

BUSINESS AND COMMERCE CODE
TITLE 2. COMPETITION AND TRADE PRACTICES
CHAPTER 16. TRADEMARKS

SUBCHAPTER A. GENERAL PROVISIONS

Sec. 16.001. DEFINITIONS. In this chapter:

(1) "Applicant" means a person applying for registration of a mark under this chapter. The term includes the person's legal representative, successor, and assignee.

(2) "Dilution" means dilution by blurring or dilution by tarnishment, without regard to the presence or absence of:

(A) competition between the owner of a famous mark and another person;

(B) actual or likely confusion, mistake, or deception; or

(C) actual economic harm.

(3) "Dilution by blurring" means an association arising from the similarity between a mark or trade name and a famous mark that impairs the famous mark's distinctiveness.

(4) "Dilution by tarnishment" means an association arising from the similarity between a mark or trade name and a famous mark that harms the famous mark's reputation.

(5) "Mark" includes a trademark or service mark that is registrable under this chapter, regardless of whether the trademark or service mark is actually registered.

(6) "Person," with respect to the applicant or another person who is entitled to a benefit or privilege or is rendered liable under this chapter, includes:

(A) a natural person; and

(B) a firm, partnership, corporation, association, union, or other organization that may sue or be sued in that capacity.

(7) "Registrant" means the person to whom a registration of a mark has been issued under this chapter. The term includes the person's legal representative, successor, or assignee.

(8) "Service mark":

(A) means a word, name, symbol, or device, or any combination of those terms, used by a person to:

(i) identify and distinguish the services of one person, including a unique service, from the services of another; and

(ii) indicate the source of the services, regardless of whether the source is unknown; and

(B) includes the titles, character names used by a person, and other distinctive features of radio or television programs, regardless of whether the titles, character names, or programs advertise the sponsor's goods.

(9) "Trade name" means a name used by a person to identify the person's business or vocation.

(10) "Trademark" means a word, name, symbol, or device, or any combination of those terms, used by a person to:

(A) identify and distinguish the person's goods, including a unique product, from the goods manufactured or sold by another; and

(B) indicate the source of the goods, regardless of whether the source is unknown.

Amended by:

Acts 2011, 82nd Leg., R.S., Ch. 563 (H.B. [3141](#)), Sec. 1, eff. September 1, 2012.

Sec. 16.002. INAPPLICABILITY OF CHAPTER. (a) This chapter does not apply to the registration or use of a livestock brand or other indicia of ownership of goods that do not qualify as a mark.

(b) Except as provided by this subsection, a trade name is not registrable under this chapter. If a trade name is also a service mark or trademark, the trade name is registrable as a service mark or trademark.

Amended by:

Acts 2011, 82nd Leg., R.S., Ch. 563 (H.B. [3141](#)), Sec. 1, eff. September 1, 2012.

Acts 2013, 83rd Leg., R.S., Ch. 762 (S.B. [1033](#)), Sec. 1, eff. September 1, 2013.

Sec. 16.003. WHEN MARK CONSIDERED TO BE IN USE. (a) A mark is considered to be in use in this state in connection with goods when:

(1) the mark is placed in any manner on:
(A) the goods;
(B) containers of the goods;
(C) displays associated with the goods;
(D) tags or labels affixed to the goods; or
(E) documents associated with the goods or sale of the goods, if the nature of the goods makes placement described by Paragraphs (A) through (D) impracticable; and

(2) the goods are sold or transported in commerce in this state.

(b) A mark is considered to be in use in this state in connection with services when:

(1) the mark is used or displayed in this state in connection with selling or advertising the services; and

(2) the services are rendered in this state.

(c) Use of a mark made merely to reserve a right in the mark is not considered to be a bona fide use of a mark for purposes of this chapter.

Amended by:

Acts 2011, 82nd Leg., R.S., Ch. 563 (H.B. [3141](#)), Sec. 1, eff. September 1, 2012.

Acts 2013, 83rd Leg., R.S., Ch. 762 (S.B. [1033](#)), Sec. 2, eff. September 1, 2013.

