

TRADEMARKS & SERVICE MARKS



Secretary of State

2004 Revised Edition

NOTE: Pages 25-42 of the Guide, which include copies of the Tennessee Trade Mark Act of 2000, the Trademark Rules (Chapter 1360-7-1), and trademark forms, are not included in this Internet version of the Guide. For this information, please refer to other links under the Corporations section of our website

Tennessee Department of State Division of Business Services

MISSION

The mission of the Division of Business Services is to execute the statutory processing and recordkeeping duties of the Secretary of State relating to businesses in Tennessee.

GOAL

Our goal is to provide our customers with document processing services that are prompt, accurate and complete.

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INTRODUCTION

Over 18,000 active marks are registered in Tennessee. New marks are registered at a rate of over 140 per month.

The Secretary of State is responsible for registering and maintaining records about trademarks and service marks under the Tennessee Trade Mark Act of 2000 (2000 Tenn. Pub. Acts, ch. 671).

The Division of Business Services is the section of the Department of State that is responsible for executing the duties and functions of the Secretary of State relative to trademarks and service marks. In addition to recording and maintaining marks, the Division provides information to the public relating to registered marks.

This publication is intended as a guide to the registration of marks with the Division of Business Services under the Tennessee Trade Mark Act of 2000. This publication is not a replacement for the statutes or for legal or other professional advice.

The Tennessee Trade Mark Act of 2000 can be found in the Tennessee Code Annotated, Sections 47-25-501 through 47-25-518.

July 30, 2004

DOCUMENT FILING

CUSTOMER SERVICE INFORMATION

- **FORMS.** Forms are available from the Division of Business Services and may be obtained by from our Internet website (see below), by contacting our office at **615-741-0531**, or in person on the 6th floor of the William R. Snodgrass Tower, 312 Eighth Avenue North, Nashville, Tennessee. For your convenience, a copy of available forms are enclosed at the back of this filing guide.
- **INTERNET WEBSITE.** The Division of Business Services has a World Wide Web page that currently contains:
 - General information about the Division of Business Services
 - *A searchable online Tennessee trademarks database*
 - Forms and fee schedules
 - Filing guides and information brochures
 - E-mail access to the Division

The Division's site may be accessed via the Secretary of State's home page at:

<http://www.state.tn.us/sos/>

Trademark forms on the website can be “filled in” and printed. Please note that these “filled in” documents cannot be saved to your computer and cannot be sent to our office electronically.

- **MAILING ADDRESS.** The mailing address of the Division of Business Services is:

**State of Tennessee
Department of State
Division of Business Services
Trademarks Unit
6th Floor, William R. Snodgrass Tower
312 Eighth Avenue North
Nashville, TN 37243**

- **COUNTER SERVICE.** Customers may file documents or obtain certification services in person during regular business hours (8:00 a.m. until 4:30 p.m. (CST) Monday - Friday). The Division is located on the 6th Floor of the William R. Snodgrass Tower, 312 Eighth Avenue North, Nashville, Tennessee. Directions to the office are available on our website (see above).
- **E-MAIL ADDRESS.** The Division of Business Services may be e-mailed by writing:

Business.Services@state.tn.us

- **FAX NUMBER.** The Division of Business Services fax number is:

615-741-7310

- **GENERAL TELEPHONE NUMBER.** For other assistance relating to trademark filings, please contact us at:

615-741-0531

- **COPIES OF STATUTES.**

A copy of the Tennessee Trade Mark Act of 2000 (2000 Tenn. Pub. Acts, ch. 671) is provided in the back of this filing guide.

LEXIS Publishing currently publishes a reference manual entitled *Tennessee Corporations, Partnerships and Associations Law Annotated*. For purchasing information, contact LEXIS Publishing, PO Box 7587, Charlottesville, VA 22906-7587, or call 1-800-562-1197.

GENERAL FILING INFORMATION

- **APPLICATION.** An application for registration of a mark **must** be made on form #SS-4264, a copy of which is enclosed at the back of this guide. Additional copies are available upon request by contacting the Trademarks Unit of the Division of Business Services or by printing copies from our website.

The application should be completed by the applicant in ink and in a legible manner, preferably typed. Please fill out the application completely; an incomplete application will cause the registration process to be delayed. **The application must be notarized before a Notary Public.**

The original application must be delivered to the Division of Business Services. Faxed or e-mailed applications are not acceptable.

