

CHAMBER ACTION

1 The Transportation & Economic Development Appropriations
2 Committee recommends the following:

3
4 **Council/Committee Substitute**

5 Remove the entire bill and insert:

6 A bill to be entitled

7 An act relating to trademarks; creating s. 495.001, F.S.;
8 providing a short title; amending s. 495.011, F.S.;
9 providing definitions; amending s. 495.021, F.S.;
10 precluding registration of certain marks; repealing s.
11 495.027, F.S., relating to reservation of a mark; amending
12 s. 495.031, F.S.; providing requirements for information
13 to be contained in an application for registration of a
14 mark; authorizing the Department of State to require
15 certain information in an application; requiring that the
16 application be signed and verified by any of certain
17 persons; requiring that the application be accompanied by
18 three specimens or facsimiles showing the mark; requiring
19 that the application be accompanied by a fee; creating s.
20 495.035, F.S.; providing filing guidelines for
21 applications; providing for disclaimers of unregistrable
22 components; providing for amendment and judicial review;
23 providing for priority of registrations; amending s.

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24 495.041, F.S.; providing that first use shall inure to the
25 benefit of the registrant or applicant under certain
26 circumstances; amending s. 495.061, F.S.; providing for
27 the issuance of a certificate of registration by the
28 department; removing a provision relating to reservation
29 of a mark; amending s. 495.071, F.S.; providing guidelines
30 for the renewal of marks; revising duration of
31 effectiveness of a registration; amending s. 495.081,
32 F.S.; providing for the assignability of marks;
33 authorizing a photocopy of an assignment to be acceptable
34 for recording; providing for change of name certificates
35 for registrants; authorizing recordation of certain
36 instruments; providing acknowledgment of recording as
37 prima facie evidence of the execution of an assignment or
38 other instrument; specifying requirements for creation and
39 perfection of security interests in marks; amending s.
40 495.091, F.S.; requiring the department to record all
41 marks registered with the state; amending s. 495.101,
42 F.S.; requiring the department to cancel certain marks;
43 amending s. 495.111, F.S., which establishes a
44 classification of goods and services; providing that a
45 single application for registration of a mark may include
46 any or all goods upon which, or services with which, the
47 mark is actually being used comprised in one or more of
48 the classes listed; amending s. 495.131, F.S.; revising
49 infringement provisions to include an element of lack of
50 consent by the registrant; conforming language; amending
51 s. 495.141, F.S.; providing additional remedies for the

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CODING: Words ~~stricken~~ are deletions; words underlined are additions.

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52 | unauthorized use of a mark; creating s. 495.145, F.S.;

53 | providing a forum for actions regarding registration;

54 | providing for service of process on nonresident

55 | registrants; amending s. 495.151, F.S.; providing for an

56 | injunction in cases of dilution of a famous mark;

57 | providing factors to be considered in determining that a

58 | mark is famous; providing damages in certain circumstances

59 | of dilution; amending s. 495.161, F.S.; deleting language

60 | relating to the diminishing of certain common law rights;

61 | amending s. 495.171, F.S.; providing effective date of

62 | changes to ch. 495, F.S., as amended by the act; providing

63 | for repeal of conflicting acts; providing application to

64 | pending actions; amending s. 495.181, F.S.; providing

65 | construction and legislative intent; creating s. 495.191,

66 | F.S.; providing certain fees; repealing s. 506.06, F.S.,

67 | relating to unlawful to counterfeit trademark, to conform;

68 | repealing s. 506.07, F.S., relating to filing of trademark

69 | or other form of advertisement for record with Department

70 | of State, to conform; repealing s. 506.08, F.S., relating

71 | to fee for filing, to conform; repealing s. 506.09, F.S.,

72 | relating to civil remedies, to conform; repealing s.

73 | 506.11, F.S., relating to unlawful use of trademark, to

74 | conform; repealing s. 506.12, F.S., relating to procuring

75 | the filing of trademark or other form of advertisement by

76 | fraudulent representations, to conform; repealing s.

77 | 506.13, F.S., relating to using the name or seal of

78 | another, to conform; providing an effective date.

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

81
82 Section 1. Section 495.001, Florida Statutes, is created
83 to read:

84 495.001 Short title.--This chapter may be cited as the
85 "Registration and Protection of Trademarks Act."