Sec. 16.004. WHEN MARK CONSIDERED TO BE ABANDONED. (a) A mark is considered to be abandoned when:

(1) the mark's use has been discontinued with intent not to resume the use; or

(2) the owner's conduct, including an omission or commission of an act, causes the mark to lose its significance as a mark.

(b) Intent not to resume use of a mark under Subsection (a)(1) may be inferred from the circumstances.

(c) Nonuse of a mark as described by Subsection (a)(1) for three consecutive years constitutes prima facie evidence of the mark's abandonment.

Amended by:

Acts 2011, 82nd Leg., R.S., Ch. 563 (H.B. [3141](#)), Sec. 1, eff. September 1, 2012.

SUBCHAPTER B. REGISTRATION OF MARK

Sec. 16.051. REGISTRABLE MARKS. (a) A mark that distinguishes an applicant's goods or services from those of others is registrable unless the mark:

(1) consists of or comprises matter that is immoral, deceptive, or scandalous;

(2) consists of or comprises matter that may disparage, falsely suggest a connection with, or bring into contempt or disrepute:

(A) a person, whether living or dead;

(B) an institution;

(C) a belief; or

(D) a national symbol;

(3) depicts, comprises, or simulates the flag, the coat of arms, the seal, the geographic outline, or other insignia of:

(A) the United States;

(B) a state;

(C) a municipality; or

(D) a foreign nation;

(4) consists of or comprises the name, signature, or portrait of a particular living individual who has not consented in writing to the mark's registration;

(5) when used on or in connection with the applicant's goods or services:

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

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

(6) is primarily merely a surname; or

(7) is likely to cause confusion or mistake, or to deceive, because, when used on or in connection with the applicant's goods or services, it resembles:

(A) a mark registered in this state; or

(B) an unabandoned mark registered with the United States Patent and Trademark Office.

(b) Subsection (a)(5) or (6) does not prevent the registration of a mark used by the applicant that has become distinctive as applied to the applicant's goods or services. The secretary of state may accept as evidence that a mark has become distinctive, when used on or in connection with the applicant's goods or services, proof of continuous use of the mark as such by the applicant in this state for the five years preceding the date on which the claim of distinctiveness is made.

Amended by:

Acts 2011, 82nd Leg., R.S., Ch. 563 (H.B. [3141](#)), Sec. 1, eff. September 1, 2012.

Acts 2017, 85th Leg., R.S., Ch. 967 (S.B. [2065](#)), Sec. 16.001, eff. September 1, 2017.

Sec. 16.052. APPLICATION FOR REGISTRATION. (a) Subject to the limitations prescribed by this chapter, a person who uses a mark may file an application to register the mark in the office of the secretary of state in the manner prescribed by the secretary of state.

(b) The application must include:

(1) the name and business address of the applicant;

(2) if the applicant is a corporation, the state under whose laws the applicant was incorporated or organized;

(3) if the applicant is a partnership, the state under whose laws the partnership was organized and the names of the general partners;

(4) the names or a description of the goods or services on or in connection with which the mark is being used;

(5) the mode or manner in which the mark is being used on or in connection with the goods or services;

(6) the class to which the goods or services belong;

(7) the date the applicant or applicant's predecessor in interest first used the mark anywhere;

(8) the date the applicant or the applicant's predecessor in interest first used the mark in this state; and

(9) a statement that:

(A) the applicant is the owner of the mark;

(B) the mark is in use; and

(C) to the knowledge of the person verifying the application, no other person:

(i) has registered the mark, either federally or in this state; or

(ii) is entitled to use the mark in this state:

(a) in the identical form used by the applicant; or

(b) in a form that is likely, when used on or in connection with the goods or services of the other person, to cause confusion or mistake, or to deceive, because of its resemblance to the mark.

(c) The secretary of state may also require a statement as to whether the applicant or the applicant's predecessor in interest has filed an application to register the mark, or a portion or composite of the mark, with the United States Patent and Trademark Office, and, if so, the applicant shall fully disclose information with respect to that filing, including:

(1) the filing date and serial number of each application;

(2) the status of the filing; and

(3) if any application was finally refused registration or has not otherwise resulted in the issuance of a registration, the reasons for the refusal or nonissuance.

