

Trademark Laws: Tennessee

by Adam Baldridge and Nicole Berkowitz Riccio, Baker Donelson, with Practical Law Intellectual Property & Technology

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A Q&A guide to Tennessee laws protecting trademarks. This Q&A addresses state laws governing trademark registration, infringement, dilution, counterfeiting, unfair competition, and deceptive trade practices. Answers to questions can be compared across a number of jurisdictions (see Trademark Laws: State Q&A Tool).

State Trademark Registration Statute

1. Does your state have a state trademark registration statute? If so, please:

- Identify the statute.
- Identify the state agency responsible for administering trademark applications and registrations.
- Describe the key substantive state trademark registration requirements.
- Describe the key benefits of state registration.

Tennessee has a trademark registration statute. The Tennessee Trade Mark Act of 2000 is codified in T.C.A. §§ 47-25-501 to 47-25-518.

State Agency

The [Tennessee secretary of state's Division of Business Services](#) (TNSOS) administers Tennessee trademark applications and registrations. Trademark and service mark registration forms and other resources are available on the TNSOS Trademarks [website](#).

Key Substantive Registration Requirements

Types of Marks Covered

The Tennessee trademark statute provides for registration of:

- Trademarks.
 - Service marks.
- (T.C.A. § 47-25-501(4).)

Use Requirements and Intent-to-Use Applications

The Tennessee trademark statute:

- Requires actual use of the mark in Tennessee.
- Does not authorize intent-to-use applications.

(T.C.A. § 47-25-503(a).)

A mark is in use when it is:

- Placed in any manner on goods or on containers, displays, or documents associated with goods that are sold or transported in commerce in Tennessee.
- Used or displayed in the sale or advertising of services rendered in Tennessee.

(T.C.A. § 47-25-501(11).)

Statutory Bars to Registration

The Tennessee trademark statute sets out substantially the same statutory bars to registration as those set out in Section 2 of the Lanham Act (T.C.A. § 47-25-502; 15 U.S.C. § 1052). For a discussion of the Lanham Act statutory bars to registration, including provisions the US Supreme Court recently struck down as unconstitutional, see [Practice Note, Acquiring Trademark Rights and Registrations: Immoral, Scandalous, and Other Restricted Matter](#).

Other Key Substantive Registration Requirements

To register a mark in Tennessee, an applicant must:

- State the applicant's name, business address, and if applicable:
 - the state of incorporation or organization; and
 - the general partners' names.
- Describe the goods or services for which the mark is intended, including:
 - listing the mode or manner the mark is used in connection with the goods or services; and
 - entering the number and name of the class of the goods and services.
- Specify the dates when the mark was first used:
 - anywhere; and
 - in Tennessee.
- Describe the mark in words.
- Include a statement that:
 - the applicant is the owner of the mark;
 - the mark is in use; and
 - to the knowledge of the applicant, no other person has registered an identical or confusingly similar mark or has the right to use it.
- Sign and verify the [application](#).
- Submit one specimen of the mark.
- Pay a \$20 filing fee for each class.

(T.C.A. § 47-25-503; see [TNSOS: Application for Registration of Trademark or Service Mark](#).)

The applicant may also need to:

- Include a statement about whether the applicant has filed an application with the US Patent and Trademark Office.
- Submit a drawing of the mark.

(T.C.A. § 47-25-503(b), (c).)

Key Benefits of State Registration

Procedural

In actions or judicial proceedings in Tennessee, a certificate or certified copy of registration is competent and sufficient proof of the registration of the mark (T.C.A. § 47-25-505(b)).

Substantive

Registration of a trademark provides the registrant with the remedies of:

- Injunctive relief.
- Destruction of counterfeits and imitations in the possession or control of any defendant.

(T.C.A. § 47-25-514(a).)

The court may award disgorgement of profits and damages if the infringer acted with the intent to cause either:

- Confusion.
- Mistake.
- Deception.

(T.C.A. §§ 47-25-512 and 47-25-514.)

If the defendant acted knowingly or in bad faith, the registrant may be entitled to:

- Up to three times the profits and damages.
- Reasonable attorneys' fees.

(T.C.A. § 47-25-514(a).)

2. Indicate the term of a state trademark registration and the key registration renewal requirements.

Registration Term

A mark registered under the Tennessee trademark statute:

- Has a term of five years from the date of registration.
- May be renewed for additional five-year periods, if procedural and statutory renewal requirements are met (see [Renewal Requirements](#)).

(T.C.A. § 47-25-506(a), (b).)

Renewal Requirements

A Tennessee trademark registrant may renew a registration for successive five-year periods by filing a [renewal application](#) with the [Tennessee secretary of state's Division of Business Services](#) (TNSOS) within six months before the expiration of the registration. The renewal application must include:

- A \$20 renewal fee for each class.
- A verified statement that the mark has been and still is in use in Tennessee.

- A specimen showing actual use of the mark on or in connection with the goods or services.

(T.C.A. § 47-25-506; see [TNSOS: Application for Renewal of Trademark or Service Mark.](#))

The TNSOS does not send renewal notices to registrants.

