

An act relating to trademarks; creating s. 495.001, F.S.; providing a short title; amending s. 495.011, F.S.; providing definitions; amending s. 495.021, F.S.; precluding registration of certain marks; repealing s. 495.027, F.S., relating to reservation of a mark; amending s. 495.031, F.S.; providing requirements for information to be contained in an application for registration of a mark; authorizing the Department of State to require certain information in an application; requiring that the application be signed and verified by any of certain persons; requiring that the application be accompanied by three specimens or facsimiles showing the mark; requiring that the application be accompanied by a fee; creating s. 495.035, F.S.; providing filing guidelines for applications; providing for disclaimers of unregistrable components; providing for amendment and judicial review; providing for priority of registrations; amending s. 495.041, F.S.; providing that first use shall inure to the benefit of the registrant or applicant under certain circumstances; amending s. 495.061, F.S.; providing for the issuance of a certificate of registration by the department; removing a provision relating to reservation of a mark; amending s. 495.071, F.S.; providing guidelines for the renewal of marks; revising duration of effectiveness of a registration; amending s. 495.081, F.S.; providing for the assignability of marks; authorizing a photocopy of an assignment to be acceptable for recording; providing for change of name certificates for registrants; authorizing recordation of certain instruments; providing acknowledgment of recording as prima facie evidence of the execution of an assignment or other instrument; specifying requirements for creation and perfection of security interests in marks; amending s. 495.091, F.S.; requiring the department to record all marks registered with the state; amending s. 495.101, F.S.; requiring the department to cancel certain marks; amending s. 495.111, F.S., which establishes a classification of goods and services; providing that a single application for registration of a mark may include any or all goods upon which, or services with which, the mark is actually being used comprised in one or more of the classes listed; amending s. 495.131, F.S.; revising infringement provisions to include an element of lack of consent by the registrant; conforming language; amending s. 495.141, F.S.; providing additional remedies for the unauthorized use of a mark; creating s. 495.145, F.S.; providing a forum for actions regarding registration; providing for service of process on nonresident registrants; amending s. 495.151, F.S.; providing for an injunction in cases of dilution of a famous mark; providing factors to be considered in determining that a mark is famous; providing damages in certain circumstances of dilution; amending s. 495.161, F.S.; deleting language relating to the diminishing of certain common law rights; amending s. 495.171, F.S.; providing effective date of changes to ch. 495, F.S., as amended by the act; providing for repeal of conflicting acts; providing application to pending actions; amending s. 495.181, F.S.; providing construction

and legislative intent; creating s. 495.191, F.S.; providing certain fees; repealing s. 506.06, F.S., relating to unlawful to counterfeit trademark, to conform; repealing s. 506.07, F.S., relating to filing of trademark or other form of advertisement for record with Department of State, to conform; repealing s. 506.08, F.S., relating to fee for filing, to conform; repealing s. 506.09, F.S., relating to civil remedies, to conform; repealing s. 506.11, F.S., relating to unlawful use of trademark, to conform; repealing s. 506.12, F.S., relating to procuring the filing of trademark or other form of advertisement by fraudulent representations, to conform; repealing s. 506.13, F.S., relating to using the name or seal of another, to conform; providing an effective date.

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

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

495.001 Short title.—This chapter may be cited as the “Registration and Protection of Trademarks Act.”

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

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

495.011 Definitions.—As used in this chapter:

(1) “Abandoned” applies to a mark when either of the following occurs:

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

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

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

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

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

(5) “Department” means the Florida Department of State or its designee charged with the administration of this chapter.

(6) “Dilution” means the lessening of the capacity of a mark to identify and distinguish goods or services, regardless of the presence or absence of:

- (a) Competition between the owner of the mark and other parties.
- (b) Likelihood of confusion, mistake, or deception.

(7) “Mark” includes any trademark, service mark, certification mark, or collective mark entitled to registration under this chapter, whether or not registered.

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

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

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

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

(12) “Trade name” means any name used by a person to identify a business or vocation of such person.

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

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

- (a) On goods when:

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

the nature of the goods makes such placement impracticable, on documents associated with the goods or their sale; and

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

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

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

495.021 Registrability.—

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

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

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

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

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

(e) Consists of a mark which:

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

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

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

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

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

~~Except as expressly excluded in subparagraphs 3. and 5., provided, however, that nothing in this paragraph shall prevent the registration of a mark used in this state by the applicant which has become distinctive of the applicant's goods or services in this state or elsewhere. The department of State may~~

accept as prima facie evidence that the mark has become distinctive, as used on or in connection with ~~applied to~~ the applicant's goods or services, proof of substantially exclusive and continuous use thereof as a mark by the applicant in this state or elsewhere for the 5 years before next preceding the date on which the claim of distinctiveness is made; or

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

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

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

495.031 Application for registration.—

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

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

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

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

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

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

- (a) The information required by paragraph (1)(a);
- (b) The date when the certification mark was first used anywhere and the date when it was first used in this state under the authority of the applicant;
- (c) The manner in which and the conditions under which the certification mark is used in this state; and
- (d) A statement that the applicant is exercising control over the use of the mark, that the applicant is not herself or himself engaged in the production or marketing of the goods or services to which the mark is applied, and that no person except the applicant or persons authorized by the applicant, or related companies thereof, has the right to use such mark in this state, either in the identical form thereof or in such near resemblance thereto as to be likely, when applied to the goods or services of such other person, to cause confusion, to cause mistake, or to deceive or confuse or to be mistaken therefor.

