

Registering a State trademark

You can register a trademark by going to the Secretary of State website (www.sos.wv.gov), and filling out an application there. There are many steps to take before filling out the application, though. The Secretary of State lists five steps to complete:

(1) Determine who has the right to register the mark. This just means that the person who is using the mark and who owns the mark is the person who should apply for registration.

(2) Decide if the mark is acceptable in West Virginia. West Virginia has eight specific restrictions on trademark registration. A trademark **may not**:

- Be immoral, deceptive, or scandalous.
- Disparage or falsely suggest connection with persons, institutions, beliefs, or national symbols, or bring them into contempt or disrepute.
- Consist of or comprise the flag or coat of arms or other insignia of the United States, any State or municipality, or any foreign nation, or any simulation of these.
- Be the name, signature, or portrait of a living person without written consent of that person.
- Be deceptively misdescriptive.
For example: a company that makes imitation leather cannot register the trademark “True Hide” because it deceives customers into thinking that they make a real leather product.
- Be merely descriptive or geographically descriptive.
For example: a yogurt shop may not be able to obtain trademark protection for the name “Creamy Yogurt,” because that is merely descriptive. Similarly, “West Virginia Landscapers” may be confusing to consumers who cannot differentiate this landscaping company from other landscaping companies in West Virginia. For marks that are merely descriptive or geographically descriptive, a corporation can earn trademark protection once those marks earn “secondary meaning.” If “Creamy Yogurt” advertised extensively and became very well known to consumers as a specific company, it might be able to demonstrate that its name, though merely descriptive, has achieved “secondary meaning” and can be protected by trademark. Achieving secondary meaning is costly and risky, not to mention easily avoided by choosing a stronger mark to begin with.
- Be merely a last name.
- Resemble a mark registered or a mark or trade name used and not abandoned as to cause confusion.
For example: it is unlikely that a computer manufacturer will get trademark protection for the mark “Apple Pie Computers” or for a logo of an apple, since those marks may cause confusion between that company and the existing Apple computers company.

(3) Research whether the mark is available. Before going through the trouble of preparing a filing, you must make sure that the mark does not conflict with an existing mark. In West Virginia, this includes providing a description of your mark to the Secretary of State, who then searches their database for similar marks. You cannot use the database yourself, and this search may cost money. West Virginia uses the same product and service classifications of the USPTO, so you can also use the USPTO’s search function to do some of your research. Remember that the USPTO will not include trademarks that are only registered in the State, or that are common law trademarks, and you should use several methods to research the availability of your mark.

See the handout on Federal Trademarks for more about this. The website to request a search of trademarks by the West Virginia Secretary of State is at <http://www.sos.wv.gov/business-licensing/trademarkservicemarks/Pages/RequestingSearchesofRegisteredMarks.aspx> .

(4) Complete an application form. The form is available from the Secretary of State's website for download. You can also request a form be emailed, faxed, or mailed to you. The application must also include examples of your mark, such as product labels, letterhead, or photographs of the mark on your product. The application form is available at <http://www.sos.wv.gov/business-licensing/trademarkservicemarks/Documents/tm1.pdf> .

(5) Submit the application along with fees. Fees for the application can vary, depending on whether you are applying for a new trademark or renewal of an existing mark, and how many classifications you are seeking to register your mark under. The fee structure currently is as follows, but you should verify that the amounts have not changed before sending your fee in to the State:

Registration, each mark:	\$50 one or two classification plus \$50 for each additional classification
Renewal, each mark:	\$50 one or two classifications plus \$50 for each additional classification
Assignment:	\$25
Amendment:	\$25
Cancellation:	\$25
Search:	\$5 per search, if records are on-site \$10 per search, plus \$10 each additional hour if records archived off-site
Copies:	\$1 first page, plus \$.50 each additional page

A State registration of your trademark is good for ten years. After ten years, you need to renew your registration, using the same application form as a new registration.

Do I need a lawyer?

In short, yes. A lawyer can help you decide first whether State registration is the right choice for you. A lawyer can also help you perform searches of the databases to make sure there is not a conflicting trademark already in use. Though the search sounds simple, it can be very complicated and technical, not to mention that it costs you money to conduct the search with the State. The application process can also be complicated, and a lawyer can help you perfect your application before you spend money applying. Please contact the Entrepreneurship and Innovation Law Clinic at the WVU College of Law for any questions, or for help applying for a trademark. Librarian Marian Armour-Gemmen at the WVU LaunchLab on the Evansdale campus can also help you conduct a search of both the State and Federal systems.

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