



REGISTER YOUR TRADEMARK OR SERVICE MARK IN OHIO



**Helping
entrepreneurs
create a
prosperous
economy for
every Ohio
family.**





Dear Entrepreneur:

Business starts at the Secretary of State's office. Once your new business is up and running, you may want to consider protecting your corporate identity. The identity of your business, no matter how small or large, will set it apart from many of the others that operate in our state.

A trademark/service mark is a word, phrase, symbol, and/or design that identifies and distinguishes the source of the goods or service of one party from those of others. While registering your trademark or service mark is not legally required, doing so offers several legal benefits. A trademark or service mark gives a business the sole use of that name and/or mark, in addition to the ability to determine who uses it and where it is used.

This publication is intended to help you better understand the registering process. While this guide is meant to help, it does not constitute legal advice. If you have specific questions, please consult a lawyer.

I also encourage you to visit our online resource: OhioBusinessCentral.gov. Through Ohio Business Central, you can file a number of forms online, obtain and request publications, search existing businesses and sign up for our Filing Notification System to track and protect your business from potential identity theft.

If you have further questions regarding corporate filings, please call 877.767.3453 or email business@OhioSoS.gov.

I wish you the best of luck in starting your business. Just as you work to help your venture succeed, we'll be doing our part to continue moving our great state forward.

Yours in service,

A blue ink signature of Frank LaRose, written in a cursive style.

Frank LaRose
Ohio Secretary of State



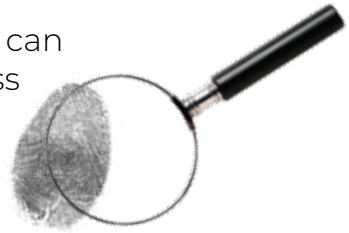
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Business Identity Theft

Don't Be a Victim

- Thousands of companies around the country have been victims of business identity theft. Protect your identity by signing up for the Ohio Secretary of State's **UCC Watchlist**. The Watchlist helps protect users when fraudulent and incorrect UCC filings are submitted in their name.
- Identity theft affects businesses too. Criminals can use your business' identity to illegally transact business and establish lines of credit. Business Identity Theft costs companies time and money.
- The Secretary of State's office can help you protect your business identity with the **Business Filing Notification System**.



What is the Business Filing Notification System?

The Business Filing Notification System is a free service allowing you to track any filing changes or updates made to your business.

For more information and to sign-up, visit
OhioSoS.gov/IDTheft



PREFACE

This guide has been prepared for informational purposes only and does not constitute legal advice. It is recommended that you seek legal and tax counsel before acting upon this information. For help finding a lawyer in Ohio, visit the Ohio Bar Association at OhioBar.org.

PERSONAL INFORMATION

The Secretary of State's office has the authority to reject any document containing a Social Security number or federal tax identification number. Please assist our office by removing all personal information from documents prior to filing them.

WHAT IS A TRADEMARK?

A trademark is defined by Ohio Revised Code Section 1329.54(A) as "any word, name, symbol, device, or combination of any word, name, symbol, or device, that is adopted and used by a person to identify and distinguish the goods of that person, including a unique product, from the goods of other persons, and to indicate the source of the goods, even if that source is unknown."

WHAT IS A SERVICE MARK?

A service mark is defined by Ohio Revised Code Section 1329.54(B) as "any word, name, symbol, device, or combination of any word, name, symbol, or device, that is adopted and used by a person to identify and distinguish the services of that person, including a unique service, from the services of other persons and to indicate the source of the services, even if that source is unknown."

While a mark may meet either of these definitions, there are several restrictions on the registration of trademarks and service marks to consider before registering a mark.



WHY FILE YOUR TRADEMARK/ SERVICE MARK IN OHIO

Registration of a trademark or service mark provides two things. First, it provides actual public notice. By registering the mark with a central filing agency, the mark is available for public scrutiny. This benefits both the owner, who seeks exclusive use of the mark and a potential filer who seeks to ensure that his or her mark does not conflict with a mark already in use. Second, registration of a mark might be used as evidence in the event an infringement claim is pursued by the registrant.

LIMITATIONS ON REGISTRATION PURSUANT TO THE OHIO REVISED CODE

Pursuant to Ohio Revised Code Section 1329.55, if your mark consists of or comprises any one or more of the following, it cannot be accepted for filing:

1. Immoral, deceptive or scandalous matter;
2. Matter that may disparage or falsely suggest a connection with persons living or dead, institutions, beliefs or national symbols, or bring them into contempt or disrepute;
3. The flag or coat of arms or other insignia of the United States, or of any state or municipality, or of any foreign nation or any simulation thereof;
4. The name, signature or portrait of any living individual, except with his/her written consent;
5. A mark which, when applied to the goods or services, is "merely descriptive," "deceptively misdescriptive" or primarily geographically descriptive (see following section for more information regarding merely descriptive and deceptively misdescriptive marks);



6. A mark that is primarily merely a surname;
7. A mark that resembles a trademark or service mark previously used in the state of Ohio by another entity and is not abandoned, and is likely to cause confusion, mistake or is deceptive; or
8. A mark that resembles a mark registered in the U.S. Patent Office by another entity and is not abandoned, and which is likely to cause confusion, mistake or is deceptive.

