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Registering Trade and Service Marks in Tennessee: A Brief How-To Guide

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REGISTERING TRADE AND SERVICE MARKS IN TENNESSEE: A BRIEF HOW-TO GUIDE

BY BRIAN K. KRUMM* & ZACKARIJ R. GARDNER**

I. A Brief Overview of Trademark Law

Origins

The use of identifying designations has ancient roots, but the development of modern trademark law has more recent origins. Scholars trace early trademark cases to 16th century England. The earliest identified trademark infringement case is *Sandforth's Case*, which was decided in 1584.¹ Although the opinion in that case is lost to time, another case, *Southern v. How*, detailed the pertinent facts. In *Sandforth's Case*, a clothier from Gloucestershire known for the fine quality of his wares used a well-known mark to sell clothing in London and “embody the good-will and fame of his business.”² The clothier had “made cloths which were more expensive and more saleable than the cloths of any other, and he put a special mark on them which no other clothier had before that.”³ Another clothier had “counterfeited said mark and placed it on his cloths, which were not as good but which he sold at the same price as the other by this deceit; [it] was deemed that the action was against him in this case.”⁴

It is unknown whether a purchaser or the clothier who owned the mark brought the action against the infringing party.⁵ The complaint alleged that the defendant willfully schemed “to hinder the . . . plaintiff in selling such cloths of his and to take away and worsen the opinion and esteem which the aforesaid merchants and subjects had concerning the cloths of the same plaintiff.”⁶

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¹ Keith M. Stolte, *How Early Did Anglo-American Trademark Law Begin? Any Answer to Schechter's Conundrum*, 8 *FORDHAM IP, MEDIA & ENT. L. J.* 505 (1998).

² *Id.* at 514.

³ *Southern v. How*, 2 *Rolle's Reports* 26, 71 Eng. Rep. 635.

⁴ *Id.*

⁵ *Id.*

⁶ *Id.*

However, it is to *Sandforth's Case* that Anglo-American trademark jurisprudence traces its origins. Since then it has continued to grow and change.

The Importance of Branding

The *Sandforth's Case* provides valuable insight into the importance of branding to manufacturers and service providers. In that case the purchaser associated the distinctive mark as a source of quality, which set it apart from products made from other inferior clothiers. In modern times, brands and brand management have become an increasingly more important aspect of business strategy. However, a successful brand encompasses far more than an indication of source and quality.⁷ From a marketing perspective, a brand is characterized as a complex symbol that incorporates consumers' motives, feelings, logic, and attitudes.⁸ Businesses establish brands in an effort to encourage consumers to purchase a product or service at a higher price than they otherwise would.⁹ To accomplish this objective, manufacturers' and service providers' coordinate their "use of design, packaging, graphics, logos, advertising, promotion, public relations, marketing, distribution pricing, communications, and other strategies to create a durable identity and loyalty with their consumers."¹⁰ Branding, therefore, is the communication of characteristics, values, and attributes that clarify what the particular brand is and is not.

Trademarks are the ultimate expression of branding. Entrepreneurs wishing to promote brand identity and loyalty of their product or service through the use of a trademark are encouraged to consider the full range of branding issues. Consider the multinational corporation, Google. Until approximately ten years ago, "google" was a term known only to math geeks and represents a 1 followed by 100 zeroes. Today, Google is the dominant player in web search and offers a diverse product line that includes email, web apps, advertising and tracking tools. From a branding perspective, it would have been much easier for Google's founders to name their startup "The Web Search Company" or "Internet Search Site." Those names would clearly inform the public of the services offered. However, those words also describe services offered by Yahoo! and Bing. By choosing a descriptive name for a brand or business, consumers may be confused as to which business is associated with that brand. Instead, by choosing the word google, the public must take an extra logical step to understand the services offered by Google. Fifteen years ago, no one readily associated the word "google" with an Internet search service, but now such Internet searches are routinely characterized as "I will just Google it."

⁷ Deven R. Desai and Spencer Weber Waller, *Brands, Competition and the Law*, 2010 BYU L. REV. 1425, 1429 (2010).

⁸ Burleigh B. Gardner & Sidney J. Levy, *The Product and the Brand*, 33 HARV. BUS. REV., Mar.–Apr. 1955, at 33 (1955).

⁹ Desai & Waller, *supra* note 7, at 1427.

¹⁰ *Id.* at 1431.

What is Trademark Law?

“Trademark law” is a legal doctrine which has developed to protect consumers from being misled. Trade and service marks enable consumers to identify goods and services which have performed well or satisfied the consumers in the past and reject those which have not.¹¹ This helps to minimize the unnecessary waste of time and effort of consumers by allowing them to forgo thorough inspection and evaluation of goods or services every time they seek to purchase a good or service. Having identified a mark representing a satisfactory good or service, consumers may rely on that mark’s reputation in the future. This, in turn, encourages the mark holder to maintain or improve the quality of its goods or services. If the mark holder does not at least maintain the quality (or if a competitor offers superior quality at a competitive price point), discerning consumers will look elsewhere.

On a normative basis, then, trademark law “foster[s] the flow of information in markets [which] reduce[s] search costs for consumers.”¹² Indeed, the United States House of Representatives recognized this fact when passing the Lanham Act, stating in the House Report that “[trade and service marks] make possible a choice between competing articles by enabling the buyer to distinguish one from the other . . . [while] encourage[ing] the maintenance of quality by securing to the producer the benefit of the good reputation which excellence creates.”¹³

Additionally, the trademark prevents traders from having their trade or service unfairly diverted by competitors.

What are Trade and Service Marks?

Generally speaking, trademarks are words, phrases, logos and symbols used by producers to identify their goods. However, fragrances, sounds, shapes, and colors may also be registered as trademarks.¹⁴

Trademark law has also expanded to include areas of the law such as trade dress. Most words, names, symbols, labels, or other devices capable of

¹¹ J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 2.30 (4th ed. 2008) [hereinafter MCCARTHY].

¹² Stacey L. Dogan & Mark A. Lemley, *Trademarks and Consumer Search Costs on the Internet*, 41 HOUS. L. REV. 777, 778 (2004).

¹³ H.R. Rep. No. 79-1333, at 1274-75 (1946).

