

**Form 901—Instructions
(Trade or Service Mark Application)**

The attached form is designed to meet minimal statutory filing requirements pursuant to the relevant code provisions. *The form and the information provided are not substitutes for the advice and services of an attorney.*

General Information

Trade 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.

Trade names not registrable. “Trade names” 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 mark, if it is advertised in such a way that it attracts little attention, is used in close proximity to an address or phone number, or is dominated by the presence of another mark. However, a company name may be registered if it is shown to function as a mark.

Effect of registration. The registration of a mark with 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 mark with the secretary of state.

Applicant should conduct a conflict check. 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. Although checking the active registrations on file with the Secretary of State can be a useful step, the absence of a conflicting registration on file does not mean that no one else claims priority of rights in the mark.

Requirements for Registration

Mark Must Be In Use: Registration of marks in Texas is based on actual use of the mark in Texas commerce. For example, before an application can be submitted to the secretary of state, the trademark must be used on a product sold or distributed in Texas, or the service mark must be used in association with services rendered in Texas (during advertising or sale). 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, 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

Type or print in black ink in English, subject to the provisions of § 93.31 of 1 Texas Administrative Code Chapter 93. Use of the application form is recommended, but not mandatory. Submit your application along with a drawing, specimens, and filing fee of \$50 per classification:

- by mail to the Secretary of State, PO Box 13697, Austin, Texas 78711-3697;
- fax with credit card information (Form 807) to (512) 463-5709; or
- delivery to the James Earl Rudder Office Building, 1019 Brazos, Austin, Texas 78701.

Item 1: The applicant should be the person who owns the mark and controls the use of the mark and the quality of the goods or 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 a general partnership or joint venture, then provide the name of the partnership or joint venture. 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.)

Item 2: Provide the business address of the applicant. (During the examination process, the secretary of state will send correspondence regarding the application to the submitter address provided in the cover letter, envelope, or enclosed check.)

Item 3: If the applicant named in Item 1 is a corporation, limited liability company, limited partnership, general partnership, or other business entity, identify the type of business organization and the state under whose laws the entity was incorporated or organized. Out-of-state applicants should also submit invoices or other material demonstrating the sale of goods or the rendition of services in Texas commerce.

Item 4: If the applicant is organized as a general or limited partnership, then provide the names of all general partners.

Item 5: *Name and/or Description of the Mark.* Describe the mark exactly as it appears in the samples of use and drawing sheet accompanying the application in Item 5A. The description in Item 5A, the drawing of the mark, and the samples of use provided must match.
Color Claim. If color is claimed as a feature of the mark, check the “yes” box in 5B. If no color is claimed, check the “no” box in 5B. If the “yes” box is checked, list the color(s) claimed in 5C, and list the location of each color in 5D.

The applicant can seek to register only one mark per application; a single application may not be used to register multiple variations or multiple color combinations.

Item 6: A disclaimer may be included in an original application. Generally, components that are generic or descriptive of the goods or 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 goods or services). An applicant cannot disclaim all elements of the proposed mark. A properly worded disclaimer might be: Without waiving any right at common law, no claim is made to the exclusive right to use of _____ apart from the mark as shown.

Item 7: State the number(s) of the class(es) in which the goods or services belong. **Please note, use of this form is recommended for an applicant seeking to register a mark in two or fewer classes.**

For assistance with classifying goods or services, see the chart below or the Acceptable Identification of Goods and Services Manual at www.uspto.gov. If you are unsure of the class, leave this item blank.

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

For each class listed on the application, describe clearly and concisely the goods or the services currently sold or provided by the applicant on or in connection with which the mark is being used. Limit the description of goods or services to those goods or services under the same class heading.

For each class listed on the application, accurately state 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 first use was in Texas, both dates will be the same). State the month, day and year for each date of first use, e.g., "11/30/1983." It is insufficient to note the month and the year without the date, if the application is submitted within the same month.

Item 8 An applicant must fully disclose whether the applicant or the applicant's predecessor in interest has filed an application to register the mark, or a portion or composite of the mark, with the United States Patent and Trademark Office.

Item 9 List the manner in which the mark is used or communicated to the consuming public, such as tags or labels attached to goods; or newspapers, brochures or signs advertising services. If the application is for more than one (1) class, list the manner in which the mark is used in each class.