Please note: Proof of secondary meaning (discussed hereafter) will permit only a trademark or service mark that is descriptive, deceptively misdescriptive, geographically descriptive or a surname to be registered.

MERELY DESCRIPTIVE AND DECEPTIVELY MISDESCRIPTIVE TERMS

A mark that is merely descriptive or deceptively misdescriptive of the goods or services for which it is used cannot be registered as a trademark or service mark unless it has become distinctive through the acquisition of a secondary meaning (see page 6 for secondary meaning information). The reason for such prohibition is that the function of a mark is to identify and distinguish the goods or services of one person from those of others. A mark that is merely descriptive or deceptively misdescriptive does not serve this function.

A mark is merely descriptive if it describes an ingredient of the goods or services, the intended purpose, function or use of the goods or services, the quality of the goods or services, the size of the goods, the class of users of the goods or services, a desirable characteristic of the goods or services, or the end effect the goods or services have upon the user. It is not necessary that a mark describe all of the purposes, functions, characteristics or features of a good or service to



be considered merely descriptive. If a mark describes only one significant characteristic of a good or service, it will be deemed merely descriptive.

The following terms have been determined to be merely descriptive and not acceptable as valid trademarks or service marks:

- Consumer Protection Plan
- America's Best Popcorn
- Escape from the Ordinary
- Fund of Funds
- Kuf'N Kolar
- Rocktober
- Navy Cut
- File-Fit
- Multi-Purpose Food

In addition, terms such as "Outstanding Pasta," which are descriptive of the alleged merit of the good or service, are regarded as merely descriptive and are not acceptable as valid trademarks or service marks.

Generic terms are considered merely descriptive and, as a result, are not acceptable. The following are examples of generic terms:

- Escalator
- Consumer Electronics Monthly
- Flowers by Wire
- Montessori
- Multipoint Data Service
- Imported Auto Parts
- Sociographics
- Surgicenter
- Video Buyer's Guide

A mark is deceptively misdescriptive if it misdescribes the goods or services and persons who encounter it are likely to



believe the misrepresentation. A mark may be deceptively misdescriptive even if the true nature of the goods or services is revealed on the labels, advertisements or other materials to which the mark is applied.

The following are examples of marks that have been determined to be deceptively misdescriptive and not acceptable as trademarks or service marks:

- Cameo, as a trademark or service mark for jewelry;
- G.I., as a trademark or service mark for gun-cleaning patches, rods, brushes, solvents and oils; and
- Softhide, as a trademark or service mark for imitation leather material.

PERSONAL NAME MARKS

Ohio Revised Code Section 1329.55(E)(1)(c) prohibits registration of a trademark or service mark that is primarily merely a surname. This prohibition is intended to allow all persons bearing a certain surname to have an equal opportunity to use the surname as a distinguishing mark. Consequently, if a mark is “primarily merely a surname” it cannot be registered as a trademark or service mark unless the applicant proves the mark has become distinctive through the acquisition of secondary meaning (see page 6 for secondary meaning information). Whether a mark sought to be registered is primarily merely a surname is determined on a case-by-case basis.

GEOGRAPHICALLY DESCRIPTIVE MARKS

Marks that describe the geographic location or origin of goods and services are not regarded as “inherently” distinctive marks and can only be registered as trademarks or service marks upon proof of secondary meaning. To determine whether a



mark is geographically descriptive, one must consider the degree to which the place is known, and whether the name as used might convey some meaning that is not geographical. Generally, a mark that identifies the geographic origin of goods or services is considered geographically descriptive and cannot be registered without proof of secondary meaning.

SECONDARY MEANING

Marks that are merely descriptive, deceptively misdescriptive, primarily merely surnames or geographically descriptive cannot be registered as a trademark or service mark unless a secondary meaning is proven. Marks gain secondary meaning when they have been used by a particular business for so long or so exclusively, or when a particular business has promoted its products or services to such an extent, that the marks do not register their meaning on the public mind but are instantly associated with one enterprise. In other words, secondary meaning exists when, in addition to their literal or dictionary meaning, marks signify to the public a product from a unique source.

In order for the Secretary of State's office to accept such a mark, evidence of secondary meaning must be presented with the application. The filing office will determine whether the mark has acquired secondary meaning from the relevant evidence presented.

Evidence that may be used to establish secondary meaning includes, but is not limited to, the following:

1. Professionally conducted consumer surveys;
2. Evidence of the size of the seller, number of actual sales, large amounts spent in promotion, advertising and scope of publicity given a mark;



3. Use of the mark in trade journals, popular magazines and newspapers showing the scope of recognition of the mark; and
4. Evidence of the length of use of the mark showing that buyers associate the mark with one seller.

Please note: There is no general rule on the minimum amount of distinctiveness necessary to achieve secondary meaning; however, the more descriptive the term, the greater the burden to establish secondary meaning.