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

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

90 495.011 Definitions.--As used in this chapter:

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

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

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

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

103 (3) "Certification mark" means any word, name, symbol, or
104 device, or any combination thereof, used by a person other than
105 the owner of the mark to certify regional or other origin,
106 material, mode of manufacture, quality, accuracy, or other
107 characteristics of such person's goods or services or that the

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108 work or labor on the goods or services was performed by members
109 of a union or other organization.

110 (4) "Collective mark" means a trademark or service mark
111 used by the members of a cooperative, an association, or other
112 collective group or organization, and includes marks used to
113 indicate membership in a union, an association, or other
114 organization.

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

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

120 (a) Competition between the owner of the mark and other
121 parties.

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

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

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

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

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

140 (11) "Service mark" means any word, name, symbol, or
141 device, or any combination thereof, used by a person to identify
142 and distinguish the services of such person, including a unique
143 service, from the services of others, and to indicate the source
144 of the services, even if that source is unknown. Titles,
145 character names, and other distinctive features of radio or
146 television programs may be registered as service marks
147 notwithstanding that the person or the programs may advertise
148 the goods of the sponsor.

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

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

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

160 (a) On goods when:

161 1. The mark is placed in any manner on the goods, their
162 containers or the displays associated therewith, or on the tags
163 or labels affixed thereto, or, if the nature of the goods makes

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164 such placement impracticable, on documents associated with the
165 goods or their sale; and

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

167 (b) On services when the mark is used or displayed in the
168 sale or advertising of services and the services are rendered in
169 this state.

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

172 495.021 Registrability.--

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

176 (a) Consists of or, comprises ~~or includes~~ immoral,
177 deceptive, or scandalous matter; ~~or~~

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

182 (c) Consists of or ~~or~~ comprises ~~or includes~~ the flag or
183 coat of arms or other insignia of the United States, or of any
184 state or municipality, or of any foreign nation, or any
185 simulation thereof; ~~or~~

186 (d) Consists of or ~~or~~ comprises a ~~or includes~~ the name,
187 signature, or portrait identifying a particular ~~of any~~ living
188 individual, except by ~~with~~ her or his written consent, or the
189 name, signature, or portrait of a deceased President of the
190 United States during the lifetime of his widow or her widower,

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191 if any, except by the written consent of the widow or widower;
192 ~~or~~

193 (e) Consists of a mark which:

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

197 2. When used on or in connection with ~~applied to~~ the goods
198 or services of the applicant, is primarily geographically
199 descriptive ~~or deceptively misdescriptive~~ of them; ~~or their~~
200 ~~source or origin, or~~

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

204 ~~4.3. Is primarily merely a surname; or;~~

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

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

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

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

227 Section 5. Section 495.031, Florida Statutes, is amended
 228 to read:

229 495.031 Application for registration.--

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

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

240 (b) The goods or services on or in connection with which
 241 the mark is used and the mode or manner in which the mark is
 242 used in connection with such goods or services and the class or
 243 classes in which such goods or services fall;

244 (c) The date ~~when~~ the mark was first used anywhere and the
 245 date ~~when~~ it was first used in this state by the applicant, the

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246 applicant's ~~or her or his~~ predecessor in interest, ~~business~~ or a
247 related company of the applicant ~~or the applicant's predecessor~~;
248 and

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

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

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

264 (b) The date when the certification mark was first used
265 anywhere and the date when it was first used in this state under
266 the authority of the applicant;

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

269 (d) A statement that the applicant is exercising control
270 over the use of the mark, that the applicant is not herself or
271 himself engaged in the production or marketing of the goods or
272 services to which the mark is applied, and that no person except
273 the applicant or persons authorized by the applicant, or related

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274 | companies thereof, has the right to use such mark in this state,
 275 | either in the identical form thereof or in such near resemblance
 276 | thereto as to be likely, when applied to the goods or services
 277 | of such other person, to cause confusion, to cause mistake, or
 278 | to deceive or confuse or to be mistaken therefor.

279 | (3) Every applicant for registration of a collective mark
 280 | in this state shall file with the department ~~of State~~, in a
 281 | manner and on a form complying with the requirements of to be
 282 | ~~furnished by~~ the department, an application setting forth, but
 283 | not limited to, the following information:

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

285 | (b) The date when the collective mark was first used
 286 | anywhere and the date when it was first used in this state by
 287 | any member of the applicant or a related company of such member;

288 | (c) The class of persons entitled to use the mark,
 289 | indicating their relationship to the applicant, and the nature
 290 | of the applicant's control over the use of the mark; and

291 | (d) A statement that no person except the applicant or
 292 | members of the applicant, or related companies thereof, has the
 293 | right to use such mark in this state, either in the identical
 294 | form thereof or in such near resemblance thereto as to be
 295 | likely, when applied to the goods or services of such other
 296 | person, to cause confusion, to cause mistake, or to deceive or
 297 | ~~confuse or to be mistaken therefor.~~

298 | (4) The department may also require that a drawing of the
 299 | mark, complying with the requirements of the department,
 300 | accompany the application.

