

TRADEMARKS

GENERAL INFORMATION

TRADEMARKS and SERVICE MARKS are commonly referred to as brand names, logos or slogans. Trademarks are used to identify tangible goods. Service marks are used to identify services. The term “mark” is used to refer to both trademarks and service marks. A mark generally does not include “trade names,” which are terms used only to identify a business organization, rather than to distinguish the goods or services provided by the business. A company name may be viewed to be merely a trade name, instead of a trademark or service mark, if it is advertised in such a way that it attracts little attention, if it is used in close proximity to an address or phone number, or if it is dominated by the presence of another, indisputable trademark. A trade name, however, may be registered as a trademark if it is shown to function as a trademark.

The registration of the trademark or service mark with the Office of the Secretary of State creates a statewide priority of rights in the mark against any other person who subsequently adopts the same or a confusingly similar mark. Registration also provides “constructive notice” to all persons in the state of Texas of the priority of the registered mark and provides the owner with certain procedural advantages when the owner seeks judicial relief for infringement. For these reasons, it is beneficial for an owner of a mark who does business in Texas to register a trademark or service mark with the secretary of state.

Since identical or confusingly similar marks may not be registered by more than one person, a person planning to use or register a mark should take steps to determine whether others have priority of rights to that mark. One important step is checking the active trademark and service mark registrations on file with the Secretary of State prior to submitting the trademark application.

An application for trademark registration undergoes an examination process similar to the federal trademark registration process. A “Trademark Examiner” (either a Trademark Attorney or Trademark Legal Assistant) reviews the application to ascertain whether the mark proposed for registration is registrable under Chapter 16, Business & Commerce Code [Section 16.08] including whether the mark performs the identifying functions of a trademark or service mark. In addition, the Examiner compares the proposed mark with similar marks previously registered in Texas to determine whether the applicant's mark will cause a likelihood of confusion for consumers with any state registered mark. Texas law, federal statutory law (upon which the Texas trademark statute is based), federal case law, and examining procedures similar to those used by the United States Patent and Trademark Office are used by the secretary of state to conduct the examinations of trademark applications.

If the examiner determines that the application does not meet the standards for registration, a written office action specifying the reasons for denial of registration will be sent to the applicant or the applicant’s agent. The applicant is given sixty (60) days within which to amend the application, to provide the information requested, or to respond to the denial. Failure to respond within the time specified will terminate the examination process and will result in abandonment of the application. Upon receipt of the applicant’s response, the examiner will re-examine the application. The examination procedures described may be repeated until the application is registered, finally denied, or abandoned by the applicant.

The Trademark Examiners cannot provide legal advice to potential or actual applicants with regard to trademark law applicable to a particular circumstance. Because trademark law is quite complex, the secretary of state recommends that persons seeking to register a mark consult with a private attorney.

REQUIRMENTS FOR REGISTRATION

Mark Must Be In Use: Registration of trademarks and service marks in Texas is based on *actual use* of the mark in Texas commerce. For example, before an application can be submitted to the Office of the Secretary of State, the trademark must be used on a product, or the service mark must be used in association with the services rendered (during advertising or sale), and the goods must be sold or distributed in Texas or the services must be rendered in this state. A proposed mark may not be “reserved” prior to its actual use in Texas commerce or before the submission of a properly completed and filed application. If an application is submitted prior to actual use, the secretary of state will consider it void, registration will be refused, and the processing fee submitted with the application will not be refunded.

Mark Must Be Distinctive: Only distinctive words, names, symbols, devices, or logos are entitled to registration. A designation that is primarily a surname, or that is commonly used in describing the product or service, or that directly describes the qualities or characteristics of a product or service is not distinctive on first use and not entitled to registration. For example, the terms "Food & Beverage On-Line" would not be entitled to registration when used in association with "a news and information service for the food processing industry contained in a database" since such terms would be merely descriptive of such a service. However, sometimes a designation that is not inherently distinctive may acquire distinctiveness through at least five (5) years of continuous and substantially exclusive use.

INSTRUCTIONS FOR APPLICATION (Form 901)

Number 1: The applicant should be the person who owns the trademark or service mark and controls the use of the mark and the quality of the goods/services. If the applicant is an individual sole proprietor doing business under an assumed name [“d/b/a”], then provide the individual’s name, followed by the assumed name of the business. If the applicant is an organized entity, such as a corporation, limited liability company, or limited partnership, then provide the legal name of the organized entity as shown in its formation document (e.g., ABC Business Company, Inc.)

Number 2: Provide the mailing address of the applicant. Please note however that during the examination/review process, the Secretary of State will send any correspondence regarding the application to the submitter address provided in the cover letter, envelope, or enclosed check.

