

Bill No. SB 2186

Barcode 493300

CHAMBER ACTION

Senate

House

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The Committee on Commerce and Consumer Services (Aronberg)
recommended the following amendment:

Senate Amendment (with title amendment)

Delete everything after the enacting clause

and insert:

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

495.001 Short title.--This chapter may be cited as the
"Registration and Protection of Trademarks Act."

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

(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 3 consecutive years shall

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1 constitute prima facie evidence of abandonment.

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

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

8 (3) "Certification mark" means any word, name, symbol,
9 or device, or any combination thereof, used by a person other
10 than the owner of the mark to certify regional or other
11 origin, material, mode of manufacture, quality, accuracy, or
12 other characteristics of such person's goods or services or
13 that the work or labor on the goods or services was performed
14 by members of a union or other organization.

15 (4) "Collective mark" means a trademark or service
16 mark used by the members of a cooperative, an association, or
17 other collective group or organization, and includes marks
18 used to indicate membership in a union, an association, or
19 other organization.

20 (5) "Department" means the Florida Department of State
21 or its designee charged with the administration of this
22 chapter.

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

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

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

29 (7) "Mark" includes any trademark, service mark,
30 certification mark, or collective mark entitled to
31 registration under this chapter, whether or not registered.

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1 (8) "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 "Juristic person" includes a firm, partnership, corporation,
 6 union, association, or other organization capable of suing and
 7 being sued in a court of law.

8 (9) "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 (10) "Related company" means any person whose use of a
 12 mark is controlled by the owner of the mark with respect to
 13 the nature and quality of the goods or services on or in
 14 connection with which the mark is used.

15 (11) "Service mark" means any word, name, symbol, or
 16 device, or any combination thereof, used by a person to
 17 identify and distinguish the services of such person,
 18 including a unique service, from the services of others, and
 19 to indicate the source of the services, even if that source is
 20 unknown. Titles, character names, and other distinctive
 21 features of radio or television programs may be registered as
 22 service marks notwithstanding that the person or the programs
 23 may advertise the goods of the sponsor.

24 (12) "Trade name" means any name used by a person to
 25 identify a business or vocation of such person.

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

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1 (14) "Use" means the bona fide use of a mark in the
 2 ordinary course of trade and not used merely for the purpose
 3 of reserving a right in a mark. For purposes of this chapter,
 4 a mark is deemed to be in use:

5 (a) On goods when:

6 1. The mark is placed in any manner on the goods,
 7 their containers or the displays associated therewith, or on
 8 the tags or labels affixed thereto, or, if the nature of the
 9 goods makes such placement impracticable, on documents
 10 associated with the goods or their sale; and

11 2. The goods are sold or transported in this state.

12 (b) On services when the mark is used or displayed in
 13 the sale or advertising of services and the services are
 14 rendered in this state.

15 Section 3. Subsection (1) of section 495.021, Florida
 16 Statutes, is amended to read:

17 495.021 Registrability.--

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

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

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

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

31 (d) Consists of or, comprises a ~~or includes~~ the name,

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1 signature, or portrait identifying a particular ~~of any~~ living
 2 individual, except by ~~with~~ her or his written consent, or the
 3 name, signature, or portrait of a deceased President of the
 4 United States during the lifetime of his widow or her widower,
 5 if any, except by the written consent of the widow or widower;

6 or

7 (e) Consists of a mark which:

8 1. When used on or in connection with ~~applied to~~ the
 9 goods or services of the applicant, is merely descriptive or
 10 deceptively misdescriptive of them;

11 2. When used on or in connection with ~~applied to~~ the
 12 goods or services of the applicant, is primarily
 13 geographically descriptive ~~or deceptively misdescriptive~~ of
 14 them; or their source or origin, or

15 3. When used on or in connection with the goods or
 16 services of the applicant, is primarily geographically
 17 misdescriptive of the goods or services;

18 4.3. ~~Is primarily merely a surname; or~~

19 5. Comprises any matter that, as a whole, is
 20 functional.

21
 22 Except as expressly excluded in subparagraphs 3. and 5.,
 23 ~~provided, however, that~~ nothing in this paragraph shall
 24 prevent the registration of a mark used ~~in this state~~ by the
 25 applicant which has become distinctive of the applicant's
 26 goods or services ~~in this state or elsewhere~~. The department
 27 ~~of State~~ may accept as prima facie evidence that the mark has
 28 become distinctive, as used on or in connection with ~~applied~~
 29 ~~to~~ the applicant's goods or services, proof of substantially
 30 exclusive and continuous use thereof as a mark by the
 31 applicant in this state or elsewhere for the 5 years before

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1 ~~next preceding~~ the date on which the claim of distinctiveness
2 is made; or

3 (f) Consists of or comprises a mark which so resembles
4 a mark registered in this state or a mark or trade name
5 previously used in this state by another and not abandoned, as
6 to be likely, when applied to the goods or services of the
7 applicant, to cause confusion or mistake or to deceive.
8 Registration shall not be denied solely on the basis of
9 reservation or registration by another of a corporate name or
10 fictitious name that is the same or similar to the mark for
11 which registration is sought.

