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In any case.

TRADE-MARKS GUIDE

PART 1 – REGISTERING A TRADE-MARK

David R. Canton
Barrister, Solicitor and Trade-mark Agent

Harrison Pensa LLP
450 Talbot Street, P.O. Box 3237
London, Ontario
N6A 4K3

(519) 661-6776
dcanton@harrisonpensa.com
www.canton.elegal.ca
www.harrisonpensa.com
www.davidcanton.tel

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This is a guide to issues to be considered before registering a trade-mark. This is a non-exhaustive guide, not specific legal advice. Please consult your lawyer for up-to-date information, any issues not addressed herein, and advice for your specific situation.

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BENEFITS OF A REGISTERED TRADE-MARK

A trade-mark identifies the source and quality of the wares and services it is used with and distinguishes them from the wares and services of the competition. Registering a trade-mark offers protection for your brand.

A registered trade-mark gives the owner an exclusive right to use the trade-mark throughout Canada for the wares or services described in the registration.

Without registering a trade-mark, protection is limited to the geographic region within which one has developed goodwill or reputation for the trade-mark. A registered trade-mark is easier to enforce against infringers. It also makes proof of ownership easier in any court proceedings against others who use your trade-mark without permission. A registered trade-mark also adds credibility in the marketplace.

You should register a trade-mark if you:

- plan on using the trade-mark for some time;
- intend to spend substantial effort and money marketing or advertising the trade-mark; or
- wish to increase credibility or market image.

WHAT CAN BE TRADE-MARKED

Trade-mark registrations can be made for words (e.g. a product name such as Dell), slogans (e.g. Microsoft's "Where do you want to go today"), designs (e.g. the McDonalds golden arches), or combinations of those (e.g. the Ford blue oval). If the trade-mark is a design, it must be filed as a black and white tiff file of under one meg.

STRONG VS. WEAK TRADE-MARKS

Good trade-marks or brands need to be memorable, not descriptive. Unfortunately trade-marks that describe their product or service are the first thing most people think to use for their own brands. The thought process is: "how else is anyone going to know what my brand/product/service is?" The right thought process is: "how can I make people remember my brand/product/service?"

From a legal perspective, one can't have a trade-mark that is "...clearly descriptive or deceptively misdescriptive...of the character or quality of the wares or services...or of their place of origin". (Section 12(1)(b) of the Trade-marks Act.)

If a trade-mark is descriptive, it is considered "weak", in that it does not do a good job of distinguishing the company's wares or services from similar wares and services of competitors.

The right approach is to have trade-marks that people easily remember, and distinguish your wares or services from the competition - not ones that describe your product.

TRADE-MARKS CAN'T BE CONFUSING

A trade-mark cannot be registered if it is confusing with an existing registered trade-mark. It is possible for the same mark to be registered by different people, so long as the uses are different. This is a rather subjective area. It is not always easy to know how much of a difference is acceptable. And to make it more complex, famous trade-marks are given protection beyond their actual registered uses.

Even if a trade-mark can be registered, the trade-mark can still be challenged later if it is confusing with an unregistered trade-mark of another, or a trade-name of another.

For those reasons, it is important to search to lessen the risks that a proposed mark is confusing with existing registered or unregistered trade-marks.

SEARCH STRATEGIES

Searching to determine trade-mark registrability can be complex and somewhat subjective. It's best to seek advice from a lawyer or trade-mark agent before adopting trade-marks - but one can conduct their own preliminary "knock-out" searches.

Keep in mind that trade-marks are considered confusing if they sound alike or look alike. For example, "phone" is confusing with "fone". Searches must be done with that in mind.

The first step is to do an internet search on a proposed trade-mark. While a trade-mark registration opinion cannot be based on just a Google search, it's a quick and easy way to eliminate obvious confusing trade-marks.

And if an internet search shows a relatively small number of hits, it's a good indication that the trade-mark may be distinctive and strong.

If the proposed trade-mark survives that stage, the next step is to search the Canadian trade-mark registry. If the product will be sold outside of Canada, it's a good idea to search in those other countries too, even if you don't plan on immediately registering there.

The CIPO (Canadian Intellectual Property Office) trade-marks database is at:

<http://www.ic.gc.ca/app/opic-cipo/trdmrks/srch/tmSrch.do?lang=eng>

The USPTO (United States Patent and Trademarks Office) trade-marks database is at:

<http://tess2.uspto.gov/bin/gate.exe?f=tess&state=4004:evm303.1.1>

If a proposed trade-mark survives those steps, a trade-mark agent will generally recommend that a complete formal search be obtained. Such a search is done by a professional search house, and covers registered and non-registered uses. If the trade-mark has been in use for a long time, there may be less need for a formal search.

USE DESCRIPTIONS

When filing a trade-mark, its uses must be described. This means that the wares and services the trade-mark will be used with, and protected for, must be listed on the application. The way the wares and services must be described is very technical. Your trade-mark agent can turn your list of wares and services into language the trade-marks office will accept.

WHEN DOES TRADE-MARK PROTECTION BEGIN?

Trade-mark protection begins at the earlier of first use, or when the application is made. Proposed uses can be claimed – provided that actual use is started within three years of the application.

The first person to use a trade-mark is entitled to registration. If however someone else applies for a trade-mark that is confusing with yours before you apply, an opposition proceeding or court action may be required to obtain your registration. So it is best not to delay registration.

DO I NEED A TRADE-MARK AGENT TO REGISTER A TRADE-MARK?

Anyone can register a trade-mark on their own. It's a good idea however to use a lawyer or trade-mark agent in order to get the best advice on issues such as registrability and use descriptions.

OBTAINING A TRADE-MARK IN A FOREIGN COUNTRY

A Canadian trade-mark registration does not protect the owner's rights in other countries. If a trade-mark will be used in other countries, you should apply to register the trade-mark in those specific countries in order to protect your rights.

We can assist you in registering your trade-mark in other countries. We have contacts worldwide through our Meritas affiliated firms.