



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

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

31

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

2

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

5 495.001 Short title.--This chapter may be cited as the  
6 "Registration and Protection of Trademarks Act."

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

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

11 495.011 Definitions.--As used in this chapter:

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

14 (a) When its use has been discontinued with intent not  
15 to resume such use. Intent not to resume use may be inferred  
16 from circumstances. Nonuse for 3 consecutive years shall  
17 constitute prima facie evidence of abandonment.

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

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

24 (3) "Certification mark" means any word, name, symbol,  
25 or device, or any combination thereof, used by a person other  
26 than the owner of the mark to certify regional or other  
27 origin, material, mode of manufacture, quality, accuracy, or  
28 other characteristics of such person's goods or services or  
29 that the work or labor on the goods or services was performed  
30 by members of a union or other organization.

31

1           (4) "Collective mark" means a trademark or service  
2 mark used by the members of a cooperative, an association, or  
3 other collective group or organization, and includes marks  
4 used to indicate membership in a union, an association, or  
5 other organization.

6           (5) "Department of State" means the Florida Department  
7 of State or its designee charged with the administration of  
8 this chapter.

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

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

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

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

18           (8) "Person," and any other word or term used to  
19 designate the applicant or other party entitled to a benefit  
20 or privilege or rendered liable under the provisions of this  
21 chapter, means a juristic person as well as a natural person.

22 "Juristic person" includes a firm, partnership, corporation,  
23 union, association, or other organization capable of suing and  
24 being sued in a court of law.

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

28           (10) "Related company" means any person whose use of a  
29 mark is controlled by the owner of the mark with respect to  
30 the nature and quality of the goods or services on or in  
31 connection with which the mark is used.

1           (11) "Service mark" means any word, name, symbol, or  
2 device, or any combination thereof, used by a person to  
3 identify and distinguish the services of such person,  
4 including a unique service, from the services of others, and  
5 to indicate the source of the services, even if that source is  
6 unknown. Titles, character names, and other distinctive  
7 features of radio or television programs may be registered as  
8 service marks notwithstanding that the person or the programs  
9 may advertise the goods of the sponsor.

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

12           (13) "Trademark" means any word, name, symbol, or  
13 device, or any combination thereof, used by a person to  
14 identify and distinguish the goods of such person, including a  
15 unique product, from those manufactured or sold by others, and  
16 to indicate the source of the goods, even if the source is  
17 unknown.

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

22           (a) On goods when:

23           1. The mark is placed in any manner on the goods,  
24 their containers or the displays associated therewith, or on  
25 the tags or labels affixed thereto, or, if the nature of the  
26 goods makes such placement impracticable, on documents  
27 associated with the goods or their sale; and

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

29           (b) On services when the mark used or displayed in the  
30 sale or advertising of services and the services are rendered  
31 in this state.

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

3 495.021 Registrability.--

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

7 (a) Consists of or, comprises ~~or includes~~ immoral,  
8 deceptive, or scandalous matter; ~~or~~

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

13 (c) Consists of or, comprises ~~or includes~~ the flag or  
14 coat of arms or other insignia of the United States, or of any  
15 state or municipality, or of any foreign nation, or any  
16 simulation thereof; ~~or~~

17 (d) Consists of or, comprises a ~~or includes~~ the name,  
18 signature, or portrait identifying a particular ~~of any~~ living  
19 individual, except by with her or his written consent, or the  
20 name, signature, or portrait of a deceased President of the  
21 United States during the lifetime of his widow or her widower,  
22 if any, except by the written consent of the widow or widower;  
23 ~~or~~

24 (e) Consists of a mark which:

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

28 2. When used on or in connection with ~~applied to~~ the  
29 goods ~~or services~~ of the applicant, is primarily  
30 geographically descriptive ~~or deceptively misdescriptive~~ of  
31 the goods; them or their source or origin, or

1           3. When used on or in connection with the goods of the  
2 applicant, is primarily geographically misdescriptive of the  
3 goods;

