



Memo

To: Councilwoman Randolph
CC: Demetris Pressley
From: Clifford B. Shepard; Ryan G. Knight
Date: June 9, 2023
Re: Protection of the Town's Logo

Councilwoman Randolph,

We have been asked to provide an opinion on protecting the Town's logo and steps the Town can take to prevent use of the Town's logo without permission. As outlined below, the Town's logo cannot be trademarked. However, the Town's logo can be protected through Fla. Stat. § 165.043 and the enactment of an ordinance adopting the Town's logo as the official seal.

Issue: Whether the Town's logo can be protected as intellectual property through trademark?

Legal Background

Section 2(b) of the Trademark Act, 15 U.S.C. § 1052(b), prohibits registration of a mark that "consists of or comprises 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." This section imposes an absolute bar against registration of a mark that consists of or contains a flag, coat of arms or other insignia, and reflects the sentiment that such symbols are indicia of government authority that ought to be reserved for signifying the government. *In re Gov't of Dist. of Columbia*, 101 USPQ2d 1588, 1597 n.14 (TTAB 2012). The absolute bar to registration under Section 2(b) is founded upon the idea that "these kinds of official governmental insignia . . . should not be registered as symbols of origin for commercial goods and services" because they "ought to be kept solely to signify the government."

Thus, we must first determine whether the Town's logo constitutes official governmental "insignia" that would be an absolute bar to registration. The recent Trademark Trial & Appeal Board ("TTAB") case *In re County of Orange*, is particularly illustrative. In this case, the TTAB affirmed the

US Patent and Trademark Office’s refusal to register two different logo marks filed by California’s County of Orange (“County”) on the ground that they constituted insignia of a municipality. One of the marks at issue in the case is below.



The County argued that the proposed mark did not constitute “insignia” because it was not an “official” seal of the County, *i.e.*, the County never formally adopted the mark as the “official” seal. TTAB found that, although the mark was not the “official” seal of the county, it was displayed prominently by the County to signify broad County of Orange authority, records, functions, and facilities. For example, the mark was displayed on the County website, signage for government offices, and displayed prominently in the meeting room for the Board of Supervisors. Ultimately, TTAB held that although the proposed mark was never adopted as an “official” seal, the mark still constituted “insignia” and was prohibited from trademark protection under Section 2(b) of the Trademark Act.

Town of Eatonville Logo

The town logo has not been officially adopted as the town seal pursuant to ordinance. However, as in the County of Orange case, the logo is prominently displayed on the town’s website, government building, and correspondence (such as town council agendas). Essentially, if the town wanted to trademark the logo, it would have to abandon the logo on its website, government building and correspondences. Thus, according to the holding in *In re County of Orange*, the town logo would not be eligible for trademark protection. We believe this is not advisable since the town logo is a special mark unique to the Eatonville government and community.

“The Town That Freedom Built”

While the town logo is not eligible for trademark protection, the phrase displayed on the town logo (“The Town That Freedom Built”) would be eligible for trademark protection. We have performed a search on the US Patent and Trademark Office’s website and the phrase “The Town That Freedom Built” has not been registered for trademark protection. To trademark this phrase, we would need to submit a detailed application to the US Patent and Trademark Office for review. The process usually takes 12-18 months. Our office would be happy to assist you should you choose to trademark this phrase.

Fla. Stat. § 165.043

Fla. Stat. § 165.043 provides:

Official county or municipal seal.- The governing body of a county or municipality may, by ordinance, designate an official county or municipal

seal. The manufacture, use, display, or other employment of any facsimile or reproduction of the county or municipal seal, except by county or municipal officials or employees in the performance of their official duties, without the express approval of the governing body is a second-degree misdemeanor, punishable as provided in s. 775.082 or s. 775.083.

To qualify for protection under this statute, the Town of Eatonville must first pass an ordinance designating the town logo as the official seal. This seems to make the most sense in this case since once the ordinance designating the town logo as the official seal is enacted, no person or entity will be allowed to use the town logo/seal without the express approval of the Town. Further, the statute provides for criminal penalties should a person use the town seal without authorization. Of course, our office will gladly assist in drafting an ordinance should the council pursue this avenue.

Sincerely,

Ryan G. Knight