

RIVER+WOLF



# Trademark<sup>®</sup> In Brief

+ WHAT IS A TRADEMARK & OUR SCREENING PROCESS



## + TRADEMARK JOURNEY

**River + Wolf excels at developing powerful brand names.** But that is just half the challenge. Navigating the trademark clutter during name development is complex. Each of the 45 trademark classes has hundreds of thousands of existing marks. In the U.S. alone, over 100,000 new trademark applications are filed each quarter, making the road to a distinctive brand name more challenging than ever. Add global filings, common law issues, and e-commerce, and the challenge increase exponentially.

This is why **our agency collaborates with top New York City trademark attorneys and their partners around the world.**





## + TRADEMARK, URL, PATENT, OR COPYRIGHT?

A trademark is distinct from a URL, patent, or copyright.

### **TRADEMARK**

A trademark shields the reputation and goodwill of a business related to its logos, sound, slogans, and designs. A trademark is how customers recognize a business or product in the marketplace. It helps set it apart from its competitors.

### **URL**

A URL (uniform record locator) is a web address.

### **PATENT**

Patents safeguard new inventions.

### **COPYRIGHT**

Copyrights protect original literary, dramatic, musical, software and other works of authorship.

Trademark

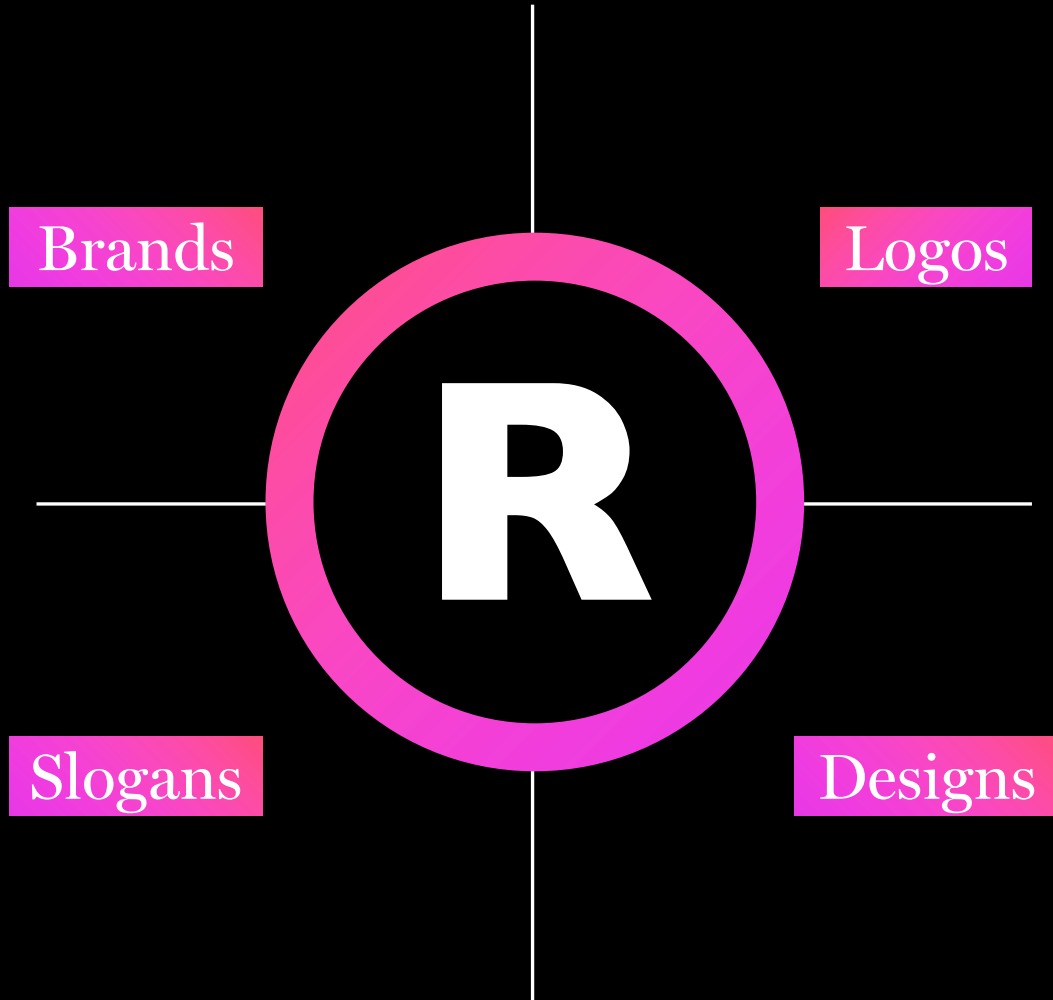
URL



Copyright

Patent

RIVER+WOLF



## TRADEMARK - A LEGAL SAFEGUARD





Possessing a trademark designates you as the originator of your products and services while providing legal safeguards for your brand. This ensures that **no other entity or person can adopt an identical or similar word, expression, or logo** for goods and services that are the same or related to yours.

