



Contact Information:
www.nebs.ca
1 800 461 7572

WHITE PAPER

Why Register a Canadian Trademark? *Trademarks Defined and Explained*

By Lionel J. Perez
President,
CorporationCentre.ca





What is a Trademark?

A trademark is a word, a symbol, a design or any combination used in association with products (wares in trademark lingo) or services. It is a useful tool for distinguishing the products or services of one entity from its competitors. A trademark may come to represent not only products and services, but also the reputation of the provider of such products or services. As such, a trademark may constitute valuable intellectual property.

Registration of a trademark is proof of ownership and therefore a key way of protecting a trademark from misuse and imitation. Registration is not obligatory but is recommended because it is a way of verifying the exclusive right that is established through using the trademark in relation to specific products or services. It is important to realize that, while registration affords the greatest possible legal protection against infringement or misuse of a trademark, it is, and can never be, a failsafe guarantee against all problems relating to trademark usage. Furthermore, registering a trademark with the Canadian Trademarks Office protects rights in that trademark in Canada only. Where an entity is providing wares or services in association with a given trademark in other countries, registration in each of such other countries should be considered.

Selecting a "Good" Trademark

In evaluating a trademark, there are four general categories of terms:

1. distinctive terms;
2. suggestive terms;
3. descriptive terms; and
4. generic terms.

Generally, the terms that are easiest to register and to protect as trademarks are **"distinctive" terms**. Distinctive terms are often arbitrary or fanciful terms. They are unmistakably capable of identifying an owner's wares or services without any likelihood of confusion, for the average consumer, with the wares or services of another party.

At the other end of the spectrum, **"generic" terms** will never be capable of registration. The meaning of a generic term is synonymous with the wares or services themselves (e.g., zipper, escalator, etc...). Generic terms are incapable of distinguishing the wares or services of one party from those of another.

Between these two extremes lie "suggestive" and "descriptive" terms.

A **"suggestive" term** is one that merely suggests the nature, quality or characteristic of the wares or services in relation to which it is used as a trademark. It is possible for suggestive terms to be registered as trademarks but they make for "weak" trademarks because they often do not provide their owner with the ability to prevent others from using marks which are very similar and used in relation to similar wares or services, or that are identical marks used in relation to different wares or services.



WHITE PAPER: *Why Register a Canadian Trademark?*

A **"descriptive" term** describes the nature, quality or characteristic, the intended purpose or function, or the end effect upon the user of the wares or services in relation to which it is used as a trademark. Descriptive terms are not registrable unless, over a period of years, the terms have acquired, in the minds of the public, a special, identifiable meaning (a "secondary meaning") which links the wares or services to the owner of the trademark.

When choosing a trademark, you should make every effort to use arbitrary and fanciful terms. Suggestive terms make for very weak trademarks and should be avoided whenever possible. Descriptive and generic terms should never be used as trademarks. Furthermore, terms which have a specific meaning within a particular industry should be avoided in relation to wares or services pertaining to that industry as they tend to make the mark suggestive or descriptive and therefore more difficult to register and to protect.

Generally, unless the trademark of a party has become clearly distinctive of a given party's wares or services, a trademark will not be registrable in Canada if it is:

- the name or surname of a person (e.g., "Jane Smith");
- clearly descriptive of the wares or services in relation to which it is used (e.g., "Perfectly Clean" in relation to dry-cleaning services);
- a word in another language which describes the wares or services (e.g., "Gelato" - the Italian term for "ice cream" - in relation to ice cream products);
- deceptively misdescriptive (e.g., "Air Courier" in relation to ground transportation services); or
- an official symbol, coat of arms, badge, crest, emblem or name (e.g., the Canadian flag, the letters "R.C.M.P.", the name "United Nations", the symbol of the Red Cross).

To maximize the likelihood of registration, a trademark should therefore be either an invented mark or one that makes only oblique reference to the nature of the wares or services in relation to which it is to be used.

It should be noted that, even where a chosen trademark is not registrable for being clearly descriptive or deceptively misdescriptive, it is possible to continue using that trademark but its owner must understand that it will not be able to enforce the exclusivity that would result from registration of the trademark.