Number 3: If the applicant is a corporation, limited partnership, limited liability company or other business entity, please identify the type of business organization and the state of incorporation or organization. If applicant is an individual, you may identify the organizational form as “sole owner/proprietor” and identify the state/country of residence. Out-of-state applicants seeking a trademark or service mark registration should also submit

invoices or other material demonstrating the sale of goods or the rendition of services in Texas commerce.

Number 4: You can only seek to register one mark per application submitted. For example, if the mark includes both words and a logo/design element (a “composite mark”), and the applicant also uses the same words without or apart from the design element, an applicant seeking to register both versions of the mark would need to make two separate applications. A single application may not be used to seek registration of (1) different variations of a term or term; (2) terms appearing either “with or without” an accompanying design logo, or (3) more than one logo/design format. In addition, the applicant should describe the mark exactly as it appears in the specimen and drawing sheet accompanying the application so that there is no doubt what the applicant seeks to register. *Finally, the description in number 4, the drawing of the mark, and the samples of use provided should be consistent.*

Number 5: Describe clearly and concisely the goods or the services currently sold or provided by the applicant. Limit the description of goods or services to those goods or services that are classified under the same class heading. [See instructions for number 7.]

Number 6: The applicant should state the ways in which the mark is used, and/or the medium by which it is communicated to the consuming public. For example: tags or labels attached to the goods; or newspapers, brochures or signs advertising the services. Specimens supporting use for the classification sought and consistent with the methods noted in the application must be submitted with the application.

Appropriate Specimens

Trademark applications: Submit specimens of use such as actual labels or tags affixed to, or containers used with, the goods. A photograph of an actual display that appears in immediate proximity to the goods (“point-of-sale” display) is also an acceptable specimen. *Brochures that advertise the product are not sufficient.*

Service mark applications: Submit actual materials used in selling or advertising the services, such as menus, newspaper advertisements, coupons and the like. Advertising samples submitted (including letterhead or business cards) must contain some understandable reference to the services described in the application.

Number 7: State the class in which the applicant believes the goods or services belong. Texas does not permit multiple class applications. Do not list more than one class. If a mark is used in multiple classes, a separate and complete application is required for each class. Inclusion of more than one class in an application will result in an office action denying registration and requesting amendment of the application.

Many of the classification headings are broad in nature, and are generally not sufficient as a description of goods/services in item number 5 of the application. If you are unsure of the appropriate classification for your goods/services, you may leave this item blank or contact our office for assistance in classification. The classification system is set forth below:

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Goods

Class 1: Chemicals
Class 2: Paints
Class 3: Cosmetics & Cleaning Preparations
Class 4: Lubricants & Fuels
Class 5: Pharmaceuticals
Class 6: Metal Goods
Class 7: Machinery
Class 8: Hand Tools
Class 9: Electrical & Scientific Apparatus
Class 10: Medical Apparatus
Class 11: Environmental Control Apparatus
Class 12: Vehicles
Class 13: Firearms
Class 14: Jewelry
Class 15: Musical Instruments
Class 16: Paper Goods & Printed Matter
Class 17: Rubber Goods
Class 18: Leather Goods
Class 19: Non-metallic Building Materials
Class 20: Furniture and articles not otherwise classified
Class 21: Housewares & Glass
Class 22: Cordage & Fibers
Class 23: Yarns & Threads
Class 24: Fabrics

Class 25: Clothing
Class 26: Fancy Goods (*e.g.*, buttons, ribbons)
Class 27: Floor Coverings
Class 28: Toys & Sporting Goods
Class 29: Meats & Processed Foods
Class 30: Staple Foods (*e.g.*, coffee, sugar)
Class 31: Natural Agricultural Products
Class 32: Light Beverages
Class 33: Wine & Spirits
Class 34: Smokers' Articles

Services

Class 35: Advertising & Business
Class 36: Insurance & Financial
Class 37: Building Construction & Repair
Class 38: Telecommunications
Class 39: Transportation & Storage
Class 40: Treatment of Materials
Class 41: Education & Entertainment
Class 42: Computer, scientific and legal
Class 43: Hotels and restaurants
Class 44: Medical, beauty and agricultural
Class 45: Personal

Number 8: The applicant should note accurately the date on which the mark was first publicly used to identify the goods or services being marketed. **BOTH** dates of first use “Anywhere” and in “Texas” **MUST** be indicated on the application. (If the date of first use was in Texas, both dates will be the same). The month, day and year should be noted for each date of first use, *e.g.*, “November 10, 1983.” It is insufficient to simply note the month and the year, if the application is submitted within the same month.

Execution and Delivery Instructions

Completed Application: The application must be typewritten or clearly printed in black ink. Enclose two (2) copies of the application and drawing of the mark and two (2) specimens of use (examples of use listed in item 6).