3. Describe the key requirements for assignment of state trademark applications and registrations.

A Tennessee state trademark registration (or application) may be assigned by:

- Filing an [assignment form](#) with the [Tennessee secretary of state's Division of Business Services](#) (TNSOS).
- Submitting an application filing fee of \$20.00 per registered classification.

(T.C.A. § 47-25-507(a); see [TNSOS: Application for Assignment of Trademark or Service Mark.](#))

The assignment form must:

- Be signed by the assignor.
- Include the name and the title of the signer, if the assignor is a business entity.
- Include a provision that expressly indicates the transfer of "good will" to the assignee.
- Indicate the state of incorporation, if the assignee is a corporation.
- Indicate the state where the partnership is organized and the names of the general partners, if the assignee is a partnership.
- Include the executed assignment document as an attachment.

(See [TNSOS: Application for Assignment of Trademark or Service Mark.](#))

The TNSOS will record the assignment and issue a new certificate for the remainder of the term of the registration or of the last renewal, in the name of the assignee. An assignment is void against any subsequent purchaser for valuable consideration without notice, unless it is recorded with TNSOS either:

- Within three months after the date of the assignment.
- Prior to the subsequent purchase.

(T.C.A. § 47-25-507(a).)

State Statutory and Common Law Trademark Infringement Causes of Action

4. Does your state have a statute that provides a trademark infringement cause of action? If so, describe:

- The elements of the cause of action.
- The available remedies.
- Any statutory defenses or exemptions.

Tennessee law provides a cause of action for infringement of state registered trademarks (T.C.A. § 47-25-512).

Elements of the Cause of Action

The Tennessee trademark statute provides state trademark registrants with an infringement cause of action against any person or entity who:

- Uses any reproduction, counterfeit, copy, or colorable imitation of a registered mark:
 - without consent of the registrant;
 - in connection with goods or services; and
 - in a manner that is likely to cause confusion about the source of origin of the goods or services.
- For intended use on or in connection with selling or distributing goods or services in Tennessee, applies a reproduction, counterfeit, copy, or colorable imitation of a mark to:
 - labels;
 - signs;
 - prints;
 - packages;
 - wrappers;
 - receptacles; or
 - advertisements.
- Uses a trade name or trademark that is confusingly similar to the name or mark of any bank, savings and loan association, savings bank, or any subsidiary or affiliate of these institutions, in a solicitation for the offering of goods or services, unless the solicitation is

unlikely to cause confusion about the source of origin, affiliation, or sponsorship of the products or services and states in bold-face type on the front page of the solicitation:

- the name, address, and telephone number of the person making the solicitation;
 - a statement that the person making the solicitation is not affiliated with the bank, savings and loan association, savings bank, or subsidiary or affiliate of these institutions; and
 - a statement that the solicitation is not authorized or sponsored by the bank, savings and loan association, savings bank, or subsidiary or affiliate of these institutions.
- Uses a trade name or trademark that is confusingly similar to the name or mark of any place of entertainment, or any event, person, or entity scheduled to perform at a place of entertainment in the domain of a ticket marketplace URL, unless the ticket marketplace obtained, prior to use, written authorization to use the name or mark in the domain of the URL, from the place of entertainment, event, person, or entity scheduled to perform.

(T.C.A. § 47-25-512.)

Remedies

The following remedies are available for infringement of a mark registered under the trademark statute:

- Injunctive relief.
- Damages and disgorgement of profits, if the defendant intended to cause confusion, mistake, or deception.
- Destruction of counterfeits and imitations in the possession or control of any defendant.
- Where the defendant acted with knowledge or bad faith:
 - up to three times the damages and profits; and
 - reasonable attorneys' fees.

(T.C.A. §§ 47-25-512 and 47-25-514(a).)

The Tennessee trademark statute does not:

- Limit or preempt criminal prosecution (T.C.A. § 47-25-514(b)).

- Affect the enforcement of common law trademark rights (T.C.A. § 47-25-516).

Statutory Defenses or Exemptions

The Tennessee trademark statute does not provide any defenses or exemptions.

5. Does your state recognize a claim for common law trademark infringement? If so, describe:

- The elements of the cause of action.
- Any significant differences between the state common law claim and a claim for infringement of an unregistered mark under Section 43(a) of the Lanham Act.

Tennessee recognizes a cause of action for common law trademark infringement (T.C.A. § 47-25-516; *Men of Measure Clothing, Inc. v. Men of Measure, Inc.*, 710 S.W.2d 43, 45-46 (Tenn. Ct. App. 1985)).

Elements of a Cause of Action

Tennessee recognizes a cause of action for common law trademark infringement “when ordinary purchasers, buying with ordinary caution, are likely to be misled” (*C.F. Simmons Med. Co. v. Mansfield Drug Co.*, 23 S.W. 165, 180 (Tenn. 1893)).

To prevail on a common law trademark infringement claim, a plaintiff must show:

- It has a valid and legally protectable mark.
- There is a likelihood of confusion among consumers from the defendant's use of the same or a similar mark.

(*Men of Measure Clothing, Inc.*, 710 S.W.2d at 46-47.)

