

CHAPTER 495

REGISTRATION OF TRADEMARKS AND SERVICE MARKS

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495.011 Definitions.—As used in this chapter:

(1) "Trademark" means any word, name, symbol, character, design, drawing or device or any combination thereof adopted and used by a person to identify goods made or sold by him and to distinguish them from goods made or sold by others.

(2) "Service mark" means any word, name, symbol, character, design, drawing or device or any combination thereof, and the distinctive features of radio, television or other advertising, adopted and used by a person to identify services rendered or offered by him and to distinguish them from services rendered or offered by others.

(3) "Certification mark" means a trademark or service mark used upon or in connection with the products or services of one or more persons other than the owner of the mark to certify regional or other origin, material, mode of manufacture, quality, accuracy or other characteristics of such 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) Unless the context otherwise requires, "mark" means any trademark, service mark, certification mark or collective mark.

(6) "Trade name" means any word, name, symbol, character, design, drawing or device or any combination thereof adopted and used by a person to identify his business, vocation or occupation and to distinguish it from the business, vocation or occupation of others.

(7) "Person" means any individual, firm, partnership, corporation, association, union or other organization.

(8) "Applicant" embraces the person filing an application for registration of a mark under this chapter, his legal representatives, successors or assigns.

(9) "Registrant" embraces the person to whom the registration of a mark under this chapter is issued, his legal representatives, successors or assigns.

(10) "Related company" means any person who legitimately controls or is controlled by the registrant or owner of the mark in respect to the nature and quality of the goods or services in connection with which the mark is used.

(11) The term "use" of a trademark or service mark means the bona fide use of the trademark or service mark in the ordinary course of trade, and does not include the use of a trademark or service mark merely for the purpose of reserving a right in the trademark or service mark. For the purposes of this chapter, a trademark shall be deemed to be "used" in this state when it is placed in any manner on the goods or their containers or the displays associated therewith, on the tags or labels affixed thereto, or if the nature of the goods makes such placement impracticable, then on documents associated with the goods or their sale, and such goods are sold or otherwise distributed in this state, and a service mark shall be deemed to be "used" in this state when it is used or displayed in the sale or advertising of services in this state or in connection with services rendered in this state.

History.—s. 1, ch. 67-58; s. 1, ch. 90-222.

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, comprises or includes immoral, deceptive or scandalous matter; or

(b) Consists of, 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, 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, comprises or includes the name, signature or portrait of any living individual, except with his written consent; or

(e) Consists of a mark which:

1. When applied to the goods or services of the applicant is merely descriptive or deceptively misdescriptive of them,

2. When 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. Is primarily merely a surname, 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 evidence that the mark has become distinctive, as applied to the appli-

cant's goods or services, proof of substantially exclusive and continuous use thereof as a mark by the applicant in this state or elsewhere for 5 years 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.

(2) Subject to the provisions relating to the registration of trademarks and service marks, so far as they are applicable, collective and certification marks, including indications of regional origin, shall be registrable under this chapter, in the same manner and with the same effect as are trademarks and service marks, by persons, and nations, states, municipalities, and the like, exercising control over the use of the marks sought to be registered, even though not possessing an industrial or commercial establishment, and when registered they shall be entitled to the protection provided in this chapter in the case of trademarks and service marks. The Department of State may establish a separate register for such collective marks and certification marks.

History.—s. 1, ch. 67-58; ss. 10, 35, ch. 69-106; s. 1, ch. 87-266; s. 2, ch. 90-222.

495.027 Reservation.—

(1) A person who has a bona fide intention, under circumstances showing the good faith of such person, to use a mark in connection with the sale within this state of goods or services, or both, may reserve the right to register a mark in this state in connection with particular types of goods or services, subject to the limitations of this chapter, by delivering to the Department of State, on a form furnished by the department, a request to reserve a specified mark. The request shall set forth, but not be limited to, the following information:

(a) The name and business address of the person requesting such reservation, and, if a corporation, the state of incorporation;

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

(c) A statement that the requester has no knowledge of any other person other than a related company that has the right to use such a mark in this state either in the identical form thereof or in such near resemblance thereto as might be likely to deceive, or confuse, or to be mistaken therefor;

(d) A statement that the requester has a bona fide intent to use the mark within this state in connection with the sale of the goods or services listed; and

(e) Such other information as the department deems necessary.

