

*Trademarks: The Handbook*



**The Alabama Secretary of State's Handbook for  
Trademarks**

*First Edition 2020*

**Written by  
Christian M. Gentile**

**Edited by  
Bobby Marsh III**

## TABLE OF CONTENTS

|  |            |
|--|------------|
| <b>BRIEF OVERVIEW .....</b>                                | <b>3</b>   |
| <b>WHAT ARE MARKS.....</b>                                 | <b>3-4</b> |
| - <b>TRADEMARKS, SERVICE MARKS, &amp; TRADE NAMES.....</b> | <b>3-4</b> |
| <b>REGISTRATION PROCESS.....</b>                           | <b>4</b>   |
| <b>RENEWAL PROCESS .....</b>                               | <b>4</b>   |
| <b>CLASSIFICATIONS.....</b>                                | <b>4</b>   |
| <b>SPECIMENS.....</b>                                      | <b>5</b>   |
| <b>APPLICATION.....</b>                                    | <b>5</b>   |
| <b>CANCELLATION &amp; ASSIGNMENT.....</b>                  | <b>6</b>   |
| <b>QUESTIONS &amp; CONTACT INFORMATION.....</b>            | <b>6</b>   |

## Brief Overview

Trademarks in the State of Alabama are registered and approved at the state level by the Secretary of State's Office. The same process applies for service marks and trade names. Trademark and Service Mark registrations were codified in 1981. Trade Name registrations were codified in 1988.

Upon application, proper registration, and confirmation by the Secretary of State's Office, the mark will become valid for a term of five (5) years. Upon expiration, the applicant can submit a renewal application and pay a registration fee in order for their mark to be renewed for another five (5) year term.

**Note:** This book is a reference guide regarding Trademarks and other marks throughout the State of Alabama. According to state law, the Secretary of State's Office is designated to handle all trademark registrations, renewals, and applications for the State of Alabama in its entirety. (Ala. Code §8-12-8(a)).

## What are Marks?

The purpose of a "mark" is to distinguish goods and services from those of others. Trademark, service mark, and trade name registrations are administered in the Secretary of State's Office. Although the term "trademark" is often used to refer to both trademarks and service marks, the two marks serve different purposes. While all have different uses, **all** marks are to be registered and renewed through the Office of the Secretary of State.

- **Trademarks**

A trademark is used to identify goods that are made or sold. Owners of trademarks can be individuals, corporations, LLCs, organizations, or other similar entities. Trademarks are classified as the owner's intellectual property. In order to maintain secure usage of these rights, it is highly encouraged that one registers their mark with the Alabama Secretary of State's Office. It is important to note that if any conflict of ownership arises, it is up to the proper courts to decide legal disputes, not the Secretary of State's Office.

- **Service Marks**

A service mark is used to identify services rendered. Different from a trademark, service marks represent services, not specific products, logos, or emblems. Service marks are also classified as the owner's intellectual property. In order to maintain secure usage of these rights, it is highly encouraged to register the mark with the Alabama Secretary of State's Office. It is important to note that if any conflict of ownership arises, it is up to the proper courts to decide legal disputes, not the Secretary of State's Office.

- **Trade Names**

A trade name is used to identify a business, vocation, occupation, or profession. Oftentimes, companies and organizations use common names as opposed to the proper legal title. Whether it is lengthy or formal, trade names allow these entities to create another name of their choice. Trade names are also classified as the owner's intellectual property. In order to maintain secure usage of these rights, it is highly encouraged to register the mark with the Alabama Secretary of State's Office. It is important to note that if any conflict of ownership arises, it is up to the proper courts to decide legal disputes, not the Secretary of State's Office.

## **Registration Process**

**Disclaimer:** While not mandatory, the Secretary of State's Office strongly encourages that applicants seek advice from licensed and trained professionals before submitting registration.