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301 ~~(5)~~(4) Every application under this section shall be
302 signed and verified by the applicant or by a member of the firm
303 or an officer or other authorized representative of the business
304 entity of the corporation, association, union or other
305 organization applying.

306 ~~(6)~~(5) Every application under this section shall be
307 accompanied by three specimens or facsimiles showing the mark as
308 actually used ~~a specimen or facsimile of such mark in~~
309 ~~triplicate.~~

310 ~~(7)~~(6) Every application under this section shall be
311 accompanied by a filing fee ~~of \$87.50,~~ payable to the department
312 in accordance with s. 495.191 of State, for each class of goods
313 ~~or services as specified in s. 495.111, in connection with which~~
314 ~~the mark is used.~~

315 Section 6. Section 495.035, Florida Statutes, is created
316 to read:

317 495.035 Filing of applications.--

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

321 (2) The applicant shall provide any additional pertinent
322 information requested by the department, including a description
323 of a design mark, and may make, or authorize the department to
324 make, such amendments to the application as may be reasonably
325 requested by the department or deemed by applicant to be
326 advisable to respond to any rejection or objection.

327 (3) The department may require the applicant to disclaim
328 an unregistrable component of a mark otherwise registrable, and

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329 an applicant may voluntarily disclaim a component of a mark
330 sought to be registered. No disclaimer shall prejudice or affect
331 the applicant's or registrant's rights then existing or
332 thereafter arising in the disclaimed matter, or the applicant's
333 or registrant's rights of registration on another application,
334 if the disclaimed matter is or has become distinctive of the
335 applicant's or registrant's goods or services.

336 (4) Amendments may be made by the department upon the
337 application submitted by the applicant upon the applicant's
338 agreement, or a new application may be required to be submitted.
339 Amendments to an otherwise properly filed application shall not
340 affect the application filing date for purposes of determining
341 the applicant's or registrant's filing priority rights.

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

348 (a) The department makes final its refusal to register the
349 mark; or

350 (b) The applicant fails to reply or amend the application
351 within the specified period, whereupon the application shall be
352 abandoned.

353
354 For good cause shown, such as the pendency of litigation
355 involving the mark, the department may extend the period of time

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356 in which to respond to the rejection or suspend examination of
357 the application.

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

361 (7) In the event of multiple applications concurrently
362 being processed by the department which seek registration of the
363 same or confusingly similar marks for the same or related goods
364 or services, the department shall grant priority to the
365 applications in order of receipt. If a prior-received
366 application is granted a registration, the other application or
367 applications shall then be rejected. The applicant of a rejected
368 application may bring an action for cancellation of the
369 registration upon grounds of prior or superior rights to the
370 mark, in accordance with the provisions of s. 495.101(3).

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

373 495.041 Use by related companies.--Where a mark registered
374 or unregistered is or may be used legitimately by related
375 companies, such use shall inure to the benefit of the owner of
376 the mark, and such use shall not affect the validity of such
377 mark or of its registration, provided such mark is not used in
378 such manner as to deceive the public. If first use of a mark by
379 a person is controlled by the registrant or applicant for
380 registration of a mark with respect to the nature and quality of
381 the goods or services, such first use shall inure to the benefit
382 of that registrant or applicant, as the case may be.

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383 Section 8. Section 495.061, Florida Statutes, is amended
384 to read:

385 495.061 Certificate of registration.--

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

400 (2) Any certificate of registration issued by the
401 department ~~of State~~ under the provisions hereof or a copy
402 thereof duly certified by the department ~~of State~~ shall be
403 admissible in evidence as competent and sufficient proof of the
404 registration of such mark in any action or judicial proceedings
405 in any court of this state, and shall be prima facie evidence of
406 the validity of the registration, registrant's ownership of the
407 mark, and of registrant's exclusive right to use the mark in
408 this state on or in connection with the goods or services
409 specified in the certificate, subject to any conditions and
410 limitations stated therein.