4           ~~4.3. Is primarily merely a surname; or,~~

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

7  
8 Except as expressly excluded in subparagraphs 3. and 5.,

9 ~~provided, however, that~~ nothing in this paragraph shall

10 prevent the registration of a mark used ~~in this state~~ by the

11 applicant which has become distinctive of the applicant's

12 goods or services ~~in this state or elsewhere~~. The Department

13 of State may accept as prima facie evidence that the mark has

14 become distinctive, as used on or in connection with ~~applied~~

15 ~~to~~ the applicant's goods or services, proof of ~~substantially~~

16 ~~exclusive and~~ continuous use thereof as a mark by the

17 applicant in this state or elsewhere for the 5 years before

18 ~~next preceding~~ the date on which the claim of distinctiveness

19 is made; or

20           (f) Consists of or comprises a mark which so resembles

21 a mark registered in this state or a mark or trade name

22 previously used in this state by another and not abandoned, as

23 to be likely, when applied to the goods or services of the

24 applicant, to cause confusion or mistake or to deceive.

25 Registration shall not be denied solely on the basis of

26 reservation or registration by another of a corporate name or

27 fictitious name that is the same or similar to the mark for

28 which registration is sought.

29           Section 4. Section 495.027, Florida Statutes, is

30 repealed.

31



1           Section 5. Section 495.031, Florida Statutes, is  
2 amended to read:

3           495.031 Application for registration.--

4           (1) Subject to the limitations set forth in this  
5 chapter, any person who ~~adopts and~~ uses a trademark or service  
6 mark in this state may file with the Department of State, in a  
7 manner and on a form complying with the requirements of the  
8 Department of State to be furnished by the department, an  
9 application for registration of that ~~trademark or service~~ mark  
10 setting forth, but not limited to, the following information:

11           (a) The name and business address of the person  
12 applying for such registration, and, if a business entity, the  
13 place corporation, the state of incorporation or organization  
14 and, if a partnership, the name of the general partners, as  
15 specified by the Department of State;

16           (b) The goods or services on or in connection with  
17 which the mark is used and the mode or manner in which the  
18 mark is used in connection with such goods or services and the  
19 class or classes in which such goods or services fall;

20           (c) The date ~~when~~ the mark was first used anywhere and  
21 the date ~~when~~ it was first used in this state by the  
22 applicant, the applicant's or her or his predecessor in  
23 interest, business or a related company of the applicant ~~or~~  
24 ~~the applicant's predecessor;~~ and

25           (d) A statement that the applicant is the owner of the  
26 mark, that the mark is in use, and that, to the best of the  
27 applicant's knowledge, no other person except a related  
28 company has registered such mark in this state, or has the  
29 right to use such mark in this state, either in the identical  
30 form thereof or in such near resemblance thereto as to be  
31 likely when applied to the goods or services of such other

1 ~~person to cause confusion, to cause mistake, or to deceive or~~  
2 ~~confuse or to be mistaken therefor.~~

3 (2) Every applicant for registration of a  
4 certification mark in this state shall file with the  
5 Department of State, on a form to be furnished by the  
6 Department of State, an application setting forth, but not  
7 limited to, the following information:

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

9 (b) The date when the certification mark was first  
10 used anywhere and the date when it was first used in this  
11 state under the authority of the applicant;

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

14 (d) A statement that the applicant is exercising  
15 control over the use of the mark, that the applicant is not  
16 herself or himself engaged in the production or marketing of  
17 the goods or services to which the mark is applied, and that  
18 no person except the applicant or persons authorized by the  
19 applicant, or related companies thereof, has the right to use  
20 such mark in this state either in the identical form thereof  
21 or in such near resemblance thereto as to be likely to deceive  
22 or confuse or to be mistaken therefor.

23 (3) Every applicant for registration of a collective  
24 mark in this state shall file with the Department of State, on  
25 a form to be furnished by the Department of State, an  
26 application setting forth, but not limited to, the following  
27 information:

28 (a) The information required by paragraphs (1)(a) and  
29 (b);

30 (b) The date when the collective mark was first used  
31 anywhere and the date when it was first used in this state by

1 any member of the applicant or a related company of such  
2 member;

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

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

11 (4) The Department of State may also require that a  
12 drawing of the mark, complying with such requirements as the  
13 Department of State may specify, accompany the application.

