

Trademark “FAQs”

The following “Frequently Asked Questions” are provided for informational purposes only and are not intended to be construed as legal advice. For legal advice regarding Trademark or Service mark registration, please consult with your own legal counsel.

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Trademark Basics

1. What is a Trademark?

Generally, you use a Trademark to identify products or goods that are sold (ex: beverages, magazines, furniture, or food).

“ ‘Trademark’ means 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 goods, even if the source is unknown.” *Ark. Code Ann. § 4-71-201(10)*

2. What is a Service mark?

Generally, you use a Service mark to identify services that are offered or sold (ex: restaurant, retail business, or computer services).

“ ‘Service mark’ means any word, name, symbol, or device or combination thereof used by a person to identify and distinguish the services of one (1) person, including unique service, from the services of others, and to indicate the source of the services, even if the source is unknown.” *Ark. Code Ann. § 4-71-201(8)(A)*

[Note: The terms “mark” and “trademark” are generically used in the following information to refer to both Trademarks and Service marks.]

3. What are Trademark and Service mark classifications?

The classifications are descriptive categories used by our Office. They help determine whether the mark is associated with the applicant’s goods or services; and also to determine whether the mark may conflict with, or be confusingly similar to, a mark for other goods or services. If applying for a Trademark, you must choose from Trademark classifications. If applying for a Service mark, you must choose from Service mark classifications. (An application for a Trademark with a Service mark classification or vice versa will be rejected.)

4. How are the classifications determined?

The Arkansas Secretary of State’s list of classifications for goods and services conforms to the United States Patent and Trademark Office’s international classification list. *See Ark. Code Ann. § 4-71-210(c)*.

For a detailed description of each classification, visit:

<http://www.uspto.gov/trademark/trademark-updates-and-announcements/nice-agreement-tenth-edition-general-remarks-class>

5. What is a Trademark/Service mark specimen?

A specimen is an actual sample of how the mark is used in business. The specimens provided by applicant must be in actual use by the applicant within the state of Arkansas. Business cards, clothing tags, labels for a product, etc. are examples of commonly provided specimens that show the mark as it is actually being used. (A photocopy of a business card or a picture of a t-shirt is not

acceptable because those photocopies and pictures are not given to potential clients or purchased by customers.)

See Ark. Code Ann. § 4-71-203(b)(4)

Registering a mark in Arkansas

6. Who can apply for a Trademark or Service mark?

Any entity (individual, corporation, partnership, or other legal entity) can apply to register for a Trademark or Service mark. A mark is generally owned by the individual or individual(s), corporation, partnership, or other organizations offering goods or services. If a business entity provides the goods or services under a certain mark or logo, the business owns this mark; an individual of that business entity does not own the mark or logo.

7. Must I pay a fee to apply for a Trademark or Service mark?

A payment of \$50.00, made payable to the Secretary of State, is required for all new and renewal applications. The fee should be submitted with the application, the payment will not be processed unless the application is accepted. Payment will be returned with the application if it is rejected for any reason. If sending in more than one application, please provide a separate check for each application. See Ark. Code Ann. § 4-71-203(b)(5).

8. Where can I find an application to register a Trademark or Service mark?

A fillable PDF of the application may be obtained online at:

<https://www.sos.arkansas.gov/uploads/bcs/TMApplication.pdf>

A paper copy may be picked up in person at the Secretary of State's Business & Commercial Services Division (1401 W. Capitol Ave., Suite 250, Little Rock, AR 72201). By request, an application may be mailed to applicant by calling (501) 682-3409.

9. Should I conduct a Trademark search before applying for registration of my trademark?

Yes, searching for potential conflicts is required by the applicant in order to confirm no one else is using a similar mark, or portions thereof. Ark. Code Ann. 4-71-203(b)(1). This will also help the applicant avoid the investment of money and time in registering your mark, especially if a conflict is discovered.

- You can search current Trademarks/Service marks registered with the Arkansas Secretary of State at:

<http://www.sos.arkansas.gov/corps/trademk/index.php>

- Also, please conduct a search for business entities registered with the Secretary of State at: http://www.sos.arkansas.gov/corps/search_all.php

A proposed mark may be rejected for being confusingly similar to an entity registered with our Office. See Ark. Code Ann. § 4-71-202(6).

