

Technical Trademark Amendments Act of 2018 White Paper

I. INTRODUCTION

The Technical Trademark Amendments Act of 2018 is designed to conform our state trademark registration classification system to national and international standards.

Classification goods and services into different classes for the purpose registration of trademarks enables systematic storage and retrieval of information. The international Nice Classification System, administered by the World Intellectual Property Organization, is a uniform system for classifying goods and services for trademark registration purposes established by a treaty to which the United States is a signatory.¹ Under the terms of the treaty, the Nice System classifications are regularly reviewed and upgraded to reflect changes in commercial practice and technology. Since the enactment of Florida's Trademark Act, the United States has twice adopted changes to its classification system to conform with international standards.² While these changes are largely ministerial, a few are substantive enough to change the classification in which a particular service is classified. For example, legal services were moved from Class 42 to Class 45. The Act ensures that Florida's classification system is in line with International Standards.

II. WHY ENACT THE ACT

Florida businesses are best served if Florida's trademark registration system is consistent with national and international standards for classification. This will facilitate better searching and reduce confusion in the marketplace, which is the ultimate goal of any trademark registration system.

The purpose of the bill is in keeping with the legislature's intent in enacting the Registration & Protection of Trademarks Act in 2006. 2006 Fla. Sess. Law Serv. Ch. 2006-191 (H.B. 7107). Then, as now, the goal is to harmonize state trademark practices with recent changes in federal trademark law. *See* Florida Staff Analysis, H.B. 7107, 4/6/2006.

¹ Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of June 15, 1957 (as amended on September 28, 1979), *available at* <http://www.wipo.int/wipolex/en/details.jsp?id=12617>.

² *See* International Trademark Classification Changes, 72 Federal Register 98 at 26810 (May 22, 2007), *available at* <https://www.uspto.gov/sites/default/files/trademarks/law/Classification-2007-FinalRule.pdf> and International Trademark Classification Changes, 82 Federal Register 230 at 56889 (December 1, 2017), *available at* <https://www.gpo.gov/fdsys/pkg/FR-2017-12-01/pdf/2017-25880.pdf>

III. APPROVALS AND THIRD-PARTY STAKEHOLDERS

The Florida Bar Business Law Section, which includes an intellectual property law committee comprised of lawyers who regularly practice trademark law, has proposed these amendments to ensure that Florida's classification system serves its purpose of enabling systematic storage and retrieval of information.

Florida's Division of Corporations supports the amendment to conform with international standards. The cost of compliance upon enactment will be minimal. There is anecdotal evidence that the Division of Corporations may already be following current Nice Classifications rather than what is set out in the statute. The Division will have to update its online trademark registration application forms and Chapter 495 Booklet to reflect the changes. Because these forms are provided on-line only, the cost of the change will be minimal.

The bill does not require a municipality or county to expend funds or to take any action requiring the expenditure of funds. The bill does not reduce the authority that municipalities or counties have to raise revenues in the aggregate. The bill does not reduce the percentage of state tax shared with municipalities or counties. The bill does not create or implicate any rulemaking authority.