



## Trademark FAQs

### **What are the grounds for registering a trade-mark?**

Trade-marks may be registered on the basis of:

- (1) proposed use in Canada
- (2) use in Canada
- (3) registration and use in another country, or
- (4) 'making known' – that is, a mark used in another country, but is 'made known' in Canada through advertising and public reputation. Example: MTV.

### **What if a competitor files an application for the same mark, but I used it first?**

As between competing applications, the earliest use will always take priority. If a competitor files an application first, however, you must file an 'opposition' to challenge them. If you do not file an opposition, the competitor's mark will proceed to registration. Your only remedy will be to challenge the mark in court, an expensive and time-consuming process.

### **What is the purpose of searches?**

The purpose of the report is to locate any 'confusingly similar' trade-marks that may pose a risk to your trade-mark application. We also search for 'common law' trade-marks such as incorporations, trade-names and domain names, to identify potential opponents to your application.

### **Why do you look for 'common law' uses?**

Businesses acquire some legal rights by building a reputation. Those rights can usurp your trade-mark application if the two marks are 'confusingly similar' and if the other party can prove that they used it first.

### **Can I use a famous trade-mark in a different industry?**

Some trade-marks are so well-known that their sheer fame acts as a barrier against other registrations of those marks. These marks are so famous that use of them with any product or service would suggest a relationship to those well-known companies. Examples included: Xerox, Kodak, Kleenex, Coke and Microsoft.

### **Who can stop my Trade-mark from being registered?**

"Opponents" and Trade-mark Office "Examiners".

### **Who can be an opponent?**

Anyone can be an opponent. 'Opponents' may challenge your application on the basis of their own registered trade-marks, or their unregistered use of a 'confusingly similar' trade-mark, or on other technical grounds. 'Opposition' is much like a lawsuit and can be very costly.

### **How do potential opponents find out about my application?**

Your TM application will be 'advertised' in the *Canadian Trade-marks Journal* to give notice to third parties who may wish to oppose your application. People can also search the TM database for information about pending TM applications.



### **What does a TM Office examiner do?**

An "examiner" checks your TM application to ensure it meets the standards set out in the *Trade-marks Act*. The examiner also checks the Canadian TM database for confusingly similar trade-marks.

### **When does the Trade-Marks Office refuse Trade-marks?**

Registration of a trade-mark may be refused if:

- (1) It is "primarily merely" the name or the surname of an individual who is living or who has died within the preceding thirty years;
- (2) whether depicted, written or sounded, the mark is either clearly descriptive or deceptively misdescriptive of the character or quality of the wares or services;
- (3) it is the name in any language of the wares or services;
- (4) it is confusing with a registered trademark; or
- (5) the mark has been previously used or made known in Canada by any other person. ("Made known" refers to a trade-mark that is used in a country other than Canada but is well-known in Canada by way of cross-border advertising.)

### **What does 'clearly descriptive' mean?**

'Clearly descriptive' refers to elements of a trade-mark that

- a) describe the character or quality of the wares or services. Ex. "Greenacres Bakery" or "Abigail's Fashion Boutique"
- b) describe the function or result of using the wares or services. Ex. "Gro-Pup" for dog food or "Shiny Clean Car Wash", or
- c) laud the merits or superiority of the wares, such as *Superior, Excellent, Quality, Best, Ultra, Super, Perfect*.

### **Can I still register my mark if it is clearly descriptive?**

The trade-mark as a whole may still be registrable if the clearly descriptive words elements are *disclaimed*. There must be a distinctive feature, a graphic for instance or non-descriptive words, which would make the mark as a whole acceptable for registration. For example, "Greenacres Bakery" would be acceptable for registration provided that the word 'Bakery' is disclaimed.

### **What's a 'disclaimer'?**

If any part of a trade-mark offends the TM Act, the applicant may 'disclaim' that part of the mark. To 'disclaim', means to agree that other parties may use that part of the mark. For example "Smith's Rainbow Landscaping" would require a disclaimer of both "Smith's" (a surname) and "Landscaping" (clearly descriptive).

### **What impact does a disclaimer have on my mark?**

The more of the mark you disclaim, however, the 'weaker' your trade-mark becomes i.e. the more limited protection your trade-mark affords.

### **When are trade-marks 'confusing'?**



Trade-marks need not be identical to another to be refused; the two marks need only be 'confusingly similar'. The following items are considered in determining whether two marks are 'confusingly similar':

- (a) the inherent distinctiveness of the trade-mark and the extent to which they have become known;
- (b) the length of time the marks have been in use;
- (c) the nature of wares, services or business;
- (d) the nature of the trade; and
- (e) the degree of resemblance between the marks in appearance or sound or in the ideas suggested by them.

The TMO considers the 'first impression' made by a mark and looks at the mark as a whole, as opposed to its separate parts.

### **How long does my trade-mark registration last?**

Fifteen years. You may renew your registration at the end of each fifteen year term upon payment of a fee (currently \$300.00). You have to use your trade-mark, however, or you are vulnerable to losing it before it expires.

### **Once my trade-mark is registered, am I safe from attack?**

Not entirely. Your trade-mark is always vulnerable to attack by a third party on the ground that:

- (1) You haven't used it. If you allow three years to pass without using the mark it is vulnerable to 'expungement' proceedings, whereby you have to prove you've used the mark within the last three years, or lose the registration; or
- (2) The trade-mark was not registrable in the first place (see "When does the Trade-Marks Office Refuse Trade-marks?" on page 5). Five years after registration, however, no one can challenge your registration based on their prior use.

### **How much does it cost to register a trade-mark?**

The total cost of a single trade-mark application is approximately \$2,200 for a simple word mark, provided that no "opposition" to your application. If the trade-mark includes a logo, the cost is approximately \$2,500.

"Oppositions" are third party challenges to your trade-mark application. Fees are charged hourly and the process is similar to the conduct of a lawsuit.