
TRADEMARK PROTECTION IN CANADA

What is a Trademark?

In Canada, a trademark 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.

Colours, sounds, scents, tastes, textures, 3-D shapes, moving images, holograms and unique form of packaging can also qualify for protection as trademarks.

How is a Trademark Chosen?

A trademark application may be filed before or after the mark is adopted. However, we recommend that searches be conducted prior to adoption of a new mark.

A preliminary search will only identify obvious obstacles to registration of a proposed mark. A comprehensive search includes a specialized search of trademark registries, business and corporate name directories, domain name registries, dictionaries and atlases and will also attempt to identify marks that may sound alike or have a similar meaning. 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 trademark.

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

Should Trademarks be Registered?

Although some rights to a trademark may accrue through use in the marketplace in Canada, it is highly recommended that applications be filed in each jurisdiction where the trademark is used or intended to be used. Some jurisdictions do not

recognize trademark rights without registration. Registration in Canada grants the owner the exclusive right to use the trademark 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 trademark, 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 trademark applications in multiple countries. This treaty stipulates that if a trademark application is filed in one or more additional countries within **6 months** after the first application is filed for the same mark, these additional trademark applications will be effectively backdated to the filing date of the first application. In other words, the applicant may assert priority over any trademark 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 either: (a) the Madrid international system for the registration of marks; or (b) associate law firms located in those countries whom we know are qualified in this specialized area of the law. One method of international filing may be recommended over the other depending on legal risks and costs.

What is the Nice Classification System?

All the goods and services identified in an application must be assigned to one of 45 possible classes. After the first class, Canada requires the payment of a supplemental application fee for each additional class of goods and/or services contained in an application.

For instance, a retail sporting goods outlet with

its own house brand for products may have a trademark application that covers four classes, namely retail sales services (Class 35), clothing (Class 25), sports equipment (Class 28) and luggage (Class 18). The basic \$330 application filing fee will cover the first class. However, payment of three supplemental filing fees will be required to cover the other three classes. The supplemental application fee is \$100.00 per class.

To avoid paying multiple application fees, many applicants will remove some of the identified classes of goods and/or services that may be considered secondary to their main business activities from their applications.

Do Trademark Rights Automatically Expire?

No. Unlike copyright and patents, trademark rights do not automatically expire after a set time period. Trademark rights may be protected as long as the trademark remains in use.

However, trademark registrations need to be renewed every ten years in Canada. The term varies in other countries. We track the trademark registrations for our clients in each country and, where possible, will remind our clients when a registration is due for renewal.

Can Trademarks be Sold or Licensed?

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

Since trademarks serve as indicators of a single source of goods or services, families of similar marks should be sold as a group and, when licensing, the owner should maintain control over the quality or character of the goods and services associated with its trademark by the licensees.

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

What are the Steps to Register a Trademark 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 Trademarks 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 trademark examiner will review the application and determine if the trademark can be approved for advertisement in the *Trademarks 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. Applicants are granted 6 months to respond to any objections and are entitled to at least one 6-month extension of time if necessary.

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
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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.
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...and when

An examiner's report or, there are no objections, an approval notice should be mailed to our office in about twelve months after filing.
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3. Advertising

If it is approved, the application will be published in one issue of the *Trademarks 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
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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 Trademarks Journal and will report the advertisement to you when it occurs. If the application is opposed, the Trademarks Opposition Board will notify our office in writing.
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...and when

The application should appear in the Journal about four to eight weeks after it is approved.
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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, in most cases, 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
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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.

4. Registration/Allowance

If the application is not opposed, it will now be eligible for registration. If the application was filed prior to June 17, 2019, payment of a \$200 registration fee is required for the mark to be registered. If the application was filed after June 17, 2019, no registration fee is payable and the certificate of registration will be issued automatically.

How our office will be notified
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If the application was filed prior to June 17, 2019, 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. If the application was filed after June 17, 2019, our office will receive a notice that the
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certificate of registration is available for download.
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...and when

If the application was not opposed, the notice of allowance or registration should be mailed to our office three months after appearing in the Journal. The certificate of registration should be available for download within one week after payment of any registration fee.

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

Or by contacting:

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