(d) The application must be accompanied by:

(1) three specimens of the mark as actually used; and

(2) an application fee payable to the secretary of state.

(e) The application must be signed and verified by the oath

or affirmation of:

(1) the applicant; or

(2) a member of the firm or officer of the corporation or association that is applying for registration of the mark, as applicable.

(f) The secretary of state may also require that a drawing of the mark that complies with any requirement specified by the secretary of state accompany the application.

Amended by:

Acts 2011, 82nd Leg., R.S., Ch. 563 (H.B. 3141), Sec. 1, eff. September 1, 2012.

Sec. 16.053. FILING OF APPLICATION; EXAMINATION. (a) On the filing of an application for registration and payment of the application fee, the secretary of state shall examine the application for compliance with this chapter.

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

Amended by:

Acts 2011, 82nd Leg., R.S., Ch. 563 (H.B. 3141), Sec. 1, eff. September 1, 2012.

Sec. 16.054. AMENDMENT TO APPLICATION. (a) In response to the secretary of state's rejection of or objection to the registration, the applicant may amend, or authorize the secretary of state to amend, the application on reasonable request of the secretary of state or if the applicant considers it advisable.

(b) The secretary of state, on agreement by the applicant, may amend the application submitted by the applicant. The secretary of state may require the applicant to submit a new application instead of amending the application.

Amended by:

Acts 2011, 82nd Leg., R.S., Ch. 563 (H.B. 3141), Sec. 1, eff. September 1, 2012.

Sec. 16.055. DISCLAIMER OF UNREGISTRABLE COMPONENT.

(a) The secretary of state may require the applicant to disclaim an unregistrable component of a mark that is otherwise registrable. An applicant may voluntarily disclaim a component of a mark sought to be registered.

(b) A disclaimer may not prejudice or affect:

(1) the rights of the applicant or registrant in the disclaimed matter; or

(2) the rights of the applicant or registrant to submit another application to register the mark if the disclaimed matter is or has become distinctive of the applicant's or registrant's goods or services.

Amended by:

Acts 2011, 82nd Leg., R.S., Ch. 563 (H.B. 3141), Sec. 1, eff. September 1, 2012.

Sec. 16.056. CONCURRENT APPLICATIONS FOR SAME OR SIMILAR MARK. (a) When concurrently processing applications for the same or confusingly similar marks used on or in connection with the same or related goods or services, the secretary of state shall grant priority to the application that was filed first. If a prior filed application is granted a registration, the secretary of state shall reject any other subsequently filed application.

(b) An applicant whose application is rejected under this section may bring an action in accordance with Section 16.106 for cancellation of the previously issued registration on the ground that the applicant has a prior or superior right to the mark.

Amended by:

Acts 2011, 82nd Leg., R.S., Ch. 563 (H.B. 3141), Sec. 1, eff. September 1, 2012.

Sec. 16.057. DENIAL OF REGISTRATION; NOTICE. (a) If the secretary of state determines that the applicant is not entitled to register the mark, the secretary of state shall:

(1) notify the applicant of the determination and the reason for the denial of the application; and

(2) give the applicant reasonable time as prescribed by the secretary of state in which to issue a response to the denial

or amend the application, in which event the secretary of state shall reexamine the application.

(b) The applicant may repeat the examination procedures described by Subsection (a) until the earlier of:

(1) the expiration of the period prescribed by the secretary of state under Subsection (a)(2); or

(2) the date on which the secretary of state finally refuses registration of the application.

(c) If the applicant fails to respond to the denial or to amend the application within the period prescribed by the secretary of state under Subsection (a)(2), the application is considered to have been abandoned.

(d) If the secretary of state finally refuses registration of the mark, the applicant may seek a writ of mandamus against the secretary of state to compel registration in accordance with the procedures prescribed by Section 16.106. The writ of mandamus may be granted, 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.

Amended by:

Acts 2011, 82nd Leg., R.S., Ch. 563 (H.B. 3141), Sec. 1, eff. September 1, 2012.

