



BALLAGH + EDWARD
LLP

TRADE MARKS
COPYRIGHT
LITIGATION
MARKETING
PATENTS
DOMAIN NAMES
TRADE SECRETS
INDUSTRIAL DESIGNS
LICENSING



Intellectual Property Legal Services in Canada

Frequently Asked Questions

Refer with Confidence

At Ballagh & Edward LLP, we provide a comprehensive range of legal services exclusively in the field of intellectual property law. In this capacity, we offer our agency services to a network of international firms whose clients do business in Canada.

Our professionals strive to be accessible and responsive in serving all our clients. We work hard to provide considered and practical advice in a cost effective manner. We take pride in keeping our clients informed in a timely manner about all developments in their matters. An alternative to large national firms, our business model encourages collaboration among partners and avoids training junior lawyers at the expense of our clients.

Because our practice is restricted to intellectual property law, we are always familiar with the current state of the law and can therefore provide prompt and high quality services to your clients. Our offices have also adopted efficient systems for the accurate processing of trademark and patent applications according to the unique requirements of Canadian law.

*Exceeding the
Standard™*



Trademarks

1 *What are the minimum requirements for filing a trademark application in Canada?*

To file an application in Canada, we require the following information:

- a. Proper legal name of applicant and address.
- b. Proper legal name(s) of all predecessors in title that used mark in Canada before applicant, if any.
- c. Identification of mark to be filed.
- d. If a design mark, a 7 cm x 7 cm black and white representation of the mark on white paper is required, or a black and white electronic version of the design in either .tif or .jpeg format.
- e. If colour is to be claimed as a feature of the mark, a colour copy may be submitted or the drawing may be lined for colour.
- f. Description of wares and services to be associated with the mark. Description to be provided in 'ordinary commercial terms'.
- g. If mark is already used in Canada, approximate date of first use in Canada (ie. date of first sale for wares and date of first advertisement for services).
- h. If mark is to be filed on the basis of proposed use, instructions to this effect.
- i. If mark is to be filed on the basis of a corresponding foreign application or registration, particulars with respect to this filing, namely the application number, the date of filing/registration and the country where filed/registered. Although not required at the filing stage, a certified copy of the foreign registration will be required to support the CDN application.

We do NOT require a power of attorney or any specimens.

For applications filed on the basis of proposed use in Canada, the applicant will be required to complete a simple declaration that use of the mark in Canada has commenced since the application was filed. This declaration is filed after the application is allowed, but before it is registered. Again, no specimens are required.

2 *Canada does NOT use a classification system for filing trademark applications! How does that impact on the description of the associated wares and services?*

In Canada, the description of related wares and services is not separated by class. Instead, each of the related wares and/or services for a trademark must be described in "ordinary commercial terms". General categories are not usually acceptable. For example, "clothing" is not an acceptable description of wares. Instead, the application should specify the types of clothing in the following format: "clothing, namely hats, shirts, pants and socks".

For novel or technical products and services, it can be helpful to file specimens of advertising and/or packaging to demonstrate the "ordinary commercial terms" used to describe them in the marketplace.

A benefit of this system is that only *one* application fee is payable for each application filed regardless of the number of wares and services involved.

Trademarks

3 *Is Canada a signatory to the Madrid Protocol?*

No. Although the Canadian Intellectual Property Office consulted the profession in early 2010 about its views as to whether Canada should become a signatory to the Madrid Protocol, the issue is not expected to advance to the crowded political agenda for some time.

4 *Are foreign trademark applicants required to “use” their marks in Canada prior to registration?*

No. Foreign applicants may file an application based on a registration or pending application filed in their country of origin. However, the trademark must be “used” somewhere in the world prior to registration in Canada, preferably in the applicant’s country of origin to ensure compliance with the law.

5 *Can new product packaging be registered as a trademark in Canada on the basis of proposed use?*

No. Product packaging such as bottle shapes cannot be registered as a trademark on the basis of proposed use. Product shapes, containers and modes of packaging may only be registered as a “distinguishing guise” after they have acquired distinctiveness through exclusive use in the marketplace for several years. On the other hand, three-dimensional figures that are not an integral part of a product, its container or mode of packaging, such as automobile hood ornaments, can be registered on the basis of proposed use.

Exclusive rights to proposed or newly introduced product packaging should be preserved as an industrial design. Note that an application to register an industrial design must be filed within *one year* after publication of the design. See discussion below under Industrial Designs.