14 (5)(4) Every application under this section shall be  
15 signed and verified by the applicant or by a member of the  
16 firm or an officer or other authorized representative of the  
17 business entity ~~of the corporation, association, union or~~  
18 ~~other organization~~ applying.

19 (6)(5) Every application under this section shall be  
20 accompanied by three specimens showing the mark as actually  
21 used ~~a specimen or facsimile of such mark in triplicate.~~

22 (7)(6) Every application under this section shall be  
23 accompanied by a filing fee ~~of \$87.50,~~ payable to the  
24 Department of State in accordance with s. 495.191, ~~for each~~  
25 ~~class of goods or services as specified in s. 495.111, in~~  
26 ~~connection with which the mark is used.~~

27 Section 6. Section 495.035, Florida Statutes, is  
28 created to read:

29 495.035 Filing of applications.--

30 (1) Upon the receipt of an application for  
31 registration and payment of the application fee, the

1 Department of State may cause the application to be examined  
2 for conformity with this chapter.

3 (2) The applicant shall provide any additional  
4 pertinent information requested by the Department of State,  
5 including a description of a design mark, and may make, or  
6 authorize the Department of State to make, such amendments to  
7 the application as may be reasonably requested by the  
8 Department of State or deemed by the applicant to be advisable  
9 to respond to any rejection or objection.

10 (3) The Department of State may require the applicant  
11 to disclaim an unregistrable component of a mark otherwise  
12 registrable, and an applicant may voluntarily disclaim a  
13 component of a mark sought to be registered. No disclaimer  
14 shall prejudice or affect the applicant's or registrant's  
15 rights then existing or thereafter arising in the disclaimed  
16 matter, or the applicant's or registrant's rights of  
17 registration on another application, if the disclaimed matter  
18 is or has become distinctive of the applicant's or  
19 registrant's goods or services.

20 (4) Amendments may be made by the Department of State  
21 upon the application submitted by the applicant upon the  
22 applicant's agreement, or a new application may be required to  
23 be submitted. Amendments to an otherwise properly filed  
24 application shall not affect the application filing date for  
25 purposes of determining the applicant's or registrant's filing  
26 priority rights.

27 (5) If the applicant is found not to be entitled to  
28 registration, the Department of State shall advise the  
29 applicant of the rejection and of the reasons for rejection.  
30 The applicant shall have 3 months in which to reply or amend  
31

1 the application, in which event the application shall be  
2 reexamined. This procedure may be repeated until:

3 (a) The Department of State makes final its refusal to  
4 register the mark; or

5 (b) The applicant fails to reply or amend the  
6 application within the specified period, whereupon the  
7 application shall be abandoned.

8  
9 For good cause shown, such as the pendency of litigation  
10 involving the mark, the Department of State may extend the  
11 period of time in which to respond to the rejection or suspend  
12 examination of the application.

13 (6) If the Department of State makes its final refusal  
14 to register the mark, the applicant may seek review of such  
15 decision in accordance with s. 120.68.

16 (7) In the event of multiple applications concurrently  
17 being processed by the Department of State which seek  
18 registration of the same or confusingly similar marks for the  
19 same or related goods or services, the Department of State  
20 shall grant priority to the applications in order of receipt.  
21 If a prior-filed application is granted a registration, the  
22 other application or applications shall then be rejected. The  
23 applicant of a rejected application may bring an action for  
24 cancellation of the registration upon grounds of prior or  
25 superior rights to the mark, in accordance with the provisions  
26 of s. 495.101.

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

29 495.041 Use by related companies.--Where a mark  
30 registered or unregistered is or may be used legitimately by  
31 related companies, such use shall inure to the benefit of the

1 owner of the mark, and such use shall not affect the validity  
2 of such mark or of its registration, provided such mark is not  
3 used in such manner as to deceive the public. If first use of  
4 a mark by a person is controlled by the registrant or  
5 applicant for registration of a mark with respect to the  
6 nature and quality of the goods or services, such first use  
7 shall inure to the benefit of that registrant or applicant, as  
8 the case may be.

