

Trademark / Service Mark

Frequently asked questions

1) What is the difference between a trademark, service mark, Business Entity name and trade name?

A. Trademark – Any word, name, symbol, or device, or any combination thereof, used by a person to identify and distinguish the goods of that person, including a unique product, from those manufactured or sold by others, and to indicate the source of the goods, even if that source is unknown. Model Act 1(a)

B. Service Mark – Any word, name, symbol, or device, or any combination thereof, used by a person to identify and distinguish the services of that person, including a unique service, from the services of others, and to indicate the source of the services, even if that source is unknown. Titles, character names used by a person, and other distinctive features of radio or television programs may be registered as service marks notwithstanding that they, or the programs, may advertise the goods of the sponsor. Model Act 1(b)

C. Business Entity name – Registering a Corporation, Limited Liability or other business entity creates a “person” under the law that is separate from the human person(s) who conducting business in the state where they are registered. Just as forming a business entity does not trademark a name, trademarking a name does not create a legal entity.

D. Trade Name – Any name used by a person to identify a business or vocation of that person.

2) Where is a trade name filed?

The law of this state does not provide for the filing of trade names or fictitious business names at the state level. A trade name or fictitious business name should be filed with the clerk of the county in which the company has its principal place of business.

Or

State law does not require or provide for a place to file a trade name.

3. What is a specimen?

A specimen demonstrates how the mark is being used presented to the public. A specimen is more than just a picture of your mark. It must show your mark as it is already being used in commerce. Model Act 1(h)

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A. For a trademark - For goods (products), acceptable specimens include labels, tags, packaging material, instruction manuals and containers which display the trademark. For a trademark, brochures, business cards, catalogs and stationery are generally not acceptable specimens for goods.

B. For a service mark - For services, acceptable specimens include brochures, flyers, advertisements, yellow page listings and websites. Please note that stationery is generally not an acceptable specimen for services. The specimen for a service mark must demonstrate the nature of the services rendered. The specimen must be something that could be handed to any average member of the public and that person would immediately know what services are being provided by the company using the mark.

4) Can photocopies or drawings of the actual specimen be submitted if the business has not started operating?

Photocopies, computer printouts, or camera ready layouts are not accepted as specimens. The company must have gone into production and have released the product or service into the market prior to registration of the trademark or service mark with the Secretary of State.

5) If I am just starting and have no specimens, what do I do?

You cannot register a trademark or service mark until you have provided your services or sold your product with the mark you wish to register. You must either be advertising your services and provide us with the advertisement, or you must have tags, labels, or photographs of your products bearing the mark you wish to register.

In order to register your mark with this office, you must have specimens. We use the specimens to make sure the mark is being used in commerce and to make sure the word or phrase that is being registered functions properly as a trademark or service mark. If you do not have specimens, you must wait until you have proper specimens before you may register the mark.

6) What can't be registered as a trademark or service mark?

We are not able to register marks that:

Consists of or comprises immoral, deceptive or scandalous matter. Model Act 2(a)

Consist of or comprises matter which may disparage or falsely suggest a connection with persons living or dead, institutions, beings or national symbols or bring them into contempt or disrepute. Model Act 2(b)

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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. Model Act 3(c)

Consists of or comprises the name, signature or portrait of any particular living individual, except with his/her written consent. Model Act 2(d)

Consists of a mark which, when used on or in connection with the goods or services of the applicant, is merely descriptive of them or merely describes one or more of the characteristics or is deceptively misdescriptive of them or falsely describes the nature, function, capacity or characteristics of them. Model Act 2e(1)

Consists of a mark which, when used on or in connection with the goods or services of the applicant, is primarily geographically descriptive or deceptively misdescriptive of them. Model Act 2(e)(2)

Consists of a mark which is primarily merely a surname. Model Act 2(e)(3)

Consists of or comprises a mark which so resembles a mark already registered in this state or a mark or trade name previously used in this state by another entity and not abandoned by that entity. Model Act 2(f)

7) How long is a trademark or service mark registration active?

