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Query

Under Florida law, what remedies are available to a brand owner when a licensee continues using licensed trademarks or branded content after the licensing agreement has been terminated, and what must the brand owner prove to obtain injunctive relief?

Confidence, Coverage & Methodology

✓ Overall Confidence: High

The question involves well-established federal trademark law (the Lanham Act) as applied in the Eleventh Circuit, supplemented by Florida state trademark and contract law. The legal framework is well-developed and extensively litigated, particularly in the franchise/licensing context.

Authority layers: U.S. Supreme Court decisions (eBay, Winter); published Eleventh Circuit opinions; the Lanham Act (15 U.S.C. §§ 1114-1118); the Trademark Modernization Act of 2020 (Pub. L. No. 116-260); Florida Statutes Chapters 495 and 501; and secondary commentary on the restored presumption of irreparable harm.

Material limitation: No directly on-point Florida DCA decision addressing post-termination trademark licensing remedies was located. The analysis relies primarily on Eleventh Circuit and federal authority, which is the dominant body of law governing these claims.

Bottom Line

When a former licensee continues using trademarks after a licensing agreement is terminated, the brand owner may pursue federal Lanham Act claims (injunctive relief, defendant's profits, actual damages, attorney's fees in exceptional cases) and Florida state claims (Chapter 495 infringement, FDUTPA, breach of contract). To obtain injunctive relief in the Eleventh Circuit, the brand owner must satisfy a four-factor test, and under the Trademark Modernization Act of 2020, a showing of likely infringement now triggers a rebuttable presumption of irreparable harm.

Direct Answer

A brand owner whose former licensee continues using licensed trademarks or branded content after the licensing agreement has been terminated has a robust set of remedies under both federal and Florida state law. The termination of the license extinguishes the only authorization the licensee had to use the marks; any continued use thereafter constitutes trademark infringement. The Eleventh Circuit has recognized that a strong risk of consumer confusion arises when a terminated licensee continues to use the former licensor's trademarks. *Burger King Corp. v. Mason*, 710 F.2d 1480, 1492 (11th Cir. 1983). This principle applies equally outside the franchise context to any trademark licensing arrangement.

The primary vehicle for enforcement is the Lanham Act (15 U.S.C. §§ 1114, 1116-1118, 1125(a)), which provides injunctive relief, monetary damages (including the infringer's profits, the owner's actual damages, and litigation costs), attorney's fees in exceptional cases, and destruction of infringing articles. Florida state law supplements these federal remedies through the Florida Trademark Act (Chapter 495), FDUTPA (§ 501.204), Florida common law unfair competition, and breach of contract based on the licensing agreement itself.

Jurisdiction Snapshot

Element	Detail
State	Florida

Federal Statute	Lanham Act, 15 U.S.C. §§ 1051-1141
Florida Statute	Chapter 495 (Trademark Act); § 501.204 (FDUTPA)
Courts	U.S. District Courts (S.D., M.D., N.D. Fla.); 11th Circuit; FL Circuit Courts
Key Legislation	Trademark Modernization Act of 2020 (Pub. L. No. 116-260, § 226)

I. Federal Remedies (Lanham Act)

A. Injunctive Relief (15 U.S.C. § 1116)

Courts have power to grant injunctions to prevent violation of any right of the registrant of a mark. In ordinary trademark infringement actions, complete injunctions against the infringing party are the standard remedy. *SunAmerica Corp. v. Sun Life Assurance Co. of Can.*, 77 F.3d 1325 (11th Cir. 1996).

B. Monetary Damages (15 U.S.C. § 1117(a))

- **Defendant's profits:** Plaintiff need only prove defendant's sales; defendant must prove all elements of cost or deduction
- **Actual damages:** Covers lost sales, licensing fees, reputational damage, and loss of goodwill. *Hard Candy, LLC v. Anastasia Beverly Hills, Inc.*, 921 F.3d 1343 (11th Cir. 2019)
- **Limiting principle:** Damages may not be speculative and must be based on proof. *Ramada Inns, Inc. v. Gadsden Motel Co.*, 804 F.2d 1562 (11th Cir. 1986)

C. Attorney's Fees (15 U.S.C. § 1117(a))

In exceptional cases, a prevailing party may be awarded attorney's fees. Willful post-termination use with knowledge of termination may support an exceptional case finding.

