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No Aero Med Express
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FILED
13 MAY 17 AM 11:30
SECRETARY OF STATE
TALLAHASSEE, FLORIDA

MAY 21 2013

N. CAUSSEAU

COVER LETTER

TO: Registration Section
Division of Corporations

SUBJECT: AEROMED

(Mark to be registered)

The enclosed Trademark/Service Mark Application, specimens and fee(s) are submitted for filing.

Please return all correspondence concerning this matter to the following:

Jill Sarnoff Riola

(Name of Person)

Carlton Fields PA

(Firm/Company)

450 S. Orange Ave.

(Address)

Orlando FL 32801

(City/State and Zip Code)

For further information concerning this matter, please call:

Jill Sarnoff Riola

(Name of Person)

at (407) 244-8246

(Area Code & Daytime Telephone Number)

MAILING ADDRESS:

Registration Section
Division of Corporations
P.O. Box 6327
Tallahassee, FL 32314

STREET/COURIER ADDRESS:

Registration Section
Division of Corporations
Clifton Building
2661 Executive Center Circle
Tallahassee, FL 32301

(**NOTE:** The information contained in this cover letter will be included in the permanent record and will be available to the general public.)



FLORIDA DEPARTMENT OF STATE
Division of Corporations

February 20, 2013

JILL SARNOFF RIOLA, ESQUIRE
CARLTON FIELDS PA
450 SOUTH ORANGE AVENUE
ORLANDO, FL 32801

SUBJECT: AEROMED
Ref. Number: W13000010521

We have received your document for AEROMED and your check(s) totaling \$87.50. However, the enclosed document has not been filed and is being returned for the following correction(s):

We must deny registration pursuant to sections 495.021(1)(f) and 495.181, Florida Statutes. There is a federal registration on file with the U.S. Patent and Trademark Office for "AERO MED EXPRESS", Registration Number 3219874, for the same or similar name and class(es).

Pursuant to s. 495.035(5), F.S., you have three months in which to reply to this letter denying registration should you desire to do so. If you choose not to respond, your application will be considered abandoned in accordance with section 495.035(5), F.S.

If you have any questions concerning the filing of your document, please call 850-245-6051.

Nanette Causseaux
Document Specialist Supervisor

Letter Number: 713A00004226

CARLTON FIELDS

Jill S. Riola
407.244.8246 direct
jriola@carltonfields.com

ATTORNEYS AT LAW

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Orlando, Florida 32801-3336
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www.carltonfields.com

Atlanta
Miami
New York
Orlando
St. Petersburg
Tallahassee
Tampa
West Palm Beach

April 24, 2013

Ms. Nanette Casseaux
Document Specialist Supervisor
Florida Department of State
Division of Corporations
Clifton Building
2661 Executive Center Circle
Tallahassee, Florida 32301

Via Federal Express #7996 0030 5435

RE: Florida State Service Mark Application for AEROMED
Ref. No.: W13000010521
Ltr. No.: 713A00004226

Dear Ms. Casseaux,

I refer to your Letter Number 713A00004226, denying my client's application to register the service mark AEROMED. Your denial was based on a prior United States federal service mark registration for the mark AERO MED EXPRESS, citing FL Stat. §§495.02(1)(f) and 495.181, in support of the denial.

With all due respect, neither of the cited statutory provisions authorize the State to consider federal or other state or international trademark or service mark registrations or applications filed and existing outside of Florida when considering the registerability of a Florida application.

FL Stat. §§495.02(1)(f) refuses registration to a mark that:

"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."

The statute makes clear that a preclusive registration is limited to a prior Florida state registration. Whether or not a mark has been "previously used in this state by another and not abandoned" is a question of fact that cannot be determined in an ex parte action, and is primarily used as a basis for a claim of cancellation of a registration. In any event, ownership of a federal

Ms. Nanette Casseaux
Document Specialist Supervisor
April 24, 2013
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registration does not equate to use in all 50 states of the union. There is simply nothing in the statute that authorizes the State to look outside of Florida to determine the existence of prior registrations.

Turning to FL Stat §495.181, that section states:

“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.”

The federal statute corresponding to FL Stat. §§495.02(1)(f) is 15 USC §1052(d), which states in relevant part:

“... Consists of or comprises a mark which so resembles a mark registered in the Patent and Trademark Office, or a mark or trade name previously used in the United States by another and not abandoned. . .”

Although Florida does not yet have a Trademark Manual of Examining Procedure, the USPTO TMEP, especially in light of FL Stat §495.181, is useful as guidance in this situation.

TMEP §1207.01 LIKELIHOOD OF CONFUSION requires the examining attorney to conduct a search of the USPTO records for confusingly similar prior registrations or applications. The TMEP says nothing about searching any state or international country trademark records. Indeed to do so would place an incredible burden on the USPTO that certainly was not intended by Congress.

TMEP §1207.03 MARKS PREVIOUSLY USED IN THE UNITED STATES BUT NOT REGISTERED. The TMEP expressly states that “this provision is not applied in ex parte examination because of the practical difficulties with which an examining attorney is faced in locating ‘previously used’ marks, and determining whether anyone has rights in them and whether they are ‘not abandoned.’”