Key Lanham Act Distinctions

The standards governing common law trademark infringement under Tennessee law are similar to those under the Lanham Act (see *Gaylord Ent. Co. v. Gilmore Ent. Grp., LLC*, 187 F. Supp. 2d 926, 945 n.16 (M.D. Tenn. 2001); *Men of Measure Clothing, Inc.*, 710 S.W.2d at 48).

State Anti-Dilution Law

6. Does your state have an anti-dilution statute or recognize a dilution cause of action under common law? If so, please describe for any statute or common law claim:

- Whether it protects both registered and unregistered marks.
- The nature of dilution protected against, including whether the law protects against any dilution by blurring or dilution by tarnishment.
- Whether distinctiveness, strength, or fame of the trademark is required for a mark to be protected in your jurisdiction.

Statute

The Tennessee anti-dilution statute is codified in T.C.A. § 47-25-513.

Registration Requirements

Tennessee's anti-dilution statute protects marks and trade names that are distinctive and famous in Tennessee. There is no registration requirement. (T.C.A. § 47-25-513(a).)

Nature and Types of Dilution Recognized

Tennessee's anti-dilution statute recognizes a cause of action for dilution of a mark's distinctive quality (T.C.A. § 47-25-513). The statute does not refer explicitly to blurring or tarnishment, and no Tennessee state court has analyzed a claim for liability under the statute. However, the US Court of Appeals for the Sixth Circuit has held that the relevant analyses under the Tennessee statute and federal law are interchangeable (see *AutoZone, Inc. v. Tandy Corp.*, 373 F.3d 786, 801-02 (6th Cir. 2004)). Additionally, another federal court applying Tennessee law recognized dilution by blurring under the previous Tennessee anti-dilution statute (*Kellogg Co. v. Exxon Mobil Corp.*, 192 F. Supp. 2d 790, 808 (W.D. Tenn. 2001)). Therefore, claims of dilution by blurring and dilution by tarnishment likely are available under Tennessee's current anti-dilution statute.

Distinctiveness, Strength, or Fame

A mark must be famous and distinctive to be protected under Tennessee's anti-dilution statute (T.C.A. § 47-25-513(a)).

To determine whether a mark is distinctive and famous, a court may consider the following non-exclusive factors:

- The degree of the mark's inherent or acquired distinctiveness in Tennessee.
- The duration and extent of the mark's use in connection with goods or services.
- The duration and extent of the mark's advertising and publicity in Tennessee.
- The geographical extent of the trading area where the mark is used.
- The channels of trade for the goods or services under the mark.
- The degree of the mark's recognition in the trading areas and channels of trade in Tennessee used by the mark's owner and the defendant.
- The nature and extent of third parties' use of the same or similar mark.
- Whether the mark is registered in:
 - Tennessee; or
 - the US Patent and Trademark Office.

(T.C.A. § 47-25-513(a).)

Common Law

Tennessee does not recognize a common law dilution cause of action.

7. For the anti-dilution law listed in Question 6, please list the elements of a cause of action, including whether a claim requires any of the following:

- Actual or likelihood of dilution.
- Likelihood of confusion.
- Competition between the parties.

Statute

To prove a dilution claim in Tennessee, a plaintiff mark owner must show:

- Its mark is:
 - famous; and
 - distinctive.

- The defendant's mark:
 - is used in commerce;
 - began after the plaintiff's mark became famous; and
 - causes dilution of the distinctive quality of the plaintiff's mark.

(T.C.A. § 47-25-513(a); *AutoZone, Inc.*, 373 F.3d at 801-02.)

Actual or Likelihood of Dilution

Tennessee's anti-dilution statute requires a showing of actual dilution (T.C.A. § 47-25-513(a); *Kellogg Co.*, 192 F. Supp. 2d at 804 n.8). However, the federal anti-dilution statute was amended in 2006 to provide protection against use that is likely to cause dilution (15 U.S.C. § 1125(c)). The Sixth Circuit and federal courts in Tennessee interchangeably analyze the Tennessee and federal anti-dilution statutes (*AutoZone, Inc.*, 373 F.3d at 801-02). Since the federal amendment, no Tennessee state cases have addressed whether a plaintiff may show a likelihood of confusion under Tennessee's anti-dilution statute.

Likelihood of Confusion

Tennessee's anti-dilution statute does not require likelihood of confusion, mistake, or deception (T.C.A. § 47-25-501(3)(B)). However, actual confusion is a factor that courts may consider to assess dilution (see Question 8).

Competition Between the Parties

Tennessee's anti-dilution statute does not require competition between the parties (T.C.A. § 47-25-501(3)(A)).

Common Law

There is no common law cause of action for dilution in Tennessee.

8. For the anti-dilution law listed in Question 6, please describe any tests set out in the statute or applied by courts to assess likely or actual dilution.

Statute

The Tennessee anti-dilution statute does not set out any test for determining likely or actual dilution other than noting that the allegedly infringing use must begin after the

owner's mark has become famous (T.C.A. § 47-25-513(a)). However, the statute does set out a list of factors courts may consider to determine whether a mark is distinctive and famous (see Question 6).

