

1 A bill to be entitled
2 An act relating to trademarks; creating s. 495.001, F.S.;
3 providing a popular name; amending s. 495.011, F.S.;
4 providing definitions; amending s. 495.021, F.S.;
5 precluding registration of certain marks; amending s.
6 495.027, F.S.; conforming provisions; amending s. 495.031,
7 F.S.; providing requirements for information to be
8 contained in an application for registration of a mark;
9 authorizing the Secretary of State to require certain
10 information in an application; requiring the application
11 to be signed and verified by oath; requiring the
12 application to be accompanied by three specimens showing
13 the mark; requiring the application to be accompanied by a
14 fee; creating s. 495.035, F.S.; providing filing
15 guidelines for applications; amending s. 495.061, F.S.;
16 providing for the issuance of a certificate of
17 registration by the secretary; amending s. 495.071, F.S.;
18 providing guidelines for the renewal of marks; providing
19 duration of effectiveness for the mark; amending s.
20 495.081, F.S.; providing for the assignability of marks;
21 providing for change of name certificates for registrants;
22 authorizing certain instruments to be recorded; providing
23 acknowledgment of recording as prima facie evidence of the
24 execution of an assignment or other instrument;
25 authorizing a photocopy of any instrument to be acceptable
26 for recording; amending s. 495.091, F.S.; requiring the
27 secretary to record all marks registered with the state;
28 amending s. 495.101, F.S.; requiring the secretary to

29 cancel certain marks; amending s. 495.111; F.S., requiring
 30 the secretary to establish a classification of goods and
 31 services; amending s. 495.121, F.S.; conforming language;
 32 amending s. 495.131, F.S.; conforming language; amending
 33 s. 495.141, F.S.; providing remedies for the unauthorized
 34 use of a mark; removing language regarding the assessment
 35 of plaintiff's profits; creating s. 495.145, F.S.;
 36 providing a forum for actions regarding registration;
 37 providing service on out-of-state residents; amending s.
 38 495.151, F.S.; providing for an injunction in cases of
 39 dilution of a famous mark; providing factors to consider
 40 in determining a mark to be famous; providing damages in
 41 certain circumstances of dilution; amending s. 495.161,
 42 F.S.; deleting language relating to the diminishing of
 43 certain common law rights; creating s. 495.165, F.S.;
 44 requiring the secretary to prescribe certain fees;
 45 amending s. 495.171, F.S.; providing application and
 46 legislative intent; providing for severability; providing
 47 an effective date.

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 49 Be It Enacted by the Legislature of the State of Florida:

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

53 495.001 Popular name.--This chapter may be cited as the
 54 "Registration and Protection of Trademarks Act."

55 Section 2. Section 495.011, Florida Statutes, is amended
 56 to read:

CODING: Words **stricken** are deletions; words **underlined** are additions.

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(Substantial rewording of section. See

s. 495.011, F.S., for present text.)

495.011 Definitions.--As used in this chapter:

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

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

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

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

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

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

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

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

(5) "Person," and any other word or term used to designate the applicant or other party entitled to a benefit or privilege or rendered liable under the provisions of this chapter, means a juristic person as well as a natural person. The term "juristic person" includes a firm, partnership, corporation, union,

85 association, or other organization capable of suing and being
 86 sued in a court of law.

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

90 (7) "Secretary" means the Secretary of State or the
 91 designee of the secretary charged with the administration of
 92 this chapter.

93 (8) "Service mark" means any word, name, symbol, device,
 94 or any combination thereof, used by a person to identify and
 95 distinguish the services of such person, including a unique
 96 service, from the services of others, and to indicate the source
 97 of the services, even if that source is unknown. Distinctive
 98 features of radio or television programs, including, but not
 99 limited to, titles and character names used by a person, may be
 100 registered as service marks notwithstanding that the person or
 101 the programs may advertise the goods of the sponsor.

102 (9) "Trademark" means any word, name, symbol, device, or
 103 any combination thereof, used by a person to identify and
 104 distinguish the goods of such person, including a unique
 105 product, from those manufactured or sold by others, and to
 106 indicate the source of the goods, even if that source is
 107 unknown.