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411 ~~(3) Contingent on the registration of a mark under this~~
412 ~~chapter, the reservation of such mark based on intent to use, as~~
413 ~~provided in this chapter, shall be prima facie evidence of~~
414 ~~priority of ownership of such mark within this state on or in~~
415 ~~connection with the goods or services specified in the~~
416 ~~reservation against any other person, except for a person whose~~
417 ~~mark has not been abandoned and who, prior to such reservation,~~
418 ~~has used the mark within this state on or in connection with~~
419 ~~such goods or services.~~

420 Section 9. Section 495.071, Florida Statutes, is amended
421 to read:

422 495.071 Duration and renewal.--

423 (1) Registration of a mark hereunder shall be effective
424 for a term of 5 ~~10~~ years from the date of registration and, upon
425 application filed within 6 months prior to the expiration of
426 such term, in a manner and form complying with the requirements
427 of ~~on a form to be furnished by~~ the department ~~of State~~, the
428 registration may be renewed for a like term beginning at the end
429 of the expiring term. Every application under this section shall
430 be accompanied by a filing fee ~~A renewal fee of \$87.50 for each~~
431 ~~class of goods or services with respect to which such renewal is~~
432 ~~sought~~, payable to the department in accordance with s. 495.191
433 ~~of State, shall accompany the application for renewal of the~~
434 ~~registration.~~

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

437 (3) Any registration in effect on January 1, 2007, shall
438 continue in effect for the unexpired term thereof and may be

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439 renewed by filing an application for renewal with the department
 440 in a manner and form complying with the requirements of the
 441 department and paying the renewal fee therefor within 6 months
 442 prior to the expiration of the registration. ~~The Department of~~
 443 ~~State shall notify registrants of marks hereunder of the~~
 444 ~~necessity of renewal within the year next preceding the~~
 445 ~~expiration of the 10 years from the date of registration by~~
 446 ~~writing to the last known address of the registrants. The~~
 447 ~~department shall prescribe the forms on which to make the~~
 448 ~~required notification and the renewal called for in subsection~~
 449 ~~(1) and may substitute the uniform business report, pursuant to~~
 450 ~~s. 606.06, as a means of satisfying the requirement of this~~
 451 ~~part.~~

452 (4) All applications for renewal ~~renewals~~ under this
 453 chapter, whether of registrations made under this act or of
 454 registrations made under any prior acts, shall include a
 455 verified statement that the mark is still in use in this state,
 456 and shall include a specimen showing actual use of the mark on
 457 or in connection with the goods or services subject to the
 458 renewal application, or shall state that its nonuse is due to
 459 special circumstances which excuse such nonuse and is not due to
 460 any intention to abandon the mark.

461 Section 10. Section 495.081, Florida Statutes, is amended
 462 to read:

463 495.081 Assignments; changes of name; security interests
 464 ~~Assignment.~~ --

465 (1) A registered mark or a mark for which an application
 466 for registration has been filed ~~Any mark and its registration~~

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467 ~~hereunder~~ shall be assignable with the goodwill ~~good will~~ of the
468 business in which the mark is used or with that part of the
469 goodwill ~~good will~~ of the business connected with the use of and
470 symbolized by the mark. ~~Assignments~~ Assignment shall be by an
471 instrument ~~instruments~~ in writing duly executed and may be
472 recorded with the department ~~of State~~ upon the payment of the
473 applicable a fee. A photocopy of an assignment shall be accepted
474 for recording if it is certified by any of the parties thereto,
475 or their successors, to be a true and correct copy of the
476 original. Upon recording of the assignment, of \$50, payable to
477 the department of State which, upon recording of the assignment,
478 shall issue in the name of the assignee a new certificate for
479 the remainder of the term of the registration or of the last
480 renewal thereof.

481 (2) An assignment of any registration under this chapter
482 shall be void ~~as~~ against any subsequent purchaser for valuable
483 consideration without notice, unless such assignment is recorded
484 with the department ~~of State~~ within 3 months after the date of
485 the assignment or prior to the subsequent purchase thereof or at
486 any time after the expiration of such 3 month period, unless an
487 assignment given in connection with any subsequent purchase is
488 recorded with the Department of State prior to or within 10 days
489 after such assignment is recorded.

490 (3) A registrant or applicant for registration effecting a
491 change of the name may record a certificate of change of name of
492 the registrant or applicant with the department upon the payment
493 of the recording fee payable to the department in accordance
494 with s. 495.191. In the case of a pending application for a mark

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495 that becomes approved for registration, the department shall
 496 issue a certificate of registration in the registrant's new
 497 name. In the case of a registered mark, the department shall
 498 issue a new certificate of registration in the registrant's new
 499 name for the remainder of the term of the registration or last
 500 renewal thereof. A person's failure to record a name change in
 501 accordance with this subsection shall not affect the person's
 502 substantive rights in the mark or its registration.