No Tennessee court has analyzed a claim under the current anti-dilution statute. However, the Sixth Circuit and federal courts in Tennessee have analyzed dilution claims under Tennessee's statute as they would claims under the federal statute (see *AutoZone, Inc.*, 373 F.3d at 801-02).

Federal courts interpreting Tennessee law have used a nonexclusive ten-factor test set out by the US Court of Appeals for the Second Circuit that examines:

- Distinctiveness.
- The similarity of the marks.
- The proximity of the products and the likelihood of bridging the gap.
- The interrelationship among:
 - the distinctiveness of the senior mark;
 - the similarity of the junior mark; and
 - the proximity of the products.
- Shared consumers and geographic limitations.
- Consumer sophistication.
- Actual confusion.
- Adjectival or referential quality of the junior use.
- Harm to the junior user and delay by the senior user.
- The effect of the senior user's prior laxity in protecting the mark.

(*AutoZone, Inc.*, 373 F.3d at 802-05.)

To determine whether the defendant's mark dilutes the plaintiff's mark, the Sixth Circuit places significant weight on the similarity of the two marks (see *AutoZone, Inc.*, 373 F.3d at 805; *Audi AG v. D'Amato*, 469 F.3d 534, 547 (6th Cir. 2006)). It has held that when the parties' marks are identical, this may be sufficient to satisfy this element of a dilution cause of action (*Audi AG*, 469 F.3d at 547).

Common Law

There is no common law cause of action for dilution in Tennessee.

9. For the anti-dilution law listed in Question 6, please describe any available remedies for violations.

Statute

Injunctive relief is the primary remedy for dilution under the Tennessee anti-dilution statute (T.C.A. § 47-25-513(b)). However, if the defendant acted with willful intent to trade on the mark owner's reputation or to cause dilution, the owner of a mark may obtain other remedies subject to the court's discretion and the principles of equity, including:

- Damages and disgorgement of profits.
- Destruction of counterfeits and imitations in the possession or control of the defendant.
- Up to three times the damages and profits.
- Reasonable attorneys' fees.

(T.C.A. §§ 47-25-513(b) and 47-25-514(a).)

Common Law

There is no common law cause of action for dilution in Tennessee.

10. For the anti-dilution law listed in Question 6, what statutory exemptions or defenses are available to defend against these claims?

Statute

The Tennessee anti-dilution statute sets out statutory exemptions for:

- 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.
- Noncommercial use of a mark.
- All forms of news reporting and news commentary.

(T.C.A. § 47-25-513(c).)

Common Law

There is no common law cause of action for dilution in Tennessee.

11. For the anti-dilution law in Question 6, please describe any significant distinctions between the applicable state law and the federal Trademark Dilution Revision Act, including differences in the available remedies.

The only significant distinction between the Tennessee anti-dilution statute and the federal Trademark Dilution Revision Act (Section 43(c) of the Lanham Act) is that the Tennessee anti-dilution statute requires actual dilution (T.C.A. § 47-25-513(a); *Kellogg Co.*, 192 F. Supp. 2d at 804 n.8). However, the Sixth Circuit and federal courts in Tennessee interchangeably analyze the Tennessee and federal anti-dilution statutes (*AutoZone, Inc.*, 373 F.3d at 801-02). Since the federal amendment providing protection against use that is likely to cause dilution, no Tennessee state cases have addressed whether a plaintiff may show a likelihood of confusion under Tennessee's anti-dilution statute (see Question 7: Actual or Likelihood of Dilution).

Anti-Counterfeiting Statute

12. Does your state have a civil anti-counterfeiting statute with a private right of action? If so, please identify the statute and describe:

- Standing requirements.
- Available remedies.
- Any statutory exemptions or defenses.

Tennessee does not have a specific anti-counterfeiting statute with a private right of action. However, the Tennessee trademark statute identifies use of a counterfeit version of a state-registered mark as trademark infringement (T.C.A. § 47-25-512(1), (2); see Question 4).

Standing Requirements

Only the owner of a mark registered under the Tennessee trademark statute may bring a counterfeiting claim (T.C.A. § 47-25-512).

Remedies

The remedies available for counterfeiting are identical to the remedies available for trademark infringement (see Question 4: Remedies).

Statutory Exemptions or Defenses

There are no specific exemptions or defenses under this law.

State Unfair Competition and Deceptive Trade Practices Statutes

13. Does your state have any unfair competition or deceptive trade practices statutes with a private right of action? If so, please identify the statute(s) and describe for each:

- The types of acts or practices it prohibits.
- The standing requirements for a private action.
- The remedies available for violations.
- Any statutory exemptions or defenses to private claims.

Tennessee Consumer Protection Act: T.C.A. §§ 47-18-101 to 47-18-132

Prohibited Conduct

The Tennessee Consumer Protection Act (TCPA) provides an extensive, non-exhaustive list of prohibited unfair or deceptive trade acts or practices, including:

- Falsely passing off goods or services as those of another.
- Causing likelihood of confusion or misunderstanding about the source, sponsorship, approval, or certification of goods or services.
- Causing likelihood of confusion or misunderstanding about affiliation, connection, or association with or certification by another.
- Using deceptive representations or designations of geographic origin in connection with goods or services.
- Representing that goods or services have sponsorship, approval, characteristics, ingredients, uses, benefits, or quantities that they do not have.
- Representing that a person has a sponsorship, approval, status, affiliation, or connection that the person does not have.
- Representing that goods or services are of a particular standard, quality, or grade, or that goods are of a particular style or model, if they are not.

