

HOUSE OF REPRESENTATIVES STAFF ANALYSIS

BILL #: HB 445 Trademark Classifications
SPONSOR(S): Diamond
TIED BILLS: IDEN./SIM. **BILLS:** SB 198

REFERENCE	ACTION	ANALYST	STAFF DIRECTOR or BUDGET/POLICY CHIEF
1) Business & Professions Subcommittee	15 Y, 0 N	Wright	Anstead
2) Civil Justice Subcommittee	15 Y, 0 N	Padgett	Poche
3) Commerce Committee			

SUMMARY ANALYSIS

A “trademark” or “service mark” means any word, name, symbol, or device, or any combination thereof, used by a person to identify and distinguish the goods or services of such person from those of others, and to indicate the source of the goods or services. Generally, a trademark or service mark registration is obtained to protect ownership of and the exclusive right to use the mark, and to enforce those rights.

In order to obtain a trademark or service mark registration in Florida, a person must submit an application to the Florida Department of State containing, among other requirements, the goods or services on or in connection with which the mark is used and the class or classes in which such goods or services fall. The international classes for goods and services, called the Nice Classification, are generated by the World Intellectual Property Organization and are used by the United States Patent and Trademark Office (USPTO). Florida codified them in 2006.

HB 445 updates Florida’s statutory classes of goods and services for mark registrations to conform to the current Nice Classification, as adopted by the USPTO.

The bill has an indeterminate fiscal impact on state government and does not appear to have a fiscal impact on local government.

The bill provides an effective date of July 1, 2019.

FULL ANALYSIS

I. SUBSTANTIVE ANALYSIS

A. EFFECT OF PROPOSED CHANGES:

Background

A “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.¹

A “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.²

Generally, a trademark or service mark (collectively “mark”) registration is obtained to protect ownership of the mark and the exclusive right to use the mark in commerce, and to enforce those rights.³ Mark registrations may be obtained federally from the United States Patent and Trademark Office (USPTO), which applies nationally.⁴ A mark registration may also be obtained from Florida through the Department of State (DOS), which applies only in Florida.⁵

In order to obtain a trademark or service mark registration from the USPTO, a person must pay a fee and submit a signed application containing:

- The owner of the mark,
- A name and address for correspondence,
- A depiction of the mark,
- For which goods and services the mark applies,
- The basis for filing, and
- A specimen for use-based marks.⁶

In order to obtain a trademark or service mark registration in Florida, a person must pay a fee and submit a signed and verified application to the DOS containing:

- The person’s name and business address, and, if a business entity, place of incorporation or organization;
- 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;
- The date the mark was first used anywhere and the date it was first used in this state by the applicant, the applicant’s predecessor in interest, or a related company of the applicant;
- 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;
- If DOS requires, a drawing of the mark; and
- Three specimens or facsimiles of the mark as actually used.⁷

¹ S. 495.011(13), F.S.; 15 U.S.C. § 1127 (2012).

² S. 495.011(11), F.S.; 15 U.S.C. § 1127 (2012).

³ United States Patent and Trademark Office, *Protecting Your Trademark*, at 11, available at <https://www.uspto.gov/sites/default/files/documents/BasicFacts.pdf> (last visited Feb. 26, 2019).

⁴ 15 U.S.C. § 1127 (2012).

⁵ S. 495.011(14), F.S.

⁶ USPTO, *supra* note 3, at 14.

Goods and Services Classification System

As part of a USPTO or Florida application for a mark registration, the applicant must state for which classes of goods and services the mark applies.

The USPTO has adopted in its regulations the international trademark classification created by the Committee of Experts of the Nice Union, set forth in the International Classification of Goods and Services for the Purpose of the Registration of Marks (Nice Classification⁸), and published by the World Intellectual Property Organization.⁹ This system lists acceptable identifications of good and services for mark registrations.¹⁰

Florida has modeled its mark registration system on the federal requirements.¹¹ As such, Florida has matched the USPTO and adopted the Nice Classification by statute, but this statute has not been updated since 2006.¹² There have since been additions to the Nice Classification.¹³

Effect of the Bill

HB 445 updates Florida's statutory classes of goods and services for mark registrations to conform to the current Nice Classification. The updates consist of technical and grammatical changes¹⁴, the combination of currently listed goods and services into a broader category¹⁵, or the addition of new goods and services¹⁶.

The effective date of the bill is July 1, 2019.

B. SECTION DIRECTORY:

Section 1: Amends s. 495.111, F.S., updating classes of goods and services for mark registrations.

Section 2: Provides an effective date.

II. FISCAL ANALYSIS & ECONOMIC IMPACT STATEMENT

A. FISCAL IMPACT ON STATE GOVERNMENT:

1. Revenues:

None.

2. Expenditures:

The Department of State will have to update forms. The fiscal impact is indeterminate.

⁷ S. 495.031, F.S.

⁸ World Intellectual Property Organization, *Nice Publication, Classes*, https://www.wipo.int/classifications/nice/nclpub/en/fr/20190101/hierarchy/class-1/?basic_numbers=show&explanatory_notes=show&lang=en&menulang=en&mode=flat&pagination=no (last visited Feb. 26, 2019).

⁹ 37 C.F.R. § 2.85 (2018).

¹⁰ USPTO, *supra* note 3, at 18.

¹¹ S. 495.181, F.S.

¹² S. 495.111(1), F.S.

¹³ United States Patent and Trademark Office, *Nice Agreement current edition version – general remarks, Class headings and explanatory notes*, <https://www.uspto.gov/trademark/trademark-updates-and-announcements/nice-agreement-current-edition-version-general-remarks> (last visited Feb. 26, 2019).

¹⁴ Examples include changes in punctuation, spelling, and the order of currently listed goods and services.

¹⁵ Typewriters are omitted from the classification schedule and incorporated within the broader category of office requisites.

¹⁶ Examples include video game apparatus; therapeutic and assistive devices adapted for the disabled; compact discs, DVDs and other digital recording media; and power-operated tools.

B. FISCAL IMPACT ON LOCAL GOVERNMENTS:

1. Revenues:

None.

2. Expenditures:

None.

C. DIRECT ECONOMIC IMPACT ON PRIVATE SECTOR:

This bill provides uniformity by aligning Florida with federal and international standards for classifying goods and services for trademark and service mark registrations, which will benefit the private sector.

D. FISCAL COMMENTS:

None.

III. COMMENTS

A. CONSTITUTIONAL ISSUES:

1. Applicability of Municipality/County Mandates Provision:

Not applicable. This bill does not appear to affect county or municipal governments.

2. Other:

None.

B. RULE-MAKING AUTHORITY:

None.

C. DRAFTING ISSUES OR OTHER COMMENTS:

None.

IV. AMENDMENTS/ COMMITTEE SUBSTITUTE CHANGES