

By the Committees on Judiciary; Commerce and Consumer Services; and Senator Campbell

590-2343-06

1                                   A bill to be entitled

2                   An act relating to trademarks; creating s.

3                   495.001, F.S.; providing a short title;

4                   amending s. 495.011, F.S.; providing

5                   definitions; amending s. 495.021, F.S.;

6                   precluding registration of certain marks;

7                   repealing s. 495.027, F.S., relating to

8                   reservation of a mark; amending s. 495.031,

9                   F.S.; providing requirements for information to

10                  be contained in an application for registration

11                  of a mark; authorizing the Department of State

12                  to require certain information in an

13                  application; requiring that the application be

14                  signed and verified by any of certain persons;

15                  requiring that the application be accompanied

16                  by three specimens showing the mark; requiring

17                  that the application be accompanied by a fee;

18                  creating s. 495.035, F.S.; providing filing

19                  guidelines for applications; providing for

20                  disclaimers of unregistrable components;

21                  providing for amendment and judicial review;

22                  providing for priority of registrations;

23                  amending s. 495.041, F.S.; providing that first

24                  use shall inure to the benefit of the

25                  registrant or applicant under certain

26                  circumstances; amending s. 495.061, F.S.;

27                  providing for the issuance of a certificate of

28                  registration by the department; removing a

29                  provision relating to reservation of a mark;

30                  amending s. 495.071, F.S.; providing guidelines

31                  for the renewal of marks; revising duration of

1 effectiveness of a registration; 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 as 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" means the Florida Department of State  
7 or its designee charged with the administration of this  
8 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, service mark,  
16 certification mark, or collective mark entitled to  
17 registration 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 is used or displayed in  
30 the sale or advertising of services and the services are  
31 rendered 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 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 them; ~~or their source or origin, or~~

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

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(e) 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 to be  
8 ~~furnished by~~ the department, an application for registration  
9 of that ~~trademark or service~~ mark setting forth, but not  
10 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           (b) The goods or services on or in connection with  
15 which the mark is used and the mode or manner in which the  
16 mark is used in connection with such goods or services and the  
17 class or classes in which such goods or services fall;

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

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

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

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

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

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

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

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

27           (a) The information required by paragraphs (1)(a) and

28 (b);

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

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, when applied to the goods or services of such  
11 other person, to cause confusion, to cause mistake, or to  
12 deceive or confuse or to be mistaken therefor.

13 (4) The department may also require that a drawing of  
14 the mark, complying with the requirements of the department,  
15 accompany the application.

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

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

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

30 Section 6. Section 495.035, Florida Statutes, is  
31 created to read:

1           495.035 Filing of applications.--

2           (1) Upon the receipt of an application for  
3 registration and payment of the application fee, the  
4 department may cause the application to be examined for  
5 conformity with this chapter.

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

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

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

30           (5) If the applicant is found not to be entitled to  
31 registration, the department shall advise the applicant of the

1 rejection and of the reasons for rejection. The applicant  
2 shall have 3 months in which to reply or amend the  
3 application, in which event the application shall be  
4 reexamined. This procedure may be repeated until:

5 (a) The department makes final its refusal to register  
6 the mark; or

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

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

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

18 (7) In the event of multiple applications concurrently  
19 being processed by the department which seek registration of  
20 the same or confusingly similar marks for the same or related  
21 goods or services, the department shall grant priority to the  
22 applications in order of receipt. If a prior-received  
23 application is granted a registration, the other application  
24 or applications shall then be rejected. The applicant of a  
25 rejected application may bring an action for cancellation of  
26 the registration upon grounds of prior or superior rights to  
27 the mark, in accordance with the provisions of s. 495.101(3).

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

30 495.041 Use by related companies.--Where a mark  
31 registered or unregistered is or may be used legitimately by

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

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

12 495.061 Certificate of registration.--

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

28 (2) Any certificate of registration issued by the  
29 department ~~of State~~ under the provisions hereof or a copy  
30 thereof duly certified by the department ~~of State~~ shall be  
31 admissible in evidence as competent and sufficient proof of

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

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

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

20 |       495.071 Duration and renewal.--

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

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 January 1, 2007,  
6 shall continue in effect for the unexpired term thereof and  
7 may be renewed by filing an application for renewal with the  
8 department in a manner and form complying with the  
9 requirements of the department and paying the renewal fee  
10 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 upon the payment of the recording fee payable to

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

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

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

17 Section 11. Section 495.091, Florida Statutes, is  
18 amended to read:

19 495.091 Records.--The department ~~of State~~ shall keep  
20 for public examination a record of all marks registered or  
21 renewed under this chapter, including all documents recorded  
22 under s. 495.081.

