

1                   A bill to be entitled  
2           An act relating to trademarks; creating s. 495.001, F.S.;  
3           providing a short title; amending s. 495.011, F.S.;  
4           providing definitions; amending s. 495.021, F.S.;  
5           precluding registration of certain marks; repealing s.  
6           495.027, F.S., relating to reservation of a mark; amending  
7           s. 495.031, F.S.; providing requirements for information  
8           to be contained in an application for registration of a  
9           mark; authorizing the Department of State to require  
10          certain information in an application; requiring that the  
11          application be signed and verified by any of certain  
12          persons; requiring that the application be accompanied by  
13          three specimens showing the mark; requiring that the  
14          application be accompanied by a fee; creating s. 495.035,  
15          F.S.; providing filing guidelines for applications;  
16          providing for disclaimers of unregistrable components;  
17          providing for amendment and judicial review; providing for  
18          priority of registrations; amending s. 495.041, F.S.;  
19          providing that first use shall inure to the benefit of the  
20          registrant or applicant under certain circumstances;  
21          amending s. 495.061, F.S.; providing for the issuance of a  
22          certificate of registration by the department; removing a  
23          provision relating to reservation of a mark; amending s.  
24          495.071, F.S.; providing guidelines for the renewal of  
25          marks; revising duration of effectiveness of a  
26          registration; amending s. 495.081, F.S.; providing for the  
27          assignability of marks; authorizing a photocopy of an  
28          assignment to be acceptable for recording; providing for

29 change of name certificates for registrants; authorizing  
30 recordation of certain instruments; providing  
31 acknowledgment of recording as prima facie evidence of the  
32 execution of an assignment or other instrument; specifying  
33 requirements for creation and perfection of security  
34 interests in marks; amending s. 495.091, F.S.; requiring  
35 the department to record all marks registered with the  
36 state; amending s. 495.101, F.S.; requiring the department  
37 to cancel certain marks; amending s. 495.111, F.S., which  
38 establishes a classification of goods and services;  
39 providing that a single application for registration of a  
40 mark may include any or all goods upon which, or services  
41 with which, the mark is actually being used comprised in  
42 one or more of the classes listed; amending s. 495.131,  
43 F.S.; revising infringement provisions to include an  
44 element of lack of consent by the registrant; conforming  
45 language; amending s. 495.141, F.S.; providing additional  
46 remedies for the unauthorized use of a mark; creating s.  
47 495.145, F.S.; providing a forum for actions regarding  
48 registration; providing for service of process on  
49 nonresident registrants; amending s. 495.151, F.S.;  
50 providing for an injunction in cases of dilution of a  
51 famous mark; providing factors to be considered in  
52 determining that a mark is famous; providing damages in  
53 certain circumstances of dilution; amending s. 495.161,  
54 F.S.; deleting language relating to the diminishing of  
55 certain common law rights; amending s. 495.171, F.S.;  
56 providing effective date of changes to ch. 495, F.S., as

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57 amended by the act; providing for repeal of conflicting  
58 acts; providing application to pending actions; amending  
59 s. 495.181, F.S.; providing construction and legislative  
60 intent; creating s. 495.191, F.S.; providing certain fees;  
61 repealing s. 506.06, F.S., relating to unlawful to  
62 counterfeit trademark, to conform; repealing s. 506.07,  
63 F.S., relating to filing of trademark or other form of  
64 advertisement for record with Department of State, to  
65 conform; repealing s. 506.08, F.S., relating to fee for  
66 filing, to conform; repealing s. 506.09, F.S., relating to  
67 civil remedies, to conform; repealing s. 506.11, F.S.,  
68 relating to unlawful use of trademark, to conform;  
69 repealing s. 506.12, F.S., relating to procuring the  
70 filing of trademark or other form of advertisement by  
71 fraudulent representations, to conform; repealing s.  
72 506.13, F.S., relating to using the name or seal of  
73 another, to conform; providing an effective date.

74  
75 Be It Enacted by the Legislature of the State of Florida:

76  
77 Section 1. Section 495.001, Florida Statutes, is created  
78 to read:

79 495.001 Short title.--This chapter may be cited as the  
80 "Registration and Protection of Trademarks Act."

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

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

85 495.011 Definitions.--As used in this chapter:

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

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

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

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

98 (3) "Certification mark" means any word, name, symbol, or  
99 device, or any combination thereof, used by a person other than  
100 the owner of the mark to certify regional or other origin,  
101 material, mode of manufacture, quality, accuracy, or other  
102 characteristics of such person's goods or services or that the  
103 work or labor on the goods or services was performed by members  
104 of a union or other organization.

105 (4) "Collective mark" means a trademark or service mark  
106 used by the members of a cooperative, an association, or other  
107 collective group or organization, and includes marks used to  
108 indicate membership in a union, an association, or other  
109 organization.

110 (5) "Department" means the Florida Department of State or  
111 its designee charged with the administration of this chapter.

