

1 any instrument to be acceptable for recording;
2 amending s. 495.091, F.S.; requiring the
3 secretary to record all marks registered with
4 the state; amending s. 495.101, F.S.; requiring
5 the secretary to cancel certain marks; amending
6 s. 495.111; F.S., requiring the secretary to
7 establish a classification of goods and
8 services; amending s. 495.121, F.S.; conforming
9 provisions; amending s. 495.131, F.S.;
10 conforming provisions; amending s. 495.141,
11 F.S.; providing remedies for the unauthorized
12 use of a mark; removing provisions regarding
13 the assessment of plaintiff's profits; creating
14 s. 495.145, F.S.; providing a forum for actions
15 regarding registration; providing service on
16 out-of-state residents; amending s. 495.151,
17 F.S.; providing for an injunction in cases of
18 dilution of a famous mark; providing factors to
19 consider in determining a mark to be famous;
20 providing damages in certain circumstances of
21 dilution; amending s. 495.161, F.S.; deleting
22 provisions relating to the diminishing of
23 certain common-law rights; creating s. 495.165,
24 F.S.; requiring the secretary to prescribe
25 certain fees; amending s. 495.171, F.S.;
26 providing application and legislative intent;
27 providing for severability; providing an
28 effective date.

29
30 Be It Enacted by the Legislature of the State of Florida:
31

1 Section 1. Section 495.001, Florida Statutes, is
2 created to read:

3 495.001 Popular name.--This chapter may be cited as
4 the "Registration and Protection of Trademarks Act."

5 Section 2. Section 495.011, Florida Statutes, is
6 amended to read:

7 (Substantial rewording of section. See
8 s. 495.011, F.S., for present text.)

9 495.011 Definitions.--As used in this chapter:

10 (1) "Abandoned" applies to a mark when either of the
11 following occurs:

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

16 (b) When any course of conduct of the owner, including
17 acts of either omission or commission, causes the mark to lose
18 its significance as a mark.

19 (2) "Applicant" means the person filing an application
20 for registration of a mark under this chapter and the legal
21 representatives, successors, or assigns of such person.

22 (3) "Dilution" means the lessening of the capacity of
23 a mark to identify and distinguish goods or services,
24 regardless of the presence or absence of:

25 (a) Competition between the owner of the mark and
26 other parties.

27 (b) Likelihood of confusion, mistake, or deception.

28 (4) "Mark" includes any trademark or service mark
29 entitled to registration under this chapter whether or not
30 registered.

31

1 (5) "Person," and any other word or term used to
2 designate the applicant or other party entitled to a benefit
3 or privilege or rendered liable under the provisions of this
4 chapter, means a juristic person as well as a natural person.
5 The term "juristic person" includes a firm, partnership,
6 corporation, union, association, or other organization capable
7 of suing and being sued in a court of law.

8 (6) "Registrant" means the person to whom the
9 registration of a mark under this chapter is issued, and the
10 legal representatives, successors, or assigns of such person.

11 (7) "Secretary" means the Secretary of State or the
12 designee of the secretary charged with the administration of
13 this chapter.

14 (8) "Service mark" means any word, name, symbol,
15 device, or any combination thereof, used by a person to
16 identify and distinguish the services of such person,
17 including a unique service, from the services of others, and
18 to indicate the source of the services, even if that source is
19 unknown. Distinctive features of radio or television programs,
20 including, but not limited to, titles and character names used
21 by a person, may be registered as service marks
22 notwithstanding that the person or the programs may advertise
23 the goods of the sponsor.

24 (9) "Trademark" means any word, name, symbol, device,
25 or any combination thereof, used by a person to identify and
26 distinguish the goods of such person, including a unique
27 product, from those manufactured or sold by others, and to
28 indicate the source of the goods, even if that source is
29 unknown.

30 (10) "Trade name" means any name used by a person to
31 identify a business or vocation of such person.

1 (11) "Use" means the bona fide use of a mark in the
2 ordinary course of trade, and does not include the use of a
3 trademark or service mark merely for the purpose of reserving
4 a right in the trademark or service mark. For the purposes of
5 this chapter, a mark shall be deemed to be in use when it is
6 placed on goods, their containers or the displays associated
7 therewith, on the tags or labels affixed thereto, or, if the
8 nature of the goods makes such placement impracticable, then
9 on documents associated with the goods or their sale, and such
10 goods are sold or transported in commerce in this state, and a
11 service mark shall be deemed to be "used" when it is used or
12 displayed in the sale or advertising of services and the
13 services are rendered in this state.