12 Section 4. Section 495.027, Florida Statutes, is
13 repealed.

14 Section 5. Section 495.031, Florida Statutes, is
15 amended to read:

16 495.031 Application for registration.--

17 (1) Subject to the limitations set forth in this
18 chapter, any person who ~~adopts and~~ uses a trademark or service
19 mark in this state may file with the department ~~of State, in a~~
20 manner and on a form complying with the requirements of to be
21 ~~furnished by~~ the department, an application for registration
22 of that ~~trademark or service~~ mark setting forth, but not
23 limited to, the following information:

24 (a) The name and business address of the person
25 applying for such registration, and, if a business entity, the
26 place corporation, the state of incorporation or organization;

27 (b) The goods or services on or in connection with
28 which the mark is used and the mode or manner in which the
29 mark is used in connection with such goods or services and the
30 class or classes in which such goods or services fall;

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

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1 the date ~~when~~ it was first used in this state by the
 2 applicant, the applicant's ~~or her or his~~ predecessor in
 3 interest, business or a related company of the applicant ~~or~~
 4 ~~the applicant's predecessor;~~ and

5 (d) A statement that the applicant is the owner of the
 6 mark, that the mark is in use, and that, to the best of the
 7 applicant's knowledge, no other person except a related
 8 company has registered such mark in this state, or has the
 9 right to use such mark in this state, either in the identical
 10 form thereof or in such near resemblance thereto as to be
 11 likely, when applied to the goods or services of such other
 12 person, to cause confusion, to cause mistake, or to deceive ~~or~~
 13 ~~confuse or to be mistaken therefor.~~

14 (2) Every applicant for registration of a
 15 certification mark in this state shall file with the
 16 department ~~of State,~~ in a manner and ~~on a~~ form complying with
 17 the requirements of ~~to be furnished by~~ the department, an
 18 application setting forth, but not limited to, the following
 19 information:

20 (a) The information required by paragraph (1)(a);

21 (b) The date when the certification mark was first
 22 used anywhere and the date when it was first used in this
 23 state under the authority of the applicant;

24 (c) The manner in which and the conditions under which
 25 the certification mark is used in this state; and

26 (d) A statement that the applicant is exercising
 27 control over the use of the mark, that the applicant is not
 28 herself or himself engaged in the production or marketing of
 29 the goods or services to which the mark is applied, and that
 30 no person except the applicant or persons authorized by the
 31 applicant, or related companies thereof, has the right to use

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1 such mark in this state either in the identical form thereof
2 or in such near resemblance thereto as to be likely to deceive
3 or confuse or to be mistaken therefor.

4 (3) Every applicant for registration of a collective
5 mark in this state shall file with the department ~~of State, in~~
6 a manner and on a form complying with the requirements of to
7 ~~be furnished by~~ the department, an application setting forth,
8 but not limited to, the following information:

9 (a) The information required by paragraphs (1)(a) and
10 (b);

11 (b) The date when the collective mark was first used
12 anywhere and the date when it was first used in this state by
13 any member of the applicant or a related company of such
14 member;

15 (c) The class of persons entitled to use the mark,
16 indicating their relationship to the applicant, and the nature
17 of the applicant's control over the use of the mark; and

18 (d) A statement that no person except the applicant or
19 members of the applicant, or related companies thereof, has
20 the right to use such mark in this state either in the
21 identical form thereof or in such near resemblance thereto as
22 to be likely to deceive or confuse or to be mistaken therefor.

23 (4) The department may also require that a drawing of
24 the mark, complying with the requirements of the department,
25 accompany the application.

26 (5)(4) Every application under this section shall be
27 signed and verified by the applicant or by a member of the
28 firm or an officer or other authorized representative of the
29 business entity ~~of the corporation, association, union or~~
30 ~~other organization~~ applying.

31 (6)(5) Every application under this section shall be

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1 accompanied by three specimens or facsimiles showing the mark
2 as actually used ~~a specimen or facsimile of such mark in~~
3 ~~triplicate.~~

4 ~~(7)(6)~~ Every application under this section shall be
5 accompanied by a filing fee ~~of \$87.50,~~ payable to the
6 department in accordance with s. 495.191 ~~of State, for each~~
7 ~~class of goods or services as specified in s. 495.111, in~~
8 ~~connection with which the mark is used.~~

9 Section 6. Section 495.035, Florida Statutes, is
10 created to read:

11 495.035 Filing of applications.--

12 (1) Upon the receipt of an application for
13 registration and payment of the application fee, the
14 department may cause the application to be examined for
15 conformity with this chapter.

16 (2) The applicant shall provide any additional
17 pertinent information requested by the department, including a
18 description of a design mark, and may make, or authorize the
19 department to make, such amendments to the application as may
20 be reasonably requested by the department or deemed by
21 applicant to be advisable to respond to any rejection or
22 objection.

23 (3) The department may require the applicant to
24 disclaim an unregistrable component of a mark otherwise
25 registrable, and an applicant may voluntarily disclaim a
26 component of a mark sought to be registered. No disclaimer
27 shall prejudice or affect the applicant's or registrant's
28 rights then existing or thereafter arising in the disclaimed
29 matter, or the applicant's or registrant's rights of
30 registration on another application, if the disclaimed matter
31 is or has become distinctive of the applicant's or

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1 registrant's goods or services.

