Arkansas Secretary of State

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Arkansas Trademark Law

4-71-201. Definitions.

As used in this subchapter:

(1) A mark shall be deemed to be "abandoned" when either of the following occurs:

(A)(i)(a) When its use has been discontinued with intent not to resume such use.

(b) Intent not to resume may be inferred from circumstances.

(ii) Nonuse for two (2) consecutive years shall constitute prima facie evidence of abandonment; or

(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” means the person filing an application for registration of a mark under this subchapter and the legal representatives, successors, or assigns of such person;

(3) “Dilution” means the lessening of the capacity of a famous mark to identify and distinguish goods or services, regardless of the presence or absence of:

(A) Competition between the owner of the famous mark and other parties; or

(B) A likelihood of confusion, mistake, or deception;

(4) “Mark” includes any trademark or service mark entitled to registration under this subchapter whether registered or not;

(5)(A) “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 this subchapter includes a juristic person as well as a natural person.

(B) 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) “Registrant” means the person to whom the registration of a mark under this subchapter is issued and the legal representatives, successors, or assigns of such person;

(7) “Secretary” means the Secretary of State or the designee of the Secretary of State charged with the administration of this subchapter;

(8)(A) “Service mark” means 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.

(B) 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;

(9) “Trade name” means any name used by a person to identify a business or vocation of such person;

(10) “Trademark” means 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 or sold by others, and to indicate the source of the goods, even if that source is unknown; and

(11)(A) “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.

(B) For the purposes of this subchapter, a mark shall be deemed to be in use:

(i) 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

(ii) On services when it is used or displayed in the sale or advertising of services and the services are rendered in this state.
History. Acts 1997, No. 1109, § 1.

4-71-202. 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 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, or any foreign nation, or any simulation;

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

(5)(A) 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;

(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.

(B)(i) Provided, however, that nothing in this subdivision (5) shall prevent the registration of a mark used by the applicant which has become distinctive of the applicant's goods or services.

(ii) 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 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

(6) 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.
History. Acts 1997, No. 1109, § 2.

4-71-203. Application for registration.

(a) Subject to the limitations set forth in this subchapter, any person who uses a mark may file in the office of the Secretary of State, in a manner complying with the requirements of 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, the state of incorporation, or if a partnership, the state in which the partnership is organized and 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 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, either federally or 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 mistake or to deceive.

(b)(1) 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 registration, the reasons therefor.

(2) The Secretary of State may also require that a drawing of the mark, complying with such requirements as the Secretary of State may specify, accompany the application.

(3) The application shall be signed and verified by oath, affirmation, or declaration subject to perjury laws by the applicant or by a member of the firm or an officer of the corporation or association applying.

(4) The application shall be accompanied by three (3) specimens showing the mark as actually used.

(5) The application shall be accompanied by the application fee payable to the Secretary of State.
History. Acts 1997, No. 1109, § 3.

4-71-204. Filing of applications.

(a) Upon the filing of an application for registration and payment of the application fee, the Secretary of State may cause the application to be examined for conformity with this subchapter.

(b) 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.

(c)(1) The Secretary of State may require the applicant to disclaim an unregisterable component of a mark otherwise registerable, and an applicant may voluntarily disclaim a component of a mark sought to be registered.

(2) 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 or shall have become distinctive of the applicant's or registrant's goods or services.

(d) Amendments may be made by the Secretary of State upon the application submitted by the applicant upon the applicant's agreement or a fresh application may be required to be submitted.

(e)(1) 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.

(2)(A) 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.

(B) This procedure may be repeated until:

(i) The Secretary of State finally refuses registration of the mark; or

(ii) The applicant fails to reply or amend within the specified period, whereupon the application shall be deemed to have been abandoned.

(f)(1) If the Secretary of State finally refuses registration of the mark, the applicant may seek a writ of mandamus to compel such registration.

(2) Such writ may be granted, but without costs 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.

(g)(1) In the instance of applications concurrently being processed by the Secretary of State seeking 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.

(2)(A) If a prior-filed application is granted a registration, the other application or applications shall then be rejected.

(B) 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 § 4-71-209.
History. Acts 1997, No. 1109, § 4.

4-71-205. Certificate of registration.

(a) Upon compliance by the applicant with the requirements of this subchapter, the Secretary of State shall cause a certificate of registration to be issued and delivered to the applicant.

