


TRADEMARK INFORMATION

Cameron IP

Intellectual Property Law

Suite 1401 - 1166 Alberni Street

Vancouver, B.C., Canada V6E 3Z3

Tel: (604) 688-6442

Fax: (604) 688-6445

Email: info@CameronIP.com

1

What is a Trademark?

A trademark is a word or design used by a business to distinguish its goods or services from those of competitors.

There are two types of trademarks. Word marks are words, letters, numbers or combinations of them. Design marks are words written in a special style such as the **COCA COLA** design, pure designs without words, such as the Mercedes-Benz star, or a combination of words and designs.

How do you get a Trademark?

The first step is to choose a suitable word or design to identify the goods or services. Trademark rights to the word or design are acquired by applying to register the trademark or by commencing use of the trademark. Unlike corporate names, it is not possible to reserve a trademark. There is always some risk that someone else will claim prior rights to a trademark after an application is filed or after use has started.

Are there any Restrictions on Choosing a Trademark?

The Trademarks Office will not register a trademark which is confusing with a registered trademark or with a trademark in another application having priority. The application with the earliest date, either the filing date or the date of first use, has priority. Use of a trademark confusing with a registered mark may make the user liable for damages if legal action is taken for trademark infringement.

In addition, if registration of a trademark is desired, it must not be clearly descriptive of the goods or services it identifies. An example of a clearly descriptive mark is **SUPERWASH** to identify woolen goods. On the other hand, trademarks may be registered if they are merely suggestive of the goods and services. An example is **WATER WOOL** for woolen goods. The assistance of an experienced trademark agent is usually needed to decide whether a mark is clearly descriptive or not.

A trademark normally cannot be registered if it is nothing more than a surname. An example is **JONES** to identify wine. However **ELDERS** may be registered for wine because, while it is a surname, it has another meaning.

Clearly descriptive trademarks or surnames may be registered after a period of extensive use. An example is the trademark **MCDONALDS**.

There are other marks which cannot be registered such as the name of the goods or services in any language, various flags, coats of arms and marks confusing with marks adopted by public authorities. A trademark agent should therefore be consulted before deciding on a mark.

What Makes Strong or Weak Trademarks?

The strength of a trademark is related to a factor called "distinctiveness". A trademark is not very distinctive, and is therefore a weak one, if it is descriptive of the goods or services, a surname, initials or constitutes words commonly used in conjunction with the goods or services. Adopting unconventional spelling of words usually doesn't help. Such marks make little impact on the mind of the consumer and therefore do not adequately direct him or her to goods or services of one person rather than competitors. However, such marks can become distinctive, and therefore valuable, by extensive use and advertising.

The most distinctive type of trademark is an arbitrary word without meaning such as **KODAK**. Such trademarks become strongest after extensive usage. Use of such marks by others on any goods or services likely would be trademark infringement.

However, many trademark owners do not like arbitrary or meaningless words because they initially create no favourable impression in the mind of the consumer. This may be very important from a marketing point of view, at least until a mark becomes well known. For this reason, the best compromise is usually a trademark which suggests some favourable characteristic of the product or service but does not clearly describe it.

How can a Business Avoid Adopting a Trademark which is Confusing with Another Trademark?

The best way to try to avoid conflicts with earlier trademarks is to have a trademark search done. An experienced registered trademark agent can offer preliminary advice before doing the search. It may be advisable to have a few alternative trademarks ready.

After the search is done, the agent gives an opinion as to whether or not the trademark appears to be available for registration. It may take considerable experience to decide whether a trademark is confusing with one found in the search, particularly if the marks are similar and their goods or services are also similar. Search results are not completely reliable though. There is some risk that conflicts with other marks will be found later.

To start a search, the agent needs to know the trademark itself and the goods and/or services the mark identifies or will identify.

Does a Trademark have to be Registered?

No, but it is highly desirable. If a trademark is not registered and someone else begins using a similar mark, then it may be difficult to stop the infringement. Legal action for "passing off" may be commenced without a registration, but passing off is more difficult to prove than infringement of a registered trademark.