¹⁴ See *Qualitex v. Jacobsen Products Co., Inc.*, 514 U.S. 159 (1995) (stating that [t]he courts and the Patent and Trademark Office have authorized for use as a mark a particular shape (of a Coca-Cola bottle), a particular sound (of NBC’s three chimes), and even a particular scent (of plumeria blossoms on sewing thread)) (*citing* Registration No. 696,147 (Apr. 12, 1960); Registration Nos. 523,616 (Apr. 4, 1950) and 916,522 (July 13, 1971); *In re Clarke*, 17 U.S.P.Q.2d 1238, 1240 (TTAB 1990).

distinguishing the source of goods may be used as a trademark—subject to a few restrictions. For example, a mark's eligibility for trademark protection may be limited by application of the “functionality doctrine,”¹⁵ and if the mark falls within any of the categories listed under 15 U.S.C. § 1052 (discussed below), then it may be denied registration.

Requirements for Trademark Protection

To be eligible for trademark protection, a mark must meet two basic requirements. First, the mark must be in use in commerce. Second, the mark must be unique or distinctive. The Lanham Act defines a trademark as (i) a mark used in commerce, or (ii) registered with a *bona fide* intent to use it in commerce.¹⁶ If a mark is not in use in commerce at the time the application for registration is filed, registration is still possible if the applicant establishes a good faith intent to use the mark in commerce at a future date.¹⁷ Except in the case of intended use, exclusive use of a trademark is given to the person or entity to first use it in commerce.

The second requirement, known as the “distinctiveness” requirement, serves the multifaceted purpose of identifying those marks capable of distinguishing and identifying products or services of one source from those of another source. Trademarks are traditionally divided into four primary categories of distinctiveness: (i) arbitrary or fanciful, (ii) suggestive, (iii) descriptive, and (iv) generic.¹⁸ If a mark is categorized as either arbitrary (including fanciful marks) or suggestive, it is considered distinctive and exclusive rights to the mark are determined solely by priority of use (i.e., date of first use). A trademark that is categorized as descriptive is protected as a trademark only after a secondary meaning to consumers has been established. Secondary meaning is also necessary to establish trademark protection for a personal name or a geographic term. Generic terms are never distinctive and are not eligible for trademark protection because they refer to a general class of products rather than indicating a unique source. A mark may be generic *ab initio* and refused registration, or it may become generic over time through use (for example, aspirin).

¹⁵ The functionality doctrine limits the breadth of trademark law so that it does not have the effect of inhibiting legitimate competition by allowing a producer to control a useful or “functional” product feature. *See* *Qualitex Co.*, 514 U.S. 159. A product feature is deemed functional, and cannot serve as a trademark, if it is essential to the use or purpose of the article or if it has an effect on the cost or quality of the article. *See Id.* The doctrine prevents the use of a product feature as a trademark where such use would put competitors at a significant non-reputation-related disadvantage.

¹⁶ *See* 15 U.S.C. § 1127 (2006) [emphasis added].

¹⁷ *See* 15 U.S.C. § 1051 (2002). Section 1051 also requires that the intent be established in writing. *Id.*

¹⁸ *See Zatarain's, Inc. v. Oak Grove Smoke House, Inc.*, 698 F.2d 786 (5th Cir. 1983).

Registration Generally – Benefits and the Law Governing the Application

Notwithstanding the requirement of distinctiveness, rights in a trademark are acquired by use, not registration. Federal protection is granted to unregistered marks under 15 U.S.C. § 1125(a), which creates a civil cause of action for claims of false designation of origin and false advertising.¹⁹ Registration is, however, *prima facie* evidence of a mark's validity and the mark-owner's exclusive right to use the registered mark in commerce on the goods or services detailed in the registration.²⁰ Although registration is not a prerequisite to federal trademark protection, registered marks enjoy significant advantages over unregistered marks. For example, registration serves as nationwide constructive notice of ownership and use of the mark under 15 U.S.C. § 1072;²¹ and a registered mark may achieve incontestable status after five years of continuous use under 15 U.S.C. § 1065, which enhances the owner's rights by eliminating a number of defenses to claims of infringement.²²

The duration of a registered mark is for a term of ten years (five in Tennessee),²³ however, a mark is automatically cancelled six years after registration is granted unless the mark-holder files (a) an affidavit stating that the mark is in use in commerce or (b) an affidavit showing excusable non-use (i.e., special circumstances and not due to intent to abandon the mark).²⁴ Mark-holders may perpetually renew registration of their marks for periods of 10 years so long as the mark is renewed within one year of the end of each 10 year term.²⁵

Certain marks may not be registered for a number of reasons. 15 U.S.C. § 1052 lists the various grounds for refusal to register a mark. Marks that are, for example, merely descriptive or deceptively misdescriptive without obtaining a secondary meaning, are deceptive, are primarily geographically deceptively misdescriptive, are confusingly similar to prior-registered marks, or are misdescriptive geographic indications of wine or liquor where the marks were first used on or after January 1, 1996.²⁶ Additionally, the Federal Circuit has stated

¹⁹ 15 U.S.C. § 1125(a) (2012).

²⁰ 15 U.S.C. § 1115(a) (2002).

²¹ *See* *Geoffrey Inc. v. Toys R Us, Inc.*, 756 F. Supp. 661 (D.P.R. 1991) (holding that the plaintiffs' registration of the mark "Toys R Us," triggered nationwide—including U.S. territories—protection and provided constructive notice of the plaintiffs' ownership of the mark to defendants in Puerto Rico")

²² 15 U.S.C. § 1065 (2010).

²³ 15 U.S.C. § 1068(a) (2000); TENN. CODE ANN. 47-25-506(a) (West 2013) (stating that the term of trade and service marks is for five years and that renewal of such marks must be made within six months of the marks expiration).

²⁴ 15 U.S.C. § 1068(a).

²⁵ 37 C.F.R. § 2.182 (1999).

²⁶ 15 U.S.C. § 1052(e) (2006).

that a generic term is “the ultimate in descriptiveness” and should be therefore barred.²⁷ This is so because such marks could not possibly be distinctive or indicative of a particular source in the mind of a consumer.

