

Canadian Trademark Law - Road Map to the Application Process

Who can register a trademark in Canada?

A person can file a trademark application on an individual basis or as a business. The trademarks Act sets out who is entitled to registration of a trademark. The CIPO site indicates that:

1. Companies, individuals, partnerships, trade unions or lawful associations, provided that they comply with the requirements of the Trade-marks Act and Trade-marks Regulations.

Conversational Adjustments:

Welcome back to another episode of our trademark video series exploring the ins and outs IP protection! Today we'll walk you through the roadmap to the application process. That way, you'll have everything you need to kickstart the trademark registration process. Let's dive in.

Whether you're brand new to the world of trademarks or even somewhat familiar, you most likely have a couple questions. Well, we have answers!

First up,

Who can register a trademark in Canada?

A person can file a trademark application on an individual basis or as a business. The Trademarks Act sets out who is entitled to the registration of a trademark. 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 Trade-marks Act and Trade-marks Regulations," can apply to register a trademark in Canada.

So how does the act define what is registerable?

The Trademarks Act sets out what is NOT registerable in Canada as a trademark. Let's take a look at some of those:

- names and surnames
- clearly descriptive marks
- deceptively misdescriptive marks
- words that represent a geographical location commonly known to be the place of origin of such goods or services
- words in other languages
- words or designs that could be confused with a registered trademark or pending trademark
- words or designs that look very similar to a prohibited mark

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.

[can we add a brief explanation of what a distinguishing guise is? Such as:

“If you’re wondering what a distinguishing guise is, we don’t blame you. Weird name, yes. Complicated, not really. A distinguishing guise refers to the overall appearance or packaging of a product that is used to distinguish said product from other items sold in the market”

Speaking of distinguishing your brand from the competition, how do you know if your trademark is even available?

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 available or required by CIPO before filing an application?

Naturally, 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. That said, CIPO does not require or provide trademark searches to the public.

If an applicant can see a registrant with a very similar trademark they may want to rebrand while they still can.

The importance of searches cannot be overstated. Searches can reveal potential obstacles to registration whether likelihood of confusion with another trademark or disclaimer requirements.

Now that you’ve determined what you’d like your trademark to be, what information and documentation must be submitted to apply for registration?

A trademark application needs to meet at least the minimum set of requirements -- minus any fine details -- in order to get a filing date and application number. The minimum requirements include:

- 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;

Speaking of trademark drawings, what is the appropriate way to submit them?

Well, 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.

Beyond the basics, you also need to decide which class (or category) your trademark falls under. So, are multi-class applications allowed?

Currently additional classes do not carry an additional cost. Once the new regulations come into effect, however, multi-class applications will still be allowed but these will carry additional fees under the Nice Classification system.

What are the fees?

Currently 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 new regulations come into effect the initial class in an application will cost \$330, plus an additional \$100 per additional class. Plus, the registration fee will be eliminated.

What if the applicant already has a foreign trademark application?

If you already have an application in a foreign jurisdiction that is a member of the either the World Trade Organization or the Paris Convention, you can take advantage of certain benefits in your Canadian application. So how does that work?

1. Firstly, your application should cover the same sorts of goods and services as in the original application and be for the same trademark.
2. The application must be filed in Canada within 6 months of the foreign filing date.
3. A copy of the foreign application is not required to be submitted with the application, but it might be requested for examination.
4. The applicant or their predecessor must have been living or be carrying on business in the country in which the foreign application is filed at the date of filing. (With that being said, when the new regulations come into effect the applicant will only have to live in or be carrying on business in one of the World Trade Organization member countries.)

If the examining authority raises objections to the application, can the applicant take measures to correct the application?

If the examiner finds grounds for rejection, in many cases, an examiner's report will be issued.

The examiner's report will outline the objections raised by the examiner in reviewing the application.

Common issues raised in examiner's reports include:

- 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

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.

In Canada only the applicant or a registered trademark agent working on behalf of the applicant can submit these response to an examiner. Once issued, an applicant has six months to submit a response to an examiner's report.

If the response is found to be satisfactory the application will proceed to the next step of registration. If the response to the examiner's report is not satisfactory the applicant will either receive a further examiner's report or an outright refusal can be issued.

Can rejected applications be appealed? If so, what procedures apply?

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 (as of right) and the Supreme Court of Canada (only with leave).

When does the registration of a trademark come into effect?

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

This fee can be paid online to reduce wait times. Once the payment is received the trademark registration process is complete. CIPO will then issue a trademark certificate to the registrant and add their trademark to the official database.

How long will my trademark be protected and how can a registration be renewed?

Currently trademark protection in Canada extends for a term of 15 years. With that said, as evidenced by The Colonial from my previous presentation, trademark protection can run indefinitely so long as the registrant renews the trademark.

Once renewed, protection will again run for 15 years before requiring renewal again. The fee to renew a trademark in Canada is currently \$350. Again, this will provide a further 15 years of trademark protection before the fee is due again.

What is the usual time frame from filing to registration?

- The usual time frame from filing to registration – assuming no significant examination issues or oppositions occur – is 16 to 18 months.

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. In order to do so, a statement of opposition must be filed along with the applicable fee. Typically, the grounds of opposition are that:

- The application does not comply with the technical requirements of of the Trademarks Act;
- The mark is not registrable under Section 12 of the Trademarks Act;
- The applicant is not the person entitled to registration under the Trademarks Act; or
- The mark is not distinctive.

The fee to file a statement of opposition to a trademark application is \$750. The applicant is able to file a counterclaim and both sides are allowed to submit evidence in support of their claim.

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.

Can a mark be cancelled for non-use? If so, what term of non-use applies and what is the procedure for cancellation?

A registration can be expunged for non-use.

The summary expungement procedure is an administrative procedure under Section 45 of the Trademarks Act.

1. 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.
2. The registrar will then issue a notice requiring the registered owner of the mark to file evidence of use – or evidence of special circumstances justifying non-use – in the three-year period immediately preceding the issuance of the notice. The registrar may also request such evidence at its own discretion.
3. 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.

Given the complexities of the trademark process, you probably have a lot more questions than what we've addressed here -- enough questions to fill an entire video series on its own, in fact. That's all we have time for today, but rest assured knowing

you can always tune in next time, visit our website, or get in touch for more information. Thanks for listening!