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Guidance For Creating and Using A Trademark/Brand

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A well-chosen trademark can become a valuable asset that increases sales and avoids excessive legal expenses in future years. Regrettably, there are many misunderstandings and some completely incorrect understandings about trademarks. This guide is for people who are not familiar with trademark law but want some guidance without reading a legal brief or a legal textbook. However, no article can address every possible situation. This is a long article with some complex concepts. Its purpose is to help avoid making some later-regretted, poor choices based on common misunderstandings of trademarks. The best practice is to be aware of the principles described in this article and then consult an attorney with experience in trademark law before you choose and use a trademark.

1. Summary of What a Trademark Is and What Can Be A Trademark

A trademark is a symbol, in the form of words and/or graphics, of the organization that is the source of whatever the organization provides. A trademark is also called a brand. When a prospective customer of a product sees a trademark displayed in association with that product, the prospective customer expects that the product originates with the same organization that other products previously seen in association with the same trademark came from. Over time, prospective customers associate a reputation, good or bad, with the quality of products that come from the organization that owns the trademark. Customers may not know the name of the organization (the “source”), but they expect that organization determines, and is responsible for, the quality of any goods or services that are associated with the organization’s trademark.

A trademark can be a word or words that exist in a dictionary or a coined (made up) word. It can be a graphical feature such as a symbol. It can be a combination of both. It can even be a sound, a fragrance or a package design, although those are more difficult to protect.

2. More About What A Trademark's Purpose Is and Isn't in a Competitive Marketplace

The most important thing to know when creating a trademark is what its purpose is. That knowledge will help you understand the reasons for many of the legal principles of trademark law that otherwise would not be foreseeable. Everyone has seen many trademarks prominently displayed in advertising and on packaging in close physical association with goods and services in the commercial world. Why are they considered valuable assets, what is their purpose and how do they accomplish it?

A short definition of a trademark is that a trademark is a symbol for a company's reputation. That reputation may extend broadly to all the products of a company or may extend to a subset of their products or even to a single product. Trademarks help customers select products that come from a company that a customer thinks makes quality products. They also help a company, which sells *quality* goods and services, sell more of their goods and services. They do that by indicating to prospective customers the origin or source of products.

Trademark law has developed over centuries not only to protect trademarks and their owners, but also to protect customers who rely on a reputation that is associated with a trademark. Understanding trademarks begins with knowledge of how they are intended to function in a market economy that encourages honest competition for providing goods and services. The principles that are applied by courts and the U.S. Patent and Trademark Office are intended to facilitate the purpose of a trademark and to prevent or stop infringing uses of a trademark that are contrary to those purposes.

As a preview, a simple summary is that the purpose and function of a trademark is to indicate the *origin or source* of goods that are sold in association with the trademark. "In association with" means that the trademark is prominent and is physically near the goods or services, an image of the goods, or advertising describing the service. The "origin or source" is the company that controls the quality of the goods or services, often the manufacturer or service provider. The trademark does NOT need to name that person or company. The trademark need only be a graphical symbol or one or more words, or a combination of both, which is unique enough that an ordinary purchaser of the goods and services will know that, whenever they see a particular trademark in association with goods or services, those goods or services always come from the same source. Importantly, the purpose of a trademark is NOT to describe or otherwise communicate to customers what the goods or services are and NOT to describe any characteristic or feature of the goods or services.

If a trademark is chosen to serve the above purpose, a reputable company can receive a very desirable consequence. If an ordinary purchaser acquires goods or services that were seen in association with a trademark, and if that purchaser later concluded that the goods or services were of good quality, that purchaser will have a preference in the future for goods or services that are associated with that same trademark. The trademark has a reputation or goodwill associated with it in the mind of customers. Goodwill or reputation gets associated with a trademark as time competing in the marketplace passes. Of course, the opposite is also true. If the goods or services are perceived to be of poor quality, ordinary purchasers will avoid goods and services that are associated with a trademark. What you should want is a trademark that is unique

enough that, as you compete in the marketplace, a good reputation for the quality of your goods or services will become associated with the trademark in the minds of prospective customers. By being unique, a trademark will not be confused by customers with other trademarks and is easier for customers to remember.