Application Examination Process Generally

The United States Patent and Trademark Office (PTO) actively examines applications²⁸ for trademark registration and—along with the court system—regulates the trademark registers. If an application for registration is denied, the applicant will have six months to reply or to amend the application, which will then be reexamined. This procedure may be repeated until one of the following occurs: (1) the examiner issues a final refusal of registration, or (2) the applicant fails to reply, amend or appeal for a period of six months.²⁹

Once an application for registration is approved, it is published in the Official Gazette of the PTO for opposition.³⁰ Any person who believes that he or she will be damaged by the registration of a mark may file an opposition.³¹ An opposing party must plead and prove that: (1) he or she is likely to be damaged by registration of the applicant's mark; and (2) that there are legally valid grounds why the applicant is not entitled to register the claimed mark. If registration is unsuccessfully opposed, the mark will be registered.³² Additionally, any person who believes that he or she is or will be harmed by the registration may file a petition for cancellation of registration *within five years* after a trademark has been registered in the PTO.³³

II. Tennessee Registration

Why File in Tennessee?

There are several reasons to file in Tennessee prior to filing at the federal level. First, state registration allows the registrant to have a certain, state acknowledged date of first use, which is necessary if a client intends on filing federally on a “use in commerce basis.”³⁴

Second, Tennessee state registration is a much quicker and less costly means of protecting one's mark—registration can be approved in as little as a

²⁷ *Bellsouth v. Data National Corp.* 60 F.3d 1565 (Fed. Cir. 1995).

²⁸ See Part III below for a step-by-step guide for applying for Federal trademark registration.

²⁹ See 15 U.S.C. § 1062 (2000); 37 C.F.R. §§ 2.61 - 2.69.

³⁰ See, e.g., 15 U.S.C. § 1062; 37 C.F.R. § 2.80 (1976).

³¹ See, e.g., 15 U.S.C. § 1063 (2006); 37 C.F.R. §§ 2.101 - 2.106.

³² See 15 U.S.C. § 1063.

³³ See, e.g., 15 U.S.C. § 1064 (2006); 37 C.F.R. §§ 111 - 114.

³⁴ See Step 5 of Part III.

week while federal registration can take more than six months. If the client is a small business that does not intend to file federally or lacks the resources to do so, they may wish to protect their mark while avoiding needless additional costs. The time-consuming nature of federal filing also requires a higher filing fee (a minimum \$225 versus a minimum \$20 for a Tennessee filing)³⁵ and will cost the client additional attorney's fees due to the more intensive nature of federal filing.

Last, if there is infringement of one's state-registered mark, the registrant may elect to seek recourse in Tennessee courts rather than federal courts, which, if forced to go to trial, would allow the registrant to avoid the nearly two year median interval between filing and judgment in federal courts.³⁶ Tennessee permits a registrant to seek civil remedies for infringement,³⁷ dilution, and injury to business reputation.³⁸ Tennessee law permits a court to award, in its discretion, up to three times the actual damages (including loss of business) and attorney's fees.³⁹

Infringement includes any use without the consent of the registration including any reproduction, counterfeit, copy, or colorable imitation of a mark registered under with the Tennessee Secretary of State in connection with a commercial purpose which is likely to cause confusion, mistake, or deception as to the source of origin of the goods or services in question.⁴⁰ It also includes any person who "reproduces, counterfeits, copies, or colorably imitates any [registered] mark and applies such reproduction, counterfeit, copy or colorable imitation labels, signs, prints, packages, wrappers, receptacles, or advertisements" intended to be used in commerce.⁴¹ Finally, it also includes using the trade name or mark, or confusingly similar name or mark, of banking and other commercial institutions if such use is likely to cause confusion as to origin, affiliation, or sponsorship of products or services.⁴²

³⁵ See TENNESSEE TRADEMARK REGISTRATION APPLICATION, Form SS-4264, *available at* <http://www.tn.gov/sos/forms/ss-4264.pdf>.

³⁶ US District Courts – Median Time Interval From Filing and Disposition in Civil Cases Terminated, by District and Method of Disposition During 12-Month Period Ending September 30, 2010, Administrative Office of U.S. Courts, *available at* <http://www.uscourts.gov/uscourts/Statistics/JudicialBusiness/2010/appendices/C05Sep10.pdf>.

³⁷ TENN. CODE ANN. § 47-25-512 (2013).

³⁸ TENN. CODE ANN. § 47-25-513 (2000).

³⁹ TENN. CODE ANN. § 47-25-514(a) (2000).

⁴⁰ TENN. CODE ANN. § 47-25-512(1).

⁴¹ *Id.* at (2).

⁴² *Id.* at (3).

Dilution, under Tennessee law, is open to marks “famous” in Tennessee.⁴³ A famous mark may enjoin another person’s commercial use of a mark or trade name “if such use begins after the mark has become famous and causes dilution of the distinctive quality of the mark.”⁴⁴ If it is shown that the infringement was willful, the mark holder may seek monetary damages.⁴⁵

Actions to cancel a mark registered in Tennessee or to compel registration of a mark must be brought in the circuit court of Davidson County, Tennessee.⁴⁶ Actions against nonresident registrants may be served upon the Tennessee Secretary of State.⁴⁷

These rules supplement and do not override or otherwise abrogate any common law trade and service mark rights. Thus, a registrant may pursue

⁴³ TENN. CODE ANN. § 47-25-513(a).

⁴⁴ *Id.* Factors for determining whether a mark is distinctive and famous include, but are not limited to:

- (1) The degree of inherent or acquired distinctiveness of the mark in this state;
- (2) The duration and extent of use of the mark in connection with the goods and services with which the mark is used;
- (3) The duration and extent of advertising and publicity of the mark in this state;
- (4) The geographical extent of the trading area in which the mark is used;
- (5) The channels of trade for the goods or services with which the mark is used;
- (6) The degree of recognition of the mark in the trading areas and channels of trade in this state used by the mark's owner and the person against whom the injunction is sought;
- (7) The nature and extent of use of the same or similar mark by third parties; and
- (8) Whether the mark is the subject of a state registration in this state, or a federal registration under the Act of March 3, 1881, or under the Act of February 20, 1905, or on the principal register.

Id.

⁴⁵ *Id.* at (b).

⁴⁶ TENN. CODE ANN. § 47-25-515(a) (2013).