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

- (a) The information required by paragraphs (1)(a) and (b);
- (b) The date when the collective mark was first used anywhere and the date when it was first used in this state by any member of the applicant or a related company of such member;
- (c) The class of persons entitled to use the mark, indicating their relationship to the applicant, and the nature of the applicant's control over the use of the mark; and
- (d) A statement that no person except the applicant or members of the applicant, or related companies thereof, has the right to use such mark in this state, either in the identical form thereof or in such near resemblance thereto as to be likely, when applied to the goods or services of such other person, to cause confusion, to cause mistake, or to deceive or confuse or to be mistaken therefor.

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

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

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

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

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

495.035 Filing of applications.—

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

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

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

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

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

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

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

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

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

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

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

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

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

495.061 Certificate of registration.—

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

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

~~(3) Contingent on the registration of a mark under this chapter, the reservation of such mark based on intent to use, as provided in this chapter, shall be prima facie evidence of priority of ownership of such mark within this state on or in connection with the goods or services specified in the reservation against any other person, except for a person whose mark has~~

not been abandoned and who, prior to such reservation, has used the mark within this state on or in connection with such goods or services.

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

495.071 Duration and renewal.—

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

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

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

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

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

495.081 Assignments; changes of name; security interests ~~Assignment.~~—

(1) A registered mark or a mark for which an application for registration has been filed ~~Any mark and its registration hereunder shall be assignable with the goodwill~~ good will of the business in which the mark is used or with that part of the goodwill ~~good will~~ of the business connected with the use of and symbolized by the mark. Assignments ~~Assignment~~ shall be by an instrument ~~instruments~~ in writing duly executed and may be recorded with the

department of State upon the payment of the applicable a fee. A photocopy of an assignment shall be accepted for recording if it is certified by any of the parties thereto, or their successors, to be a true and correct copy of the original. Upon recording of the assignment, of \$50, payable to the department of State which, upon recording of the assignment, shall issue in the name of the assignee a new certificate for the remainder of the term of the registration or of the last renewal thereof.

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

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

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

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

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

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

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

495.101 Cancellation.—The department of State shall cancel from the register:

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

(1)(2) Any registration ~~for concerning~~ which the department of State has received shall receive a voluntary request for cancellation by the registrant,

which request shall be in a manner and form complying with the requirements of the department thereof from the registrant.

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

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

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

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

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

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

~~(c) The registration was granted improperly.~~

~~(d) The registration was obtained fraudulently.~~

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

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

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

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

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

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

495.111 Classification.—

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

(a) Goods:

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

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

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

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

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

6. Class 6 Common metals and their alloys; metal building materials; transportable buildings of metal; materials of metal for railway tracks; non-electric cables and wires of common metal; ironmongery and small items of metal hardware; pipes and tubes of metal; safes; goods of common metal not included in other classes; and ores.

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

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

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

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

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

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

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

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

15. Class 15 Musical instruments.

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

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

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

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

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

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

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

23. Class 23 Yarns and threads for textile use.

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

25. Class 25 Clothing, footwear, and headgear.

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

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

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

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

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

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

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

33. Class 33 Alcoholic beverages except beers.

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

(b) Services:

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

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

3. Class 37 Building construction; repair; and installation services.
4. Class 38 Telecommunications.
5. Class 39 Transport; packaging and storage of goods; and travel arrangements.
6. Class 40 Treatment of materials.
7. Class 41 Education; providing of training; entertainment; and sporting and cultural activities.
8. Class 42 Scientific and technological services and research and design relating thereto; industrial analysis and research services; design and development of computer hardware and software; and legal services.
9. Class 43 Services for providing food and drink; and temporary accommodation.
10. Class 44 Medical services; veterinary services; hygienic and beauty care for human beings or animals; and agriculture, horticulture, and forestry services.
11. Class 45 Personal and social services rendered by others to meet the needs of individuals; and security services for the protection of property and individuals.

(c) Certification and collective membership marks:

1. Class 200 Collective membership marks.
2. Class A Certification marks for goods.
3. Class B Certification marks for services.

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

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

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

495.131 Infringement.—Subject to the provisions of s. 495.161, any person who shall, without the consent of the registrant:

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

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

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

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

495.141 Remedies.—

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

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

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

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

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

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

495.151 Dilution.—

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

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

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

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

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

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

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

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

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

(2) In an action brought under this section, the owner of a famous mark shall be entitled only to injunctive relief in this state unless the person against whom the injunctive relief is sought willfully intended to trade on the owner's reputation or to cause dilution of the famous mark. If such

willful intent is proven, and the mark is registered in this state, the owner shall also be entitled to all remedies set forth in this chapter, subject to the discretion of the court and the principles of equity.

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

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

(b) Noncommercial use of the mark.

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

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

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

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

495.171 Effective date; repeal of conflicting prior acts.—

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

Approved by the Governor June 12, 2006.

Filed in Office Secretary of State June 12, 2006.