Sec. 16.058. CERTIFICATE OF REGISTRATION. (a) If the application complies with the requirements of this chapter, the secretary of state shall cause a certificate of registration to be issued and delivered to the applicant.

(b) The certificate of registration must:

(1) be signed by the secretary of state;

(2) be issued under the secretary of state's official seal;

(3) indicate the name and business address of the person claiming ownership of the mark;

(4) if the applicant is a corporation, indicate the state under whose laws the applicant was incorporated or organized;

(5) if the applicant is a partnership, indicate the state under whose laws the partnership was organized and the names

of the general partners;

(6) include a description of the goods or services on or in connection with which the mark is being used;

(7) state the class of the goods or services;

(8) state the date claimed for the first use of the mark anywhere;

(9) state the date claimed for the first use of the mark in this state;

(10) show a reproduction of the mark;

(11) state the registration date; and

(12) state the term of the registration.

Amended by:

Acts 2011, 82nd Leg., R.S., Ch. 563 (H.B. 3141), Sec. 1, eff. September 1, 2012.

Sec. 16.059. TERM AND RENEWAL OF REGISTRATION. (a) The registration of a mark under this chapter expires on the fifth anniversary of the date of registration.

(b) The registration of a mark under this chapter may be renewed for an additional five-year term by filing a renewal application in the manner prescribed by the secretary of state and paying a renewal fee not earlier than the 180th day before the date the registration expires.

(c) An application for renewal under this chapter, whether of a registration made under this chapter, or a registration that took effect under a predecessor statute, must include:

(1) a verified statement stating that the mark has been and is still in use in this state; and

(2) a specimen of the mark, as actually used on or in connection with the goods or services.

(d) A mark for which a registration was in effect on August 31, 2012, continues in effect for the unexpired term of the registration and may be renewed by complying with the requirements for renewal under this section.

Amended by:

Acts 2011, 82nd Leg., R.S., Ch. 563 (H.B. 3141), Sec. 1, eff. September 1, 2012.

Acts 2013, 83rd Leg., R.S., Ch. 762 (S.B. 1033), Sec. 3, eff. September 1, 2013.

Sec. 16.060. RECORD AND PROOF OF REGISTRATION. (a) The secretary of state shall keep for public examination a record of all:

- (1) marks registered or renewed under this chapter;
- (2) assignments recorded under Section 16.061; and
- (3) other instruments recorded under Section 16.062.

(b) Registration of a mark under this chapter is constructive notice throughout this state of the registrant's claim of ownership of the mark throughout this state.

(c) A certificate of registration issued by the secretary of state under this chapter, or a copy of it certified by the secretary of state, is admissible in evidence as prima facie proof of:

- (1) the validity of the registration;
- (2) the registrant's ownership of the mark; and
- (3) the registrant's exclusive right to use the mark in commerce in this state in connection with the goods or services specified in the certificate, subject to any conditions and limitations stated in the certificate.

Amended by:

Acts 2011, 82nd Leg., R.S., Ch. 563 (H.B. 3141), Sec. 1, eff. September 1, 2012.

Sec. 16.061. ASSIGNMENT OF MARK AND REGISTRATION. (a) A mark and its registration under this chapter are 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.

(b) An assignment must be made by a properly executed written instrument and may be recorded with the secretary of state by:

- (1) filing the assignment; and
- (2) paying a recording fee to the secretary of state.

(c) If an assignment has been properly filed for record under Subsection (b), the secretary of state shall issue in the

assignee's name a new certificate of registration for the remainder of the term of the mark's registration or last renewal.

(d) The assignment of a mark registered under this chapter is void against a purchaser who purchases the mark for valuable consideration after the assignment is made and without notice of it unless the assignment is recorded by the secretary of state:

(1) not later than the 90th day after the date of the assignment; or

(2) before the mark is purchased.

(e) An acknowledgment is prima facie evidence of the execution of an assignment, and when recorded by the secretary of state, the record is prima facie evidence of execution.

Amended by:

Acts 2011, 82nd Leg., R.S., Ch. 563 (H.B. [3141](#)), Sec. 1, eff. September 1, 2012.