503 (4) Acknowledgment shall be prima facie evidence of the
 504 execution of an assignment or other instrument and, when
 505 recorded by the department, the record shall be prima facie
 506 evidence of execution.

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

509 Section 11. Section 495.091, Florida Statutes, is amended
 510 to read:

511 495.091 Records.--The department ~~of State~~ shall keep for
 512 public examination a record of all marks registered or renewed
 513 under this chapter, including all documents recorded under s.
 514 495.081.

515 Section 12. Section 495.101, Florida Statutes, is amended
 516 to read:

517 495.101 Cancellation.--The department ~~of State~~ shall
 518 cancel from the register:

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

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522 (1)-(2) Any registration for concerning which the
523 department ~~of State has received~~ shall receive a voluntary
524 request for cancellation by the registrant, which request shall
525 be in a manner and form complying with the requirements of the
526 department thereof from the registrant.

527 (2)-(3) All registrations granted under this chapter and
528 not renewed in accordance with the provisions hereof.

529 (3)-(4) Any registration for concerning which a court of
530 competent jurisdiction finds ~~shall find~~ that:

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

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

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

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

545 (c) The registration was granted improperly.

546 (d) The registration was obtained fraudulently.

547 (e) The mark is or has become the generic name for the
548 goods or services, or a portion thereof, for which the mark has
549 been registered.

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550 ~~(f)(e)~~ The registered mark is so similar, as to be likely
551 to cause confusion or mistake or to deceive, to a mark
552 registered by another person in the United States Patent and
553 Trademark Office, prior to the date of the filing of the
554 application for registration by the registrant hereunder, and
555 not abandoned; ~~provided, however, that~~ should the registrant
556 prove that the registrant ~~she or he~~ is the owner of a concurrent
557 registration of a her or his mark in the United States Patent
558 and Trademark Office covering an area including this state, the
559 registration hereunder shall not be canceled.

560 ~~(g)(f)~~ In the case of a certification mark, that the
561 registrant does not control or is not able to exercise control
562 over the use of such mark; or engages in the production or
563 marketing of any goods or services to which the certification
564 mark is applied; or the registrant permits the use of the
565 certification mark for purposes other than to certify; or the
566 registrant discriminately refuses ~~refused~~ to certify or ~~to~~
567 continue to certify the goods or services of any person who
568 maintains the standards or conditions which such mark certifies.
569 Nothing in this paragraph shall be deemed to prohibit the
570 registrant from using its certification mark in advertising or
571 promoting recognition of the certification program or of the
572 goods or services meeting the certification standards of the
573 registrant.

574 ~~(4)(5)~~ When a court of competent jurisdiction shall order
575 cancellation of a registration on any ground.

576 Section 13. Section 495.111, Florida Statutes, is amended
577 to read:

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

580 495.111 Classification.--

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

585 (a) Goods:

586 1. Class 1 Chemicals used in industry, science, and
587 photography; agriculture, horticulture, and forestry;
588 unprocessed artificial resins and, unprocessed plastics;
589 manures; fire extinguishing compositions; tempering and
590 soldering preparations; chemical substances for preserving
591 foodstuffs; tanning substances; and adhesives used in industry.

592 2. Class 2 Paints, varnishes, lacquers; preservatives
593 against rust and against deterioration of wood; colorants;
594 mordants; raw natural resins; and metals in foil and powder form
595 for painters, decorators, printers, and artists.

596 3. Class 3 Bleaching preparations and other substances
597 for laundry use; cleaning, polishing, scouring, and abrasive
598 preparations; soaps; perfumery, essential oils, cosmetics, and
599 hair lotions; and dentifrices.

600 4. Class 4 Industrial oils and greases; lubricants; dust
601 absorbing, wetting, and binding compositions; fuels (including
602 motor spirit) and illuminants; and candles and wicks for
603 lighting.

604 5. Class 5 Pharmaceuticals and veterinary preparations;
605 sanitary preparations for medical purposes; dietetic substances

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606 adapted for medical use and food for babies; plasters and
607 materials for dressings; material for stopping teeth and dental
608 wax; disinfectants; preparations for destroying vermin; and
609 fungicides and herbicides.