23 Section 12. Section 495.101, Florida Statutes, is  
24 amended to read:

25 495.101 Cancellation.--The department ~~of State~~ shall  
26 cancel from the register:

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

31

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

6           ~~(2)(3)~~ All registrations granted under this chapter  
7 and not renewed in accordance with the provisions hereof.

8           ~~(3)(4)~~ Any registration for concerning which a court  
9 of competent jurisdiction finds shall find that:

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

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

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

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

25           (c) The registration was granted improperly.

26           (d) The registration was obtained fraudulently.

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

30           ~~(f)(e)~~ The registered mark is so similar, as to be  
31 likely to cause confusion or mistake or to deceive, to a mark

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

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

23 ~~(4)(5)~~ When a court of competent jurisdiction shall  
24 order cancellation of a registration on any ground.

25 Section 13. Section 495.111, Florida Statutes, is  
26 amended to read:

27 (Substantial rewording of section. See  
28 s. 495.111, F.S., for present text.)  
29 495.111 Classification.--

30 (1) The following general classes of goods and  
31 services, conforming to the classification adopted by the

1 United States Patent and Trademark Office, are established for  
2 convenience of administration of this chapter:

3 (a) Goods:

4 1. Class 1 Chemicals used in industry, science, and  
5 photography; agriculture, horticulture, and forestry;  
6 unprocessed artificial resins and, unprocessed plastics;  
7 manures; fire extinguishing compositions; tempering and  
8 soldering preparations; chemical substances for preserving  
9 foodstuffs; tanning substances; and adhesives used in  
10 industry.

11 2. Class 2 Paints, varnishes, lacquers; preservatives  
12 against rust and against deterioration of wood; colorants;  
13 mordants; raw natural resins; and metals in foil and powder  
14 form for painters, decorators, printers, and artists.

15 3. Class 3 Bleaching preparations and other  
16 substances for laundry use; cleaning, polishing, scouring, and  
17 abrasive preparations; soaps; perfumery, essential oils,  
18 cosmetics, and hair lotions; and dentifrices.

19 4. Class 4 Industrial oils and greases; lubricants;  
20 dust absorbing, wetting, and binding compositions; fuels  
21 (including motor spirit) and illuminants; and candles and  
22 wicks for lighting.

23 5. Class 5 Pharmaceuticals and veterinary  
24 preparations; sanitary preparations for medical purposes;  
25 dietetic substances adapted for medical use and food for  
26 babies; plasters and materials for dressings; material for  
27 stopping teeth and dental wax; disinfectants; preparations for  
28 destroying vermin; and fungicides and herbicides.

29 6. Class 6 Common metals and their alloys; metal  
30 building materials; transportable buildings of metal;  
31 materials of metal for railway tracks; nonelectric cables and

1 wires of common metal; ironmongery and small items of metal  
2 hardware; pipes and tubes of metal; safes; goods of common  
3 metal not included in other classes; and ores.

4 7. Class 7 Machines and machine tools; motors and  
5 engines (except for land vehicles); machine coupling and  
6 transmission components (except for land vehicles);  
7 agricultural implements other than hand-operated; incubators  
8 for eggs.

9 8. Class 8 Hand tools and hand-operated implements;  
10 cutlery; side arms; and razors.

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

22 10. Class 10 Surgical, medical, dental, and  
23 veterinary apparatus and instruments, artificial limbs, eyes,  
24 and teeth; orthopedic articles; and suture materials.

25 11. Class 11 Apparatus for lighting, heating, steam  
26 generating, cooking, refrigerating, drying, ventilating, water  
27 supply, and sanitary purposes.

28 12. Class 12 Vehicles; apparatus for locomotion by  
29 land, air, or water.

30 13. Class 13 Firearms; ammunition and projectiles;  
31 explosives; and fireworks.