D. Destruction of Infringing Articles (15 U.S.C. § 1118)

Courts may order destruction of labels, signs, packaging, and other materials bearing the infringing marks.

II. Florida State Remedies

A. Florida Trademark Act (Chapter 495, Florida Statutes)

Provides state-level registration, protection, and enforcement of trademarks and service marks. Grants owners of registered marks the exclusive right to use the trademark with remedies including damages and injunctions. Fla. Stat. § 495.151 provides an anti-dilution remedy for owners of famous marks.

B. FDUTPA (Fla. Stat. § 501.204)

Supplements Lanham Act claims where continued use constitutes an unfair or deceptive trade practice. Allows monetary damages, injunctive relief, and attorney's fees for the prevailing party.

C. Breach of Contract

The brand owner may assert breach of the licensing agreement, which typically contains express post-termination obligations (cessation of mark use, return or destruction of branded materials). Contract claims may provide additional bases for liquidated damages, attorney's fees (if the agreement includes fee-shifting), and specific performance.

III. Injunctive Relief: What the Brand Owner Must Prove

A. The Four-Factor Preliminary Injunction Test (11th Circuit)

- (1) Substantial likelihood of success on the merits
- (2) Irreparable injury unless the injunction issues

- (3) Threatened injury to movant outweighs damage to opposing party
- (4) Injunction would not be adverse to the public interest

Siegel v. LePore, 234 F.3d 1163, 1176 (11th Cir. 2000) (en banc); CBS Broad., Inc. v. EchoStar Communications Corp., 265 F.3d 1193 (11th Cir. 2001).

B. Success on the Merits: Proving Infringement

The brand owner must show: (a) it owns a valid, protectable mark, and (b) the defendant's use creates a likelihood of consumer confusion. Leigh v. Warner Bros., Inc., 212 F.3d 1210, 1216 (11th Cir. 2000).

Eleventh Circuit Seven-Factor Likelihood of Confusion Test:

Factor	Description
1. Strength of mark	How distinctive and well-known is the mark?
2. Similarity of marks	How similar in sight, sound, and meaning?
3. Similarity of products	Are the offerings related or competing?
4. Sales methods	Are the parties using the same retail channels?
5. Advertising methods	Do the parties advertise through the same media?
6. Defendant's intent	Did the defendant intend to trade on plaintiff's goodwill?
7. Actual confusion	Is there evidence consumers have been confused?

Alliance Metals, Inc. v. Hinely Indus., Inc., 222 F.3d 895, 907 (11th Cir. 2000). In post-termination licensee cases, many factors are readily satisfied because the former licensee is using identical marks for the same products through the same channels with knowledge of termination. Burger King Corp. v. Mason, 710 F.2d 1480, 1492 (11th Cir. 1983).

C. Irreparable Harm and the Restored Presumption

Pre-TMA (before Dec. 27, 2020): Following eBay Inc. v. MercExchange LLC, 547 U.S. 388 (2006), the Eleventh Circuit held courts could no longer automatically presume irreparable harm from infringement. The brand owner had to present independent evidence. North American Medical Corp. v. Axiom Worldwide, Inc. (11th Cir. 2008).

Post-TMA (after Dec. 27, 2020): The Trademark Modernization Act (Pub. L. No. 116-260, § 226) amended 15 U.S.C. § 1116(a) to restore the rebuttable presumption of irreparable harm upon a finding of infringement or a showing of likelihood of success on the merits. This statutory amendment expressly abrogated decisions applying eBay to eliminate the presumption in Lanham Act cases.

Practical effect: A brand owner suing a former licensee now benefits from the TMA's presumption. Once likely infringement is established, irreparable harm is presumed unless the former licensee can rebut it.