6 *What constitutes “use” of a trademark in Canada?*

In Canada, a mark is deemed to be used:

- a. in association with *wares* when it is marked on the wares, the packaging or otherwise associated with the wares at the point of sale;
- b. in association with *services* when it is displayed in the performance or advertising of the related services.

The display of a mark in advertising is not, on its own, considered “use” of the mark in association with *wares*.

7 *Can geographic indicators (appellations of origin) be registered in Canada?*

Yes. In accordance with TRIPS, GIs can be registered in Canada for use in association with “wines and spirits”. In ongoing international negotiations, Canada currently opposes the expansion of GIs to other food products.

8 *What is an “official mark”?*

An official mark is a mark adopted by a government or agency of government in Canada, its military or a university. Foreign universities and governments may be eligible to record their marks, arms, crests and flags as official marks.

Official marks enjoy a monopoly for all wares and services in the marketplace and are not subject to opposition.



Patents

9 *What are the minimum requirements for filing a patent application in Canada?*

To receive an official filing date in Canada, an applicant must submit no less than the following:

- a. a statement that a patent is sought;
- b. documentation describing an invention;
- c. the applicant's name;
- d. the applicant's address;
- e. the name and address of a domestic representative in Canada, and,
- f. the filing fee.

A complete patent application includes the foregoing, plus the following:

- a. a formal petition;
- b. abstract of the invention;
- c. claim or claims to the invention;
- d. any drawings mentioned in the description;
- e. nucleotide sequence listing, if applicable, in electronic form;
- f. appointment of a patent agent or representative, unless the applicant is the inventor.

The application must be completed within 15 months from the filing date of the application or the filing date of the earliest foreign application from which priority is claimed.

10 *Does Canada use a 'first-to-file' or a 'first-to-invent' system for patents?*

In Canada, as in most other countries in the world, the first party to file a patent application for the invention is entitled to the patent.

11 *Is there a "grace period" for filing patents in Canada?*

In Canada, there is a one year grace period within which to file a patent application after public disclosure by the applicant or someone who obtained knowledge from the applicant.

12 *What documentation is required to demonstrate an applicant's entitlement to file a patent application in Canada?*

Applications are required to include a declaration that the applicant is the "legal representative" of the inventor. The declaration may be signed by our office on behalf of the applicant and no supporting documentation is required. To make the declaration, we only require information regarding the factual basis for the entitlement, namely by virtue of the fact that the inventors are employees of the applicant or by an agreement between the inventors and applicant.

13 *Are fee reductions available in Canada to assist sole inventors and small businesses in the payment of official fees?*

Yes. Applicants who qualify as a "small entity" are eligible for a 50% reduction of the official filing, examination and maintenance fees.

"small entity" means,

- a. an entity that employs 50 or fewer employees or that is a university, but does not include an entity that is controlled directly or indirectly by an entity, other than a university, that employs more than 50 employees; or,
- b. has transferred or licensed or has an obligation, other than a contingent obligation, to transfer or license any right in the invention to any entity, other than a university, that employs more than 50 employees.

Patents

Applicants are encouraged to carefully review this definition. Even when inadvertent, the erroneous filing of a small entity declaration can result in the loss of patent rights. Generally, we require a declaration signed by the applicant that they comply with the definition of a small entity.

14 *Is a legalized power of attorney required when filing a patent application in Canada?*

No. An appointment of patent agent and representative for service in Canada is completed and filed with the originating application document by our office. The applicant is not required to sign this appointment document or any power of attorney.

To assume carriage of a pre-existing Canadian application, the applicant will be required to sign a document revoking all previous appointments and appointing our office instead. No legalization is required.

15 *Are patent applications examined automatically after filing?*

No. Canada has a system of deferred examination. A new application is not examined until a request for examination is filed and the requisite examination fees are paid. The request for examination can be filed concurrently with the application, or it can be deferred for up to 5 years from the filing date of the application. If no request for examination is made by the 5th anniversary of the filing date, the application will be considered abandoned.

16 *When is an applicant required to start paying maintenance fees for a patent application?*

Starting on the second anniversary of the application filing date and each year thereafter until the patent expires, fees must be paid to maintain each patent application. If not paid in a timely manner, the patent will be considered abandoned.