Item 10 *Specimen.* Three (3) specimens supporting the goods/services described in Item 7 and supporting the manner in which the mark is used in Item 9 must be attached to the application. In Item 10, check the box for each type of specimen included. Include at least one (1) specimen for each class. If color is claimed as a feature of the mark, include at least one specimen showing the mark in color.

Appropriate Specimens (samples of use)

Trademarks: Acceptable specimens include 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 marks: Acceptable specimens include actual materials used in selling or advertising the services, such as menus, newspaper advertisements, coupons and the like. To serve as specimens, advertising materials (including letterhead or business cards) must contain some understandable reference to the services described in the application.

Drawing: Include the mark exactly as it appears in the samples of use accompanying the application and exactly as it is described in Item 5 of the application. Do not include other words that are not part of the mark.

If the mark consists only of a word, letter or numeral, or a combination thereof, and is not depicted in a special form, type or print the mark in capital letters on the drawing sheet. If the mark is not only words, letters or numerals, or a combination thereof, and also includes a design, the entire design must appear on the drawing sheet.

If the mark includes a color claim, it may either appear in color or black and white. If the mark appears in color, it must match the color(s) described in the color statement.

The drawing must depict only one mark, and the drawing must fit within the 3.15 inches by 3.15 inches drawing box. The drawing must be an exact reproduction of the mark sought to be registered. If desired, the drawing may be taped to the drawing sheet.

A black and white reproduction of the mark in the drawing box will appear on the certificate issued, so an electronic reproduction of the mark is recommended.

Signature: The registrant named in Item 1 must sign and date the application. An application made by a business entity must be signed by an authorized person. The application must be signed and verified before a notary public or other person authorized to administer oaths and should not be executed before the date of first use of the mark.

Before signing, carefully review the application. An application or registration procured by fraud is subject to cancellation pursuant to Chapter 16, Business & Commerce Code.

Fee: The application fee (\$50 per class) may be paid by personal check, money order, LegalEase debit card, cashier's check, or American Express, Discover, MasterCard, or Visa credit card. Checks or money orders must be payable through a U.S. bank or financial institution and made payable to the secretary of state. Fees paid by credit card are subject to a statutorily authorized convenience fee of 2.7 percent of the total fees. The fee is not refundable regardless of whether the mark is registered, denied, or abandoned.

Examination Process

An application for trade or service mark registration undergoes an examination process similar to the federal registration process. A "trademark examiner" reviews the application to ascertain whether the proposed mark proposed is registrable under Section 16.051, Business & Commerce Code. 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 (USPTO) are used by the secretary of state to examine applications. The Examiner also compares the proposed mark with marks previously registered in Texas and with the USPTO to determine whether the proposed mark will cause a likelihood of confusion.

During the course of the examination process, the trademark examiner may require the applicant to disclaim an unregistrable component of a mark that is otherwise registrable. 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. A disclaimer 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 mark as a whole. Generally, components that are generic or descriptive of the goods or 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 goods or services). A disclaimer may be included in an original application or may be added by amendment. An applicant cannot disclaim all elements of the proposed mark.

If the application for registration is approved, we will return a certificate of registration. 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. The applicant is given ninety (90) 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 trademark examiner will reexamine 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 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.

Revised 05/13

Submit to:
Secretary of State
PO Box 13697
Austin, TX 78711-3697
512 463-9760
FAX: 512 463-5709
Application Fee:
\$50 per class



**Application for Registration
of a Trade or Service Mark**

1. NAME OF APPLICANT (owner of mark—individual, corporation, or other entity applying for registration):

2. BUSINESS ADDRESS OF APPLICANT:

City:

State:

Zip Code:

Country:

3. BUSINESS STRUCTURE OF APPLICANT (Check One and Complete)

Corporation

(State of Incorporation): _____

General Partnership

(State of Organization): _____

Limited Liability Company

(State of Organization): _____

Sole Proprietor

Limited Partnership

(State of Organization): _____

Other

(Describe): _____

4. NAMES OF GENERAL PARTNERS, IF APPLICANT IS A PARTNERSHIP (attach additional sheet if necessary):

5A. NAME AND/OR DESCRIPTION OF MARK (For design, provide a brief written description that can be pictured in the mind without reference to the specimens. Do not draw the design on the application. Attach a drawing of the mark.):