(b) 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, 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, 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.

(c) 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 a mark in any actions or judicial proceedings in any court of this state.
History. Acts 1997, No. 1109, § 5.

4-71-206. Duration and renewal.

(a)(1) A registration of a mark under this subchapter shall be effective for a term of five (5) years from the date of registration and, upon application filed within six (6) months prior to the expiration of that term, in a manner complying with the requirements 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.

(3) A registration may be renewed for successive periods of five (5) years in like manner.

(b) Any registration in force on August 1, 1997, shall continue in full force and effect for the unexpired term and may be renewed by filing an application for renewal with the Secretary of State complying with the requirements of the Secretary of State and paying the renewal fee within six (6) months prior to the expiration of the registration.

(c) All applications for renewal under this subchapter, whether of registrations made under this subchapter or of registrations effected under any prior act, 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.
History. Acts 1997, No. 1109, § 6.

4-71-207. Assignments, changes of name, and other instruments.

(a)(1) Any mark and its registration under this subchapter 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.

(2) Assignment shall be by instruments in writing duly executed and shall be recorded with the Secretary of State upon the payment of the recording fee payable to the Secretary of State, who, upon recording 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.

(3) An assignment of any registration under this subchapter shall be void as against any subsequent purchaser for valuable consideration without notice, unless it is recorded with the Secretary of State within three (3) months after the date thereof or prior to such subsequent purchase.

(b)(1) 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 record a certificate of change of name of the registrant or applicant with the Secretary of State upon payment of the recording fee.

(2)(A) The Secretary of State may issue in the name of the assignee a certificate of registration of an assigned application.

(B) The Secretary of State may issue in the name of the assignee a new certificate or registration for the remainder of the term of the registration or last renewal thereof.

(c) Other instruments which relate to a mark registered or application pending pursuant to this subchapter such as, by way of example, licenses, security interests, or mortgages, may be recorded in the discretion of the Secretary of State provided that such instrument is in writing and duly executed.

(d) Acknowledgement shall be prima facie evidence of the execution of an assignment or other instrument and, when recorded by the Secretary of State, the record shall be prima facie evidence of execution.

(e) A photocopy of any instrument referred to in subsections (a), (b), or (c) of this section shall be accepted for recording if it is certified by any of the parties thereto, or their successors, to be a true and correct copy of the original.
History. Acts 1997, No. 1109, § 7.

4- 71-208. Records.

The Secretary of State shall keep for public examination a record of all marks registered or renewed under this subchapter, as well as a record of all documents recorded pursuant to § 4-71-207.
History. Acts 1997, No. 1109, § 8.

4-71-209. Cancellation.

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

(1) Any registration concerning which the Secretary of State shall receive a voluntary request for cancellation from the registrant or the assignee of record;

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

(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 has been registered; or

(F)(i) 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 application for registration by the registrant under this subchapter, and not abandoned, as to be likely to cause confusion or mistake or to deceive.

(ii) Provided, however, that should the registrant prove that the registrant 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 under this subchapter shall not be cancelled for that area of the state; or
(4) Any registration that a court of competent jurisdiction shall order cancelled on any ground.
History. Acts 1997, No. 1109, § 9.

4-71-210. Classification.

(a) The Secretary of State shall by regulation establish a classification of goods and services for convenience of administration of this subchapter, 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.

(b) 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.

(c) To the extent practical, the classification of goods and services should conform to the classification adopted by the United States Patent and Trademark Office.

History. Acts 1997, No. 1109, § 10.

4-71-211. Fraudulent registration.

Any person who shall for himself or herself, or on behalf of any other person, procure the filing or registration of any mark in the office of the Secretary of State under the provisions of this subchapter 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.

History. Acts 1997, No. 1109, § 11.

4-71-212. Infringement.

Subject to the provisions of § 4-71-216, any person who shall commit the following acts shall be liable in a civil action by the registrant for any and all of the remedies provided in § 4-71-214, except that under 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:

(1) To use, without the consent of the registrant, any reproduction, counterfeit, copy, or colorable imitation of a mark registered under this subchapter 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) To 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.

History. Acts 1997, No. 1109, § 12.

4-71-213. Injury to business reputation - Dilution.