2 (4) Amendments may be made by the department upon the
3 application submitted by the applicant upon the applicant's
4 agreement, or a new application may be required to be
5 submitted. Amendments to an otherwise properly filed
6 application shall not affect the application filing date for
7 purposes of determining the applicant's or registrant's filing
8 priority rights.

9 (5) If the applicant is found not to be entitled to
10 registration, the department shall advise the applicant of the
11 rejection and of the reasons for rejection. The applicant
12 shall have 3 months in which to reply or amend the
13 application, in which event the application shall be
14 reexamined. This procedure may be repeated until:

15 (a) The department makes final its refusal to register
16 the mark; or

17 (b) The applicant fails to reply or amend the
18 application within the specified period, whereupon the
19 application shall be abandoned.

20
21 For good cause shown, such as the pendency of litigation
22 involving the mark, the department may extend the period of
23 time in which to respond to the rejection or suspend
24 examination of the application.

25 (6) If the department makes its final refusal to
26 register the mark, the applicant may seek review of such
27 decision in accordance with ss. 120.569 and 120.57.

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

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

7 Section 7. Section 495.041, Florida Statutes, is
 8 amended to read:

9 495.041 Use by related companies.--Where a mark
 10 registered or unregistered is or may be used legitimately by
 11 related companies, such use shall inure to the benefit of the
 12 owner of the mark, and such use shall not affect the validity
 13 of such mark or of its registration, provided such mark is not
 14 used in such manner as to deceive the public. If first use of
 15 a mark by a person is controlled by the registrant or
 16 applicant for registration of a mark with respect to the
 17 nature and quality of the goods or services, such first use
 18 shall inure to the benefit of that registrant or applicant, as
 19 the case may be.

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

22 495.061 Certificate of registration.--

23 (1) Upon compliance by the applicant with the
 24 requirements of this chapter, the department ~~of State~~ shall
 25 cause a certificate of registration to be issued and delivered
 26 to the applicant. The certificate of registration shall be
 27 issued under the signature of the Secretary of State and the
 28 seal of the state, and it shall show the name and business
 29 address and, if a business entity ~~corporation~~, the place ~~state~~
 30 of incorporation or organization, of the person claiming
 31 ownership of the mark in this state, the date claimed for the

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1 first use of the mark anywhere and the date claimed for the
 2 first use of the mark in this state, the class or classes of
 3 goods or services and a description of the goods or services
 4 on or in connection with ~~on~~ which the mark is used, a
 5 reproduction of the mark, the registration date and the term
 6 of the registration.

7 (2) Any certificate of registration issued by the
 8 department ~~of State~~ under the provisions hereof or a copy
 9 thereof duly certified by the department ~~of State~~ shall be
 10 admissible in evidence as competent and sufficient proof of
 11 the registration of such mark in any action or judicial
 12 proceedings in any court of this state, and shall be prima
 13 facie evidence of the validity of the registration,
 14 registrant's ownership of the mark, and of registrant's
 15 exclusive right to use the mark in this state on or in
 16 connection with the goods or services specified in the
 17 certificate, subject to any conditions and limitations stated
 18 therein.

19 ~~(3) Contingent on the registration of a mark under~~
 20 ~~this chapter, the reservation of such mark based on intent to~~
 21 ~~use, as provided in this chapter, shall be prima facie~~
 22 ~~evidence of priority of ownership of such mark within this~~
 23 ~~state on or in connection with the goods or services specified~~
 24 ~~in the reservation against any other person, except for a~~
 25 ~~person whose mark has not been abandoned and who, prior to~~
 26 ~~such reservation, has used the mark within this state on or in~~
 27 ~~connection with such goods or services.~~

28 Section 9. Section 495.071, Florida Statutes, is
 29 amended to read:

30 495.071 Duration and renewal.--

31 (1) Registration of a mark hereunder shall be

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1 effective for a term of 5 ~~10~~ years from the date of
 2 registration and, upon application filed within 6 months prior
 3 to the expiration of such term, in a manner and form complying
 4 with the requirements of ~~on a form to be furnished by the~~
 5 department ~~of State~~, the registration may be renewed for a
 6 like term beginning at the end of the expiring term. Every
 7 application under this section shall be accompanied by a
 8 filing fee ~~A renewal fee of \$87.50 for each class of goods or~~
 9 ~~services with respect to which such renewal is sought, payable~~
 10 to the department in accordance with s. 495.191 ~~of State,~~
 11 ~~shall accompany the application for renewal of the~~
 12 ~~registration.~~

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

15 (3) Any registration in effect on January 1, 2007,
 16 shall continue in effect for the unexpired term thereof and
 17 may be renewed by filing an application for renewal with the
 18 department in a manner and form complying with the
 19 requirements of the department and paying the renewal fee
 20 therefor within 6 months prior to the expiration of the
 21 registration. ~~The Department of State shall notify registrants~~
 22 ~~of marks hereunder of the necessity of renewal within the year~~
 23 ~~next preceding the expiration of the 10 years from the date of~~
 24 ~~registration by writing to the last known address of the~~
 25 ~~registrants. The department shall prescribe the forms on which~~
 26 ~~to make the required notification and the renewal called for~~
 27 ~~in subsection (1) and may substitute the uniform business~~
 28 ~~report, pursuant to s. 606.06, as a means of satisfying the~~
 29 ~~requirement of this part.~~

30 (4) All applications for renewal ~~renewals~~ under this
 31 chapter, whether of registrations made under this act or of

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1 registrations made under any prior acts, shall include a
 2 verified statement that the mark is still in use in this
 3 state, and shall include a specimen showing actual use of the
 4 mark on or in connection with the goods or services subject to
 5 the renewal application, or shall state that its nonuse is due
 6 to special circumstances which excuse such nonuse and is not
 7 due to any intention to abandon the mark.