(2) Every request under this section shall be signed and verified by the requester or by a member of the firm or an officer of the corporation or other organization submitting the request.

(3) Every request under this section shall be accompanied by a filing fee of \$50, payable to the Department of State, for each class of goods or services as specified in s. 495.111, in connection with which the mark is to be used.

(4) If the Department of State finds that the mark requested is available for registration by the requester in connection with the specified goods or services, subject to the limitations set forth in this chapter, the department shall reserve the mark for registration by the requester for a nonrenewable 120-day period commencing from the date that the requester files a request for reservation that complies with the requirements of this chapter.

(5) The right to register a specified mark so reserved may not be transferred during such reservation.

(6) The Department of State may revoke any reservation if, after a hearing, it finds that the request was not made in good faith.

(7) If a person who has obtained such a reservation files an application for registration of such mark prior to the expiration of the reservation, that person shall have the exclusive right during that reservation period to register the mark for the goods or services set forth in that reservation.

History.—s. 3, ch. 90-222.

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, on a form 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 corporation, the state of incorporation;

(b) The goods or services 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 or his predecessor in business or a related company of the applicant or his predecessor; and

(d) A statement that the applicant is the owner of the mark and that no other person except a related company 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 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, on a form 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 he is not 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 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, on a form 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 to deceive or confuse or to be mistaken therefor.

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

(5) Every application under this section shall be accompanied by a specimen or facsimile of such mark in triplicate.

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

History.—s. 1, ch. 67-58; s. 1, ch. 67-560; ss. 10, 35, ch. 69-106; s. 5, ch. 71-114; s. 2, ch. 87-265; s. 59, ch. 90-132; s. 4, ch. 90-222.

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.

History.—s. 1, ch. 67-58.

495.051 Disclaimers.—

(1) The Department of State may require the applicant for registration to disclaim an unregistrable component of a mark otherwise registrable. An applicant may voluntarily disclaim a component of a mark sought to be registered.

(2) No disclaimer shall prejudice or affect the applicant's or registrant's rights then existing or thereafter arising in the disclaimed matter, or his right of registration on another application if the disclaimed matter be

or shall have become distinctive of his goods or services.

History.—s. 1, ch. 67-58; ss. 10, 35, ch. 69-106.

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 corporation, the state of incorporation, 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 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 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.

History.—s. 1, ch. 67-58; ss. 10, 35, ch. 69-106; s. 5, ch. 90-222.

495.071 Duration and renewal.—

(1) Registration of a mark hereunder shall be effective for a term of 10 years from the date of registration and, upon application filed within 6 months prior to the expiration of such term, on a form to be furnished by the Department of State, the registration may be renewed for a like term. 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 of State, shall accompany the application for renewal of the registration.

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

(3) 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.

(4) Any registration in force on the date on which this chapter shall become effective shall be effective for a term of 10 years from the date of the registration or of

the last renewal thereof or 1 year after the effective date of this chapter, whichever is later, and may be renewed by filing an application with the Department of State on a form furnished by it and paying the aforementioned renewal fee therefor within 6 months prior to the expiration of the registration.

(5) All applications for renewals under this chapter shall include a statement that the mark is still in use in this state, or that its nonuse is due to special circumstances which excuse such nonuse and is not due to any intention to abandon the mark.

History.—s. 1, ch. 67-58; s. 2, ch. 67-560; ss. 10, 35, ch. 69-106; s. 6, ch. 71-114; s. 8, ch. 89-359; s. 60, ch. 90-132.

495.081 Assignment.—Any mark and its registration hereunder shall be assignable with the good will of the business in which the mark is used or with that part of the good will of the business connected with the use of and symbolized by the mark. Assignment shall be by instruments in writing duly executed and may be recorded with the Department of State upon the payment of a fee 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. 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 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.

History.—s. 1, ch. 67-58; s. 3, ch. 67-560; ss. 10, 35, ch. 69-106; s. 7, ch. 71-114; s. 3, ch. 87-265.

495.091 Records.—The Department of State shall keep for public examination a record of all marks registered or renewed under this chapter.

History.—s. 1, ch. 67-58; ss. 10, 35, ch. 69-106.

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.

(2) Any registration concerning which the Department of State shall receive a voluntary request for cancellation thereof from the registrant.