14 Section 3. Section 495.021, Florida Statutes, is
15 amended to read:

16 495.021 Registrability.--

17 ~~(1)~~ A mark by which the goods or services of any
18 applicant for registration may be distinguished from the goods
19 or services of others shall not be registered if it:

20 ~~(1)(a)~~ Consists of or, comprises ~~or includes~~ immoral,
21 deceptive or scandalous matter; ~~or~~

22 ~~(2)(b)~~ Consists of or, comprises ~~or includes~~ matter
23 which may disparage or falsely suggest a connection with
24 persons, living or dead, institutions, beliefs, or national
25 symbols, or bring them into contempt, or disrepute; ~~or~~

26 ~~(3)(c)~~ Consists of or, comprises ~~or includes~~ the flag
27 or coat of arms or other insignia of the United States, or of
28 any state or municipality, or of any foreign nation, or any
29 simulation thereof; ~~or~~

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31

1 ~~(4)(d)~~ Consists of or, ~~comprises or includes~~ the name,
2 signature, or portrait of any living individual, except with
3 her or his written consent; ~~or~~

4 ~~(5)(e)~~ Consists of a mark which:

5 ~~(a)1.~~ When used on or in connection with ~~applied to~~
6 the goods or services of the applicant is merely descriptive
7 or deceptively misdescriptive of them,

8 ~~(b)2.~~ When used on or in connection with ~~applied to~~
9 the goods or services of the applicant is primarily
10 geographically descriptive or deceptively misdescriptive of
11 ~~them or their source or origin~~, or

12 ~~(c)3.~~ Is primarily merely a surname, provided,
13 however, that nothing in this subsection ~~paragraph~~ shall
14 prevent the registration of a mark used in this state by the
15 applicant which has become distinctive of the applicant's
16 goods or services ~~in this state or elsewhere~~.

17
18 The secretary ~~Department of State~~ may accept as evidence that
19 the mark has become distinctive, as used on or in connection
20 with ~~applied to~~ the applicant's goods or services, proof of
21 ~~substantially exclusive and~~ continuous use thereof as a mark
22 by the applicant in this state or elsewhere for 5 years next
23 preceding the date on which the claim of distinctiveness is
24 made; or

25 ~~(6)(f)~~ Consists of or comprises a mark which so
26 resembles a mark registered in this state or a mark or trade
27 name previously used ~~in this state~~ by another and not
28 abandoned, as to be likely, when used on or in connection with
29 ~~applied to~~ the goods or services of the applicant, to cause
30 confusion or mistake or to deceive. ~~Registration shall not be~~
31 ~~denied solely on the basis of reservation or registration by~~

1 ~~another of a corporate name or fictitious name that is the~~
2 ~~same or similar to the mark for which registration is sought.~~

3 ~~(2) Subject to the provisions relating to the~~
4 ~~registration of trademarks and service marks, so far as they~~
5 ~~are applicable, collective and certification marks, including~~
6 ~~indications of regional origin, shall be registrable under~~
7 ~~this chapter, in the same manner and with the same effect as~~
8 ~~are trademarks and service marks, by persons, and nations,~~
9 ~~states, municipalities, and the like, exercising control over~~
10 ~~the use of the marks sought to be registered, even though not~~
11 ~~possessing an industrial or commercial establishment, and when~~
12 ~~registered they shall be entitled to the protection provided~~
13 ~~in this chapter in the case of trademarks and service marks.~~
14 ~~The Department of State may establish a separate register for~~
15 ~~such collective marks and certification marks.~~

16 Section 4. Subsection (3) of section 495.027, Florida
17 Statutes, is amended to read:

18 495.027 Reservation.--

19 (3) Every request under this section shall be
20 accompanied by a filing fee of \$50, payable to the Department
21 of State, for each class of goods or services established
22 pursuant to as specified in s. 495.111, in connection with
23 which the mark is to be used.

24 Section 5. Section 495.031, Florida Statutes, is
25 amended to read:

26 (Substantial rewording of section. See
27 s. 495.031, F.S., for present text.)

