

Checklist

... for the development, review and protection of trademarks

1. [We recommend to develop a name that is memorable and has a strong distinctive character.](#) It should be short and should fit into the product and service environment. A name is always highly distinctive, if it consists of inventive, imaginatively derived terms and uses descriptive or associative name components limitedly. This also applies to name components of English origin, as these are also considered by recent case law to have a weak distinctive character. If names with weak distinctiveness are chosen as a brand name, high costs for the preservation of rights and very likely the defence of the name may arise.
2. [A selection of goods and/or services for the trademark classes has to be made before the searches can be carried out.](#) After determining the name ideas to be searched, the necessary trademark classes must be chosen on the basis of the predefined goods and/or services. Please see our download "The 45 trademark classes" for more information.
3. [Determination of the countries in which the names are to be searched and used in the future.](#) After selecting the names and determining the trademark classes, the third step is to select the registers in which the proposed names are to be searched. If, for example, the target market is Germany, it is essential to search not only in the national trademark register but also in the CTM (Community Trade Mark) and WIPO (World Intellectual Property Organization) registers, where registered trademarks also have or can have an effect on the national market. If a brand name is also to be used on foreign markets, for example within the European Union, it is still not sufficient to search exclusively in the CTM and WIPO registers. If, for example, one takes a country such as France, in which the trademarks are to be used without risk in the future, it is essential to conduct similarity searches in the French national register in addition to the CTM and WIPO registers. This is justified as follows: If you rely solely on searches in the

registers of Germany, CTM and WIPO and had the long-term intention of also operating in other European countries by filing an EU trademark application, then an older national trademark application filed by another party, here in France for example, could bring down one's own EU trademark. Accordingly, in all those EU countries in which trademark protection is to be applied for in the long term, the respective national register must be taken into account as well as the CTM and WIPO registers. In addition, it must be pointed out that there is a risk that the application for European trademarks may also be brought down against the background of a merely national use in Germany because oppositions or prohibitions can be derived from a foreign market via national trademark rights.

It is therefore important that you define the necessary search and protection strategy at an early stage in order to choose the right scope of the search during the first searches.

4. **Evaluation of the results after the search.** After the trademark searches have been carried out, the results of the search report must be assessed. If there are already similar trademarks, this does not mean that name proposals must necessarily be abandoned. The existence of an actual likelihood of confusion can only be assessed by a trademark attorney. Accordingly, experts should always be consulted here, who will carry out a case-by-case examination and provide you with a sound judgement on the chances of success of the name proposals you have chosen. In general, if the signs are identical or almost identical and the services are identical or almost identical, a likelihood of confusion is assumed and the use of such a name is not advisable. In the case of more distant signs and sufficiently distant goods and services, it may well be promising to achieve coexistence with the holders of earlier rights by means of appropriate demarcation agreements.

5. **Registration of the trademark.** First, determine whether you wish to apply for your name idea as a word mark or as a figurative or combined word and figurative mark (e.g. as a company logo). Then clarify whether there is already a longer period of time between the date of the search and the actual date of application, because then an updated search should be carried out again. At the time of filing, you must first determine - similar to the searches - in which classes and in which registers the search is to be carried out. In the next step you should then delete descriptive elements at least for the application. For example, if you take a well-known trademark such as "COCA-COLA", it is neither necessary nor advisable in the sense of trademark law to also apply for additions such as "COCA-COLA lemonade", "COCA-COLA cold drinks" or "COCA-COLA soft drinks". The trademark protection is derived from the highly distinctive term "COCA-COLA". The additions are only of a descriptive nature and can be used, for example, to identify a company but should be deleted for trademark protection. Even a company suffix such as "GmbH" or "Ltd.", which merely represents the legal form of the company, would not strengthen the unique selling proposition of the trademark but rather weaken it.

6. **Note the date of the trademark application in your resubmission.** If, for example, you have applied for a trademark application in Germany in the first step, you have the possibility to file foreign applications in a large number of countries with German priority within the so-called 6 month priority period. This means, for example, that if you have applied for a national trademark on 14.01.2021, you have half a year to "follow up" foreign applications with the retroactive priority as of 14.01.2021 within 6 months (i.e. by 14.07.2021 at the latest), depending on your business success.

7. [Make a note of the expiry of the grace period for use](#). Especially in larger companies it is not uncommon for names to be searched and registered in large numbers for future projects. In this case you should know that a name can be registered for five years without risk and can remain in the "drawer" as a stock brand. Only after the expiry of the 5 year so-called grace period for use from the registration of the trademark, is it necessary to prove genuine use in case of conflict. This means that brand names which are older than five years and are not used can usually be successfully removed from the register by anyone (but in most cases by competitors) by means of a simple action for cancellation.

8. [Use the trademark in the registered form](#). If you - like most trademark owners - have applied for a word trademark, this point is less important than if you have decided to apply for a figurative trademark or a composite word and figurative mark. In particular in the case of figurative marks or composite word and figurative marks, it is very important that the sign is used exactly as applied for. A changed use weakens or even prevents the protective effect of the sign applied for.

9. [Ask professionals who are experienced in the respective special fields](#). Whenever you have questions regarding the development of a trademark name, the performance of searches or the evaluation of search results, it is strongly recommended that you contact specialised naming agencies. In the case of searches to be carried out, there are numerous search providers who, like our business unit trademarkCHECK, can carry out professional searches for you with appropriate support and telephone assistance. In the case of further support, registration or assessment of possible conflicts under trademark law, it is strongly recommended to consult appropriate law firms with a focus on trademark law issues.