- **RECEIPT STAMP.** Any application received by the Division of Business Services, regardless of the method of delivery, is endorsed upon receipt with a date and time stamp. This date and time become the official filing date and time if the document is accepted for filing during the initial review process.
- **MICROFILMING & OPTICAL IMAGING.** An application received by the Division of Business Services is microfilmed and the mark is optically imaged into a computer database. After processing, the original application (but not the mark specimen) is returned to the applicant.
- **SPECIMENS.** Mark specimens submitted as part of the application process are required (see page 9), but cannot be returned to the applicant.
- **FEE PAYMENT.** The document to be filed must be accompanied by the correct fee payment, with check, bank draft, money order or other such instrument made payable to the Tennessee Secretary of State. The fee payment is **nonrefundable**. See page 36 for a list of applicable fees.
- **ACCEPTED FILING.** A document accepted for filing by the Division of Business Services is returned to the applicant together with a certificate of registration.
- **REJECTED FILING.** A document that cannot be accepted for filing by the Division of Business Services at the time of initial review will be returned to the applicant with a letter identifying the reason(s) for document rejection. A reasonable amount of time (usually 14 days) will be identified in the rejection

letter during which the applicant may resubmit a corrected application. A copy of the rejection letter should accompany any filing resubmission.

If an acceptable application is not refiled by the date provided in the rejection letter, the application will be rejected and the mark registration will be refused.

A rejected application will take precedence over a later filed application (and the later filed application will be rejected) IF the first applicant resubmits an acceptable application by the date specified by our office.

[NOTE: In lieu of returning a rejected application to the applicant for corrections, the Division of Business Services may contact the applicant and, with the applicant's approval, amend the application to make it acceptable for filing.]

An applicant whose registration is rejected by the Division of Business Services has the right under TCA §47-25-515 to seek judicial action (mandamus) in the Circuit Court of Davidson County to compel the registration of the mark.

REGISTERING A MARK WITH THE DIVISION OF BUSINESS SERVICES

WHAT MARKS CAN BE REGISTERED WITH THE DIVISION OF BUSINESS SERVICES?

- Generally, a mark that distinguishes the goods or services of an applicant from the goods or services of others can be registered with the Division of Business Services.
- A mark that distinguishes the goods or services of an applicant from the goods or services of others **cannot** be registered if it:
 1. Consists of or comprises immoral, deceptive, or scandalous matter;
 2. Consists of or comprises matter which 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. Consists of or comprises the flag or coat of arms, or other insignia of the United States, or of any state or municipality, or of any foreign nation, or any simulation of such flag, coat of arms, or other insignia;
 4. Consists of or comprises the name, signature, or portrait identifying a particular living individual, except with that individual's written consent;
 5. Consists of a mark which:
 - When used on or in connection with the goods or services of the applicant, is merely descriptive or deceptively misdescriptive of them;
 - When used on or in connection with the goods or services of the applicant, is primarily geographically descriptive or deceptively misdescriptive of them; or
 - Is primarily merely a surname; or
 6. Consists of or comprises a mark that so resembles a mark registered in this State or a mark or trade name previously used by another and not abandoned, as to be likely, when used on or in connection with the goods or services of the applicant, to cause confusion or mistake, or to deceive.
- Even though a mark would otherwise be unacceptable for registration due to #5 above, the mark may still be acceptable if the applicant provides evidence that the mark has become distinctive as used on or in connection with the applicant's goods or services. Such proof must include evidence of continuous use of the mark by the applicant in Tennessee for the five years before the date on which the claim of distinctiveness is made.
 - A proposed mark must be distinguishable from the marks of others not only in the same category, but also in all other categories (see pages 14-18).
 - A mark is **not** distinguishable from another mark by:
 1. Differences in color or texture of words or symbols;

2. Differences in punctuation, spacing or capitalization of words;
 3. The presence or absence of articles, conjunctions or prepositions as symbols or words;
 4. Differences between singular and plural forms of words;
 5. The use of similar words or symbols or the use of groups or sequences of similar words or symbols;
 6. The use of words or groups or sequences of words with essentially the same meaning or spelling;
 7. The use of entity identifiers such as “incorporated,” “company” and “limited”; or
 8. Addition of a subscript, superscript or a numerical designation (such as “#2,” or “II).”
- NOTE: In determining whether a mark is distinguishable from the marks of others, the Division of Business Services compares the proposed mark to other marks registered in its trademark database. **The Division conducts no review of other databases such as the Division’s corporate filing database (containing the registered, reserved and assumed names of corporations, limited liability companies, limited partnerships and limited liability partnerships) or federal trademarks.**
 - **The Division’s action in determining whether a mark is distinguishable from the marks of others for purposes of registration is ministerial and does not serve to insure, regulate or license the use of such a mark. In addition, the Division makes no determination as to whether the use of a particular mark constitutes unfair competition, unfair trade practice or name infringement with other marks already in existence.**
 - A mark also must be **in use** in order to be registered. The term “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. A mark is deemed “used”:
 1. On goods, when it is placed in any manner on the goods or their 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 such goods are sold or transported in commerce in Tennessee; and

2. On services, when it is used or displayed in the sale or advertising of services and the services are rendered in Tennessee.