⁴⁷ *Id.* at (b).

statutory and common law infringement and unfair trade actions upon infringing parties.⁴⁸

Differences between Federal and State Registration

There are several significant differences between state and federal trademark registration. First, as was mentioned above, is the time factor: it is simply a shorter, less time-consuming process to file at the state level than it is to file at the federal level. Second is the wide-reaching effect of federal registration: once you register federally, you have a nationally recognized trademark. That is, a federally registered mark gives a presumption of validity to a mark throughout the United States. A state mark only creates that presumption within a single state. Third, registration at the federal level trumps registration at the state level under Tennessee law. Tennessee law states that if a mark is registered at the federal level prior to registration of a confusingly similar mark in Tennessee, then the Tennessee-registered mark will be cancelled.⁴⁹ Additionally, there is no statute of limitations period for cancellation of a mark in Tennessee, but federal law requires a party seeking cancellation to do so within five years or else the mark will be conclusively presumed to be valid.⁵⁰ Fourth, federal registration gives third parties *national* notice of the mark whereas state registration merely gives notice to others within the bounds of a particular state. This means that a Tennessee-registered mark is given no statutory protection from another party using the same or similar mark in commerce in Georgia or Kentucky. Lastly, a federally-registered mark is more beneficial for companies and individuals operating an interstate business, while a state-registered mark is beneficial for those operating only within one state. With that being said, if one works primarily within one or a few states, it will be beneficial to file for state registration during the pendency of a federal application. This ensures that a mark will have at least state-level protection.

Requirements for Registration

A mark shall not be registered in Tennessee if it consists of (1) immoral, deceptive, or scandalous subject matter; (2) subject matter which may disparage or falsely suggest a connection with persons, institutions, beliefs, or national symbols, or otherwise defames them; (3) the flag, coat of arms, or other insignia of the U.S., or its states and municipalities, or of a foreign nation; (4) the name, signature, or portrait identifying a particular living individual without their consent; (5) a mark which is (i) merely descriptive or deceptively misdescriptive (ii) geographically descriptive or deceptively misdescriptive; or (iii) merely a surname; or (6) a mark which is likely to cause confusion, mistake, or deception.⁵¹

⁴⁸ TENN. CODE ANN. § 47-25-516 (2000).

⁴⁹ TENN. CODE ANN. § 47-25-509(3)(F) (2013).

⁵⁰ 15 U.S.C. § 1064 (2006); 37 C.F.R. §§ 111 - 114.

⁵¹ TENN. CODE ANN. § 47-25-502 (2013).

The Tennessee application for registration of a mark is detailed in Tennessee Code section 47-25-503. The application must set forth the following information:

- (1) The name and business address of the person applying for such registration; and, if a corporation, the state of incorporation, or if a partnership, the state in which the partnership is organized and the names of the general partners, as specified by the secretary;
- (2) The goods or services on or in connection with which the mark is used, the mode or manner in which the mark is used on or in connection with such goods or services and the class in which such goods or services fall;
- (3) The date when the mark was first used anywhere and the date when it was first used in this state by the applicant or a predecessor in interest; and
- (4) A statement 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, either federally or in this state, or has the right to use such mark either in the identical form thereof or in such near resemblance thereto as to be likely, when applied to the goods or services of such other person, to cause confusion, or to cause mistake, or to deceive.⁵²

As of July of 2013, a registrant's application must include only one specimen sample of the mark as actually used in commerce.⁵³ Additionally, the application must be signed and verified by the applicant or its agent or representative.⁵⁴ The Tennessee Secretary of State may also require other information.⁵⁵ This information will be indicated on the Tennessee Form SS-4264.⁵⁶

Step-by-Step Guide to Tennessee Filing:

Step 1: Discuss the Mark with Your Client

This may sound obvious, but this is crucial for a couple of reasons:

⁵² TENN. CODE ANN. § 47-25-503(a) (2013).

⁵³ *Id.* at (e). Prior to July 1, 2013, the statute required the registrant's application to include three specimens showing the mark as actually used. TENN. CODE ANN. § 47-25-503 (West 2012) (current version at TENN. CODE ANN. § 47-25-503(e)).

⁵⁴ TENN. CODE ANN. § 47-25-503(d). Verification includes having the application duly notarized. TENNESSEE TRADEMARK REGISTRATION APPLICATION, Form SS-4264, available at <http://www.tn.gov/sos/forms/ss-4265.pdf>.

⁵⁵ TENN. CODE ANN. § 47-25-503(a)-(c).

⁵⁶ TENNESSEE TRADEMARK REGISTRATION APPLICATION, Form SS-4264.

1. First, you will need to know what goods or services the mark is used in conjunction with. This will aid in determining the classification of the mark.⁵⁷ This is important because the classifications registered will define the breadth of your client's statutory trademark protection—one may only seek statutory trademark protection for a mark that has been used in conjunction, or is anticipated to be used in conjunction with, a good or service.⁵⁸
2. Second, you will need to determine how the mark has been used—that is, was it used on a storefront sign, in advertising (print, television, internet, etc.), on receipts, on service orders, on brochures or pamphlets, or a number of other ways. The crucial point here is the necessity to fully understand how the mark has been used so that you can more adequately assist your client in protecting their trade or service mark(s) at both the state and federal level.

Step 2: Perform a Search on the Tennessee Secretary of State Website (http://www.tn.gov/sos/bus_svc/TrademarkSearch.htm)

1. Once you arrive at the Trademark Search page, enter a number of terms that might lead you to a registered trademark. For example, if one were to look for the trademarked term “NFL,” one would simply search “NFL.” This brings up a number of results, including the NFL we are looking for (the National Football League's registered trademark). It also brings up “Inflamacool” and “Boing Boing Inflatables.” Since these include a similar letter order, they were included in the search results.
2. It may also be good to thoroughly search similar terms to make sure a registered trade or service mark is not missed. For example, for the name “Tradeprints,” one would search not only “Tradeprints” but “Trade,” “prints,” “tradeprint,” or a number of other potential combinations.

Step 3: Download the Tennessee Trademark Application

1. Go to the Tennessee Secretary of State's trademark webpage (http://tn.gov/sos/bus_svc/trademarks.htm);
2. Next, under “Forms” find the “Registration of Trademark/Service Mark” link and click it;

⁵⁷ See TENN. CODE ANN. § 47-25-510 (2000).

⁵⁸ See TENN. CODE ANN. § 47-25-512 (2013).

