994 Ky. Acts ch. 468, sec. 18, effective July 15, 1994. -- Created 1966 Ky. Acts ch. 230, sec. 14.