17 *When is last opportunity to complete national entry in Canada of a PCT International Patent Application?*

The last opportunity to complete a national entry in Canada is 42 months from the earlier of the filing date of the PCT application or the earliest foreign application from which priority is claimed.

18 *What is the standard duration of a patent issued in Canada?*

For all patent applications filed in Canada after October 1, 1989, the issued patent will expire 20 years after the filing date of the application.



Copyright

19 *Can you register copyright in Canada?
If so, what are the minimal requirements for filing?*

Yes. Canada does maintain a copyright register. To file an application in Canada, we require the following information:

- a. title of the work;
- b. category of the work, namely literary, dramatic, musical or artistic;
- c. date and place of first publication, if any, or advice that work is unpublished;
- d. full legal name of author(s); and
- e. full legal name of name of owner(s) with their respective mailing address.

We do NOT require a copy of the work.

20 *What are moral rights?*

Moral rights are exclusive to the *author* of a work. They include:

- a. the right to the integrity of a work, including the right to protect a work from:
 - i. distortion, mutilation or modification; or
 - ii. being used in association with a product, service, cause or institution *to the prejudice of the honour or reputation of the author*, and
- b. the right to be associated with a work as its author (by name or pseudonym), *where reasonable in the circumstances*, or to remain anonymous.

Moral rights cannot be sold or assigned. They can only be waived.

21 *What is the standard duration of copyright in Canada?*

In Canada, the general rule is that copyright expires 50 years after the death of the author.

Industrial Designs

22 *What are the minimum requirements for filing an industrial design application in Canada?*

An application for an industrial design must contain the following:

- a. a declaration that the applicant is the proprietor of the design and that, to the applicant's knowledge, no one else used the design before the first proprietor;
- b. the name and complete street address of the applicant;
- c. the title of the article;
- d. a description of the features of the design;
- e. the name and complete street address of a representative for service in Canada, if the applicant has no office or place of business in Canada; and
- f. drawings or photographs showing the features of the design.

23 *Is there a "grace period" for filing industrial designs in Canada?*

In Canada, there is a one year grace period within which to file an industrial design application after public disclosure.

24 *What is the standard duration for an industrial design registration in Canada?*

Industrial design registrations expire 10 years after the date of registration in Canada. A single maintenance fee must be paid on or before the 5th anniversary to maintain the registrations.

25 *What is the relationship between industrial designs and copyright in Canada?*

In Canada, copyright becomes unenforceable after more than 50 copies have been made where the design may be protected as an industrial design. As a result, an industrial design registration must be sought to preserve exclusive rights in the design for any useful article produced in large quantities.

26 *What is the relationship between industrial designs and trademarks in Canada?*

Copyright in the design for a useful article like *product packaging* becomes unenforceable in Canada after more than 50 copies are made.

Moreover, new *product packaging* cannot be registered as a trademark on the basis of proposed use. Such packaging may only be registered as a "distinguishing guise" on the trademark register after if it has acquired distinctiveness through exclusive use in the marketplace for several years.

On the other hand, registration of new *product packaging* as an industrial design can preserve a monopoly in the design for up to 10 years. Accordingly, it is prudent to register such packaging as an industrial design to preserve a monopoly in the design *after* copyright becomes unenforceable and *before* trademark protection becomes available.





VALERIE G. EDWARD

LAWYER, PATENT & TRADE-MARK AGENT

Valerie Edward practices in the area of intellectual property law. Her practice includes patent prosecution in the biotechnology and mechanical patent areas, and trade-mark prosecution.

Valerie also advises on matters relating to other aspects of intellectual property including, copyright, industrial design, technology transfer and licensing.

From 1998 through 2004, Valerie practiced with the prominent Toronto law firms, Morris/Rose/Ledgett LLP, Aird & Berlis LLP and Heenan Blaikie LLP. In December 2004, Valerie set up her own practice and on January 1, 2009 became a founding partner of Ballagh & Edward LLP.



MICHELE BALLAGH

LAWYER & TRADE-MARK AGENT

Michele Ballagh is a lawyer and trade-mark agent. She practices exclusively in the area of intellectual property law.

Michele was admitted to the Ontario Bar in 1999 and has practiced as a trade-mark agent in Canada and the US since 2000. Michele is also an experienced litigator having appeared before all levels of the Ontario and Federal Courts.

After 10 years working for national law firms in South-western Ontario, Michele set up her own practice in Hamilton in November 2007 and became one of the founding partners of Ballagh & Edward LLP in January 2009.



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