Based on all of the foregoing, it seems highly unlikely that the drafters of the revised Florida Trademark Statute intended FL Stat §495.181 to be applied literally; indeed, if it were, then the State would have no right to search its own records, just those of the USPTO, and would be required to apply federal law and procedure to a wholly state matter.

A more likely interpretation is that §495.181 is meant to give the Department of Corporations some useful guidelines to apply by analogy – for a federal application, the federal records should be searched, for a state application, the state records should be searched. The drafters of the revised Florida Trademark Statute are all too familiar with the limited resources of the Department of Corporations, and particularly that section of the Department devoted to the

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Document Specialist Supervisor
April 24, 2013
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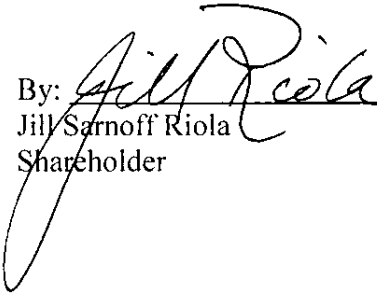
review and processing of state trademark applications. The purpose of the revisions was to streamline and modernize the *state* law and the *state* process, not to create more work for the Department by requiring them to familiarize themselves with and apply federal law and procedure.

Indeed, since there is no specific reference to a requirement to research the USPTO records, an argument can be made that if Florida is going to search outside of its own records, then a prior registration/application search should be made not only of the USPTO, but of every other state trademark database. I sincerely doubt that is what the drafters intended.

On the basis of all of the foregoing, I request that you kindly reconsider the subject application and allow it to issue to a Florida State Registration.

Very truly yours,

CARLTON FIELDS, PA

By: 
Jill Sarnoff Riola
Shareholder

JSR:ds
Enclosure

APPLICATION FOR THE REGISTRATION OF A TRADEMARK OR SERVICE MARK
PURSUANT TO CHAPTER 495, FLORIDA STATUTES

TO: Division of Corporations
Post Office Box 6327
Tallahassee, FL 32314

FILED
13 MAY 17 AM 11:30
SECRETARY OF STATE
TALLAHASSEE, FLORIDA

PART I

1. OWNER/APPLICANT: Enter the name and address of the individual or the business entity to be listed as the owner of the Trademark and/or Service Mark on the records of the Florida Department of State.

(a) Owner's/Applicant's name: Florida Health Sciences Center, Inc.

(b) Owner's/Applicant's business address: Tampa General Hospital, One Tampa General Circle
Tampa, FL 33606

City/State/Zip

If different, Owner's/Applicant's mailing address: _____

City/State/Zip

(c) Owner's/Applicant's telephone number: (____) _____

Check the appropriate box to indicate the Owner/Applicant is a(n):

- ☐ Individual ☐ Corporation ☐ Joint Venture ☐ Limited Liability Company
☐ General Partnership ☐ Limited Partnership ☐ Union ☒ Other: Non-profit corporation

If the Owner/Applicant is a business entity, the business entity must have an active filing or registration on file with the Florida Department of State. If the Owner/Applicant is not an individual, enter the business entity's Florida registration/document number in #1, the state or country under the laws of which the business entity is currently formed, organized or incorporated under in #2, and the entity's federal employer identification number (EIN) in #3.

(1) Florida registration/document number: N97000003941

(2) Domicile State or Country: Florida

(3) Federal Employer Identification Number: 593458145

2. (a) **SERVICE MARK:** If the owner/applicant is using the name, logo, design and/or slogan being registered in connection with a type of service, the mark is a service mark. If the mark is a service mark, the applicant/owner must list the specific service(s) the mark is being used in connection with. For example: furniture moving services, diaper services, house painting services, wholesale and retail sales of tractor equipment, etc. If the owner/applicant is using the mark to identify services available in the market place, enter the specific service(s) being rendered here:

(Note: List only those services currently being rendered by the owner/applicant. Do not include future services.)

Air ambulance services

2. (b) **TRADEMARK:** If the owner/applicant is using the name, logo, design and/or slogan being registered in connection with an actual product manufactured by the owner/applicant or on the owner/applicant's behalf, the mark is a trademark. If the mark is a trademark, the applicant/owner must list the specific product(s) the name, logo, design and/or slogan is being used to identify. For example: ladies sportswear, cat food, barbecue grills, shoe laces, etc. If the owner/applicant is using the name, logo, design and/or slogan to identify goods available in the market place, enter the specific product(s) the name, logo, design and/or slogan is being used to identify:

(Note: List only those product(s) currently available. Do not include future products.)