112 (6) "Dilution" means the lessening of the capacity of a

113 mark to identify and distinguish goods or services, regardless  
 114 of the presence or absence of:

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

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

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

121 (8) "Person," and any other word or term used to designate  
 122 the applicant or other party entitled to a benefit or privilege  
 123 or rendered liable under the provisions of this chapter, means a  
 124 juristic person as well as a natural person. "Juristic person"  
 125 includes a firm, partnership, corporation, union, association,  
 126 or other organization capable of suing and being sued in a court  
 127 of law.

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

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

135 (11) "Service mark" means any word, name, symbol, or  
 136 device, or any combination thereof, used by a person to identify  
 137 and distinguish the services of such person, including a unique  
 138 service, from the services of others, and to indicate the source  
 139 of the services, even if that source is unknown. Titles,  
 140 character names, and other distinctive features of radio or

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141 television programs may be registered as service marks  
142 notwithstanding that the person or the programs may advertise  
143 the goods of the sponsor.

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

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

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

155 (a) On goods when:

156 1. The mark is placed in any manner on the goods, their  
157 containers or the displays associated therewith, or on the tags  
158 or labels affixed thereto, or, if the nature of the goods makes  
159 such placement impracticable, on documents associated with the  
160 goods or their sale; and

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

162 (b) On services when the mark used or displayed in the  
163 sale or advertising of services and the services are rendered in  
164 this state.

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

167 495.021 Registrability.--

168 (1) A mark by which the goods or services of any applicant

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169 for registration may be distinguished from the goods or services  
 170 of others shall not be registered if it:

171 (a) Consists of or, ~~comprises or includes~~ immoral,  
 172 deceptive, or scandalous matter; ~~or~~

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

177 (c) Consists of or ~~comprises or includes~~ the flag or  
 178 coat of arms or other insignia of the United States, or of any  
 179 state or municipality, or of any foreign nation, or any  
 180 simulation thereof; ~~or~~

181 (d) Consists of or ~~comprises a or includes~~ the name,  
 182 signature, or portrait identifying a particular ~~of any~~ living  
 183 individual, except by ~~with~~ her or his written consent, or the  
 184 name, signature, or portrait of a deceased President of the  
 185 United States during the lifetime of his widow or her widower,  
 186 if any, except by the written consent of the widow or widower;  
 187 ~~or~~

188 (e) Consists of a mark which:

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

192 2. When used on or in connection with ~~applied to~~ the goods  
 193 ~~or services~~ of the applicant, is primarily geographically  
 194 descriptive ~~or deceptively misdescriptive~~ of the goods; ~~them or~~  
 195 ~~their source or origin, or~~

196 3. When used on or in connection with the goods of the

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197 applicant, is primarily geographically misdescriptive of the  
 198 goods;

199 ~~4.3. Is primarily merely a surname; or,~~

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

201  
 202 Except as expressly excluded in subparagraphs 3. and 5.,  
 203 ~~provided, however, that~~ nothing in this paragraph shall prevent  
 204 the registration of a mark used ~~in this state~~ by the applicant  
 205 which has become distinctive of the applicant's goods or  
 206 services ~~in this state or elsewhere~~. The department ~~of State~~ may  
 207 accept as prima facie evidence that the mark has become  
 208 distinctive, as used on or in connection with ~~applied to~~ the  
 209 applicant's goods or services, proof of substantially exclusive  
 210 and continuous use thereof as a mark by the applicant in this  
 211 state or elsewhere for the 5 years before ~~next preceding~~ the  
 212 date on which the claim of distinctiveness is made; or

213 (f) Consists of or comprises a mark which so resembles a  
 214 mark registered in this state or a mark or trade name previously  
 215 used in this state by another and not abandoned, as to be  
 216 likely, when applied to the goods or services of the applicant,  
 217 to cause confusion or mistake or to deceive. Registration shall  
 218 not be denied solely on the basis of reservation or registration  
 219 by another of a corporate name or fictitious name that is the  
 220 same or similar to the mark for which registration is sought.

221 Section 4. Section 495.027, Florida Statutes, is repealed.

222 Section 5. Section 495.031, Florida Statutes, is amended  
 223 to read:

224 495.031 Application for registration.--



225 (1) Subject to the limitations set forth in this chapter,  
 226 any person who ~~adopts and~~ uses a trademark or service mark in  
 227 this state may file with the department ~~of State,~~ in a manner  
 228 and on a form complying with the requirements of to be furnished  
 229 ~~by~~ the department, an application for registration of that  
 230 ~~trademark or service~~ mark setting forth, but not limited to, the  
 231 following information:

232 (a) The name and business address of the person applying  
 233 for such registration, and, if a business entity, the place  
 234 ~~corporation, the state~~ of incorporation or organization;

235 (b) The goods or services on or in connection with which  
 236 the mark is used and the mode or manner in which the mark is  
 237 used in connection with such goods or services and the class or  
 238 classes in which such goods or services fall;

239 (c) The date ~~when~~ the mark was first used anywhere and the  
 240 date ~~when~~ it was first used in this state by the applicant, the  
 241 applicant's or her or his predecessor in interest, business or a  
 242 related company of the applicant ~~or the applicant's predecessor;~~  
 243 and

