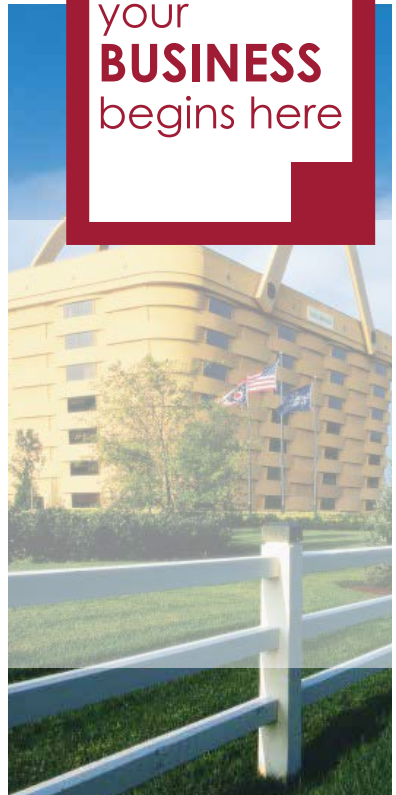


your
guide to

Jon Husted
Ohio Secretary of State

Registering Your Trademark or Service Mark

your
BUSINESS
begins here



JON HUSTED
Ohio Secretary of State



Ohio Secretary of State
Business Services Division



Dear Ohioan:

Ohio is open for business!

Starting a business in Ohio begins here at the Secretary of State's Office. Here, we authorize companies to do business in our state and we strive to make the filing process as straightforward as possible so you can focus more on growing your business and less on government bureaucracy.

I encourage you to visit the Ohio Business Central website at www.OHBusinessCentral.com. Through Ohio Business Central, you can file the most frequently used forms online. You can also obtain all other forms and office publications, search existing businesses and sign up for our Filing Notification System to track and protect your business from potential identity theft.

Starting a business requires a great deal of planning and work and while the *Guide to Registering Your Trademark or Service Mark in Ohio* is meant to help, it is important to remember it does not constitute legal advice. Please seek professional counsel specific to your situation and goals.

Should you have further questions regarding trademarks or service marks, please call (877) SOS-FILE (877-767-3453) or e-mail the business services staff at busserv@OhioSecretaryofState.gov.

Thank you for consulting with the Ohio Secretary of State's Office for your business needs. We look forward to serving you.

Sincerely,

Jon Husted
Ohio Secretary of State

your **BUSINESS** begins here

Start and Manage Your Business Online

www.OHBusinessCentral.com

TABLE OF CONTENTS

Preface	1
Personal Information	1
What Is a Trademark?	1
What Is a Service Mark?	1
Why File Your Trademark/Service Mark in Ohio	1
Limitations on Registration Pursuant to the Ohio Revised Code	2
Merely Descriptive and Deceptively Misdescriptive Terms	3
Personal Name Marks	4
Geographically Descriptive Marks	5
Secondary Meaning	5
Registration of Composite Marks	6
Procedural Requirements	6
Specimen	7
Copyright Matters	7
Rejected Registrations	7
Submitting Trademark or Service Mark Filings	8
Expedite Service	9
Contact Business Services	9
Fee Schedule	10
Trademark and Service Mark Filings	10
Business Startup Checklist	11

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.

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 4 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 5 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 (see below for secondary meaning information).

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 Trademark/Service Mark Application (Form 555) may be requested by phone at (877) SOS-FILE (877-767-3453) or e-mail at busserv@OhioSecretaryofState.gov, obtained in person from the Secretary of State's Office, or downloaded from the Secretary of State's website at: www.OhioSecretaryofState.gov. The filing fee for a Trademark/Service Mark Application is \$125, payable to the "Ohio Secretary of State." Expedited service is available by marking the "Expedite" box on the application and including the additional \$100 expedite fee (see page 9 for expedite 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.

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.

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.

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: www.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 www.ohbusinesscentral.com 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 www.OhioSecretaryofState.gov. Please mail the form to the address provided on the first page of the filing form as well as a check, money order or credit card authorization form.

To submit a filing in person please go to the Secretary of State's Client Service Center at 180 E. Broad St., suite 103 (Ground Floor), Columbus, OH 43215 between 8 a.m. and 5 p.m., Monday to Friday. The Client Service Center is closed on holidays and the day after Thanksgiving.

Expedite Service

The Ohio Secretary of State offers three levels of expedite service for trademark / service mark filings. The expedite 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.

