

TITLE 1. ADMINISTRATION

PART 4. OFFICE OF THE SECRETARY OF STATE

CHAPTER 93. TRADEMARKS

SUBCHAPTER A. GENERAL INFORMATION AND CORRESPONDENCE

1 TAC §§93.1 - 93.6

§93.1. Address.

All letters and other communications relating to trademark matters should be addressed to: Secretary of State of Texas, Business & Public Filings Division, P.O. Box 13697, Austin, Texas 78711-3697. Correspondence is not received on Saturdays, Sundays, or legal holidays.

§93.2. Business To Be Transacted in Writing.

Unless otherwise specifically stated in the rules of this chapter, all business should be transacted in writing. The action of the Secretary of State will be based on the written record; no consideration will be given to any alleged oral promise, stipulation, or understanding in relation to which there is disagreement or doubt.

§93.3. Business To Be Conducted with Decorum and Courtesy.

Applicants and their attorneys or agents are required to conduct their business with the Secretary of State with decorum and courtesy. Written complaints against examiners and other employees must be kept separate from any application file.

§93.4. Correspondence.

(a) A letter relating to a trademark application should identify the name of the applicant, the mark, and the reference number appearing on the office action letter.

(b) Each application file should be complete in itself. Although the response submitted for two or more applications may be identical, a separate response should be provided for each application.

(c) A letter relating to a registered trademark should include the name of the registrant, an identification of the mark, the registration number, and the date of registration.

§93.5. Times for Taking Action: Expiration on Saturday, Sunday, or Holiday.

Whenever periods of time are specified in these sections in days, calendar days are intended. When the day, or the last day, fixed by statute or by these sections for taking any action in the Office of the Secretary of State falls on Saturday, Sunday, or on a legal holiday, the action may be taken on the next succeeding day which is not a Saturday, Sunday, or a legal holiday.

§93.6. Access to Applications.

Copies of pending applications and accompanying letters and documents will be available for public inspection. Copies of the papers will be furnished upon paying the appropriate fee.



SUBCHAPTER B. REPRESENTATION

1 TAC §§93.11 - 93.15

§93.11. Representation by an Attorney.

The owner of a trademark may file the application for registration of the mark or assignment or renewal of registration, or an attorney may represent the owner. The Secretary of State cannot aid in the selection of an attorney.

§93.12. Recognition for Representation.

When an attorney at law, acting in a representative capacity, appears in person or signs a paper in a trademark matter, the personal appearance or signature shall constitute a representation to the Secretary of State that the attorney is authorized and qualified to represent the particular party. Further proof of authority to act in a representative capacity may be required.

§93.13. Correspondence with Attorney or Agent.

The Secretary of State will correspond with the attorney or other recognized person representing the applicant. The Secretary of State will not undertake correspondence with more than one attorney or agent. If more than one attorney or agent appears, the Secretary of State will correspond with the last one appearing, unless otherwise requested.

§93.14. Revocation of Power of Attorney or Authorization of Agent.

Authority to represent an applicant may be revoked at any stage in the registration proceedings upon notification to the Secretary of State. Once revoked, the Secretary of State will communicate directly with the applicant or with any other person authorized by the applicant.

§93.15. Representation by Non-Lawyers.

Recognition of any person under this chapter is not to be construed as sanctioning or authorizing the performance of any acts regarded as the unauthorized practice of law.



SUBCHAPTER C. SUBMISSION REQUIREMENTS

1 TAC §§93.21 - 93.24

§93.21. *Date of Receipt.*

(a) An application accompanied by the appropriate fee for at least one class of goods and/or services will be given a date of receipt for purposes of processing by the Secretary of State. The application will be held pending final determination of the mark's registrability by an examiner.

(b) An application delivered without the appropriate fee for at least one class of goods and/or services will not be accorded a date of receipt for purposes of processing and will be returned to sender.

§93.22. *Papers Not Returnable.*

(a) Applicants should not include confidential information with an application. Any documents containing confidential information will be returned to the sender prior to filing.

(b) After an application is filed the papers will not be returned for any purpose. The Secretary of State will furnish copies to the applicant upon request and payment of the copy cost.

§93.23. *Application To Be Clear and Legible.*

All documents must be clear and legible, written with black ink on white paper, so that a clear electronic image may be made. The application should be written on only one side of the paper.

§93.24. *Requirements for Receiving a Registration Date.*

A mark registrable under §16.051 of the Business & Commerce Code will receive a registration date only if each of the following items is received and found to comply with the requirements of the Code and this chapter:

- (1) written application for registration that complies with Subchapter D of this chapter (relating to the Written Application);
- (2) a drawing of the mark that complies with Subchapter E of this chapter (relating to Drawing);
- (3) at least three specimens of the mark as actually used, that comply with Subchapter F of this chapter (relating to Specimens), including at least one specimen per class; and
- (4) the application fee for each class of goods and/or services, as required by §93.151 of this title (relating to Recordation Fees).



SUBCHAPTER D. THE WRITTEN APPLICATION

1 TAC §§93.31 - 93.40

§93.31. *Application Requirements.*

(a) The application must be in English, subject to the provisions of §93.35 of this title (relating to Description of Mark). Use of the application form promulgated by the Secretary of State is recommended, but not mandatory, for an applicant seeking to register a mark in two or fewer classes.