244 (d) A statement that the applicant is the owner of the  
 245 mark, that the mark is in use, and that, to the best of the  
 246 applicant's knowledge, no other person except a related company  
 247 has registered such mark in this state, or has the right to use  
 248 such mark in this state, either in the identical form thereof or  
 249 in such near resemblance thereto as to be likely when, applied  
 250 to the goods or services of such other person, to cause  
 251 confusion, to cause mistake, or to deceive or confuse or to be  
 252 ~~mistaken therefor.~~

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

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

259 (b) The date when the certification mark was first used  
260 anywhere and the date when it was first used in this state under  
261 the authority of the applicant;

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

264 (d) A statement that the applicant is exercising control  
265 over the use of the mark, that the applicant is not herself or  
266 himself engaged in the production or marketing of the goods or  
267 services to which the mark is applied, and that no person except  
268 the applicant or persons authorized by the applicant, or related  
269 companies thereof, has the right to use such mark in this state  
270 either in the identical form thereof or in such near resemblance  
271 thereto as to be likely to deceive or confuse or to be mistaken  
272 therefor.

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

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

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

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281 any member of the applicant or a related company of such member;

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

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

290 (4) The department may also require that a drawing of the  
 291 mark, complying with the requirements of the department,  
 292 accompany the application.

293 (5)-(4) Every application under this section shall be  
 294 signed and verified by the applicant or by a member of the firm  
 295 or an officer or other authorized representative of the business  
 296 entity of the corporation, association, union or other  
 297 organization applying.

298 (6)-(5) Every application under this section shall be  
 299 accompanied by three specimens showing the mark as actually used  
 300 a specimen or facsimile of such mark in triplicate.

301 (7)-(6) Every application under this section shall be  
 302 accompanied by a filing fee of \$87.50, payable to the department  
 303 in accordance with s. 495.191 of State, for each class of goods  
 304 or services as specified in s. 495.111, in connection with which  
 305 the mark is used.

306 Section 6. Section 495.035, Florida Statutes, is created  
 307 to read:

308 495.035 Filing of applications.--

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309       (1) Upon the receipt of an application for registration  
310 and payment of the application fee, the department may cause the  
311 application to be examined for conformity with this chapter.

312       (2) The applicant shall provide any additional pertinent  
313 information requested by the department, including a description  
314 of a design mark, and may make, or authorize the department to  
315 make, such amendments to the application as may be reasonably  
316 requested by the department or deemed by applicant to be  
317 advisable to respond to any rejection or objection.

318       (3) The department may require the applicant to disclaim  
319 an unregistrable component of a mark otherwise registrable, and  
320 an applicant may voluntarily disclaim a component of a mark  
321 sought to be registered. No disclaimer shall prejudice or affect  
322 the applicant's or registrant's rights then existing or  
323 thereafter arising in the disclaimed matter, or the applicant's  
324 or registrant's rights of registration on another application,  
325 if the disclaimed matter is or has become distinctive of the  
326 applicant's or registrant's goods or services.

327       (4) Amendments may be made by the department upon the  
328 application submitted by the applicant upon the applicant's  
329 agreement, or a new application may be required to be submitted.  
330 Amendments to an otherwise properly filed application shall not  
331 affect the application filing date for purposes of determining  
332 the applicant's or registrant's filing priority rights.

333       (5) If the applicant is found not to be entitled to  
334 registration, the department shall advise the applicant of the  
335 rejection and of the reasons for rejection. The applicant shall  
336 have 3 months in which to reply or amend the application, in

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337 which event the application shall be reexamined. This procedure  
 338 may be repeated until:

339 (a) The department makes final its refusal to register the  
 340 mark; or

341 (b) The applicant fails to reply or amend the application  
 342 within the specified period, whereupon the application shall be  
 343 abandoned.

344  
 345 For good cause shown, such as the pendency of litigation  
 346 involving the mark, the department may extend the period of time  
 347 in which to respond to the rejection or suspend examination of  
 348 the application.

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

352 (7) In the event of multiple applications concurrently  
 353 being processed by the department which seek registration of the  
 354 same or confusingly similar marks for the same or related goods  
 355 or services, the department shall grant priority to the  
 356 applications in order of receipt. If a prior-received  
 357 application is granted a registration, the other application or  
 358 applications shall then be rejected. The applicant of a rejected  
 359 application may bring an action for cancellation of the  
 360 registration upon grounds of prior or superior rights to the  
 361 mark, in accordance with the provisions of s. 495.101(3).

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

364 495.041 Use by related companies.--Where a mark registered

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365 or unregistered is or may be used legitimately by related  
 366 companies, such use shall inure to the benefit of the owner of  
 367 the mark, and such use shall not affect the validity of such  
 368 mark or of its registration, provided such mark is not used in  
 369 such manner as to deceive the public. If first use of a mark by  
 370 a person is controlled by the registrant or applicant for  
 371 registration of a mark with respect to the nature and quality of  
 372 the goods or services, such first use shall inure to the benefit  
 373 of that registrant or applicant, as the case may be.

