

TRADEMARKS GUIDE

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This is a guide to registering and maintaining a trademark. This is a non-exhaustive guide, not specific legal advice. Please consult your lawyer for up-to-date information, any issues not addressed here, and advice for your specific situation.

This guide reflects new trademarks practices in effect since June 17, 2019. Some details may change as the Canadian Intellectual Property Office (CIPO) and practitioners get more experience with the new rules.



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INTRODUCTION

ABOUT THIS TRADEMARKS GUIDE

This guide has been developed as a resource to help our clients better understand Canada's trademark landscape.

Harrison Pensa's Technology and Privacy Law Group also produces a weekly Technology Law Blog and Newsletter to help people stay abreast of this rapidly evolving area of law.

Subscribe to this free resource at [Tech Law Weekly Signup](#).

ABOUT DAVID CANTON

David is a business lawyer and trademark agent with a practice focusing on technology issues and technology companies. He leads the Technology and Privacy Law Group at Harrison Pensa.

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David is the co-author of Legal Landmines in e-Commerce, McGraw-Hill, 2002, blogs at [Tech Law Weekly](#).

David is recognized in the Canadian Legal Lexpert Directory, a peer review of leading lawyers for Data Protection & Privacy. He is also recognized in The Best Lawyers in Canada™ editions since 2019 for Information & Technology Law, since 2020 for Privacy and Data Security Law, and since 2020 for Technology Law. David is also recognized as a recommended lawyer in Who's Who Legal: Canada 2023.



If you want to register a trademark, need other assistance with trademarks, or general advice about technology and privacy issues, contact:

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PART 1

REGISTERING A TRADEMARK

BENEFITS OF A REGISTERED TRADEMARK

A trademark identifies the source and quality of the goods and services it is used with and distinguishes them from the goods and services of others. Registering a trademark offers protection for your brand.

A registered trademark gives the owner an exclusive right to use the trademark throughout Canada for the goods and services described in the registration.

Without registering a trademark, protection is limited to the geographic region where one has developed goodwill or reputation for the trademark. A registered trademark is easier to enforce against infringers. It also makes proof of ownership easier when making a demand against an infringer and in court proceedings against an infringer. A registered trademark also adds credibility in the marketplace.

It is important to note that having a corporate name, or registering a business name or trade name, does not give any protection over that name.

You should register a trademark if you:

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

WHAT CAN BE TRADEMARKED?

Trademark registrations can be made for words (e.g. a product name such as Dell), slogans (e.g. Apple's "Think different"), logos (e.g. the McDonalds golden arches), or combinations of those (e.g. the Ford blue oval). The 2019 law expanded what can be registered to include "... a word, a personal name, a design, a letter, a numeral, a colour, a figurative element, a three-dimensional shape, a hologram, a moving image, a mode of packaging goods, a sound, a scent, a taste, a texture and the positioning of a sign".

Applicants are required to file evidence of distinctiveness in order to register certain types of marks. This means proving that the marketplace (a) is aware of the mark and (b) associates the mark with your product or service. Providing proof of distinctiveness can significantly increase the cost of a trademark application.

DISTINCTIVE TRADEMARKS



STRONG VS. WEAK TRADEMARKS

Trademarks are best if they are memorable. After all, the goal of a trademark is to set your goods and services apart from those of your competitors in the minds of customers.

Unfortunately, trademarks that describe their product are often the first thing many people think to use for their brands.

The question to ask is “How can I make people remember my brand and product?” not “How is everyone going to know what my product is?”

Indeed, the Trademarks Act says one cannot register a trademark that is “... clearly descriptive or deceptively misdescriptive ... of the character or quality of the goods or services ... or of their place of origin.”

The 2019 trademark reforms put a heightened emphasis on the need for a trademark to be distinctive. Examiners can now reject a trademark application if they believe it is not distinctive. Distinctiveness means the mark is something unique that others selling the same product or service might not think to use as a brand.

In some cases, one can get around this if acquired distinctiveness can be shown — meaning showing proof of long use and public awareness. But that isn’t a place you want to go if you don’t have to.

Using the words as part of a design can be helpful, but it does not always solve the problem.

Strong, distinctive marks are more likely to be registrable, more recognizable by the public, do a better job of distinguishing your products from your competitors, and easier to enforce against competitors.