(b) The application must include:

- (1) the name and business address of the applicant;
- (2) if the applicant is a corporation or LLC, the state under whose laws the applicant was incorporated or organized;
- (3) if the applicant is a general or limited partnership, the state under whose laws the partnership was organized and the names of the general partners;
- (4) the names or a description of the goods and/or services on or in connection with which the mark is being used;
- (5) the mode or manner in which the mark is being used on or in connection with the goods and/or services;
- (6) the class to which the goods and/or services belong;
- (7) the date the applicant or applicant's predecessor in interest first used the mark anywhere;
- (8) the date the applicant or the applicant's predecessor in interest first used the mark in this state;
- (9) a statement that the applicant is the owner of the mark, the mark is in use and, to the best of applicant's knowledge, no other person has registered the mark, either federally or in this state, no other person is entitled to use the mark in this state in the identical form used by applicant, or in a form that is likely, when used in connection with the goods and/or services, to cause confusion or mistake, or to deceive, because of its resemblance to the mark used by the applicant; and
- (10) a statement as to whether the applicant or the applicant's predecessor in interest has filed an application to register the mark, or a portion or composite of the mark, with the United States Patent and Trademark Office, and, if so, the applicant shall fully disclose information with respect to that filing, including the filing date and serial number of each application, the status of the filing, and if any application was finally refused registration or has not otherwise resulted in the issuance of a registration, the reasons for the refusal or nonissuance.

(c) The application must be accompanied by:

- (1) a drawing sheet;

- (2) at least three specimens of the mark as actually used; and
- (3) the application fee pursuant to §93.151 of this title (relating to Recordation Fees).

(d) The application must be signed and verified in compliance with §93.33 of this title (relating to Execution Requirements).

§93.32. Supplemental Application Requirements for Applicants Seeking to Register a Mark in Two or More Classes.

(a) An applicant seeking to register a mark in two or more classes must comply with §93.31 of this title (relating to Application Requirements). Additionally, the applicant must:

- (1) clearly and concisely describe the goods and/or services, in each class, on or in connection with which the mark is being used by the applicant at the time of submission of the application;
- (2) include the dates of use and specimen of use appropriate to each class; and
- (3) submit an application fee for each class pursuant to §93.151 of this title (relating to Recordation Fees).

(b) The Secretary of State will issue a single certificate of registration that identifies each class in which the mark is registered. If an applicant wishes to obtain separate certificates of registration for one or more classes, the applicant must file a separate application for each class.

§93.33. Execution Requirements.

(a) The application must indicate the date of execution and be signed and verified by the oath or affirmation of an authorized person.

- (1) The verification shall substantially comply with the following:

Figure: 1 TAC §93.33(a)(1)

State of _____
 County of _____

_____, personally appeared before me, and being first duly sworn declared that he/she signed this application in the capacity designated, if any, and further states that he/she has read the above application and the statements therein contained are true and correct.

 (Personalized Seal) Signature of Officer
 Authorized to Administer Oaths

(2) In lieu of a verification, the application may include a declaration by an authorized person that complies with §132.001 of the Civil Practice & Remedies Code.

(b) For purposes of this subchapter, a person is authorized to sign an application if:

- (1) the person has legal authority to bind the owner;
- (2) the person has firsthand knowledge of the facts and actual or implied authority to act on behalf of the applicant; or
- (3) the person is an attorney who has actual written or verbal power of attorney or an implied power of attorney from the applicant.

(c) A person with legal authority to bind the owner means:

- (1) in the case of a sole proprietor, the individual that owns the mark;
- (2) in the case of a joint venture, a party to the venture;
- (3) in the case of a partnership, a general partner;
- (4) in the case of a corporation, an authorized corporate officer;
- (5) in the case of a limited liability company, an authorized manager, member, or officer;

(6) in the case of an applicant organized in any manner, other than set forth in this subsection, a person that has the authority to legally bind the applicant or registrant under its governing documents.

§93.34. Description of Goods and/or Services.

(a) The application must clearly and concisely identify the goods and/or services on or in connection with which the applicant uses the mark in commerce.

(b) The description of goods and/or services must use common or generic terms or phrases to describe applicant's goods and/or services. Do not include highly technical language or a reference to a federally or state registered mark.

(c) Each description of goods and/or services must be limited to a single class. If the applicant seeks to register a mark in multiple classes, the application must include a separate description of goods and/or services for each class.

(d) An application that contains a description of goods and/or services that is broad or ambiguous enough to fall into more than one class will be rejected. The applicant will be required to more narrowly specify the goods and/or services in connection with which the mark is being used. For example, "publication" is not an acceptable description of goods and/or services because it is not specific enough to identify the goods and/or services with which the mark is being used, e.g., downloadable publications (Class 09), educational publications (Class 16), online publications (Class 41).

§93.35. Description of Mark.

(a) The description should clearly and accurately describe all significant aspects of the mark, including both word and design elements. An element of a mark is considered significant if its addition or deletion would affect the overall commercial impression of the mark.

(b) The description of the mark should not mention colors unless applicant is making a color claim. If color is claimed as a feature of the mark, the description must comply with §93.36 of this title (relating to Color in the Mark).

(c) If the mark includes non-English wording, the description of the mark must include an English translation of that wording.

§93.36. Color in the Mark.

(a) If the mark includes color, the description of the mark must claim color as a feature of the mark and include a color location statement specifying where the color(s) appear on the mark. The color(s) should be described in generic terms rather than by reference to a commercial color identification system.

(1) A properly worded color claim would read as follows: "The color(s) {name the color(s)} is/are claimed as a feature of the mark."

(2) A properly worded color location statement would read as follows: "The mark consists of {specify the color(s) and literal or design element(s) on which the color(s) appear (e.g., a red balloon with a yellow ribbon)."

(b) When color is claimed as part of the mark, the applicant may provide either a color or a black and white drawing sheet. If a color drawing sheet is provided, the colors must match the colors as described in the color location statement.

(c) When color is claimed as part of the mark, at least one specimen per class in which registration of the mark is sought, must be in color and the location of the colors must match the colors as described in the color location statement.

§93.37. Identification of Prior Applications or Registrations with the United States Patent and Trademark Office.