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

110 (11) "Use" means the bona fide use of a mark in the
 111 ordinary course of trade, and does not include the use of a
 112 trademark or service mark merely for the purpose of reserving a

113 right in the trademark or service mark. For the purposes of this
 114 chapter, a mark shall be deemed to be in use when it is placed
 115 on goods, their containers or the displays associated therewith,
 116 on the tags or labels affixed thereto, or, if the nature of the
 117 goods makes such placement impracticable, then on documents
 118 associated with the goods or their sale, and such goods are sold
 119 or transported in commerce in this state, and a service mark
 120 shall be deemed to be "used" when it is used or displayed in the
 121 sale or advertising of services and the services are rendered in
 122 this state.

123 Section 3. Section 495.021, Florida Statutes, is amended
 124 to read:

125 495.021 Registrability.--

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

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

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

135 (3)(c) Consists of or, ~~comprises or includes~~ the flag or
 136 coat of arms or other insignia of the United States, or of any
 137 state or municipality, or of any foreign nation, or any
 138 simulation thereof; ~~or~~

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

142 (5)(e) Consists of a mark which:

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

146 (b)2. When used on or in connection with ~~applied to~~ the
 147 goods or services of the applicant is primarily geographically
 148 descriptive or deceptively misdescriptive of ~~them or their~~
 149 ~~source or origin~~, or

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

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 156 The secretary ~~Department of State~~ may accept as evidence that
 157 the mark has become distinctive, as used on or in connection
 158 with ~~applied to~~ the applicant's goods or services, proof of
 159 ~~substantially exclusive and~~ continuous use thereof as a mark by
 160 the applicant in this state or elsewhere for 5 years next
 161 preceding the date on which the claim of distinctiveness is
 162 made; or

163 (6)(f) Consists of or comprises a mark which so resembles
 164 a mark registered in this state or a mark or trade name
 165 previously used ~~in this state~~ by another and not abandoned, as
 166 to be likely, when used on or in connection with ~~applied to~~ the

167 goods or services of the applicant, to cause confusion or
 168 mistake or to deceive. ~~Registration shall not be denied solely~~
 169 ~~on the basis of reservation or registration by another of a~~
 170 ~~corporate name or fictitious name that is the same or similar to~~
 171 ~~the mark for which registration is sought.~~

172 ~~(2) Subject to the provisions relating to the registration~~
 173 ~~of trademarks and service marks, so far as they are applicable,~~
 174 ~~collective and certification marks, including indications of~~
 175 ~~regional origin, shall be registrable under this chapter, in the~~
 176 ~~same manner and with the same effect as are trademarks and~~
 177 ~~service marks, by persons, and nations, states, municipalities,~~
 178 ~~and the like, exercising control over the use of the marks~~
 179 ~~sought to be registered, even though not possessing an~~
 180 ~~industrial or commercial establishment, and when registered they~~
 181 ~~shall be entitled to the protection provided in this chapter in~~
 182 ~~the case of trademarks and service marks. The Department of~~
 183 ~~State may establish a separate register for such collective~~
 184 ~~marks and certification marks.~~

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

187 495.027 Reservation.--

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

193 Section 5. Section 495.031, Florida Statutes, is amended
 194 to read:

195 (Substantial rewording of section. See

196 s. 495.031, F.S., for present text.)

197 495.031 Application for registration.--

198 (1) Subject to the limitations set forth in this chapter,

199 any person who uses a mark may file in the office of the

200 secretary, in a manner complying with the requirements of the

201 secretary, an application for registration of that mark,

202 including, but not limited to, the following information:

203 (a) The name and business address of the person applying

204 for such registration and, if a corporation, the state of

205 incorporation or, if a partnership, the state in which the

206 partnership is organized and the names of the general partners,

207 as specified by the secretary.

208 (b) The goods or services on or in connection with which

209 the mark is used and the mode or manner in which the mark is

210 used on or in connection with such goods or services and the

211 class in which such goods or services fall.

212 (c) The date when the mark was first used anywhere and the

213 date when it was first used in this state by the applicant or a

214 predecessor in interest.

215 (d) A statement that the applicant is the owner of the

216 mark, that the mark is in use, and that, to the knowledge of the

217 person verifying the application, no other person has

218 registered, either federally or in this state, or has the right

219 to use such mark either in the identical form thereof or in such

220 near resemblance thereto as to be likely, when applied to the

221 goods or services of such other person, to cause confusion, to

222 cause mistake, or to deceive.

223 (2) The secretary may also require a statement as to
 224 whether an application to register the mark, or portions or a
 225 composite thereof, has been filed by the applicant or a
 226 predecessor in interest in the United States Patent and
 227 Trademark Office and, if so, the applicant shall provide full
 228 particulars with respect thereto, including the filing date and
 229 serial number of each application, the status thereof, and, if
 230 any application was finally refused registration or has
 231 otherwise not resulted in a registration, the reasons therefore.