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

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

In the event of an expedite 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:** Expedite 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
180 E. Broad St., 16th floor
Columbus, Ohio 43215
(614) 466-3910
(877) SOS-FILE (877-767-3453)
TTY: (614) 466-0562
Toll Free TTY: (877) 644-6889

Walk-In Client Service Center
180 E. Broad St., Suite 103 (ground floor)
Columbus, Ohio 43215

E-mail: busserv@OhioSecretaryofState.gov
Website: www.OhioSecretaryofState.gov
File online: www.OHBusinessCentral.com

Fee Schedule

Trademark and Service Mark Filings			
Filing Type	Form #	Fee	P.O. Box #
Trademark/Service Mark Application	555	\$125	1329
Renewal	523	\$25	788
Change of Ownership Name	558	\$25	1329
Name Registration Update	524	\$25	788

For the complete Cross Reference Filing Guide by Product, please visit www.OhioSecretaryofState.gov, click on “Business Services” and then click “Filing Forms/Fee Schedule.”

You may also request the complete Cross Reference Filing Guide by Product by calling (877) SOS-FILE (877-767-3453) or by e-mailing busserv@OhioSecretaryofState.gov.

Helpful steps as you further develop your business or organization

1. Register with the Ohio Secretary of State.

Register online at www.OHBusinessCentral.com or find the forms needed to file for your business at www.OhioSecretaryofState.gov.

2. Contact the Internal Revenue Service (IRS) to obtain an Employer Identification Number (EIN).

Additional information and an online application are available at www.irs.gov - search "EIN."

3. Then, open a bank account.

You will need your EIN to open a bank account.

4. Contact the Ohio Department of Taxation.

Register with the Ohio Department of Taxation at www.tax.ohio.gov. The Ohio Department of Taxation can assist businesses in determining state and local tax obligations.

5. Report newly hired and re-hired employees to the Ohio New Hire Reporting Center.

Report employee information at www.OH-NewHire.com. More information can be obtained by contacting the Ohio New Hire Reporting Center at (888) 872-1490 ext. 300.

6. Contact the Ohio Bureau of Workers' Compensation.

If your business or organization has an employee or employees visit www.bwc.ohio.gov under "Employers."

7. Contact the Ohio Department of Job & Family Services.

Employers may be required to establish an Unemployment Compensation Tax Account with the Ohio Department of Job & Family Services. Visit jfs.ohio.gov - search "Employer."

8. Finally, obtain the proper licenses and permits.

The Ohio Business Gateway, www.business.ohio.gov, "Licenses & Permits" page provides a list of professional licenses and business permits necessary to do business in Ohio. Contact your county and local government to determine if any special requirements exist for your type of business.

Special Considerations for Nonprofit Organizations

Apply for tax exemption. Visit www.irs.gov to apply to become a tax-exempt organization. Also, contact the Ohio Department of Taxation and your county and local governments to determine how to apply for applicable exemptions.

Register with the Ohio Attorney General's Office if entity is a charitable organization.

Ohio requires charitable organizations located in Ohio and groups that ask Ohioans for contributions to register and file annual reports. Please go to www.ohioattorneygeneral.gov for more information.

Apply for a nonprofit postal permit. Apply for a nonprofit mailing permit from the United States Postal Service at www.usps.com.

Disclaimer: The information contained in this document is not legal or accounting advice. You should consult a legal or accounting professional.

Ohio Business Profile

Jon Husted
Ohio Secretary of State



As the place where business begins in Ohio, the Ohio Secretary of State's Office has launched the **Ohio Business Profile** to highlight some of the great work being done in the Buckeye State. Each month a handful of diverse businesses with a common theme will be selected to be featured on our website. If you are interested in having your business profiled go to www.OhioBusinessProfile.com.

Ohio
BUSINESS
Profile

For more information: (877) SOS-OHIO (877-767-6446) x4
OBP@OhioSecretaryofState.gov

Follow OhioSOSHusted:



JON HUSTED

Ohio Secretary of State



Business Services Division

180 East Broad Street, 16th floor

Columbus, Ohio 43215

Telephone: (614) 466-3910

Toll Free: (877) SOS-FILE (877-767-3453)

TTY: (614) 466-0562

Toll Free TTY: (877) 644-6889

E-mail: busserv@OhioSecretaryofState.gov

On the web: www.OhioSecretaryofState.gov

File online: www.OHBusinessCentral.com

Walk-in Client Service Center

180 East Broad Street, Suite 103 (ground floor)

Columbus, Ohio 43215