- Disparaging the goods, services, or business of another by false or misleading representations of fact.
- Advertising goods or services with intent not to sell them as advertised.
- Making false statements about price reductions.
- Misrepresenting that a service, replacement, or repair is needed.
- Advertising a sale by misrepresenting that a person is going out of business.
- Using statements or illustrations in any advertisement that create a false impression of the grade, quality, quantity, make, value, age, size, color, usability, or origin of the goods or services offered.
- Using any advertisement containing an offer to sell goods or services when the offer is not a bona fide effort to sell the advertised goods or services.

(T.C.A. § 47-18-104.)

The statute does not prohibit conduct outside of trade or commerce. For example, a defendant who posted signs on the defendant's property to dissuade buyers from bidding on plaintiff's property at auction was held not to be acting in trade or commerce under the TCPA (*Wagner v. Fleming*, 139 S.W.3d 295, 301 (Tenn. Ct. App. 2004)).

Prima facie evidence of a TCPA violation in private actions includes:

- Any permanent injunction, judgment, or final court order made under T.C.A. § 47-18-108 that has not been complied with.
- Any assurance of voluntary compliance entered under T.C.A. § 47-18-107 that has not been complied with.

(T.C.A. § 47-18-109(d).)

Standing Requirements for a Private Action

A person may bring an action to recover damages for the ascertainable loss of the following because of another's unfair or deceptive act under the TCPA:

- Money.
- Real or personal property.
- Any other thing of value.

(T.C.A. § 47-18-109(a)(1).)

The TCPA defines person to include:

- Natural persons.
- Individuals.

- Governmental agencies.
- Partnerships.
- Corporations.
- Trusts.
- Estates.
- Incorporated or unincorporated associations.
- Any other legal or commercial entity however organized.

(T.C.A. § 47-18-103(14).)

The TCPA protects only consumers, who are defined as either:

- Natural persons who seek or acquire by purchase, lease, or other disposition:
 - goods;
 - services;
 - property; or
 - any other thing of value.
- Any person who purchases or is offered:
 - a franchise;
 - a distributorship; or
 - a similar type of business opportunity.

(T.C.A. § 47-18-103(3).)

For example, a seller of property cannot assert a claim under the TCPA against a buyer (*Hood Land Tr. v. Hastings*, 2010 WL 3928647, at *8-9 (Tenn. Ct. App. Oct. 5, 2010)).

Class action lawsuits for damages are not allowed under the TCPA (T.C.A. § 47-18-109(g)).

Anyone affected by a violation of the TCPA may bring an action to obtain a declaratory judgment and to enjoin the person who:

- Has violated the TCPA.
- Is violating the TCPA.
- Is likely to violate the TCPA.

(T.C.A. § 47-18-109(b).)

However, this remedy is not available if the Tennessee attorney general has commenced a proceeding under either T.C.A. § 47-18-107 or T.C.A. § 47-18-108 (T.C.A. §§ 47-18-103(1) and 47-18-109(b)).

The TCPA contains a catch-all provision for any other practice that is deceptive to the consumer or to any other person. However, only the attorney general may enforce this provision. (T.C.A. § 47-18-104(b)(27).)

Remedies

Successful plaintiffs may obtain:

- Actual damages.
- Treble damages and other necessary and proper relief, if the court finds that the violation was willful or knowing.
- Injunctive relief.
- Reasonable attorneys' fees and costs.

(T.C.A. § 47-18-109(a), (b), and (e); see *Standing Requirements for a Private Action*.)

Punitive damages are not available under the TCPA (*Concrete Spaces, Inc. v. Sender*, 2 S.W.3d 901, 911-12 (Tenn. 1999)).

A plaintiff may need to indemnify the defendant for any damages incurred, including reasonable attorneys' fees and costs, if the TCPA claim is found to be:

- Frivolous.
- Without legal or factual merit.
- Harassing.

(T.C.A. § 47-18-109(e)(2).)

Statutory Exemptions or Defenses to Private Claims

The TCPA exempts:

- Acts or transactions required or specifically authorized under the laws, rules, or regulations of any authority of Tennessee or the US.
- A publisher, broadcaster, or other person that prepares or disseminates unlawful matter on behalf of others without notification from the attorney general that the matter violates the TCPA.
- Credit terms of a transaction that may be otherwise subject to the TCPA, except where the Tennessee Equal Consumer Credit Act of 1974 may apply.
- A retailer who in good faith disseminates claims of a manufacturer or wholesaler without actual knowledge that the claims violated the TCPA.

(T.C.A. § 47-18-111(a).)

The person claiming an exemption has the burden of proving it (T.C.A. § 47-18-111(b)).

The TCPA has a one-year statute of limitations that begins to run from the date of a person's discovery of the unlawful act or practice. The TCPA also includes a statute of repose that bars claims brought more than five years after the date of the consumer transaction giving rise to the claim. (T.C.A. § 47-18-110.)