374 Section 8. Section 495.061, Florida Statutes, is amended  
 375 to read:

376 495.061 Certificate of registration.--

377 (1) Upon compliance by the applicant with the requirements  
 378 of this chapter, the department ~~of State~~ shall cause a  
 379 certificate of registration to be issued and delivered to the  
 380 applicant. The certificate of registration shall be issued under  
 381 the signature of the Secretary of State and the seal of the  
 382 state, and it shall show the name and business address and, if a  
 383 business entity corporation, the place state of incorporation or  
 384 organization, of the person claiming ownership of the mark in  
 385 this state, the date claimed for the first use of the mark  
 386 anywhere and the date claimed for the first use of the mark in  
 387 this state, the class or classes of goods or services and a  
 388 description of the goods or services on or in connection with ~~on~~  
 389 which the mark is used, a reproduction of the mark, the  
 390 registration date and the term of the registration.

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

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393 thereof duly certified by the department ~~of State~~ shall be  
 394 admissible in evidence as competent and sufficient proof of the  
 395 registration of such mark in any action or judicial proceedings  
 396 in any court of this state, and shall be prima facie evidence of  
 397 the validity of the registration, registrant's ownership of the  
 398 mark, and of registrant's exclusive right to use the mark in  
 399 this state on or in connection with the goods or services  
 400 specified in the certificate, subject to any conditions and  
 401 limitations stated therein.

402 ~~(3) Contingent on the registration of a mark under this~~  
 403 ~~chapter, the reservation of such mark based on intent to use, as~~  
 404 ~~provided in this chapter, shall be prima facie evidence of~~  
 405 ~~priority of ownership of such mark within this state on or in~~  
 406 ~~connection with the goods or services specified in the~~  
 407 ~~reservation against any other person, except for a person whose~~  
 408 ~~mark has not been abandoned and who, prior to such reservation,~~  
 409 ~~has used the mark within this state on or in connection with~~  
 410 ~~such goods or services.~~

411 Section 9. Section 495.071, Florida Statutes, is amended  
 412 to read:

413 495.071 Duration and renewal.--

414 (1) Registration of a mark hereunder shall be effective  
 415 for a term of 5 ~~10~~ years from the date of registration and, upon  
 416 application filed within 6 months prior to the expiration of  
 417 such term, in a manner and form complying with the requirements  
 418 of on a form to be furnished by the department ~~of State~~, the  
 419 registration may be renewed for a like term beginning at the end  
 420 of the expiring term. Every application under this section shall

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421 be accompanied by a filing fee ~~A renewal fee of \$87.50 for each~~  
422 ~~class of goods or services with respect to which such renewal is~~  
423 ~~sought, payable to the department in accordance with s. 495.191~~  
424 ~~of State, shall accompany the application for renewal of the~~  
425 ~~registration.~~

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

428 (3) Any registration in effect on January 1, 2007, shall  
429 continue in effect for the unexpired term thereof and may be  
430 renewed by filing an application for renewal with the department  
431 in a manner and form complying with the requirements of the  
432 department and paying the renewal fee therefor within 6 months  
433 prior to the expiration of the registration. ~~The Department of~~  
434 ~~State shall notify registrants of marks hereunder of the~~  
435 ~~necessity of renewal within the year next preceding the~~  
436 ~~expiration of the 10 years from the date of registration by~~  
437 ~~writing to the last known address of the registrants. The~~  
438 ~~department shall prescribe the forms on which to make the~~  
439 ~~required notification and the renewal called for in subsection~~  
440 ~~(1) and may substitute the uniform business report, pursuant to~~  
441 ~~s. 606.06, as a means of satisfying the requirement of this~~  
442 ~~part.~~

443 (4) All applications for renewal ~~renewals~~ under this  
444 chapter, whether of registrations made under this act or of  
445 registrations made under any prior acts, shall include a  
446 verified statement that the mark is still in use in this state,  
447 and shall include a specimen showing actual use of the mark on  
448 or in connection with the goods or services subject to the



449 renewal application, or shall state that its nonuse is due to  
 450 special circumstances which excuse such nonuse and is not due to  
 451 any intention to abandon the mark.

452 Section 10. Section 495.081, Florida Statutes, is amended  
 453 to read:

454 495.081 Assignments; changes of name; security interests  
 455 Assignment.--

456 (1) A registered mark or a mark for which an application  
 457 for registration has been filed ~~Any mark and its registration~~  
 458 ~~hereunder~~ shall be assignable with the goodwill ~~good will~~ of the  
 459 business in which the mark is used or with that part of the  
 460 goodwill ~~good will~~ of the business connected with the use of and  
 461 symbolized by the mark. Assignments ~~Assignment~~ shall be by an  
 462 instrument ~~instruments~~ in writing duly executed and may be  
 463 recorded with the department ~~of State~~ upon the payment of the  
 464 applicable a fee. A photocopy of an assignment shall be accepted  
 465 for recording if it is certified by any of the parties thereto,  
 466 or their successors, to be a true and correct copy of the  
 467 original. Upon recording of the assignment, of \$50, payable to  
 468 ~~the department of State which, upon recording of the assignment,~~  
 469 shall issue in the name of the assignee a new certificate for  
 470 the remainder of the term of the registration or of the last  
 471 renewal thereof.

