

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 or facsimiles showing the mark; requiring
14 that the application be accompanied by a fee; creating s.
15 495.035, F.S.; providing filing guidelines for
16 applications; providing for disclaimers of unregistrable
17 components; providing for amendment and judicial review;
18 providing for priority of registrations; amending s.
19 495.041, F.S.; providing that first use shall inure to the
20 benefit of the registrant or applicant under certain
21 circumstances; amending s. 495.061, F.S.; providing for
22 the issuance of a certificate of registration by the
23 department; removing a provision relating to reservation
24 of a mark; amending s. 495.071, F.S.; providing guidelines
25 for the renewal of marks; revising duration of
26 effectiveness of a registration; amending s. 495.081,
27 F.S.; providing for the assignability of marks;

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

55 relating to the diminishing of certain common law rights;
56 amending s. 495.171, F.S.; providing effective date of
57 changes to ch. 495, F.S., as amended by the act; providing
58 for repeal of conflicting acts; providing application to
59 pending actions; amending s. 495.181, F.S.; providing
60 construction and legislative intent; creating s. 495.191,
61 F.S.; providing certain fees; repealing s. 506.06, F.S.,
62 relating to unlawful to counterfeit trademark, to conform;
63 repealing s. 506.07, F.S., relating to filing of trademark
64 or other form of advertisement for record with Department
65 of State, to conform; repealing s. 506.08, F.S., relating
66 to fee for filing, to conform; repealing s. 506.09, F.S.,
67 relating to civil remedies, to conform; repealing s.
68 506.11, F.S., relating to unlawful use of trademark, to
69 conform; repealing s. 506.12, F.S., relating to procuring
70 the 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
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 is 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
 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 ~~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 ~~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 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 them; ~~or their~~
 195 ~~source or origin, or~~

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

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.~~

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

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

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

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

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

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

293 | (4) The department may also require that a drawing of the
294 | mark, complying with the requirements of the department,
295 | accompany the application.

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

301 ~~(6)-(5)~~ Every application under this section shall be
 302 accompanied by three specimens or facsimiles showing the mark as
 303 actually used ~~a specimen or facsimile of such mark in~~
 304 ~~triplicate.~~

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

310 Section 6. Section 495.035, Florida Statutes, is created
 311 to read:

312 495.035 Filing of applications.--

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

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

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

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

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

343 (a) The department makes final its refusal to register the
344 mark; or

345 (b) The applicant fails to reply or amend the application
346 within the specified period, whereupon the application shall be
347 abandoned.

348

349 For good cause shown, such as the pendency of litigation
350 involving the mark, the department may extend the period of time
351 in which to respond to the rejection or suspend examination of
352 the application.

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

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

366 Section 7. Section 495.041, Florida Statutes, is amended
367 to read:

368 495.041 Use by related companies.--Where a mark registered
369 or unregistered is or may be used legitimately by related
370 companies, such use shall inure to the benefit of the owner of
371 the mark, and such use shall not affect the validity of such
372 mark or of its registration, provided such mark is not used in
373 such manner as to deceive the public. If first use of a mark by
374 a person is controlled by the registrant or applicant for
375 registration of a mark with respect to the nature and quality of

376 | the goods or services, such first use shall inure to the benefit
377 | of that registrant or applicant, as the case may be.

378 | Section 8. Section 495.061, Florida Statutes, is amended
379 | to read:

380 | 495.061 Certificate of registration.--

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

395 | (2) Any certificate of registration issued by the
396 | department ~~of State~~ under the provisions hereof or a copy
397 | thereof duly certified by the department ~~of State~~ shall be
398 | admissible in evidence as competent and sufficient proof of the
399 | registration of such mark in any action or judicial proceedings
400 | in any court of this state, and shall be prima facie evidence of
401 | the validity of the registration, registrant's ownership of the
402 | mark, and of registrant's exclusive right to use the mark in

403 | this state on or in connection with the goods or services
 404 | specified in the certificate, subject to any conditions and
 405 | limitations stated therein.