Sec. 16.062. RECORDING OF OTHER INSTRUMENTS. (a) A certificate of the registrant or applicant effecting a name change of the person to whom the mark was issued or for whom an application was filed may be recorded with the secretary of state by paying a recording fee to the secretary of state.

(b) Other properly executed written instruments that relate to a mark registered or an application pending with the secretary of state under this chapter, including a license, security interest, or mortgage, may be recorded with the secretary of state, at the secretary of state's discretion.

(c) An acknowledgment is prima facie evidence of the execution of an instrument other than an assignment under this section, and when recorded by the secretary of state, the record is prima facie evidence of execution.

(d) The secretary of state must accept for recording a copy of an original instrument under this section if the copy is certified to be a true copy by any party to the transaction or the party's successor.

Amended by:

Acts 2011, 82nd Leg., R.S., Ch. 563 (H.B. [3141](#)), Sec. 1, eff. September 1, 2012.

Sec. 16.063. CHANGE OF REGISTRANT'S NAME. If a registrant's name is changed during the unexpired term of a mark's registration, a new certificate of registration may be issued for the remainder of the unexpired term in the new name of the registrant on the filing of a certificate under Section 16.062.

Amended by:

Acts 2011, 82nd Leg., R.S., Ch. 563 (H.B. 3141), Sec. 1, eff. September 1, 2012.

Sec. 16.064. CANCELLATION OF REGISTRATION. (a) The secretary of state shall cancel a registration:

(1) in force on August 31, 2012, that has not been renewed under Section 16.059;

(2) on receipt of a voluntary request for cancellation from the registrant under this chapter or the registrant's assignee of record;

(3) granted under this chapter and not renewed under Section 16.059;

(4) with respect to which a court has rendered a judgment finding 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 registered mark is or has become the generic name for the goods or services, or part of the goods or services, in connection with which the mark was registered;

(F) the registered mark is so similar, as to be likely to cause confusion or mistake or to deceive, to a mark that:

(i) is registered by another person in the United States Patent and Trademark Office before the date the application for registration was filed under this chapter; and

(ii) is not abandoned; or

(G) the registration was canceled by order of a court on any ground; or

(5) when a court of competent jurisdiction orders

cancellation of a registration on any ground.

(b) If a registrant's mark is considered for cancellation under Subsection (a)(4)(F) and the registrant proves that the registrant is the owner of a mark concurrently registered as a mark with the United States Patent and Trademark Office to cover a geographical area that includes a part of this state, the secretary of state may not cancel registration of the mark for the geographical area of this state covered by the federal registration.

Amended by:

Acts 2011, 82nd Leg., R.S., Ch. 563 (H.B. [3141](#)), Sec. 1, eff. September 1, 2012.

Sec. 16.065. CLASSIFICATION OF GOODS AND SERVICES.

(a) The secretary of state by rule shall establish a classification of goods and services for the convenient administration of this chapter. The classifications established under this section may not limit or expand an applicant's or registrant's rights. To the extent practicable, the classification of goods and services must conform to the classification of goods and services adopted by the United States Patent and Trademark Office.

(b) An applicant may include in a single application for registration of a mark any or all goods or services in connection with which the mark is actually being used and the appropriate class or classes of the goods or services.

(c) If a single application for registration of a mark includes goods or services that belong in multiple classes, the secretary of state may require payment of a fee for each class of goods or services.

Amended by:

Acts 2011, 82nd Leg., R.S., Ch. 563 (H.B. [3141](#)), Sec. 1, eff. September 1, 2012.

Sec. 16.066. FEES. (a) The secretary of state by rule shall prescribe the amount of fees payable for the various applications and for the filing and recording of those applications

for related services.

(b) Unless specified otherwise by the secretary of state, a fee under this chapter is not refundable.

Amended by:

Acts 2011, 82nd Leg., R.S., Ch. 563 (H.B. [3141](#)), Sec. 1, eff. September 1, 2012.