8 Section 10. Section 495.081, Florida Statutes, is
 9 amended to read:

10 495.081 Assignments; changes of name; security
 11 interests ~~Assignment~~.--

12 (1) A registered mark or a mark for which an
 13 application for registration has been filed ~~Any mark and its~~
 14 ~~registration hereunder~~ shall be assignable with the goodwill
 15 ~~good will~~ of the business in which the mark is used or with
 16 that part of the goodwill ~~good will~~ of the business connected
 17 with the use of and symbolized by the mark. Assignments
 18 ~~Assignment~~ shall be by an instrument ~~instruments~~ in writing
 19 duly executed and may be recorded with the department ~~of State~~
 20 upon the payment of the applicable ~~a~~ fee. A photocopy of an
 21 assignment shall be accepted for recording if it is certified
 22 by any of the parties thereto, or their successors, to be a
 23 true and correct copy of the original. Upon recording of the
 24 assignment, of \$50, payable to the department of State which,
 25 ~~upon recording of the assignment,~~ shall issue in the name of
 26 the assignee a new certificate for the remainder of the term
 27 of the registration or of the last renewal thereof.

28 (2) An assignment of any registration under this
 29 chapter shall be void ~~as~~ against any subsequent purchaser for
 30 valuable consideration without notice, unless such assignment
 31 is recorded with the department ~~of State~~ within 3 months after

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1 the date of the assignment or prior to the subsequent purchase
 2 thereof or at any time after the expiration of such 3-month
 3 period, unless an assignment given in connection with any
 4 subsequent purchase is recorded with the Department of State
 5 prior to or within 10 days after such assignment is recorded.

6 (3) A registrant or applicant for registration
 7 effecting a change of the name may record a certificate of
 8 change of name of the registrant or applicant with the
 9 department upon the payment of the recording fee payable to
 10 the department in accordance with s. 495.191. In the case of a
 11 pending application for a mark that becomes approved for
 12 registration, the department shall issue a certificate of
 13 registration in the registrant's new name. In the case of a
 14 registered mark, the department shall issue a new certificate
 15 of registration in the registrant's new name for the remainder
 16 of the term of the registration or last renewal thereof. A
 17 person's failure to record a name change in accordance with
 18 this subsection shall not affect the person's substantive
 19 rights in the mark or its registration.

20 (4) Acknowledgment shall be prima facie evidence of
 21 the execution of an assignment or other instrument and, when
 22 recorded by the department, the record shall be prima facie
 23 evidence of execution.

24 (5) Security interests in marks shall be created and
 25 perfected in accordance with chapter 679.

26 Section 11. Section 495.091, Florida Statutes, is
 27 amended to read:

28 495.091 Records.--The department ~~of State~~ shall keep
 29 for public examination a record of all marks registered or
 30 renewed under this chapter, including all documents recorded
 31 under s. 495.081.

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1 Section 12. Section 495.101, Florida Statutes, is
2 amended to read:

3 495.101 Cancellation.--The department ~~of State~~ shall
4 cancel from the register:

5 ~~(1) After 1 year from the effective date of this~~
6 ~~chapter, all registrations under prior laws which are more~~
7 ~~than 10 years old and not renewed in accordance with this~~
8 ~~chapter.~~

9 (1)(2) Any registration for ~~concerning~~ which the
10 department ~~of State~~ has received ~~shall receive~~ a voluntary
11 request for cancellation by the registrant, which request
12 shall be in a manner and form complying with the requirements
13 of the department thereof from the registrant.

14 ~~(2)(3)~~ All registrations granted under this chapter
15 and not renewed in accordance with the provisions hereof.

16 ~~(3)(4)~~ Any registration for ~~concerning~~ which a court
17 of competent jurisdiction finds ~~shall find~~ that:

18 (a) The registered mark has been abandoned. ~~A mark~~
19 ~~shall be deemed to be "abandoned" when either of the following~~
20 ~~occurs:~~

21 1. ~~When its use has been discontinued with intent not~~
22 ~~to resume such use. Intent not to resume may be inferred from~~
23 ~~circumstances. Nonuse for 2 consecutive years shall be prima~~
24 ~~facie evidence of abandonment.~~

25 2. ~~When any course of conduct of the owner, including~~
26 ~~acts of omission as well as commission, causes the mark to~~
27 ~~become the generic name for the goods or services on or in~~
28 ~~connection with which it is used, or otherwise to lose its~~
29 ~~significance as a mark. Purchaser motivation shall not be a~~
30 ~~test for determining abandonment under this paragraph.~~

31 (b) The registrant ~~of a trademark or service mark is~~

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1 not the owner of the mark.

2 (c) The registration was granted improperly.

3 (d) The registration was obtained fraudulently.

4 (e) The mark is or has become the generic name for the
5 goods or services, or a portion thereof, for which the mark
6 has been registered.