- 1           14. Class 14 Precious metals and their alloys and  
2 goods in precious metals or coated therewith (not included in  
3 other classes); jewelry and precious stones; and horological  
4 and chronometric instruments.
- 5           15. Class 15 Musical instruments.
- 6           16. Class 16 Paper, cardboard, and goods made from  
7 these materials (not included in other classes); printed  
8 matter; bookbinding material; photographs; stationery;  
9 adhesives for stationery or household purposes; artists'  
10 materials; paint brushes; typewriters and office requisites  
11 (except furniture); instructional and teaching material  
12 (except apparatus); plastic materials for packaging (not  
13 included in other classes); printers' type; and printing  
14 blocks.
- 15           17. Class 17 Rubber, gutta-percha, gum, asbestos,  
16 mica, and goods made from these materials and not included in  
17 other classes; plastics in extruded form for use in  
18 manufacture; packing, stopping, and insulating materials; and  
19 flexible pipes not of metal.
- 20           18. Class 18 Leather and imitations of leather and  
21 goods made of these materials and not included in other  
22 classes; animal skins and hides; trunks and traveling bags;  
23 umbrellas, parasols, and walking sticks; and whips, harness,  
24 and saddlery.
- 25           19. Class 19 Building materials (nonmetallic);  
26 nonmetallic rigid pipes for building; asphalt, pitch, and  
27 bitumen; nonmetallic transportable buildings; monuments, not  
28 of metal.
- 29           20. Class 20 Furniture, mirrors, and picture frames;  
30 goods (not included in other classes) of wood, cork, reed,  
31 cane, wicker, horn, bone, ivory, whalebone, shell, amber,

1 mother-of-pearl, and meerschaum and substitutes for all these  
2 materials, or of plastics.

3 21. Class 21 Household or kitchen utensils and  
4 containers (not of precious metal or coated therewith); combs  
5 and sponges; brushes (except paint brushes); brush-making  
6 materials; articles for cleaning purposes; steel wool;  
7 unworked or semiworked glass (except glass used in building);  
8 and glassware, porcelain, and earthenware not included in  
9 other classes.

10 22. Class 22 Ropes, string, nets, tents, awnings,  
11 tarpaulins, sails, sacks, and bags (not included in other  
12 classes); padding and stuffing materials (except of rubber or  
13 plastics); and raw fibrous textile materials.

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

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

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

18 26. Class 26 Lace and embroidery, ribbons, and braid;  
19 buttons, hooks and eyes, pins, and needles; and artificial  
20 flowers.

21 27. Class 27 Carpets, rugs, mats and matting,  
22 linoleum, and other materials for covering existing floors;  
23 and wall hangings (nontextile).

24 28. Class 28 Games and playthings; gymnastic and  
25 sporting articles not included in other classes; and  
26 decorations for Christmas trees.

27 29. Class 29 Meat, fish, poultry, and game; meat  
28 extracts; preserved, dried, and cooked fruits and vegetables;  
29 jellies, jams, and compotes; eggs, milk, and milk products;  
30 and edible oils and fats.

31



1           30. Class 30 Coffee, tea, cocoa, sugar, rice,  
2 tapioca, sago, and artificial coffee; flour and preparations  
3 made from cereals, bread, pastry and confectionery, and ices;  
4 honey and treacle; yeast, baking powder; salt, and mustard;  
5 vinegar and sauces (condiments); spices; and ice.

6           31. Class 31 Agricultural, horticultural, and  
7 forestry products and grains not included in other classes;  
8 live animals; fresh fruits and vegetables; seeds, natural  
9 plants, and flowers; foodstuffs for animals and malt.

10           32. Class 32 Beers; mineral and aerated waters and  
11 other nonalcoholic drinks; fruit drinks and fruit juices; and  
12 syrups and other preparations for making beverages.

13           33. Class 33 Alcoholic beverages except beers.

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

15           (b) Services:

16           1. Class 35 Advertising; business management;  
17 business administration; and office functions.

18           2. Class 36 Insurance; financial affairs; monetary  
19 affairs; and real estate affairs.

20           3. Class 37 Building construction; repair; and  
21 installation services.

22           4. Class 38 Telecommunications.

23           5. Class 39 Transport; packaging and storage of  
24 goods; and travel arrangements.

25           6. Class 40 Treatment of materials.

26           7. Class 41 Education; providing of training;  
27 entertainment; and sporting and cultural activities.

28           8. Class 42 Scientific and technological services and  
29 research and design relating thereto; industrial analysis and  
30 research services; design and development of computer hardware  
31 and software; and legal services.

