



# How to File a State Trademark Application

State registration may be important if you are making purely intrastate use (i.e., within the state) of your trademark. In fact, the first requirement of registering a trademark in a state registry is that you are using the mark in that state. Another benefit of state registration is its relatively low cost. In Pennsylvania, for example, the registration fee is \$50.00, renewable every five years. Many other states charge fees in a broadly similar range, though specific amounts will vary by state.

Registering your trademark in a state registry provides a public record, and so gives notice to potential registrants that you are using your mark. For example, the state registration will be revealed in trademark searches run by other potential users. Because trademark rights are tied to first use under United States law, evidence of first use is critical to prevailing in a trademark action. Thus, state registration may also establish prior use of the mark in an infringement action. It is worth noting, however, that trademark rights, while based upon use, are also tied to the geographic area in which the trademark is being used. So, where a state registration is evidence of priority, it only extends to the state in which it is registered. State registration, therefore, may not be appropriate for businesses that conduct interstate activities or sell goods and services over the Internet to customers in other states.

Pennsylvania trademark law closely tracks some of the same principles that 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, that is if you are not using your trademark but intend to in the future.

Also, 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](#). Other states have similar statutes.

Here are the steps for registering a trademark in Pennsylvania. Other states may have similar rules.

## 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.” A ‘trade name’ identifies your business itself rather than specific goods or services. A trade name may or may not function as a trademark, but if your trade name is the same as or confusingly similar to a registered trademark, you may not have the right to use it and could be sued for trademark infringement.

Marks that are generally not registrable include merely descriptive marks (unless they have acquired distinctiveness), immoral, deceptive or scandalous marks, and flags or other symbols representative of the Commonwealth of Pennsylvania or the United States, among others. 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 time or 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 your state's trademark registry if accessible, and 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**

Ensure 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 you 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. If you want to use the ® symbol then you want to learn more about federal trademark registration. [See Circular No. 1.](#)