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

17 (g)(f) In the case of a certification mark, that the
18 registrant does not control or is not able to exercise control
19 over the use of such mark; or engages in the production or
20 marketing of any goods or services to which the certification
21 mark is applied; or the registrant permits the use of the
22 certification mark for purposes other than to certify; or the
23 registrant discriminately refuses ~~refused~~ to certify or ~~to~~
24 continue to certify the goods or services of any person who
25 maintains the standards or conditions which such mark
26 certifies. Nothing in this paragraph shall be deemed to
27 prohibit the registrant from using its certification mark in
28 advertising or promoting recognition of the certification
29 program or of the goods or services meeting the certification
30 standards of the registrant.

31 (4)(5) When a court of competent jurisdiction shall

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1 order cancellation of a registration on any ground.

2 Section 13. Section 495.111, Florida Statutes, is
3 amended to read:

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

6 495.111 Classification.--

7 (1) The following general classes of goods and
8 services, conforming to the classification adopted by the
9 United States Patent and Trademark Office, are established for
10 convenience of administration of this chapter:

11 (a) Goods:

12 1. Class 1 Chemicals used in industry, science, and
13 photography; agriculture, horticulture, and forestry;
14 unprocessed artificial resins and, unprocessed plastics;
15 manures; fire extinguishing compositions; tempering and
16 soldering preparations; chemical substances for preserving
17 foodstuffs; tanning substances; and adhesives used in
18 industry.

19 2. Class 2 Paints, varnishes, lacquers; preservatives
20 against rust and against deterioration of wood; colorants;
21 mordants; raw natural resins; and metals in foil and powder
22 form for painters, decorators, printers, and artists.

23 3. Class 3 Bleaching preparations and other
24 substances for laundry use; cleaning, polishing, scouring, and
25 abrasive preparations; soaps; perfumery, essential oils,
26 cosmetics, and hair lotions; and dentifrices.

27 4. Class 4 Industrial oils and greases; lubricants;
28 dust absorbing, wetting, and binding compositions; fuels
29 (including motor spirit) and illuminants; and candles and
30 wicks for lighting.

31 5. Class 5 Pharmaceuticals and veterinary

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1 preparations; sanitary preparations for medical purposes;
 2 dietetic substances adapted for medical use and food for
 3 babies; plasters and materials for dressings; material for
 4 stopping teeth and dental wax; disinfectants; preparations for
 5 destroying vermin; and fungicides and herbicides.

6 6. Class 6 Common metals and their alloys; metal
 7 building materials; transportable buildings of metal;
 8 materials of metal for railway tracks; nonelectric cables and
 9 wires of common metal; ironmongery and small items of metal
 10 hardware; pipes and tubes of metal; safes; goods of common
 11 metal not included in other classes; and ores.

12 7. Class 7 Machines and machine tools; motors and
 13 engines (except for land vehicles); machine coupling and
 14 transmission components (except for land vehicles);
 15 agricultural implements other than hand-operated; incubators
 16 for eggs.

17 8. Class 8 Hand tools and hand-operated implements;
 18 cutlery; side arms; and razors.

19 9. Class 9 Scientific, nautical, surveying,
 20 photographic, cinematographic, optical, weighing, measuring,
 21 signaling, checking (supervision), and life-saving and
 22 teaching apparatus and instruments; apparatus and instruments
 23 for conducting, switching, transforming, accumulating,
 24 regulating, or controlling electricity; apparatus for
 25 recording, transmission, or reproduction of sound or images;
 26 magnetic data carriers and recording discs; automatic vending
 27 machines and mechanisms for coin-operated apparatus; cash
 28 registers, calculating machines, and data processing equipment
 29 and computers; and fire-extinguishing apparatus.

30 10. Class 10 Surgical, medical, dental, and
 31 veterinary apparatus and instruments, artificial limbs, eyes,

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1 and teeth; orthopedic articles; and suture materials.

2 11. Class 11 Apparatus for lighting, heating, steam
3 generating, cooking, refrigerating, drying, ventilating, water
4 supply, and sanitary purposes.

5 12. Class 12 Vehicles; apparatus for locomotion by
6 land, air, or water.

7 13. Class 13 Firearms; ammunition and projectiles;
8 explosives; and fireworks.

9 14. Class 14 Precious metals and their alloys and
10 goods in precious metals or coated therewith (not included in
11 other classes); jewelry and precious stones; and horological
12 and chronometric instruments.

13 15. Class 15 Musical instruments.

14 16. Class 16 Paper, cardboard, and goods made from
15 these materials (not included in other classes); printed
16 matter; bookbinding material; photographs; stationery;
17 adhesives for stationery or household purposes; artists'
18 materials; paint brushes; typewriters and office requisites
19 (except furniture); instructional and teaching material
20 (except apparatus); plastic materials for packaging (not
21 included in other classes); printers' type; and printing
22 blocks.

23 17. Class 17 Rubber, gutta-percha, gum, asbestos,
24 mica, and goods made from these materials and not included in
25 other classes; plastics in extruded form for use in
26 manufacture; packing, stopping, and insulating materials; and
27 flexible pipes not of metal.

28 18. Class 18 Leather and imitations of leather and
29 goods made of these materials and not included in other
30 classes; animal skins and hides; trunks and traveling bags;
31 umbrellas, parasols, and walking sticks; and whips, harness,

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1 and saddlery.