- A search should also be conducted for marks registered with the United States Patent and Trademark Office (USPTO) at:

<http://tmsearch.uspto.gov/bin/gate.exe?f=tess&state=4805:x5gy5p.1.1>

“Live” marks on file with the USPTO may prevent the registration of a proposed mark with the Arkansas Secretary of State given certain circumstances. (Ex: the use of the word “Razorback” is not registrable as part of a mark or entity name without proof of permitted use from the Federal Trademark owner, i.e. a licensing contract, etc.)

10. Will I need an attorney to apply for the registration of my mark?

No. However, it is important to keep in mind that our Office can only assist you in the basic completion of the application. Our Office cannot give you any legal or business advice. In general, rejected applications are most often submitted by non-attorneys. Applicants may benefit greatly by consulting with an attorney about the best way to protect their intellectual property.

11. Can I fax or email my application?

No. The application, payment, and specimens submitted must be original. Faxed or photocopied signatures are not acceptable. You should mail or hand deliver your application to:

Arkansas Secretary of State
Business & Commercial Services
Attn: Trademark/Service Marks
1401 W. Capitol Ave., Suite 250
Little Rock, AR 72201

12. Who can sign the application?

The application may be signed by the following, according to the type of applicant:

- An officer of the corporation should sign on behalf of a corporation;
- A General Partner should sign on behalf of a partnership;
- A member or manager of a limited liability company should sign on behalf of the LLC;
- An individual should sign on their own behalf. If there is more than one individual listed in #2, each individual should sign a separate notarized affidavit;
- A non-employee attorney may sign when proof of corporate authorization has been provided to our Office and signed by an officer on record with the Secretary of State. In-house counsel is acceptable and should so indicate with words "General Counsel" (or "Assistant General Counsel", etc.)

Please see Ark. Code Ann. §4-71-203(b)(3)

13. How long does it take to process a Trademark/Service mark application?

The applications are handled as they are received, on a first come first serve basis. Although a specific time frame cannot be given, it may take several weeks before an applicant receives a response from our Office. The protection of an applicant's mark, along with protection of current marks on file, is important to us; we strive to search potential conflicts and ensure the submitted application is complete and accurate. Nevertheless, receipt of a Trademark or Service mark from the Arkansas Secretary of State is not a guarantee of absolute right to use the mark; since prior or superior rights to use the mark may exist elsewhere.

14. Can I expedite the processing of my application?

No. Applications are processed in the order they are received. If you choose to hand deliver your application, your filing will still go through the same review process and the applicant will receive an answer by mail.

15. Can I apply for more than one Trademark/Service mark classification?

Yes. A mark is eligible for registration in multiple classes. One application can be used for multiple classes as long as all of the classes fall under their

corresponding selection as a Trademark or Service mark. Trademark classifications are numbered 1-34 and Service mark classifications are numbered 35-45. The detailed list of classifications with their titles is provided on page four (4) of the Trademark/Service Mark application's instructions.

16. What is a Trademark/Service mark specimen?

A specimen is an actual sample of how the mark is used in business. The specimens provided by applicant must be in actual use by the applicant within the state of Arkansas. Business cards, clothing tags, labels for a product, etc. are examples of commonly provided specimens that show the mark as it is actually being used. (A photocopy of a business card or a picture of a t-shirt is not acceptable because those are not given to potential clients or purchased by customers.)

See Ark. Code Ann. § 4-71-203(b)(4)

17. If I have just started my business and have no specimens, what can I provide instead?

A mark must be in actual use in commerce before our Office will grant registration of a Trademark or Service mark. You must have specimens. The specimens are used to ensure actual use in commerce and also to verify the words, phrase, or logo being applied for is properly described and functions as an actual Trademark or Service mark. If you do not have specimens, you must wait until you have proper specimens before you apply for registration of a mark.

18. What are acceptable specimens?

Specimens should be items (showing the mark being applied for) that are actually used by the applicant in commerce such as tags, labels, menus, t-shirts, magnets, business cards or professional letterhead. The specimens must be original. Copies are not acceptable unless they are pictures of signage too large to mail (such as a picture of a billboard or storefront) or webpage "screen shots" with a visible web address originating from applicant's own website (social media not acceptable). The specimens should not be older than two years, as this shows that they are in current use.

For a Trademark, an acceptable specimen would be the actual label, tag, or packaging on the product which is sold under the mark. For a Service mark, an acceptable specimen would be an advertisement, such as a newspaper ad, brochure, leaflet, flyer, or webpage screen shot which shows the mark and denotes the services provided and distinguishes the services from those of another party.