28 495.031 Application for registration.--

29 (1) Subject to the limitations set forth in this
30 chapter, any person who uses a mark may file in the office of
31 the secretary, in a manner complying with the requirements of

1 the secretary, an application for registration of that mark,
2 including, but not limited to, the following information:

3 (a) The name and business address of the person
4 applying for such registration and, if a corporation, the
5 state of incorporation or, if a partnership, the state in
6 which the partnership is organized and the names of the
7 general partners, as specified by the secretary.

8 (b) The goods or services on or in connection with
9 which the mark is used and the mode or manner in which the
10 mark is used on or in connection with such goods or services
11 and the class in which such goods or services fall.

12 (c) The date when the mark was first used anywhere and
13 the date when it was first used in this state by the applicant
14 or a predecessor in interest.

15 (d) A statement that the applicant is the owner of the
16 mark, that the mark is in use, and that, to the knowledge of
17 the person verifying the application, no other person has
18 registered, either federally or in this state, or has the
19 right to use such mark either in the identical form thereof or
20 in such near resemblance thereto as to be likely, when applied
21 to the goods or services of such other person, to cause
22 confusion, to cause mistake, or to deceive.

23 (2) The secretary may also require a statement as to
24 whether an application to register the mark, or portions or a
25 composite thereof, has been filed by the applicant or a
26 predecessor in interest in the United States Patent and
27 Trademark Office and, if so, the applicant shall provide full
28 particulars with respect thereto, including the filing date
29 and serial number of each application, the status thereof,
30 and, if any application was finally refused registration or
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1 has otherwise not resulted in a registration, the reasons
2 therefore.

3 (3) The secretary may also require that a drawing of
4 the mark, complying with such requirements as the secretary
5 may specify, accompany the application.

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

10 (5) The application shall be accompanied by three
11 specimens showing the mark as actually used.

12 (6) The application shall be accompanied by the
13 application fee payable to the secretary.

14 Section 6. Section 495.035, Florida Statutes, is
15 created to read:

16 495.035 Filing of applications.--

17 (1) Upon the filing of an application for registration
18 and payment of the application fee, the secretary may cause
19 the application to be examined for conformity with this
20 chapter.

21 (2) The applicant shall provide any additional
22 pertinent information requested by the secretary, including a
23 description of a design mark and may make, or authorize the
24 secretary to make, such amendments to the application as may
25 be reasonably requested by the secretary or deemed by
26 applicant to be advisable to respond to any rejection or
27 objection.

28 (3) The secretary may require the applicant to
29 disclaim an unregistrable component of a mark otherwise
30 registrable, and an applicant may voluntarily disclaim a
31 component of a mark sought to be registered. No disclaimer

1 shall prejudice or affect the applicant's or registrant's
2 rights then existing or thereafter arising in the disclaimed
3 matter, or the applicant's or registrant's rights of
4 registration on another application if the disclaimed matter
5 be or shall have become distinctive of the applicant's or
6 registrant's goods or services.

7 (4) Amendments may be made by the secretary upon the
8 application submitted by the applicant upon the applicant's
9 agreement, or a new application may be required to be
10 submitted.

11 (5) If the applicant is found not to be entitled to
12 registration, the secretary shall advise the applicant of the
13 rejection and of the reasons for rejection. The applicant
14 shall have a reasonable period of time specified by the
15 secretary in which to reply or to amend the application, in
16 which event the application shall then be reexamined. This
17 procedure may be repeated until:

18 (a) The secretary refuses registration of the mark; or

19 (b) The applicant fails to reply or amend the
20 application within the specified time, whereupon the
21 application shall be abandoned.

22 (6) If the secretary denies registration of the mark,
23 the applicant may seek a writ of mandamus to compel such
24 registration. Such writ may be granted, but without costs to
25 the secretary, on proof that all the statements in the
26 application are true and that the mark is otherwise entitled
27 to registration.

28 (7) In the instance of multiple applications
29 concurrently being processed by the secretary which seek
30 registration of the same or confusingly similar marks for the
31 same or related goods or services, the secretary shall grant

1 priority to the applications in order of filing. If a
2 prior-filed application is granted a registration, the other
3 application or applications shall then be rejected. Any
4 rejected applicant may bring an action for cancellation of the
5 registration upon grounds of prior or superior rights to the
6 mark, in accordance with the provisions of s. 495.101.