5B. COLOR CLAIM. Is a claim made to color? <input type="checkbox"/> Yes (go to 5C and 5D) <input type="checkbox"/> No (go to 6)	5C. If yes, claim is made to the following colors: <hr/> <hr/> <hr/>	
5D. COLOR LOCATION STATEMENT. Please include the location of each color (<i>e.g.</i> , a red balloon with a yellow ribbon): <hr/> <hr/>		
6. DISCLAIMER (If Applicable) No claim is made to the exclusive right to use the term: <hr/> <hr/>		
7A. CLASS NUMBER(S)	Class #1: _____ (go to 7B)	Class #2: _____ (go to 7C)
7B. CLASS #1: If a trademark, list specific goods. If a service mark, list specific services: <hr/> <hr/>		
Date the mark was first used in Texas:	Date the mark was first used anywhere:	
7C. CLASS #2: If a trademark, list specific goods. If a service mark, list specific services: <hr/> <hr/>		
Date the mark was first used in Texas:	Date the mark was first used anywhere:	
8. USPTO TRADEMARK REGISTRATION/APPLICATION. Complete the following if the applicant or a predecessor in interest has filed an application to register the mark or portions of the mark with the United States Patent and Trademark Office. Filing _____ Serial/File _____ Status of _____ Date _____ No. _____ Application _____ If Refused, Why? _____ <input type="checkbox"/> Check here if this item does not apply.		
9. MANNER IN WHICH THE MARK IS USED (If more than one (1) class, list the manner in which the mark is used in each class): <hr/> <hr/> <hr/>		

10. SPECIMENS (Check the applicable boxes below and enclose three (3) original specimens supporting the goods/services described in Item 7. Include at least one (1) specimen for each class)

For Trademarks Only

- Actual Labels
- Actual Tags
- Photographs of Goods/Containers Showing the Mark
- Front Panels of a Paper Container Bearing the Mark
- Other: _____

For Service Marks Only

- Advertising Leaflets
- Advertising Brochures
- Menus Showing the Mark
- Business Cards that Reference Services
- Other: _____

11. DECLARATION OF OWNERSHIP

Applicant declares that the applicant is the owner of the mark, that the mark is in use, and that to the knowledge of the person verifying the application, no other person has registered the mark, either federally or in this state, or is entitled to use the mark in this state, either in the identical form used by the applicant or in a form that is likely, when used on or in connection with the goods or services of the other person, to cause confusion or mistake, or to deceive, because of its resemblance to the mark.

12. SIGNATURE AND VERIFICATION

DATE

SIGNATURE OF AUTHORIZED PERSON

TYPE OR PRINT NAME AND TITLE

TO BE COMPLETED BY A NOTARY PUBLIC:

STATE OF _____)
COUNTY _____)

On _____, _____ personally appeared before me, and being first duly sworn declared that he/she signed this application in the capacity designated, if any, above application and the statements therein contained are true and and further stated that he/she has read the above application and the statements therein are true and correct.

(seal)

NOTARY PUBLIC SIGNATURE

TRADEMARK DRAWING SHEET

Instructions: Include the mark exactly as it appears in the samples of use accompanying the application and exactly as it is described in item 5 of the application. Do not include other words that are not part of the mark.

- If the mark consists only of a word, letter or numeral, or a combination thereof, and is not depicted in a special form, type or print the mark in capital letters on the drawing sheet.
- If the mark is not only words, letters or numerals, or a combination thereof, and also includes a design, the entire design must appear on the drawing sheet.
- The drawing *must*
 - Depict only one mark
 - Fit within the box (3.15 in (8 cm) high by 3.15 in (8 cm) long)
 - Be an exact reproduction of the mark
- A mark including a color claim must either
 - Appear in color and match the color(s) described in the color statement.
 - Appear in black and white
- If desired, you may tape a drawing of the mark to this drawing sheet.
- **A black and white reproduction of the mark in the drawing box will appear on the certificate issued, so an electronic reproduction of the mark is recommended.**

