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# Canadian Trademark Law

Roadmap to the Application Process





# Whether your brand new to the world of trademarks



or even somewhat familiar, you most likely have a couple questions. Well, we have answers!





Who can register a  
trademark in Canada?





A person can file a trademark application on an **individual basis** or as a **business**.



According to the Canadian Intellectual Property Office, (AKA “CIPO”), any:

“Companies, individuals, partnerships, trade unions or lawful associations, provided that they comply with the requirements of the Trademark Act and Trademark Regulations,” can apply to register a trademark in Canada



# What is NOT Registerable



 names and surnames  


 clearly descriptive marks  


 deceptively mis-descriptive marks  


 geographical location  


 words in other languages  


 confusion or similarities  


# So What CAN you Trademark in Canada?



At this point, trademarks can be applied to

- words
- designs
- colour as applied to a particular shape and size
- sound
- motion
- certification marks; and
- distinguishing guises.



# How do you know if your trademark is even available?

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It all starts with a trademark search -- the deeper the search, the more accurate the results will be, and the higher your chances are of getting your trademark registration approved.



# Are Trademark Searches Required by CIPO?



- A search is advisable to protect not only an applicant's initial application fee but also any marketing investment that has been put behind a particular trademark.
- CIPO does not require or provide trademark searches to the public.
- Searches can reveal potential obstacles to registration





A trademark application needs to meet at least the minimum set of requirements, minus any fine details

- the name and address of the applicant;
- the goods or services that the trademark will be or has been used for;
- either a statement of your intention to use the trademark or the date of when you first used the trademark in Canada;
- And the application fee
- a representation of the trademark (such as a drawing), unless the trademark is just a word or words;



# Trademark Drawings?

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- The drawing must be no larger than 7 cm. by 7 cm.
  - The drawing must be in black and white and may not include anything that is unrelated to the desired trademark itself.
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# Fees and Classes

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Currently additional classes do not carry an additional cost.

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It costs an applicant **\$250** for their initial application and **\$200 at the end** of the application process upon registration of the trademark

Once the regulations come into effect the initial class in an application will cost **\$330**, plus an additional **\$100 per additional class**.





Already Have an  
Application?

In a jurisdiction that is a member of the  
WTO or Paris Convention

You can take advantages of certain benefits in your  
Canadian application



# Objections?

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## Common Issues Raised

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- likelihood of confusion
- an issue with a description of the goods and services contained within the application.
- Do the goods and services emanate from Canada
- Descriptiveness of the mark in relation to the goods and/or services

## Response

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Once issued, an applicant has six months to submit a response to an examiner's report.

An application can be denied registration if the issues raised in an examiner's report are not addressed in a proper response to the examiner's report.





# Can Rejected Applications be Appealed?

A rejected application can be appealed by the applicant to the **Federal Court**.

The appeal will be heard by a single judge of the Federal Court. A further appeal can be made to the Federal Court of Appeal. The Supreme Court of Canada can only be appealed to with leave to do so.



# When Does Registration Come Into Effect?



## “Almost There”



Currently, once the notice of allowance has been granted by CIPO the applicant must submit a **registration fee of \$200.**

In Canada, trademark protection extends for a term of 15 years

## Can third parties formally oppose an application?

Any person can file to oppose the registration of a trademark once it has been published in the Trade-marks Journal.




The fee to file a statement of opposition to a trademark application is \$750.

The Trademark Opposition Board is the governing body that will rule on the matter. Typically, the approximate time frame for an opposition will be two to three years in length.



# Non-Use



-  It is commenced on the request of a third party made after the third anniversary of the registration and the payment of an **official fee of C\$400**.
-  The registrar will then issue a notice requiring the registered owner of the mark to file *evidence of use*
-  The owner of record must file evidence of use (or of circumstances excusing non-use). Both parties then have the opportunity to file written arguments and attend a hearing.

# For More Insights



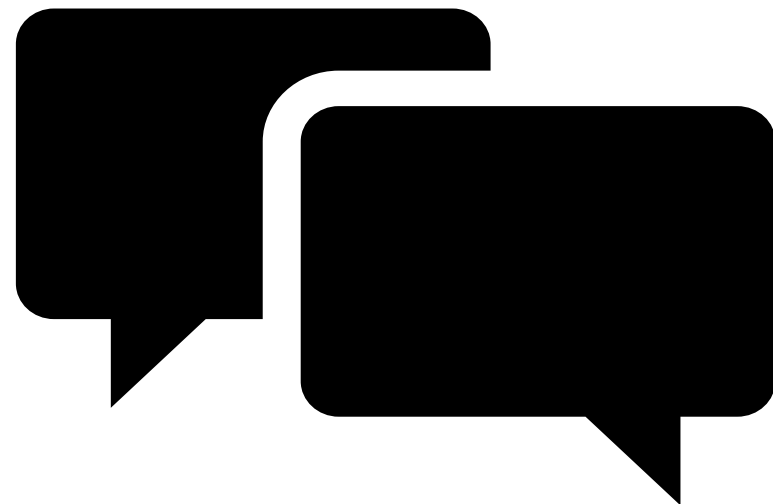
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# Up Next

The Upcoming Changes to Canada's Trademark Law