7 Section 7. Section 495.061, Florida Statutes, is
8 amended to read:

9 495.061 Certificate of registration.--

10 (1) Upon compliance by the applicant with the
11 requirements of this chapter, the secretary ~~Department of~~
12 ~~State~~ shall cause a certificate of registration to be issued
13 and delivered to the applicant. The certificate of
14 registration shall be issued under the signature of the
15 secretary ~~of State~~ and the seal of the state, and it shall
16 show the name and business address and, if a corporation or
17 partnership, the state of incorporation or the state in which
18 the partnership is organized and the names of the general
19 partners, of the person claiming ownership of the mark in this
20 state, the date claimed for the first use of the mark anywhere
21 and the date claimed for the first use of the mark in this
22 state, the class or classes of goods or services on which the
23 mark is used, a reproduction of the mark, the registration
24 date and the term of the registration.

25 (2) Any certificate of registration issued by the
26 secretary ~~Department of State~~ under the provisions hereof or a
27 copy thereof duly certified by the secretary ~~Department of~~
28 ~~State~~ shall be admissible in evidence as competent and
29 sufficient proof of the registration of such mark in any
30 action or judicial proceedings in any court of this state, ~~and~~
31 ~~shall be prima facie evidence of the validity of the~~

1 ~~registration, registrant's ownership of the mark, and of~~
2 ~~registrant's exclusive right to use the mark in this state in~~
3 ~~connection with the goods or services specified in the~~
4 ~~certificate, subject to any conditions and limitations stated~~
5 ~~therein.~~

6 ~~(3) Contingent on the registration of a mark under~~
7 ~~this chapter, the reservation of such mark based on intent to~~
8 ~~use, as provided in this chapter, shall be prima facie~~
9 ~~evidence of priority of ownership of such mark within this~~
10 ~~state on or in connection with the goods or services specified~~
11 ~~in the reservation against any other person, except for a~~
12 ~~person whose mark has not been abandoned and who, prior to~~
13 ~~such reservation, has used the mark within this state on or in~~
14 ~~connection with such goods or services.~~

15 Section 8. Section 495.071, Florida Statutes, is
16 amended to read:

17 495.071 Duration and renewal.--

18 (1) Registration of a mark hereunder shall be
19 effective for a term of 5 ~~10~~ years from the date of
20 registration and, upon application filed within 6 months prior
21 to the expiration of such term, in a manner complying with the
22 requirements of the secretary ~~on a form to be furnished by the~~
23 ~~Department of State~~, the registration may be renewed for a
24 like term beginning at the end of the previous term. A renewal
25 fee of ~~\$87.50 for each class of goods or services with respect~~
26 ~~to which such renewal is sought~~, payable to the secretary
27 ~~Department of State~~, shall accompany the application for
28 renewal of the registration.

29 (2) A ~~mark~~ registration may be renewed for successive
30 periods of 5 ~~10~~ years in like manner.

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1 (3) Any registration in effect on the date on which
2 this section becomes law shall continue in effect for the
3 unexpired term thereof and may be renewed by filing an
4 application for renewal with the secretary complying with the
5 requirements of the secretary and paying the renewal fee
6 therefor within 6 months prior to the expiration of the
7 registration ~~The Department of State shall notify registrants~~
8 ~~of marks hereunder of the necessity of renewal within the year~~
9 ~~next preceding the expiration of the 10 years from the date of~~
10 ~~registration by writing to the last known address of the~~
11 ~~registrants. The department shall prescribe the forms on which~~
12 ~~to make the required notification and the renewal called for~~
13 ~~in subsection (1) and may substitute the uniform business~~
14 ~~report, pursuant to s. 606.06, as a means of satisfying the~~
15 ~~requirement of this part.~~

16 (4) All applications for renewals under this chapter
17 whether of registrations made under this act or of
18 registrations effected under any prior act, shall include a
19 statement that the mark has been and is still in use and
20 include a specimen showing actual use of the mark on or in
21 connection with the goods or services in this state, or that
22 ~~its nonuse is due to special circumstances which excuse such~~
23 ~~nonuse and is not due to any intention to abandon the mark.~~

24 Section 9. Section 495.081, Florida Statutes, is
25 amended to read:

26 495.081 Assignments; changes of name; other
27 instruments ~~Assignment.--~~

28 (1) Any mark and its registration hereunder shall be
29 assignable with the good will of the business in which the
30 mark is used or with that part of the good will of the
31 business connected with the use of and symbolized by the mark.