472 (2) An assignment of any registration under this chapter  
 473 shall be void as against any subsequent purchaser for valuable  
 474 consideration without notice, unless such assignment is recorded  
 475 with the department ~~of State~~ within 3 months after the date of  
 476 the assignment or prior to the subsequent purchase thereof or at

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477 ~~any time after the expiration of such 3 month period, unless an~~  
478 ~~assignment given in connection with any subsequent purchase is~~  
479 ~~recorded with the Department of State prior to or within 10 days~~  
480 ~~after such assignment is recorded.~~

481 (3) A registrant or applicant for registration effecting a  
482 change of the name may record a certificate of change of name of  
483 the registrant or applicant with the department upon the payment  
484 of the recording fee payable to the department in accordance  
485 with s. 495.191. In the case of a pending application for a mark  
486 that becomes approved for registration, the department shall  
487 issue a certificate of registration in the registrant's new  
488 name. In the case of a registered mark, the department shall  
489 issue a new certificate of registration in the registrant's new  
490 name for the remainder of the term of the registration or last  
491 renewal thereof. A person's failure to record a name change in  
492 accordance with this subsection shall not affect the person's  
493 substantive rights in the mark or its registration.

494 (4) Acknowledgment shall be prima facie evidence of the  
495 execution of an assignment or other instrument and, when  
496 recorded by the department, the record shall be prima facie  
497 evidence of execution.

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

500 Section 11. Section 495.091, Florida Statutes, is amended  
501 to read:

502 495.091 Records.--The department ~~of State~~ shall keep for  
503 public examination a record of all marks registered or renewed

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504 under this chapter, including all documents recorded under s.  
 505 495.081.

506 Section 12. Section 495.101, Florida Statutes, is amended  
 507 to read:

508 495.101 Cancellation.--The department ~~of State~~ shall  
 509 cancel from the register:

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

513 (1)(2) Any registration for concerning which the  
 514 department ~~of State~~ has received shall receive a voluntary  
 515 request for cancellation by the registrant, which request shall  
 516 be in a manner and form complying with the requirements of the  
 517 department thereof from the registrant.

518 (2)(3) All registrations granted under this chapter and  
 519 not renewed in accordance with the provisions hereof.

520 (3)(4) Any registration for concerning which a court of  
 521 competent jurisdiction finds shall find that:

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

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

528 2. ~~When any course of conduct of the owner, including acts~~  
 529 ~~of omission as well as commission, causes the mark to become the~~  
 530 ~~generic name for the goods or services on or in connection with~~  
 531 ~~which it is used, or otherwise to lose its significance as a~~

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532 ~~mark. Purchaser motivation shall not be a test for determining~~  
533 ~~abandonment under this paragraph.~~

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

536 (c) The registration was granted improperly.

537 (d) The registration was obtained fraudulently.

538 (e) The mark is or has become the generic name for the  
539 goods or services, or a portion thereof, for which the mark has  
540 been registered.

541 (f)~~(e)~~ The registered mark is so similar, as to be likely  
542 to cause confusion or mistake or to deceive, to a mark  
543 registered by another person in the United States Patent and  
544 Trademark Office, prior to the date of the filing of the  
545 application for registration by the registrant hereunder, and  
546 not abandoned; ~~provided, however, that~~ should the registrant  
547 prove that the registrant ~~she or he~~ is the owner of a concurrent  
548 registration of a ~~her or his~~ mark in the United States Patent  
549 and Trademark Office covering an area including this state, the  
550 registration hereunder shall not be canceled.

551 (g)~~(f)~~ In the case of a certification mark, that the  
552 registrant does not control or is not able to exercise control  
553 over the use of such mark; or engages in the production or  
554 marketing of any goods or services to which the certification  
555 mark is applied; or the registrant permits the use of the  
556 certification mark for purposes other than to certify; or the  
557 registrant discriminately refuses ~~refused~~ to certify or ~~to~~  
558 continue to certify the goods or services of any person who  
559 maintains the standards or conditions which such mark certifies.

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560 Nothing in this paragraph shall be deemed to prohibit the  
561 registrant from using its certification mark in advertising or  
562 promoting recognition of the certification program or of the  
563 goods or services meeting the certification standards of the  
564 registrant.

565 ~~(4)-(5)~~ When a court of competent jurisdiction shall order  
566 cancellation of a registration on any ground.

567 Section 13. Section 495.111, Florida Statutes, is amended  
568 to read:

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

571 495.111 Classification.--

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

576 (a) Goods:

577 1. Class 1 Chemicals used in industry, science, and  
578 photography; agriculture, horticulture, and forestry;  
579 unprocessed artificial resins and, unprocessed plastics;  
580 manures; fire extinguishing compositions; tempering and  
581 soldering preparations; chemical substances for preserving  
582 foodstuffs; tanning substances; and adhesives used in industry.