HOW IS A MARK REGISTERED?

- In order to register a mark, an applicant must submit a completed form #SS-4264 to the Division of Business Services. This form requires the applicant to certify under oath and penalty of perjury the following statements:
 1. The name of the applicant;
 2. The business address (a street address, post office box, or both) of the applicant;
 3. If the applicant is a corporation, the state of incorporation;
 4. If the applicant is a partnership, the state in which the partnership is organized and the names of the general partners;
 5. A description of the goods or services on or in connection with which the mark is used (**what** business the applicant is engaged in-- for example, restaurant, business consultant, country music band, communications, jewelry, gift baskets, etc.);
 6. The mode or manner in which the mark is used on or in connection with such goods or services (**how** the applicant is using the mark-- for example, business cards, letterhead, flyers, signs, labels, newspaper advertisements, billboards, bus benches, television advertisements, home pages, etc.);
 7. The classifications into which such goods or services fall (see pages 14-18) (**Note: on or after April 25, 2000, a new registration application may list multiple classifications**);
 8. The date (month, day and year) when the mark was first used anywhere and the date (month, day and year) when it was first used in Tennessee by the applicant or a predecessor in business.

- Both dates must be completed for every application; if the mark has only been used in Tennessee, then the date the mark was first used “anywhere” is the same date as the date the mark was first used in Tennessee.
 - Since the mark must be in use prior to registration, both of these dates must also reflect a time **prior** to the signature date of the application;
9. A description of the mark (what the mark looks like--for example, tiger, rainbow, heart, flower, baseball bat, house, guitar, etc.; or if a name, the name printed or typed);
 10. A statement that a specimen showing the mark as actually used accompanies the application; and
 11. A statement that the applicant is the owner of the mark, the mark is in use in Tennessee, and to the knowledge of the person verifying the application, no other person has registered, either federally or in Tennessee, or has the right to use the mark in an identical form or in such near resemblance as to be likely, when applied to the goods or services of the other person, to cause confusion or mistake, or to deceive.
- The application must be signed by the applicant or by a member of the firm or an officer of the applicant corporation or association. **The application must also be notarized before a Notary Public.**
 - The original application must be delivered to the Division of Business Services. **A faxed or e-mailed application cannot be accepted for filing purposes.**
 - **A specimen of the mark or name must accompany the application** (see next section). Failure to include the specimen will result in the rejection of the application.
 - The application also must be accompanied by a nonrefundable registration application fee of **\$20.00 per classification**, payable to the Tennessee Secretary of State.

WHAT CONSTITUTES AN ACCEPTABLE SPECIMEN?

- A specimen of the mark or name must accompany the application; failure to include the specimen will result in the rejection of the application.
- The specimen provided **must** establish that the mark currently is **in use** in commerce in this State.
- Specimens should not be larger than 8 1/2 inches by 11 inches and should be flat. Small specimens, such as tags or labels, may be taped or pasted to a sheet of paper and labeled “SPECIMEN.”
- For **trademarks**, examples of acceptable specimens are tags or labels that are attached to the goods, containers for the goods, displays associated with the goods, or photographs of the goods showing use of the mark of the goods themselves. Invoices, announcements, order forms, bills of lading, leaflets, brochures, catalogs, publicity releases, letterhead, and business cards may be acceptable specimens for trademarks if they sufficiently demonstrate that the mark is being used with the goods. If it is impractical to send an actual specimen because of its size, photographs or other acceptable reproductions that show the mark on the goods, or packaging for the goods, must be furnished.
- For **service marks**, examples of acceptable specimens are signs, brochures about the services, advertisements for the services, business cards or stationery showing the mark in connection with the services, or photographs that show the mark either as it is used in the rendering or advertising of the services. The specimen must either show the mark **and** include some clear reference to the type of services rendered under the mark in some form of advertising, or show the mark as it is used in the rendering of the service (for example, on a store front or the side of a delivery truck).
- The Division of Business Services will not be able to return the specimen to the applicant.

WHAT IS A CERTIFICATE OF REGISTRATION?

