

TRADEMARK PROTECTION IN CANADA

What is a Trade-Mark?

In Canada, a trade-mark is a one or more words, a graphic design or a combination of words and graphics that is used to distinguish the goods or services of one business from its competitors in the marketplace.

In some cases, a colour, a melody or a unique form of packaging may also qualify for protection as a trade-mark.

How is a Trade-Mark Chosen?

Trade-mark applications can be filed on the basis of past use in Canada or on the basis of an intention to use in Canada.

However, before adopting a proposed trade-mark, we often recommend that a professional search and opinion be requested to determine whether it is available. A comprehensive search includes a specialized search of trade-mark registries, business and corporate name directories, domain name registries, dictionaries and atlases. The search results are then reviewed by counsel who prepares a written opinion as to whether there are any likely obstacles to the adoption and/or registration of the proposed trade-mark.

Since trade-mark rights are generally recognized nationally, we recommend that similar searches be conducted in each country in which the trade-mark is intended to be used.

Should Trade-Marks be Registered?

Although some rights to a trade-mark may accrue through use in the marketplace in Canada, it is highly recommended that applications be filed in each jurisdiction where the trade-mark is used or intended to be used. Some jurisdictions do not recognize trade-mark rights without registration. Registration in Canada grants the owner the

exclusive right to use the trade-mark across Canada in association with the goods and services listed in the application. In addition to giving notice to the public of your exclusive right to the trade-mark, a registration is especially helpful in protecting that right when a dispute subsequently arises.

Most countries in the world adhere to an international treaty which regulates the orderly filing of trade-mark applications in multiple countries. This treaty stipulates that if a trade-mark application is filed in one or more additional countries within **6 months** after the first application is filed for the same mark, these additional trade-mark applications will be effectively backdated to the filing date of the first application. In other words, the applicant may assert priority over any trade-mark applications subsequently filed in foreign jurisdictions for a period of **6 months**.

The professionals at Ballagh & Edward LLP are qualified to file applications in both Canada and the United States. We will also file applications in other countries through associate law firms located in those countries whom we know are qualified in this specialized area of the law.

Do Trade-Mark Rights Automatically Expire?

No. Unlike copyright and patents, trade-mark rights do not automatically expire after a set time period. Trade-mark rights may be protected as long as the trade-mark remains in use. However, trade-mark registrations need to be renewed every fifteen years in Canada. The term varies in other countries. We track the trade-mark registrations for our clients in each country and, where possible, will remind our clients when a registration is due for renewal.

Can Trade-Marks be Sold or Licensed?

Yes, with certain restrictions, trade-marks and their related applications or registrations can be sold or licensed to third parties in Canada.

Since trade-marks serve as indicators of a single source of goods or services, families of similar marks must be sold as a group and, when licensing, the owner is required to maintain control over the quality or character of the goods and services associated with its trade-mark by the licensees.

If confusingly similar trade-marks are used by various parties in a common marketplace without proper controls, the trade-mark owners may lose their right to the exclusive use of those trade-marks. Trade-mark rights must be protected by constant vigilance.

What are the Steps to Register a Trade-Mark in Canada?

1. Formalities

As your agent, our office files an application with the Canadian Intellectual Property Office (“CIPO”). If it is in order, complete and includes the filing fee, the application will receive a filing date and an application number from CIPO. The application will be entered on the Canadian Trade-marks Registry and other databases maintained by external companies. The application is now described as 'Pending' and moves to step two.

How our office will be notified
Our office will receive a formal filing acknowledgement and a proof sheet by email showing all the information about the application. It should be reviewed carefully and any errors or omissions reported to CIPO.
...and when
The acknowledgement and proof sheet should be emailed to our office seven days after the application is filed if it is filed electronically. If the application needs to be filed by regular post, it may take longer.

2. Examination

A trade-mark examiner will review the application and determine if the trade-mark can be approved for advertisement in the *Trade-marks Journal*.

If it cannot be approved, our office will be advised why and you may be able to amend certain formal aspects of the application so it can be approved. We may also submit written argument to attempt to overcome any substantive objections.

When approved, the application moves to step three.

If amendments and/or argument fail to overcome the examiner's objections, you may elect to abandon the application or it may be refused. If the application is refused, we may appeal this through the courts. Please note that if no response is filed to the examiner's objections per the stipulated deadlines, the application will be marked as abandoned and cannot be revived.

How our office will be notified
With simple problems in the application, our office may be contacted by phone and the problems resolved verbally. Or, a written examiner's report will be mailed to our office detailing more complex problems. When the application is approved, our office will receive a formal written notice of approval.
...and when
The examiner's report or approval notice should be mailed to our office in about seven months if the application was received correctly and approved without amendments.

3. Advertising

If it is approved, the application will be published in one issue of the *Trade-marks Journal* — published weekly and available for viewing on the CIPO web site. Within two months of being advertised the application can be opposed by someone else and will then be removed from the normal processing cycle until the opposition has

been resolved. See step four for what will happen if the application is opposed.

How our office will be notified

Our office will not be sent a written notice at this stage unless the application is opposed by one or more parties. However, our office will review the Trade-marks Journal and will report the advertisement to you when it occurs. If the application is opposed, the Trade-marks Opposition Board will notify our office in writing.

...and when

The application should appear in the Journal about five weeks after it is approved.

4. Opposition

If the application is opposed after being advertised in the Journal, the Opposition Board will forward to our office a copy of the statement of opposition. Should you wish to contest the opposition, we will have one month to serve and file a counter statement, although reasonable extensions of time are usually granted upon request. Both parties will, in turn, have an opportunity to file affidavit evidence and written arguments, as well as to make submissions at an oral hearing.

An opposition is a complex adversarial proceeding. Most proceedings are resolved during the course of the opposition, but a complete opposition may last more than two years and the legal fees incurred cannot be recovered from the opposing party.

If the opposition is withdrawn or is unsuccessful, the application will proceed to allowance. See step five for what will happen if the application is allowed.

How our office will be notified

Our office will be notified that the application has been opposed when the Opposition Board forwards a copy of the statement of opposition by mail.

...and when

Our office will take responsibility for tracking

deadlines for filing pleadings and evidence in an opposition proceeding.

5. Allowance

The application will now be allowed for registration. Note that this does not mean the trade-mark is registered — payment of a registration fee is required for the mark to be registered as described in step 6. If the application is for a proposed mark, we may request a limited number of extensions of time until the mark is actually in use. There is a fee for each extension.

How our office will be notified

Our office will receive a notice that the application has been allowed for registration. If no response is provided to this notice in the indicated time, abandonment steps may be taken.

...and when

If the application was not opposed, the notice of allowance should be mailed to our office three months after appearing in the Journal.

6. Registration

Upon payment of the registration fee and, if the application was for a proposed trade-mark, the filing of a declaration of use indicating that the mark is being used, the application now moves from 'Pending' status and the applied-for-mark becomes a 'Registered trade-mark'.

How our office will be notified

The official Registration Certificate for the trade-mark will be downloaded from the CIPO web site by our office.

...and when

The certificate should be available for download between one and two weeks after payment of the registration fee and filing of any required declaration of use.

Where Can I Get More Information?

You can get more information by visiting the web sites for:

Canadian Intellectual Property Office
www.cipo.ic.gc.ca

United States Patent & Trademark Office
www.uspto.gov

Or by contacting:

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