Pre-application Conflict Searches

The whole point of registering a trademark is to protect corporate identity from imitation by or confusion with others. Before applying for trademark registration a search may be undertaken to help determine from the outset whether there is a chance for the success of the application. By locating similar marks, a pre-application conflict search may help avoid trademark infringement and potential legal proceedings in the long term, or the unnecessary expense of an application for registration where the application has little chance of succeeding.



WHITE PAPER: *Why Register a Canadian Trademark?*

Conflict searches vary in scope. They may cover federal and/or provincial corporate registers, trademarks registered with the Canadian Intellectual Property Office, Internet domain names, distinctive character sources from specialized dictionaries and directories of product or trade names, or they may encompass all of the afore-mentioned searches. Generally speaking, the greater the scope of the search, the greater its cost but the greater the assurance obtained. While it is true that the greater the scope of the search, the more likely it is that the search will reveal potentially conflicting marks and therefore avoid needless expenditures and proceedings, it is important to realize that there is never any failsafe guarantee against the possible existence or use by another party of a conflicting mark.

Registration Process

In Canada, registration of a trademark consists of having the trademark entered on the Trademarks Register of the Trademarks Office of the Canadian Intellectual Property Office of Industry Canada. The entire process takes approximately ten to twelve (10-12) months, unless there are opposition proceedings, in which case the process can be much longer.

1. Application

In Canada, a trademark is registered by filing an application with the Trademarks Office together with a non-refundable fee of two hundred and fifty dollars (\$250.00) for each trademark applied for. It is possible to file an application for registration of a trademark that is not yet in use somewhere in Canada.

2. Initial Examination

Within the following four months, the Trademarks Office examiners then carry out a search of trademark records for potentially conflicting marks. Should there be no apparent conflict, the examiners then make an initial determination as to the registrability of the trademark, assessing such characteristics as whether the trademark is "clearly descriptive" or "deceptively mis-descriptive". They will also decide whether the description of the wares or services complies with the regulations and is in normal commercial terms. The examiners advise the applicant of any adverse findings. Applicants may be required to submit revised applications. CorporationCentre.ca now offer a revised application submission service. [Click here](#) for details.

3. Approval

Once past the conflict search stage and initial determination of registrability and any revisions to the application the Trademarks Office will submit for Advertisement.

4. Advertisement.

The trademark information is published in the Trademarks Journal. Any interested party may then make representations to the Trademarks Office, such as filing an opposition against registration of the trademark owing to alleged confusion with an existing mark. Should this happen, opposition proceedings can, if successful, bring the application process to an end or otherwise delay the registration process for eighteen (18) months or more.

5. Allowance.

If the Trademarks Office receives no objection within approximately two (2) months of publication in the Trademarks Journal, the Trademarks Office issues a notice of allowance of the application for registration.



6. Registration.

To proceed to the final step of registration, a fee of two hundred dollars (\$200.00) per trademark must be paid by the applicant within six (6) months of the date of the notice of allowance. Upon receipt of the registration fees, the Trademarks Office will issue a certificate of registration for each duly registered trademark. In Canada, registration of a trademark is valid for fifteen (15) years. A trademark registration is renewable every fifteen (15) years upon payment of a renewal fee.

Marking Requirements

Although not required by law to do so, trademark owners often indicate ownership or registration of their trademark through certain symbols, namely "™" (trademark) or "®" (registered trademark). The "™" symbol can be used with a trademark regardless of whether it is registered, as long as it is being used in association with wares or services. The "®" symbol, however, should only be used once the trademark is registered.

[Click here](#) to learn more about trademarks or to submit a trademark application.Δ

Lionel J. Perez is co-founder and currently oversees operations of CorporationCentre.ca - Canada's leading corporation website for small businesses, entrepreneurs and professionals. As an attorney, Lionel practiced corporate, commercial and technology law with a technology law firm servicing start-ups and publicly traded corporations. Lionel holds law degrees from Osgoode Hall Law School and the Université de Montréal and is a member of the Quebec Bar Association.