

# Canadian Trade-marks – Frequently Asked Questions†

## Q: WHAT IS A TRADE-MARK?

A **trade-mark** can consist of a word, slogan, logo, symbol, design or any combination thereof, adopted and used by a manufacturer or merchant to identify his or her wares or services and to distinguish them from those manufactured and sold by others. Examples are everywhere you look: the words “Coca Cola” and the Nike “swoosh” are but just two.

It is the “good will” which gives a trade-mark value and keeps the consumers interested in purchasing one manufacturer's products over another. A trade-mark generally indicates the source of the wares and services, although it may also indicate that the wares or services meet the same standard of quality as all other wares or services associated with the mark.

**Strong trade-marks**, from a legal point of view, are those that are fanciful, coined or arbitrary. Weak trade-marks are descriptive marks or suggestive marks. Although from a marketing point of view it is tempting to choose a trade-mark which describes the product, such a descriptive mark presents legal difficulties. Generally, if it would be unfair to prevent others from using it in association with a product or service, the trade-mark will not be allowed by the Trade-marks Office (e.g. “Shoe” for footwear).

### **TRADE-MARK CATEGORIES**

**Fanciful** - e.g. *Exxon* for petroleum products and *Oshkosh* for children's clothing. These terms initially meant nothing until their respective companies gave it a style and until it became recognized by the public.

**Arbitrary** - e.g. *Apple Computers* for computers. Although both the words apple and computers had meaning, their combination was initially arbitrary.

**Suggestive** - e.g. *Coppertone* for sun tan oil and *Whirlpool* for washers. These trade-marks are suggestive of their associated wares. A suggestive trade-mark is somewhat less strong, approaching almost the descriptive end of the spectrum.

**Descriptive** - If a trademark is clearly descriptive of a good or service it is not registrable, except where you can show that it has acquired a secondary meaning through use (i.e. starting to distinguish your product from the others).

A **trade name**, on the other hand, is a name under which a particular business is carried out, such as a partnership name or corporate name. When a trade name is displayed on wares or associated with services, it may also function as a trade-mark.

## Q: MUST I REGISTER MY TRADE-MARK?

Trade-mark registration is not necessary in order to use it. Your trade-mark becomes established as soon as you have begun to properly use it; and it is enforceable against infringers through the common law action for passing off.

However, registration provides you with a number of **important advantages**, and it is worth considering before significant investments are made in advertising, signs, websites, letterhead and product labels.

SISSON  
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Barristers, Solicitors, Notaries Public  
and Trade-Mark Agents

Barry M. Wilson  
Donald J. Sinclair  
Kirk L. Sisson Q.C.  
Christopher R. Warren Q.C.  
Gordon G. Yake  
Donna C. Purcell  
Michael D. Keyes  
Rhonda M. Elder  
Kevin A. Beattie  
Sander R. Gelsing\*

Robert H. Scammell Q.C. Retired

\* Practice restricted to intellectual property law

## ADVANTAGES TO REGISTRATION OF A TRADE-MARK

**Exclusive right** of the owner to use the trade-mark throughout Canada in respect of the wares and/or services for which registration issues. Registration reserves your right of exclusive use across Canada.

**Prevent the registration of similar marks** by others, since your mark is on public record.

**Proof of ownership of title and distinctiveness** in a trade-mark is established through registration.

**No need to establish good will**, or reputation, in a particular geographical region, as is the case in a passing-off-action.

**No need to establish misrepresentation** resulting in confusion or likelihood of confusion, as is the case in a passing-off-action.

**Licensing** of the use of the trade-mark is easier with a registered mark.

**Internet Domain Name** – a trade-mark registration can be of vital importance in registering or maintaining an internet domain name.

### **Q: CAN ANYONE REGISTER A TRADE-MARK?**

Generally yes: individuals, companies, partnerships and other entities may apply for registration of *their own marks*. However, be aware that trade-mark law is technical. A trade-mark agent can significantly simplify the application process for you. Also by consulting a professional, your application is much more likely to succeed.

Furthermore, a lawyer specializing in trade-marks and intellectual property law can advise you on whether your proposed marks might infringe the rights of others, help you sort out your branding priorities, assist in licensing your marks, and advise you on other types intellectual property law protection that might be suitable.

### **Q: DO I NEED TO DO A TRADE-MARK SEARCH?**

No, a trade-mark search is not necessary prior to filing for a registration. However, a search is often advisable, for instance to find out whether there is a prior registration or a similar mark. If a similar mark is found, then the expense of preparing and filing a trade-mark application can be avoided.

Note, that a search cannot “guarantee” that a given trade-mark will in fact be registered.

### **Q: HOW LONG WILL MY TRADE-MARK BE PROTECTED?**

In Canada, your registered trade-mark is valid for 15 years. By paying a renewal fee you may have it renewed every 15 years.

For further information please contact:

**Mr. Sander R. Gelsing**  
B.Sc., B.A., LL.B.  
Barrister, Solicitor and  
Trade-mark Agent, A.I.P.I.C.

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First Red Deer Place  
600, 4911 - 51 Street  
Red Deer, Alberta T4N 6V4  
Telephone (403) 343-3320  
Fax (403) 343-6069  
(Delburne: 749-3650)  
[www.swslawyers.com](http://www.swslawyers.com)