SUBCHAPTER C. ENFORCEMENT

Sec. 16.101. FRAUDULENT REGISTRATION. A person who procures for the person or another the filing of an application or the registration of a mark under this chapter by knowingly making a false or fraudulent representation or declaration, oral or written, or by any other fraudulent means, is liable to pay all damages sustained as a result of the filing or registration. The damages may be recovered by or on behalf of the injured party in any court of competent jurisdiction.

Amended by:

Acts 2011, 82nd Leg., R.S., Ch. 563 (H.B. [3141](#)), Sec. 1, eff. September 1, 2012.

Sec. 16.102. INFRINGEMENT OF REGISTERED MARK. (a) Subject to Section [16.107](#), a person commits an infringement if the person:

(1) without the registrant's consent, uses anywhere in this state a reproduction, counterfeit, copy, or colorable imitation of a mark registered under this chapter in connection with selling, distributing, offering for sale, or advertising goods or services when the use is likely to deceive or cause confusion or mistake as to the source or origin of the goods or services; or

(2) reproduces, counterfeits, copies, or colorably imitates a mark registered under this chapter and applies the reproduction, counterfeit, copy, or colorable imitation to a label, sign, print, package, wrapper, receptacle, or advertisement intended to be used in selling or distributing, or in connection with the sale or distribution of, goods or services in this state.

(b) A registrant may sue for damages and to enjoin an infringement proscribed by Subsection (a).

(c) If the court determines that there has been an infringement, the court shall enjoin the act of infringement and may:

(1) subject to Subsection (d), require the violator to pay the registrant all profits derived from or damages resulting from the acts of infringement; and

(2) order that the infringing counterfeits or imitations in the possession or under the control of the violator be:

(A) delivered to an officer of the court to be destroyed; or

(B) delivered to the registrant to be destroyed.

(d) If the court finds that the violator acted with actual knowledge of the registrant's mark or in bad faith, the court, in the court's discretion, may:

(1) enter judgment in an amount not to exceed three times the amount of profits and damages; and

(2) award reasonable attorney's fees to the prevailing party.

(e) A registrant is entitled to recover damages under Subsections (a)(2), (c)(1), and (d) only if the violator acted with intent to cause confusion or mistake or to deceive.

(f) The enumeration of any right or remedy under this section does not affect the prosecution of conduct under the penal laws of this state.

Amended by:

Acts 2011, 82nd Leg., R.S., Ch. 563 (H.B. [3141](#)), Sec. 1, eff. September 1, 2012.

Sec. 16.103. INJURY TO BUSINESS REPUTATION; DILUTION.

(a) Subject to the principles of equity, the owner of a mark that is famous and distinctive, inherently or through acquired distinctiveness, in this state is entitled to enjoin another person's commercial use of a mark or trade name that begins after the mark has become famous if use of the mark or trade name is likely to cause the dilution of the famous mark.

(b) For purposes of this section, a mark is considered to be

famous if the mark is widely recognized by the public throughout this state or in a geographic area in this state as a designation of source of the goods or services of the mark's owner. In determining whether a mark is famous, a court may consider factors including:

(1) the duration, extent, and geographic reach of the advertisement and publicity of the mark in this state, regardless of whether the mark is advertised or publicized by the owner or a third party;

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

(3) the extent of actual recognition of the mark in this state; and

(4) whether the mark is registered in this state or in the United States Patent and Trademark Office.

(c) In an action brought under this section, the owner of a famous mark is entitled to injunctive relief throughout the geographic area in this state in which the mark is found to have become famous before the use of the other mark. If the court finds that the person against whom the injunctive relief is sought wilfully intended to cause the dilution of the famous mark, the owner shall also be entitled to remedies under this chapter, subject to the court's discretion and principles of equity.

(d) A person may not bring an action under this section for:

(1) a fair use, including a nominative or descriptive fair use, or facilitation of the fair use, of a famous mark by another person other than as a designation of source for the person's own goods or services, including a fair use in connection with:

(A) advertising or promoting that permits consumers to compare goods or services; or

(B) identifying and parodying, criticizing, or commenting on the famous mark owner or the famous mark owner's goods or services;

(2) a noncommercial use of the mark; or

(3) any form of news reporting or commentary.

