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ANSWERS TO YOUR QUESTIONS ABOUT U.S. TRADEMARK LAW

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TABLE OF CONTENTS

	<u>Page</u>
I. What is the Difference Between Trademarks, Corporate Names and Trade Names?.....	1
A. Basic Differences	1
B. Trademarks, Service Marks and Trade Dress	2
C. Corporate Names.....	2
D. Trade Names (also known as assumed business names or dba's) - defined	2
E. Trademarks, Patents and Copyrights are Different	3
II. How Do You Select a Strong Name?	4
A. The Relative Strength of Marks	4
B. Trademarks, Service Marks and Logos Searches.....	5
C. Corporate Names Searches	6
D. Trade Names Searches	6
E. Expanded Research.....	6
III. How Do You Register and Enforce a Mark?	7
A. Federal Registration.....	7
B. State Registration.....	8
C. Foreign Registrations.....	8
D. Madrid Protocol Registrations.....	8
IV. How Do You Obtain Rights to Trademarks?.....	8
A. Obtaining Rights	8
B. Benefits of Registration.....	9
C. Foreign Trademarks	9
D. U.S. Customs Registration	9
V. How Do You Use Names Properly to Maintain Rights in Trademarks?.....	9
VI. Is There a Checklist for Doing a Company Name Change?	11
VII. Actual Business Signs from the Internet (Authors Unknown)	11



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Answers to Your Questions About U.S. Trademark Law

I. What Is the Difference Between Trademarks, Corporate Names and Trade Names?

A. Basic Differences. With many businesses, names are the most valuable asset. Companies promote names with much effort and expense. In fact, company pride and viability may hinge on the fame, strength and value of its names. Yet, often the benefits of available legal protections are not enjoyed and there are no clear company directives as to how to best select, use and protect names. The proper selection, use and protection of names begins with understanding the differences between *Corporate Names*, *Trade Names* and *Trademarks*.

The same name may, but most likely will not, be used as a Trademark, Service Mark and/or Trade Name. Other looks, texts, and designs may be protected as Trade Dress, Copyright, Trade Secret, or Patents. Each of these uses has separate meanings, rights and registration requirements. For example, the *Corporate Name* (or legal name) of one company is Edo Japan, Inc. Yet, when the company does business it generally uses the shorter Edo Japan¹ on its letterhead and invoices. This use is considered a Trade Name. The same shortened name is also used on its package labels as a brand name for the sale of its sauces and pre-prepared foods. This use is considered a Trademark. When the company uses the name on its signage to designate the name of its restaurant or in advertising to promote its franchise system, the use is considered a Service Mark. A slogan used in advertising to promote the restaurants or franchise system can also be a Service Mark. There are also other types of protection. For example, the look of the company's restaurants and the unique packaging of its goods are protected as *Trade Dress* (and the nonfunctional designs can also be subject to *Trademark* or *Service Mark* protection). The actual text of the company's operating manual is the subject of Copyright protection. The recipes for its unique food dishes are the subject of Trade Secret protection. The functional design of a product or business process may be a subject of Patent protection. The same name or look may entitle one to a variety of different protections strategies.

Each of these categories is a separate type of use and registration and protection is different for each, i.e., you cannot obtain a *Trademark* or *Service Mark* on the name Edo Japan, Inc. if it is only used as the Corporate Name, you cannot obtain a *Trademark* on Edo Japan®, unless it is actually used with the private label sale of its products, and you cannot obtain a Service Mark on Edo Japan® unless it is actually used with the sale of services. The mere registration with a state of a Corporate Name or Trade Name does not of itself confer Trademark or Service Mark ownership or even necessarily the exclusive right of use in that state. A name must be used as a Trademark or Service Mark to enjoy Trademark or Service Mark protection. A company must protect its names and brands with the proper legal means.

In this case, Edo Japan® is a franchisor; it enjoys protection of each of the above and vigorously enforces its various rights to its Corporate Names, Trade Names, Trademarks, Service Marks, Trade Dress, Trade Secrets and Copyrights. Let us now compare Trademarks, Corporate Names and Trade Names.

¹ Edo Japan is a registered trademark of Edo Food International, Inc.