2 19. Class 19 Building materials (nonmetallic);
3 nonmetallic rigid pipes for building; asphalt, pitch, and
4 bitumen; nonmetallic transportable buildings; monuments, not
5 of metal.

6 20. Class 20 Furniture, mirrors, and picture frames;
7 goods (not included in other classes) of wood, cork, reed,
8 cane, wicker, horn, bone, ivory, whalebone, shell, amber,
9 mother-of-pearl, and meerschaum and substitutes for all these
10 materials, or of plastics.

11 21. Class 21 Household or kitchen utensils and
12 containers (not of precious metal or coated therewith); combs
13 and sponges; brushes (except paint brushes); brush-making
14 materials; articles for cleaning purposes; steel wool;
15 unworked or semiworked glass (except glass used in building);
16 and glassware, porcelain, and earthenware not included in
17 other classes.

18 22. Class 22 Ropes, string, nets, tents, awnings,
19 taraulins, sails, sacks, and bags (not included in other
20 classes); padding and stuffing materials (except of rubber or
21 plastics); and raw fibrous textile materials.

22 23. Class 23 Yarns and threads for textile use.

23 24. Class 24 Textiles and textile goods not included
24 in other classes and bed and table covers.

25 25. Class 25 Clothing, footwear, and headgear.

26 26. Class 26 Lace and embroidery, ribbons, and braid;
27 buttons, hooks and eyes, pins, and needles; and artificial
28 flowers.

29 27. Class 27 Carpets, rugs, mats and matting,
30 linoleum, and other materials for covering existing floors;
31 and wall hangings (nontextile).

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1 28. Class 28 Games and playthings; gymnastic and
2 sporting articles not included in other classes; and
3 decorations for Christmas trees.

4 29. Class 29 Meat, fish, poultry, and game; meat
5 extracts; preserved, dried, and cooked fruits and vegetables;
6 jellies, jams, and compotes; eggs, milk, and milk products;
7 and edible oils and fats.

8 30. Class 30 Coffee, tea, cocoa, sugar, rice,
9 tapioca, sago, and artificial coffee; flour and preparations
10 made from cereals, bread, pastry and confectionery, and ices;
11 honey and treacle; yeast, baking powder; salt, and mustard;
12 vinegar and sauces (condiments); spices; and ice.

13 31. Class 31 Agricultural, horticultural, and
14 forestry products and grains not included in other classes;
15 live animals; fresh fruits and vegetables; seeds, natural
16 plants, and flowers; foodstuffs for animals and malt.

17 32. Class 32 Beers; mineral and aerated waters and
18 other nonalcoholic drinks; fruit drinks and fruit juices; and
19 syrups and other preparations for making beverages.

20 33. Class 33 Alcoholic beverages except beers.

21 34. Class 34 Tobacco; smokers' articles; and matches.

22 (b) Services:

23 1. Class 35 Advertising; business management;
24 business administration; and office functions.

25 2. Class 36 Insurance; financial affairs; monetary
26 affairs; and real estate affairs.

27 3. Class 37 Building construction; repair; and
28 installation services.

29 4. Class 38 Telecommunications.

30 5. Class 39 Transport; packaging and storage of
31 goods; and travel arrangements.

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1 6. Class 40 Treatment of materials.

2 7. Class 41 Education; providing of training;
3 entertainment; and sporting and cultural activities.

4 8. Class 42 Scientific and technological services and
5 research and design relating thereto; industrial analysis and
6 research services; design and development of computer hardware
7 and software; and legal services.

8 9. Class 43 Services for providing food and drink;
9 and temporary accommodation.

10 10. Class 44 Medical services; veterinary services;
11 hygienic and beauty care for human beings or animals; and
12 agriculture, horticulture, and forestry services.

13 11. Class 45 Personal and social services rendered by
14 others to meet the needs of individuals; and security services
15 for the protection of property and individuals.

16 (c) Certification and collective membership marks:

17 1. Class 200 Collective membership marks.

18 2. Class A Certification marks for goods.

19 3. Class B Certification marks for services.

20 (d) The goods and services recited in collective
21 trademark and collective service mark applications are
22 assigned to the same classes that are appropriate for those
23 goods and services in general.

24 (2) The establishment of the classes of goods and
25 services set forth in subsection (1) is not for the purpose of
26 limiting or extending the rights of the applicant or
27 registrant. A single application for registration of a mark
28 may include any or all goods upon which, or services with
29 which, the mark is actually being used comprised in one or
30 more of the classes listed, but in the event that a single
31 application includes goods or services in connection with

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1 which the mark is being used which fall within different
2 classes of goods or services, a fee equaling the sum of the
3 fees for registration in each class shall be payable.