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

415 | Section 9. Section 495.071, Florida Statutes, is amended
 416 | to read:

417 | 495.071 Duration and renewal.--

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

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

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

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

456 Section 10. Section 495.081, Florida Statutes, is amended
457 to read:

458 495.081 Assignments; changes of name; security interests
459 Assignment.--

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

476 (2) An assignment of any registration under this chapter
477 ~~shall be void as~~ against any subsequent purchaser for valuable
478 consideration without notice, unless such assignment is recorded
479 with the department ~~of State~~ within 3 months after the date of
480 the assignment or prior to the subsequent purchase thereof or at
481 ~~any time after the expiration of such 3 month period, unless an~~
482 ~~assignment given in connection with any subsequent purchase is~~

483 ~~recorded with the Department of State prior to or within 10 days~~
484 ~~after such assignment is recorded.~~

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

498 (4) Acknowledgment shall be prima facie evidence of the
499 execution of an assignment or other instrument and, when
500 recorded by the department, the record shall be prima facie
501 evidence of execution.

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

504 Section 11. Section 495.091, Florida Statutes, is amended
505 to read:

506 495.091 Records.--The department ~~of State~~ shall keep for
507 public examination a record of all marks registered or renewed
508 under this chapter, including all documents recorded under s.
509 495.081.

510 Section 12. Section 495.101, Florida Statutes, is amended
 511 to read:

512 495.101 Cancellation.--The department ~~of State~~ shall
 513 cancel from the register:

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

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

522 (2)(3) All registrations granted under this chapter and
 523 not renewed in accordance with the provisions hereof.

524 (3)(4) Any registration for concerning which a court of
 525 competent jurisdiction finds shall find that:

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

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

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

536 | ~~mark. Purchaser motivation shall not be a test for determining~~
537 | ~~abandonment under this paragraph.~~

538 | (b) The registrant ~~of a trademark or service mark~~ is not
539 | the owner of the mark.

540 | (c) The registration was granted improperly.

541 | (d) The registration was obtained fraudulently.

542 | (e) The mark is or has become the generic name for the
543 | goods or services, or a portion thereof, for which the mark has
544 | been registered.

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

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

563 maintains the standards or conditions which such mark certifies.
 564 Nothing in this paragraph shall be deemed to prohibit the
 565 registrant from using its certification mark in advertising or
 566 promoting recognition of the certification program or of the
 567 goods or services meeting the certification standards of the
 568 registrant.

569 (4)(5) When a court of competent jurisdiction shall order
 570 cancellation of a registration on any ground.

571 Section 13. Section 495.111, Florida Statutes, is amended
 572 to read:

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

575 495.111 Classification.--

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

580 (a) Goods:

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

587 2. Class 2 Paints, varnishes, lacquers; preservatives
 588 against rust and against deterioration of wood; colorants;

589 mordants; raw natural resins; and metals in foil and powder form
590 for painters, decorators, printers, and artists.

591 3. Class 3 Bleaching preparations and other substances
592 for laundry use; cleaning, polishing, scouring, and abrasive
593 preparations; soaps; perfumery, essential oils, cosmetics, and
594 hair lotions; and dentifrices.

595 4. Class 4 Industrial oils and greases; lubricants; dust
596 absorbing, wetting, and binding compositions; fuels (including
597 motor spirit) and illuminants; and candles and wicks for
598 lighting.

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

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

611 7. Class 7 Machines and machine tools; motors and engines
612 (except for land vehicles); machine coupling and transmission
613 components (except for land vehicles); agricultural implements
614 other than hand-operated; incubators for eggs.

615 8. Class 8 Hand tools and hand-operated implements;
616 cutlery; side arms; and razors.

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

628 10. Class 10 Surgical, medical, dental, and veterinary
629 apparatus and instruments, artificial limbs, eyes, and teeth;
630 orthopedic articles; and suture materials.

631 11. Class 11 Apparatus for lighting, heating, steam
632 generating, cooking, refrigerating, drying, ventilating, water
633 supply, and sanitary purposes.

634 12. Class 12 Vehicles; apparatus for locomotion by land,
635 air, or water.

636 13. Class 13 Firearms; ammunition and projectiles;
637 explosives; and fireworks.