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

11 495.061 Certificate of registration.--

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

27 (2) Any certificate of registration issued by the  
28 Department of State under the provisions hereof or a copy  
29 thereof duly certified by the Department of State shall be  
30 admissible in evidence as competent and sufficient proof of  
31 the registration of such mark in any action or judicial

1 proceedings in any court of this state, and shall be prima  
2 facie evidence of the validity of the registration,  
3 registrant's ownership of the mark, and of registrant's  
4 exclusive right to use the mark in this state on or in  
5 connection with the goods or services specified in the  
6 certificate, subject to any conditions and limitations stated  
7 therein.

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

17 Section 9. Section 495.071, Florida Statutes, is  
18 amended to read:

19 495.071 Duration and renewal.--

20 (1) Registration of a mark hereunder shall be  
21 effective for a term of 5 ~~10~~ years from the date of  
22 registration and, upon application filed within 6 months prior  
23 to the expiration of such term, in a manner and form complying  
24 with the requirements of ~~on a form to be furnished by~~ the  
25 Department of State, the registration may be renewed for a  
26 like term beginning at the end of the expiring term. Every  
27 application under this section shall be accompanied by a  
28 filing fee ~~A renewal fee of \$87.50 for each class of goods or~~  
29 ~~services with respect to which such renewal is sought,~~ payable  
30 to the Department of State, in accordance with s. 495.191  
31

1 ~~shall accompany the application for renewal of the~~  
2 ~~registration.~~

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

5 (3) Any registration in effect on July 1, 2006, shall  
6 continue in effect for the unexpired term thereof and may be  
7 renewed by filing an application for renewal with the  
8 Department of State in accordance with the form and  
9 requirements of the Department of State and paying the renewal  
10 fee therefor within 6 months prior to the expiration of the  
11 registration. ~~The Department of State shall notify registrants~~  
12 ~~of marks hereunder of the necessity of renewal within the year~~  
13 ~~next preceding the expiration of the 10 years from the date of~~  
14 ~~registration by writing to the last known address of the~~  
15 ~~registrants. The department shall prescribe the forms on which~~  
16 ~~to make the required notification and the renewal called for~~  
17 ~~in subsection (1) and may substitute the uniform business~~  
18 ~~report, pursuant to s. 606.06, as a means of satisfying the~~  
19 ~~requirement of this part.~~

20 (4) All applications for renewal ~~renewals~~ under this  
21 chapter, whether of registrations made under this act or of  
22 registrations made under any prior acts, shall include a  
23 verified statement that the mark is still in use in this  
24 state, and shall include a specimen showing actual use of the  
25 mark on or in connection with the goods or services subject to  
26 the renewal application, or shall state that its nonuse is due  
27 to special circumstances which excuse such nonuse and is not  
28 due to any intention to abandon the mark.

29 Section 10. Section 495.081, Florida Statutes, is  
30 amended to read:  
31



1           495.081 Assignments; changes of name; security  
2 interests Assignment.--

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

19           (2) An assignment of any registration under this  
20 chapter shall be void as against any subsequent purchaser for  
21 valuable consideration without notice, unless such assignment  
22 is recorded with the Department of State within 3 months after  
23 the date of the assignment or prior to the subsequent purchase  
24 ~~thereof or at any time after the expiration of such 3 month~~  
25 ~~period, unless an assignment given in connection with any~~  
26 ~~subsequent purchase is recorded with the Department of State~~  
27 ~~prior to or within 10 days after such assignment is recorded.~~

28           (3) A registrant or applicant for registration  
29 effecting a change of the name may record a certificate of  
30 change of name of the registrant or applicant with the  
31 Department of State upon the payment of the recording fee

1 payable to the Department of State in accordance with s.  
2 495.191. In the case of a pending application for a mark that  
3 becomes approved for registration, the Department of State  
4 shall issue a certificate of registration in the registrant's  
5 new name. In the case of a registered mark, the Department of  
6 State shall issue a new certificate of registration in the  
7 registrant's new name for the remainder of the term of the  
8 registration or last renewal thereof. A person's failure to  
9 record a name change in accordance with this subsection shall  
10 not affect the person's substantive rights in the mark or its  
11 registration.