The best way to understand strong vs weak marks and the concept of distinctiveness is to think of it as a continuum with a weak descriptive unregistrable mark on one end, and a strong distinctive mark on the other.

TRADEMARKS CAN'T BE CONFUSING

A trademark cannot be registered if it is confusing with an existing registered trademark. It is possible for the same mark to be registered by different people, so long as the uses are different. The confusion test is rather subjective. It is not always easy to know how much of a difference is acceptable. And to make it more complex, famous trademarks are given protection beyond their actual registered uses. It is considered confusing if the two marks are similar enough to confuse the two. Or if the products or services are close enough that someone might think one trademark owner might provide the goods or services listed for the other.

Even if a trademark can be registered, the trademark can still be challenged later if it is confusing with someone else's unregistered trademark or trade-name.

Prior to choosing a trademark it is important to search to reduce the risks that a proposed mark is confusing with existing registered or unregistered trademarks.

SEARCH STRATEGIES

Searching to determine trademark registrability can be complex and somewhat subjective. It is best to seek advice from a lawyer or trademark agent before adopting trademarks — but you can conduct your own preliminary “knock-out” searches to see if there are any obvious existing conflicting marks.

Keep in mind that trademarks are considered confusing if they sound alike or look alike. For example, “phone” is confusing with “fone”.

The first step is to do an internet search on a proposed trademark. While a trademark registration opinion can't be based on just a Google search, it's a quick and easy way to eliminate obvious confusing trademarks.

If an internet search shows a relatively small number of hits, it's a good indication that the trademark may be distinctive and strong.

If the proposed trademark survives that stage, the next step is to search the Canadian trademark 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.

[CLICK HERE FOR THE CIPO TRADEMARKS DATABASE](#)

If a proposed trademark survives those steps, a trademark agent will generally want to do that search themselves to make sure, and may recommend doing a more complete formal search. Such a search is done by a professional search house, and covers registered marks, and unregistered sources such as domain names and business directories. If the trademark has been in use for a long time, or the goods and services are unique and the applicant knows their competitors well, there may be less need for a formal search.

USE DESCRIPTIONS

A trademark application must list the goods and services the trademark will be used with and protected for. The goods and services must be described and classified in a very technical way. For example, uses must be grouped in classes according to the Nice Classification system that classifies goods and services into 45 different classes.

Registration fees are based on the number of classes you are registering for, so while it is best to make sure the use describes everything you expect the trademark will be used for, attention should be paid to try not to end up with more classes than needed. Your trademark agent can recommend language that will be acceptable to the trademarks office and will give your mark the widest possible protection.

In the event that the CIPO examiner determines that your application requires additional classes, you must pay the extra class fees in order to proceed with registration. You do not have the option to drop goods and services from your application in order to avoid the extra fees.

THE APPLICATION PROCESS

After searching is done and the application is drafted, it is filed with CIPO. A CIPO examiner will review the application and will either approve it, or provide comments on the use description, classes, confusion with other marks, or other technical requirements. CIPO is currently reviewing applications 19 months after filing if the use description is from their pre-approved use list. If the examiner has issues with the application, there may be a quick and simple fix, or they may be difficult to overcome.

Once approved, the trademark is published in the trademarks journal, giving others a 60 day period to oppose it. If not opposed, the trademark registration is final, and a certificate will be issued.

WHEN DOES TRADEMARK PROTECTION BEGIN?

Trademark protection begins at the earlier of first use, or when the application is submitted.

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

Trademark registrations are valid for 10 years and can be renewed for additional 10-year periods.

DO I NEED A TRADEMARK AGENT TO REGISTER A TRADEMARK?

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

OBTAINING A TRADEMARK IN A FOREIGN COUNTRY

A Canadian trademark registration does not protect the owner's rights in other countries. If a trademark will be used in other countries, you should apply to register the trademark in those specific countries to protect your rights. If enough countries are required, there is a procedure called the Madrid Protocol that streamlines the process somewhat.

We can assist in registering trademarks in other countries.

PART 2

AFTER REGISTRATION

IDENTIFYING THE TRADEMARK

The law does not require a trademark symbol to be used with a trademark. A symbol should be used, however, as it may dissuade others from using the trademark improperly for their product or service.