If an application to register a trademark is not filed, then someone else may register a similar trademark in the meantime, making it difficult or impossible for the original user to obtain registration later.

After a trademark has been registered for 5 years it often may be enforced against others who used the same mark earlier but didn't register it.

Notifying an infringer that a trademark is registered is often enough to stop infringement. Infringers are less likely to cease their activities because of complaints by owners of unregistered trademarks.

How is a Trademark Registered?

An application is filed by the Trademark Agent with the Canadian Trademarks Office. There are no provincial trademark registrations in Canada. People sometimes speak of registering their name in Victoria. This refers to trade names or business names and not to trademarks. Registration in Victoria confers no right to use the name as a trademark. Federal trademark laws take priority.

After the application is filed, the Trademarks Office sends a filing notice which merely acknowledges receipt of the application and gives a filing date and an application number.

A few months later, the application is reviewed by an Examiner at the Trademarks Office who conducts another search to see if there other confusing marks. If a confusing trademark is not found, and there are no other objections, such as descriptiveness or that the mark is a surname, then the trademark is approved for advertisement in the Trademarks Journal. If objections are made, then the Examiner sends an Examiner's Report listing objections to registration. A period of time, usually 4 months, is given to respond. Often an experienced trademark agent can overcome objections by presenting arguments in favour of registration of the trademark.

The Trademarks Journal is published by the Trademarks Office and lists trademarks which the Office proposes registering. Other parties then have the opportunity to oppose the registration of the published marks, usually on the grounds of prior use or registration of a similar trademark.

If an opposition is filed, which occurs in only a small percentage of cases, then the matter is decided by opposition proceedings. These are generally similar to a trial but are conducted mainly by written submissions and are much less expensive.

If no opposition is filed, then the trademark application is allowed. If the trademark was already in use at the time the application was filed, then the only remaining step is paying the registration fee. If the trademark was not in use at the time the application was filed, then it is also necessary to file a declaration stating that use of the trademark has started.

When can a Trademark Application be Filed?

An application may be filed either before or after use of a trademark starts. An application takes a minimum of one year to be approved and so trademark owners should file applications for proposed trademarks, or a few alternatives, a year or more before they plan on using the marks. Often such advanced planning is not possible, and the trademark owner then may have to change the mark if problems develop, particularly conflicts with other trademarks.

What does “use” of a Trademark Mean?

A trademark is used on goods when the mark appears on the goods, or packaging or labelling for the goods, and the goods are sold in the normal course of trade. A trademark is not used on goods when it appears in advertisements for the goods or if the sale of the goods is an isolated one or if they are distributed free.

A trademark is used on services, for example restaurants, retail stores, construction contractors or musical bands, when the mark appears in advertisements or promotional material for the services and such services are actually available at that time.

How do you Protect a Trademark in Other Countries?

Generally a separate trademark application is required in each country where protection is desired.

Canadian trademark owners should seriously consider registration of their trademarks in the United States. Otherwise, later expansion into the U.S. may be prohibited, or a change of trademark required, if the mark is later found to be unavailable there.

If registration in the U.S. is essential or desirable, then it may be advisable to do a U.S. trademark search before a Canadian search. It is generally more difficult to find an available trademark in the United States.

If the trademark appears to be available in the U.S. and Canada, then a Canadian application should be filed first. The U.S. application may be filed up to 6 months after the Canadian application and will get the filing date of the Canadian application. No use of the trademark in the United States is required to obtain registration if this procedure is followed.

Applications in other foreign countries should also be filed within 6 months of filing the Canadian application. They also get the filing date of the Canadian application under the International Convention.

Note:

This publication adopts the spelling "trademark" which is the one most widely used throughout the world. In Canada the official spelling is "trade-mark", while "trademark" is used in the U.S.

Disclaimer:

The information above is a considerable simplification of trademark laws and procedures and is not intended to be legal advice. Consult a lawyer or a registered trademark agent before deciding on any course of action. Many situations and limitations are not discussed.