3. You will then be viewing (or downloading depending on your browser's settings) a PDF copy of the Tennessee Trademark Application.

Step 4: Read the Trademark Application Thoroughly and Complete the Portion of the Application Pertaining to Your Client's Personal Information (name, address, phone number, etc.)

Step 5: Determine the Date of First Use (both outside and inside Tennessee)

1. You first need to determine when your client first used the Trademark/Service mark in commerce. This could be an advertisement, business card, brochure, order form, or any number of other things. However, you must be certain of the exact date—day, month, and year.
2. Second, you need to determine when the mark was first used in commerce within the state of Tennessee. Again, you must be certain of the exact day, month, and year.

Pertinent statutory language:

"Use" means the bona fide use of a mark in the ordinary course of trade, and not made merely to reserve a right in a mark. For the purposes of this part, a mark shall be deemed to be in use:

(A) On goods when it is placed in any manner on the goods or other containers or the displays associated therewith or on the tags or labels affixed thereto, or if the nature of the goods makes such placement impracticable, then on documents associated with the goods or their sale, and the goods are sold or transported in commerce in this state; and

(B) On services when it is used or displayed in the sale or advertising of services and the services are rendered in this state.⁵⁹

Step 6: Refer to Step 1 (understanding the good or service that the mark will be used in conjunction with)

1. Here (items 5 and 6 of the application) you will state what goods or services the mark is used in conjunction with and *how* the mark will be used. In line 5, you state the goods or services (for example, if your client is in the business of selling fresh produce, then you will state "fresh produce including fruits and vegetables," or a similar description).

⁵⁹ TENN. CODE ANN. § 47-25-501(11) (2013).

2. In line 6, you will state *how* the item will be used. For example, you will list if a client uses the mark on tags, receipts, banners, advertisements (print, television, etc.), letterhead, store signs, etc.

Note: Be as thorough as possible, but do not go over the allotted space on the application unless necessary—otherwise, you will need to attach additional pages to the application and incur an additional fee.⁶⁰

Step 7: Choosing the Correct Classification(s)

1. On line 7 of the Tennessee Trademark Application you will enter the classification numbers and names.
 - a. The classification names and numbers are listed at the end of the Tennessee Trademark Application and can also be found in the Code of Federal Regulations. 61
 - b. When listing the names, list as much of the name as you can. If you have multiple classification names to list, give a portion of the name and indicate that it is a portion, using ellipses to indicate the name is truncated and backslashes to indicate the start of a second classification name.⁶²
2. If you are unsure of the classification, the USPTO supplies a very useful tool that allows you to search the type of products/services the mark is associated with, giving you the correct classification number. The tool is the U.S. Acceptable Identification of Goods and Services Manual, and can be found at <http://tess2.uspto.gov/netahtml/tidm.html> (referred to as the the “ID Manual” on the Federal Registration Application). For example, if the applicant sells purses, search “purse” and it will tell you the correct classification (in this case, class 18).

⁶⁰ As of November 2013, the fee is an additional \$20 per page. See TENNESSEE TRADEMARK REGISTRATION APPLICATION, Form SS-4264, available at <http://www.tn.gov/sos/forms/ss-4264.pdf>.

⁶¹ 37 C.F.R. § 6.1 (2015); see TENN. CODE ANN. § 47-25-510 (stating that “[t]o the extent practical, the classification of goods and services should conform to the classification adopted by the United States patent and trademark office.”).

⁶² This was the procedure that the Secretary of State’s Business Services offices advised.

Step 8: Determining the Proper Filing Fee

1. There are several factors that may impact the filing fee.⁶³ First is the base application fee—\$20. Second, the number of classifications affect the cost of filing the application. Each classification beyond the first adds \$20 to the filing fee. For example, if you have two classifications, it will cost a total of \$40—\$20 for the application and \$20 for the additional classification. Finally, if you must append additional pages to the application, each page adds \$20 to the filing fee. For example, if you have a two-classification filing that requires an additional page, the total fee will be \$60—\$40 for the two classifications and \$20 for the additional page.
2. After determining the proper filing fee, you must determine the form of payment.⁶⁴ The Trademark office accepts the following forms of payment by mail: check, money order, and certified check. If you are delivering the application in person, payment may be in cash in addition to the above forms of payment.

Further Reading

- Trademark Guide from the Tennessee Secretary of State, available at <http://www.tn.gov/sos/forms/tm-guide.pdf>.
- Tennessee Trademark Act of 2000 – Tenn. Code Ann. § 47-25-501 *et seq.*, available at <http://www.state.tn.us/sos/acts/101/pub/pc671.pdf> (also available on Westlaw, LexisNexis, or other legal databaseS).

III. Federal Registration⁶⁵*Step 1: Identify the Mark and How it Will be Used*

1. See Part II, Step 1 above for more information.

Step 2: Identify the Mark Format⁶⁶

Three possible mark formats are available:

⁶³ See TENN. COMP. R. & REGS. 1360-07-01-.02 (2015).

⁶⁴ See TENNESSEE TRADEMARK REGISTRATION APPLICATION, Form SS-4264, available at <http://www.tn.gov/sos/forms/ss-4264.pdf>.

⁶⁵ See UNITED STATES PATENT AND TRADEMARK OFFICE, *TRADEMARK PROCESS*, TRADEMARKS (Feb. 10, 2015, 1:56 PM), <http://www.uspto.gov/trademarks-getting-started/trademark-process> (listing and summarizing the following 18 steps for Federal Registration).

⁶⁶ See UNITED STATES PATENT AND TRADEMARK OFFICE, *Representation of the Mark*, TRADEMARKS (Dec. 14, 2011, 5:20 PM), <http://www.uspto.gov/trademarks-getting-started/trademark-basics/representation-mark>.

- (1) standard character format;
- (2) stylized/design format; or
- (3) sound mark.

The standard character format should be used to register words, letters, numbers, or any combination thereof, without claim to any particular font style, size, or color, and absent any design element. Registration of a mark in the standard character format will provide broad rights, namely use in any manner of presentation.

The stylized/design format, on the other hand, is appropriate if you wish to register a mark with a design element and/or word(s) and/or letter(s) having a particular stylized appearance that you wish to protect.

Formats (1) and (2) may not be mixed in one mark. DO NOT submit a representation of a mark that attempts to combine a standard character format and a stylized/design format. It will be rejected. If both forms need to be registered, it is necessary to file separate applications for registration.

