



TRADE MARKS

Questions and Answers

BUREAU OF INTELLECTUAL PROPERTY



Consumer and
Corporate Affairs Canada

Consommation
et Corporations Canada

QUESTIONS AND ANSWERS ABOUT TRADE MARKS

1. Q. *What is a Trade Mark?*
 - A. A Trade Mark is a word, symbol or picture or a combination of these used to distinguish the goods or services of a person or organization from the goods or services of others in the market place.

2. Q. *How does one differentiate Trade Marks from Copyright, Industrial Designs and Patents?*
 - A. Copyright deals with original literary, musical, dramatic and artistic works. The term of a Copyright is for the life of the author plus 50 years.
Industrial Designs deal with original ornamentation of any article or manufacture. This includes any shape, feature or ornamentation, the object of which is an aesthetic effect. Functional or utilitarian features may not be the subject of an Industrial Design but may be the subject of a Patent application. The term of an Industrial Design is for 5 years and is renewable for an additional 5 years but no longer.
Patents deal with inventions, that is, new and useful processes, machines, manufactures, compositions of matter or any new and useful improvements thereof. A patent is a grant by the Government of Canada giving an inventor the right to exclude others from making, using or selling his invention within Canada for a period of 17 years, and is given in exchange for a full and complete disclosure of the invention.

3. Q. *How long does a Trade Mark last?*
 - A. A Trade Mark is registered for a period of 15 years from the date of registration.

4. Q. *Once I have registered my Trade Mark, are any further fees necessary to keep it in force?*
 - A. No, during the 15 years period of registration, no further fees are necessary. However, if at the end of the 15 years, you wish to continue the registration for a further 15 years, a renewal fee is payable.

5. Q. *May the term of a Trade Mark be extended?*
 - A. Yes, it may be renewed every fifteen years without limitation.

6. Q. *Must I register my Trade Mark?*
 - A. No, it is not mandatory to register a Trade Mark, but it is advisable to do so, for a registered Trade Mark is prima facie evidence of ownership of the mark and is more easily protected than an unregistered trade mark.

7. Q. *Is there such a thing as an unregistered Trade Mark?*
- A. Yes, those who have not registered their Trade Marks and have left their rights to be established in Common Law have what is known as an unregistered Trade Mark. They may register at any time providing they meet the requirements of the Trade Marks Act.
8. Q. *Does a Trade Mark registered in Canada have any validity in foreign countries?*
- A. No, a registered Trade Mark gives its owner the exclusive right to its use in Canada. If your product or services are sold in other countries, you should also consider registration of your Trade Mark in those countries where your products or services are used.
9. Q. *What subject matter may not be used in a Trade Mark?*
- A. Such things as coats of arms of the Royal Family, badges and crests of the R.C.M.P. and the Canadian Armed Forces, the Red Cross, the Red Crescent or national symbols may not be used in Trade Marks, nor may anything be used that is obviously immoral or offensive. One should consult sections 9 or 10 of the Trade Marks Act for a complete statement of what may not be used.
10. Q. *What is a Certification Mark?*
- A. A Certification Mark is a type of Trade Mark and is a mark used to distinguish goods or services that meet a defined standard. A good example is the "wool mark" used on clothing to indicate the presence of a wool fabric.
11. Q. *What is a Trade Name?*
- A. A trade name is the name under which any business is carried on, whether it be the name of a corporation, a partnership or an individual.
12. Q. *How is a Trade Mark different from a trade name?*
- A. A Trade Mark identifies the goods or services marketed under its protection. The trade name identifies a company or business.
13. Q. *Can I register a trade name under the Trade Marks Act?*
- A. A trade name can be registered under the Trade Marks Act only if it is also used as a trade mark.
14. Q. *Who may obtain a Trade Mark?*
- A. Companies, individuals, partnerships, trade unions and lawful associations may obtain registration of their marks of identification for goods or services provided they meet the requirements of the Trade Marks Act.

15. Q. *Must I use my Trade Mark?*

- A. Yes and no; one of the requirements of registration is that the mark must be used in association with goods or services prior to being registered. However, an application for registration of a Trade Mark may be filed on the basis of proposed use before the mark has actually been used.

16. Q. *Can I assign or sell my Trade Mark?*

- A. Yes, you can sell or assign the rights to a registered or unregistered Trade Mark, with or without the goodwill of the business. However all changes in ownership or assignment of a registered Trade Mark should be registered with the Registrar of Trade Marks.

17. Q. *How do I register my Trade Mark?*

- A. An application for the registration of a Trade Mark should be filed with the Registrar of Trade Marks, Ottawa/Hull, K1A 0E1. Information on filing and application will be forwarded on request or may be obtained by visiting the Trade Marks Office at Place du Portage, Victoria St., Hull, Québec.

18. Q. *Can I prepare my own application for a Trade Mark?*

- A. Yes, anyone may file an application for the registration of a Trade Mark. However, as the preparation and prosecution of a Trade Mark application may be complex and involves the grant of a legal right, it is recommended that applicants consult a Trade Mark Agent, trained in this specialized practice and registered to practice before the Canadian Trade Marks Office. If one intends to register his marks in other countries the use of a Trade Mark Agent is imperative.

19.a) Q. *What papers are required to register a trade mark?*

- A. You must submit an application following the format illustrated in the Trade Marks Rules. Application forms are not available.

b) Q. *What fees must I pay to have my Trade Mark registered?*

- A. A fee of \$35.00 is payable on the filing of each application and a fee of \$25.00 is required for advertisement in the Trade Marks Journal. If you use an agent to prosecute your application, his fees will of course be over and above these amounts.