638 14. Class 14 Precious metals and their alloys and goods
639 in precious metals or coated therewith (not included in other
640 classes); jewelry and precious stones; and horological and
641 chronometric instruments.

642 15. Class 15 Musical instruments.

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

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

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

660 19. Class 19 Building materials (nonmetallic);
661 nonmetallic rigid pipes for building; asphalt, pitch, and
662 bitumen; nonmetallic transportable buildings; monuments, not of
663 metal.

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

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

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

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

680 24. Class 24 Textiles and textile goods not included in
681 other classes and bed and table covers.

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

683 26. Class 26 Lace and embroidery, ribbons, and braid;
684 buttons, hooks and eyes, pins, and needles; and artificial
685 flowers.

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

689 28. Class 28 Games and playthings; gymnastic and sporting
690 articles not included in other classes; and decorations for
691 Christmas trees.

692 29. Class 29 Meat, fish, poultry, and game; meat
693 extracts; preserved, dried, and cooked fruits and vegetables;
694 jellies, jams, and compotes; eggs, milk, and milk products; and
695 edible oils and fats.

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

701 31. Class 31 Agricultural, horticultural, and forestry
 702 products and grains not included in other classes; live animals;
 703 fresh fruits and vegetables; seeds, natural plants, and flowers;
 704 foodstuffs for animals and malt.

705 32. Class 32 Beers; mineral and aerated waters and other
 706 nonalcoholic drinks; fruit drinks and fruit juices; and syrups
 707 and other preparations for making beverages.

708 33. Class 33 Alcoholic beverages except beers.

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

710 (b) Services:

711 1. Class 35 Advertising; business management; business
 712 administration; and office functions.

713 2. Class 36 Insurance; financial affairs; monetary
 714 affairs; and real estate affairs.

715 3. Class 37 Building construction; repair; and
 716 installation services.

717 4. Class 38 Telecommunications.

718 5. Class 39 Transport; packaging and storage of goods;
 719 and travel arrangements.

720 6. Class 40 Treatment of materials.

721 7. Class 41 Education; providing of training;
 722 entertainment; and sporting and cultural activities.

723 8. Class 42 Scientific and technological services and
724 research and design relating thereto; industrial analysis and
725 research services; design and development of computer hardware
726 and software; and legal services.

727 9. Class 43 Services for providing food and drink; and
728 temporary accommodation.

729 10. Class 44 Medical services; veterinary services;
730 hygienic and beauty care for human beings or animals; and
731 agriculture, horticulture, and forestry services.

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

735 (c) Certification and collective membership marks:

736 1. Class 200 Collective membership marks.

737 2. Class A Certification marks for goods.

738 3. Class B Certification marks for services.

739 (d) The goods and services recited in collective trademark
740 and collective service mark applications are assigned to the
741 same classes that are appropriate for those goods and services
742 in general.

743 (2) The establishment of the classes of goods and services
744 set forth in subsection (1) is not for the purpose of limiting
745 or extending the rights of the applicant or registrant. A single
746 application for registration of a mark may include any or all
747 goods upon which, or services with which, the mark is actually
748 being used comprised in one or more of the classes listed, but
749 in the event that a single application includes goods or

750 services in connection with which the mark is being used which
751 fall within different classes of goods or services, a fee
752 equaling the sum of the fees for registration in each class
753 shall be payable.

754 Section 14. Section 495.131, Florida Statutes, is amended
755 to read:

756 495.131 Infringement.--Subject to the provisions of s.
757 495.161, any person who shall, without the consent of the
758 registrant:

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

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

775

776 shall be liable in a civil action by the owner of such
777 registered mark for any or all of the remedies provided in s.
778 495.141, except that under subsection (2) hereof the registrant
779 shall not be entitled to recover profits or damages unless the
780 acts have been committed with knowledge that such mark is
781 intended to be used to cause confusion or mistake or to deceive.