14. For each statute listed in Question 13, please describe the elements of a cause of action.

**Tennessee Consumer Protection Act:
T.C.A. §§ 47-18-101 to 47-18-132**

To recover under the Tennessee Consumer Protection Act (TCPA), a plaintiff must prove that:

- The defendant engaged in an unfair or deceptive act or practice under the TCPA.
- The defendant's conduct caused an ascertainable loss of:
 - money;
 - real, personal, or mixed property; or
 - any other article, commodity, or thing of value.

(T.C.A. § 47-18-109; *Tucker v. Sierra Builders*, 180 S.W.3d 109, 115 (Tenn. Ct. App. 2005).)

TCPA claims must be pleaded with the same particularity that Tenn. R. Civ. P. 9.02 requires of common law fraud claims (*McLean v. Bourget's Bike Works, Inc.*, 2005 WL 2493479, at *7 (Tenn. Ct. App. Oct. 7, 2005); *Harvey v. Ford Motor Credit Co.*, 8 S.W.3d 273, 275 (Tenn. Ct. App. 1999)).

A TCPA claim that includes trademark infringement is governed by the likelihood of confusion analysis used in a federal claim for trademark infringement (*Gen. Conf. Corp. of Seventh-Day Adventists v. McGill*, 624 F. Supp. 2d 883, 891 (W.D. Tenn. 2008); *McDonald's Corp. v. Shop at Home, Inc.*, 82 F. Supp. 2d 801, 816-17 (M.D. Tenn. 2000)).

15. For each statute listed in Question 13, please describe the statute's applicability to trademark infringement and dilution claims.

**Tennessee Consumer Protection Act:
T.C.A. §§ 47-18-101 to 47-18-132**

The Tennessee Consumer Protection Act (TCPA) applies to trademark infringement claims. A TCPA claim regarding allegations of trademark infringement is governed by the likelihood of confusion analysis used in a federal claim for trademark infringement (see *Gen. Conf. Corp. of Seventh-Day Adventists*, 624 F. Supp. 2d at 891; *McDonald's Corp.*, 82 F. Supp. 2d at 816-17).

The TCPA has not been applied to address trademark dilution claims. Tennessee has a separate anti-dilution statute (see Question 6).

16. Please identify the principal common law unfair competition causes of action in your state that are available to trademark owners and for each cause of action describe:

- The elements of the cause of action.
- Any significant distinctions between claims under state common law and claims under Section 43(a) of the Lanham Act.

Tennessee recognizes the common law tort of unfair competition, though the case law is not well developed (see *Sovereign Order of Saint John of Jerusalem, Inc. v. Grady*, 119 F.3d 1236, 1243 (6th Cir. 1997)). Unfair competition covers several related torts involving improper interference with business prospects (*B & L Corp. v. Thomas & Thorngren, Inc.*, 917 S.W.2d 674, 681 (Tenn. Ct. App. 1995)).

Relating to trademarks, Tennessee recognizes:

- Use of a similar trade name or trademark.
- Passing off.

(See *M.M. Newcomer Co. v. Newcomer's New Store*, 217 S.W. 822, 825 (Tenn. 1919); *Kay Jewelry Co. of Chattanooga v. Morris*, 171 S.W.2d 410, 411-12 (Tenn. Ct. App. 1942); *Men of Measure Clothing, Inc.*, 710 S.W.2d at 45-47; *Sovereign Order of Saint John of Jerusalem, Inc.*, 119 F.3d at 1243.)

Elements of a Common Law Unfair Competition Cause of Action

Use of a Similar Trade Name or Mark

Tennessee courts have held that to prevail on a common law unfair competition claim for use of a similar unregistered trade name or trademark, a plaintiff must show that:

- The plaintiff owns an established trade name or trademark.
- The defendant is using a name or mark so similar in general appearance that it is deceiving to the public.
- The defendant's use will result in substantial loss or injury.

(*Kay Jewelry Co.*, 171 S.W.2d at 411-12; *M.M. Newcomer Co.*, 217 S.W. at 825.)

It is unnecessary to prove that the public has actually been deceived by the similarity or that actual fraud was intended (*Kay Jewelry Co.*, 171 S.W.2d at 411-12; *M.M. Newcomer Co.*, 217 S.W. at 826).

Because Tennessee federal courts interpret federal and state claims interchangeably, this cause of action may overlap with a common law trademark infringement cause of action (see Question 5).

Passing Off

The Sixth Circuit has held that to prevail on a common law tort of unfair competition under Tennessee law, a plaintiff must show that:

- The defendant passed off its organization or services as that of the plaintiff.
- The defendant intended to deceive the public.
- The public was actually confused or deceived.

(*Sovereign Order of Saint John of Jerusalem, Inc.*, 119 F.3d at 1243; *Aquashield, Inc. v. Sonitec Vortisand, Inc.*, 2013 WL 5524598, at *10-11 (E.D. Tenn. Oct. 4, 2013).)