Consider an illustrative, early example of a trademark in a simple marketplace. The marketplace includes several sellers of pottery. The quality of the pottery sold by some sellers is better than the quality of other sellers. As time passes, purchasers of pottery come to prefer the better pottery. But, if the person who made the better pottery is not personally standing in the market selling his or her pottery, and there are several sellers of pottery, how can prospective customers know whose pottery to buy? All the pottery looks very similar. What can the better manufacturer do? Historically, someone invented the trademark but didn't know it! The better pottery maker etched a graphical symbol into the pottery. That symbol is a "mark" and it is used in "trade". So it came to be known as a trademark. That symbol enabled prospective purchasers to look for that mark on pottery as an indication of the source of the higher quality pottery. If a purchaser knew from past purchases or from the recommendation of neighbors or from advertising that pottery with that mark was good quality, the likelihood of making a sale was greatly increased.

Unsurprisingly, a competing pottery maker noticed that customers seemed to prefer pottery with that mark on it. So, the competing pottery maker decided to put a mark on his or her pottery that was identical to the mark of the quality manufacturer, or more likely, intentionally designed it to be similar to, but a little different from, the quality manufacturer's mark. Although there were differences, a prospective customer might not look at the mark very closely and would be likely to think it was the mark of the quality pottery maker. By confusing the two marks, a prospective customer would be misled into thinking that the quality manufacturer made the competing pottery. Perhaps the similarity was not intentional. But the result would be the same. In either case, the pottery would be purchased in the belief that its source was the quality pottery maker when in fact it wasn't. In other words, the prospective customer purchased the pottery based on a mistaken belief about the origin or source of the pottery. In trademark law terms, that customer was confused or misled about the origin or source of the pottery because the marks were confusingly similar.

A trademark functions somewhat like a flag for a country. If you see a flag sewn on a military uniform or painted on a military vehicle, you know that all military assets that have that flag on them are associated with the same particular country. You may not know the country's name, but you know that the same country is the origin or source that controls that military asset.

Most of the principles of trademark law are related to the above examples. Those principles are applied by courts and the U.S. Patent and Trademark Office to facilitate trademark uses that accomplish a trademark's intended purpose and prevent or stop uses that defeat that purpose. If you develop a good reputation among prospective customers, you want to be able to prevent another company from getting a free ride on your reputation. You want to maximize your legal right under the law to prevent or stop another company from using the same or similar trademark in a way that misleads or deceives potential customers into the mistaken belief that the other company's product comes from you. That would be trademark infringement. So you want to do those things that will maximize the legal strength of your trademark in order to maximize the probability that a

court would order an infringer to stop infringing your trademark and minimize the likely legal cost of convincing a court to do so. The stronger your legal rights in your trademark, the more likely it is that an infringer would stop infringing your trademark without the need for you to resort to expensive legal action against the infringer.

3. Select a Distinct and Memorable Trademark

The strength of your legal rights in a trademark depends upon several things, principally your choice of a trademark, how you use that trademark and whether you own and maintain a U.S. Trademark Registration. That legal strength is also highly dependent upon the extent to which others use similar trademarks. You want your trademark to be *distinctive*. You want a trademark that is different enough from trademarks used by others for your type of products so that your trademark strongly distinguishes the origin of your products from the origin of the products of others. You also want to select a trademark that is *easily remembered* by prospective customers. You would like prospective customers to look for your brand when shopping for the products that you make or sell.

If you have selected a trademark and want to see whether it is distinctive, there are some things that you can do. None of them can provide certainty but, if you find something that is too similar to your chosen trademark, you could select something else before you invest in the trademark you originally selected. You can search in the U.S. Patent and Trademark Office website at <https://tmsearch.uspto.gov/search/search-information>. You can search the internet generally from your browser. You can employ a trademark attorney to have a search performed, although the cost of a search can approach or even exceed the cost of filing a trademark application in the U.S. Patent and Trademark Office and seeing what its response is.