782 Section 15. Section 495.141, Florida Statutes, is amended
783 to read:

784 495.141 Remedies.--

785 (1) Any owner of a mark registered under this chapter may
786 proceed by suit to enjoin the manufacture, use, display, or sale
787 of any counterfeits or imitations thereof and any court of
788 competent jurisdiction may grant injunctions to restrain such
789 manufacture, use, display or sale as may be by the said court
790 deemed just and reasonable, and may require the defendants to
791 pay to such owner all profits derived from and/or all damages
792 suffered by reason of such wrongful manufacture, use, display,
793 or sale and to pay the costs of the action; and such court may
794 also order that any such counterfeits or imitations in the
795 possession or under the control of any defendant in such case be
796 delivered to an officer of the court, or to the complainant, to
797 be destroyed. In assessing profits the plaintiff shall be
798 required to prove defendant's sales only; defendant must prove
799 all elements of cost or deduction claimed. In assessing damages
800 the court may enter judgment, according to the circumstances of
801 the case, for any sum above the amount found as actual damages,
802 not exceeding three 3 times such amount. If the court shall find

803 that the amount of the recovery based on profits is either
804 inadequate or excessive the court may in its discretion enter
805 judgment for such sum as the court shall find to be just,
806 according to the circumstances of the case. Such sum in either
807 of the above circumstances shall constitute compensation and not
808 a penalty. The court may also award reasonable attorney's fees
809 to the prevailing party according to the circumstances of the
810 case.

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

814 Section 16. Section 495.145, Florida Statutes, is created
815 to read:

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

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

825 (Substantial rewording of section. See
826 s. 495.151, F.S., for present text.)
827 495.151 Dilution.--

828 (1) The owner of a mark that is famous in this state shall
829 be entitled, subject to the principles of equity and upon such

830 terms as the court deems reasonable, to an injunction and to
831 obtain such other relief against another person's commercial use
832 of a mark or trade name if such use begins after the mark has
833 become famous and is likely to cause dilution of the distinctive
834 quality of the famous mark, as provided in this section. In
835 determining whether a mark is distinctive and famous, a court
836 may consider factors, including, but not limited to:

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

839 (b) The duration and extent of use of the mark in
840 connection with the goods and services with which the mark is
841 used.

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

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

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

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

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

853 (h) Whether the mark is the subject of a state
854 registration in this state or a federal registration under the
855 Federal Trademark Act of March 3, 1881, or the Federal Trademark

856 Act of February 20, 1905, or a principal register registration
857 under the Federal Trademark Act of July 5, 1946.

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

867 (3) The following shall not be actionable under this
868 section:

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

872 (b) Noncommercial use of the mark.

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

874 Section 18. Section 495.161, Florida Statutes, is amended
875 to read:

876 495.161 Common-law rights.--Nothing herein shall adversely
877 affect ~~or diminish~~ the rights or the enforcement of rights in
878 marks acquired in good faith at any time at common law.

879 Section 19. Section 495.171, Florida Statutes, is amended
880 to read:

881 495.171 Effective date; repeal of conflicting ~~prior~~
882 acts.--

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

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

894 Section 20. Section 495.181, Florida Statutes, is amended
 895 to read:

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

898 495.181 Construction of chapter.--The intent of this
 899 chapter is to provide a system of state trademark registration
 900 and protection substantially consistent with the federal system
 901 of trademark registration and protection under the Trademark Act
 902 of 1946, as amended. To that end, the construction given the
 903 federal act should be examined as persuasive authority for
 904 interpreting and construing this chapter.

905 Section 21. Section 495.191, Florida Statutes, is created
 906 to read:

907 495.191 Fees.--Filing and other applicable fees payable to
 908 the department under this chapter shall be as follows:

909 (1) Application filing fee: \$87.50 per class.

910 (2) Renewal application fee: \$87.50 per class.

911 (3) Assignment filing fee: \$50 per class.

912 (4) Certificate of name change filing fee: \$50.

913 (5) Voluntary cancellation filing fee: \$50.

914 (6) Certificate of registration under seal: \$8.75.

915 (7) Certified copy of application file: \$52.50.

916 Section 22. Sections 506.06, 506.07, 506.08, 506.09,
 917 506.11, 506.12, and 506.13, Florida Statutes, are repealed.

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