1 Assignment shall be by instruments in writing duly executed
2 and may be recorded with the secretary ~~Department of State~~
3 upon the payment of a recording fee ~~of \$50~~, payable to the
4 secretary who ~~Department of State which~~, upon recording of the
5 assignment, shall issue in the name of the assignee a new
6 certificate for the remainder of the term of the registration
7 or of the last renewal thereof. An assignment of any
8 registration under this chapter shall be void as against any
9 subsequent purchaser for valuable consideration without
10 notice, unless such assignment is recorded with the secretary
11 ~~Department of State~~ within 3 months after the date thereof or
12 prior to subsequent purchase ~~at any time after the expiration~~
13 ~~of such 3 month period, unless an assignment given in~~
14 ~~connection with any subsequent purchase is recorded with the~~
15 ~~Department of State prior to or within 10 days after such~~
16 ~~assignment is recorded.~~

17 (2) Any registrant or applicant effecting a change of
18 the name of the person to whom the mark was issued or for whom
19 an application was filed may record a certificate of change of
20 name of the registrant or applicant with the secretary upon
21 the payment of the recording fee. The secretary may issue in
22 the name of the assignee a certificate of registration of an
23 assigned application. The secretary may issue in the name of
24 the assignee a new certificate or registration for the
25 remainder of the term of the registration or last renewal
26 thereof.

27 (3) Other instruments, such as licenses, security
28 interests, or mortgages which relate to a mark registered or
29 application pending pursuant to this chapter, may be recorded
30 in the discretion of the secretary, provided that such
31 instrument is in writing and duly executed.

1 (4) Acknowledgement shall be prima facie evidence of
2 the execution of an assignment or other instrument and, when
3 recorded by the secretary, the record shall be prima facie
4 evidence of execution.

5 (5) A photocopy of any instrument referred to in this
6 subsection shall be accepted for recording if it is certified
7 to be a true and correct copy of the original by any of the
8 parties thereto, or their successors.

9 Section 10. Section 495.091, Florida Statutes, is
10 amended to read:

11 495.091 Records.--The ~~secretary~~ ~~Department of State~~
12 shall keep for public examination a record of all marks
13 registered or renewed under this chapter, as well as a record
14 of all documents recorded pursuant to s. 495.081.

15 Section 11. Section 495.101, Florida Statutes, is
16 amended to read:

17 (Substantial rewording of section. See
18 s. 495.101, F.S., for present text.)

19 495.101 Cancellation.--The secretary shall cancel from
20 the register:

21 (1) Any registration voluntarily requested to be
22 canceled by the registrant or the assignee of record.

23 (2) All registrations granted under this chapter and
24 not renewed in accordance with the provisions hereof.

25 (3) Any registration which a court of competent
26 jurisdiction finds that:

27 (a) The registered mark has been abandoned.

28 (b) The registrant is not the owner of the mark.

29 (c) The registration was granted improperly.

30 (d) The registration was obtained fraudulently.

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1 (e) The mark is or has become the generic name for the
2 goods or services, or a portion thereof, for which it has been
3 registered.

4 (f) The registered mark is so similar, as to be likely
5 to cause confusion or mistake or to deceive, to a mark
6 registered by another person in the United States Patent and
7 Trademark Office, prior to the date of the filing of the
8 application for registration by the registrant hereunder, and
9 not abandoned; however, should the registrant prove that the
10 registrant is the owner of a concurrent registration of a mark
11 in the United States Patent and Trademark Office covering an
12 area including this state, the registration hereunder shall
13 not be canceled.

14 (4) Any registration which a court of competent
15 jurisdiction orders canceled on any ground.

16 Section 12. Section 495.111, Florida Statutes, is
17 amended to read:

18 (Substantial rewording of section. See
19 s. 495.111, F.S., for present text.)

20 495.111 Classification.--The secretary shall establish
21 a classification of goods and services for convenience of
22 administration of this chapter, but shall not limit or extend
23 the applicant's or registrant's rights. A single application
24 for registration of a mark may include any or all goods upon
25 which, or services with which, the mark is actually being used
26 indicating the appropriate class or classes of goods or
27 services. When a single application includes goods or services
28 that fall within multiple classes, the secretary may require
29 payment of a fee for each class. To the extent practicable,
30 the classification of goods and services should conform to the
31

1 classification adopted by the United States Patent and
2 Trademark Office.