Amended by:

Acts 2011, 82nd Leg., R.S., Ch. 563 (H.B. 3141), Sec. 1, eff. September 1, 2012.

Sec. 16.104. REMEDIES. (a) An owner of a mark registered under this chapter may bring an action to enjoin the manufacture, use, display, or sale of any counterfeits or imitations of a mark.

(b) If the court finds that a wrongful act described by Subsection (a) has been committed, the court shall enjoin the wrongful manufacture, use, display, or sale and may:

(1) subject to Subsection (c), require the violator to pay to the owner of the mark all profits derived from or damages resulting from the wrongful acts; and

(2) order that the wrongful counterfeits or imitations in the possession or under the control of the defendant be:

(A) delivered to an officer of the court to be destroyed; or

(B) delivered to the complainant to be destroyed.

(c) If the court finds that the violator committed the wrongful acts with knowledge of the registrant's mark or in bad faith, or otherwise as according to the circumstances of the case, the court, in the court's discretion, may:

(1) enter judgment in an amount not to exceed three times the amount of profits and damages; and

(2) award reasonable attorney's fees to the prevailing party.

Amended by:

Acts 2011, 82nd Leg., R.S., Ch. 563 (H.B. 3141), Sec. 1, eff. September 1, 2012.

Sec. 16.105. OLYMPIC SYMBOLS. (a) Without the permission of the United States Olympic Committee, a person may not, for the purpose of trade, to induce the sale of goods or services, or to promote a theatrical exhibition, athletic performance, or competition, use:

(1) the symbol of the International Olympic Committee, consisting of five interlocking rings;

(2) the emblem of the United States Olympic Committee,

consisting of an escutcheon having a blue chief and vertically extending red and white bars on the base with five interlocking rings displayed on the chief;

(3) a trademark, trade name, sign, symbol, or insignia falsely representing association with or authorization by the International Olympic Committee or the United States Olympic Committee; or

(4) the words "Olympic," "Olympiad," or "Citius Altius Fortius" or a combination or simulation of those words that tends to cause confusion or mistake, to deceive, or to suggest falsely a connection with the United States Olympic Committee or an Olympic activity.

(b) On violation of Subsection (a), the United States Olympic Committee is entitled to the remedies available to a registrant on infringement of a mark registered under this chapter. Added by Acts 1997, 75th Leg., ch. 248, Sec. 2, eff. Sept. 1, 1997. Amended by:

Acts 2011, 82nd Leg., R.S., Ch. 563 (H.B. 3141), Sec. 1, eff. September 1, 2012.

Sec. 16.106. FORUM FOR ACTIONS REGARDING REGISTRATION; SERVICE ON OUT-OF-STATE REGISTRANTS. (a) An action to require cancellation of a mark registered under this chapter or in mandamus to compel registration of a mark under this chapter shall be brought in a district court of Travis County. In an action to compel registration of a mark, the proceeding must be based solely on the record before the secretary of state.

(b) In an action for cancellation, the secretary of state may 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 the action is filed and shall be given the right to intervene in the action.

(c) In an action brought against a nonresident registrant, service may be made on the secretary of state as agent for service of process of the registrant in accordance with the procedures established for service on foreign corporations and business entities under the Business Organizations Code.

Added by Acts 1997, 75th Leg., ch. 248, Sec. 2, eff. Sept. 1, 1997.

Amended by:

Acts 2011, 82nd Leg., R.S., Ch. 563 (H.B. [3141](#)), Sec. 1, eff. September 1, 2012.

Sec. 16.107. COMMON LAW RIGHTS NOT AFFECTED. No registration under this chapter adversely affects common law rights acquired prior to registration under this chapter. However, during any period when the registration of a mark under this chapter is in force and the registrant has not abandoned the mark, no common law rights as against the registrant of the mark may be acquired.

Added by Acts 1997, 75th Leg., ch. 248, Sec. 2, eff. Sept. 1, 1997.

Amended by:

Acts 2011, 82nd Leg., R.S., Ch. 563 (H.B. [3141](#)), Sec. 1, eff. September 1, 2012.