

## Five Steps for Registering a Trademark in Pennsylvania

We've written about the [benefits of state trademark registration](#). There aren't many but if you believe state registration is right for you, here's a brief guide on how to register your trademark in Pennsylvania.



Pennsylvania trademark law closely tracks some of the same principles, which apply to federal trademarks. These include the definition of trademarks and service marks, use of the International Classification System with respect to assigning trademarks to classes of goods and services; and the requirement that a trademark be used in the ordinary course of trade.

Unlike federal trademarks, there is no provision to register a trademark on an “intent to use” basis. Also, as a side note, *state trademarks are renewable every five years*, you may abandon a state registered trademark by not using it, and your trademark is subject to cancellation should another trademark user consider your registration infringing. All the rules are embodied in the [Pennsylvania Trademark Act](#).

### STEP 1 – IS IT A TRADEMARK?

**Determine that the “trademark” you wish to register is actually a trademark.**

A “trademark” under Pennsylvania law is defined as “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.” “Service marks” are defined as “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.”

A “trade name,” on the other hand, is defined as a “word, name, symbol, device or any combination thereof used by a person to identify the business, vocation or occupation of the person and distinguish it from the business, vocation or occupation of others.” Trade names **are not** trademarks; however, if your trade name is the same or confusingly similar to a registered trademark, you may not have the rights to use your trade name and could be sued for trademark infringement if you do. Marks that are not registrable include descriptive marks; immoral, deceptive or scandalous marks; flags or other symbols representative of the Commonwealth of Pennsylvania or the United States as well as other kinds of marks. If you're unsure that the trademark you wish to register qualifies as a “trademark”, you should check with a trademark lawyer.

## STEP 2 – IS ANYBODY ELSE USING YOUR TRADEMARK?

**Make sure that nobody else is using your trademark or one that is confusingly similar.**

Do not waste your time and money registering or attempting to register a trademark that is the same or confusingly similar to another business' trademark. Although commercial trademark clearance searches are the best option, they are expensive and require a trademark professional to interpret them. Alternatively, you may search the Internet for similar trademarks. Remember, similar marks are not only marks that look or are spelled the same but also sound the same. CAT and KAT, therefore, are confusingly similar.

## STEP 3 – USE YOUR TRADEMARK IN COMMERCE.

**Make sure that you are using the trademark in commerce.**

Pennsylvania has no mechanism for reserving a trademark before you begin using it. Therefore, you must have a “bona fide use of the mark in the ordinary course of trade.” Under Pennsylvania law a mark is deemed to be in use when “it is placed in any manner on the goods or other containers or the displays associated” with the goods. Service marks are deemed to be in use when used or displayed in the sale or advertising of the associated service.

## STEP 4 – FILE AN APPLICATION.

**File a registration application with the Commonwealth of Pennsylvania, Department of State.**

The Pennsylvania trademark application is a simple document, which requires you to describe your trademark, the international class designation for the trademark, a description of the goods and services identified by the trademark, the date the trademark was used anywhere and the date upon which the trademark was first used in the Commonwealth of Pennsylvania. Also, if the trademark owner filed a trademark application with the United States Patent and Trademark Office, the application requests information about the application and whether and why it was refused, if applicable.

## STEP 5 – PAY THE FEE.

**Pay a \$50 registration fee to the Commonwealth of Pennsylvania.**

**CAUTION: A Pennsylvania Registration does not entitle you to use the ® symbol.** That's all there is to it but if you have concerns over whether state registration is an appropriate mechanism for protecting your brand, the lawyers at Lipton Weinberger & Husick would be pleased to advise you.

This guide is provided for general information purposes only and is not intended to be, nor should it be construed as professional legal advice. If you have a specific legal question related to the above information, please contact an attorney who is familiar with this area of the law.