12 (4) Acknowledgment shall be prima facie evidence of  
13 the execution of an assignment or other instrument and, when  
14 recorded by the Department of State, the record shall be prima  
15 facie evidence of execution.

16 (5) Security interests in marks shall be created and  
17 perfected in accordance with the Uniform Commercial Code,  
18 chapter 679.

19 Section 11. Section 495.091, Florida Statutes, is  
20 amended to read:

21 495.091 Records.--The Department of State shall keep  
22 for public examination a record of all marks registered or  
23 renewed under this chapter, including all documents recorded  
24 under s. 495.081.

25 Section 12. Section 495.101, Florida Statutes, is  
26 amended to read:

27 495.101 Cancellation.--The Department of State shall  
28 cancel from the register:

29 ~~(1) After 1 year from the effective date of this~~  
30 ~~chapter, all registrations under prior laws which are more~~  
31

1 ~~than 10 years old and not renewed in accordance with this~~  
2 ~~chapter.~~

3       ~~(1)(2)~~ Any registration for ~~concerning~~ which the  
4 Department of State has received ~~shall receive~~ a voluntary  
5 request for cancellation by the registrant, which request  
6 shall be in a manner and form complying with the requirements  
7 of the Department of State thereof from the registrant.

8       ~~(2)(3)~~ All registrations granted under this chapter  
9 and not renewed in accordance with the provisions hereof.

10       ~~(3)(4)~~ Any registration for ~~concerning~~ which a court  
11 of competent jurisdiction finds ~~shall find~~ that:

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

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

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

25           (b) The registrant ~~of a trademark or service mark~~ is  
26 not the owner of the mark.

27           (c) The registration was granted improperly.

28           (d) The registration was obtained fraudulently.

29           ~~(e)~~ The mark is or has become the generic name for the  
30 goods or services, or a portion thereof, for which the mark  
31 has been registered.

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

11           ~~(g)(f)~~ In the case of a certification mark, that the  
12 registrant does not control or is not able to exercise control  
13 over the use of such mark; or engages in the production or  
14 marketing of any goods or services to which the certification  
15 mark is applied; or the registrant permits the use of the  
16 certification mark for purposes other than to certify; or the  
17 registrant discriminately refuses ~~refused~~ to certify or ~~to~~  
18 continue to certify the goods or services of any person who  
19 maintains the standards or conditions which such mark  
20 certifies.

21           ~~(4)(5)~~ When a court of competent jurisdiction shall  
22 order cancellation of a registration on any ground.

23  
24 Nothing in subsection shall be deemed to prohibit the  
25 registrant from using its certification mark in advertising or  
26 promoting recognition of the certification program or of the  
27 goods or services meeting the certification standards of the  
28 registrant.

29           Section 13. Section 495.111, Florida Statutes, is  
30 amended to read:

31           (Substantial rewording of section. See

1           s. 495.111, F.S., for present text.)  
2           495.111 Classification.--  
3           (1) The following general classes of goods and  
4 services, conforming to the classification adopted by the  
5 United States Patent and Trademark Office, are established for  
6 convenience of administration of this chapter:  
7           (a) Goods:  
8           1. Class 1.--Chemicals used in industry, science, and  
9 photography; agriculture, horticulture, and forestry;  
10 unprocessed artificial resins and, unprocessed plastics;  
11 manures; fire extinguishing compositions; tempering and  
12 soldering preparations; chemical substances for preserving  
13 foodstuffs; tanning substances; and adhesives used in  
14 industry.  
15           2. Class 2.--Paints, varnishes, lacquers;  
16 preservatives against rust and against deterioration of wood;  
17 colorants; mordants; raw natural resins; and metals in foil  
18 and powder form for painters, decorators, printers, and  
19 artists.  
20           3. Class 3.--Bleaching preparations and other  
21 substances for laundry use; cleaning, polishing, scouring, and  
22 abrasive preparations; soaps; perfumery, essential oils,  
23 cosmetics, and hair lotions; and dentifrices.  
24           4. Class 4.--Industrial oils and greases; lubricants;  
25 dust absorbing, wetting, and binding compositions; fuels  
26 (including motor spirit) and illuminants; and candles and  
27 wicks for lighting.  
28           5. Class 5.--Pharmaceuticals and veterinary  
29 preparations; sanitary preparations for medical purposes;  
30 dietetic substances adapted for medical use and food for  
31 babies; plasters and materials for dressings; material for

1 stopping teeth and dental wax; disinfectants; preparations for  
2 destroying vermin; and fungicides and herbicides.