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B. Trademarks, Service Marks and Trade Dress - defined. A Trademark is any word, phrase, symbol, logo, group of letters or numbers, package design, product shape, color, sound or aroma, or combination of these, that identifies one's goods or services and distinguishes them from the goods or services of another. The primary purpose of Trademark laws and protections is to prevent consumers from being confused about the source or origin of a product or service. "Trademarks" is actually a general term referring to the following categories of Marks:

1. Trademarks. Trademarks are brand names used to identify goods, *i.e.*, a brand of cereal or a beverage (as opposed to providing services).
2. Service Marks. Service Marks are used to identify services, *i.e.*, a retail store or a real estate appraisal business (as opposed to the sale of goods).
3. Trade Dress. Trade Dress refers to the appearance of a product or its packaging that is not merely functional, *i.e.*, distinctive bottles for a beverage. Trade Dress can be protected as a Trademark or Service Mark, depending upon whether it is used for the sale of goods or the providing of services. Note: functional designs may be the subject of a design Patent while non-functional designs may be better protected by a Trademark.

C. Corporate Names - defined. A Corporate Name is the term we use for the legal name of an entity, be it a corporation name, limited partnership name, partnership name or limited liability company name. Most states (there is no federal Corporate Name registration in the U.S.) permit the registration of a Corporate Name in that state if it is merely distinguishable from the names of other entities, even if the name is confusingly similar to another. Registration generally only authorizes one to use that exact Corporate Name in that state and does not necessarily grant ownership or ensure protection from infringement by another. The standards for registering a Corporate Name are different from the standards as to what constitutes ownership or what constitutes infringement of a Trade Name or Service Mark. One may have authority from the state to use a Corporate Name but still may not own the name and still may be sued as an infringer. Therefore, we recommend a Corporate Name search be conducted before registering a Corporate Name. These searches conducted by our office are described below.

D. Trade Names (also known as assumed business names or dba's) – defined. A Trade Name is any name used in the course of business that differs in any respect from the full legal Corporate Name. This is usually the name a business (including a sole proprietorship) uses on its letterhead or invoices. Registration of the Trade Name is accomplished in each applicable state (there is no federal registration in the U.S.) but this does not confer ownership and does not necessarily provide protection from the use of the name by others. In fact, some states may permit registration of the same or similar Trade Name by different people. Therefore, we recommend a Trade Name search be conducted. These searches conducted by our office are described below.

Registration of a Trade Name is imperative, since most states forbid a company from bringing suit, unless the Trade Name is registered. A registration only permits a company to do business in the state under that name and does not necessarily grant ownership or infringement protection. The standards for registering a Trade Name are different from the standards as to what constitutes ownership or infringement of a Trade Name or Service Mark. A company may have filed its Trade Name but still may not own the name and still may be sued as an infringer.

The state of Washington uses the following example to help a company know what Trade Names need to be registered:

Registration of Trade Names

Registered Corporate Name	Do Not Need to Register as Trade Name	Need to Register as Trade Name if Used
Ginger's Sweets Emporium, Inc.	Ginger's Sweets Emporium, Inc.	Ginger's Sweets Emporium
		Ginger's Sweets
		Ginger's Emporium
		Ginger's
		Sweet Emporium
		GSE

E. Trademarks, Patents and Copyrights are Different. While Trademarks, Patents and Copyrights each involve intangible property rights, each differ significantly from the other.

1. Trademarks identify one's goods or services and thus, show the identity of the origin of goods or services (i.e., brand names and slogans). Trademarks may also include non-functional designs.
2. Copyrights protect the works of authors in tangible form (i.e., literary works, motion pictures, sound recordings, and computer programs) but not the ideas themselves.
3. Patents protect functional inventions (utility Patents for processes and compositions of matter) and functional designs (design Patents for new ornamental designs).

Note: Trade Secret Laws protect unpatented inventions and know-how that have been kept secret against unauthorized use or disclosure, i.e., the formula for a soft drink is best kept as a Trade Secret, since disclosure is required for most Patents or Copyrights. Most States have adopted the Uniform Trade Secrets Act (adopted by Washington in 1981 at RCW 19.108) and Congress passed The Espionage Act (18 U.S.C. §§ 1831-1839) in 1996 to curb the theft of Trade Secrets (Washington has a state statute making theft of a trade secret a crime – see RCW 95A.56 0100(5)).