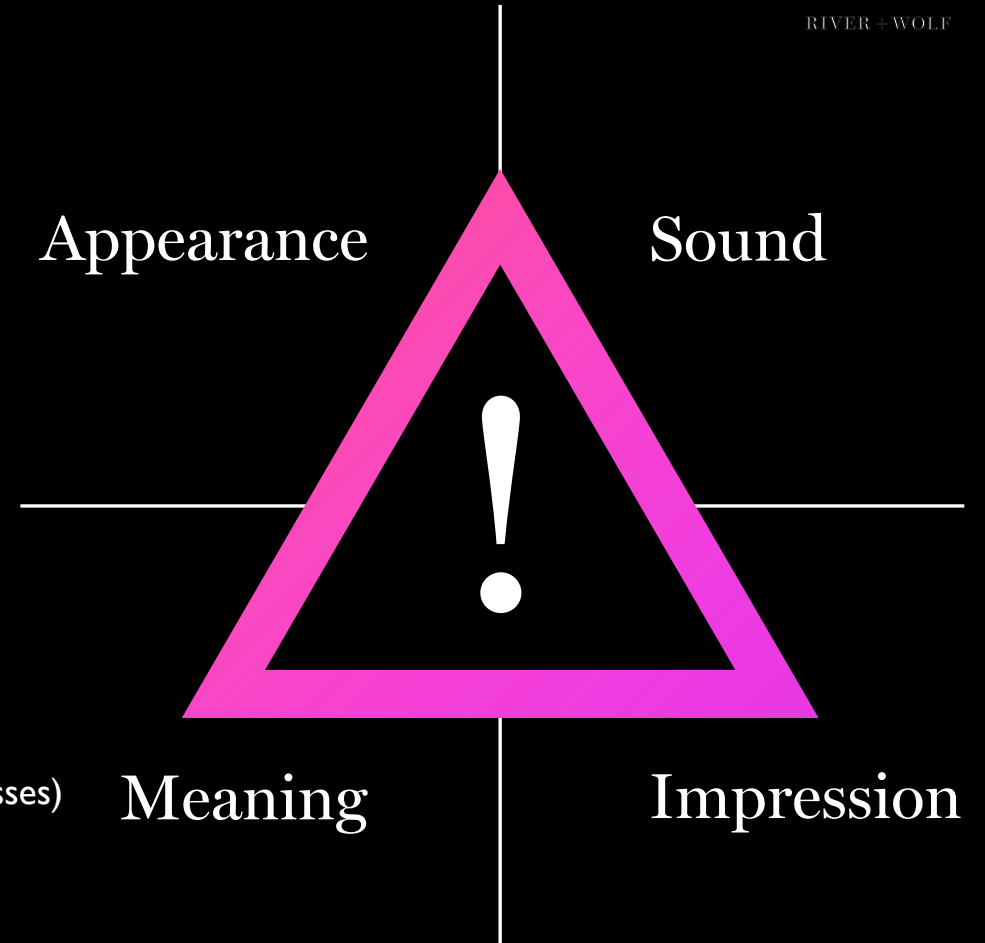
- Ⓡ **PROTECTS SIMILAR WORD** (within the same category)
- Ⓡ **PROTECTS EXPRESSION** (within the same category)
- Ⓡ **PROTECTS LOGO** (within the same category)

## THINGS TO CONSIDER

### + BEYOND IDENTICAL MATCH

Trademark law is complicated and what constitutes "likelihood of confusion" with another mark is not always straightforward. Moreover, **names in the same or related trademark classes do not need to be identical to create a potential trademark infringement.** They could be close in sound, appearance, meaning, or could create a similar commercial impression.

-  **SIMILAR SOUND** (within the same or related TM classes)
-  **SIMILAR APPEARANCE** (within the same or related TM classes)
-  **SIMILAR MEANING** (within the same or related TM classes)
-  **SIMILAR COMMERCIAL IMPRESSION** (within the same or related TM classes)