In order to properly register with the state of Alabama, the applicant must properly register with the Secretary of State's Office. This process involves an application form, three specimens, and a registration fee of thirty dollars (\$30). Registration and renewal fees are non-refundable. There are no exceptions. If it is the applicant's first time registering a mark with the State of Alabama, they **will need to provide three (3) specimens with their application.** If the applicant is renewing their mark with the State of Alabama, then only one (1) specimen is needed. Also, if the applicant's entity handles multiple different classifications, then the Secretary of State's Office requires an additional application for registration and an additional fee for each application.

## **Renewal Process**

In order to properly renew each mark with the state of Alabama, the applicant must re-apply their mark with the Office of the Secretary of State. This process is similar to the registration process; however the renewal process **only requires one (1) specimen.** There is also the thirty dollar (\$30) renewal fee. The renewal fee is non-refundable. There are no exceptions. Also, if the applicant's entity handles multiple different classifications, then the Office of the Secretary of State requires an additional application for registration, as well as an additional fee for each application.

**Note:** Renewal notifications will be mailed six (6) months prior to mark expiration. Therefore, please notify the Secretary of State's Office if the applicant's letterhead address has changed. This will ensure that the renewal application is received.

## **Classifications**

On both the registration and renewal applications, there are different "classifications." These classifications are meant for "businesses" and "goods and services." It is critical that the proper classifications are clear on the applicant's registration or renewal application. If unclear, then the application may be either denied or refused. It is also important that the applicant only fill in the classifications that are applicable to their respective entity.

## Specimens

Specimens are samples of the mark and its usage. It is vitally important that the applicant provide clear and clean specimen(s). Failure to follow this guideline may result in the denial and refusal of the application. There is zero tolerance for altered, defaced, or fraudulent specimens.

Rejection or denial of mark registration by this office does not prevent use of the mark. Rights of ownership are achieved through the common laws of adoption and usage in Alabama. Current case law states that once you adopt and use a mark and are documented as the first to use such mark, you are entitled to exclusive rights to that mark (Ala. Code §8-12-1). Any conflict of ownership is handled outside of the Secretary of State's Office and is an issue for the courts.

## Application

**Note:** The state of Alabama **DOES NOT** recognize personal names for trademark, service mark, or trade name applications.

Before submitting the registration or renewal application, it is strongly encouraged that one seeks advice from a licensed and trained professional. It is also strongly encouraged that the applicant reviews their application thoroughly before submitting it to the Secretary of State's Office. Failure to complete an application in its entirety will result in the refusal/denial of a desired mark. Be sure to review the following aspects of application:

- a) Check to make sure the applicant's name (individual, corporation, LLC, etc.) is correct with proper spelling and naming.
- b) Assure that the three (3) specimens for registration and one (1) specimen for renewal applications are clear and clean. Failure to meet this criterion will result in refusal/denial of application.
- c) Properly identify which mark is desired. It is vitally important that this information be correct. Failure to do so may result in improper mark designation.
- d) Thirty dollar (\$30) application fee payable to the "Alabama Secretary of State's Office." If paying with a credit card, please fill out and attach the credit card payment slip that can be found on the Secretary of State's official website. ([www.sos.alabama.gov](http://www.sos.alabama.gov))

## **Cancellation and Assignment**

All voluntary registration cancellations that the Secretary of State's Office receives can and will be recorded. Notices of cancellations **must be in writing** and sent to the Secretary of State's Office. Registrations that are not renewed will automatically be cancelled from the Secretary of State's official register of current and usable marks.

In some cases, marks can be assigned to another company or entity if it is performed within the bounds of the law. The most common cases of this include mergers between two or more businesses. If the owner of a mark changes as result of a lawful transfer of the mark, a notarized statement must be included to the Secretary of State's Office along with the fee of thirty dollars (\$30). Additionally, there is a separate application for assigning new marks. Contact our office for more information.

## **Questions and Contact Information**

Any questions regarding marks can gladly be answered by the Secretary of State's Office.

Office of the Secretary of State

Trademarks Division

11 South Union Street, Suite 224

Montgomery, Alabama 36130

(334) 242-5325