Sources: Trademarks and Unfair Competition, 4th Edition, J. Thomas McCarthy (1999); Trademark Manual of Examining Procedure

REGISTRATION OF COMPOSITE MARKS

Composite marks are a combination of terms that individually cannot be protected, but when put together, are not merely descriptive and can be protected. A composite mark may contain both registrable elements and descriptive elements that are individually not registrable.

PROCEDURAL REQUIREMENTS

To register a trademark or service mark in Ohio, you must submit to the Ohio Secretary of State's office the application form prescribed by the Secretary of State (Form 555). The prescribed form includes instructions for its completion and a description of each classification of goods and services for which a mark may be registered. The form must be accompanied by a specimen of the mark in use (for example, as it appears on letterhead). The mark must be in use prior to filing the application.

The filing fee for a Trademark/Service Mark Application is \$125. Expedited service is available by marking the "Expedite" box on the application and including the additional \$100 expedited



fee (see page 10 for expedited information). The registration is effective for a term of 10 years and can be renewed up to six months in advance of the expiration date. The renewal fee is \$25.00.

A trademark or service mark may also be assigned to a new owner. The assignment may or may not include the goodwill associated with the mark, depending on the agreement between the original and new owners. You may assign a new owner by completing the “Information for Assignment” section of the Name Registration Update (Form 524) and filing the form with the Secretary of State’s office. The filing fee is \$25.00.

If the name or address of the owner changes in any way, the change must be noted upon the Secretary of State’s records. A change of address must be submitted on the Name Registration Update form. If a company owns a mark and changes its name prior to renewal, it must file the Change of Ownership Name (Form 558) and indicate how the owner changed its name (i.e., through an amendment to articles, through a merger, etc.). The filing fee for either form is \$25.00.

SPECIMEN

You must submit a specimen of the mark with your application for a trademark or service mark. An acceptable specimen is one that shows the mark in use. For example, if the mark is used on letterhead or business cards, an acceptable specimen is a piece of the letterhead or a business card displaying the mark. An example of an unacceptable specimen is a hand-drawn sketch of a mark.

COPYRIGHT MATTERS

The protection of literary, musical, pictorial, graphic, sculptural, motion picture works and sound recordings is a federal copyright matter. Questions regarding preservation of rights



for such works should be directed to the United States Copyright Office, 101 Independence Ave. S.E., Washington, D.C., 20559. You may contact the United States Copyright Office via phone at 877.476.0778 or by visiting its website: Copyright.gov.

REJECTED REGISTRATIONS

If your application for a trademark or service mark is submitted and is denied, you may appeal for reconsideration by calling or writing to the Corporations Counsel at the Secretary of State's office. Written requests for reconsideration must be supported by legal authority and must be accompanied by a copy of the application in question, including a specimen of the mark.

If a written appeal is denied, the applicant or applicant's attorney will receive a written response from the examining attorney explaining the reason(s) for such denial.

SUBMITTING FILINGS

For quick and accurate service, complete filing forms online at OhioBusinessCentral.gov and pay with any major credit card. Filings will either be processed automatically upon submission or a review may be required and approval certificate will be sent to your email address after submission.

If you prefer, please obtain a filing form to be submitted by mail or dropped off in person at OhioSoS.gov. Please mail the form to the address provided on the first page of the filing form as well as a check or money order.

To submit a filing in person go to the Secretary of State's Client Service Center. The Client Service Center is open between 8:00 a.m. and 5:00 p.m., Monday to Friday. The Client Service Center is closed on holidays and the day after Thanksgiving.



EXPEDITED SERVICE

The Ohio Secretary of State offers three levels of expedited service for filings. An expedited level 1 filing may be mailed, submitted in person, or filed online. Levels 2 and 3 may only be submitted in person at the Client Service Center or filed online at OhioBusinessCentral.gov.

Levels of Service	Additional Fee	Turnaround Time
Expedited 1	\$100.00	2 Business Days
Expedited 2	\$200.00	1 Business Day
Expedited 3	\$300.00	4 Hours*

The expedited filing fee must be added to each filing submitted. If only some of your filings require expedited service, please submit a separate check for the expedited filings.

In the event of an expedited 3 filing containing an error, the customer will be notified. If a filing is re-submitted by 1:00 p.m., the filing will be processed by 5:00 p.m.

***Please note:** Expedited level 3 filings submitted after 1:00 p.m. will be available the next business day.

CONTACT BUSINESS SERVICES

Ohio Secretary of State
Business Services Division
614.466.3910
877.767.3453
TTY: 877.644.6889

Client Service Center

Note: The Ohio Secretary of State's office is moving. Please verify the address of the Client Service Center before traveling to the office.



Hours of Operation

Monday - Friday 8:00 a.m. - 5:00 p.m.

Open 24 hours at OhioSoS.gov.

Email: business@OhioSoS.gov

Website: OhioSoS.gov

File online: OhioBusinessCentral.gov

Multilingual services are available.

FEE SCHEDULE

Trademark and Service Mark Filings			
Filing Type	Form #	Fee	P.O. Box #
Trademark/Service Mark Application	555	\$125	1329
Renewal	523B	\$25	1329
Change of Ownership Name	558	\$25	1329
Name Registration Update	524B	\$25	1329



BUSINESS SERVICES

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