610 6. Class 6 Common metals and their alloys; metal building
611 materials; transportable buildings of metal; materials of metal
612 for railway tracks; nonelectric cables and wires of common
613 metal; ironmongery and small items of metal hardware; pipes and
614 tubes of metal; safes; goods of common metal not included in
615 other classes; and ores.

616 7. Class 7 Machines and machine tools; motors and engines
617 (except for land vehicles); machine coupling and transmission
618 components (except for land vehicles); agricultural implements
619 other than hand-operated; incubators for eggs.

620 8. Class 8 Hand tools and hand-operated implements;
621 cutlery; side arms; and razors.

622 9. Class 9 Scientific, nautical, surveying, photographic,
623 cinematographic, optical, weighing, measuring, signaling,
624 checking (supervision), and life-saving and teaching apparatus
625 and instruments; apparatus and instruments for conducting,
626 switching, transforming, accumulating, regulating, or
627 controlling electricity; apparatus for recording, transmission,
628 or reproduction of sound or images; magnetic data carriers and
629 recording discs; automatic vending machines and mechanisms for
630 coin-operated apparatus; cash registers, calculating machines,
631 and data processing equipment and computers; and fire-
632 extinguishing apparatus.

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633 10. Class 10 Surgical, medical, dental, and veterinary
634 apparatus and instruments, artificial limbs, eyes, and teeth;
635 orthopedic articles; and suture materials.

636 11. Class 11 Apparatus for lighting, heating, steam
637 generating, cooking, refrigerating, drying, ventilating, water
638 supply, and sanitary purposes.

639 12. Class 12 Vehicles; apparatus for locomotion by land,
640 air, or water.

641 13. Class 13 Firearms; ammunition and projectiles;
642 explosives; and fireworks.

643 14. Class 14 Precious metals and their alloys and goods
644 in precious metals or coated therewith (not included in other
645 classes); jewelry and precious stones; and horological and
646 chronometric instruments.

647 15. Class 15 Musical instruments.

648 16. Class 16 Paper, cardboard, and goods made from these
649 materials (not included in other classes); printed matter;
650 bookbinding material; photographs; stationery; adhesives for
651 stationery or household purposes; artists' materials; paint
652 brushes; typewriters and office requisites (except furniture);
653 instructional and teaching material (except apparatus); plastic
654 materials for packaging (not included in other classes);
655 printers' type; and printing blocks.

656 17. Class 17 Rubber, gutta-percha, gum, asbestos, mica,
657 and goods made from these materials and not included in other
658 classes; plastics in extruded form for use in manufacture;
659 packing, stopping, and insulating materials; and flexible pipes
660 not of metal.

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

665 19. Class 19 Building materials (nonmetallic);
666 nonmetallic rigid pipes for building; asphalt, pitch, and
667 bitumen; nonmetallic transportable buildings; monuments, not of
668 metal.

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

674 21. Class 21 Household or kitchen utensils and containers
675 (not of precious metal or coated therewith); combs and sponges;
676 brushes (except paint brushes); brush-making materials; articles
677 for cleaning purposes; steel wool; unworked or semiworked glass
678 (except glass used in building); and glassware, porcelain, and
679 earthenware not included in other classes.

680 22. Class 22 Ropes, string, nets, tents, awnings,
681 tarpsaulins, sails, sacks, and bags (not included in other
682 classes); padding and stuffing materials (except of rubber or
683 plastics); and raw fibrous textile materials.

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

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

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

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688 26. Class 26 Lace and embroidery, ribbons, and braid;
689 buttons, hooks and eyes, pins, and needles; and artificial
690 flowers.

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

694 28. Class 28 Games and playthings; gymnastic and sporting
695 articles not included in other classes; and decorations for
696 Christmas trees.

697 29. Class 29 Meat, fish, poultry, and game; meat
698 extracts; preserved, dried, and cooked fruits and vegetables;
699 jellies, jams, and compotes; eggs, milk, and milk products; and
700 edible oils and fats.

701 30. Class 30 Coffee, tea, cocoa, sugar, rice, tapioca,
702 sago, and artificial coffee; flour and preparations made from
703 cereals, bread, pastry and confectionery, and ices; honey and
704 treacle; yeast, baking powder; salt, and mustard; vinegar and
705 saucers (condiments); spices; and ice.

706 31. Class 31 Agricultural, horticultural, and forestry
707 products and grains not included in other classes; live animals;
708 fresh fruits and vegetables; seeds, natural plants, and flowers;
709 foodstuffs for animals and malt.