Comparison

	Trademarks	Copyrights	Patents
Nature	Words, phrases, designs, symbols, logos, groups of letters or numbers, package designs, product shapes, colors, sounds or aromas or combinations of these that identify one's goods or services	Original literary and artistic expressions, i.e., books, paintings, music, records, plays, movies, and software	New and useful inventions and configurations of useful articles

	Trademarks	Copyrights	Patents
Protection	Likelihood of confusion	Copying	Making, using or selling the invention or design
Rights	Use	Create work and fix it in intangible form	Apply for Patent
Basis	Use or intent to use	Originality	Novelty, unobviousness, utility
Notice	Optional TM or SM if unregistered or state registration; ® if federal registration	Optional after March 1, 1989; (c) with year of first publication and name of owner if used (use of copyright notice recommended by us)	Optional Patent Pending after application; Patent plus number after grant
Term	As long as used; federal registration must be continued in 6 th year and renewed every 10 years. State terms differ, usually 5 to 10 years.	Creations after January 1, 1978, author's life plus 50 years, or if anonymous or work for hire, then earlier of 75 years from publication or 100 years from creation	17 years for utility Patents subject to maintenance fees and 14 years for design Patents

II. How Do You Select a Strong Name?

A. The Relative Strength of Marks. When selecting a Trademark, one should not only be concerned with infringement but also be aware that unique words or logos are easier to enforce than words that simply describe one's products or services. The five types of Marks and the relative protection of each are listed below. Note that generic terms cannot be registered.

	1. Generic or Deceptive	2. Descriptive or Laudatory	3. Suggestive	4. Arbitrary	5. Unique
Protection	Not protectable	Narrow – no protection until it acquires distinction or secondary meaning in the marketplace	Immediate Protection	More Protection	Broadest Protection
Examples	Generic lawn mower, razor, candy	Descriptive Seattle Plumbing, Japanese Cuisine, Fast Copy	Caterpillar for tractors, Coppertone for tanning lotion, Whirlpool for washers	Apples for Computers	Kodak for cameras, Exxon for petroleum products

	1. Generic or Deceptive	2. Descriptive or Laudatory	3. Suggestive	4. Arbitrary	5. Unique
	<u>Deceptive</u> French for wine from Washington	<u>Laudatory</u> Blue Ribbon for beer, Gold Medal for flour			
		<u>Surnames</u> Gallo for wines			
Definition	Generic word for a type of goods or services can never be a Trademark, since the generic word only describes the goods or services and not the source or origin.	Describes the goods or services or a characteristic of them and thus can not be a Trademark until the mark becomes known as a source in the marketplace.	Words that suggest some attribute of or benefit of the goods, but do not immediately describe the goods can be Trademarks.	Existing words that have no relation to the goods or services.	Words made up that have no built-in meaning.

Finding the right name can be difficult. Our firm has relationships with specialized branding companies that help select names, logos, and looks. Some of these services can be very expensive. Many names have already been taken but a creative company can find the right name by studying synonyms, colloquial terms, slang, or new words (neologisms). A name should be unique, attract the eye, be pleasing to the ear, be easy to remember, be short, convey something tangible about the company, product or service, and elicit desirable consumer responses.

If a Mark is to be used in international markets, one should be sure the Mark does not translate into an inappropriate or undesirable term in another language. For example, Chevrolet introduced the NOVA in South America not thinking “No va” in Spanish means “does not go” or “does not work.” When Pepsi translated their slogan “Pepsi Brings You Back to Life” in Chinese, it really meant, “Pepsi Brings Your Ancestors Back from the Grave.” Our firm has a great deal of experience and can help you find the right name.

B. Trademarks, Service Marks and Logos Searches.

1. Searches. Due diligence in selecting and clearing a name or logo prior to actual use can significantly reduce the risk of infringement, damage claims, and wasted time and marketing expenses. A Trademark search should be conducted to provide needed information to make an informed decision on whether to proceed with use. Even though the question of whether two Trademarks are confusingly similar is not a black and white scientific formula but the weighing of risks by one and their experienced Trademark professionals. Still the search, even though not a guaranty that no one is using a similar Mark, plus a letter from legal counsel, can constitute a good faith defense of due diligence and can preclude a claim for damages by proving one was a good faith or innocent infringer.



