

INFORMATION SHEET

Obtaining trade-mark protection

Preliminary considerations. A trade-mark is a word, logo, label or other device that is used to distinguish the wares or services of one from the wares or services of others. A trade-mark registration may be applied for in simple block letters or in design form. The Canadian *Trade-marks Act* ("Act") defines "trade-mark" as a mark that is used by a person for the purpose of distinguishing or so as to distinguish wares or services manufactured, sold, leased, hired or performed by him or her from those manufactured, sold, leased, hired or performed by others; a certification mark; a distinguishing guise; or a proposed trade-mark.

A certification mark is a mark that is used for the purpose of distinguishing wares or services that are of a defined standard as specified by the certification mark owner.

A distinguishing guise is defined as a shaping of wares or their containers or to their mode of wrapping or packaging in such a manner that the appearance serves to distinguish the wares or services of the owner of the distinguishing guise from those of others.

A proposed trade-mark is a trade-mark that is intended to be used in Canada, but that has not been so used as of the date of filing of the application.

Although an unregistered trade-mark may be enforceable at common law in an action for passing off, there are significant advantages available to the trade-mark owner if he or she can register his or her mark. Some of the more important advantages are as follows.

First, registration of the trade-mark gives to the trade-mark owner the exclusive right to use the mark throughout Canada. That right is infringed by anyone who uses the same or a confusing trade-mark or trade name. A registered trade-

mark can even be relied upon to restrain the use of a confusing corporate name. Without a trade-mark registration, the only remedy available to the owner of a corporate name, trade name or unregistered trade-mark who is concerned about the use of a confusing trade-mark or trade name by another is an action for passing off. An action for passing off will fail unless the owner of the corporate name, trade name or unregistered trade-mark can establish that it has a reputation in its mark or name in the same area where the defendant is doing business. In contrast, the owner of a registered trade-mark, who does business only in, for example, Halifax, can, notwithstanding an inability to prove reputation beyond Halifax, restrain the use of a confusing trade-mark or trade name in Vancouver. Because of the exclusive right that is conferred by a trade-mark registration, it is always advisable to carry out a search of the Trade-marks Office records before adopting a new trade-mark or trade name.

Second, by registering your trade-mark, the mark is recorded in the public records of the Trade-marks Office. As a result, your registered mark would come to the attention of any other party who is considering using a similar mark and anyone who conducts a search of the Trade-marks Office records.

Finally, Canada is a member of the International Convention for the Protection of Industrial Property under which registration of a trade-mark in Canada facilitates the ability to obtain a corresponding registration in other countries that adhere to the Convention. The International Convention also provides that, in the event corresponding foreign applications are filed within six months of the date of filing of the Canadian application, the foreign applications will be treated as having been filed on the same day as the Canadian application.

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Registrable trade-marks. Not all trade-marks are necessarily registrable. Thus, registration of a mark may be objected to if the mark is held to be primarily merely the name or surname of an individual who is living or who has died within the preceding 30 years; if the mark is held to be either clearly descriptive or deceptively misdescriptive (in the English or French languages) of the character or quality of the wares or services of the trade-mark applicant; if the mark is held to be the name (in any language) of the wares or services of the trade-mark applicant; if the mark is held to be confusing with a previously used or registered trade-mark or trade name; or if the mark is held to be a mark, the adoption of which is prohibited either because it is a public mark or because it is a mark which, through ordinary commercial usage, has become recognized in Canada as designating the kind, quality, quantity, destination, value, place of origin or date of production of any wares or services in respect of which registration is being sought.

Searches. We strongly recommend that a preliminary registrability search of at least the Trade-marks Office records be conducted prior to the filing of an application for registration, in order to locate any confusing trade-marks that may be the subject of prior registrations or applications filed by others. In order to conduct such a search, we must be advised of the particulars of the trade-mark. It is also necessary to provide us with a list of the goods and/or services with which the trade-mark will be used. Often such a search should be extended to cover possible conflicting prior uses in Canada by conducting a common law search as well.

Applications to register. In order to prepare a trade-mark application we need to know several details, including the full name and post office address of the applicant. If the mark is in design form, we also need one copy of an accurate rendition of the trade-mark in respect of which registration is to be sought. This is used to prepare formal drawings. While a specimen of the trade-mark as actually used is not normally required, the Registrar may require such a specimen upon written notice to the applicant.

We also need an accurate description of the specific wares and/or services in respect of

which trade-mark protection is required. If the mark has been used in association with any of the wares and/or services, we need to know the first date in Canada that the mark was so used in association with each class of wares and services. If there is any uncertainty, we should be provided with a conservative date of first use in Canada as it is important not to claim a date earlier than when use commenced. Similarly, if the mark has been used in Canada, proposed use in Canada should not be claimed.

If an assignment needs to be recorded, we require a photocopy of the assignment.

After filing. An Examiner, acting on behalf of the Registrar of Trade-marks, reviews the trade-mark applications, in order to ensure that there has been technical compliance with the requirements of the Act. The Examiner also carries out a search with a view to ensuring that the mark is not confusing with any prior registrations or pending applications that have either an earlier priority date or an earlier date of first use.

Assuming that the Examiner does not raise any insurmountable objections, the mark is then published in the Trade-marks Journal. Upon publication, any person may oppose registration of the mark by filing a Statement of Opposition. In Canada, opposition or a request for a three-month extension of time must be filed within two months of the Canadian publication date. If the applicant wishes to resist the opposition, it files a Counterstatement. Thereafter, both parties have an opportunity to file affidavit evidence. If necessary, the Registrar will permit cross-examination on the affidavits. Once evidence is closed, the parties file written arguments and there is an opportunity for an oral hearing. The Registrar's decision in the opposition may be appealed by either party to the Federal Court of Canada. In general, though, relatively few applications are opposed.

Allowance. A trade-mark application is allowed if there is no successful opposition. Upon payment of a registration fee, a certificate of registration is issued automatically, if the application was based on use of the trade-mark or on a foreign registration. If the application was based on the applicant's intent to use the

trade-mark, registration will not occur until actual use of the mark has commenced in Canada (and a declaration of use has been filed, together with the registration fee).

Term of registration. If an application for registration of a trade-mark does not run into difficulty at the examination stage, and if it is not opposed following publication, registration is obtained and the registration lasts for 15 years, subject to the mark being cancelled due to

nonuse. The registration is renewable for successive 15-year terms. Registration of a United States trade-mark is for a term of 10 years with renewal for similar periods.

If a registered trade-mark is infringed or passing off occurs, various remedies may be awarded, including a pre-trial and permanent injunction, damages or profits, customs detention orders, delivery up or destruction of infringing goods and payment of legal fees.