



## TEST YOUR IP KNOWLEDGE

1. Five years ago, I acted on an Asset purchase. Several trade-marks were transferred, but the vendor retained one mark for his remaining operation. We attempted to register the change in ownership, but The Trade-Marks Office refused saying the transferred marks are "associated". Isn't the TM Office required to honour transfers of TMs?

NO. "Associated" trade-marks must be owned by the same owner. Usually, "associated marks" are confusingly similar and would otherwise not be registrable. It is permissible to register confusingly similar trade-marks if they are owned by the same party.

2. My client has owned and operated a restaurant for twenty years. He received a letter from a trade-mark owner demanding that he change the name of his restaurant. The trade-mark registration is only 5 years old. Doesn't my client have recourse based on his longstanding use?

NO. The limitation period for attacking a trade-mark registration based on prior use is three years.

3. My client is in the midst of franchising his clothing store operation. He's been in business for four years as "Tags & Togs". This week he got a call from somebody in Muskoka who has apparently been using the same name. There is no corporate name registration, no business name registration and certainly no trade-mark. Is this a problem?

YES. If this franchisor attempts to register a trade-mark now, the person with prior use may oppose the application taking 2-3 years or more to reach a conclusion. Few businesses can tolerate that kind of uncertainty. Anyone considering a franchise operation ought seek a trade-mark registration before offering franchises.

4. My client owns a bar and has a licence from Big Boxing Productions (USA) Inc. to show live boxing matches. A competitor down the street started showing the matches, too, but doesn't have a licence. Apparently Big Boxing doesn't care. The licensee rights are non-exclusive for Ontario. Can he sue the bar?

NO, not successfully. Only exclusive licensees have a right to sue. Your client will need to join Big Boxing to the lawsuit to enforce the rights, if they will do so.

5. A colleague told me that copyright royalties are payable for music on hold – is that true?

YES. SOCAN (Society of Composers, Authors and Music Publishers of Canada) collects royalties for music on hold and a wide variety of other uses.

6. My client is an artist. Someone has copied one of his drawings and printed it on t-shirts. He has no copyright registration. Is he able to sue successfully?

YES. It is not necessary to register copyright in order to enforce it. However, there are advantages to registration that make enforcement easier.





7. My client is in the furniture making business. He has come up with a unique design for an armchair and wants to protect it. Is this covered by a patent registration in Canada?

NO. In Canada, this is an industrial design registration, a unique breed of IP that is a hybrid of copyright and patent protection. The equivalent protection in the United States is called a 'design patent'.