(a) The applicant must disclose any prior applications for registration of the mark, or a portion of the mark, with the United States Patent and Trademark Office (USPTO). If any prior applications for registration have been made by the applicant or applicant's predecessor, the applicant must provide the following information to the Secretary of State:

(1) the filing date and serial number of each application;

(2) the status of any filing; and

(3) if any application was finally refused registration or has not otherwise resulted in the issuance of a registration, the reasons for the refusal or nonissuance.

(b) Applicants may comply with subsection (a) of this section by providing copies of documents issued by the USPTO that include the required information.

(c) Failure to disclose an application for registration with the USPTO that was finally refused or has not otherwise resulted in issuance of a registration may result in the rejection of an application.

§93.38. Use by Predecessor or by Related Companies.

(a) An applicant may assert a date of first use by a predecessor in title, or by a related company, if the use operates to benefit the applicant. The application must include a statement that the first use was by the predecessor in title or by the related company.

(b) If the applicant is not using the mark, but one or more related companies are using the mark, and their use operates to benefit the applicant, the application must indicate this fact.

(c) The trademark examiner may inquire into the relationship and may require appropriate evidence showing that the use by related companies operates to benefit the applicant.

§93.39. Proof of Distinctiveness.

(a) An applicant may seek registration of a mark, otherwise unregistrable by reason of §16.051(a)(5)(A), (B), or (6) of the Business & Commerce Code, which the applicant believes has become distinctive as applied to the applicant's goods and/or services. To support the claim of distinctiveness the applicant may submit:

(1) evidence of prior registrations with the Secretary of State of the same or similar marks owned by the applicant or applicant's predecessor in interest;

- (2) actual evidence of acquired distinctiveness; or
- (3) a sworn statement of the applicant's substantially exclusive and continuous use of the mark for the five years preceding the date on which the applicant filed its application for registration.

(b) Types of evidence that may be submitted to support a claim of distinctiveness may include sworn affidavits, depositions, or other evidence showing duration, extent, and nature of use of the mark. The applicant also may submit evidence of advertising expenditures made in connection with the mark; the evidence should identify the types of media and should include typical advertisements. Additional evidence may include affidavits, letters, or statements from the trade or public. Sworn statements in the application may, in appropriate cases, be accepted as prima facie evidence of distinctiveness.

(c) After reviewing evidence submitted to support a claim of distinctiveness, the trademark examiner may require further evidence, or may determine that the mark is so generic or highly descriptive as applied to the applicant's goods and/or services that the mark cannot be registered regardless of the amount of evidence provided.

§93.40. Olympic Symbols.

(a) An application for registration of a mark that uses a symbol, emblem, trademark, trade name, or insignia of the International Olympic Committee or the United States Olympic Committee; or which consists of or includes the words, "Olympic," "Olympiad," or "Citius Altius Fortius," or a combination or simulation of those words must be accompanied by a letter from the United States Olympic Committee consenting to its use as a trademark or service mark and its registration as a trademark or service mark.

(b) Written consent from the United States Olympic Committee for the registration of the mark is not determinative of the issue of registrability under the provisions of §16.051 of the Business & Commerce Code.



SUBCHAPTER E. DRAWING

1 TAC §93.51, §93.52

§93.51. Drawing Required.

(a) The drawing depicts the mark sought to be registered and will be used to reproduce the mark on the registration certificate. The drawing shall be a substantially exact representation of the mark as actually used on or in connection with the goods and/or services.

(b) The drawing must be clear and legible and presented on white paper, so that a clear electronic image may be made. An electronic reproduction of the mark will suffice as the drawing, as long as it meets the requirements of this section and §93.52 of this title (relating to Requirements for a Drawing).

(c) The drawing sheet should be no larger than 8 1/2 inches by 11 inches. The actual drawing of the mark must be no larger than 3.15 inches (8 cm) high by 3.15 inches (8 cm) wide.

(d) The drawing must depict only one mark and should be limited to the mark sought to be registered. Matter appearing on the specimens that is not part of the mark should not be placed on the drawing sheet. Purely informational matter such as package contents, contact information, and organizational identifiers are generally not considered part of the mark.

§93.52. Requirements for a Drawing.

(a) *Marks that include standard characters:* For purposes of this chapter, a "standard character" shall be words, letters, numbers, or any combination thereof without claim to any particular font, style, or color.

(1) If the mark sought to be registered consists of standard characters, those characters shall be typed in capital letters with black ink.

(2) When a mark includes standard characters, those characters shown in the drawing do not have to appear in the exact same font, style, or color as the specimen of use. However, the Secretary of State will review the mark depicted on the specimen to determine whether the characters are so distinctive as to change the overall commercial impression of the mark.

(b) *Marks that include a design element:* A mark is considered to contain a design element, if the mark is comprised, in whole or in part, of special characteristics such as a two or three-dimensional design and/or words, letters, or numbers or the combination thereof in a particular font, style, or color.

(c) *Marks that include color:* If a color is claimed as a feature of the mark pursuant to §93.36 of this title (relating to Color in the Mark), the drawing of the mark may be presented in either color or black and white. If the drawing of the mark is in color, it must match the color(s) described in the color location statement. If color is not claimed as a feature of the mark, any color(s) shown in the drawing sheet will be disregarded.



SUBCHAPTER F. SPECIMENS

1 TAC §§93.61 - 93.63

§93.61. Inclusion in Application.

(a) The application must include at least three specimens or examples of use of the mark, including at least one specimen per class in which registration is sought. The specimen must show the mark as it is used on or in connection with the goods and/or services in Texas.

(b) If a specimen supports multiple classes, the applicant should indicate which classes are supported by the specimen.

(c) A specimen which is merely a printer's proof or reproduction of the drawing submitted to comply with §93.51 of this title (relating to Drawing Required) will not be considered to be a specimen of the mark in use.