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

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

6           11. Class 45 Personal and social services rendered by  
7 others to meet the needs of individuals; and security services  
8 for the protection of property and individuals.

9           (c) Certification and collective membership marks:

10           1. Class 200 Collective membership marks.

11           2. Class A Certification marks for goods.

12           3. Class B Certification marks for services.

13           (d) The goods and services recited in collective  
14 trademark and collective service mark applications are  
15 assigned to the same classes that are appropriate for those  
16 goods and services in general.

17           (2) The establishment of the classes of goods and  
18 services set forth in subsection (1) is not for the purpose of  
19 limiting or extending the rights of the applicant or  
20 registrant. A single application for registration of a mark  
21 may include any or all goods upon which, or services with  
22 which, the mark is actually being used comprised in one or  
23 more of the classes listed, but in the event that a single  
24 application includes goods or services in connection with  
25 which the mark is being used which fall within different  
26 classes of goods or services, a fee equaling the sum of the  
27 fees for registration in each class shall be payable.

28           Section 14. Section 495.131, Florida Statutes, is  
29 amended to read:

30  
31

1           495.131 Infringement.--Subject to the provisions of s.  
2 495.161, any person who shall, without the consent of the  
3 registrant:

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

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

21  
22 Shall be liable in a civil action by the owner of such  
23 registered mark for any or all of the remedies provided in s.  
24 495.141, except that under subsection (2) hereof the  
25 registrant shall not be entitled to recover profits or damages  
26 unless the acts have been committed with knowledge that such  
27 mark is intended to be used to cause confusion or mistake or  
28 to deceive.

29           Section 15. Section 495.141, Florida Statutes, is  
30 amended to read:

31           495.141 Remedies.--

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

28           (2) The enumeration of any right or remedy herein  
29 shall not affect a registrant's right to prosecute under any  
30 penal law of this state.  
31

1           Section 16. Section 495.145, Florida Statutes, is  
2 created to read:

3           495.145 Forum for actions regarding registration.--An  
4 action seeking cancellation of a registration of a mark  
5 registered under this chapter may be brought in any court of  
6 competent jurisdiction in this state. Service of process on a  
7 nonresident registrant may be made in accordance with s.  
8 48.181. The department shall not be made a party to  
9 cancellation proceedings.

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

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

14           495.151 Dilution.--

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

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

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

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

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

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

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

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

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

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

25        (3) The following shall not be actionable under this  
26 section:

27        (a) Fair use of a famous mark by another person in  
28 comparative commercial advertising or promotion to identify  
29 the competing goods or services of the owner of the famous  
30 mark.

31        (b) Noncommercial use of the mark.

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

2           Section 18. Section 495.161, Florida Statutes, is  
3 amended to read:

4           495.161 Common-law rights.--Nothing herein shall  
5 adversely affect ~~or diminish~~ the rights or the enforcement of  
6 rights in marks acquired in good faith at any time at common  
7 law.

8           Section 19. Section 495.171, Florida Statutes, is  
9 amended to read:

10           495.171 Effective date; repeal of conflicting prior  
11 acts.--

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

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

23           Section 20. Section 495.181, Florida Statutes, is  
24 amended to read:

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

27           495.181 Construction of chapter.--The intent of this  
28 chapter is to provide a system of state trademark registration  
29 and protection substantially consistent with the federal  
30 system of trademark registration and protection under the  
31 Trademark Act of 1946, as amended. To that end, the

1 construction given the federal act should be examined as  
2 persuasive authority for interpreting and construing this  
3 chapter.

4 Section 21. Section 495.191, Florida Statutes, is  
5 created to read:

6 495.191 Fees.--Filing and other applicable fees  
7 payable to the department under this chapter shall be as  
8 follows:

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

16 Section 22. Sections 506.06, 506.07, 506.08, 506.09,  
17 506.11, 506.12, and 506.13, Florida Statutes, are repealed.

18 Section 23. This act shall take effect January 1,  
19 2007.

20  
21 STATEMENT OF SUBSTANTIAL CHANGES CONTAINED IN  
22 COMMITTEE SUBSTITUTE FOR  
23 CS for Senate Bill 2186

24 The committee substitute adds the word "deceptively" to the  
25 phrase "primary geographically misdescriptive" (relating to  
26 certain marks that are excluded from registration) to make the  
27 phrase conform to federal law. The committee substitute also  
28 makes other technical changes to the bill.  
29  
30  
31