- Upon compliance by the applicant with the registration requirements mentioned above, the Division of Business Services issues to the applicant a certificate of registration that shows:

1. The name and business address of the person claiming ownership of the mark, and if a corporation or partnership, the state of formation;
 2. The date claimed for the first use of the mark anywhere and the date claimed for the first use of the mark in this State;
 3. The class of goods or services and a description of the goods or services on or in connection with which the mark is used (Note: For new marks registered on or after April 25, 2000, a certificate may list multiple classes). “Old” United States classification designations will be identified with “US” preceding the class number;
 4. A reproduction (optical image) of the mark;
 5. The registration date; and
 6. The term of the registration (see below).
- A certificate of registration or a certified copy of a certificate of registration is admissible in evidence under TCA §47-25-505(b) as competent and sufficient proof of the registration of such mark in any action or judicial proceedings in any court of Tennessee.

WHAT IF THE REGISTRANT’S BUSINESS ADDRESS CHANGES?

- The registrant may change the registrant’s business address at any time by submitting in writing an address change. There is no filing fee for such a change and the requested address change should be directed to the Trademarks Unit of the Division of Business Services.
- **IMPORTANT NOTE: An address change in an annual report or other business document submitted to the Corporate Filings Unit of the Division does not operate to change the address listed on a registered trademark. The registrant must submit a separate address change request to the Trademarks Unit.**

WHAT IF THE REGISTRANT’S NAME CHANGES?

- A registrant whose name has been legally changed can record the name change and obtain a new certificate of registration by submitting to the Trademarks Unit a written instrument evidencing the change of name and by identifying

the registered mark(s) affected by the name change. The nonrefundable processing fee for recording such a change is **\$20.00 per registered classification for each registered mark.**

FOR HOW LONG IS THE REGISTRATION VALID AND CAN THE REGISTRATION BE RENEWED?

- Registration of a mark filed on or after April 25, 2000, is effective for a term of **five** years from the date of registration. Registration of a mark filed or renewed prior to April 25, 2000, is effective for a term of ten years from the date of registration/renewal.
- **IMPORTANT NOTE: THE DIVISION OF BUSINESS SERVICES NO LONGER SENDS RENEWAL NOTICES TO REGISTRANTS.**
- On or after April 25, 2000, any registration may be renewed for additional five year terms if the mark is still **in use** in Tennessee (see pages 6-7). A renewal application may be filed within the six months preceding the expiration date of the registration, and the renewed registration is effective for a period of five years from the end of the expiring term.
- In order to apply for the renewal of a mark registration, an applicant must submit a completed form **#SS-4263** to the Division of Business Services. This form requires the applicant to certify under oath and penalty of perjury the following statements:
 1. The name of the applicant;
 2. The business address (a street address, post office box, or both) of the applicant;
 3. The date of the original registration;
 4. A description of the mark (what the mark looks like--for example, tiger, rainbow, heart, flower, baseball bat, house, guitar, etc.; or if a name, the name printed or typed);
 5. A statement that the mark has been and is still in use in Tennessee; and
 6. A statement that a specimen showing the mark as actually used accompanies the renewal application.

- **Note for new marks registered on or after April 25, 2000, only.** An applicant may elect to renew all or some of the classifications listed in the original certificate; if only some of the classes are to be renewed, such classes should be listed on the renewal application (using the class designations in effect at the time of original registration).
- A specimen and a nonrefundable renewal application fee of **\$20.00 per classification renewed**, payable to the Tennessee Secretary of State, must accompany the completed renewal application.

CAN THE MARK AND ITS REGISTRATION BE ASSIGNED?

- A mark and its registration are assignable with the good will of the business in which the mark is used, or with that part of the good will of the business connected with the use of and symbolized by the mark.
- An assignment is valid for the remainder of the mark's term of registration or of the last registration renewal.
- An assignment must be made by "instruments in writing duly executed" and must include within the assignment instrument itself a provision expressly indicating the transfer of "good will" to the assignee.
- In order to assign the mark registration, an assignment cover form (**SS-4262**) should be completed. This form requires the following information:
 1. The name and description of the registered mark;
 2. The date of original registration;
 3. The owner of record of the registered mark (assignor) and his/her address;
 4. The name of the new owner (assignee) and his/her address;
 5. If the new owner (assignee) is a corporation, the state of incorporation;
 6. If the new owner (assignee) is a partnership, the state where the partnership is organized and the names of the general partners;