Key Lanham Act Distinctions

The main distinction between a cause of action for unfair competition under Tennessee common law and under the Lanham Act is that Tennessee law regarding passing off requires a showing of actual confusion and intent to deceive, while the Lanham Act only requires a likelihood of confusion and intent is only a factor in the analysis (*Sovereign Order of Saint John of Jerusalem, Inc.*, 119 F.3d at 1243).

One federal court noted that while the same analysis may be applied to state claims of unfair competition and to claims under the Lanham Act for a likelihood of confusion analysis, this does not necessarily mean that a state claim is limited in all aspects to the scope of the Lanham Act. In that case, the court declined to dismiss the plaintiff's common law unfair competition claim premised on the defendant's unauthorized performance and exploitation of a derivative work of a copyrighted song. (*Brainard v. Vassar*, 561 F. Supp. 2d 922, 936 (M.D. Tenn. 2008).)

Other Significant State Statutory and Common Law Trademark-Related Claims

17. Please describe any significant statutory or common law causes of action in your state available to trademark owners that are not already described in the preceding questions (for example, false advertising and trade libel).

Trade Libel

Tennessee does not have a specific trade libel statute. However, the Tennessee Consumer Protection Act prohibits disparaging the goods, services, or business of another by false or misleading representations of fact (T.C.A. § 47-18-104(b)(8); see Question 13).

Violation of this law is a Class B misdemeanor punishable by either or both:

- A fine of up to \$500.
- Imprisonment for up to six months.

(T.C.A. §§ 40-35-111(e)(2) and 47-18-104(a).)

Tennessee has not specifically recognized a common law cause of action for trade libel (*McCord v. HCA Health Servs. of Tenn., Inc.*, 2015 WL 1914634, at *8 n.18 (Tenn. Ct. App. Apr. 27, 2015); *Medison Am., Inc. v. Preferred Med. Sys., LLC*, 548 F. Supp. 2d 567, 584 (W.D. Tenn. 2007)). Persons claiming injury to reputation in a trade or business assert ordinary defamation claims (see *AmMed Direct, LLC v. Liberty Med. Supply, Inc.*, 2009 WL 3680539, at *8 (M.D. Tenn. Sept. 23, 2009); *Medison Am., Inc.*, 548 F. Supp. 2d at 584).

To the extent that Tennessee common law recognizes trade libel and injurious falsehood as causes of action,

these claims require proof of the publication of a false statement of fact (*Seaton v. TripAdvisor LLC*, 728 F.3d 592, 602 (6th Cir. 2013)).

To prove a claim for defamation under Tennessee law, a plaintiff must show that the defendant published a statement with either:

- Knowledge that the statement is false and defaming to the other.
- Reckless disregard for the truth of the statement or negligence in failing to ascertain the truth of the statement.

Publication is the communication of the defamatory matter to a third person. (*Sullivan v. Baptist Mem'l Hosp.*, 995 S.W.2d 569, 571-72 (Tenn. 1999).)

Unjust Enrichment

To prove a claim of unjust enrichment under Tennessee law, a plaintiff must show that:

- It conferred a benefit on the defendant.
- The defendant appreciated the benefit.
- The defendant accepted the benefit under circumstances where it would be inequitable to retain the benefit without payment of the value of the benefit.

(*Freeman Indus., LLC v. Eastman Chem. Co.*, 172 S.W.3d 512, 525 (Tenn. 2005); *Paschall's, Inc. v. Dozier*, 407 S.W.2d 150, 155 (Tenn. 1966).)

The plaintiff must show exhaustion of all other remedies against the defendant (*Paschall's, Inc.*, 407 S.W.2d at 155; *Whitehaven Cmty. Baptist Church v. Holloway*, 973 S.W.2d 592, 596 (Tenn. 1998)).

18. For each statute or common law claim identified in Questions 4, 5, 6, 12, and 13, identify any applicable statute of limitations and how it is calculated.

Statutory and Common Law Trademark Infringement

There are no specific statutes of limitations for Tennessee statutory or common law trademark infringement claims. However, Tennessee recognizes laches as an affirmative defense to trademark infringement. To establish laches under Tennessee law, the defendant must prove that the plaintiff:

- Inexcusably delayed enforcing its trademark rights.
- Caused injury to the defendant because of this delay.

(*State ex rel. Elvis Presley Int'l Mem'l Found. v. Crowell*, 733 S.W.2d 89, 101 (Tenn. Ct. App. 1987).)

Applying Tennessee law, the Sixth Circuit adopted the doctrine of presumption of laches. Laches is presumed if a plaintiff brings a trademark claim after the expiration of the statute of limitations period of an analogous statute. Applying the three-year statute of limitations for an action for tortious injury to property, the Sixth Circuit held that the presumption of laches period for trademark infringement claims is three years. (T.C.A. § 28-3-105; *Tandy Corp. v. Malone & Hyde, Inc.*, 769 F.2d 362, 366 (6th Cir. 1985).)

Actions for unfair competition are governed by the one-year statute of limitations under the Tennessee Consumer Protection Act (TCPA) (T.C.A. § 47-18-110; *Johnny's Fine Foods, Inc. v. Johnny's Inc.*, 286 F. Supp. 2d 876, 881 (M.D. Tenn. 2003); *Fed. Express Corp. v. U.S. Postal Serv.*, 75 F. Supp. 2d 807, 816-17 (W.D. Tenn. 1999)).