4 Section 14. Section 495.131, Florida Statutes, is
5 amended to read:

6 495.131 Infringement.--Subject to the provisions of s.
7 495.161, any person who shall, without the consent of the
8 registrant:

9 (1) ~~Use, without the consent of the registrant,~~ any
10 reproduction, counterfeit, copy, or colorable imitation of a
11 mark registered under this chapter ~~on any goods or~~ in
12 connection with the sale, offering for sale, distribution, or
13 advertising of any goods or services on or in connection with
14 which such use is likely to cause confusion, to cause or
15 mistake, or to deceive ~~as to the source or origin of such~~
16 ~~goods or services;~~ or

17 (2) Reproduce, counterfeit, copy, or colorably imitate
18 a any such mark registered under this chapter and apply such
19 reproduction, counterfeit, copy, or colorable imitation to
20 labels, signs, prints, packages, wrappers, receptacles, or
21 advertisements intended to be used upon or in connection
22 ~~conjunction~~ with the sale, ~~offering for sale,~~ distribution, or
23 advertising ~~in this state~~ of goods or services on or in
24 connection with which such use is likely to cause confusion,
25 to cause mistake, or to deceive;

26
27 Shall be liable in a civil action by the owner of such
28 registered mark for any or all of the remedies provided in s.
29 495.141, except that under subsection (2) hereof the
30 registrant shall not be entitled to recover profits or damages
31 unless the acts have been committed with knowledge that such

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1 mark is intended to be used to cause confusion or mistake or
2 to deceive.

3 Section 15. Section 495.141, Florida Statutes, is
4 amended to read:

5 495.141 Remedies.--

6 (1) Any owner of a mark registered under this chapter
7 may proceed by suit to enjoin the manufacture, use, display,
8 or sale of any counterfeits or imitations thereof and any
9 court of competent jurisdiction may grant injunctions to
10 restrain such manufacture, use, display or sale as may be by
11 the said court deemed just and reasonable, and may require the
12 defendants to pay to such owner all profits derived from
13 and/or all damages suffered by reason of such wrongful
14 manufacture, use, display, or sale and to pay the costs of the
15 action; and such court may also order that any such
16 counterfeits or imitations in the possession or under the
17 control of any defendant in such case be delivered to an
18 officer of the court, or to the complainant, to be destroyed.
19 In assessing profits the plaintiff shall be required to prove
20 defendant's sales only; defendant must prove all elements of
21 cost or deduction claimed. In assessing damages the court may
22 enter judgment, according to the circumstances of the case,
23 for any sum above the amount found as actual damages, not
24 exceeding three 3 times such amount. If the court shall find
25 that the amount of the recovery based on profits is either
26 inadequate or excessive the court may in its discretion enter
27 judgment for such sum as the court shall find to be just,
28 according to the circumstances of the case. Such sum in either
29 of the above circumstances shall constitute compensation and
30 not a penalty. The court may also award reasonable attorney's
31 fees to the prevailing party according to the circumstances of

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1 the case.

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

5 Section 16. Section 495.145, Florida Statutes, is
6 created to read:

7 495.145 Forum for actions regarding registration.--An
8 action seeking cancellation of a registration of a mark
9 registered under this chapter may be brought in any court of
10 competent jurisdiction in this state. Service of process on a
11 nonresident registrant may be made in accordance with s.
12 48.181. The department shall not be made a party to
13 cancellation proceedings.

14 Section 17. Section 495.151, Florida Statutes, is
15 amended to read:

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

18 495.151 Dilution.--

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

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

31 (b) The duration and extent of use of the mark in

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1 connection with the goods and services with which the mark is
2 used.

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

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

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

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

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

15 (h) Whether the mark is the subject of a state
16 registration in this state or a federal registration under the
17 Federal Trademark Act of March 3, 1881, or the Federal
18 Trademark Act of February 20, 1905, or a principal register
19 registration under the Federal Trademark Act of July 5, 1946.

20 (2) In an action brought under this section, the owner
21 of a famous mark shall be entitled only to injunctive relief
22 in this state unless the person against whom the injunctive
23 relief is sought willfully intended to trade on the owner's
24 reputation or to cause dilution of the famous mark. If such
25 willful intent is proven, and the mark is registered in this
26 state, the owner shall also be entitled to all remedies set
27 forth in this chapter, subject to the discretion of the court
28 and the principles of equity.

29 (3) The following shall not be actionable under this
30 section:

31 (a) Fair use of a famous mark by another person in

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1 comparative commercial advertising or promotion to identify
2 the competing goods or services of the owner of the famous
3 mark.

4 (b) Noncommercial use of the mark.

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

6 Section 18. Section 495.161, Florida Statutes, is
7 amended to read:

8 495.161 Common-law rights.--Nothing herein shall
9 adversely affect ~~or diminish~~ the rights or the enforcement of
10 rights in marks acquired in good faith at any time at common
11 law.

12 Section 19. Section 495.171, Florida Statutes, is
13 amended to read:

14 495.171 Effective date; repeal of conflicting ~~prior~~
15 ~~acts.--~~

16 (1) This chapter, as amended by this act, shall be in
17 force and take effect January ~~October 1, 2007~~ ~~1967,~~ ~~after its~~
18 ~~enactment,~~ but shall not affect any suit, proceeding, or
19 appeal then pending.

20 (2) Sections 506.06-506.13 ~~Former ss. 495.01-495.14~~
21 are repealed on January 1, 2007 ~~the effective date of this~~
22 ~~act,~~ provided that as to any suit, proceeding or appeal, and
23 for that purpose only, pending at the time this chapter, as
24 amended by this act, takes effect such repeal shall be deemed
25 not to be effective until final determination of said pending
26 suit, proceeding or appeal.

27 Section 20. Section 495.181, Florida Statutes, is
28 amended to read:

29 (Substantial rewording of section. See
30 s. 495.181, F.S., for present text.)