2. (c) **HOW IS THE NAME, LOGO, DESIGN AND/OR SLOGAN CURRENTLY USED:**

SERVICE MARKS: If the name, logo, design and/or slogan are/is being used in connection with a type of service, you must specify the form(s)/mean(s) of advertisement the applicant/owner is using to advertise the services to the general public. For example: newspaper advertisements, business cards, brochures, flyers, pamphlets, menus, etc. If the mark is being used in connection with a type of service, state how the name, logo, design and/or slogan are/is being used in advertising here:

On the air ambulances, on the applicant's website

TRADEMARKS: If the name, logo, design and/or slogan are/is being used to identify a product manufactured by or for the applicant/owner, you must specify how the mark is applied or affixed to the actual product or its packaging. For example: a tag, label, imprinted or engraved on the actual product, etc. If the mark is being used in connection with a specific product, state how the name, logo, design and/or slogan is applied or affixed to the actual product(s) or the packaging:

2. (d) **FEE(S) AND CLASS(ES):** There are a total of 45 classes or categories in which all products or services must be categorized. The fee to register a mark is \$87.50 per class. Make check payable to Florida Department of State.

List the class(es) which apply to the product(s) and/or service(s) listed in 2(a) and/or 2(b) above:

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PART II

1. You must state the date the name, logo, design and/or slogan was first used in the state of Florida, and, if it was used in another state or country, the date you first used the name, logo, design and/or slogan in the other state or country. Enter the month, day, and year the name, logo, design and/or slogan was first used by the applicant/owner, the predecessor, or a related company in Florida. If the name, logo, design and/or slogan has been used in another state or country, then you must also enter the month, day, and year the name, logo, design and/or slogan was/were used in another state or country, when applicable.

Note: The Florida Statutes require a mark to be in use prior to registration.

(a) Date first used in other state or country, if applicable: _____

(b) Date first used in Florida: April 1 1989

PART III

ENTER NAME, LOGO, DESIGN AND/OR SLOGAN BEING REGISTERED:

1. Enter the name, a brief description of the logo or design, and/or the slogan you are registering. The description of the logo and/or design must be 25 words or less. List the exact name, slogan, and/or description of the logo/design here: (NOTE: The name, logo, design and/or slogan listed in this section must match the exact name, logo, design and/or slogan listed on your specimens or examples.)

AEROMED

Provide the English translation of any and all terms listed #1 above, when applicable: _____

2. DISCLAIMER STATEMENT (if applicable):

Your mark may include a word or design that is commonly used by others. Commonly used terms or designs must be disclaimed. When you disclaim a specific term or design, you are acknowledging this term is commonly used by others and that you do not claim the exclusive right to use the disclaimed term or design. All geographical terms and representations of cities, states or countries must be disclaimed (i.e., Miami, Orlando, Florida, the design of the state of Florida, the design of the United States of America, etc.). Corporate suffixes and terms readily associated with the specific product(s) and/or(s) service being provided must also be disclaimed.

Enter all terms listed in #1 above which require a disclaimer in the space provided below:

NO CLAIM IS MADE TO THE EXCLUSIVE RIGHT TO USE THE TERM(S)" _____

_____ "APART FROM THE MARK AS SHOWN.

3. ATTACH OR INCLUDE THREE SPECIMENS OR EXAMPLES OF THE TRADEMARK OR SERVICE MARK BEING REGISTERED

Chapter 495, F.S., requires you to submit three specimens (samples or examples) of the mark in use. You must submit three specimens FOR EACH CLASS listed in Part I #2(d). The name, logo, design and/or slogan on the specimens must be identical to the name, logo, design and/or slogan being registered. You may provide three identical specimens or three different specimens. For each service mark class (classes 35-45), you may provide three newspaper advertisements, business cards, brochures, flyers, or any combination thereof. For each trademark class (classes 1-34), you may provide three tags, labels, boxes, etc. or any combination thereof. Photographs of bulky specimens are acceptable if the mark being registered and the good(s) or product(s) are clearly legible.

SIGNATURE OF APPLICANT/OWNER AND NOTARIZATION:

I, Jill Sarnoff Riola, being sworn, depose and say that I am the owner and the applicant herein, or that I am authorized to sign on behalf of the owner and applicant herein, and to the best of my knowledge no other person except a related company has registered this mark in this state or has the right to use such mark in Florida either in the identical form thereof or in such near resemblance as to be likely, when applied to the goods or services of such other person to cause confusion, to cause mistake or to deceive. I make this affidavit and verification on my/the applicant's behalf. I further acknowledge that I have read the application and know the contents thereof and that the facts stated herein are true and correct.

JILL SARNOFF RIOLA

Typed or printed name of applicant

Jill Sarnoff Riola, Attorney of Records

Applicant's signature
(List name and title)

STATE OF FLORIDA

COUNTY OF ORANGE

Sworn to and subscribed before me on this 19th day of FEBRUARY 2013, JILL S. RIOLA.
(Name of Individual Signing)

☒ who is personally known to me ☐ whose identity I proved on the basis of _____

(Seal)



Deborah J. Shelton

Notary Public Signature

DEBORAH J. SHELTON

Notary's Printed Name

My Commission Expires: 9/22/2013

FILING FEE: \$87.50 per class

FILED
13 MAY 17 AM 11:30
SECRETARY OF STATE
TALLAHASSEE, FLORIDA