Signature: The applicant must sign and date the application. The applicant's attorney of record may sign the application only with express authorization pursuant to a power of attorney; however, a copy of the power of attorney is not required to be part of the application. In addition, the application should not be executed before the first date of use of the mark.

Prior to signing, please review carefully the statements set forth in the application. A person commits an offense under Section 16.31, Business & Commerce Code, if the person signs a document that is forged or that the person knows is false in any material respect with the intent

that the document be delivered to the secretary of state for filing. The offense is a Class A misdemeanor. In addition, an application or registration procured by fraud is subject to cancellation pursuant to Sections 16.16 and 16.28, Business & Commerce Code.

Fee: The application processing fee of \$50.00 may be paid by personal check, money order, cashier's check, or by credit card. Fees paid by credit card are subject to a statutorily authorized convenience fee of 2.7% of the total fees. Checks should be made payable to the secretary of state. **The processing fee is not refundable regardless of whether the application is subsequently registered, denied or abandoned.**

Delivery: Documents should be mailed to the address shown in the heading of this form. The delivery address is James Earl Rudder Office Building, 1019 Brazos, Austin, Texas 78701. Responses to office actions may be faxed or mailed. The fax number is (512) 463-5709.

Examination Process

Not all applications submitted to the Secretary of State are approved for registration. If an application is rejected, we will notify the submitter of the objections to registration. If the application for registration is approved, then we will return a file stamped copy of the application for registration and attach a certificate of registration. (See General Information section for further information on the examination process.)

During the course of the examination process, the Secretary of State may require the applicant to disclaim an unregistrable component of a mark that is otherwise registrable. **An applicant cannot however disclaim all elements of the mark.** A disclaimer is a statement that the applicant does not claim the exclusive right to use a specified element or elements of the mark. Generally, elements that are descriptive or generic of the goods/services would be disclaimed (e.g., an outline of the state, a geographic term of origin, or words that are commonly used to describe the services/goods). A disclaimer may be included in an application or may be added by amendment, e.g., to comply with a requirement by the examining attorney.

The purpose of a disclaimer is to permit the registration of a mark that is registrable as a whole but contains matter that would not be registrable standing alone. As used in trademark registrations, a disclaimer of a descriptive component of a composite mark amounts merely to a statement that, in so far as the particular registration is concerned, no rights are being asserted in the disclaimed component standing alone, but rights are asserted in the composite; and that the particular registration represents only such rights as flow from the use of the composite mark.

Application Check-List:

- Two copies of the application, including drawing sheet.
- Two appropriate specimens of use.
- Application processing fee of \$50.00.



Office of the Secretary of State
Corporations Section
P.O. Box 13697
Austin, Texas 78711-3697

APPLICATION FOR REGISTRATION OF TRADEMARK OR SERVICE MARK

The undersigned applicant has adopted and used, and is now using, a certain trademark or service mark in Texas and hereby makes application for registration of such mark, in accordance with Chapter 16 of the Texas Business & Commerce Code.

1. **Applicant:** _____
2. **Address:** _____
City: _____ **State:** _____ **Zip:** _____
3. **Applicant is incorporated or organized as a** _____
and is incorporated or organized under the laws of _____
4. **Describe the mark (words and/or design) SHOWN ON THE ATTACHED DRAWING SHEET:**

5. **Description of goods or services in connection with which the mark is being used: (BE SPECIFIC)**

6. **The manner in which the mark is being used (labels, tags on the goods, etc; OR brochures, newspapers advertising the services, etc.): (A SAMPLE IS ATTACHED)**

7. **Number and title of the class of goods or services:** _____
(Do not list more than one class. See instruction 7.)

8. **Date mark first used by applicant (BOTH A & B MUST BE COMPLETED):**

(a) **Anywhere:** (Month) ___ ___/(Day)___ ___/(Year)___ ___ ___

(b) **In Texas:** (Month) ___ ___/(Day)___ ___/(Year)___ ___ ___

9. **Applicant hereby appoints the Secretary of State of Texas as its agent for service of process only in suits relating to the registration which may be issued if the applicant is or becomes a nonresident individual, partnership or association or foreign corporation, limited partnership, or limited liability company without a certificate of authority to do business in this state or cannot be found in this state.**

10. **Applicant is the owner of the mark and, to the best of the applicant's knowledge, no other person is entitled to use the mark in this state in the identical form used by applicant, or in a form that is likely, when used in connection with the goods or services, to cause confusion or mistake, or to deceive, because of its resemblance to the mark used by the applicant.**

11. **A drawing of the mark is enclosed.**

12. **Two examples of advertising are enclosed (if mark is used in connection with services). OR**

Two actual tags, labels, or actual product packaging are enclosed (if mark is used in connection with a distributed product).