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

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

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

241 (6) The application shall be accompanied by the
 242 application fee payable to the secretary.

243 Section 6. Section 495.035, Florida Statutes, is created
 244 to read:

245 495.035 Filing of applications.--

246 (1) Upon the filing of an application for registration and
 247 payment of the application fee, the secretary may cause the
 248 application to be examined for conformity with this chapter.

249 (2) The applicant shall provide any additional pertinent
 250 information requested by the secretary, including a description

251 of a design mark and may make, or authorize the secretary to
252 make, such amendments to the application as may be reasonably
253 requested by the secretary or deemed by applicant to be
254 advisable to respond to any rejection or objection.

255 (3) The secretary may require the applicant to disclaim an
256 unregistrable component of a mark otherwise registrable, and an
257 applicant may voluntarily disclaim a component of a mark sought
258 to be registered. No disclaimer shall prejudice or affect the
259 applicant's or registrant's rights then existing or thereafter
260 arising in the disclaimed matter, or the applicant's or
261 registrant's rights of registration on another application if
262 the disclaimed matter be or shall have become distinctive of the
263 applicant's or registrant's goods or services.

264 (4) Amendments may be made by the secretary upon the
265 application submitted by the applicant upon the applicant's
266 agreement, or a new application may be required to be submitted.

267 (5) If the applicant is found not to be entitled to
268 registration, the secretary shall advise the applicant of the
269 rejection and of the reasons for rejection. The applicant shall
270 have a reasonable period of time specified by the secretary in
271 which to reply or to amend the application, in which event the
272 application shall then be reexamined. This procedure may be
273 repeated until:

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

275 (b) The applicant fails to reply or amend the application
276 within the specified time, whereupon the application shall be
277 abandoned.

278 (6) If the secretary denies registration of the mark, the

279 applicant may seek a writ of mandamus to compel such
 280 registration. Such writ may be granted, but without costs to the
 281 secretary, on proof that all the statements in the application
 282 are true and that the mark is otherwise entitled to
 283 registration.

284 (7) In the instance of multiple applications concurrently
 285 being processed by the secretary which seek registration of the
 286 same or confusingly similar marks for the same or related goods
 287 or services, the secretary shall grant priority to the
 288 applications in order of filing. If a prior-filed application is
 289 granted a registration, the other application or applications
 290 shall then be rejected. Any rejected applicant may bring an
 291 action for cancellation of the registration upon grounds of
 292 prior or superior rights to the mark, in accordance with the
 293 provisions of s. 495.101.

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

296 495.061 Certificate of registration.--

297 (1) Upon compliance by the applicant with the requirements
 298 of this chapter, the secretary ~~Department of State~~ shall cause a
 299 certificate of registration to be issued and delivered to the
 300 applicant. The certificate of registration shall be issued under
 301 the signature of the secretary ~~of State~~ and the seal of the
 302 state, and it shall show the name and business address and, if a
 303 corporation or partnership, the state of incorporation or the
 304 state in which the partnership is organized and the names of the
 305 general partners, of the person claiming ownership of the mark
 306 in this state, the date claimed for the first use of the mark

307 anywhere and the date claimed for the first use of the mark in
 308 this state, the class or classes of goods or services on which
 309 the mark is used, a reproduction of the mark, the registration
 310 date and the term of the registration.

311 (2) Any certificate of registration issued by the
 312 secretary ~~Department of State~~ under the provisions hereof or a
 313 copy thereof duly certified by the secretary ~~Department of State~~
 314 shall be admissible in evidence as competent and sufficient
 315 proof of the registration of such mark in any action or judicial
 316 proceedings in any court of this state, ~~and shall be prima facie~~
 317 ~~evidence of the validity of the registration, registrant's~~
 318 ~~ownership of the mark, and of registrant's exclusive right to~~
 319 ~~use the mark in this state in connection with the goods or~~
 320 ~~services specified in the certificate, subject to any conditions~~
 321 ~~and limitations stated therein.~~

322 ~~(3) Contingent on the registration of a mark under this~~
 323 ~~chapter, the reservation of such mark based on intent to use, as~~
 324 ~~provided in this chapter, shall be prima facie evidence of~~
 325 ~~priority of ownership of such mark within this state on or in~~
 326 ~~connection with the goods or services specified in the~~
 327 ~~reservation against any other person, except for a person whose~~
 328 ~~mark has not been abandoned and who, prior to such reservation,~~
 329 ~~has used the mark within this state on or in connection with~~
 330 ~~such goods or services.~~