Delta  
AIRLINES



Delta  
FAUCETS

## THINGS TO CONSIDER

### + SAME NAMES, DIFFERENT CATEGORIES

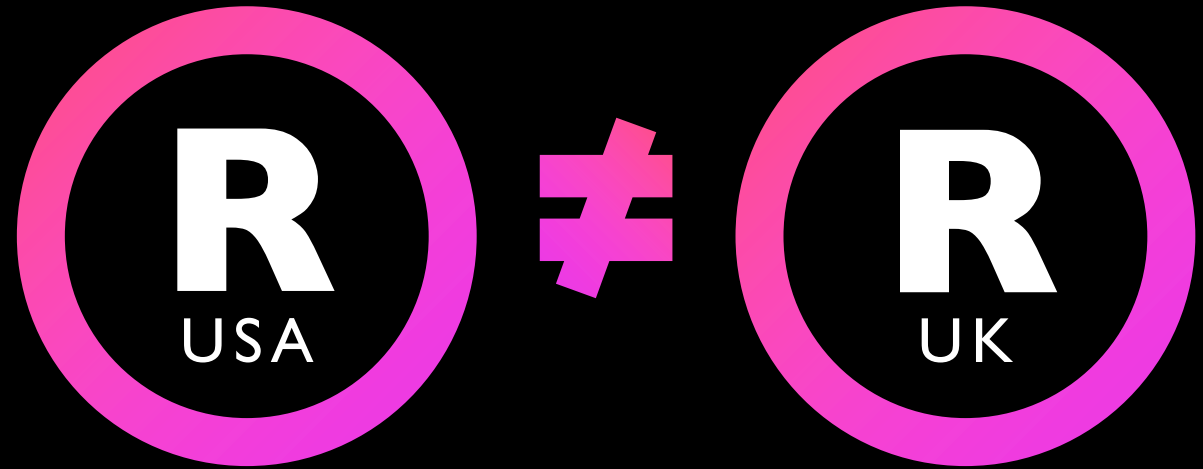
**The same names, however, can co-exist if they exist in different categories.** For examples DELTA FAUCETS and DELTA AIRLINES, or DOVE ice-cream bars and DOVE personal care products can co-exist. It is unlikely that the average consumer would confuse faucets and airlines or ice-cream and personal care products.

An exception to this is famous marks. These are marks such as APPLE, NIKE, and MCDONALDS that have a strong connection to a specific product or service in consumer minds. Such marks enjoy a broader scope of protection and are best avoided, even if the goods and services are completely unrelated.

## THINGS TO CONSIDER

### + TRADEMARKS ARE JURISDICTION-SPECIFIC

Name protection is jurisdiction-specific; **a business name safeguarded in Germany may not enjoy protection in the U.S. due to distinct geographic locations.** To secure a trademark globally, registration is required in every country where you are *actively* conducting business or selling your products/services. This applies to both brick-and-mortar stores and e-commerce. An experienced IP attorney can help determine active versus passive selling in e-commerce and how this may impact your trademark protection.



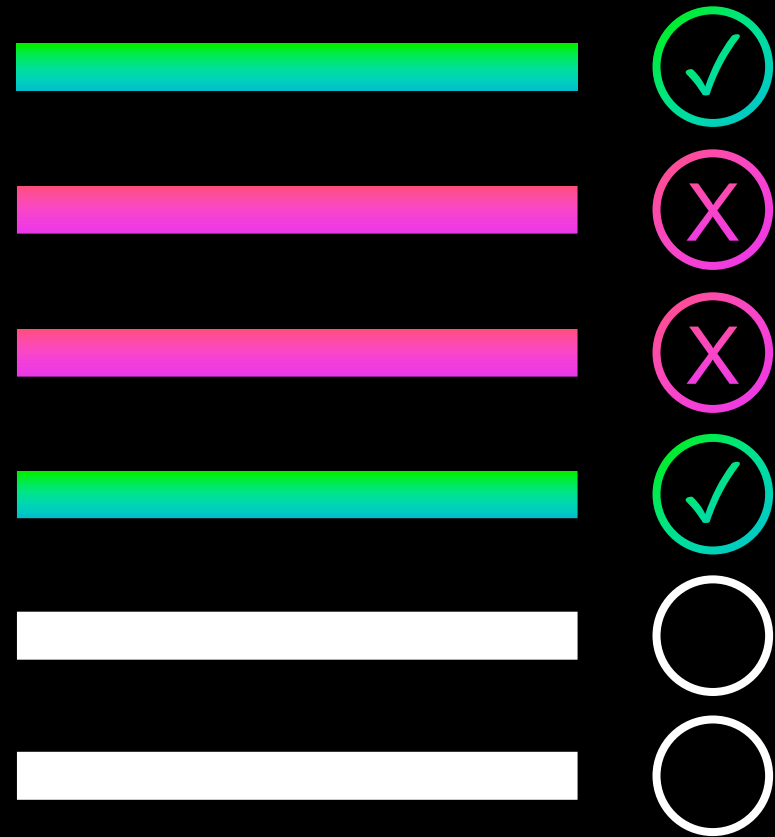
-  **BUSINESS NAME PROTECTED in GERMANY**
-  **BUSINESS NAME UNPROTECTED in USA**
-  **BUSINESS NAME UNPROTECTED in CANADA**

## OUR SCREENING APPROACH

### + STEP 1A: Preliminary Screening - Identical Matches

**Before showcasing names to clients, River + Wolf employs advanced A.I. software to eliminate identical matches within the client's primary trademark classes.**

This initial screening, also known as a "knock-out" search, focuses on "blatant offenders," referring to names with a high risk of receiving a likelihood of confusion objection in the PTOs (Patent and Trademark Offices) in your relevant jurisdictions.





