

Canadian Trademarks – Information for Foreign Attorneys[†]

Sisson Warren Sinclair offers a complete range of trademark services to foreign attorneys, ranging from the traditional filing and prosecution of a mark to portfolio management. We use an integrated system of software and portfolio management tools to provide you with quick, efficient and effective service.

For clients with a large number of marks being prosecuted by us, we prepare periodic trademark reports which shows the individual status of all the pending and registered marks in an easy to read format.

The following outlines the basic filing requirements, provides some notes on Canadian trademark practice and lists the approximate costs.

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Filing Requirements

To file an application, we require the following information:

- The applicant's name and address of its principal office or place of business.
- The trademark; if it is a design please forward a clear copy.
- How the applicant came to own the mark; including a list of predecessors in title if applicable.
- A description of all wares and services to be associated with the trademark.
- Whether the mark has actually been *used* in Canada; and if so please specify: how, where and the earliest date of such use for each type of wares and services. Please provide a specimen of such use.
- Details of any pending applications or registrations for the same mark outside Canada.
- If the mark is going to be used by an entity other than the applicant, even if it's a subsidiary, please provide the name of that entity and full particulars (e.g. copies of license agreements).

Notes on Canadian Trademark Practice

- A signature of the applicant is *not* required.
- Canada does *not* follow the International Classification system, so goods and services should be described in ordinary commercial terms and as specific as possible (e.g. 'clothing' is too simple, 'shirts' is better).
- *No* power of attorney, nor any other kind of legalization, is required.
- "Use" in Canada is different depending on whether the mark is for wares or for services:
 - *wares*: a trademark is used on wares by: selling the wares with the mark applied to the wares or their packaging.
 - *services*: a trademark is used in association with services by: actual provision of the services coupled with a display of the trademark in advertising for those services, or accompanying the provision of the services.
- Paris Convention priority can be claimed if a Canadian application is filed within 6 months of the original filing in a member country.
- A certified copy of the priority application is *not* required.

Approximate Costs

Please contact us, and we will forward you a recent Schedule of Costs.

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