583 2. Class 2 Paints, varnishes, lacquers; preservatives  
584 against rust and against deterioration of wood; colorants;  
585 mordants; raw natural resins; and metals in foil and powder form  
586 for painters, decorators, printers, and artists.

587 3. Class 3 Bleaching preparations and other substances

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588 for laundry use; cleaning, polishing, scouring, and abrasive  
589 preparations; soaps; perfumery, essential oils, cosmetics, and  
590 hair lotions; and dentifrices.

591 4. Class 4 Industrial oils and greases; lubricants; dust  
592 absorbing, wetting, and binding compositions; fuels (including  
593 motor spirit) and illuminants; and candles and wicks for  
594 lighting.

595 5. Class 5 Pharmaceuticals and veterinary preparations;  
596 sanitary preparations for medical purposes; dietetic substances  
597 adapted for medical use and food for babies; plasters and  
598 materials for dressings; material for stopping teeth and dental  
599 wax; disinfectants; preparations for destroying vermin; and  
600 fungicides and herbicides.

601 6. Class 6 Common metals and their alloys; metal building  
602 materials; transportable buildings of metal; materials of metal  
603 for railway tracks; nonelectric cables and wires of common  
604 metal; ironmongery and small items of metal hardware; pipes and  
605 tubes of metal; safes; goods of common metal not included in  
606 other classes; and ores.

607 7. Class 7 Machines and machine tools; motors and engines  
608 (except for land vehicles); machine coupling and transmission  
609 components (except for land vehicles); agricultural implements  
610 other than hand-operated; incubators for eggs.

611 8. Class 8 Hand tools and hand-operated implements;  
612 cutlery; side arms; and razors.

613 9. Class 9 Scientific, nautical, surveying, photographic,  
614 cinematographic, optical, weighing, measuring, signaling,  
615 checking (supervision), and life-saving and teaching apparatus

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616 and instruments; apparatus and instruments for conducting,  
617 switching, transforming, accumulating, regulating, or  
618 controlling electricity; apparatus for recording, transmission,  
619 or reproduction of sound or images; magnetic data carriers and  
620 recording discs; automatic vending machines and mechanisms for  
621 coin-operated apparatus; cash registers, calculating machines,  
622 and data processing equipment and computers; and fire-  
623 extinguishing apparatus.

624 10. Class 10 Surgical, medical, dental, and veterinary  
625 apparatus and instruments, artificial limbs, eyes, and teeth;  
626 orthopedic articles; and suture materials.

627 11. Class 11 Apparatus for lighting, heating, steam  
628 generating, cooking, refrigerating, drying, ventilating, water  
629 supply, and sanitary purposes.

630 12. Class 12 Vehicles; apparatus for locomotion by land,  
631 air, or water.

632 13. Class 13 Firearms; ammunition and projectiles;  
633 explosives; and fireworks.

634 14. Class 14 Precious metals and their alloys and goods  
635 in precious metals or coated therewith (not included in other  
636 classes); jewelry and precious stones; and horological and  
637 chronometric instruments.

638 15. Class 15 Musical instruments.

639 16. Class 16 Paper, cardboard, and goods made from these  
640 materials (not included in other classes); printed matter;  
641 bookbinding material; photographs; stationery; adhesives for  
642 stationery or household purposes; artists' materials; paint  
643 brushes; typewriters and office requisites (except furniture);

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644 instructional and teaching material (except apparatus); plastic  
645 materials for packaging (not included in other classes);  
646 printers' type; and printing blocks.

647 17. Class 17 Rubber, gutta-percha, gum, asbestos, mica,  
648 and goods made from these materials and not included in other  
649 classes; plastics in extruded form for use in manufacture;  
650 packing, stopping, and insulating materials; and flexible pipes  
651 not of metal.

652 18. Class 18 Leather and imitations of leather and goods  
653 made of these materials and not included in other classes;  
654 animal skins and hides; trunks and traveling bags; umbrellas,  
655 parasols, and walking sticks; and whips, harness, and saddlery.

656 19. Class 19 Building materials (nonmetallic);  
657 nonmetallic rigid pipes for building; asphalt, pitch, and  
658 bitumen; nonmetallic transportable buildings; monuments, not of  
659 metal.

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

665 21. Class 21 Household or kitchen utensils and containers  
666 (not of precious metal or coated therewith); combs and sponges;  
667 brushes (except paint brushes); brush-making materials; articles  
668 for cleaning purposes; steel wool; unworked or semiworked glass  
669 (except glass used in building); and glassware, porcelain, and  
670 earthenware not included in other classes.

671 22. Class 22 Ropes, string, nets, tents, awnings,



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672 taraulins, sails, sacks, and bags (not included in other  
673 classes); padding and stuffing materials (except of rubber or  
674 plastics); and raw fibrous textile materials.