§93.62. *Requirements for a Specimen.*

(a) *Marks that include color:* If a color is claimed as a feature of the mark pursuant to §93.36 of this title (relating to Color in the Mark), at least one specimen in each class in which registration of the mark is sought must be in color and the location of the colors must match the colors as described in the color location statement.

(b) *Trademark specimens:* An appropriate specimen for a trademark may include labels, tags, containers, or displays associated with the goods. In the case of goods for which the mark is applied by means of stamp impression or stencil, the specimen may be a representation or impression of the stamp or stencil on a piece of paper. If the nature of the goods makes placement of the mark on the goods impracticable, documents associated with the goods or sale of the goods may be submitted.

(c) *Service mark specimens:* An appropriate specimen for a service mark shall show the mark as actually used in the sale or advertising of the services. In the case of service marks not used in printed or written form, the Secretary of State may accept audio or video recordings in CD or DVD format, if accompanied by a written transcript of the contents.

§93.63. *Photographs as Specimens.*

When the manner of use of a mark prevents the applicant from providing actual specimens, the applicant may provide a suitable photograph. The photograph should be no larger than 8 1/2 inches by 11 inches. The photograph should clearly show the mark and the item on which it is used. Matte finish photographs are most suitable for creating an electronic image.



SUBCHAPTER G. CLASSIFICATION

1 TAC §93.71, §93.72

§93.71. *Classification of Goods and Services.*

(a) In accordance with the Business & Commerce Code, §16.065, the Secretary of State uses the international classification of goods and services used by the United States Patent and Trademark Office (USPTO). That classification is set forth in this section. The classification shall not limit or extend an applicant's rights. The U.S. Acceptable Identification of Goods and Services Manual on the USPTO website may be referenced for a more specific listing of goods and services.

(b) The classes of goods and services are as follows:

(1) chemicals used in industry, science, and photography, as well as in agriculture, horticulture, and forestry; unprocessed artificial resins, unprocessed plastics; manures; fire extinguishing compositions; tempering and soldering preparations; chemical substances for preserving foodstuffs; tanning substances; adhesives used in industry;

(2) paints, varnishes, lacquers; preservatives against rust and against deterioration of wood; colorants; mordants; raw natural resins; metals in foil and powder form for painters, decorators, printers, and arts;

(3) bleaching preparations and other substances for laundry use; cleaning, polishing, scouring, and abrasive preparations; soaps; perfumery, essential oils, cosmetics, hair lotions; dentifrices;

(4) industrial oils and greases; lubricants; dust absorbing, wetting, and binding compositions; fuels (including motor spirit) and illuminants; candles and wicks for lighting;

(5) pharmaceutical, veterinary preparations; sanitary preparations for medical purposes; dietetic food and substances adapted for medical or veterinary use, food for babies; dietary supplements for humans and animals; plasters, materials for dressings; material for stopping teeth, dental wax; disinfectants; preparations for destroying vermin; fungicides, herbicides;

(6) common metals and their alloys; metal building materials; transportable buildings of metal; materials of metal for railway tracks; nonelectric cables and wires of common metal; ironmongery, small items of metal hardware; pipes and tubes of metal; safes; goods of common metal not included in other classes; ores;

(7) machines and machine tools, motors (except for land vehicles); machine coupling and transmission components (except for land vehicles); agricultural implements other than hand-operated; incubators for eggs; automatic vending machines;

(8) hand tools and implements (hand-operated); cutlery; side arms; razors;

(9) scientific, nautical, surveying, photographic, cinematographic, optical, weighing, measuring, signaling, checking (supervision), life-saving and teaching apparatus and instruments; apparatus and instruments for conducting, switching, transforming, accumulating, regulating or controlling electricity; apparatus for recording, transmission, or reproduction of sound or images; magnetic data carriers, recording discs; compact discs, DVDs and other digital recording media; mechanisms for coin-operated apparatus; cash registers, calculating machines, and data processing equipment, computers; computer software; fire-extinguishing apparatus;

(10) surgical, medical, dental, and veterinary apparatus and instruments, artificial limbs, eyes, and teeth; orthopedic articles; suture materials;

(11) apparatus for lighting, heating, steam generating, cooking, refrigerating, drying, ventilating, water supply, and sanitary purposes;

(12) vehicles; apparatus for locomotion by land, air, or water;