For a registered trademark, use “®” beside the trademark. Where practical, insert text, such as “® Registered trademark of Harrison Pensa LLP.”

When a trademark is not registered, use “TM” beside the trademark. Where practical, insert text such as “TM Trademark of Harrison Pensa LLP.” The ® symbol should not be used if the trademark is not registered.

The “TM” symbol can be used whether the trademark is registered or not.

A trademark symbol — such as ® or TM — acts as a warning to others that a monopoly on the use of the trademark is being claimed in conjunction with that particular good or service.

If your trademark is a design mark, rather than a word mark, copyright notices can also be used for protection (in addition to, but not instead of, a trademark legend), such as “© copyright 2021 Harrison Pensa LLP. All rights reserved”.

If you use the same label or advertising in both Canada and the United States, it is important to consider the status and marking requirements of the trademark in both countries. In the United States, the ® symbol should not be used if the trademark has not been registered there. Once a trademark is registered in the U.S., the trademark owner must give notice (e.g. by using the ® symbol) to recover profits or damages in an infringement action.

USE IT OR LOSE IT

The concept of “use” is key to trademark rights. The Trademarks Act is based on the acquisition of trademark rights through use of the trademark.

If regular use is not made of a trademark, it is vulnerable to cancellation. If “use” has not occurred within the last 3 years, others can take procedures to expunge the registration for the unused uses. Don’t let long periods pass between uses of your trademarks for the goods and services listed in its registration. Be sure to keep records and samples of use with the goods and services listed on the use description along with proof of timing. That includes pictures of packages and ads, screenshots of websites, proof of sales in various provinces, and proof of when labels were purchased.

PROPER USE OF A TRADEMARK

Properly used, a trademark can be protected indefinitely. A trademark may however become worthless or fall into generic use through improper use. If a trademark becomes a generic term the mark loses its protected status and may be used by anyone, including your competition.

Despite being distinct when a trademark is first registered, a trademark is vulnerable to losing its distinctiveness post-registration. Distinctiveness must be maintained to ensure a long life for a trademark.

“Distinctive” means a trademark that actually distinguishes the goods or services of the owner from the goods or services of others.

Think it can’t happen to you? Nylon, Escalator, Shredded Wheat and Yo-Yo were once trademarks that have become generic product terms.

THE DEFINITION OF USE

The law defines “use” for trademark purposes much more narrowly than you might think. For example, putting your logo on your building, while certainly a good thing to do, is not considered use for trademark purposes.

Place the trademark directly on the subject goods wherever possible, or on the container or packaging in which the goods are sold. Use of a trademark when advertising goods, but not on the product or packaging, is not sufficient to preserve trademark rights.

“Use” with goods

A trademark is deemed to be used in association with goods if, at the time of the transfer of the property in or possession of the goods, in the normal course of trade, it is marked on the goods themselves or on the packages in which they are distributed or it is in any other manner so associated with the goods that notice of the association is then given to the person to whom the property or possession is transferred.

“Use” with services

A trademark is deemed to be used in association with the services if it is used or displayed in the performance or advertising of those services.

TIPS ON USING YOUR TRADEMARK PROPERLY

None of the misuses described below will instantly result in the loss of a registered trademark, but continued misuse of a trademark may ultimately result in its loss.

- Use a trademark exactly as it is registered and shown on the Certificate of Registration. Variations can render a trademark invalid and subject to expungement.
- Never use a trademark as a noun. Use a trademark in conjunction with the generic description of the product. This will prevent confusion by distinguishing the trademark from the product.

For example:

Correct ⇒ ARM & HAMMER brand baking soda

Incorrect ⇒ ARM & HAMMER

- Never use your trademark as a verb. This prevents confusion by distinguishing the trademark from what the product is or service does.

For example:

Correct ⇒ ARM & HAMMER baking soda to get rid of refrigerator odours

Incorrect ⇒ ARM & HAMMER your refrigerator odours

- Never use the trademark as a possessive noun.

For example:

Correct ⇒ The new formula in GERBER baby food is healthier for babies

Incorrect ⇒ GERBER's new formula is healthier for babies

- Never let non-trademark matter appear to form part of the trademark.

For example:

Correct ⇒ GERBER baby formula

Incorrect ⇒ GERBER BABY FORMULA

- Never make a trademark plural when it is singular, or vice versa.