31 495.181 Construction of chapter.--The intent of this

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1 chapter is to provide a system of state trademark registration
 2 and protection substantially consistent with the federal
 3 system of trademark registration and protection under the
 4 Trademark Act of 1946, as amended. To that end, the
 5 construction given the federal act should be examined as
 6 persuasive authority for interpreting and construing this
 7 chapter.

8 Section 21. Section 495.191, Florida Statutes, is
 9 created to read:

10 495.191 Fees.--Filing and other applicable fees
 11 payable to the department under this chapter shall be as
 12 follows:

- 13 (1) Application filing fee: \$87.50 per class.
- 14 (2) Renewal application fee: \$87.50 per class.
- 15 (3) Assignment filing fee: \$50 per class.
- 16 (4) Certificate of name change filing fee: \$50.
- 17 (5) Voluntary cancellation filing fee: \$50.
- 18 (6) Certificate of registration under seal: \$8.75.
- 19 (7) Certified copy of application file: \$52.50.

20 Section 22. Sections 506.06, 506.07, 506.08, 506.09,
 21 506.11, 506.12, and 506.13, Florida Statutes, are repealed.

22 Section 23. This act shall take effect January 1,
 23 2007.

24
 25

26 ===== T I T L E A M E N D M E N T =====

27 And the title is amended as follows:

28 Delete everything before the enacting clause

29

30 and insert:

31 A bill to be entitled

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1 An act relating to trademarks; creating s.
2 495.001, F.S.; providing a short title;
3 amending s. 495.011, F.S.; providing
4 definitions; amending s. 495.021, F.S.;
5 precluding registration of certain marks;
6 repealing s. 495.027, F.S., relating to
7 reservation of a mark; amending s. 495.031,
8 F.S.; providing requirements for information to
9 be contained in an application for registration
10 of a mark; authorizing the Department of State
11 to require certain information in an
12 application; requiring that the application be
13 signed and verified by any of certain persons;
14 requiring that the application be accompanied
15 by three specimens showing the mark; requiring
16 that the application be accompanied by a fee;
17 creating s. 495.035, F.S.; providing filing
18 guidelines for applications; providing for
19 disclaimers of unregistrable components;
20 providing for amendment and judicial review;
21 providing for priority of registrations;
22 amending s. 495.041, F.S.; providing that first
23 use shall inure to the benefit of the
24 registrant or applicant under certain
25 circumstances; amending s. 495.061, F.S.;
26 providing for the issuance of a certificate of
27 registration by the department; removing a
28 provision relating to reservation of a mark;
29 amending s. 495.071, F.S.; providing guidelines
30 for the renewal of marks; revising duration of
31 effectiveness of a registration; amending s.

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1 495.081, F.S.; providing for the assignability
2 of marks; authorizing a photocopy of an
3 assignment to be acceptable for recording;
4 providing for change of name certificates for
5 registrants; authorizing recordation of certain
6 instruments; providing acknowledgment of
7 recording as prima facie evidence of the
8 execution of an assignment or other instrument;
9 specifying requirements for creation and
10 perfection of security interests in marks;
11 amending s. 495.091, F.S.; requiring the
12 department to record all marks registered with
13 the state; amending s. 495.101, F.S.; requiring
14 the department to cancel certain marks;
15 amending s. 495.111, F.S., which establishes a
16 classification of goods and services; providing
17 that a single application for registration of a
18 mark may include any or all goods upon which,
19 or services with which, the mark is actually
20 being used comprised in one or more of the
21 classes listed; amending s. 495.131, F.S.;
22 revising infringement provisions to include an
23 element of lack of consent by the registrant;
24 conforming language; amending s. 495.141, F.S.;
25 providing additional remedies for the
26 unauthorized use of a mark; creating s.
27 495.145, F.S.; providing a forum for actions
28 regarding registration; providing for service
29 of process on nonresident registrants; amending
30 s. 495.151, F.S.; providing for an injunction
31 in cases of dilution of a famous mark;

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1 providing factors to be considered in
2 determining that a mark is famous; providing
3 damages in certain circumstances of dilution;
4 amending s. 495.161, F.S.; deleting language
5 relating to the diminishing of certain common
6 law rights; amending s. 495.171, F.S.;
7 providing effective date of changes to ch. 495,
8 F.S., as amended by the act; providing for
9 repeal of conflicting acts; providing
10 application to pending actions; amending s.
11 495.181, F.S.; providing construction and
12 legislative intent; creating s. 495.191, F.S.;
13 providing certain fees; repealing s. 506.06,
14 F.S., relating to unlawful to counterfeit
15 trademark, to conform; repealing s. 506.07,
16 F.S., relating to filing of trademark or other
17 form of advertisement for record with
18 Department of State, to conform; repealing s.
19 506.08, F.S., relating to fee for filing, to
20 conform; repealing s. 506.09, F.S., relating to
21 civil remedies, to conform; repealing s.
22 506.11, F.S., relating to unlawful use of
23 trademark, to conform; repealing s. 506.12,
24 F.S., relating to procuring the filing of
25 trademark or other form of advertisement by
26 fraudulent representations, to conform;
27 repealing s. 506.13, F.S., relating to using
28 the name or seal of another, to conform;
29 providing an effective date.

30
31