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

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

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

679 26. Class 26 Lace and embroidery, ribbons, and braid;  
680 buttons, hooks and eyes, pins, and needles; and artificial  
681 flowers.

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

685 28. Class 28 Games and playthings; gymnastic and sporting  
686 articles not included in other classes; and decorations for  
687 Christmas trees.

688 29. Class 29 Meat, fish, poultry, and game; meat  
689 extracts; preserved, dried, and cooked fruits and vegetables;  
690 jellies, jams, and compotes; eggs, milk, and milk products; and  
691 edible oils and fats.

692 30. Class 30 Coffee, tea, cocoa, sugar, rice, tapioca,  
693 sago, and artificial coffee; flour and preparations made from  
694 cereals, bread, pastry and confectionery, and ices; honey and  
695 treacle; yeast, baking powder; salt, and mustard; vinegar and  
696 saucers (condiments); spices; and ice.

697 31. Class 31 Agricultural, horticultural, and forestry  
698 products and grains not included in other classes; live animals;  
699 fresh fruits and vegetables; seeds, natural plants, and flowers;

700 foodstuffs for animals and malt.

701 32. Class 32 Beers; mineral and aerated waters and other

702 nonalcoholic drinks; fruit drinks and fruit juices; and syrups

703 and other preparations for making beverages.

704 33. Class 33 Alcoholic beverages except beers.

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

706 (b) Services:

707 1. Class 35 Advertising; business management; business

708 administration; and office functions.

709 2. Class 36 Insurance; financial affairs; monetary

710 affairs; and real estate affairs.

711 3. Class 37 Building construction; repair; and

712 installation services.

713 4. Class 38 Telecommunications.

714 5. Class 39 Transport; packaging and storage of goods;

715 and travel arrangements.

716 6. Class 40 Treatment of materials.

717 7. Class 41 Education; providing of training;

718 entertainment; and sporting and cultural activities.

719 8. Class 42 Scientific and technological services and

720 research and design relating thereto; industrial analysis and

721 research services; design and development of computer hardware

722 and software; and legal services.

723 9. Class 43 Services for providing food and drink; and

724 temporary accommodation.

725 10. Class 44 Medical services; veterinary services;

726 hygienic and beauty care for human beings or animals; and

727 agriculture, horticulture, and forestry services.

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

731           (c) Certification and collective membership marks:

732           1. Class 200 Collective membership marks.

733           2. Class A Certification marks for goods.

734           3. Class B Certification marks for services.

735           (d) The goods and services recited in collective trademark  
 736 and collective service mark applications are assigned to the  
 737 same classes that are appropriate for those goods and services  
 738 in general.

739           (2) The establishment of the classes of goods and services  
 740 set forth in subsection (1) is not for the purpose of limiting  
 741 or extending the rights of the applicant or registrant. A single  
 742 application for registration of a mark may include any or all  
 743 goods upon which, or services with which, the mark is actually  
 744 being used comprised in one or more of the classes listed, but  
 745 in the event that a single application includes goods or  
 746 services in connection with which the mark is being used which  
 747 fall within different classes of goods or services, a fee  
 748 equaling the sum of the fees for registration in each class  
 749 shall be payable.

750           Section 14. Section 495.131, Florida Statutes, is amended  
 751 to read:

752           495.131 Infringement.--Subject to the provisions of s.  
 753 495.161, any person who shall, without the consent of the  
 754 registrant:

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755           (1) Use, ~~without the consent of the registrant,~~ any  
756 reproduction, counterfeit, copy, or colorable imitation of a  
757 mark registered under this chapter ~~on any goods or~~ in connection  
758 with the sale, offering for sale, distribution, or advertising  
759 of any goods or services on or in connection with which such use  
760 is likely to cause confusion, ~~or~~ to cause mistake, or to deceive  
761 ~~as to the source or origin of such goods or services;~~ or

762           (2) Reproduce, counterfeit, copy, or colorably imitate a  
763 ~~any such~~ mark registered under this chapter and apply such  
764 reproduction, counterfeit, copy, or colorable imitation to  
765 labels, signs, prints, packages, wrappers, receptacles, or  
766 advertisements intended to be used upon or in connection  
767 ~~conjunction~~ with the sale, ~~offering for sale,~~ distribution, or  
768 advertising ~~in this state~~ of goods or services on or in  
769 connection with which such use is likely to cause confusion, to  
770 cause mistake, or to deceive;

771  
772 shall be liable in a civil action by the owner of such  
773 registered mark for any or all of the remedies provided in s.  
774 495.141, except that under subsection (2) hereof the registrant  
775 shall not be entitled to recover profits or damages unless the  
776 acts have been committed with knowledge that such mark is  
777 intended to be used to cause confusion or mistake or to deceive.