(a)(1) The owner of a mark which is famous in this state shall be entitled, subject to the principles of equity and upon such terms as the court deems reasonable, to an injunction against another person's commercial use of a mark or trade name if such use begins after the mark has become famous and causes dilution of the distinctive quality of the mark, and to obtain such other relief as is provided in this section.

(2) In determining whether a mark is distinctive and famous, a court may consider factors such as, but not limited to:

(A) The degree of inherent or acquired distinctiveness of the mark in this state;

(B) The duration and extent of use of the mark in connection with the goods and services with which the mark is used;

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

(D) The geographical extent of the trading area in which the mark is used;

(E) The channels of trade for the goods or services with which the mark is used;

(F) The degree of recognition of the mark in the trading areas and channels of trade in this state used by the mark's owner and the person against whom the injunction is sought;

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

(H) Whether the mark is the subject of a state registration in this state, or a federal registration under the act of March 3, 1881, or under the act of February 20, 1905, or on the principal register.

(b)(1) In an action brought under this section, the owner of a famous mark shall be entitled only to injunctive relief in this state, unless the person against whom the injunctive relief is sought willfully intended to trade on the owner's reputation or to cause dilution of the famous mark.

(2) If such willful intent is proven, the owner shall also be entitled to the remedies set forth in this subchapter, subject to the discretion of the court and the principles of equity.

(c) The following shall not be actionable under this section:

(1) Fair use of a famous mark by another person in comparative commercial advertising or promotion to identify the competing goods or services of the owner of the famous mark;

(2) Noncommercial use of the mark; and

(3) All forms of news reporting and news commentary.
History. Acts 1997, No. 1109, § 13.

4-71-214. Remedies.

(a)(1)(A) Any owner of a mark registered under this subchapter may proceed by suit to enjoin the manufacture, use, display, or sale of any counterfeits or imitations of that mark and any court of competent jurisdiction may grant injunctions to restrain any manufacture, use, display, or sale as may be by the court deemed just and reasonable, and may require the defendants to pay to the owner all profits derived from or all damages suffered by reason of, or both, such wrongful manufacture, use, display, or sale.

(B) The court may also order that any such counterfeits or imitations in the possession or under the control of any defendant in such case be delivered to an officer of the court or to the complainant to be destroyed.

(2) The court, in its discretion, may enter judgment for an amount not to exceed three (3) times such profits and damages or reasonable attorney's fees of the prevailing party, or both, in cases where the court finds the other party committed wrongful acts with knowledge or in bad faith or otherwise as according to the circumstances of the case.

(b) The enumeration of any right or remedy in this section shall not affect a registrant's right to prosecute under any penal law of this state.
History. Acts 1997, No. 1109, § 14.

4-71-215. Forum for actions regarding registration - Service on out-of-state registrants.

(a)(1) Actions to require cancellation of a mark registered pursuant to this subchapter or in mandamus to compel registration of a mark pursuant to this subchapter shall be brought in the circuit court.

(2)(A) In an action in mandamus, the proceeding shall be based solely upon the record before the Secretary of State.

(B) 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.

(b) 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 §§ 16-58-126 and 16-58-127.
History. Acts 1997, No. 1109, § 15.

4-71-216. Common law rights.

Nothing in this subchapter shall adversely affect the rights or the enforcement of rights in marks acquired in good faith at any time at common law.
History. Acts 1997, No. 1109, § 16.

4-71-217. Fees.

(a) The Secretary of State shall by regulation prescribe the fees payable for the various applications and recording fees and for related services.

(b) Unless specified by the Secretary of State, the fees payable in this subchapter are not refundable.
History. Acts 1997, No. 1109, § 17.

4-71-218. Repeal of prior acts - Intent of subchapter.

(a)(1) This subchapter shall not affect any suit, proceeding, or appeal pending prior to August 1, 1997.

(2)(A) All acts relating to marks and parts of any other acts inconsistent herewith are hereby repealed on August 1, 1997.

(B) Provided, that as to any application, suit, proceeding, or appeal pending at the time this subchapter takes effect, and for that purpose only, such repeal shall be deemed not to be effective until final determination of said pending application, suit, proceeding, or appeal.

(b)(1) The intent of this subchapter 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.

(2) To that end, the construction given the federal act should be examined as persuasive authority for interpreting and construing this subchapter.
History. Acts 1997, No. 1109, § 20.