If you do a search, how do you determine whether your trademark is too similar to a trademark used or registered by another company for its products? That question is also the same question that is asked when trying to determine whether your trademark is registerable and whether one trademark infringes another. The answer to that question depends upon whether an ordinary customer, who sees your trademark and the trademark of someone else and sees the products sold by both, is likely to be confused into the mistaken belief that the products of both companies come from the same company. If an ordinary customer would be confused in that manner, then the trademarks are too similar. The degree of similarity between the two trademarks is one fact that has a strong influence on whether an ordinary customer would be confused into that mistaken belief. For example, Google and Googel are very similar. Google and GoodGold are not. Another fact that also has a strong influence on whether an ordinary customer would be confused is the degree of relatedness between the products sold by you and by the other company. Products are related if an ordinary customer would believe that the same company sells both your product and the other company's product. The degree of relatedness is the likelihood (probability) that an ordinary customer would believe that the same company sells both your product and the other company's product. For example, restaurant services are usually considered highly related to foods and beverages sold in a grocery store because it is common for a restaurant chain to also sell some of its food products in grocery stores under the restaurant's trademark. However, a company that sells restaurant services is unlikely to also sell automobiles.

Therefore, to form an opinion whether an ordinary customer would be confused into that mistaken belief, you estimate the *total* effect of *both* the degree of similarity between the two trademarks and the degree of relatedness between the products sold by you and by the other company. Greater trademark similarity and greater relatedness each point toward conflict between the trademarks. Little trademark similarity and little relatedness each point toward an absence of conflict between the trademarks. Because that judgment is extraordinarily subjective, competent trademark law experts can easily have honest disagreements about the correct answer.

So, what is a wise course of action to take when creating a new trademark? If, in your opinion, the new trademark you created is highly desirable, you may be willing to accept more risk. Risk means a risk of greater legal expenses and risk of a failure to secure legal protection. But if you are selecting a new trademark, you are likely at the beginning of a new product or new venture. That seems like a good place to make decisions that minimize the risks and maximize the probability of acquiring a trademark that will have both strong legal protection and be distinctive in the marketplace.

4. Some Things To Avoid When Selecting a Trademark

Before creating your trademark, you should know some of the legal principles that exist to support the above-described purpose and function of a trademark. Unfortunately, these principles are often not readily apparent from the purpose and function of trademarks until they are explained. But they are critically important to the value that your trademark can acquire and to your potential expenses in protecting your trademark. Unfortunately, law is often a series of principles, exceptions to the principles, and exceptions to the exceptions. There are exceptions for following principles, but it could be costly to qualify for the exceptions.

A. *Avoid Descriptive Words, Phrases Or Images.* The most common mistake that many people make is to select a word or phrase for their trademark that is merely descriptive of their goods or services. A proposed trademark is merely descriptive if it describes an ingredient, quality, characteristic, function, feature, purpose, or use of the goods or services for which the trademark is used. The law makes it more difficult or impossible for merely descriptive words or images to receive trademark protection. The reason is that all the competitors for the goods or services in a free market need to be able to use words or images that describe their goods and services to prospective customers. So, words or images that ordinary customers would perceive as merely descriptive cannot be owned as a trademark by any one company. Consider a few examples: BED & BREAKFAST REGISTRY was considered merely descriptive of lodging reservations services; SUPERJAWS was considered merely descriptive of a variety of machine and hand tools that included jaws; BOBBLE POPS was considered merely descriptive of "candy," which was a lollipop candy featuring a bobble head device; COASTER-CARDS was considered merely descriptive of coasters suitable for direct mailing;