778           Section 15. Section 495.141, Florida Statutes, is amended  
779 to read:

780           495.141 Remedies.--

781           (1) Any owner of a mark registered under this chapter may  
782 proceed by suit to enjoin the manufacture, use, display, or sale

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783 of any counterfeits or imitations thereof and any court of  
784 competent jurisdiction may grant injunctions to restrain such  
785 manufacture, use, display or sale as may be by the said court  
786 deemed just and reasonable, and may require the defendants to  
787 pay to such owner all profits derived from and/or all damages  
788 suffered by reason of such wrongful manufacture, use, display,  
789 or sale and to pay the costs of the action; and such court may  
790 also order that any such counterfeits or imitations in the  
791 possession or under the control of any defendant in such case be  
792 delivered to an officer of the court, or to the complainant, to  
793 be destroyed. In assessing profits the plaintiff shall be  
794 required to prove defendant's sales only; defendant must prove  
795 all elements of cost or deduction claimed. In assessing damages  
796 the court may enter judgment, according to the circumstances of  
797 the case, for any sum above the amount found as actual damages,  
798 not exceeding three ~~3~~ times such amount. If the court shall find  
799 that the amount of the recovery based on profits is either  
800 inadequate or excessive the court may in its discretion enter  
801 judgment for such sum as the court shall find to be just,  
802 according to the circumstances of the case. Such sum in either  
803 of the above circumstances shall constitute compensation and not  
804 a penalty. The court may also award reasonable attorney's fees  
805 to the prevailing party according to the circumstances of the  
806 case.

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

810 Section 16. Section 495.145, Florida Statutes, is created

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811 to read:

812 495.145 Forum for actions regarding registration.--An  
813 action seeking cancellation of a registration of a mark  
814 registered under this chapter may be brought in any court of  
815 competent jurisdiction in this state. Service of process on a  
816 nonresident registrant may be made in accordance with s. 48.181.  
817 The department shall not be made a party to cancellation  
818 proceedings.

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

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

823 495.151 Dilution.--

824 (1) The owner of a mark that is famous in this state shall  
825 be entitled, subject to the principles of equity and upon such  
826 terms as the court deems reasonable, to an injunction and to  
827 obtain such other relief against another person's commercial use  
828 of a mark or trade name if such use begins after the mark has  
829 become famous and is likely to cause dilution of the distinctive  
830 quality of the famous mark, as provided in this section. In  
831 determining whether a mark is distinctive and famous, a court  
832 may consider factors, including, but not limited to:

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

835 (b) The duration and extent of use of the mark in  
836 connection with the goods and services with which the mark is  
837 used.

838 (c) The duration and extent of advertising and publicity

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839 of the mark in this state.

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

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

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

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

849 (h) Whether the mark is the subject of a state  
850 registration in this state or a federal registration under the  
851 Federal Trademark Act of March 3, 1881, or the Federal Trademark  
852 Act of February 20, 1905, or a principal register registration  
853 under the Federal Trademark Act of July 5, 1946.

854 (2) In an action brought under this section, the owner of  
855 a famous mark shall be entitled only to injunctive relief in  
856 this state unless the person against whom the injunctive relief  
857 is sought willfully intended to trade on the owner's reputation  
858 or to cause dilution of the famous mark. If such willful intent  
859 is proven, and the mark is registered in this state, the owner  
860 shall also be entitled to all remedies set forth in this  
861 chapter, subject to the discretion of the court and the  
862 principles of equity.

863 (3) The following shall not be actionable under this  
864 section:

865 (a) Fair use of a famous mark by another person in  
866 comparative commercial advertising or promotion to identify the

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867 competing goods or services of the owner of the famous mark.

868 (b) Noncommercial use of the mark.

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

870 Section 18. Section 495.161, Florida Statutes, is amended  
871 to read:

872 495.161 Common-law rights.--Nothing herein shall adversely  
873 affect ~~or diminish~~ the rights or the enforcement of rights in  
874 marks acquired in good faith at any time at common law.

875 Section 19. Section 495.171, Florida Statutes, is amended  
876 to read:

877 495.171 Effective date; repeal of conflicting ~~prior~~  
878 acts.--

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

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

890 Section 20. Section 495.181, Florida Statutes, is amended  
891 to read:

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

894 495.181 Construction of chapter.--The intent of this



895 chapter is to provide a system of state trademark registration  
 896 and protection substantially consistent with the federal system  
 897 of trademark registration and protection under the Trademark Act  
 898 of 1946, as amended. To that end, the construction given the  
 899 federal act should be examined as persuasive authority for  
 900 interpreting and construing this chapter.

901 Section 21. Section 495.191, Florida Statutes, is created  
 902 to read:

903 495.191 Fees.--Filing and other applicable fees payable to  
 904 the department under this chapter shall be as follows:

- 905 (1) Application filing fee: \$87.50 per class.
- 906 (2) Renewal application fee: \$87.50 per class.
- 907 (3) Assignment filing fee: \$50 per class.
- 908 (4) Certificate of name change filing fee: \$50.
- 909 (5) Voluntary cancellation filing fee: \$50.
- 910 (6) Certificate of registration under seal: \$8.75.
- 911 (7) Certified copy of application file: \$52.50.

912 Section 22. Sections 506.06, 506.07, 506.08, 506.09,  
 913 506.11, 506.12, and 506.13, Florida Statutes, are repealed.

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