



# 5 Key Considerations When Seeking a Trademark

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**T**rademarks and service marks are some of the most powerful assets available to market goods and services because they create brand identity and loyalty. Trademarks and service marks can include words, phrases, symbols, or designs used to help your products stand out from the competition in the marketplace. However, there are several things to consider to maximize the value of your marks. Here are five key considerations to maximize the value of your trademark or service mark.

- 1. What kind of mark do you want?** Like many other assets, trademarks and service marks may come in many shapes and sizes. First, a trademark identifies and distinguishes the origin of a specific good available in commerce, whereas a service mark identifies and distinguishes the origin of a specific service. For example, Coca-Cola® is a trademark for soft drink products, but DoorDash®, which provides food delivery services without selling its own products, is a service mark. Trademarks and service marks may take the form of words or phrases (known as “standard character” marks), or as symbols or designs (known as design marks). Unlike a standard character mark that only includes alphanumeric characters, a design mark may protect specific colors, patterns, fonts, or other images associated with your goods or services. If a particular good has specific, identifiable packaging that sets it apart from other products on the market, such identifiable packaging, known as a trade dress, can also be protected under trademark law.
- 2. What is the purpose of the mark?** Trademarks and service marks protect the unique “brand” you have built for your unique good or service from being copied or used by others. Before seeking protection for a trademark or service mark, you must determine the types of goods or services for which you are trying to protect your mark. In making that determination, consider that the World Intellectual Property Organization (WIPO) recognizes a list of 45 international classifications of goods and services for which trademarks and service marks may apply, which cover everything from tools, musical instruments, foods, and textiles to advertising, sports organizations, technology services, and transportation. Protections for trademarks and service marks are limited only to those categories of products or services for which they are intended to apply.
- 3. May the mark be protected?** Although you may develop what you consider to be the perfect mark to identify your products or services, not all marks are protectable under applicable law. Generally, one cannot seek trademark or service mark protection for common words, phrases, or images. For example, you cannot protect a phrase such as “thank you” or a generic image of a tree. However, trademarks or service marks may be applied to unique combinations of common words, phrases, or images. Generally speaking, the more unique and distinguishable a mark is, the greater levels of trademark protection it will garner. Before utilizing a trademark or service mark, it is also critical to conduct a thorough and diligent search to determine whether any substantially similar mark is already being used in commerce. If your desired mark is similar enough to another existing mark that it would likely create confusion among consumers as to the actual goods or services being offered or the source of those goods or services, your desired mark may infringe on the existing mark and should be reconsidered before pursuing protection.

4. **Where is the mark protectable?** Because goods and services are commonly available only in specific geographic markets, legal protections for trademarks and service marks are often controlled by the local markets in which the identified goods or services are sold. While the United States Patent and Trademark Office (USPTO) oversees all federal trademark regulations and registrations in the United States, trademarks and service marks receive certain common law protections without registration in the states in which the marks are used in commerce. In other words, if you are using a trademark or service mark for a good or service already in commerce in a specific city or state, and assuming your mark does not infringe on an existing mark in that particular market, you will receive certain limited, common law protections for your mark even without registration. However, such common law protections are limited only to that particular market and do not facilitate the protection of your brand identity outside of that market area.
5. **Should the mark be registered?** Although trademarks and service marks do not have to be registered to receive certain state common law protections, seeking state or federal registrations provides many advantages. First, registering trademarks creates a legal presumption of ownership of the marks and provides public notice of your marks. With a federal registration through the USPTO, a trademark or service mark may be protected throughout the United States, rather than only in a single state or market area. Additionally, unlike unregistered marks, a trademark owner may reserve protections for a trademark or service mark before it is actually used in commerce by assigning it an “intent to use” designation. Finally, if another entity were to infringe on an existing trademark or service mark, registration of the existing mark allows for the mark owner to recover statutory damages from the infringing entity in addition to actual damages resulting from the infringement.

No two trademarks or service marks are the same (that is the point after all!), and these are just a few of the issues to consider when seeking to protect your brands with trademarks or service marks. It is important to consult with an attorney experienced in trademarks and service marks regarding all of the protections potentially available for your brand.



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## ABOUT THE AUTHOR

Jaclyn represents and advises clients in a wide variety of business and litigation matters, including matters related to commercial litigation, sports, media, intellectual property, contractual disputes, technology licensing, and corporate formation.

Jaclyn graduated *summa cum laude* and earned an Intellectual Property Law Graduate Certificate from the Indiana University Robert H. McKinney School of Law in 2015. While attending law school, Jaclyn also served as an Executive Articles Editor of the *Indiana Law Review* and as an intellectual property research assistant to Professor Xuan-Thao Nguyen.

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