However, there are trademarks that *appear* to be an exception to the prohibition against descriptive trademarks but, upon analysis, they are actually not an exception. They result from a change in the market and in customer perceptions. It sometimes

happens that a word, phrase or image has been used in commerce for a long enough time and has been promoted extensively enough that its customers for the goods and service for which the trademark is used have come to recognize it as a trademark. In other words, because of long and extensive use, customers come to perceive the trademark as indicating origin or source of the goods or services rather than as being descriptive. If there is sufficient evidence that the public associates the trademark with a specific source, a trademark is considered not descriptive because it has *acquired* distinctiveness. Therefore, that trademark is protectable and registrable as a trademark. For example: American Airlines described an airline based in America; Holiday Inn described an inn to stay in during a holiday; 5-Hour Energy described a drink that provides energy for five hours; Best Buy described the kind of purchase every buyer wants.

So, if you select a descriptive word, phrase or image as your trademark, there is a substantial risk. The risk is that your trademark may begin with weak or no legal right to stop infringers, at least early in your marketing effort. There can be excessive legal costs trying to protect or enforce your trademark. There is the risk that, despite substantial legal expense, you may never be able to prove that your trademark has acquired distinctiveness. In that case, there is the risk that other companies may have a right to use your trademark. Importantly, there is a risk that you cannot register your trademark.

It is possible to register a descriptive trademark on the *Supplemental Register* of the U.S. Patent and Trademark Office. But that affords far fewer legal rights than the *Principal Register* and may not prevent another company from using your trademark. Consequently, if you are selecting a new trademark, you should select a word, phrase or image that begins with healthy, strong legal rights. You do not want to risk the possibility that you will spend money on advertising and providing customers with a quality product only to lose rights in a trademark that you think symbolizes your reputation and goodwill.

B. Avoid surnames. A surname is a last name or family name of people. The law makes it more difficult or impossible for surnames to receive trademark protection. The reason is that courts recognized long ago that all people should be able to use their surnames in their business. However, the same exception and risks exist for surnames as described above for merely descriptive words, phrases or images. For example, McDonald is a common surname. But, unless you own a franchise, you would not want to open a restaurant called McDonald's, which is very much a protected trademark.

C. Avoid trademarks for which a U.S. trademark registration is prohibited by statute. The U.S trademark statute prohibits registration of a trademark which:

(a) Consists of or comprises immoral, deceptive, or scandalous matter; or matter which may disparage or falsely suggest a connection with persons, living or dead, institutions, beliefs, or national symbols, or bring them into contempt, or disrepute; or a geographical indication which, when used on or in connection with wines or spirits, identifies a place other than the origin of the goods and is first used on or in connection with wines or spirits by the applicant on or after one year after the date on which the WTO Agreement (as defined in section 3501(9) of title 19) enters into force with respect to the United States.

(b) Consists of or comprises the flag or coat of arms or other insignia of the United States, or of any State or municipality, or of any foreign nation, or any simulation thereof.

(c) Consists of or comprises a name, portrait, or signature identifying a particular living individual except by his written consent, or the name, signature, or portrait of a deceased President of the United States during the life of his widow, if any, except by the written consent of the widow.

However, it should be noted that the U.S. Supreme Court has ruled that, for constitutional reasons, registrations can be permitted for the well-known and often used F-word. Also, flags which are sufficiently different from, but use some features of the prohibited flags, can be registered. How much difference is sufficient is a subjective judgment so you cannot be certain whether yours would be sufficient.

5. The Trademark Spectrum and The Most Desirable Trademarks

The courts have recognized that trademarks fall along a spectrum according to their amount of distinctiveness. You should keep this concept in mind when creating a trademark.

That spectrum is: **generic-descriptive-suggestive-arbitrary-coined**

The farther to the right that your trademark lies, the more distinctive and legally strong and protectable it is likely to be. Also, the less likely that it will conflict with an existing trademark. However, after creating a potential trademark, it still is desirable to do some searching because someone else may have thought of it before you did.