For example:

Correct ⇒ Buy 4 boxes of ARM & HAMMER baking soda

Incorrect ⇒ Buy 4 ARM & HAMMERS

- If someone else uses your trademark with your permission, make sure it is used with proper trademark credits, and make sure you grant them permission in writing on terms under which you retain control.
- If you use another's trademark, make sure you obtain permission from the owner to avoid potential liability for trademark infringement.
- Emphasize your trademark graphically: Use capitals, italics, different fonts, colours or type sizes to distinguish your trademark from other text.

For example:

Buy ⇒ GERBER baby formula

Buy ⇒ *gerber* baby formula

Buy ⇒ *gerber* baby formula

- If colour has been claimed as part of the trademark registration, it is best to stick with that colour.
- Keep samples of your trademark's use and advertising over time in case you need to take legal action or defend a lawsuit.
- Monitor the marketplace, your competition, the media, and your staff for improper or unauthorized use of your trademark. You may also want to keep tabs on trade journals, advertisements, and the Internet.
- Consider obtaining your trademark as an Internet domain name. An Internet domain resolving to web pages including the trademark helps establish use of the trademark.

KEEP STAFF INFORMED

Instruct your staff on proper trademark use.

Develop trademark guidelines outlining the appropriate use and forms of your trademarks. These guidelines should be provided to your employees, especially your marketing department, and to any licensed users.

It may be useful to periodically perform a trademark audit within your business to ensure your trademark is being used properly.

ASSIGNING OR LICENSING TRADEMARKS

Assigning and licensing trademarks are two ways by which individuals or companies can profit from their trademarks.

If another person or business will use your trademark, even if it is a company related to the trademark registrant, a formal agreement should be signed.

The process of assigning or licensing a trademark can be complex. To make sure your rights are protected, contact us for advice, or to draft documents.

When a trademark is used under a license, notice of that fact should be indicated. For example, if possible, insert text such as “XYZ is a registered trademark of Acme Canada Inc. Used under license.”

TRADEMARK CHANGES

Altering the appearance of a registered mark can result in loss of protection. Whenever you wish to modify your trademark or the goods or services it is used in conjunction with, contact us. If necessary, we can submit a new application to CIPO reflecting the modified trademark and/or its new use.

A trademark registration should always reflect all goods and services used in association with the trademark.

Changes in your corporate name or address should be registered with CIPO.

An assignment is the sale of your ownership in a trademark. Assignments should be in writing. Any change in ownership of a trademark should be registered with CIPO.

Licensing a trademark gives someone else a right to use the trademark, while the owner maintains the ownership to the trademark. A fee or royalty may be charged for granting someone a license to use the trademark, or it may simply authorize use in conjunction with the sale of the owner's goods or services. Licensing agreements will also set out limitations on the other party's ability to use the trademark.

Registered trademarks must be renewed within 10 years of its initial registration. There is no limit to the number of renewals. It is your responsibility to renew on time.

TRADEMARK INFRINGEMENT

Trademark infringement occurs when someone uses your trademark (or one confusingly similar to it) without your consent for similar goods or services. CIPO does not police or prevent other people's use of your trademark. It is up to you, as the owner of the trademark, to ensure that no one else uses it. You should watch for trademarks that could be confused with yours.

Trademark watch services are available both in Canada and internationally.

If you are concerned that someone has infringed your trademark, you should contact us as soon as possible. Failure to stop others from using your mark can result in the loss of your mark. If the infringement is proven, a court could order the guilty party to stop using your trademark and to pay compensation.

WHEN OTHERS MAY USE YOUR TRADEMARK WITHOUT INFRINGING

- Comparative advertising of goods using someone else's trademark is risky and should be approached with caution. Other parties may advertise in a comparative fashion using your trademark in association with goods, but never on packaging, labelling, or point-of-purchase material.

For example

PEPSI has only half the calories of COKE.

- Comparative advertising of services is not allowed.
- Compatible product statements or replacement part statements made on product packaging or in point-of-purchase material is likely acceptable — even where the competitor's trademark is used — provided the trademark of another is used only to inform the public about the capability of the product to be used in association with another product. The reference to RCA in the example below is not meant to trade off the goodwill of RCA, but merely to inform the consumer of the ability of ABC remote to be used in association with a non-competitive product.

