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Florida Enacts New Tradmark Law

WHAT'S IN A NAME? FLORIDA ENACTS A TRADEMARK ACT FOR THE 21ST CENTURY

BY DAVID R. ELLIS, ATTORNEY AT LAW, LARGO, FLORIDA

This past year, the Florida legislature enacted a new trademark statute to modernize the law of trademarks in the state and harmonize it with the Federal trademark statute and most other state trademark laws. The statute, approved by the governor in June 2006, revises Chapter 495 of the Florida Statutes in a number of substantive ways.

The statute is based on the Model State Trademark Bill (MSTB) of the International Trademark Association (INTA) and makes several changes that will more generally conform Florida's law to the current federal trademark statute, the U.S. Trademark Act of 1946, as amended, 15 U.S.C. § 1051 et seq., familiarly known as the Lanham Act.

The new act is effective on January 1, 2007. In the first section, the legislature gave the revised chapter the catchy popular title, "Registration and Protection of Trademarks Act." The act proceeds to revise a number of definitions to make them more consistent with federal law, which has undergone several changes of its own over the past twenty years.

The new state law eliminates a provision under which trademarks could be reserved before use, so that now marks in Florida will only be capable of registration after actual use in commerce in the state. This contrasts with the Lanham Act, under which an application may be filed either on the basis of actual use in commerce or by alleging that the applicant has a bona fide intent to use the mark in commerce. Under the federal scheme, the applicant must still use the mark before being issued a registration, but can gain valuable rights akin to reserving the mark by filing an intent-to use application before use.

Under the new Florida law, an applicant whose application to register a mark is refused now has the right to an administrative hearing, where before the applicant could only go to court to seek an order of mandamus. The term of registration is reduced from ten years to five years (unlike the federal statute, which provides a ten-year term), and each renewal period will also now be five years. The purpose of these reductions in the duration of trademark registration is to weed out the "deadwood" marks from the register when they are no longer being used. However, so long as a mark remains in use, it may continue to be renewed every five years, each time by filing a renewal application in the last six months of its term.

Further, the new act clarifies that security interests in a mark may be created and perfected in accordance with the Uniform Commercial Code, a point that was in doubt under the old law. Specific provisions also cover the filing and recording of changes in ownership of marks. The new act also amends the classification of goods and services to conform to the International Trademark Classification System, which consists of 34 classes of goods and 11 of services. It also adopts the U.S. Patent and Trademark Office's system for classifying certification and collective membership marks.

The new act specifically authorizes an award of attorney's fees to a prevailing party in litigation involving a registered mark, in contrast to the federal law which permits the award of attorney's fees only in "exceptional cases." This means that practitioners should consider obtaining a state registration and adding a claim of trademark infringement under the state statute in order to obtain attorney's fees in any case involving infringement or dilution of a trademark in Florida.

Another provision of the new act revises the law of trademark dilution, i.e. the tarnishment, blurring, or whittling away of a famous mark, to be more consistent with federal law. Specifically, the new act allows the owner of a mark that is "famous" in the state to sue to enjoin or obtain other relief against a 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 mark.

The act establishes criteria that may be used to determine whether a mark has become distinctive and famous. The law limits relief to an injunction unless the person against whom the injunction is sought willfully intended to trade on the owner's reputation or to cause dilution of the famous mark. In the case where willful intent is proven and the affected mark is registered in Florida, the owner of the mark will be entitled to damages and attorney's fees.

Contrary to federal law, as interpreted by the U.S. Supreme Court in the Victoria's Secret case, Moseley v. V Secret Catalogue, 537 U.S. 418 (2003), the new law retains Florida's "likelihood of dilution" standard rather than requiring actual dilution of the mark. (For a discussion of that case, see my article, It's Not Just Victoria's Secret: In A Case Of Comparative Negligees The Supreme Court Clarifies Trademark Dilution Law. http://easl.info/index.php?module=Static_Docs&func=view&f=20030419+David+Ellis+Victorias+Secret+Article.htm).

Florida's trademark law was first enacted in 1967 and was based on the then current Model State Trademark Bill, which has now been updated and adopted in 26 states The Florida law was last amended substantively in 1990, but was not kept up to date with current trends in trademark law.

The bill that resulted in the new act was introduced in the Florida legislature in early 2006, and was based on the MSTB in most respects. A subcommittee of the Intellectual Property Law Committee of the Florida Bar's Business Law Section (of which I was a member) provided extensive comments on the bill, after which it was amended and enacted into law.

David Ellis is a Largo attorney practicing copyrights, trademarks, patents, trade secrets, and intellectual property law; computer and cyberspace law; business, entertainment and arts law; and franchise, licensing and contract law. A graduate of M.I.T. and Harvard Law School, he is a registered patent attorney and the author of the book, A Computer Law Primer. He has taught Intellectual Property and Computer Law as an Adjunct Professor at the Law Schools of the University of Florida and Stetson University.

Please direct comments to ellislaw@alum.mit.edu
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