- (13) firearms; ammunition and projectiles; explosives; fireworks;
- (14) precious metals and their alloys and goods in precious metals or coated therewith, not included in other classes; jewelry, precious stones; horological and chronometric instruments;
- (15) musical instruments;
- (16) paper, cardboard, and goods made from these materials, not included in other classes; printed matter; bookbinding material; photographs; stationery; adhesives for stationery or household purposes; artists' materials; paint brushes; typewriters and office requisites (except furniture); instructional and teaching material (except apparatus); plastic materials for packaging (not included in other classes); printers' type; printing blocks;
- (17) rubber, gutta-percha, gum, asbestos, mica, and goods made from these materials and not included in other classes; plastics in extruded form for use in manufacture; packing, stopping, and insulating materials; flexible pipes, not of metal;
- (18) leather and imitations of leather, and goods made of these materials and not included in other classes; animal skins, hides; trunks and traveling bags; umbrellas, parasols, and walking sticks; whips, harness, and saddlery;
- (19) building materials (nonmetallic); nonmetallic rigid pipes for building; asphalt, pitch, and bitumen; nonmetallic transportable buildings; monuments, not of metal;
- (20) furniture, mirrors, picture frames; goods (not included in other classes) of wood, cork, reed, cane, wicker, horn, bone, ivory, whalebone, shell, amber, mother-of-pearl, meerschaum, and substitutes for all these materials, or of plastics;
- (21) household or kitchen utensils and containers; combs and sponges; brushes (except paint brushes); brush-making materials; articles for cleaning purposes; steel wool; unworked or semi-worked glass (except glass used in building); glassware, porcelain, and earthenware not included in other classes;
- (22) ropes, string, nets, tents, awnings, tarpaulins, sails, sacks and bags (not included in other classes); padding and stuffing materials (except of rubber or plastics); raw fibrous textile materials;
- (23) yarns and threads, for textile use;
- (24) textiles and textile goods, not included in other classes; bed and table covers;
- (25) clothing, footwear, headgear;
- (26) lace and embroidery, ribbons and braid; buttons, hooks and eyes, pins and needles; artificial flowers;
- (27) carpets, rugs, mats and matting, linoleum and other materials for covering existing floors; wall hangings (nontextile);
- (28) games and playthings; gymnastic and sporting articles not included in other classes; decorations for Christmas trees;
- (29) meat, fish, poultry, and game; meat extracts; preserved, dried, and cooked fruits and vegetables; jellies, jams, compotes; eggs, milk, and milk products; edible oils and fats;
- (30) coffee, tea, cocoa, and artificial coffee; rice, tapioca, sago; flour and preparations made from cereals; bread, pastry and confectionery, ices; sugar, honey, treacle; yeast, baking-powder; salt, mustard; vinegar, sauces (condiments); spices; ice;
- (31) grains, and agricultural, horticultural, and forestry products not included in other classes; living animals; fresh fruits and vegetables; seeds, natural plants, and flowers; foodstuffs for animals; malt;
- (32) beers; mineral and aerated waters and other nonalcoholic beverages; fruit beverages and fruit juices; syrups and other preparations for making beverages;
- (33) alcoholic beverages (except beers);
- (34) tobacco; smokers' articles; matches;
- (35) advertising; business management; business administration; office functions;
- (36) insurance; financial affairs; monetary affairs; real estate affairs;
- (37) building construction; repair; installation services;
- (38) telecommunications;
- (39) transport; packaging and storage of goods; travel arrangement;
- (40) treatment of materials;
- (41) education; providing training; entertainment; sporting and cultural activities;
- (42) scientific and technological services and research and design relating thereto; industrial analysis and research services; design and development of computer hardware and software;
- (43) services for providing food and drink; temporary accommodation;
- (44) medical services; veterinary services; hygienic and beauty care for human beings or animals; agriculture, horticulture, and forestry services; and

(45) legal services; security services for the protection of property and individuals; personal and social services rendered by others to meet the needs of individuals.

§93.72. *Identification of Goods and/or Services.*

(a) The application must identify the goods and/or services in connection with which the mark is being used. A single class application may state that the mark is in use with any number of goods and/or services contained within one class. If the goods and/or services identified on the application fall within two or more classes, the application must comply with §93.32 of this title (relating to Supplemental Application Requirements for Applicants Seeking to Register a Mark in Two or More Classes).

(b) Classification is the basis for determining the fees that must be paid. If the application sets forth goods and/or services in more than one class and submits insufficient fees to cover all the classes, the applicant must either amend the application to restrict the goods and/or services to the number of classes for which the fee has been paid, or submit additional payment to cover each class set forth in the identification of goods and/or services.



SUBCHAPTER H. EXAMINATION OF AN APPLICATION AND ACTION BY APPLICANT

1 TAC §§93.81 - 93.89

§93.81. *Action by Examiner.*

(a) Upon receiving an application for registration and payment of the application fee for at least one class, a trademark examiner will examine an application for registration.

(b) Applications will be examined in the order in which they are received, including applications concurrently processed for registration of the same or confusingly similar marks used in connection with the same or similar goods and/or services.

(c) The applicant will be notified in writing of any formal requirements or objections to the application for registration.

(d) An examiner may require the applicant to furnish any information and exhibits reasonably necessary to the proper examination of the application.

§93.82. *Concurrent Applications for Same or Similar Mark.*

(a) When concurrently processing applications for marks that are likely to cause confusion or mistake, when applied to the applicant's goods and/or services, the Secretary of State will give priority to the application with the earliest date of receipt, as determined by §93.21 of this title (relating to Date of Receipt). Applications for the same or similar mark that have a later date of receipt will be cited to the conflicting pending application. The application will be held pending until the Secretary of State makes a final determination regarding the registration of the prior received application.

(b) When applications have the same date of receipt, pursuant to §93.21 of this title, the application with the later date of execution will be held pending a final determination of the application with the earlier date of execution. An application that does not specify a date of execution will be presumed to have been executed no earlier than:

- (1) its postmark date, if mailed; or
- (2) its date of receipt, if delivered by other means.

(c) When applications have the same date of receipt and the same date of execution, the trademark examiner will give priority to the application stating the earliest date of first use in this state.

§93.83. *Period for Response.*

A written response must be received by the Secretary of State within 90 days from the date of mailing of any action by an examiner. The response may be made with or without amendment and include proper action by the applicant as the nature of the action and the case may require.

§93.84. *Suspension of Action.*

(a) Action may be taken by the Secretary of State to suspend a pending application for good and sufficient cause, including a pending proceeding before the United States Patent and Trademark Office (USPTO) or a court which is relevant to the issue of registrability of the applicant's mark. An application suspended by the Secretary of State will be reviewed for any substantive defects and then suspended for a reasonable amount of time, but not longer than six months. The applicant will be notified in writing of the reason for the suspension. The Secretary may suspend the application for additional six-month periods by notifying the applicant in writing.

(b) On written request of the applicant, the Secretary of State may suspend action for a period of up to six months, if a proceeding is pending before the USPTO or a court which is relevant to the issue of registrability of the applicant's mark. An applicant's written request for a suspension of action under this section filed within the 90-day response period may be considered responsive to an examiner's action.

(c) The request should include the following information:

- (1) an identification of the application;
- (2) a statement that the applicant requests suspension of the trademark examination process;
- (3) an identification of the pending proceeding including the name of the court, file name, and cause number; and
- (4) a brief statement of the relevance of the pending proceeding to the application before the trademark examiner.