Generic words or images are the common name for the goods and services or an image of the product. Examples are: hamburger, barber shop, underwear, and cars. Generic words or images are not protectable. The reason is that all competitors need to be able to use the common name and image for their products. Furthermore, if words are initially recognized as a valid trademark but the public, over time, comes to adopt them as the common name for the goods, trademark rights become extinguished. Examples are "aspirin" and "nylon".

Descriptive words describe a characteristic or feature of the goods sold in association with the trademark. They are more fully described above.

Suggestive words convey a desirable image or perception in the mind of an ordinary customer without being descriptive. They are protectable trademarks. The judgment whether a trademark is only suggestive or is descriptive can be a very close subjective judgment. Examples include: Microsoft which suggests software for microcomputers; YouTube which suggests a "tube" (television/screen) "you" create; and Airbus which suggests buses that fly.

Arbitrary words or images are words that exist in a language but have no relationship to the product being provided. An example is the word "amazon" which is known as an existing word for a river or a strong woman but has no relationship to the well-known online store. Another example is Apple for computers.

Coined words are words which are made up or invented and are unknown in a language. An example is Google. Shopify is not a known word but very strongly implies what customers do there.

Coined words make the strongest trademarks, but they require that many customers be exposed to them for a substantial amount of time. They are as unique and distinctive as a word or words can be. But often they are not considered because initially they are unusual, unfamiliar and have no meaning and do not suggest anything. But if you want to create strong customer recognition and are willing to wait for some time to pass to build a reputation in association with your trademark, they are the best. Arbitrary words make strong trademarks and have more familiarity to consumers. Suggestive words are often a desirable compromise but they require a lot of creative balance between avoiding descriptiveness and having an attractive trademark. It is usually desirable that a trademark be brief, such as one or two words in length. One or two words of one or two syllables are easier for prospective customers to remember.

6. Display and Use of a Trademark to Prospective Customers

Some organizations, large and small, are knowledgeable about how to use a trademark. Their use in the marketplace provides useful examples of good trademark practices. Some organizations, large and small, demonstrate ignorance about how to use a trademark. Put yourself in the former group.

There are several desirable characteristics of uses of a trademark and also some undesirable characteristics. A trademark is desirably prominently imprinted on a physical product, on packages or containers for the product and on displays, including website pages, at which the products can be purchased. A trademark for services is desirably prominently displayed where it can be seen by customers during the rendering of a service. Examples include on signs outside and inside a place of business and on vehicles or uniforms used for rendering a service. A trademark is desirably prominently displayed in advertising for goods or services, including websites and printed advertising.

It is very desirable to avoid referring to your trademark as the name of your product in advertising or other text that you use to describe your product. For example, if your trademark is HEAVENLY and you sell bed pillows, do NOT call your product a Heavenly. Always refer to it as a Heavenly pillow. In other words, include the accepted common or generic name of the product after the trademark. It is a Heavenly *brand* of pillow, although it is unnecessary to include the word “brand”. The accepted common or generic name of the product can be in the same or lesser prominence.

Here is the reason for this policy. A previous section of this article [4. A] described how a descriptive word can *acquire* distinctiveness by long and extensive use and a resulting eventual change in the perception of it by ordinary customers. The opposite can also happen. A perfectly valid trademark can acquire *non-distinctiveness*. It acquires non-distinctiveness if ordinary customers eventually come to use your trademark as the common or generic name for your goods and/or services. If that happens, your legal rights to the trademark will be lost and your competitors will be free to use it as a common or the generic name of the goods or services. A classic example is the word ASPIRIN. It

began as a trademark but, after the public began to perceive and use it as the name of the pill itself, it became free to use by all companies that manufacture that pill.

7. Conclusion

If you have read the above information and have concluded that creating and using a trademark is difficult, then you have understood what you read. Often companies pay someone a significant amount of money to propose some trademarks to them. Often other companies apply little effort when creating or selecting a trademark. Some of the latter companies are lucky and create a strong trademark even without exerting much effort to learn trademark principles. But it is not unusual for the consequence of their lack of effort to be unexpected legal and other costs along with a loss of what they thought was their legally protectable trademark.