7. A statement that the executed assignment document is attached to the form; and
 8. The signature of the assignor, a member of the assignor's firm, or an officer of the assignor's corporation or association.
- A separate assignment instrument and cover form (form SS-4262) must be submitted for each registered mark; if a mark is registered in more than one class, only one assignment instrument and cover form need be submitted. A photocopy of the executed assignment instrument may be submitted in lieu of the original assignment instrument if it is certified by any of the parties thereto, or their successors, to be a true and correct copy of the original.
 - An assignment must be accompanied by a nonrefundable recording fee of **\$20.00 per registered classification**, made payable to the Tennessee Secretary of State.
 - After recording an assignment, the Division returns the assignment with a certificate indicating the name of the assignor, the name of the assignee and the name and classification of the mark. The certificate also indicates the expiration date of the mark.
 - An assignment is void as against any subsequent purchaser for valuable consideration without notice unless it is recorded with the Division of Business Services within three months after the date thereof or prior to such subsequent purchase.

HOW IS A REGISTERED MARK CANCELED?

- The Division of Business Services will cancel a registered mark under any of the following circumstances:
 1. The Division receives a voluntary written request for cancellation from the registrant or the assignee of record;
 2. The registration is not renewed in accordance with the provisions mentioned above;
 3. A court of competent jurisdiction finds that:
 - The registered mark has been abandoned;

- The registrant is not the owner of the mark;
- The registration was granted improperly;
- The registration was obtained fraudulently;
- The mark is or has become the generic name for the goods or services, or a portion thereof, for which it has been registered;
or
- The registered mark is so similar, as to be likely to cause confusion or mistake or to deceive, to a mark registered by another person in the United States Patent and Trademark Office prior to the date of the filing of the application for registration by the registrant, and not abandoned. However, if the registrant proves that the registrant is the owner of a concurrent registration of the mark in the Patent and Trademark Office covering an area including Tennessee, the registration shall not be canceled for such area of Tennessee;
or

4. A court of competent jurisdiction orders cancellation for any reason.
- A voluntary written request for cancellation as described in #1, above, must be accompanied by a nonrefundable recording fee of **\$20.00 per registered classification**, made payable to the Tennessee Secretary of State.

WHAT ARE THE CLASSIFICATIONS OF GOODS AND SERVICES?

- In the application for registration of a mark, an applicant must identify not only the goods and services with which the mark is used, but also the classification into which such goods and services fall.
- New trademark and service mark registrations on or after April 25, 2000, are classified in accordance with the International Schedule of Classes of Goods & Services as adopted by the United States Patent and Trademark Office and found at Title 37, Code of Federal Regulations, Part 6.1 (37CFR 6.1):

Goods

1. Chemical products used in industry, science, photography, agriculture, horticulture, forestry; artificial and synthetic resins; plastics in the form of powders, liquids or pastes, for industrial use; manures (natural and artificial); fire extinguishing compositions; tempering substances and chemical preparations for soldering; chemical substances for preserving foodstuffs; tanning substances; adhesive substances used in industry.

2. Paints, varnishes, lacquers; preservatives against rust and against deterioration of wood; colouring matters, dyestuffs; mordants; natural resins; metals in foil and powder form for painters and decorators.

3. Bleaching preparations and other substances for laundry use; cleaning, polishing, scouring and abrasive preparations; soaps; perfumery, essential oils, cosmetics, hair lotions; dentifrices.

4. Industrial oils and greases (other than oils and fats and essential oils); lubricants; dust laying and absorbing compositions; fuels (including motor spirit) and illuminants; candles, tapers, night lights and wicks.

5. Pharmaceutical, veterinary, and sanitary substances; infants' and invalids' foods; plasters, material for bandaging; material for stopping teeth, dental wax, disinfectants; preparations for killing weeds and destroying vermin.

6. Unwrought and partly wrought common metals and their alloys; anchors, anvils, bells, rolled and cast building materials; rails and other metallic materials for railway tracks; chains (except driving chains for vehicles); cables and wires (nonelectric); locksmiths' work; metallic pipes and tubes; safes and cash boxes; steel balls; horseshoes; nails and screws; other goods in nonprecious metal not included in other classes; ores.

7. Machines and machine tools; motors (except for land vehicles); machine couplings and belting (except for land vehicles); large size agricultural implements; incubators.

8. Hand tools and instruments; cutlery, forks, and spoons; side arms.

9. Scientific, nautical, surveying and electrical apparatus and instruments (including wireless), photographic, cinematographic, optical, weighing, measuring, signalling, checking (supervision), life-saving and teaching apparatus and instruments; coin or counterfreed apparatus; talking machines; cash registers; calculating machines; fire extinguishing apparatus.

10. Surgical, medical, dental, and veterinary instruments and apparatus (including artificial limbs, eyes, and teeth).

11. Installations for lighting, heating, steam generating, cooking, refrigerating, drying, ventilating, water supply, and sanitary purposes.