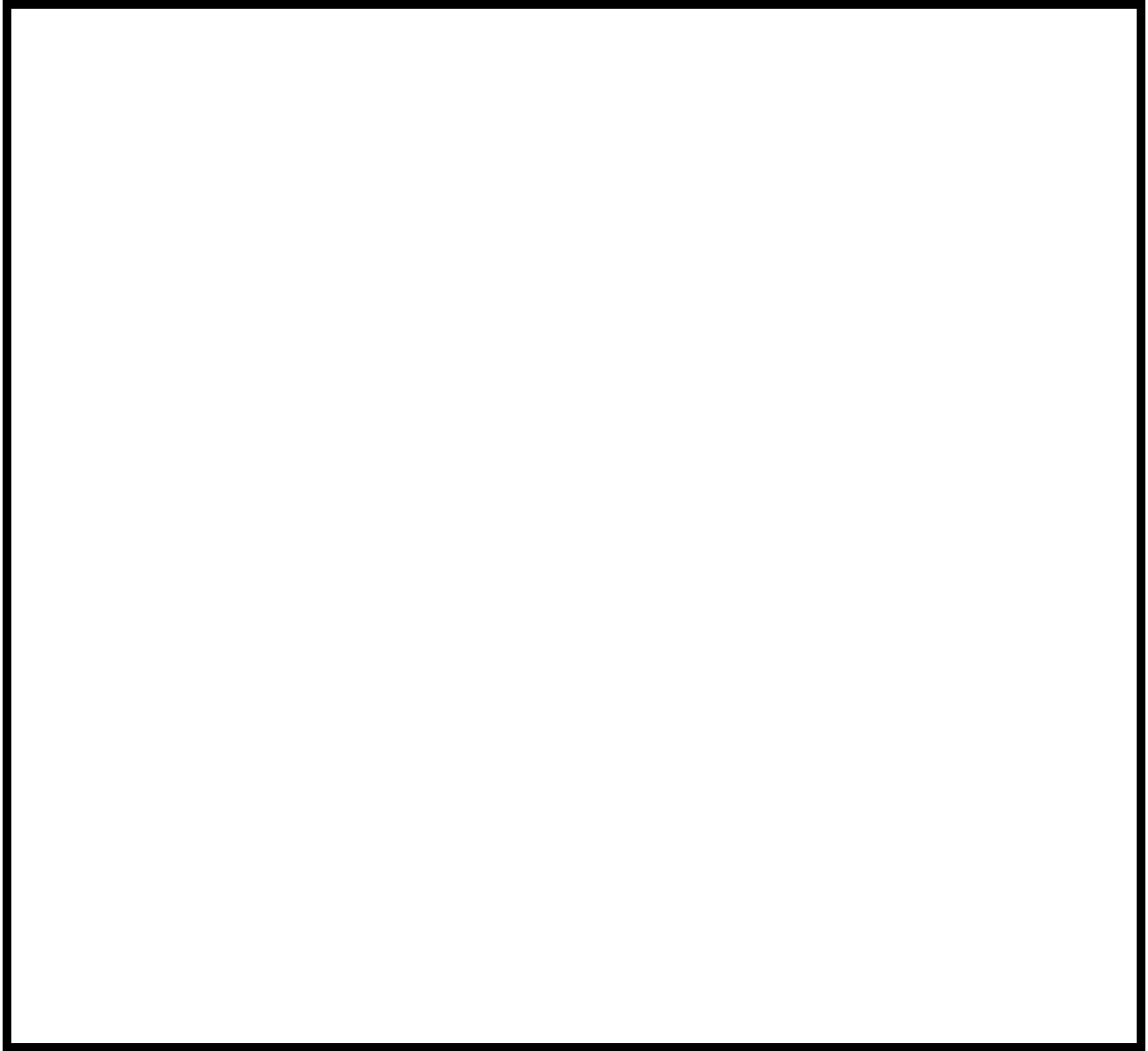
Executed on this _____ day of _____, ____ .

(Name of Applicant)

(Signature of Applicant)

(Title)

TRADEMARK DRAWING SHEET



Drawing Instructions :

The applicant also must submit with the application a “drawing sheet” that shows the mark exactly as it appears in the specimen accompanying the application and exactly as it is described in paragraph 4 of the application. If the mark includes a design, a drawing of the entire proposed mark (in clean, uniform black lines) must be attached to the application. If the mark described in the application consists only of a word, letter or numeral, or any combination thereof, and if the mark is not depicted in a special form, the mark may be typed in capital letters on the drawing sheet.