19. How should I describe the mark?

The mark should be described exactly as it appears on the specimens provided.

- If you are applying for words or a phrase, only write the words/phrase for the description in #7.
- If the mark consists of a design and words, provide a detailed description of the design elements in such a way that an individual could visualize the mark by reading the description.

Description examples:

- *For a word mark:* "Brown Moose Lodge"

- *For a stylized mark: “Brown Moose Lodge’ in yellow capital letters on a single line.”*
- *For a stylized design mark: “The mark is the outline of a black square containing the head of a brown moose facing to the right. There is a line of 7green pine trees behind the moose head and 3 blades of green grass on both the left and right sides of the moose’s head. The phrase ‘Brown Moose Lodge’ is yellow, in all capital letters on single line centered below the square.”*

20. Should I include the color scheme for the mark as part of the description?

Color may be included in the description (this is optional). If applicant chooses to protect the colors of the mark, it is important to accurately note which color corresponds to each area of the mark. The three specimens submitted should show the color scheme exactly as described on the application. If there is more than one color combination for the mark (ex: a black star on a red background on one label, and a red star on black background on another label), two separate applications should be submitted, one for each color scheme.

- If you do not wish to include color as part of the mark, specifying that “color is not claimed as part of the mark” will ensure that your mark is accurately processed.

21. There are two (or more) versions of my mark; can I include both versions on a single application?

No. Different versions of the mark are considered separate marks and a new application (including separate payment and specimens) will be necessary to protect each version.

22. What does it mean to “disclaim” rights to certain words?

Our Office may ask you to “disclaim” the exclusive right to use certain words, phrases, or design elements included in your mark. This means that certain parts of the mark are not distinctive when viewed from the whole mark. Generally, a disclaimer will be requested for use of a geographical location or words in common usage (i.e. the state name “Arkansas” or the word “restaurant”). Disclaiming the exclusive right to use words does not mean that you cannot use them as part of your mark; it is simply a statement that you do not claim any right to those words apart from your mark and will not prevent others from using the disclaimed words. See Ark. Code Ann. § 4-71-204(c)(1)

23. When is it necessary to use a disclaimer?

Disclaimers are necessary when a word, phrase, or design is in common usage by the public. For example, if applying for “Tops Sandwich Shop,” applicant should disclaim use of the word “sandwich” and “shop” because they are commonly used words. Geographic locations must also be disclaimed. “Arkansas River,” “Petit Jean Mountain” and town names such as “Little Rock” are geographic locations, because ownership cannot be claimed for names of locations.

Additional disclaimer information is can be found on the United States Patent and Trademark Office’s website. Although their information specifically references the application process for a Federal Trademark, the general information stated similarly applies to Arkansas registration of Trademarks and Service marks concerning the use of disclaimers.

24. Why is it necessary to provide the dates of use for my mark?

The dates of first use can be important when determining who has rights to a mark if two applicants apply for the same or similar marks. Even if the mark is not currently protected, the individual who was using the mark in business first will likely be granted some protection for the earlier version in the event of a court conflict.

See Ark. Code Ann. § 4-71-203(a)(3)

Rejected Applications

25. What happens if my application is rejected?

Any rejected application will be returned with a cover sheet explaining the reasons for rejection. Any specimens and payment which were provided with the application will also be returned with the rejection notice.

26. Can I make corrections on my returned application and then re-submit the application to the Secretary of State?

No. Once an application or form has been notarized, it cannot be changed. If your application has been rejected for inadequate responses, a new application should be submitted. Fillable PDF forms may help you to save your application to make subsequent corrections.

27. What are reasons that my application could be rejected?

The reasons for rejection may include, but are not necessarily limited to:

- An incomplete form is submitted;
- Acceptable specimens are not provided;
- The application is not signed and/or not properly notarized;
- The application is messy or difficult to read. *Please print or type answers;*
- Failure to include payment of \$50.00 per each mark being applied;
- Ownership is incorrectly identified in #2 of the application;
- The proposed mark is not in current use within the state of Arkansas;
- The proposed mark is not registrable as described in #7 pursuant to Ark. Code Ann. § 4-71-202.