12. Vehicles; apparatus for locomotion by land, air, or water.

13. Firearms; ammunition and projectiles; explosive substances; fireworks.

14. Precious metals and their alloys and goods in precious metals or coated therewith (except cutlery, forks and spoons); jewelry, precious stones, horological and other chronometric instruments.

15. Musical instruments (other than talking machines and wireless apparatus).

16. Paper and paper articles, cardboard and cardboard articles; printed matter, newspaper and periodicals, books; bookbinding material; photographs; stationery, adhesive materials (stationery); artists' materials; paint brushes; typewriters and office requisites (other than furniture); instructional and teaching material (other than apparatus); playing cards; printers' type and clichés (stereotype).

17. Gutta percha, india rubber, balata and substitutes, articles made from these substances and not included in other classes; plastics in the form of sheets, blocks and rods, being for use in manufacture; materials for packing, stopping or insulating; asbestos, mica and their products; hose pipes (nonmetallic).

18. Leather and imitations of leather, and articles made from these materials and not included in other classes; skins, hides; trunks and travelling bags; umbrellas, parasols and walking sticks; whips, harness and saddlery.

19. Building materials, natural and artificial stone, cement, lime, mortar, plaster and gravel; pipes of earthenware or cement; roadmaking materials; asphalt, pitch and bitumen; portable buildings; stone monuments; chimney pots.

20. Furniture, mirrors, picture frames; articles (not included in other classes) of wood, cork, reeds, cane, wicker, horn, bone, ivory, whalebone, shell, amber, mother-of-pearl, meerschaum, celluloid, substitutes for all these materials, or of plastics.

21. Small domestic utensils and containers (not of precious metals, or coated therewith); combs and sponges; brushes (other than paint brushes); brushmaking materials; instruments and material for cleaning purposes, steel wool; unworked or semi-worked glass (excluding glass used in building); glassware, porcelain and earthenware, not included in other classes.

22. Ropes, string, nets, tents, awnings, tarpaulins, sails, sacks; padding and stuffing materials (hair, kapok, feathers, seaweed, etc.); raw fibrous textile materials.

23. Yarns, threads.
24. Tissues (piece goods); bed and table covers; textile articles not included in other classes.
25. Clothing, including boots, shoes and slippers.
26. Lace and embroidery, ribands and braid; buttons, press buttons, hooks and eyes, pins and needles; artificial flowers.
27. Carpets, rugs, mats and matting; linoleums and other materials for covering existing floors; wall hangings (nontextile).
28. Games and playthings; gymnastic and sporting articles (except clothing); ornaments and decorations for Christmas trees.
29. Meats, fish, poultry and game; meat extracts; preserved, dried and cooked fruits and vegetables; jellies, jams; eggs, milk and other dairy products; edible oils and fats; preserves, pickles.
30. Coffee, tea, cocoa, sugar, rice, tapioca, sago, coffee substitutes; flour, and preparations made from cereals; bread, biscuits, cakes, pastry and confectionary, ices; honey, treacle; yeast, baking powder; salt, mustard, pepper, vinegar, sauces, spices; ice.
31. Agricultural, horticultural and forestry products and grains not included in other classes; living animals; fresh fruits and vegetables; seeds; live plants and flowers; foodstuffs for animals, malt.
32. Beer, ale and porter; mineral and aerated waters and other nonalcoholic drinks; syrups and other preparations for making beverages.
33. Wines, spirits and liqueurs.
34. Tobacco, raw or manufactured; smokers' articles; matches.

Services

35. Advertising and business.
36. Insurance and financial.
37. Construction and repair.
38. Communication.
39. Transportation and storage.
40. Material treatment.
41. Education and entertainment.
42. Miscellaneous.

- **IMPORTANT NOTE:** These general classes are established for the convenience of administering the trademark law and do not limit or extend the applicant's or registrant's trademark rights. In order to be approved for registration, a proposed mark must be distinguishable from

the marks of others not only in the same category, but also in all other categories identified above.

- An application for registration of a mark filed on or after April 25, 2000, may include one or more classifications of goods or services.
- **IMPORTANT NOTE:** New trademark and service mark registrations filed on or after April 25, 2000, and prior to January 1, 2001, may be classified either in accordance with the International Schedule of Classes of Goods & Services noted above, or in accordance with the “old” United States classifications in effect prior to April 25, 2000, and found at 1982 Tenn. Pub. Acts, ch. 698, §10. “Old” classification designations will be identified by our office with “US” preceding the class number.
- **IMPORTANT NOTE:** Trademark and service mark registrations filed prior to April 25, 2000, will continue to be classified and renewed using the “old” United States classifications in effect prior to April 25, 2000, and found at 1982 Tenn. Pub. Acts, ch. 698, §10. “Old” classification designations will be identified by our office with “US” preceding the class number.