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Before investing in and using a Mark, one should obtain a Trademark search and have such interpreted by a professional.

2. Types of Searches.

a. Preliminary Trademark Search. This is generally performed in our office using the Trademark Register and various on-line services. The cost can be as low as \$35, plus our analysis time. Same day turnaround is available.

b. Comprehensive Searches. A comprehensive search is performed by an outside company at their cost (we do not surcharge): plus our analysis time. Normal delivery of a search from an outside company is in 5 business days, unless one pays extra for a rush. Comprehensive searches include federal and state Trademark records, domain name registrations, and common law uses as shown in trade materials.

c. Comprehensive Design or Logo Searches. Our firm also conducts preliminary and orders comprehensive design and logo searches. These searches are more expensive than normal word Mark searches. A comprehensive design or logo search is at the cost of an outside company (we do not surcharge), plus our firm's review time.

d. Foreign Country Searches. Our firm provides preliminary and comprehensive foreign Mark or design searches for most countries. We have a network of attorneys and Trademark service companies we have used throughout the world.

C. Corporate Names Searches. Our firm conducts Corporate Name (entity name) searches with the appropriate Secretary of State or Department of Licensing. Our firm searches the state's records on-line for preliminary searches or uses an outside company for complete searches. If the name will be in the public eye, we recommend a Trademark search also be conducted, since many names may be registered as Service Marks but not as Trade Names or Corporate Names. Corporate Names may also be reserved prior to incorporation, qualification or use in a state for a limited time (usually up to six months).

D. Trade Names Searches. If a name will only be used on a local basis within the state, our firm searches the state's Trade Name filings, the state's Trademark filings, the area's local telephone directories and other local resources. If the name will be used in other states, Trade Name searches can also be accomplished for most states. We recommend a Trademark search also be conducted.

E. Expanded Research. Our firm can conduct, in-house or via specialized companies further investigation into companies, their products, etc., in the case of actual or potential name conflicts. These investigations vary in cost.



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III. How Do You Register and Enforce a Mark?

Failure by a Trademark owner to take reasonable steps to protect a Trademark against infringers can dilute the strength of the Mark and lead to abandonment of the Mark. Registration is not a panacea but is an important protection, benefit and notice to others.

Our firm has literally filed thousands of Trademark applications at the state and federal levels, as well as numerous foreign Marks through our network of Trademark experts throughout the world.

A. Federal Registration. A federal Trademark or Service Mark can be filed on either an “Intent to Use” or “Actual Use” basis. If one has not yet used the Mark, filing on an “Intent to Use” basis can be advantageous, since one later files a statement of use after actual use of the mark yet the original filing date is kept intact. One could, by filing for extensions, wait for more than two years before actually having to use the Mark.

To effectuate an Intent to Use filing, we need the following:

1. The Mark;
2. Description of the products or services;
3. A drawing of the Mark if it is stylized or a logo, and the colors if such are included;
4. Copies of any previously related filings, whether in a state, the U.S. or a foreign country; and
5. The filing fee.

If the filing is based on Actual Use, then we will also need:

1. Date of first use anywhere;
2. Date of first use in interstate commerce; and
3. Three copies of a specimen (example of use) showing the Mark (not three different specimens but three copies of the same specimen).

The process is lengthy:

1. The Trademark application is filed electronically (or in some cases still by certified mail or federal express).
2. Several months later, the Trademark office sends us a formal filing receipt acknowledging receipt of the application only.
3. The application is then assigned to a Trademark examiner for review and response. This is usually 6 months after the filing. The examiner may approve the application as filed or may issue an Office Action to seek amendments or declare that registration is refused.



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4. If approved, the Mark will be Published for Opposition in the Trademark Gazette. Upon publication, anyone may object within 30 days.
5. If there are no objections, a Certificate of Registration is issued.

If there are no Office Action items then it takes approximately 9 months to obtain registration. Registration is now averaging about 16 months, so start the process as early as possible.

B. State Registration. The items needed are the same, except there is no need for interstate use. State registrations are a simple process taking 2-4 weeks and are much less expensive.

C. Foreign Registrations. Similar information is required except that you will usually need to appoint an agent and sign a power of attorney authorizing the agent to do the filings for each country.

