



**Office of the
Secretary of State**

Corporations Section

P.O. Box 13697
Austin, Texas 78711-3697

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.

APPLICATION FOR REGISTRATION

Registration of trademarks and service marks in Texas is based on actual use of the mark in Texas. 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.

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.



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**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: _____
8. Date mark first used by applicant (BOTH SPACES MUST BE COMPLETED):
(a) Anywhere: _____

(b) In Texas: _____

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.

Executed on this _____ day of _____, ____ .

(Name of Applicant)

(Signature of Applicant) (if applicable, title of officer, partner, or other authorized person)

INSTRUCTIONS

Submit an ORIGINAL and one copy of the application. 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.

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

The application processing fee of \$50.00 also must be enclosed. 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.

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. We will place one document on record and return a file stamped copy. The telephone number is (512) 463-5576, TDD: (800) 735-2989, FAX: (512) 463-5709.

TRADEMARK DRAWING SHEET

Applicant:

Address:

Goods/Services:

**RED or
PINK**



BROWN



BLUE



**GRAY or
SILVER**



**VIOLET or
PURPLE**



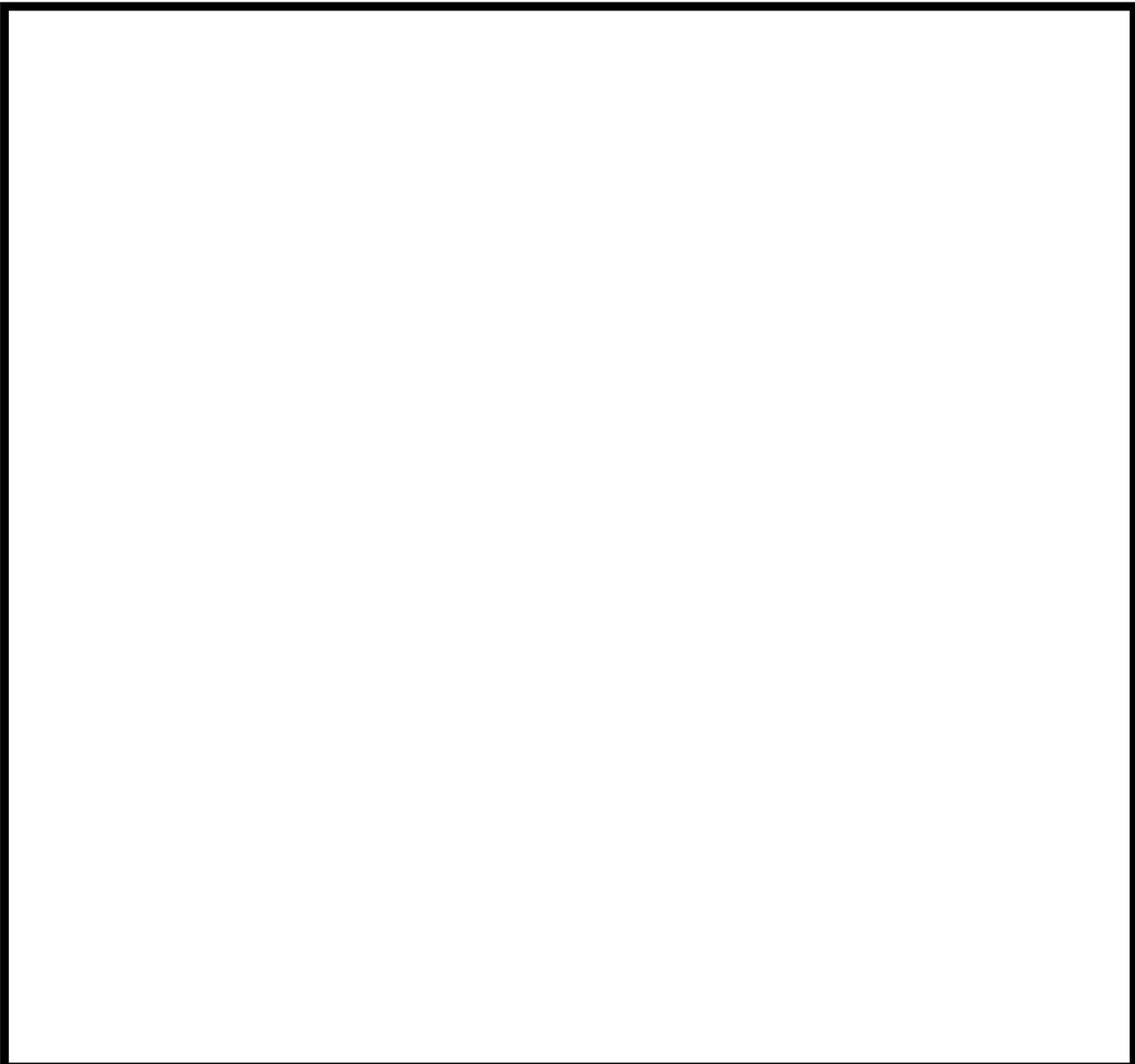
GREEN



ORANGE



**YELLOW or
GOLD**



INSTRUCTIONS FOR APPLICATIONS

Numbers 1 & 2 of the application form: The applicant should be the person who owns the trademark or service mark and controls the use of the mark. The complete name and address of the applicant is to be entered. A sole proprietor doing business under an assumed name should state the individual's name, followed by "d/b/a [assumed name]".

Number 3: If 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. Out of state corporations or other out-of-state business entities 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: Registration of only one mark may be sought in one application. For example, if the mark includes words and a design element (a "composite mark"), and applicant also uses the same words apart from the design, applicant may have two separate marks. A single application may not be used to register words "with or without" an accompanying design, or with more than one design. In addition, the applicant should describe the mark exactly as it appears in the specimen accompanying the application.

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. Where color is a feature of a mark, the color or colors shall be designated by the linings accepted by the United States Patent and Trademark Office, which are shown on the drawing sheet. In addition, state in the description of the mark that "the mark is lined for the color 'X'."

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 consistent with the methods noted in the application must be submitted with the application.

Specimens: For trademark applications, include specimens 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. For 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. The classification system is set forth below:

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
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: Miscellaneous Services
(including providing of food & drink, legal services, temporary accommodation, medical, hygienic & beauty care, veterinary & agricultural services, computer programming, scientific & industrial research, and other services that do not fit into the other classes)

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.”

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. In addition, the application should not be executed before the first date of use of the mark.

Form No. 901
Revised 9/97