The registration is active for five years. At the end of five years, the mark may be renewed for another five years. The mark may be renewed every five years as long as the mark is in continual use. Model Act 6(a)

8) Can a trademark and service mark be filed on the same application?

Trademarks and service marks must be filed on separate applications. They require separate fees and submittal of separate specimens. The fee for filing a trademark or a service mark is (*Insert fee*) per classification per mark. An application may be downloaded or requested via telephone or written request to the Trademark Unit of the Secretary of State. Please see contact information for the correct address and telephone number.

9) Can a name and a design be filed on the same application?

If a name and design are used together and constitute one complete mark, they may be filed on the same application. If a name and design are used separately, as two separate marks, then two separate applications with separate fees and two sets of specimens must be submitted.

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10) Does a federal trademark or service mark supersede a filing at the state level?

To ensure that all issues are considered and addressed appropriately, you should consult with private legal counsel. However, trademarks may be filed at the state and/or federal level and can be protected by state and federal laws simultaneously. Federally registered marks provide national protection and puts parties on notice of the trademark across the nation. State registered marks can put parties on notice on a statewide basis, and can give some protection against infringement. However, merely registering a trademark in a single state will give no protection against infringement in another state. Furthermore, if a company does not register a trademark federally, the company may find it's precluded from expanding with the trademark to other states, where competitors are already using the mark.

It is important to note that the state will only look for conflicts within the state trademark database as we have no authority to reject a filing based on a trademark filed at the federal level nor do we have the authority to reject a filing based on a registration in any other state.

11) Does registration with your Department prevent others from registering the same or similar mark in other states?

No. Registration of your mark in on a state level only provides protection in the state where you file. You should consult with an intellectual property attorney to determine whether additional state and/or federal registrations are needed.

12) If a trademark or service mark is registered at the federal level, does it have to be registered at the state level?

No, however it is recommended that the mark be registered at the state level as well to have a record of the mark.

13) Does registering a trademark or service mark give exclusive rights to the mark?

Registration in and of itself does not guarantee exclusive ownership of a mark. To ensure that all issues are considered and addressed appropriately, you should consult with private legal counsel.

14) Does your Department register patents?

No. A patent protects inventions and improvements to existing inventions. Although the Trademark Section does not issue patents, you may contact the United States Patent and Trademark Office for more information. Visit the United States Patent and Trademark Office Web site at www.uspto.gov/.

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15) Does your Department file "copyrights"?

No. Copyrights are registered federally in the office of the United States Copyright Office of the Library of Congress. Their phone number is (202) 707-3000. Visit the Copyright Office Web site at www.lcweb.loc.gov/copyright/.

16) Once I register a mark, can I sell it to someone else?

Yes, you can. Transferring the right to use a mark to another person or business entity is called an "assignment".

17) What do the designations "TM" and "SM" mean?

These designations indicate that a person claims rights in a trademark or service mark. They do not mean that a mark has been registered in this Department. A person or entity that claims ownership rights in a trademark or service mark may place these designations next to it even though the mark may not be registered.

18) Can I use the "®" designation if my mark is registered in your office?

No. This designation indicates that a mark is federally registered with the United States Patent and Trademark Office. It should only be used if that agency has granted registration.

19) What is the federal patents/trademarks office address?

Trademarks Commissioner
P.O. Box 1451
Alexandria, VA 22313-1451

20) Where do I find the list of the classification of goods and services?

The list can be found through the [United States Patent and Trademark Office](#) website or at [37 Code of Federal Regulations, part 6, section 6.1](#).

21) Is my website a proper specimen for goods?

A website is an acceptable specimen if the mark appears near a picture of the goods (or a text description of the goods) and your customers can order the goods from the website. A website that merely advertises the goods is not acceptable. You must provide an actual screenshot of the website; i.e., merely providing the website address is not acceptable.