D. Madrid Protocol Registrations. Applicants can make a single application in the “country of origin” of the applicant, pay one fee based on the countries desired, file in one language, and hold a registration on the same number and same renewal date. This method has been popular for foreign based companies trying to register worldwide including the U.S. U.S. companies are still confronted with the U.S. Trademark Office which is much tougher and more restrictive than most other countries. Consequently, few U.S. companies utilize this Protocol.

IV. How Do You Obtain Rights to Trademarks?

A. Obtaining Rights.

1. Common Law Ownership. Trademark rights in the United States are obtained through actual use of a Mark in connection with the offering of goods or services. This is called common law protection, since protection arises from court rulings and not from statutory authority. The first person to adopt a Mark has a common law right to prevent others from using a similar Mark in a manner that is likely to confuse consumers, regardless of registration. However, common law protection may be confined to the established market and others may register a Mark for use outside that market. **Necessary protections are obtained through state, federal and foreign Trademark registration, including domain name registrations.**

2. State Trademark Registration. If a Mark is used only intrastate, that is, within only one state, then state Trademark registration is appropriate as opposed to federal registration that requires interstate use or use between a foreign country and a state. State Trademark registration provides constructive notice to all that the Mark is being used throughout the state and provides other protections, such as attorneys' fees, state anti dilution protection, etc. Some states will now permit registration based on an intent to use the Mark. State Trademark registration is much faster and less expensive than federal registration.

3. Federal Trademark Registration. If a Mark is used interstate (in more than one state), or between the United States and a foreign country then federal registration is appropriate. It is also possible to apply for federal registration before actual use, based on a *bona fide* intent to use the Mark.



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B. Benefits of Registration.

1. Principal Register. Registration creates a presumption in favor of the registrant's exclusive rights nationwide, constructive notice to any subsequent use of the registrant's rights, and procedural benefits including a right to attorney's fees and the right to use a ® symbol with the Trademark. Registration on the Principal Register may also become incontestable on all but a few narrow grounds after five years.

2. Supplemental Register. Descriptive or laudatory Marks not yet sufficiently distinctive for registration on the Principal Register may still obtain formal registration on the Supplemental Register if the Marks distinguish the goods and services from those of another. While the same presumptions of exclusivity are not found, it does provide notice to others of the registration and allows one to use the ® symbol with a Trademark. After a Mark becomes distinctive after use for approximately 5 years, some Supplemental Registered Marks can then be moved to the Principal Register.

3. Risks of Filing an Application. An attempted registration defeated by the Trademark Office because the Trademark Office felt the Mark was confusingly similar to another could show later that, if use continues, the applicant had knowledge of the infringement. When an application is approved by the Trademark Office, it is then published in the Trademark Official Gazette for others to oppose the registration. Sometimes a conflict may arise through review of the Official Gazette by your competitor which conflict may not have arisen without the attempted registration. Still, it is better to discover and resolve disputes as soon as possible.

Note: The laws of each state differ as to the scope of protection provided to Trademark registrants. States may provide protection not available through just federal registration so some Trademark owners file with both the states and the U.S. Trademark Office.

C. Foreign Trademarks. One important note is that while the United States is a member of several treaties, the laws of different countries vary dramatically. While in the United States one obtains rights to a Trademark by use, in some foreign countries ownership is obtained by the first to file. This has proven most difficult for many United States companies that start in the United States and then proceed to registration in foreign countries and find their Marks are already registered by opportunists.

D. U.S. Customs Registration. We can also work with companies to file Trademarks with United States Customs to help curtail gray market goods. This is a valuable process to help stop look-a-likes.

V. How Do You Use Names Properly to Maintain Rights in Trademarks?

Proper usage may be the most important means of protecting a name. One example is the continuing struggle of XEROX to keep its name as a Service Mark and not as a generic term for a copy. If generic, there is no protection. Examples of Marks becoming generic are "escalator" and "shredded wheat."



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There are a number of guidelines to protect a Mark. Here are some guidelines presented by Thomson & Thomson, a Trademark search company.

1. **Use the Trademark as an adjective followed by the generic name of the product.** A Trademark is not a noun.

Correct: The TRADEMARKSCAN® Online databases are valuable tools for preliminary Trademark searching.

Incorrect: TRADEMARKSCAN is a valuable tool for preliminary Trademark searching.

