



**INDIANA UNIVERSITY**  
OFFICE OF LICENSING AND TRADEMARKS

# Developing New Trademarks

## Introduction

Indiana University's Office of Licensing and Trademarks is charged with managing the University's trademark portfolio which consists of over 100 trademarks registered with the United State Patent and Trademark Office (USPTO). The Office also manages a licensing program, including over 500 licensees, which regulates the commercial use of 40 of the Universities trademarks.

A trademark can consist of any name, symbol, figure, letter, word, or mark adopted and used by manufacturer or merchant in order to designate his or her goods or services, and to distinguish them from those manufactured or sold by others. A trademark is a proprietary term that is usually registered with the US Patent and Trademark Office to assure exclusive use of its owner. Trademark registration affords the owner ten (10) years of protection.

## When should I register a trademark?

If you answer yes to the follow questions, you should register a trademark:

- Do you want to use the mark in services such as advertising and communications, or on commercial goods?
- Do you want to prevent others from using the mark?
- Do you want to distinguish yourself from competitors?
- Do you intend to use the mark for more than 2 years?

## Steps to Register a Trademark

1. Contact the Office of Licensing and Trademarks
  - a. Our office is located on the Bloomington Campus in the Poplars Building, Room 408. Located at 400 E. 7th Street. We can be reached via phone or email:

- i. Valerie Gill-University Director of Licensing and Trademarks, [vkgyll@indiana.edu](mailto:vkgyll@indiana.edu), phone: 812-855-6794
    - ii. Robin Cooper-Assistant Director of Licensing and Trademarks, [cooperrl@indiana.edu](mailto:cooperrl@indiana.edu), phone 812-855-8830
  - b. We will ask you a series of questions about your mark including:
    - i. What is the mark?
    - ii. Who will use the mark and how will they use it?
    - iii. What goods or services are you using the mark on or intend to use the mark on?
    - iv. What is the exact date you first started using the mark in interstate commerce? What exact date did you first start using the mark in interstate commerce or otherwise? The date must be specific, say January 1, 2008.
    - v. How long do you plan to use the mark?
    - vi. Can you provide specimens or samples of the mark being used?

## 2. Conduct a Trademark Search

- a. After we have obtained the information above from you, we will order a Comprehensive US trademark search. This search looks for any example of your mark, or confusingly similar mark, being used commercially. The intent of the search is to identify any potential liability before you begin using the mark. It also gives us a better idea of who might pose opposition to the mark during the registration process.

## 3. Intent to Use

- a. In certain instances, we plan to use a trademark but have not implemented it use. The USPTO allows applicants to file an "Intent to Use" application in this instance. This type of application provides trademark protection for an applicant 6 months prior to a mark being used.

## 4. Define how goods or services are to be used

- a. The USPTO has created 45 different International Classes or Categories of goods and services. See attached list. An applicant registers their mark in these classes dependent upon use. A list of goods or services for the selected International Class will be provided to you at the onset of the registration process. Once the classes for registration have been selected, a description of use will be written for the mark.

## 5. Provide specimens of use

- a. The USPTO required specimens or samples of each mark being used in that particular good or service. Specimens can be submitted as an electronic photo or j-peg.

#### 6. Registrations Process at the USPTO

- a. Submit application
- b. Within 5-6 months a USPTO Examiner will review the application and either issues an Office Action, requesting additional information or providing objections to the application, or move the application through to step C.
- c. Upon successful review of the application by the Examiner, the mark is approved for publication in the Official Gazette
- d. Upon publication, any party who feels this mark is confusingly similar to their mark or is infringing on their trademark has 30 days to post opposition to the trademark application.
- e. If no opposition is filed, or if the opposition is unsuccessful, the application enters the registration process.
- f. A certificate of registration will be issued to the applicant.

#### 7. Registering a mark with a Foreign entity

- a. If you intent to market the goods or services using the mark abroad contact the Office of Licensing and Trademarks to discuss your particular situation in greater detail.