710 32. Class 32 Beers; mineral and aerated waters and other
711 nonalcoholic drinks; fruit drinks and fruit juices; and syrups
712 and other preparations for making beverages.

713 33. Class 33 Alcoholic beverages except beers.

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

715 (b) Services:

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- 716 1. Class 35 Advertising; business management; business
 717 administration; and office functions.
- 718 2. Class 36 Insurance; financial affairs; monetary
 719 affairs; and real estate affairs.
- 720 3. Class 37 Building construction; repair; and
 721 installation services.
- 722 4. Class 38 Telecommunications.
- 723 5. Class 39 Transport; packaging and storage of goods;
 724 and travel arrangements.
- 725 6. Class 40 Treatment of materials.
- 726 7. Class 41 Education; providing of training;
 727 entertainment; and sporting and cultural activities.
- 728 8. Class 42 Scientific and technological services and
 729 research and design relating thereto; industrial analysis and
 730 research services; design and development of computer hardware
 731 and software; and legal services.
- 732 9. Class 43 Services for providing food and drink; and
 733 temporary accommodation.
- 734 10. Class 44 Medical services; veterinary services;
 735 hygienic and beauty care for human beings or animals; and
 736 agriculture, horticulture, and forestry services.
- 737 11. Class 45 Personal and social services rendered by
 738 others to meet the needs of individuals; and security services
 739 for the protection of property and individuals.
- 740 (c) Certification and collective membership marks:
- 741 1. Class 200 Collective membership marks.
- 742 2. Class A Certification marks for goods.
- 743 3. Class B Certification marks for services.

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744 (d) The goods and services recited in collective trademark
 745 and collective service mark applications are assigned to the
 746 same classes that are appropriate for those goods and services
 747 in general.

748 (2) The establishment of the classes of goods and services
 749 set forth in subsection (1) is not for the purpose of limiting
 750 or extending the rights of the applicant or registrant. A single
 751 application for registration of a mark may include any or all
 752 goods upon which, or services with which, the mark is actually
 753 being used comprised in one or more of the classes listed, but
 754 in the event that a single application includes goods or
 755 services in connection with which the mark is being used which
 756 fall within different classes of goods or services, a fee
 757 equaling the sum of the fees for registration in each class
 758 shall be payable.

759 Section 14. Section 495.131, Florida Statutes, is amended
 760 to read:

761 495.131 Infringement.--Subject to the provisions of s.
 762 495.161, any person who shall, without the consent of the
 763 registrant:

764 ~~(1) Use, without the consent of the registrant, any~~
 765 ~~reproduction, counterfeit, copy, or colorable imitation of a~~
 766 ~~mark registered under this chapter ~~on any goods or~~ in connection~~
 767 ~~with the sale, offering for sale, distribution, or advertising~~
 768 ~~of any goods or services on or in connection with which such use~~
 769 ~~is likely to cause confusion, ~~or~~ to cause mistake, or to deceive~~
 770 ~~as to the source or origin of such goods or services; or~~

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771 (2) Reproduce, counterfeit, copy, or colorably imitate a
772 ~~any such~~ mark registered under this chapter and apply such
773 reproduction, counterfeit, copy, or colorable imitation to
774 labels, signs, prints, packages, wrappers, receptacles, or
775 advertisements intended to be used upon or in connection
776 ~~conjunction~~ with the sale, ~~offering for sale,~~ distribution, or
777 advertising ~~in this state~~ of goods or services on or in
778 connection with which such use is likely to cause confusion, to
779 cause mistake, or to deceive;

780
781 shall be liable in a civil action by the owner of such
782 registered mark for any or all of the remedies provided in s.
783 495.141, except that under subsection (2) hereof the registrant
784 shall not be entitled to recover profits or damages unless the
785 acts have been committed with knowledge that such mark is
786 intended to be used to cause confusion or mistake or to deceive.

787 Section 15. Section 495.141, Florida Statutes, is amended
788 to read:

789 495.141 Remedies.--

790 (1) Any owner of a mark registered under this chapter may
791 proceed by suit to enjoin the manufacture, use, display, or sale
792 of any counterfeits or imitations thereof and any court of
793 competent jurisdiction may grant injunctions to restrain such
794 manufacture, use, display or sale as may be by the said court
795 deemed just and reasonable, and may require the defendants to
796 pay to such owner all profits derived from and/or all damages
797 suffered by reason of such wrongful manufacture, use, display,
798 or sale and to pay the costs of the action; and such court may