(d) No later than upon request for suspension, the applicant should address all objections to registration other than those on which the suspension is based.

(e) The trademark examiner shall send written notice of the acceptance or rejection of the request to the applicant. If the examiner accepts the request, the examiner shall make appropriate notations on the application file.

(f) The applicant shall notify the Secretary of State within 20 days of the resolution of any proceeding.

(g) If the proceeding remains pending at the end of the initial, or any subsequent suspension period, the applicant shall provide written notice of this fact to the Secretary of State. The Secretary of State may suspend action for additional periods of up to six months. If the applicant does not provide notice by the end of the initial or any subsequent suspension period, the application will be deemed abandoned.

§93.85. Third Party Communications.

(a) Except as otherwise provided in subsection (b) of this section, action of the Secretary of State will be based upon the written record developed by the applicant and the trademark examiner. Communications from third parties in opposition to the registration of a pending application which are adversarial in nature are inappropriate and will not be considered part of the record by the trademark examiner. Objections to registration of this nature should be resolved judicially pursuant to §16.104, Business & Commerce Code.

(b) Communication from a third party which brings to the attention of the Secretary of State facts or information bearing upon the registrability of the mark because of the generic or descriptive nature of the mark may be made part of the record for consideration along with all other facts available to the examiner. Before any of the factual information can be made part of the record, the communication must be in writing and contain proof and support of the information provided.

§93.86. Final Action.

When a refusal of registration is stated to be a final action, the applicant's response is limited to bringing an action to compel registration pursuant to the Business & Commerce Code, §16.106.

§93.87. Abandonment.

If within 90 days of the date of mailing of an action by an examiner, an applicant fails to respond or fails to respond completely, the application will be deemed abandoned. After an application has been abandoned, the applicant may submit a new application and fee.

§93.88. Express Abandonment.

An applicant may expressly abandon an application during the course of the examination process by executing and submitting a written abandonment with the Secretary of State.

§93.89. Judicial Review of Final Action of the Secretary of State.

(a) A final action or final decision of the Secretary of State may be judicially reviewed pursuant to §16.057 of the Business & Commerce Code. An applicant or registrant may seek judicial review of the refusal of the Secretary of State to register a trademark or renew the registration of a trademark by seeking a writ of mandamus in a district court of Travis County, pursuant to §16.106 of the Business & Commerce Code.

(b) A person seeking cancellation of a trademark registered by the Secretary of State may bring suit in a district court in Travis County to cancel the registration pursuant to §16.106 of the Business & Commerce Code.



SUBCHAPTER I. AMENDMENTS

1 TAC §§93.91 - 93.94

§93.91. Amendments to Application.

(a) The applicant may amend the application, as required, to correct informalities, to avoid objections, or at the request of the Secretary of State.

(b) The identification of goods and/or services may be amended to clarify or limit, but not to broaden, the stated goods and/or services.

(c) If the verification or declaration is executed by the wrong party, the applicant may submit a substitute verification or declaration.

(d) The dates of use may be amended, provided that the applicant does not amend the application to include a date of use that is subsequent to the date of receipt of the application.

(e) The name of the applicant may be amended if incorrectly stated in the application, but the application may not be amended to include a different applicant.

§93.92. Amendments to Description or Drawing.

The trademark examiner will permit amendments to the description or drawing of the mark only if warranted by the specimens or facsimiles as originally filed. Amendments to the description or drawing supported by additional specimens may require an additional statement signed by the applicant alleging that the mark shown in the amended drawing was in actual use prior to the date of receipt of the application.

§93.93. Form of Amendment.

(a) In every amendment the applicant must indicate the exact word or words to be stricken from or inserted in the application. The applicant must indicate precisely where the insertion or deletion is to occur. Additions or insertions on the application must be made by the applicant, applicant's agent, or attorney.

(b) An examiner may require the applicant to rewrite the entire application if the number or nature of amendments makes it difficult to consider the application. The examiner also may require the entire application to be rewritten to clarify the record.

§93.94. *Disclaimer by Amendment.*

(a) An examiner may require a disclaimer of any unregistrable component (such as descriptive words, abbreviations, names, symbols, terms, slogans, or elements) of a mark otherwise registrable.

(b) An applicant may voluntarily disclaim a component of a mark sought to be registered.

(c) An applicant's failure to comply with a request for disclaimer is sufficient basis for a final action denying registration.



SUBCHAPTER J. ALLOWANCE OF REGISTRATION

1 TAC §93.101, §93.102

§93.101. *Registration.*

(a) If an examiner determines that all requirements have been met and the application is in condition for registration, the examiner will issue a certificate of registration to the applicant. The applicant will only receive a file-stamped copy of the application if the application, and all supporting material, were submitted in duplicate.

(b) The date of filing will be the date of receipt for examination, or the date of last receipt for reexamination. The date of filing may not be a date before the date on which the application is found to conform to law.

§93.102. *Certificate.*

When an application has been found to comply with Chapter 16 of the Business & Commerce Code, a certificate will be issued. The certificate will be under the signature and official seal of the Secretary of State and will include:

- (1) the name and business address of the person claiming ownership of the mark;
- (2) the applicant's organizational form and state of formation, if applicant is organized as an entity;
- (3) the names of the general partners, if applicant is organized as a partnership;
- (4) a description of any word element of the mark;
- (5) a color claim and color location statement, if any;
- (6) a description of the goods and/or services on or in connection with which the mark is being used;
- (7) a statement of each class of goods and/or services in which the mark is registered;
- (8) for each class, the date claimed for the first use of the mark anywhere;
- (9) for each class, the date claimed for the first use of the mark in Texas;
- (10) a black and white reproduction of the mark;
- (11) the registration date; and
- (12) the term of the registration.