WHAT ARE THE CONSEQUENCES OF FILING A FRAUDULENT REGISTRATION?

- **Statements made in a registration application and a renewal application are made under oath and under penalty of perjury. Perjury is a class A misdemeanor.**
- **In addition, any person who procures the filing or registration of any mark in the Division of Business Services, by knowingly making any false or fraudulent representation or declaration, orally or in writing, or by any other fraudulent means, shall be liable to pay all damages sustained in consequence of such filing or registration, to be recovered by or on behalf of the party injured thereby in any court of competent jurisdiction.**

WHAT ARE COMMON FILING REJECTION REASONS?

- Avoiding the frequently encountered problems noted below will help ensure that trademark or service mark can be timely filed with the Division of Business Services.
 1. The entire form is not completed. All blanks must be filled in for both registration and renewal applications.
 2. An acceptable specimen is not provided. A specimen is required for both registration and renewal applications.
 3. The signature is missing and/or is not notarized. Both registration and renewal applications must be signed and notarized before a Notary Public.
 4. Dates are not complete. All dates on the registration and renewal applications must include the day, month and year.
 5. The application is completed in pencil. All registration and renewal applications must be typewritten or completed in ink.
 6. The \$20.00 per classification filing fee is not included with the application or other document.
 7. The type of goods and services is not listed in the application. A registration application must provide this information.
 8. The mode or manner of use is not listed in the application. A registration application must provide this information.
 9. A classification is not listed in the application. A registration application must identify at least one classification.
 10. A new owner is listed in a renewal application. Changes in ownership require a valid assignment or new registration application.

HOW CAN I OBTAIN INFORMATION FROM THE TRADEMARKS UNIT ABOUT WHETHER A MARK IS REGISTERED IN TENNESSEE?

- The Division of Business Services is developing a searchable internet trademark database at <http://www.state.tn.us/sos/service.htm>. Please check this website for updated information.
- Any person may contact the Trademarks Unit at 615-741-0531 for an informal, oral determination as to whether a particular mark is registered in Tennessee.
- Any person may request an “information search” as to whether a particular mark is registered in Tennessee by submitting to the Trademarks Unit a written request accompanied by payment of a nonrefundable \$20.00 processing fee. The Trademarks Unit will conduct a search of its records and issue a written response to the person requesting the search. If the search reveals the existence of an active trademark, the response will include registration information similar to that provided on the registration certificate (see pages 9-10).
- Copies of mark documents on file may be obtained from the Trademarks Unit at a cost of \$1.00 per page copied; if requested, such copies may be certified at an additional cost of \$2.00 per certification.

MAY OTHER DOCUMENTS BE FILED WITH THE TRADEMARKS UNIT?

- Other written and executed instruments which relate to a registered mark or pending application for registration, including licenses, security interests or mortgages, may be submitted to the Trademarks Unit for filing. Each such instrument must be accompanied by a nonrefundable recording fee of **\$20.00 per registered classification**, made payable to the Tennessee Secretary of State.
- **IMPORTANT NOTE:** Such miscellaneous instruments are **NOT** cross-referenced or cross-filed with any other recording systems or databases maintained by the Division of Business Services or any other agency. While information about such miscellaneous instruments is available from the Trademarks Unit upon specific request, information about such miscellaneous instruments will **NOT** appear in certificates of mark registration or mark registration information searches conducted by the Trademarks Unit.

FREQUENTLY ASKED QUESTIONS

DO YOU HAVE TO USE AN ATTORNEY TO REGISTER A MARK?

The statutes do not require the use of an attorney to register a mark; however, the use of a professional may be advisable. In addition, if you have any questions about the “protection” of a mark, infringement upon your mark, or the application of filing requirements to your specific situation, you should consult an attorney or other professional.

WHAT IS A TRADEMARK? A trademark is any word, name, symbol, device or combination thereof used by a person to identify goods made or sold and to distinguish them from the goods made or sold by another person. In general, you use a trademark to identify a product or goods that are sold (examples include soft drinks, automobiles, magazines, and food).

WHAT IS A SERVICE MARK? A service mark is the same as a trademark, except that a service mark is used by a person to identify **services** rendered or offered and to distinguish them from the services rendered or offered by another person. The services must be provided to the public or any party other than the applicant. In general, you use a service mark to identify services that are offered or sold (examples include restaurant, retail business and computer services).

