

CHECKLIST

... for the development, examination and protection of name ideas

1. Develop names that are memorable and of high distinctiveness!

Catchy names that possess distinctiveness should be short, easy to remember, and unmistakable within their field of products and services. A name becomes very distinctive if it does not rely on descriptive or associative components, but consists of original, imaginatively generated terms. This also regards name elements of with an English language origin, which possess little distinctiveness in recent legal terms. If terms that are hardly distinctive are chosen already in the process of creating and choosing the brand name, legal maintenance and defense often turns out quite costly.

2. Choosing goods and services for the searches

After the names that are to be researched are determined, all necessary trademark classes have to be selected in accordance with matching goods and services. You will find helpful hints within the category entitled "Tips" at www.trademarkCHECK.de/en/tipps-und-beispiele.

3. Choosing the countries in which the name is to be researched and used in future

After defining the names and the trademark classes, the registers you wish to search your name propositions in have to be defined in the third step. If you take Germany as your target market as an example, it is indispensable to check within the national trademark register as well as in the CTM and WIPO registers, as trademarks can unfold their effect on the national market here. If the names are to be used in other markets as well - within the European Union for instance - it is not enough to simply search the registers CTM and WIPO. If you wish to use a trademark name in countries such as France securely, it is indispensable to check the CTM and WIPO registers as well as the French register for similarity researches. Relying on the CTM, the WIPO and the German register alone, and yet planning to use the trademark within the European market, could be the defeat of your own EU trademark because of an existing national trademark elsewhere, in France e.g. The corresponding country's register has to be taken into account besides the CTM and WIPO register in order to secure long-lasting trademark protection. Registering European trademarks bears another risk and may fail: Even if the trademark is to be used in Germany only, foreign markets could affect conflicts and prohibitions through national trademark

rights. It is therefore vital to settle on a much-needed research- and protection- strategy in order to choose the right scope of your first research.

4. Assessing the results after conducting your research(es)

After conducting trademark researches as described at www.trademarkCHECK.de, the results of the search reports have to be assessed. If there are similar trademarks already existing, it does not automatically mean having to dismiss certain ideas for names. A true danger of confusion can only be assessed by a trademark lawyer. Consequently, experts must be consulted to do individual case checks and give you their knowledgeable verdict regarding the prospects of your chosen name ideas. Generally speaking, there is a danger of confusion for identical or nearly identical trademarks within identical or nearly identical services, and using an identical name should be advised against. Negotiating on delimitation agreements with more distant trademarks and goods or services could prove to be promising a success in coexisting.

5. Registering the trademark

You should determine first of all, whether you want to register your name idea as a word mark or a design mark or a combined word/ design mark (as a company logo e.g.). Then you should clarify if there is a long time span between the time of conducting the research and the factual registration because an additional and more up to date research should be carried out in this case. At the time of registration you have to determine the classes and registers - similar to the time of researching - within which you wish to register your trademark. In the next step, you should dismiss all descriptive components, at least for the registration. If you take a well-known trademark like "Coca-Cola" as an example, it is not required or advisable from a trademark law perspective to register additions such as "Coca-Cola Lemonade" or "Coca-Cola Cold Drinks" or "Coca-Cola Refreshments" as well. Trademark protection is effected by the distinctive term "Coca-Cola". The additions are of a merely descriptive nature and may be used for company distinction, but should best be deleted with regards to trademark protection. Business additions such as Ltd., which simply represents the legal form of the company, would not strengthen but weaken the uniqueness of the trademark.

6. Note the time of the trademark registration within your resubmission!

Should you have applied for a trademark registration in Germany, for instance, you have the possibility to register your trademark for foreign markets in a large number of countries with the German priority within the so-called six-month priority period. This means that if

you registered your national trademark on March 1st 2015 e.g., you have half a year left to follow with registrations abroad (so, on September 1st 2015, at the latest), possibly depending on your business success, with the help of your retroactive priority, dating back to March 1st 2015.

7. Note the expiration of the grace period for using the name!

In large businesses especially, large quantities of names are researched and registered for future projects. It is good to know that a name can be registered for the following five years without risk and be shelved as a stock-trademark. After five years upon registering the trademark however, the so called grace period for using the name expires, and, in cases of conflict, proof that the name is used has to be given in order to secure its rights. This means that brand names that are older than five years and not used may be deleted successfully from the register with a simple suit for cancellation filed by anyone (mainly by competitors though).

8. Use the trademark as registered!

Should you have registered a word mark, like most trademark holders, the following point is less important than it is to trademark holders that have registered a design mark or a combined word/ design mark. It is of great importance for design marks or combined word/ design marks that the trademark is used exactly as it was registered. Using it differently weakens or inhibits the protection that the registered trademark possesses.

9. Seek advice from experts from the respective fields!

When questions arise regarding the development of a trademark name, conducting a research or assessing research results, it is highly recommendable to seek professional advice. With respect to developing a name, specialized Naming Agencies should be consulted. With respect to conducting researches, there are many research providers such as www.trademarkCHECK.de, who provide professional researches and appropriate support, also by telephone. Regarding further support, registration, and assessment of possible trademark law conflicts, we strongly recommend consulting qualified law offices focusing on trademark law. You can find a number of recommendable and renowned addresses within the category entitled "Experts & Links" at www.trademarkCHECK.de/en/experten.