SUBCHAPTER K. CORRECTIONS

1 TAC §§93.111 - 93.115

§93.111. *Correction of Mistake by Owner.*

(a) If a registrant incorrectly sets forth its name, business address, organizational structure, state of organization, or name of general partners in the original application for registration or application for renewal of registration, the registrant may provide evidence of such mistake or error in execution and request that the record regarding the registered trademark be corrected. If the Secretary of State determines that the proposed correction is not a change in the identity or organizational form of the registrant or a change of ownership, but is merely a correction of a drafting error by the registrant, the Secretary may file the request and update its computer records accordingly.

(b) The Secretary of State records may be corrected to change the identification of goods and/or services relating to an active trademark or service mark registration to delete from that identification the registered word mark of another party. The notice of correction must be signed by the registrant and must set forth the following information:

- (1) the name and address of the registrant;
- (2) an identification of the trademark and its certificate of registration number;
- (3) the term(s) to be deleted from the identification of goods and/or services; and
- (4) the generic term(s) or phrase to be used in place of the deleted term(s). Upon receipt of the notice of correction, the Secretary of State will file the notice and place the notice on record, update its computer records accordingly, and send a letter of acknowledgment to the

registrant. A duplicate "file stamped" copy of the notice of correction will accompany the letter of acknowledgment, provided that a duplicate copy of the notice is provided for such purpose.

(c) If the records of the Secretary of State clearly disclose a material mistake in a certificate of registration, including a mistake relating to the classification of goods and/or services, the Secretary, pursuant to §93.113 of this title (relating to Issuance of a Corrected Certificate), will issue a corrected certificate of registration, upon the registrant's request.

§93.112. Change of Address.

Upon written notification by the registrant, the Secretary of State shall change a registrant's business address. Upon submitting the notice of an address change, the registrant may request a new certificate of registration pursuant to §93.113 of this title (relating to Issuance of a Corrected Certificate).

§93.113. Issuance of a Corrected Certificate.

(a) A registrant, or registrant's authorized representative, may request a corrected certificate of registration by submitting the following to the Secretary of State:

- (1) the required fee; and
- (2) its original certificate of registration; or
- (3) a statement that the certificate of registration has been lost, misplaced, or destroyed.

(b) This subsection also applies to certificates issued upon renewal, transfer of ownership, change of name, or assignment.

§93.114. Correction of Office Mistake.

If the Secretary of State makes a material mistake when recording pertinent information about a registration, the Secretary, upon receiving notice of the mistake, will update the computer records accordingly. In its discretion, the Secretary may also issue a new certificate of registration without charge.

§93.115. Transfer of Ownership or Change of Name.

(a) In the case of a transfer of ownership or a change of name of the registrant which does not constitute an assignment, a new certificate of registration for the remainder of the unexpired term of a mark's registration may, upon request, be issued in the new name or in the name of the transferee, if the instrument evidencing the transfer of ownership or change of name has been recorded pursuant to §16.062, Business & Commerce Code.

(b) A request for a new certificate under this section must comply with §93.113 of this title (relating to Issuance of a Corrected Certificate) and must be signed by the registrant or transferee or an agent of the registrant or transferee.



SUBCHAPTER L. TERM AND RENEWAL

1 TAC §§93.121 - 93.124

§93.121. Term of Registrations and Renewals.

Unless cancelled in accordance with the Business & Commerce Code, Chapter 16, or these sections, a registration remains in force for five years, and may be renewed for additional terms of five years.

§93.122. Renewal Period.

(a) The renewal period for a registered mark begins one year before the expiration date of the current registration and lasts for six months.

(b) If not submitted during the renewal period, an application for renewal will be considered timely if received during the six-month grace period immediately preceding the expiration date of the current registration.

(c) An application for renewal may only be submitted during the renewal period or during the six-month grace period. An application for renewal submitted before the renewal period begins or after the current term of registration of the mark expires will be rejected.

§93.123. Requirements of Application for Renewal.

An application for renewal of registration must include the following items:

(1) a verified statement setting forth the goods and/or services recited in the current registration on or in connection with which the mark is still in use in Texas. If the renewal application covers less than all the goods and/or services in the current registration, a list of the particular goods and/or services to be renewed;

(2) at least one specimen of the mark, per class, as actually used; and

(3) the renewal fee for each class of goods and/or services, as required by §93.151 of this title (relating to Recordation Fees).

§93.124. Refusal of Renewal.

(a) If the application for renewal is incomplete or defective, the renewal will be refused. The application may be completed or amended in response to a refusal.

(b) If the application for renewal is refused, the response to an action by the examiner must be received within 90 days from the date of mailing of an action by the examiner and before the registration expires. If the renewal cannot be filed before the registration expires, a new registration must be made.

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SUBCHAPTER M. ASSIGNMENT OF MARKS AND RECORDATION OF OTHER INSTRUMENTS

1 TAC §93.131, §93.132

§93.131. Requirements for Assignments.

(a) Assignments of registered marks may be recorded with the Secretary of State. An assignment may be recorded if it meets the following requirements:

- (1) it is a written instrument executed by the registrant (assignor);
- (2) it identifies the certificate of registration by registration number and date of registration (this information may be submitted as a separate statement if it is not contained within the assignment document);
- (3) it is in English or, if not in English, it is accompanied by a translation signed by the translator; and
- (4) it contains the name and address of the assignee (this information may be submitted as a separate statement if it is not contained within the assignment document).

(b) The original or a copy of the assignment should be submitted with the filing fee to the Secretary of State.

(c) Upon compliance with provisions of this section, the Secretary of State also will issue the assignee a new certificate of registration issued in the assignee's name for the remainder of the mark's term of registration, or the remainder of the mark's last term of renewal.

§93.132. Requirements for Recordation of Other Instruments.