331 Section 8. Section 495.071, Florida Statutes, is amended
 332 to read:

333 495.071 Duration and renewal.--

334 (1) Registration of a mark hereunder shall be effective
 335 for a term of 5 ~~10~~ years from the date of registration and, upon
 336 application filed within 6 months prior to the expiration of
 337 such term, in a manner complying with the requirements of the
 338 secretary ~~on a form to be furnished by the Department of State,~~
 339 the registration may be renewed for a like term beginning at the
 340 end of the previous term. A renewal fee ~~of \$87.50 for each class~~
 341 ~~of goods or services with respect to which such renewal is~~
 342 ~~sought,~~ payable to the secretary ~~Department of State,~~ shall
 343 accompany the application for renewal of the registration.

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

346 (3) Any registration in effect on the date on which this
 347 section becomes law shall continue in effect for the unexpired
 348 term thereof and may be renewed by filing an application for
 349 renewal with the secretary complying with the requirements of
 350 the secretary and paying the renewal fee therefor within 6
 351 months prior to the expiration of the registration ~~The~~
 352 ~~Department of State shall notify registrants of marks hereunder~~
 353 ~~of the necessity of renewal within the year next preceding the~~
 354 ~~expiration of the 10 years from the date of registration by~~
 355 ~~writing to the last known address of the registrants. The~~
 356 ~~department shall prescribe the forms on which to make the~~
 357 ~~required notification and the renewal called for in subsection~~
 358 ~~(1) and may substitute the uniform business report, pursuant to~~
 359 ~~s. 606.06, as a means of satisfying the requirement of this~~
 360 ~~part.~~

361 (4) All applications for renewals under this chapter
362 whether of registrations made under this act or of registrations
363 effected under any prior act, shall include a statement that the
364 mark has been and is still in use and include a specimen showing
365 actual use of the mark on or in connection with the goods or
366 services in this state, or that its nonuse is due to special
367 circumstances which excuse such nonuse and is not due to any
368 intention to abandon the mark.

369 Section 9. Section 495.081, Florida Statutes, is amended
370 to read:

371 495.081 Assignments; changes of name; other instruments
372 Assignment.--

373 (1) Any mark and its registration hereunder shall be
374 assignable with the good will of the business in which the mark
375 is used or with that part of the good will of the business
376 connected with the use of and symbolized by the mark. Assignment
377 shall be by instruments in writing duly executed and may be
378 recorded with the secretary ~~Department of State~~ upon the payment
379 of a recording fee of ~~\$50~~, payable to the secretary who
380 ~~Department of State which~~, upon recording of the assignment,
381 shall issue in the name of the assignee a new certificate for
382 the remainder of the term of the registration or of the last
383 renewal thereof. An assignment of any registration under this
384 chapter shall be void as against any subsequent purchaser for
385 valuable consideration without notice, unless such assignment is
386 recorded with the secretary ~~Department of State~~ within 3 months
387 after the date thereof or prior to subsequent purchase ~~at any~~
388 ~~time after the expiration of such 3-month period, unless an~~

389 ~~assignment given in connection with any subsequent purchase is~~
390 ~~recorded with the Department of State prior to or within 10 days~~
391 ~~after such assignment is recorded.~~

392 (2) Any registrant or applicant effecting a change of the
393 name of the person to whom the mark was issued or for whom an
394 application was filed may record a certificate of change of name
395 of the registrant or applicant with the secretary upon the
396 payment of the recording fee. The secretary may issue in the
397 name of the assignee a certificate of registration of an
398 assigned application. The secretary may issue in the name of the
399 assignee a new certificate or registration for the remainder of
400 the term of the registration or last renewal thereof.

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

406 (4) Acknowledgement shall be prima facie evidence of the
407 execution of an assignment or other instrument and, when
408 recorded by the secretary, the record shall be prima facie
409 evidence of execution.

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

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

416 495.091 Records.--The secretary ~~Department of State~~ shall
417 keep for public examination a record of all marks registered or
418 renewed under this chapter, as well as a record of all documents
419 recorded pursuant to s. 495.081.

420 Section 11. Section 495.101, Florida Statutes, is amended
421 to read:

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

424 495.101 Cancellation.--The secretary shall cancel from the
425 register:

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

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

430 (3) Any registration which a court of competent
431 jurisdiction finds that:

432 (a) The registered mark has been abandoned.