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

(4) Any registration concerning which a court of competent jurisdiction 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 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 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 he is the owner of a concurrent registration of his mark in the United States Patent Office covering an area including this state, the registration hereunder shall not be canceled.

(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 permits the use of the certification mark for purposes other than to certify; or discriminately 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.

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

History.—s. 1, ch. 67-58; ss. 10, 35, ch. 69-106; s. 6, ch. 90-222.

495.111 Classification.—

(1) The following general classes of goods and services are established for convenience of administration of this chapter:

(a) Goods:

Class 1 Chemicals

Class 2 Paints

Class 3 Cosmetics and cleaning preparations

Class 4 Lubricants and fuels

Class 5 Pharmaceuticals

Class 6 Metal goods

Class 7 Machinery

Class 8 Hand tools

Class 9 Electrical and scientific apparatus

Class 10 Medical apparatus

Class 11 Environmental control apparatus

Class 12 Vehicles

Class 13 Firearms

Class 14 Jewelry

Class 15 Musical instruments

Class 16 Paper goods and printed matter

Class 17 Rubber goods

Class 18 Leather goods

Class 19 Nonmetallic building materials

Class 20 Furniture and articles not otherwise classified

Class 21 Housewares and glass

Class 22 Cordage and fibers

Class 23 Yarns and threads

Class 24 Fabrics

Class 25 Clothing

- Class 26 Fancy goods
- Class 27 Floor coverings
- Class 28 Toys and sporting goods
- Class 29 Meats and processed foods
- Class 30 Staple foods
- Class 31 Natural agricultural products
- Class 32 Light beverages
- Class 33 Wines and spirits
- Class 34 Smokers' articles
- (b) Services:
 - Class 35 Advertising and business
 - Class 36 Insurance and financial
 - Class 37 Construction and repair
 - Class 38 Communication
 - Class 39 Transportation and storage
 - Class 40 Material treatment
 - Class 41 Education and entertainment
 - Class 42 Miscellaneous

(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.

History.—s. 1, ch. 67-58; s. 4, ch. 87-265.

495.121 Fraudulent registration.—Any person who shall for himself, or on behalf of any other person, procure the filing or registration of any mark with the Department of State under the provisions hereof, by knowingly making any false or fraudulent representation or declaration, verbally or in writing, or by any other fraudulent means, shall be liable to pay all damages sustained in consequence of such filing or registration, and for punitive or exemplary damages, to be recovered by or on behalf of the party injured thereby in any court of competent jurisdiction.

History.—s. 1, ch. 67-58; ss. 10, 35, ch. 69-106.

495.131 Infringement.—Subject to the provisions of s. 495.161, any person who shall:

(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 mistake or to deceive as to the source or origin of such goods or services; or

(2) Reproduce, counterfeit, copy or colorably imitate any such mark 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 conjunction with the sale, offering for sale, distribution or advertising in this state of goods or services;

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.

History.—s. 1, ch. 67-58.

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 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.

(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.

History.—s. 1, ch. 67-58.

495.151 Injury to business reputation; dilution.—

Every person, association, or union of working men adopting and using a mark, trade name, label or form of advertisement may proceed by suit, and all courts having jurisdiction thereof shall grant injunctions, to enjoin subsequent use by another of the same or any similar mark, trade name, label or form of advertisement if it appears to the court that there exists a likelihood of injury to business reputation or of dilution of the distinctive quality of the mark, trade name, label or form of advertisement of the prior user, notwithstanding the absence of competition between the parties or of confusion as to the source of goods or services.

History.—s. 1, ch. 67-58.

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.

History.—s. 1, ch. 67-58.

495.171 Effective date; repeal of prior acts.—This chapter shall be in force and take effect October 1, 1967, after its enactment, but shall not affect any suit,

proceeding or appeal then pending. Former ss. 495.01-495.14 are repealed on 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 takes effect such repeal shall be deemed not to be effective until final determination of said pending suit, proceeding or appeal.

History.—s. 1, ch. 67-56.

495.181 Construction of chapter.—It is the intent of the Legislature that, in construing this chapter, due consideration and great weight be given to the interpretations of the federal courts relating to comparable provisions of the Trademark Act of 1946, as amended (15 U.S.C. ss. 1051 et seq.).

History.—s. 7, ch. 90-222.