Step 3: Identifying the Precise Goods and Services (or both) to Which the Mark Will Apply

1. See Part II, Steps 1 and 7 above (regarding the determination of Classifications).
2. If you are having trouble determining the proper classification of the goods or services associated with the mark, use the USPTO's "U.S. Acceptable Identification of Goods and Services Manual,"⁶⁷ available at <http://tess2.uspto.gov/netahhtml/tidm.html>. This is a search database that allows you to search for types of goods and services and receive results that include the proper classification number.
3. Once you have the proper class number, look up the class name to save with your records (this will help save time while filling out the application).

Step 4: Performing a Search of the Federal Trademark Database⁶⁸

1. Perform a search on the USPTO's trademark website, available at <http://tess2.uspto.gov/bin/gate.exe?f=tess&state=4006:tpdo6v.1.1> or <http://tess2.uspto.gov/bin/gate.exe?f=tess&state=4804:l08x58.1.1>, to

⁶⁷ "ID Manual" on the TEAS Plus or TEAS Regular applications.

⁶⁸ See UNITED STATES PATENT AND TRADEMARK OFFICE, *Searching Marks in USPTO Database*, TRADEMARKS (Dec. 14, 2011, 5:58 PM), <http://www.uspto.gov/trademarks-getting-started/trademark-basics/searching-marks-uspto-database>.

make sure that no one else is using the mark or that no mark exists that may be confusingly similar to the one you wish to register.

2. Unlike the Tennessee trademark search, the federal search allows one to search for designs (i.e., an image search) instead of just having a word search. However, this adds another layer of complexity to performing a trademark search. You will need to consult the “Design Search Code Manual,” available at <http://tess2.uspto.gov/tmdb/dscm/index.htm>.
3. The Design Search Code Manual details the general guidelines for using the search tool under the aptly named “General Guidelines” link on the page listed above under Step 4 Part 2. One can also access the “Design Search Code” from the link above, which explains the codes necessary to search for types of images (for example, an “acorn” shape is listed under code number 05.07.07, while “oranges” are listed under 05.09.03).
4. Good advice: Be sure to consult the Design Search Code Manual before doing any search—small changes can impact the precise code that should be used in a design search. *Always consult the Design Search Code Manual.*

*Step 5: Determine Your Basis for Filing*⁶⁹

*To complete this step, it may be necessary to consult the Trademark Manual of Examining Procedure (the “TMEP”) (available at <http://tmep.uspto.gov/RDMS/detail/manual/TMEP/Oct2012/d1e2.xml> <http://www.uspto.gov/trademark/guides-and-manuals/trademark-manual-examining-procedure-april-2014>).

1. There are two primary bases for filing that this guide will focus on: (1) use in commerce, or (2) intent to use. Prior to registration for either “use in commerce” or “intent to use,” an applicant must demonstrate that they have used the mark in commerce. The types of commerce encompassed in this definition are interstate, territorial, and between the United States and a foreign country.
2. If filing under a “use in commerce” basis,⁷⁰ the applicant must:
 - (a) Submit a verified statement that the mark is in use in commerce on or in connection with the goods or services listed in the application.⁷¹ If this verified statement is not filed

⁶⁹ See UNITED STATES PATENT AND TRADEMARK OFFICE, *Basis for Filing*, TRADEMARKS (Dec. 15, 2011, 1:05 PM), <http://www.uspto.gov/trademarks-getting-started/trademark-basics/basis-filing>.

⁷⁰ 15 U.S.C. §1051(a) (2002).

⁷¹*Id.* at (a)(3)(C); see 37 C.F.R. § 2.34(a)(1)(i) (2012).

with the initial application, the verified statement must also allege that the mark was in use in commerce on or in connection with the goods or services listed in the application as of the application filing date;⁷²

- (b) Specify the date of the applicant's first use of the mark anywhere on or in connection with the goods or services;⁷³
 - (c) Specify the date of the applicant's first use of the mark in commerce as a trademark or service mark;⁷⁴ and
 - (d) Submit one specimen for each class, showing how the applicant actually uses the mark in commerce.⁷⁵
3. If filing under an "intent-to-use" basis,⁷⁶ the applicant must submit a verified statement that the applicant has a bona fide intention to use the mark in commerce on or in connection with the goods or services listed in the application.⁷⁷ If the verified statement is not filed with the initial application, the verified statement must also allege that the applicant had a bona fide intention to use the mark in commerce on or in connection with the goods or services as of the filing date of the application.⁷⁸

Prior to registration, the applicant must file "an allegation of use" (i.e., either an amendment to allege⁷⁹ use under 15 U.S.C. §1051(c) or a statement of use⁸⁰ under 15 U.S.C. §1051(d)) that states that the applicant is using the mark in commerce on or in connection with the goods or services, includes dates of use and a filing fee for each class, and includes one specimen evidencing such use for each class. Once an applicant claims a §1(b) basis for any or all of the goods or services, the applicant may not amend the application to seek registration under §1(a) of the Act for those goods or services unless

⁷² 37 C.F.R. § 2.34(a)(1)(i).

⁷³ *Id.* at (a)(1)(ii); *see* TMEP, § 903.01 (5th ed. 2007).

⁷⁴ 37 C.F.R. §2.34(a)(1)(iii); *see* TMEP § 903.02.

⁷⁵ 37 C.F.R. §§ 2.34(a)(1)(iv); *see id.* §2.56; TMEP §§ 904 *et seq.*

⁷⁶ 15 U.S.C. § 1051(b).

⁷⁷ *Id.* at (b)(3)(B).

⁷⁸ 37 C.F.R. §2.34(a)(2).