3 Section 13. Section 495.121, Florida Statutes, is
4 amended to read:

5 495.121 Fraudulent registration.--Any person who shall
6 for herself or himself, or on behalf of any other person,
7 procure the filing or registration of any mark with the
8 secretary ~~Department of State~~ under the provisions hereof, by
9 knowingly making any false or fraudulent representation or
10 declaration, verbally or in writing, or by any other
11 fraudulent means, shall be liable to pay all damages sustained
12 in consequence of such filing or registration, and for
13 punitive or exemplary damages, to be recovered by or on behalf
14 of the party injured thereby in any court of competent
15 jurisdiction.

16 Section 14. Section 495.131, Florida Statutes, is
17 amended to read:

18 495.131 Infringement.--Subject to the provisions of s.
19 495.161, any person who shall:

20 (1) Use, without the consent of the registrant, any
21 reproduction, counterfeit, copy, or colorable imitation of a
22 mark registered under this chapter ~~on any goods or in~~
23 connection with the sale, offering for sale, distribution or
24 advertising of any goods or services on or in connection with
25 which such use is likely to cause confusion or mistake or to
26 deceive as to the source or origin of such goods or services;
27 or

28 (2) Reproduce, counterfeit, copy or colorably imitate
29 any such mark and apply such reproduction, counterfeit, copy
30 or colorable imitation to labels, signs, prints, packages,
31 wrappers, receptacles or advertisements intended to be used

1 upon or in conjunction with the sale or other, ~~offering for~~
2 ~~sale~~, distribution ~~or advertising~~ in this state of goods or
3 services;

4
5 shall be liable in a civil action by the owner of such
6 registered mark for any or all of the remedies provided in s.
7 495.141, except that under subsection (2) hereof the
8 registrant shall not be entitled to recover profits or damages
9 unless the acts have been committed with the intent ~~knowledge~~
10 ~~that such mark is intended to be used~~ to cause confusion or
11 mistake or to deceive.

12 Section 15. Section 495.141, Florida Statutes, is
13 amended to read:

14 495.141 Remedies.--

15 ~~(1)~~ Any owner of a mark registered under this chapter
16 may proceed by suit to enjoin the manufacture, use, display,
17 or sale of any counterfeits or imitations thereof and any
18 court of competent jurisdiction may grant injunctions to
19 restrain such manufacture, use, display or sale as may be by
20 the said court deemed just and reasonable, and may require the
21 defendants to pay to such owner all profits derived from
22 and/or all damages suffered by reason of such wrongful
23 manufacture, use, display, or sale ~~and to pay the costs of the~~
24 ~~action~~; and such court may also order that any such
25 counterfeits or imitations in the possession or under the
26 control of any defendant in such case be delivered to an
27 officer of the court, or to the complainant, to be destroyed.
28 The court, in its discretion, may enter judgment for an amount
29 not to exceed three times such profits and damages and
30 reasonable attorney's fees of the prevailing party in such
31 cases where the court finds the other party committed the

1 wrongful acts with knowledge, in bad faith, or otherwise as
2 according to the circumstances of the case. The enumeration of
3 any right or remedy herein shall not affect a registrant's
4 right to prosecute under any penal law of this state ~~in~~
5 ~~assessing profits the plaintiff shall be required to prove~~
6 ~~defendant's sales only; defendant must prove all elements of~~
7 ~~cost or deduction claimed. In assessing damages the court may~~
8 ~~enter judgment, according to the circumstances of the case,~~
9 ~~for any sum above the amount found as actual damages, not~~
10 ~~exceeding 3 times such amount. If the court shall find that~~
11 ~~the amount of the recovery based on profits is either~~
12 ~~inadequate or excessive the court may in its discretion enter~~
13 ~~judgment for such sum as the court shall find to be just,~~
14 ~~according to the circumstances of the case. Such sum in either~~
15 ~~of the above circumstances shall constitute compensation and~~
16 ~~not a penalty.~~

17 ~~(2) The enumeration of any right or remedy herein~~
18 ~~shall not affect a registrant's right to prosecute under any~~
19 ~~penal law of this state.~~

20 Section 16. Section 495.145, Florida Statutes, is
21 created to read:

22 495.145 Forum for actions regarding registration;
23 service on out-of-state registrants.--

24 (1) Actions to require cancellation of a mark
25 registered pursuant to this chapter, or in mandamus, to compel
26 registration of a mark pursuant to this chapter shall be
27 brought in any court of competent jurisdiction. In an action
28 in mandamus, the proceeding shall be based solely upon the
29 record before the secretary. In an action for cancellation,
30 the secretary shall not be made a party to the proceeding but
31 shall be notified of the filing of the complaint by the clerk

1 of the court in which it is filed and shall be given the right
2 to intervene in the action.