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

434 (c) The registration was granted improperly.

435 (d) The registration was obtained fraudulently.

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

439 (f) The registered mark is so similar, as to be likely to
440 cause confusion or mistake or to deceive, to a mark registered
441 by another person in the United States Patent and Trademark
442 Office, prior to the date of the filing of the application for
443 registration by the registrant hereunder, and not abandoned;

444 however, should the registrant prove that the registrant is the
 445 owner of a concurrent registration of a mark in the United
 446 States Patent and Trademark Office covering an area including
 447 this state, the registration hereunder shall not be canceled.

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

450 Section 12. Section 495.111, Florida Statutes, is amended
 451 to read:

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

454 495.111 Classification.--The secretary shall establish a
 455 classification of goods and services for convenience of
 456 administration of this chapter, but shall not limit or extend
 457 the applicant's or registrant's rights. A single application for
 458 registration of a mark may include any or all goods upon which,
 459 or services with which, the mark is actually being used
 460 indicating the appropriate class or classes of goods or
 461 services. When a single application includes goods or services
 462 which fall within multiple classes, the secretary may require
 463 payment of a fee for each class. To the extent practicable, the
 464 classification of goods and services should conform to the
 465 classification adopted by the United States Patent and Trademark
 466 Office.

467 Section 13. Section 495.121, Florida Statutes, is amended
 468 to read:

469 495.121 Fraudulent registration.--Any person who shall for
 470 herself or himself, or on behalf of any other person, procure
 471 the filing or registration of any mark with the secretary

472 ~~Department of State~~ under the provisions hereof, by knowingly
 473 making any false or fraudulent representation or declaration,
 474 verbally or in writing, or by any other fraudulent means, shall
 475 be liable to pay all damages sustained in consequence of such
 476 filing or registration, and for punitive or exemplary damages,
 477 to be recovered by or on behalf of the party injured thereby in
 478 any court of competent jurisdiction.

479 Section 14. Section 495.131, Florida Statutes, is amended
 480 to read:

481 495.131 Infringement.--Subject to the provisions of s.
 482 495.161, any person who shall:

483 (1) Use, without the consent of the registrant, any
 484 reproduction, counterfeit, copy, or colorable imitation of a
 485 mark registered under this chapter ~~on any goods or~~ in connection
 486 with the sale, offering for sale, distribution or advertising of
 487 any goods or services on or in connection with which such use is
 488 likely to cause confusion or mistake or to deceive as to the
 489 source or origin of such goods or services; or

490 (2) Reproduce, counterfeit, copy or colorably imitate any
 491 such mark and apply such reproduction, counterfeit, copy or
 492 colorable imitation to labels, signs, prints, packages,
 493 wrappers, receptacles or advertisements intended to be used upon
 494 or in conjunction with the sale or other, ~~offering for sale,~~
 495 ~~distribution or advertising~~ in this state of goods or services;

496
 497 shall be liable in a civil action by the owner of such
 498 registered mark for any or all of the remedies provided in s.
 499 495.141, except that under subsection (2) hereof the registrant

500 shall not be entitled to recover profits or damages unless the
 501 acts have been committed with the intent ~~knowledge that such~~
 502 ~~mark is intended to be used~~ to cause confusion or mistake or to
 503 deceive.

504 Section 15. Section 495.141, Florida Statutes, is amended
 505 to read:

506 495.141 Remedies.--

507 ~~(1)~~ Any owner of a mark registered under this chapter may
 508 proceed by suit to enjoin the manufacture, use, display, or sale
 509 of any counterfeits or imitations thereof and any court of
 510 competent jurisdiction may grant injunctions to restrain such
 511 manufacture, use, display or sale as may be by the said court
 512 deemed just and reasonable, and may require the defendants to
 513 pay to such owner all profits derived from and/or all damages
 514 suffered by reason of such wrongful manufacture, use, display,
 515 or sale ~~and to pay the costs of the action;~~ and such court may
 516 also order that any such counterfeits or imitations in the
 517 possession or under the control of any defendant in such case be
 518 delivered to an officer of the court, or to the complainant, to
 519 be destroyed. The court, in its discretion, may enter judgment
 520 for an amount not to exceed three times such profits and damages
 521 and reasonable attorney's fees of the prevailing party in such
 522 cases where the court finds the other party committed the
 523 wrongful acts with knowledge, in bad faith, or otherwise as
 524 according to the circumstances of the case. The enumeration of
 525 any right or remedy herein shall not affect a registrant's right
 526 to prosecute under any penal law of this state ~~In assessing~~
 527 ~~profits the plaintiff shall be required to prove defendant's~~