2. **Do not use the Trademark in the plural or possessive form.**

Correct: The TRADEMARKSCAN Online databases are up-to-date.

Incorrect: TRADEMARKSCAN's databases are up-to-date.

3. **Do not use the Trademark as a verb.** Trademarks are proper adjectives, and should never be used as verbs.

Correct: I searched several potential Trademarks for our new product against the TRADEMARKSCAN Online databases.

Incorrect: I TRADEMARKSCANed several potential Trademarks for our new product.

4. **Use the Trademark consistently, as each deviation creates a new and different Trademark.** Do not use hyphenated variations or combine the Mark with other words.

5. **Use the Trademark distinctively.** A Trademark should always be written in a manner that distinguishes it from the rest of the text. The following formats are acceptable and often used to make the Trademark more conspicuous than the generic name:

CLIENT&TIMES
ClientT&Times

ClientT&Times
ClientT&Times

“ClientT&Times”

6. **Use proper notice of a Trademark.** Identify the Trademark as registered or unregistered:

® For a Trademark registered with the U.S. Patent & Trademark Office

™ For an unregistered Trademark

SM For an unregistered Service Mark

A company should consider developing a corporate identity handbook with guidelines on usage, including actual approved samples. Our firm can assist to develop such a handbook.

VI. Is There a Checklist for Doing a Company Name Change?

This is a list of items to remember to consider when changing a company name.

STATIONERY, TEMPLATES, AND MACROS	LISTINGS & CERTIFICATES	EMPLOYEE COMMUNICATIONS	BUSINESS FORMS	BUSINESS AFFAIRS	ADVERTISING & PROMOTION	SIGNAGE
Letterhead	Articles of Incorporation	Recruiting materials	Invoices	Lease agreements	Advertisements	Buildings
Envelopes	Trademark Filings (to change name of owner)	Benefit books	Purchase orders	Insurance policies	Literature	Doorways
Mailing Labels	Director and Shareholder Minutes	ID cards	Statements	Computer entry codes	Presentation formats	Windows
Calling Cards	Stock Certificates	Credit union materials	Payroll checks	Foreign exchange agreements	Yellow Pages	Directional
Memorandum	Business directories	Pension plans	Corporate checks	Executory contracts and leases	Packaging	Exhibit booths
News release	Who's Who	Medical plans	Message forms	Loan documents especially UCC-1 Financing Statement	Binders	Rolling stock
Postal meter	Credit certificates	Service awards			Apparel	
Fax answerback	Licenses				Novelty items	
E-mail address	Permits					
Internet address	Titles					
Cable Code						

VII. Actual Business Signs from the Internet (Authors Unknown)

In a Non-smoking area: "If we see you smoking, we will assume you are on fire and take appropriate action."

On Maternity Room door: "Push, Push, Push."

On a Front Door: "Everyone on the premises is a vegetarian except the dog."

At an Optometrist's Office: "If you don't see what you're looking for, you've come to the right place."

On a Scientist's door: "Gone Fission."

On a Taxidermist's window: "We really know our stuff."

In a Podiatrist's window: "Time wounds all heels."

On a Butcher's window: "Let me meat your needs."



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On another Butcher's window: "Pleased to meat you."

At a Used Car Lot: "Second Hand cars in first crash condition."

On a fence: "Salesmen welcome. Dog food is expensive."

At a Car Dealership: "The best way to get back on your feet – miss a car payment."

Outside a Muffler Shop: "No appointment necessary. We'll hear you coming."

Outside a Hotel: "Help! We need inn-experienced people."

On a desk in a Reception Room: "We shoot every 3rd salesman, and the 2nd one just left."

In a Veterinarian's waiting room: "Be back in 5 minutes. Sit! Stay!"

On a Music Teacher's door: "Out Chopin."

At the Electric Company: "We would be delighted if you send in your bill. However if you don't, you will be."

In a Beauty Shop: "Dye now!"

On the door of a Computer Store: "Out for a quick byte."

In a Restaurant window: "Don't stand there and be hungry, come in and get fed up."

Inside a Bowling Alley: "Please be quiet. We need to hear a pin drop."

On the door of a Music Library: "Bach in a minute."

In the front yard of a Funeral Home: "Drive carefully, we'll wait."

In a Counselor's office: "Growing old is mandatory. Growing wise is optional."