20. Q. *How can I get a copy of the Trade Marks Act and Rules?*

- A. Copies of both the Trade Marks Act and the Trade Marks Rules can be obtained from any Canadian Government Bookstore.

21. Q. *Are drawings or illustrations necessary?*
- A. If the Trade Mark is anything other than a word (or word combination) of non-specific form, drawings are required. Four drawings in black and white and three specimen Trade Marks must be included with the application.
22. Q. *What can I do if my Trade Mark application is (a) refused by the Office or (b) opposed by someone else following advertisement of my application in the Trade Marks Journal?*
- A. (a) The applicant may appeal the Registrar's decision to the Federal Court of Canada.
- (b) An opposition procedure is provided for and it will be necessary for the applicant to follow the steps in this procedure as set out in the Trade Marks Act and Trade Marks Rules.
23. Q. *Is there a fee to search the Trade Marks Records?*
- A. No, any individual may make a search free of charge.
24. Q. *Should I search them myself?*
- A. It will depend on the type of search you wish done. If it is for the purpose of filing a Trade Mark application one should consider having an agent do it for, as stated earlier, the filing of a Trade Mark application can be a tricky and complicated business, and an unskilled searcher may not be aware of all the implications of what he is looking at.
25. Q. *Will the Trade Marks Office give me an opinion on my ideas for a Trade Mark, or advise me on whether or not I should obtain Trade Mark Protection?*
- A. No, regulations prohibit the Office from expressing an opinion on the registrability of a trade mark until a formal application is filed. As with other legal matters, one should consult a properly qualified agent to determine the necessity of obtaining legal protection.
26. Q. *What happens if two individuals or companies apply for the same Trade Mark?*
- A. The Trade Marks Office will determine which applicant has priority and is entitled to registration.
27. Q. *May a Trade Mark be registered if the applicant dies while it is being processed?*
- A. Yes, it will be considered to be part of the applicant's estate and should be assigned to the heirs.

28. Q. *May foreigners register their Trade Marks in Canada?*
- A. Yes, (a) if the Trade Mark is used or intended to be used in Canada, or (b) if the Trade Mark is registered and used in the country of origin.
29. Q. *Will the Trade Marks Office protect me if someone else starts using my registered Trade Mark?*
- A. No, it is up to the owner to police the use of his Trade Mark and take such action as necessary. The registration of a Trade Mark gives the applicant prima facie evidence of ownership of the Trade Mark and is an entrée to the courts.
30. Q. *How long does it take to have a Trade Mark registered?*
- A. Normally it takes about a year from the date of application to registration of a Trade Mark. However, each application is examined on its own merits and may be affected by opposition or other obstacles and so the period will vary.
31. Q. *Is it necessary to visit the Trade Marks Office to prosecute a registration?*
- A. No, it is not necessary as the registration may be entirely prosecuted by mail.
32. Q. *May an applicant write directly to the Trade Marks Office about his application after it is filed?*
- A. Yes, unless he has hired an agent to prosecute his application, in which case he should conduct all correspondence through his agent.
33. Q. *After an application for Trade Mark registration is filed, may changes be made to it?*
- A. Minor changes or corrections are allowed, as defined within the Trade Marks Rules, during prosecution. However, major changes are not permitted; hence the need to exercise care in preparing an application in order to ensure that it is correct and includes all essential items. Otherwise it may be necessary to go to the trouble and expense of filing an entirely new application. An application that does not comply with the Trade Marks Act may be defeated in opposition proceedings for that reason.
34. Q. *If another person has a Trade Mark registered in Canada but he is not using it, can he stop others from using it also?*
- A. Normally a Trade Mark is intended to be used and both the Trade Marks Act and the Common Law tests for restraint of trade provide redress for abuse in the use of a Trade Mark. In the case of none-use of a Trade Mark any person can initiate proceedings to remove the Trade Mark from the register.

35. Q. *How can I obtain the addresses of foreign Trade Marks Offices?*
- A. Addresses of foreign Trade Marks offices may be obtained from the foreign countries' Canadian representatives.
foreign countries' Canadian representatives.
36. Q. *How may I telephone the Trade Marks Office?*
- A. Area code 819, Number 997-1420.
37. Q. *If a registered Trade Mark is used on a product that is only distributed locally, may I use it in another part of the country?*
- A. No, not normally, for the registration gives the owner exclusive use of the mark throughout Canada.
38. Q. *Will the Trade Marks office help me if someone uses my Trade Mark, or one like it, in such a way that it will depreciate the value of my mark of the goodwill I attach to it?*
- A. No, the Trade Marks office does not assist in the enforcement of a registered or unregistered Trade Mark (see Q. 29). It would be advisable for you to seek legal advice in such a case. The value of the registered Trade Mark in this case is that the owner has prima facie evidence of its use and its ownership and he can protect it more easily by legal action than an unregistered mark.
39. Q. *May I license other persons to use my registered Trade Mark?*
- A. Yes, a person other than the owner of a registered trade mark may be permitted to use the mark if the person is recorded with the Trade Marks office as the registered user.
40. Q. *What is an "appellation of origin"?*
- A. An "appellation of origin" is the geographical name of a country, region or specific place which serves to designate a product originating therein, the characteristic qualities of which are due exclusively or essentially to the geographical environment, including both natural and human factors. They are often recognized by international agreement and may or may not be registered Trade Marks. A good example is the word Champagne used to designate the white, bubbly wine originating in the Champagne district of France.