WHAT ARE TRADE NAMES? A trade name is a name that an owner uses to identify his or her business. If a trade name meets the criteria of a trademark or service mark, it may be eligible for registration.

DOES REGISTRATION WITH THE DIVISION OF BUSINESS SERVICES PROTECT MY MARK? No. Trademark or service mark protection is acquired through a person or entity’s use of the mark in connection with the sale of goods or services and through enforcement actions brought by the owner in civil legal proceedings.

WHAT ARE THE BENEFITS OF REGISTERING A MARK? Registration of a trademark or service mark provides actual public notice of ownership claimed in a mark used in Tennessee and makes the mark available for public viewing. Such registration benefits the owner, who seeks exclusive use of a mark, and a

potential registrant, who seeks to ensure that his or her mark does not conflict with a mark already in use.

Registration also may be used as evidence in the event that an infringement action is pursued by the registrant (**Please consult your attorney for more information about such actions**).

CAN I RESERVE A MARK BEFORE USING IT? No. A mark cannot be registered unless and until goods or services identified by the mark have actually been sold or offered in Tennessee.

DOES REGISTRATION OF A MARK PREVENT OTHERS FROM REGISTERING A SIMILAR MARK IN OTHER STATES? No. Registration of a mark with the Division of Business Services only applies to the State of Tennessee. There is no cross-referencing between states or between state and federal registrations.

CAN I REGISTER MY MARK FEDERALLY? Yes. Trademarks can be registered federally in the United States Patent and Trademark Office of the Department of Commerce. You may contact that office at 800-786-9199.

DOES THE DIVISION OF BUSINESS SERVICES SEARCH ITS CORPORATE DATABASE OR THE FEDERAL REGISTER WHEN CHECKING ON THE AVAILABILITY OF MARKS? No. The Division does **not** search its corporate database or the federal register when checking on the availability of marks.

CAN I SEARCH FEDERAL REGISTRATIONS IN TENNESSEE? Yes. The Memphis & Shelby County Public Library and Information Center and the Stevenson Science Library of Vanderbilt University have been designated as Patent and Trademark Depository Libraries in the State of Tennessee. Marks may be searched and other information obtained through those facilities. The telephone numbers are 901-725-8877 and 615-322-2717, respectively.

ARE COPYRIGHTS FILED WITH THE DIVISION OF BUSINESS SERVICES? No. Copyrights are registered at the federal level with the United States Copyright Office of the Library of Congress. The telephone number for this office is 202-707-3000.

WHAT ARE SPECIMENS? A specimen is an actual example of the use of the mark in commerce. It is the means by which the public would view your mark and be aware of the specific goods or services offered.

HOW LONG DOES IT TAKE TO PROCESS A REGISTRATION APPLICATION? Applications are usually processed within three working days.

WHAT DO THE “TM” AND “SM” DESIGNATIONS MEAN? These designations indicate that a person or entity claims rights in a particular trademark or service mark. They do not indicate that the mark has been registered. A person or entity claiming ownership in an unregistered mark may place such designations next to the mark.

WHAT DOES THE “®” DESIGNATION MEAN? This designation indicates that a mark is federally registered. It may only be used if the United States Patent and Trademark Office has granted registration.

UNDER WHAT CIRCUMSTANCES IS A MARK DEEMED ABANDONED? A mark is deemed to be “abandoned” when either of the following occurs:

- (1) When its use has been discontinued with intent not to resume such use. Intent not to resume may be inferred from circumstances. Non-use for two consecutive years shall constitute prima facie evidence of abandonment.
- (2) When any course of conduct of the owner, including acts of omission as well as commission, causes the mark to lose its significance as a mark.

GLOSSARY

APPLICANT - The person filing an application for registration of a mark under the Tennessee Trade Mark Act of 2000, or the person's legal representatives, successors or assigns.

DIVISION OF BUSINESS SERVICES - The division of the Tennessee Department of State that is responsible for executing the duties and functions of the Secretary of State under the Tennessee Trade Mark Act of 2000.

MARK - Any trademark or service mark entitled to registration under the Tennessee Trade Mark Act of 2000.

PERSON - Any natural person or any firm, partnership, corporation, association, union or other organization capable of suing and being sued in a court of law.

REGISTRANT - The person to whom the registration of a mark under the Tennessee Trade Mark Act of 2000 is issued, or the person's legal representatives, successors or assigns.

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

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

TRADE NAME – Any name used by a person to identify a business or vocation of such person.