## OUR SCREENING APPROACH

### + STEP 1B: Preliminary Screening - Identical Matches Plus



After the naming presentation, you will select 10 or more names for a second round of screening. These **names undergo scrutiny by River + Wolf's IP attorney**, who will consider factors like phonetic similarity, spelling variations, vowel substitutions, plurals, and overall commercial impression.

Remember, at the heart of all trademark law is the question of **consumer confusions** – when a consumer sees a junior trademark attached to goods/services, does he think the goods/services are produced by the senior trademark?

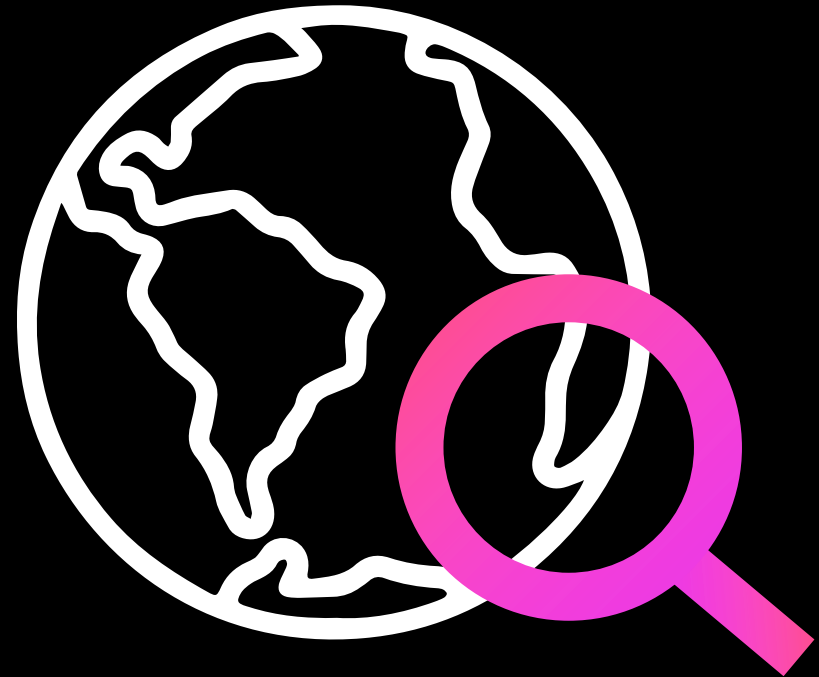
## OUR SCREENING APPROACH

### + STEP 2: COMPREHENSIVE TRADEMARK SCREENING

Before finalizing your name, River + Wolf's IP attorneys conduct a comprehensive search in the relevant countries or jurisdictions. This exhaustive search focuses exclusively on the final name or names of interest, aiming to identify potential conflicts beyond the Patent and Trademark Offices.

Common Law Trademarks are those marks, which like registered marks are sufficiently distinct vis-à-vis their goods/services. They are marks used in commerce in connection with the sale of their designated goods/services.

Common Law Trademark protection, unlike the federal scope of protection granted to a registered mark, is geographically constrained. Determining jurisdiction can be complicated with an e-commerce/internet business, so consultation with experienced IP attorney is strongly advised.





## OUR SCREENING APPROACH

### + STEP 2: COMPREHENSIVE TRADEMARK SCREENING

Conducted by a professional search firm, a comprehensive trademark search combs through **directories, registers, and platforms such as these:**

- + Federal Trademark Database (s)
- + State Trademark Registers
- + Common Law Searches
- + Domain Name Searches
- + Social Media Platforms
- + International Trademark Databases
- + Industry-Specific Directories

Logo and other visual elements associated with a trademark should also be searched. The purpose of this is to avoid visual similarity with existing logos or designs that are registered or in use via common law.

## + IN SUM

In the current landscape of congested trademark databases, identifying names with acceptable risk levels can be likened to finding a needle in a haystack. However, there's no need for despair—**River + Wolf excels in crafting names that not only hit the mark in terms of desired sound and meaning, but also succeed in avoiding trademark clearance obstacles.**

Moreover, if a name is deemed "high risk," our expert IP attorneys can often negotiate co-existence agreements to overcome potential conflicts.