While laches precludes a plaintiff from recovering damages, it does not bar injunctive relief. Acquiescence by the plaintiff typically also bars injunctive relief. (See *Kellogg Co. v. Exxon Corp.*, 209 F.3d 562, 568 (6th Cir. 2000); *Johnny's Fine Foods, Inc.*, 286 F. Supp. 2d at 882.)

Dilution

There is no specific statute of limitations under the Tennessee anti-dilution statute. However, a laches defense may apply to these claims (*Johnny's Fine Foods, Inc.*, 286 F. Supp. 2d at 881; see Statutory and Common Law Trademark Infringement).

Tennessee Consumer Protection Act: T.C.A. §§ 47-18-101 to 47-18-132

The TCPA has a one-year statute of limitations that begins to run from the date of a person's discovery of the unlawful act or practice. The TCPA also includes a statute of repose that bars claims brought more than five years after the date of the consumer transaction giving rise to the claim. (T.C.A. § 47-18-110.)

Counterfeiting

See Statutory and Common Law Trademark Infringement.

State Criminal Trademark Laws

19. Does your state have any criminal trademark protection statutes? If so, please identify the statute and describe the offense.

Deceptive Business Practices: T.C.A. § 39-14-127

Tennessee law prohibits a person from, in the course of business and with intent to deceive:

- Selling, offering, or exposing for sale adulterated or mislabeled goods.
- Making a false or misleading statement in a public advertisement to promote the purchase or sale of property or services.
- Falsely representing in an advertisement or solicitation that goods or services have sponsorship, approval, affiliation, or connection with:
 - a bank;
 - a savings and loan association;
 - a savings bank; or
 - any subsidiary or affiliate of these institutions.
- Using a trade name or trademark that is confusingly similar to the name or mark of any bank, savings and loan association, savings bank, or any subsidiary or affiliate of these institutions:
 - in a solicitation for the offering of goods or services; and
 - if this use is likely to cause confusion, mistake, or deception about the source of origin, affiliation, or sponsorship of the goods or services.
- Using a trade name or trademark that is confusingly similar to the name or mark of any bank, savings and loan association, savings bank, or any subsidiary or affiliate of these institutions in any manner in a solicitation for goods or services, unless the solicitation clearly and conspicuously states in bold-face type on the front page of the solicitation:
 - the name, address, and telephone number of the person making the solicitation;
 - that the person making the solicitation is not affiliated with the financial institution; and

- that the solicitation is not authorized or sponsored by the financial institution.

- Using a trade name or trademark that is confusingly similar to the name or mark of any place of entertainment, or any event, person, or entity scheduled to perform at a place of entertainment in the domain of a ticket marketplace URL, unless the ticket marketplace obtained, prior to use, written authorization to use the name or mark in the domain of the URL, from the place of entertainment, event, person, or entity scheduled to perform.

(T.C.A. § 39-14-127.)

Violation of this law is a Class B misdemeanor punishable by either or both:

- A fine of up to \$500.
- Imprisonment for up to six months.

(T.C.A. §§ 39-14-127(c) and 40-35-111(e)(2).)

Trademark Counterfeiting of Drugs: T.C.A. §§ 47-25-401 to 47-25-407

Tennessee law prohibits a person from, without the written authority of the owner of a trademark for a drug:

- Making or causing to be made, selling, possessing, or using commercially any:
 - counterfeit, copy, or deceptive imitation of the trademark; or
 - package or label bearing or containing any counterfeit, copy, or deceptive imitation of the trademark.
- Knowingly receiving, keeping, or having in the person's possession or under the person's control, selling, offering for sale, or disposing of any drug:
 - bearing any counterfeit, copy, or deceptive imitation of the trademark; or
 - in any package or under any label bearing any counterfeit, copy, or deceptive imitation of the trademark.
- Making or causing to be made or knowingly possessing, selling, disposing of, delivering, or offering to deliver to any person a die, plate, block, stone, type-face, matrix, or other means of printing, lithographing, or otherwise making a counterfeit, copy, or deceptive imitation of the trademark.

- Knowingly misrepresenting orally or by advertisement or artifice the manufacture, origin, or commercial sponsorship of any drug sold, offered, or exposed for sale.

(T.C.A. § 47-25-403.)

The statute does not define a counterfeit. However, the statute provides that a drug is misbranded when its container bears a counterfeit, copy, or deceptive imitation of any trademark (T.C.A. § 47-25-401(3)). Deceptive imitation means any imitation calculated or likely to deceive purchasers exercising the care ordinarily exercised in buying (T.C.A. § 47-25-401(1)).

Violation of this law is a Class C misdemeanor punishable by either or both:

- A fine of up to \$50.
- Imprisonment for up to 30 days.

(T.C.A. §§ 40-35-111(e)(3) and 47-25-405.)

Trade Libel: T.C.A. § 47-18-104(b)(8)

See Question 17: Trade Libel.

Pending Legislation

20. Please describe any legislation pending in your state that would materially impact civil trademark enforcement and protection.

There is no relevant legislation pending in Tennessee.

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