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

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

14 8. Class 8.--Hand tools and hand-operated implements;  
15 cutlery; side arms; and razors.

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

27 10. Class 10.--Surgical, medical, dental, and  
28 veterinary apparatus and instruments, artificial limbs, eyes,  
29 and teeth; orthopedic articles; and suture materials.

30  
31

- 1           11. Class 11.--Apparatus for lighting, heating, steam  
2 generating, cooking, refrigerating, drying, ventilating, water  
3 supply, and sanitary purposes.
- 4           12. Class 12.--Vehicles; apparatus for locomotion by  
5 land, air, or water.
- 6           13. Class 13.--Firearms; ammunition and projectiles;  
7 explosives; and fireworks.
- 8           14. Class 14.--Precious metals and their alloys and  
9 goods in precious metals or coated therewith (not included in  
10 other classes); jewelry and precious stones; and horological  
11 and chronometric instruments.
- 12           15. Class 15.--Musical instruments.
- 13           16. Class 16.--Paper, cardboard, and goods made from  
14 these materials (not included in other classes); printed  
15 matter; bookbinding material; photographs; stationery;  
16 adhesives for stationery or household purposes; artists'  
17 materials; paint brushes; typewriters and office requisites  
18 (except furniture); instructional and teaching material  
19 (except apparatus); plastic materials for packaging (not  
20 included in other classes); printers' type; and printing  
21 blocks.
- 22           17. Class 17.--Rubber, gutta-percha, gum, asbestos,  
23 mica, and goods made from these materials and not included in  
24 other classes; plastics in extruded form for use in  
25 manufacture; packing, stopping, and insulating materials; and  
26 flexible pipes not of metal.
- 27           18. Class 18.--Leather and imitations of leather and  
28 goods made of these materials and not included in other  
29 classes; animal skins and hides; trunks and traveling bags;  
30 umbrellas, parasols, and walking sticks; and whips, harness,  
31 and saddlery.

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

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

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

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

21           23. Class 23.--Yarns and threads for textile use.

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

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

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

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



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  
22 matches.

23           (b) Services:

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

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

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

30           4. Class 38.--Telecommunications.

31

1           5. Class 39.--Transport; packaging and storage of  
2 goods; and travel arrangements.  
3           6. Class 40.--Treatment of materials.  
4           7. Class 41.--Education; providing of training;  
5 entertainment; and sporting and cultural activities.  
6           8. Class 42.--Scientific and technological services  
7 and research and design relating thereto; industrial analysis  
8 and research services; design and development of computer  
9 hardware and software; and legal services.  
10          9. Class 43.--Services for providing food and drink;  
11 and temporary accommodation.  
12          10. Class 44.--Medical services; veterinary services;  
13 hygienic and beauty care for human beings or animals; and  
14 agriculture, horticulture, and forestry services.  
15          11. Class 45.--Personal and social services rendered  
16 by others to meet the needs of individuals; and security  
17 services for the protection of property and individuals.  
18          (c) Certification and collective membership marks:  
19           1. Class 200.--Collective membership marks.  
20           2. Class A.--Certification marks for goods.  
21           3. Class B.--Certification marks for services.  
22          (d) The goods and services recited in collective  
23 trademark and collective service mark applications are  
24 assigned to the same classes that are appropriate for those  
25 goods and services in general.  
26          (2) The establishment of the classes of goods and  
27 services set forth in subsection (1) is not for the purpose of  
28 limiting or extending the rights of the applicant or  
29 registrant. A single application for registration of a mark  
30 may include any or all goods upon which, or services with  
31 which, the mark is actually being used comprised in one or

1 more of the classes listed, but in the event that a single  
2 application includes goods or services in connection with  
3 which the mark is being used which fall within different  
4 classes of goods or services, a fee equaling the sum of the  
5 fees for registration in each class shall be payable.