28. What determines the registrability of a Trademark/Service mark?

Pursuant to Ark. Code Ann. § 4-71-202, a mark shall not be registered if:

- (1) The mark applied for is comprised of immoral, deceptive, or scandalous matter.
- (2) The mark applied for is comprised of 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) The mark applied for consists of or comprises the flag or coat of arms or other insignia of the United States, any state or municipality, or any foreign nation, or any simulation thereof.
- (4) The mark applied for consists of or comprises the name, signature, or portrait identifying a particular living individual, except by the individual's written consent.
- (5) (i) The mark applied for is merely descriptive or deceptively misdescriptive of the goods or services represented.

- (ii) The mark applied for is primarily geographically descriptive or deceptively misdescriptive of them.
 - (iii) The mark applied for is primarily merely a surname.
- (6) The mark applied for consists of or comprises a mark which so resembles a mark registered in this state or a mark or trade name previously used by another registrant or business entity in this state.

Renewal and Other Post-Registration Issues

29. What symbol can I use to indicate I have registered a Trademark or Service mark?

After a mark has been registered with the Arkansas Secretary of State, you may use a “TM” (for a Trademark) or a “SM” (for a Service mark).

30. Can I use the registered Trademark symbol “R” within a circle ®?

The symbol with the letter “R” within a circle: “®” is for a mark that has been registered federally. It can only be used after the United States Trademark and Patent Office has granted registration of the mark, and not while the application is pending. Registering a mark with the Arkansas Secretary of State does not entitle you to use “®”.

31. How long is a Trademark or Service mark registration valid?

Registration of a mark is effective for five (5) years from the date of registration. Applicant may apply for renewal as early as six (6) months before the expiration date. *See Ark. Code Ann. § 4-71-206*
If a Trademark is not renewed before the expiration date, the trademark will expire. Expired trademarks cannot be renewed.

32. How do I renew my Trademark/Service mark registration?

Applicant may apply for renewal as early as six (6) months before the expiration date. The mark may be renewed every five years as long as the mark is in continual use. The information about the mark provided on a renewal application should be the same as what was provided on the original application, although with current specimens, unless an assignment (for change in ownership or entity name) was filed with our Office.
See Ark. Code Ann. § 4-71-206

33. What is required to change the words or design of an existing mark?

The wording or design of a mark currently registered with the Secretary of State’s office may not be changed. If you wish to make changes to an existing mark, a new application will be required since this would be considered a new mark.

34. What is a Trademark Assignment?

An assignment refers to the transfer of ownership to a mark. An assignor (current owner) transfers the ownership to an assignee (new owner of the mark) by correctly filing an assignment form with the Secretary of State, along with the \$20.00 fee.

35. Where can I find the Trademark Assignment form?

A Trademark Assignment form may be obtained online at:
<https://www.sos.arkansas.gov/uploads/bcs/TMAssignment.pdf>

A paper copy may be picked up in person at the Secretary of State's Business & Commercial Services Division (1401 W. Capitol Ave., Suite 250, Little Rock, AR 72201). By request, the form can be mailed to the assignor by calling (501) 682-3409.

36. I am selling my business. The sale includes a registered mark. Do I need to notify the Secretary of State?

Yes, an assignment of the mark should be submitted to the Secretary of State, along with the \$20.00 fee. When the assignment has been properly filed, a new certificate of registration in the assignee's name will be issued for the remainder of the mark's registration period. The assigned mark will also be eligible for the renewal in the same way the original mark would have been.

37. My business owns a mark and recently changed its corporate name with the Secretary of State. How will this affect the registration of our Trademark?

In order to accurately identify ownership, a Trademark assignment (with \$20.00 fee) must be filed with the Arkansas Secretary of State to reflect the change in a business name, as the owner to a mark. Before a Trademark/Service mark renewal will be granted, ownership must be correctly recorded in the Secretary of State files.

38. How does the Secretary of State regulate the use or misuse of Trademarks/Service marks?

The Secretary of State's office simply handles the registration and maintenance of records regarding the marks registered in Arkansas. If you have any questions regarding the protection of your mark, or infringement, please consult your own legal counsel.

39. Does registration with the Arkansas Secretary of State prevent others from registering a similar mark in other states?

Registration of your mark with this office only applies to the state of Arkansas. You should consult with your own attorney to determine whether additional state registrations are necessary.

40. Will registering my Trademark in Arkansas protect it against a Federal Trademark?

To ensure that all issues are considered and addressed appropriately, please consult with your own legal counsel.