3 (2) In any action brought against a nonresident
4 registrant, service may be effected upon the secretary as
5 agent for service of the registrant in accordance with the
6 procedures established for service upon nonresident
7 corporations and business entities under s. 48.081.

8 Section 17. Section 495.151, Florida Statutes, is
9 amended to read:

10 (Substantial rewording of section. See
11 s. 495.151, F.S., for present text.)

12 495.151 Injury to business reputation; dilution.--

13 (1) The owner of a mark that is famous in this state
14 shall be entitled, subject to the principles of equity and
15 upon such terms as the court deems reasonable, to an
16 injunction, and to obtain such other relief against another
17 person's commercial use of a mark or trade name, if such use
18 begins after the mark has become famous and causes dilution of
19 the distinctive quality of the mark, as is provided in this
20 section. In determining whether a mark is distinctive and
21 famous, a court may consider factors, including, but not
22 limited to:

23 (a) The degree of inherent or acquired distinctiveness
24 of the mark in this state.

25 (b) The duration and extent of use of the mark in
26 connection with the goods and services with which the mark is
27 used.

28 (c) The duration and extent of advertising and
29 publicity of the mark in this state.

30 (d) The geographical extent of the trading area in
31 which the mark is used.

1 (e) The channels of trade for the goods or services
2 with which the mark is used.

3 (f) The degree of recognition of the mark in the
4 trading areas and channels of trade in this state used by the
5 mark's owner and the person against whom the injunction is
6 sought.

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

9 (h) Whether the mark is the subject of a state
10 registration in this state, or a federal registration under
11 the federal Act of March 3, 1881, or the federal Act of
12 February 20, 1905, or on the principal register.

13 (2) In an action brought under this section, the owner
14 of a famous mark shall be entitled only to injunctive relief
15 in this state, unless the person against whom the injunctive
16 relief is sought willfully intended to trade on the owner's
17 reputation or to cause dilution of the famous mark. If such
18 willful intent is proven, the owner shall also be entitled to
19 the remedies set forth in this chapter, subject to the
20 discretion of the court and the principles of equity. The
21 following shall not be actionable under this section:

22 (a) Fair use of a famous mark by another person in
23 comparative commercial advertising or promotion to identify
24 the competing goods or services of the owner of the famous
25 mark.

26 (b) Noncommercial use of the mark.

27 (c) All forms of news reporting and news commentary.

28 Section 18. Section 495.161, Florida Statutes, is
29 amended to read:

30 495.161 Common-law rights.--Nothing herein shall
31 adversely affect ~~or diminish~~ the rights or the enforcement of

1 | rights in marks acquired in good faith at any time at common
2 | law.

3 | Section 19. Section 495.165, Florida Statutes, is
4 | created to read:

5 | 495.165 Fees.--The secretary shall prescribe
6 | reasonable fees payable for the various applications and
7 | recording fees and for related services. Unless specified by
8 | the secretary, the fees payable herein are not refundable.

9 | Section 20. Section 495.171, Florida Statutes, is
10 | amended to read:

11 | (Substantial rewording of section. See
12 | s. 495.171, F.S., for present text.)

13 | 495.171 Effective date; intent of chapter.--

14 | (1) This section shall be in force and take effect
15 | after its becoming a law but shall not affect any suit,
16 | proceeding, or appeal then pending.

17 | (2) The intent of this chapter is to provide a system
18 | of state trademark registration and protection substantially
19 | consistent with the federal system of trademark registration
20 | and protection under the Trademark Act of 1946, as amended. To
21 | that end, the construction given the federal act should be
22 | examined as persuasive authority for interpreting and
23 | construing this chapter.

24 | Section 21. If any provision of this act or the
25 | application thereof to any person or circumstance is held
26 | invalid, the invalidity shall not affect other provisions or
27 | applications of the act which can be given effect without the
28 | invalid provision or application, and to this end the
29 | provisions of this act are declared severable.

30 | Section 22. This act shall take effect July 1, 2005.
31 |