



The First Step to Protecting Your Brand in Canada

Establishing and protecting your brand and goodwill is crucial to your success as you expand into Canada. One of the most important first steps is to register your trademarks with the Canadian Intellectual Property Office (CIPO).

1) Benefits of a Registration

Unregistered trademarks offer limited protection. Canadian law protects your rights in unregistered trademarks at common law, but only in a limited way. You do not own trademark rights in your business or corporate name merely because you have incorporated in Canada or have registered with a province or territory. Your U.S. trademark registrations do not generally apply in Canada, or provide a legal right to enforce your trademarks against unauthorized use in Canada.

Registration offers a number of key advantages:

- 1) Registered trademarks are enforceable nationally, regardless of whether the mark is known in a given locale. Unregistered marks only grant rights in geographic areas where your goodwill or reputation exists.
- 2) The owner of a registered trademark enjoys the sole right to use the mark across Canada in connection with the specified goods and/or services, for a period of 10 years, after which it may be automatically renewed for a fee.
- 3) Owners of registered marks may enforce claims for depreciation of goodwill - a statutory cause of action unavailable to unregistered marks. Claiming depreciation of goodwill does not require the owner of the registered trademark to prove that the unauthorized use is confusing. Instead, the owner must only demonstrate that the mark has significant goodwill attached to it and that the unauthorized use impacted such goodwill in a way likely to cause its value to depreciate.
- 4) Registering a trademark makes it less likely that another party will inadvertently market their own goods or services under the same or a similar mark. All registered trademarks in Canada and pending applications are listed in a publicly-searchable database accessible on the CIPO website. Before choosing a name or logo for their company or product, many businesses search this database to determine whether the same or similar marks are already in use, often in preparation for registering the marks themselves. Any likely conflict is then averted.
- 5) Enforcing your unregistered mark against unauthorized use requires you to claim “passing off”, in which you bear the burden of proving the existence of goodwill (or reputation) in the mark in the geographical area where it is being used, that the unauthorized use of the mark constitutes a misrepresentation that may confuse the public, and that this misrepresentation has caused, or is likely to cause, damage to the owner of the mark. A trademark registration does not require the owner to establish passing off. Use of a registered trademark by an unauthorized person to sell, distribute or advertise goods or services similar to or likely to be confusing with your mark constitutes a prima facie infringement.



II) How to Register a Trademark

You can apply to register your trademark before beginning business in Canada. The applicant, usually by its agent, submits an Application to CIPO with the application fee. The fee depends on the number of classes of goods and services, and starts at \$330.

The Application must include, among other things, a plain-language statement of the goods and services that the applicant presently associates or intends to associate with the trademark. These goods and services are classified in accordance with CIPO's standard classification scheme.

The submitted Application is reviewed by a trademarks examiner who decides to approve it for advertisement in the Trademarks Journal. If the examiner has objections or requires clarification, they contact the applicant who may respond to their concerns. Once the Application is approved, it is advertised, and anyone has two months within which to oppose the Application. If the Application is opposed, the applicant and the opponent file written arguments and make submissions at an oral hearing. If the Application is not opposed, it is allowed and the applicant receives a Certificate of Registration.

Improperly drafted Applications will be rejected by the examiner, and the applicant will be required to submit a revised Application. Also, since registering a trademark only confers exclusive rights to use the mark in connection with the goods and services stated on the Application, errors can prevent your trademark from being effective for your intended use in Canada.

Successfully registering your trademarks at the earliest possible opportunity is one of the most important steps you can take to protect your brands and goodwill. By retaining experienced counsel who specialize in trademark law, you can avoid strategic missteps in your Applications that make them vulnerable to rejection, and can increase the likelihood of successfully resisting oppositions to your Application, and later challenges to your registration.

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This communication offers general comments on legal developments of concern to business organizations and individuals and is not intended to provide legal advice. Readers should seek professional legal advice on the particular issues that concern them.

Contacts



R. Grant Cansfield

Partner

T 416.865.7741

E gcansfield@airdberlis.com

Grant is passionate about helping his clients achieve their corporate/commercial goals. An astute listener, he is focused on better understanding his clients' core objectives and determining the most effective solution to their business, licencing or intellectual property issues. His proactive approach to keeping clients informed and his ability to provide results in a timely manner allow Grant to build strong, lasting client relationships.

Grant is a member of the firm's Corporate/Commercial Group and Chair of the Licensing Group. His primary practice in the area of intellectual property focuses on trademark prosecution and enforcement and various licensing matters. He is lead Canadian counsel and provides corporate and commercial advice to a number of local, national and international clients in financial services as well as in industrial, retail and manufacturing industries.



Fiona Brown

Partner

T 416.865.3078

E fbrown@airdberlis.com

Fiona has extensive experience advising international businesses entering the Canadian market. To date, she has advised more than 100 companies expanding into Canada. Fiona advises clients in this space all day, every day. She has been practising for more than a decade and is a regular speaker and writer on market expansion matters. Fiona is proud to have been recognized by *The Best Lawyers in Canada*, *The Canadian Legal Expert Directory* and *Benchmark Canada*.

A proactive and comprehensive approach is required to succeed in a new market. Fiona manages teams of other lawyers and patent agents to provide her clients with a full range of legal services to help their businesses grow. She acts as project manager to ensure her clients receive seamless legal services in all relevant areas.

Fiona takes great care to understand her clients' businesses and deliver advice that is tailored to meeting their specific needs. Her responsiveness, dedication to clear communication and hands-on approach show that she is personally invested in the success of her clients.

Amelia McLeod, a student at Aird & Berlis LLP, contributed to this article.