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799 also order that any such counterfeits or imitations in the
800 possession or under the control of any defendant in such case be
801 delivered to an officer of the court, or to the complainant, to
802 be destroyed. In assessing profits the plaintiff shall be
803 required to prove defendant's sales only; defendant must prove
804 all elements of cost or deduction claimed. In assessing damages
805 the court may enter judgment, according to the circumstances of
806 the case, for any sum above the amount found as actual damages,
807 not exceeding three ~~3~~ times such amount. If the court shall find
808 that the amount of the recovery based on profits is either
809 inadequate or excessive the court may in its discretion enter
810 judgment for such sum as the court shall find to be just,
811 according to the circumstances of the case. Such sum in either
812 of the above circumstances shall constitute compensation and not
813 a penalty. The court may also award reasonable attorney's fees
814 to the prevailing party according to the circumstances of the
815 case.

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

819 Section 16. Section 495.145, Florida Statutes, is created
820 to read:

821 495.145 Forum for actions regarding registration.--An
822 action seeking cancellation of a registration of a mark
823 registered under this chapter may be brought in any court of
824 competent jurisdiction in this state. Service of process on a
825 nonresident registrant may be made in accordance with s. 48.181.

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826 The department shall not be made a party to cancellation
827 proceedings.

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

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

832 495.151 Dilution.--

833 (1) The owner of a mark that is famous in this state shall
834 be entitled, subject to the principles of equity and upon such
835 terms as the court deems reasonable, to an injunction and to
836 obtain such other relief against another person's commercial use
837 of a mark or trade name if such use begins after the mark has
838 become famous and is likely to cause dilution of the distinctive
839 quality of the famous mark, as provided in this section. In
840 determining whether a mark is distinctive and famous, a court
841 may consider factors, including, but not limited to:

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

844 (b) The duration and extent of use of the mark in
845 connection with the goods and services with which the mark is
846 used.

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

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

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

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

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

858 (h) Whether the mark is the subject of a state
859 registration in this state or a federal registration under the
860 Federal Trademark Act of March 3, 1881, or the Federal Trademark
861 Act of February 20, 1905, or a principal register registration
862 under the Federal Trademark Act of July 5, 1946.

863 (2) In an action brought under this section, the owner of
864 a famous mark shall be entitled only to injunctive relief in
865 this state unless the person against whom the injunctive relief
866 is sought willfully intended to trade on the owner's reputation
867 or to cause dilution of the famous mark. If such willful intent
868 is proven, and the mark is registered in this state, the owner
869 shall also be entitled to all remedies set forth in this
870 chapter, subject to the discretion of the court and the
871 principles of equity.

872 (3) The following shall not be actionable under this
873 section:

874 (a) Fair use of a famous mark by another person in
875 comparative commercial advertising or promotion to identify the
876 competing goods or services of the owner of the famous mark.

877 (b) Noncommercial use of the mark.

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

879 Section 18. Section 495.161, Florida Statutes, is amended
880 to read:

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881 495.161 Common-law rights.--Nothing herein shall adversely
882 affect ~~or diminish~~ the rights or the enforcement of rights in
883 marks acquired in good faith at any time at common law.

884 Section 19. Section 495.171, Florida Statutes, is amended
885 to read:

886 495.171 Effective date; repeal of conflicting ~~prior~~
887 acts.--

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

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

899 Section 20. Section 495.181, Florida Statutes, is amended
900 to read:

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

903 495.181 Construction of chapter.--The intent of this
904 chapter is to provide a system of state trademark registration
905 and protection substantially consistent with the federal system
906 of trademark registration and protection under the Trademark Act
907 of 1946, as amended. To that end, the construction given the

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908 | federal act should be examined as persuasive authority for
 909 | interpreting and construing this chapter.

910 | Section 21. Section 495.191, Florida Statutes, is created
 911 | to read:

912 | 495.191 Fees.--Filing and other applicable fees payable to
 913 | the department under this chapter shall be as follows:

- 914 | (1) Application filing fee: \$87.50 per class.
- 915 | (2) Renewal application fee: \$87.50 per class.
- 916 | (3) Assignment filing fee: \$50 per class.
- 917 | (4) Certificate of name change filing fee: \$50.
- 918 | (5) Voluntary cancellation filing fee: \$50.
- 919 | (6) Certificate of registration under seal: \$8.75.
- 920 | (7) Certified copy of application file: \$52.50.

921 | Section 22. Sections 506.06, 506.07, 506.08, 506.09,
 922 | 506.11, 506.12, and 506.13, Florida Statutes, are repealed.

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