⁷⁹ *See* 37 C.F.R. § 2.76 (2012); TMEP §§ 1104 *et seq.*

⁸⁰ *See* 37 C.F.R. § 2.88 (2012); TMEP §§1109 *et seq.*

the applicant files an allegation of use under §1(c) or §1(d) of the Act.⁸¹

4. Use is established by providing the date of first use of the mark anywhere and the date of first use of the mark in commerce, as well as submitting a specimen (example) showing how you use the mark in commerce. Under certain international agreements, it is possible to file in the U.S. based on a foreign application, foreign registration, or international registration.⁸²

*Step 6: Filing your Federal Trademark Application Online*⁸³

1. First, you must choose whether you are going to use the TEAS Plus or TEAS regular forms. If filed electronically, the Plus is \$225 per classification to file while the regular is \$325 per classification.⁸⁴ TEAS Reduced Fee (TEAS RF) is a new application filing option with a fee of \$275 per class of goods/services, which promotes electronic communication and application processing while giving applicants more flexibility in identifying their goods and/or services. The Plus requirements are also stricter. The TEAS Plus system is similar to the regular TEAS electronic filing system, only it has additional filing requirements that the TEAS does not include. In order to use TEAS Plus electronic filing, the applicant must:
 - a. File a "complete" application - most of the fields are mandatory, including some you could leave blank with TEAS;
 - b. Select the description of goods and/or services from the Manual of Acceptable Identifications of Goods and Services. If you want to use a description that is not in the manual, you can request to have it added by emailing it to TMIDSUGGEST@uspto.gov;
 - c. Pay in full at the time of filing for all classifications covered by the application;
 - d. Agree to file future correspondence, such as responses to Office Actions, through TEAS; and

⁸¹ 37 C.F.R. § 2.35(b)(8) (2014).

⁸² See generally TMEP Chapters 1000 and 1900 for more information.

⁸³ See UNITED STATES PATENT AND TRADEMARK OFFICE, *Filing Your Application Online*, TRADEMARKS (Jan. 17, 2015, 6:03 AM), <http://www.uspto.gov/trademarks-application-process/filing-online/filing-your-application-online>.

⁸⁴ *Id.*

- e. Agree to receive communications from the Examining Attorney via email.⁸⁵

If you have a mark that will be used for fairly easily described goods and/or services, TEAS Plus saves some money on filing fees. Otherwise, it is best to use the TEAS Regular due to the less strict requirements.

Additionally, if you use TEAS Plus, you must pay an additional fee of \$50 per class if at any time during the examination of the application the USPTO determines that

- (1) The application did not meet the TEAS Plus requirements as of the filing date;
 - (2) You file a paper form after the initial application when a TEAS form exists for that purpose (e.g., a Response to an Office action); and/or
 - (3) You refuse to receive correspondence from the USPTO by e-mail during the pendency of the application.⁸⁶
2. Next, read the application thoroughly. PDF copies are available at http://www.uspto.gov/trademarks/teas/new_tas_plus.pdf (Plus) and http://www.uspto.gov/trademarks/teas/new_tas.pdf (Regular). These PDFs MAY NOT be filed—they are for review purposes only. You must use the TEAS electronic form for online filing, available at <http://www.uspto.gov/teas/teasplus.htm>.
 3. After reading through the application, consult the information you gathered by following the previous steps. This information will be necessary to fill out the application.
 4. When you come to the item requesting you upload a specimen, be sure to have it in the correct format. For images, only .JPG or .PDF files of less than five megabytes (5MB) will be accepted. For video or audio files, .WAV, .WMV, .WMA, .MP3, .MPG, or .AVI files of no more than 5MB for audio files and 30MB for video files are acceptable.
 5. Determine your fee. You will either pay \$225 or \$325 per classification (Plus or Regular, respectively) plus any additional fees applicable under the fee schedule (available at <http://www.uspto.gov/web/offices/ac/qs/ope/fee031913.htm#tm>).

⁸⁵ See TMEP § 819.01.

⁸⁶ UNITED STATES PATENT AND TRADEMARK OFFICE, *Selection of Application Type*, TRADEMARK ELECTRONIC APPLICATION SYSTEM, <http://www.uspto.gov/custom-page/trademarkservice-mark-application-principal-register-0>.

NOTE: If a paper filing is absolutely necessary, it will cost \$375 per classification.⁸⁷

*Step 7: The USPTO Reviews the Application*⁸⁸

1. After the USPTO determines that you have met the minimum filing requirements, an application serial number is assigned and the application is forwarded to an examining attorney.
2. This may take a number of months. The examining attorney reviews the application to determine whether it complies with all applicable rules and statutes, and includes all required fees. Filing fees will not be refunded, even if the application is later refused registration on legal grounds.
3. A complete review includes a search for conflicting marks, and an examination of the written application, the drawing, and any specimen.

*Step 8: USPTO Issues a Letter (Office Action)*⁸⁹

1. If the examining attorney decides that a mark should not be registered, the examining attorney will issue a letter (Office action) explaining any substantive reasons for refusal, and any technical or procedural deficiencies in the application.
2. If only minor corrections are required, the examining attorney may contact the applicant by telephone or e-mail (if the applicant has authorized communication by e-mail).
3. If the examining attorney sends an Office action, the applicant's response to the Office action must be received in the Office within six months of the mailing date of the Office action, or the application will be declared abandoned.

⁸⁷ UNITED STATES PATENT AND TRADEMARK OFFICE, *USPTO Fee Schedule*, OFFICE OF THE CHIEF FINANCIAL OFFICER (Apr. 17, 2015, 12:23 PM), <http://www.uspto.gov/learning-and-resources/fees-and-payment/uspto-fee-schedule>. This guide will not discuss in-depth the paper filing process—it is essentially the same, except one must order an application by contacting the USPTO at (800) 786-9199 and mail the completed application to the Commissioner for Trademarks, P.O. Box 1451, Alexandria, VA 22313-1451.

⁸⁸ UNITED STATES PATENT AND TRADEMARK OFFICE, *Trademark Process*, TRADEMARKS (Feb. 12, 2015, 1:56 PM), <http://www.uspto.gov/trademarks-getting-started/trademark-process>.

⁸⁹ *Id.* This step may be unnecessary if the examiner finds no issues and approves the application.

*Step 9: Response to USPTO Action*⁹⁰

1. You, on behalf of your client, will need to respond to the Office Action letter.
2. If your response does not overcome all objections, the examining attorney will issue a final refusal. To attempt to overcome a final refusal, the applicant may, for an additional fee, appeal to the Trademark Trial and Appeal Board (the “TTAB”), an administrative tribunal within the USPTO.