Rebuttal factors courts consider:

- **Delay:** Unexplained delay in seeking relief militates against irreparable harm. Wreal, LLC v. Amazon.com, Inc., 840 F.3d 1244 (11th Cir. 2016). Even a few months can be damaging.
- **Adequate pecuniary remedy:** Evidence that harm can be fully compensated through money damages
- **Voluntary cessation:** Evidence defendant has ceased or will imminently cease (courts often skeptical of mere promises)
- **Quality of goods/services:** Some courts find presumption rebutted where former licensee maintained quality standards, but others hold loss of quality control itself constitutes irreparable harm

D. Balance of Hardships and Public Interest

In post-termination trademark cases, the balance of hardships typically favors the brand owner because any harm the former licensee suffers from being enjoined is self-inflicted. The public interest factor also generally favors the brand owner. Angel Flight of Ga., Inc. v. Angel Flight Am., Inc., 522 F.3d 1200 (11th Cir. 2008).

Eleventh Circuit Authority

Case	Rule
Burger King v. Mason, 710 F.2d 1480 (11th Cir. 1983)	Strong risk of consumer confusion when terminated licensee continues using marks
Hard Candy v. Anastasia Beverly Hills, 921 F.3d 1343 (11th Cir. 2019)	Broad menu of Lanham Act remedies; five categories of monetary damages
SunAmerica v. Sun Life, 77 F.3d 1325 (11th Cir. 1996)	Complete injunctions are the standard in trademark infringement
Angel Flight v. Angel Flight Am., 522 F.3d 1200 (11th Cir. 2008)	Public interest supports injunctive relief to prevent confusion
Wreal v. Amazon.com, 840 F.3d 1244 (11th Cir. 2016)	Delay in seeking relief, even months, undermines irreparable harm
McDonald's v. Robertson, 147 F.3d 1301 (11th Cir. 1998)	Strong likelihood of confusion may itself show irreparable harm

U.S. Supreme Court Authority

- **eBay Inc. v. MercExchange LLC**, 547 U.S. 388 (2006) — Four-factor equitable test for injunctive relief in IP cases; rejecting categorical rules
- **Winter v. NRDC**, 555 U.S. 7 (2008) — Requires showing of likely (not merely possible) irreparable harm for preliminary injunctions

Florida State Authority

- **Florida Trademark Act** (Ch. 495, Fla. Stat.) — State-level trademark registration, protection, enforcement; injunctive relief and damages
- **Fla. Stat. § 495.151** — Anti-dilution remedy for famous marks (blurring or tarnishment)
- **FDUTPA** (Fla. Stat. § 501.204) — Unfair and deceptive trade practices; supplements Lanham Act; allows attorney's fees
- **Trademark Modernization Act of 2020** (Pub. L. No. 116-260, § 226) — Restored rebuttable presumption of irreparable harm in Lanham Act injunction cases

Best Practices for Brand Owners

- **Act immediately upon termination.** Delay undermines the irreparable harm showing even under the TMA presumption. Send a cease-and-desist letter promptly and file suit or seek a TRO without unnecessary delay.
- **Pair the TMA presumption with affirmative evidence.** Document loss of quality control, consumer confusion reports, reputational damage, and inability to license to replacement licensees.
- **Preserve contract claims.** The licensing agreement's post-termination obligations (cessation, material return/destruction, liquidated damages, fee-shifting) provide independent remedies beyond the Lanham Act.
- **Layer federal and state claims.** Plead Lanham Act (§§ 1114, 1125(a)), Chapter 495, FDUTPA, and breach of contract to maximize remedies and leverage.
- **Document everything.** Screenshots of continued mark use, customer complaints about quality, social media posts, signage photographs, and web archives establish the evidentiary record for both injunction and damages.

Suggested Follow-Up Questions

1. Does the licensing agreement contain specific post-termination obligations (wind-down period, liquidated damages, arbitration clause, fee-shifting provision) that may shape the available remedies or forum selection?
 2. Is the brand owner's mark federally registered, and has the registration been maintained, enabling claims under 15 U.S.C. § 1114 (registered marks) in addition to § 1125(a) (unregistered marks)?
 3. How quickly after termination did the brand owner act (cease-and-desist letter, filing suit, seeking a TRO), and is there evidence that the former licensee's continued use is degrading product quality or causing consumer complaints?
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