(a) An instrument relating to the transfer of ownership of a mark or pending application (such as a certificate of merger or conversion) or a document effecting a name change (other than a change of entity) may be recorded with the Secretary of State. Each document may be recorded if it meets the following requirements:

- (1) it is an instrument authorized by law to be recorded or filed and in fact is recorded or filed in a public office and the copy of the instrument is certified by the appropriate official or authority;
- (2) the instrument is not authorized by law to be recorded or filed, but is the type of instrument which would be recorded and filed in the records of the Secretary of State if the business entity were a corporation;
- (3) the certified copy of the instrument is in English or, if not in English, it is accompanied by a translation signed by the translator;

and

(4) the certified copy is accompanied by a cover sheet, signed by the registrant or transferee or an agent of the registrant or transferee, which includes the following information:

- (A) an identification of the mark, including the certificate of registration number and date of registration;
- (B) the name of the registrant/transferee conveying the interest and the name and address of the transferee receiving the interest;

and

- (C) a concise description of the transaction being recorded.

(b) The certified copy of the instrument and accompanying cover sheet should be submitted with the filing fee to the Secretary of State. A corporation or other business entity which has filed the instrument to be recorded with the Corporations Section of the Secretary of State may provide an additional statement on the cover sheet identifying the instrument filed and the date of its filing with the Secretary of State in lieu of a certified copy of the instrument.

(c) Upon compliance with the provisions of this section, the Secretary of State shall file the instrument, and return a filed stamped copy if a duplicate copy was provided for such purpose.

(d) Upon written request of the registrant or transferee, or an agent of the registrant or transferee, the Secretary of State will send the registrant or transferee a new certificate of registration issued in the registrant's new name or in the transferee's name for the remainder of the mark's term of registration, or the remainder of the mark's term of renewal. The request for the new certificate must be accompanied by the fee established for a new or corrected certification pursuant to §93.151 of this title (relating to Recordation Fees).

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SUBCHAPTER N. CANCELLATION OF REGISTRATION

1 TAC §§93.141 - 93.144

§93.141. Voluntary Cancellation.

(a) The Secretary of State may cancel a registration upon receipt of a sworn request in writing for cancellation executed by the registrant or registrant's assignee of record. The request must include the following:

- (1) the mark to be cancelled, registration number, and date registered;
- (2) the name and address of the registrant; and

(3) a statement as to the classes sought to be cancelled, or if registrant seeks to cancel the registration in its entirety, a statement to that effect.

(b) The request for cancellation should be accompanied by:

- (1) the certificate of registration; or
- (2) the registrant's statement that the certificate has been lost.

(c) If fewer than all classes are cancelled, the Secretary of State will update the computer records to reflect the classes cancelled. A correct certificate of registration is available upon request by complying with §93.113 of this title (relating to Issuance of a Corrected Certificate).

§93.142. Administrative Cancellation.

(a) The Secretary of State shall cancel a registration upon:

- (1) finding that the registration was granted under Chapter 16 and was not renewed under Business & Commerce Code, §16.059;
- (2) receipt of a request for a cancellation of a mark in its entirety, pursuant to §93.141 of this title (relating to Voluntary Cancellation);

or

- (3) receipt of a cancellation pursuant to §93.143 of this title (relating to Judicial Cancellation).

(b) The Secretary of State may partially cancel a registration upon:

- (1) receipt of a request for cancellation of a mark in fewer than all the registered classes, pursuant to §93.141 of this title; or
- (2) proof that registrant of a mark, found by a court to be likely to cause confusion with a mark previously registered, holds a concurrent registration for the mark with the United States Patent and Trademark Office covering a portion of this state. In this situation, the mark may be cancelled only as to the portion of the state not covered by the USPTO registration.

§93.143. Judicial Cancellation.

(a) The Secretary of State is not a necessary party to any action or proceeding for the cancellation of a trademark registered by the Secretary of State. The Secretary of State will cancel a trademark registration upon receipt of a certified copy of a final judgment brought by a district or appellate court or other court of competent jurisdiction canceling the trademark or finding that:

- (1) the registered mark has been abandoned;
- (2) the registrant is not the owner of the mark;
- (3) the registration was granted improperly;
- (4) the registration was obtained fraudulently;
- (5) the registered mark is or has become the generic name for the goods and/or services, or part of the goods and/or services, in connection with which the mark was registered; or
- (6) the registered mark is so similar, as to be likely to cause confusion or mistake or to deceive, to a mark that:

(A) is registered by another person in the United States Patent and Trademark Office before the date the application for registration was filed under Chapter 16 of the Business & Commerce Code; and

(B) is not abandoned.

(b) There is no fee for the filing of a judicial cancellation of a trademark registration.

§93.144. Revocation of Registration, Renewal, Assignment or Recordation.

The Secretary of State may revoke the filing of an application for registration, renewal of registration, or an assignment or other instrument recorded in the trademark records of the Secretary of State if the fee for the document was paid by an instrument or credit card that was dishonored when presented by the state for payment. The Secretary of State will mail notice of the revocation of the filing to the business address of the registrant or the registrant's agent. A revocation is effective as of the date of the filing of the document. Failure to give or receive notice does not invalidate the revocation.



SUBCHAPTER O. FEES

1 TAC §93.151

§93.151. Recordation Fees.

(a) The Secretary of State requires the following processing fees.

- (1) Application for registration, per class--\$50.
- (2) Application for renewal of a trademark registration, per class--\$25.
- (3) Assignment of registration--\$25.
- (4) Transfer of ownership/change in registrant or applicant name--\$10.

- (5) Recording of other instruments--\$10.
- (6) Change of registrant address--no fee.
- (7) Voluntary cancellation of registration--no fee.
- (8) Issuance of a new or corrected certificate of registration--\$15.

(b) The fee accompanying each trademark application, renewal, or assignment is not refundable, regardless of whether the application, renewal, or assignment is subsequently approved, rejected, or abandoned.