528 ~~sales only; defendant must prove all elements of cost or~~
529 ~~deduction claimed. In assessing damages the court may enter~~
530 ~~judgment, according to the circumstances of the case, for any~~
531 ~~sum above the amount found as actual damages, not exceeding 3~~
532 ~~times such amount. If the court shall find that the amount of~~
533 ~~the recovery based on profits is either inadequate or excessive~~
534 ~~the court may in its discretion enter judgment for such sum as~~
535 ~~the court shall find to be just, according to the circumstances~~
536 ~~of the case. Such sum in either of the above circumstances shall~~
537 ~~constitute compensation and not a penalty.~~

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

541 Section 16. Section 495.145, Florida Statutes, is created
542 to read:

543 495.145 Forum for actions regarding registration; service
544 on out-of-state registrants.--

545 (1) Actions to require cancellation of a mark registered
546 pursuant to this chapter, or in mandamus, to compel registration
547 of a mark pursuant to this chapter shall be brought in any court
548 of competent jurisdiction. In an action in mandamus, the
549 proceeding shall be based solely upon the record before the
550 secretary. In an action for cancellation, the secretary shall
551 not be made a party to the proceeding but shall be notified of
552 the filing of the complaint by the clerk of the court in which
553 it is filed and shall be given the right to intervene in the
554 action.

555 (2) In any action brought against a nonresident
556 registrant, service may be effected upon the secretary as agent
557 for service of the registrant in accordance with the procedures
558 established for service upon nonresident corporations and
559 business entities under s. 48.081.

560 Section 17. Section 495.151, Florida Statutes, is amended
561 to read:

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

564 495.151 Injury to business reputation; dilution.--

565 (1) The owner of a mark which is famous in this state
566 shall be entitled, subject to the principles of equity and upon
567 such terms as the court seems reasonable, to an injunction, and
568 to obtain such other relief against another person's commercial
569 use of a mark or trade name, if such use begins after the mark
570 has become famous and causes dilution of the distinctive quality
571 of the mark, as is provided in this section. In determining
572 whether a mark is distinctive and famous, a court may consider
573 factors, including, but not limited to:

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

576 (b) The duration and extent of use of the mark in
577 connection with the goods and services with which the mark is
578 used.

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

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

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

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

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

590 (h) Whether the mark is the subject of a state
 591 registration in this state, or a federal registration under the
 592 federal Act of March 3, 1881, or the federal Act of February 20,
 593 1905, or on the principal register.

594 (2) In an action brought under this section, the owner of
 595 a famous mark shall be entitled only to injunctive relief in
 596 this state, unless the person against whom the injunctive relief
 597 is sought willfully intended to trade on the owner's reputation
 598 or to cause dilution of the famous mark. If such willful intent
 599 is proven, the owner shall also be entitled to the remedies set
 600 forth in this chapter, subject to the discretion of the court
 601 and the principles of equity. The following shall not be
 602 actionable under this section:

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

606 (b) Noncommercial use of the mark.

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

608 Section 18. Section 495.161, Florida Statutes, is amended
 609 to read:

610 495.161 Common-law rights.--Nothing herein shall adversely
 611 affect ~~or diminish~~ the rights or the enforcement of rights in
 612 marks acquired in good faith at any time at common law.

613 Section 19. Section 495.165, Florida Statutes, is created
 614 to read:

615 495.165 Fees.--The secretary shall prescribe reasonable
 616 fees payable for the various applications and recording fees and
 617 for related services. Unless specified by the secretary, the
 618 fees payable herein are not refundable.

619 Section 20. Section 495.171, Florida Statutes, is amended
 620 to read:

621 (Substantial rewording of section. See
 622 s. 495.171, F.S., for present text.)

623 495.171 Effective date; intent of chapter.--

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

627 (2) The intent of this chapter is to provide a system of
 628 state trademark registration and protection substantially
 629 consistent with the federal system of trademark registration and
 630 protection under the Trademark Act of 1946, as amended. To that
 631 end, the construction given the federal act should be examined
 632 as persuasive authority for interpreting and construing this
 633 chapter.

634 Section 21. If any provision of this act or the
 635 application thereof to any person or circumstance is held
 636 invalid, the invalidity shall not affect other provisions or
 637 applications of the act which can be given effect without the

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638 | invalid provision or application, and to this end the provisions
639 | of this act are declared severable.

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