6 Section 14. Section 495.131, Florida Statutes, is  
7 amended to read:

8 495.131 Infringement.--Subject to the provisions of s.  
9 495.161, any person who shall, without the consent of the  
10 registrant:

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

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

28  
29 shall be liable in a civil action by the owner of such  
30 registered mark for any or all of the remedies provided in s.  
31 495.141, except that under subsection (2) hereof the

1 | registrant shall not be entitled to recover profits or damages  
2 | unless the acts have been committed with knowledge that such  
3 | mark is intended to be used to cause confusion or mistake or  
4 | to deceive.

5 |           Section 15. Section 495.141, Florida Statutes, is  
6 | amended to read:

7 |           495.141 Remedies.--

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

1 not a penalty. The court may also award reasonable attorney's  
2 fees to the prevailing party according to the circumstances of  
3 the case.

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

7 Section 16. Section 495.145, Florida Statutes, is  
8 created to read:

9 495.145 Forum for actions regarding registration.--An  
10 action seeking cancellation of a registration of a mark  
11 registered under this chapter may be brought in any court of  
12 competent jurisdiction in this state. Service of process on a  
13 nonresident registrant may be made in accordance with s.  
14 48.181. The Department of State shall not be made a party to  
15 cancellation proceedings.

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

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

20 495.151 Dilution.--

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

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

3       (b) The duration and extent of use of the mark in  
4 connection with the goods and services with which the mark is  
5 used.

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

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

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

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

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

18       (h) Whether the mark is the subject of a state  
19 registration in this state or a federal registration under the  
20 federal act of March 3, 1881, or the federal act of February  
21 20, 1905, or a principal register registration under the  
22 federal act of July 5, 1946.

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

1           (3) The following shall not be actionable under this  
2 section:

3           (a) Fair use of a famous mark by another person in  
4 comparative commercial advertising or promotion to identify  
5 the competing goods or services of the owner of the famous  
6 mark.

7           (b) Noncommercial use of the mark.

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

9           Section 18. Section 495.161, Florida Statutes, is  
10 amended to read:

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

15           Section 19. Section 495.171, Florida Statutes, is  
16 amended to read:

17           495.171 Effective date; repeal of conflicting prior  
18 acts.--

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

23           (2) Sections 506.06-506.13 ~~Former ss. 495.01-495.14~~  
24 are repealed on July 1, 2006 ~~the effective date of this act,~~  
25 provided that as to any suit, proceeding or appeal, and for  
26 that purpose only, pending at the time this chapter, as  
27 amended by this act, takes effect such repeal shall be deemed  
28 not to be effective until final determination of said pending  
29 suit, proceeding or appeal.

30           Section 20. Section 495.181, Florida Statutes, is  
31 amended to read:

1           (Substantial rewording of section. See  
2           s. 495.181, F.S., for present text.)  
3           495.181 Construction of chapter.--The intent of this  
4 chapter is to provide a system of state trademark registration  
5 and protection substantially consistent with the federal  
6 system of trademark registration and protection under the  
7 Trademark Act of 1946, as amended. To that end, the  
8 construction given the federal act should be examined as  
9 persuasive authority for interpreting and construing this  
10 chapter.

11           Section 21. Section 495.191, Florida Statutes, is  
12 created to read:

13           495.191 Fees.--Filing and other applicable fees  
14 payable to the Department of State under this chapter shall be  
15 as follows:

- 16           (1) Application filing fee: \$87.50 per class.  
17           (2) Renewal application fee: \$87.50 per class.  
18           (3) Assignment filing fee: \$87.50 per class.  
19           (4) Certificate of name change filing fee: \$50.00.  
20           (5) Voluntary cancellation filing fee: \$87.50.  
21           (6) Certificate of registration under seal: \$8.75.  
22           (7) Certified copy of application file: \$52.50.

23           Section 22. Sections 506.06, 506.07, 506.08, 506.09,  
24 506.11, 506.12, and 506.13, Florida Statutes, are repealed.

25           Section 23. This act shall take effect July 1, 2006.

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