*Step 10: USPTO Approves the Application*⁹¹

1. If the examining attorney raises no objections to registration, or if the applicant overcomes all objections, the examining attorney will approve the mark for publication in the “Official Gazette,” a weekly publication of the USPTO.
2. The USPTO will send a notice of publication to the applicant stating the date of publication. After the mark is published in the Official Gazette, any party who believes it may be damaged by registration of the mark has 30 days from the publication date to file either an opposition to registration or a request to extend the time to oppose.

An opposition is similar to a proceeding in a federal court, but is held before the TTAB. If no opposition is filed or if the opposition is unsuccessful, the application enters the next stage of the registration process.

*Step 11: Registration Certificate Issues for Applications Based on Use, Foreign Registrations, and International Registrations*⁹²

1. A certificate of registration will be issued for applications based on use, a foreign registration, or an extension of protection of an international registration to the United States under Section 66(a).

If the mark is published based upon the actual use of the mark in commerce, or on a foreign registration, and no party files an opposition or request to extend the time to oppose, the USPTO will normally register the mark and issue a registration certificate about 8 weeks after the date the mark was published.

⁹⁰ *Id.*; see *supra* note 32.

⁹¹ UNITED STATES PATENT AND TRADEMARK OFFICE, *Trademark Process*, TRADEMARKS (Feb. 12, 2015, 1:56 PM), <http://www.uspto.gov/trademarks-getting-started/trademark-process>.

⁹² *Id.*

2. After the mark registers, the owner of the mark must file specific maintenance documents to keep the registration live (Renewal applications, etc.).

Steps 12 through 16 only apply to intent-to-use filings

*Step 12: Notice of Allowance Issues for Marks Based on an Intent-to-Use the Mark*⁹³

1. If the mark is published based upon the applicant's bona fide intention to use the mark in commerce and no party files either an opposition or request to extend the time to oppose, the USPTO will issue a notice of allowance about *eight weeks* after the date the mark was published. The applicant then has *six months* from the date of the notice of allowance to either:
 - a. Use the mark in commerce and submit a Statement of Use (an "SOU"); or
 - b. Request a six-month extension of time to file a statement of use (extension request).
2. A notice of allowance is a written notification from the USPTO that a specific mark has survived the opposition period following publication in the Official Gazette, and has consequently been allowed; it does not mean that the mark has registered yet.

Receiving a notice of allowance is another step on the way to registration. Notices of allowance are only issued for applications that have been filed based on an intent to use a mark in commerce under Trademark Act Section 1(b).

*Step 13: Applicant Files Timely Statement of Use or Extension Request*⁹⁴

1. The Applicant has six months from the mailing date of the notice of allowance in which to either file a statement of use or file an extension request. Please review the explanatory information for the statement of use and extension request processes, available at <http://www.uspto.gov/teas/eTEASpageB2.htm>.
2. If the applicant is not using the mark in commerce on all of the goods and/or services listed in the notice of allowance, the applicant must file an extension request and the required fee(s) to avoid abandonment. Because

⁹³ *Id.*

⁹⁴ See UNITED STATES PATENT AND TRADEMARK OFFICE, *Trademarks - What Happens Next*, TRADEMARKS (Aug. 10, 2011, 3:14 PM), <http://www.uspto.gov/trademarks-getting-started/trademark-basics/trademarks-what-happens-next>.

extension requests are granted in six month increments, applicant must continue to file extension requests every six months. A total of five extension requests may be filed. The first extension request must be filed within six months of the issuance date of the notice of allowance and subsequent requests before the expiration of a previously granted extension.

3. If the applicant is using the mark in commerce on all of the goods and/or services listed in the notice of allowance, the applicant must submit an statement of use and the required fee(s) within six months from the date the notice of allowance issued to avoid abandonment. Applicant cannot withdraw the statement of use; however, the applicant may file one extension request with the statement of use to provide more time to overcome deficiencies in the statement of use. No further extension requests may be filed.

Step 14: Applicant Does Not File Timely Statement of Use or Extension Request⁹⁵

If the applicant does not file a statement of use or extension request within six (6) months from the date the notice of allowance issued, the application is abandoned (no longer pending/under consideration for approval). To continue the application process, the applicant must file a petition to revive the application within two (2) months of the abandonment date.

Step 15: USPTO Reviews Statement of Use⁹⁶

3. If the minimum filing requirements are met, the statement of use is forwarded to the examining attorney. The examining attorney conducts a review of the statement of use to determine whether federal law permits registration. The applicant cannot withdraw the statement of use and the filing fee(s) will not be refunded, even if the application is later refused registration on legal grounds. If no refusals or additional requirements are identified, the examining attorney approves the statement of use.
4. If refusals or requirements must still be satisfied, the examining attorney assigned to the application issues a letter (Office action) stating the refusals and/or requirements. This is the same process that occurs prior to publication of the mark if the examining attorney determines that legal requirements must be met. The process and timeframes remain the same, except that if issues are ultimately resolved and the statement of use is

⁹⁵ See UNITED STATES PATENT AND TRADEMARK OFFICE, *Trademark Process*, TRADEMARKS (Feb. 12, 2015, 1:56 PM), <http://www.uspto.gov/trademarks-getting-started/trademark-process>.

⁹⁶ *Id.*

approved, the USPTO issues a registration within approximately two months. If all issues are not resolved, the application will be abandoned.

*Step 16: Registration Certificate Issues*⁹⁷

Within approximately two months after the SOU is approved, the USPTO issues a registration. To keep the registration "live," the registrant must file specific maintenance documents. Failure to make these required filings will result in cancellation and/or expiration of the registration.

*Step 17: Monitoring Status*⁹⁸

Throughout the entire process, you should monitor the progress of your application through the Trademark Status and Document Retrieval (the "TSDR") system, available at <http://tsdr.uspto.gov>. It is important to check the status of your application at least every three to four months (or more frequently) after the initial filing of the application, because otherwise you may miss a filing deadline. Please review the additional information on checking status to ensure you understand this important step in the overall registration process.

*Step 18: Protecting Your Client's Rights*⁹⁹

The attorney and client are the only persons responsible for enforcing their rights if they receive a registration, because the USPTO does not "police" the use of marks. While the USPTO attempts to ensure that no other party receives a federal registration for an identical or similar mark for or as applied to related goods and/or services, the owner of a registration is responsible for bringing any legal action to stop a party from using an infringing mark.

⁹⁷ *Id.*

⁹⁸ *Id.*

⁹⁹ *Id.*