For example

ABC remote can be used with all RCA® televisions.

- A registered trademark only provides you with the exclusive right to use the trademark in Canada in conjunction with the goods or services it has been registered to identify. Different people can use the same trademark for different goods and services. Uses are only protected if they are described in the trademark registration.

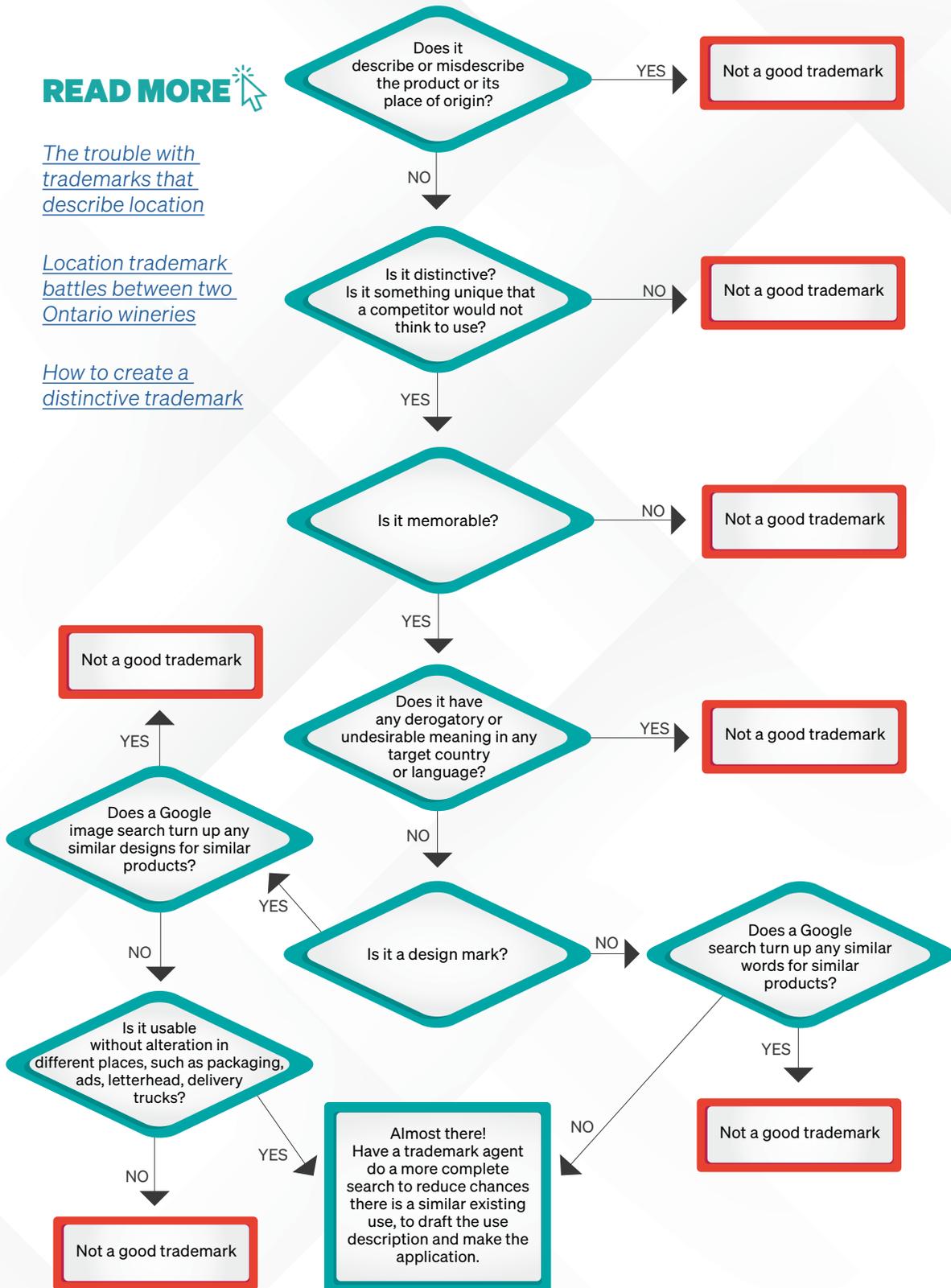
Process to create a strong TRADEMARK

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[The trouble with trademarks that describe location](#)

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