

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; ~~or~~

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

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

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

30 (b);

31

1 (b) The date when the collective mark was first used
2 anywhere and the date when it was first used in this state by
3 any member of the applicant or a related company of such
4 member;

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

8 (d) A statement that no person except the applicant or
9 members of the applicant, or related companies thereof, has
10 the right to use such mark in this state, either in the
11 identical form thereof or in such near resemblance thereto as
12 to be likely, when applied to the goods or services of such
13 other person, to cause confusion, to cause mistake, or to
14 ~~deceive or confuse or to be mistaken therefor.~~

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

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

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

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

1 Section 6. Section 495.035, Florida Statutes, is
2 created to read:

3 495.035 Filing of applications.--

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

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

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

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

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

7 (a) The department makes final its refusal to register
8 the mark; or

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

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

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

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

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

1 495.041 Use by related companies.--Where a mark
2 registered or unregistered is or may be used legitimately by
3 related companies, such use shall inure to the benefit of the
4 owner of the mark, and such use shall not affect the validity
5 of such mark or of its registration, provided such mark is not
6 used in such manner as to deceive the public. If first use of
7 a mark by a person is controlled by the registrant or
8 applicant for registration of a mark with respect to the
9 nature and quality of the goods or services, such first use
10 shall inure to the benefit of that registrant or applicant, as
11 the case may be.

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

14 495.061 Certificate of registration.--

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

30 (2) Any certificate of registration issued by the
31 department ~~of State~~ under the provisions hereof or a copy

1 | thereof duly certified by the department ~~of State~~ shall be
2 | admissible in evidence as competent and sufficient proof of
3 | the registration of such mark in any action or judicial
4 | proceedings in any court of this state, and shall be prima
5 | facie evidence of the validity of the registration,
6 | registrant's ownership of the mark, and of registrant's
7 | exclusive right to use the mark in this state on or in
8 | connection with the goods or services specified in the
9 | certificate, subject to any conditions and limitations stated
10 | therein.

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

20 | Section 9. Section 495.071, Florida Statutes, is
21 | amended to read:

22 | 495.071 Duration and renewal.--

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

1 ~~services with respect to which such renewal is sought, payable~~
2 ~~to the department in accordance with s. 495.191 of State,~~
3 ~~shall accompany the application for renewal of the~~
4 ~~registration.~~

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

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

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

31

1 Section 10. Section 495.081, Florida Statutes, is
2 amended to read:

3 495.081 Assignments; changes of name; security
4 interests Assignment.--

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

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

30 (3) A registrant or applicant for registration
31 effecting a change of the name may record a certificate of

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

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

17 (5) Security interests in marks shall be created and
18 perfected in accordance with 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 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. Nothing in this paragraph shall be deemed to
21 prohibit the registrant from using its certification mark in
22 advertising or promoting recognition of the certification
23 program or of the goods or services meeting the certification
24 standards of the registrant.

25 ~~(4)(5)~~ When a court of competent jurisdiction shall
26 order cancellation of a registration on any ground.

27 Section 13. Section 495.111, Florida Statutes, is
28 amended to read:

29 (Substantial rewording of section. See
30 s. 495.111, F.S., for present text.)
31 495.111 Classification.--

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

5 (a) Goods:

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

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

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

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

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

31

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

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

12 8. Class 8 Hand tools and hand-operated implements;
13 cutlery; side arms; and razors.

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

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

28 11. Class 11 Apparatus for lighting, heating, steam
29 generating, cooking, refrigerating, drying, ventilating, water
30 supply, and sanitary purposes.

31

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

1 bitumen; nonmetallic transportable buildings; monuments, not
2 of metal.

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

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

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

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

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

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

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

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

29 28. Class 28 Games and playthings; gymnastic and
30 sporting articles not included in other classes; and
31 decorations for Christmas trees.

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

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

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

14 32. Class 32 Beers; mineral and aerated waters and
15 other nonalcoholic drinks; fruit drinks and fruit juices; and
16 syrups and other preparations for making beverages.

17 33. Class 33 Alcoholic beverages except beers.

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

19 (b) Services:

20 1. Class 35 Advertising; business management;
21 business administration; and office functions.

22 2. Class 36 Insurance; financial affairs; monetary
23 affairs; and real estate affairs.

24 3. Class 37 Building construction; repair; and
25 installation services.

26 4. Class 38 Telecommunications.

27 5. Class 39 Transport; packaging and storage of
28 goods; and travel arrangements.

29 6. Class 40 Treatment of materials.

30 7. Class 41 Education; providing of training;
31 entertainment; and sporting and cultural activities.

1 8. Class 42 Scientific and technological services and
2 research and design relating thereto; industrial analysis and
3 research services; design and development of computer hardware
4 and software; and legal services.

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

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

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

13 (c) Certification and collective membership marks:

14 1. Class 200 Collective membership marks.

15 2. Class A Certification marks for goods.

16 3. Class B Certification marks for services.

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

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

1 Section 14. Section 495.131, Florida Statutes, is
2 amended to read:

3 495.131 Infringement.--Subject to the provisions of s.
4 495.161, any person who shall, without the consent of the
5 registrant:

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

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

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

31

1 Section 15. Section 495.141, Florida Statutes, is
2 amended to read:

3 495.141 Remedies.--

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

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

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

6 495.145 Forum for actions regarding registration.--An
7 action seeking cancellation of a registration of a mark
8 registered under this chapter may be brought in any court of
9 competent jurisdiction in this state. Service of process on a
10 nonresident registrant may be made in accordance with s.
11 48.181. The department shall not be made a party to
12 cancellation proceedings.

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

15 (Substantial rewording of section. See

16 s. 495.151, F.S., for present text.)

17 495.151 Dilution.--

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

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

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

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

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

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

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

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

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

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

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

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

5 (b) Noncommercial use of the mark.

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

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

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

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

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

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

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

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

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

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

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

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

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

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

23 Section 23. This act shall take effect January 1,
24 2007.

25
26 STATEMENT OF SUBSTANTIAL CHANGES CONTAINED IN
27 COMMITTEE SUBSTITUTE FOR
28 CS/CS Senate Bill 2186

29 The committee substitute for committee substitute for
30 committee substitute for Senate Bill 2186, makes one minor
31 technical change to eliminate a typographical error, and adds
clarifying language relating to prohibiting the registration
of marks that may be deceptive or cause confusion or mistakes.