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Canadian Trademark Law

Life after Application





We are here to help!

Which courts are empowered to hear Trademark disputes?



01

Exclusive Rights:

Statutory registration, expungement or grants of trademark rights is at issue

02

Concurrent Rights:

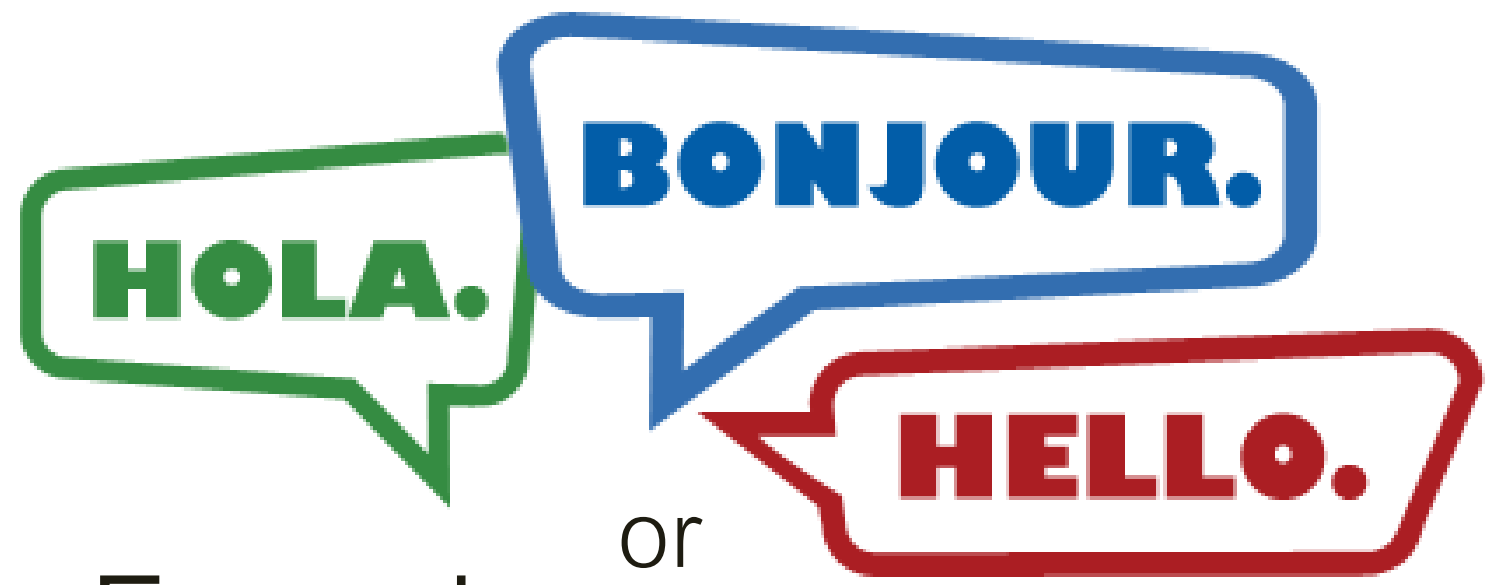
Claim is one of infringement of those rights



Enforcement of trademarks in Canada



- The Federal government gained exclusive jurisdiction rights in the Constitution Act 1867
- The Federal Court has concurrent jurisdiction along with the Provincial Superior Courts on certain matters such as infringement and passing off.



French

or

English

Trademark Ownership Issue



What actions do you think can be taken against
trademark infringement?

Civil Action

Only a *registered trademark* can be infringed

which includes:

- Sales
- Distribution
- Advertisement





A party can sue based on Sections 19 and 20 before the *Federal court* or *provincial superior court*




Criminal Action

Targets:

- Sale
- Offer for sale
- Distribution of counterfeit products
- Manufacture
- Cause to be manufactured
- Possession
- Import
- Export
- Attempt to export any counterfeit goods
- Label or packaging of the purpose of sale or distribution on a commercial sale

Beware...there are penalties for infringing trademarks



- Fine up to C\$1 million AND 5 years in prison for *an indictment*
- \$25,000 fine AND six months in prison for *summary conviction offence*

What are possible remedies for owners of infringed marks?



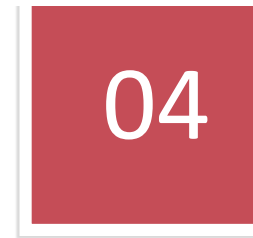
Injunctions



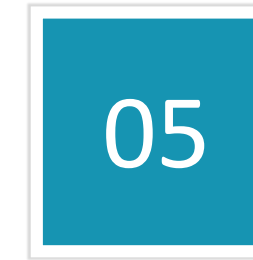
Permanent injunctions



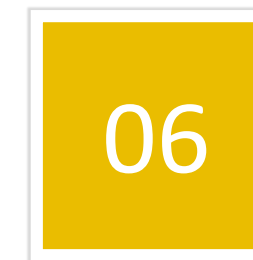
Damages



An accounting of profits



Destruction or disposition of
offending goods, packaging, labels
and advertising material



Punitive damages and exemplary
damages may be awarded in
exceptional circumstances

What customs enforcement measures are available to halt the import or export of infringing goods?



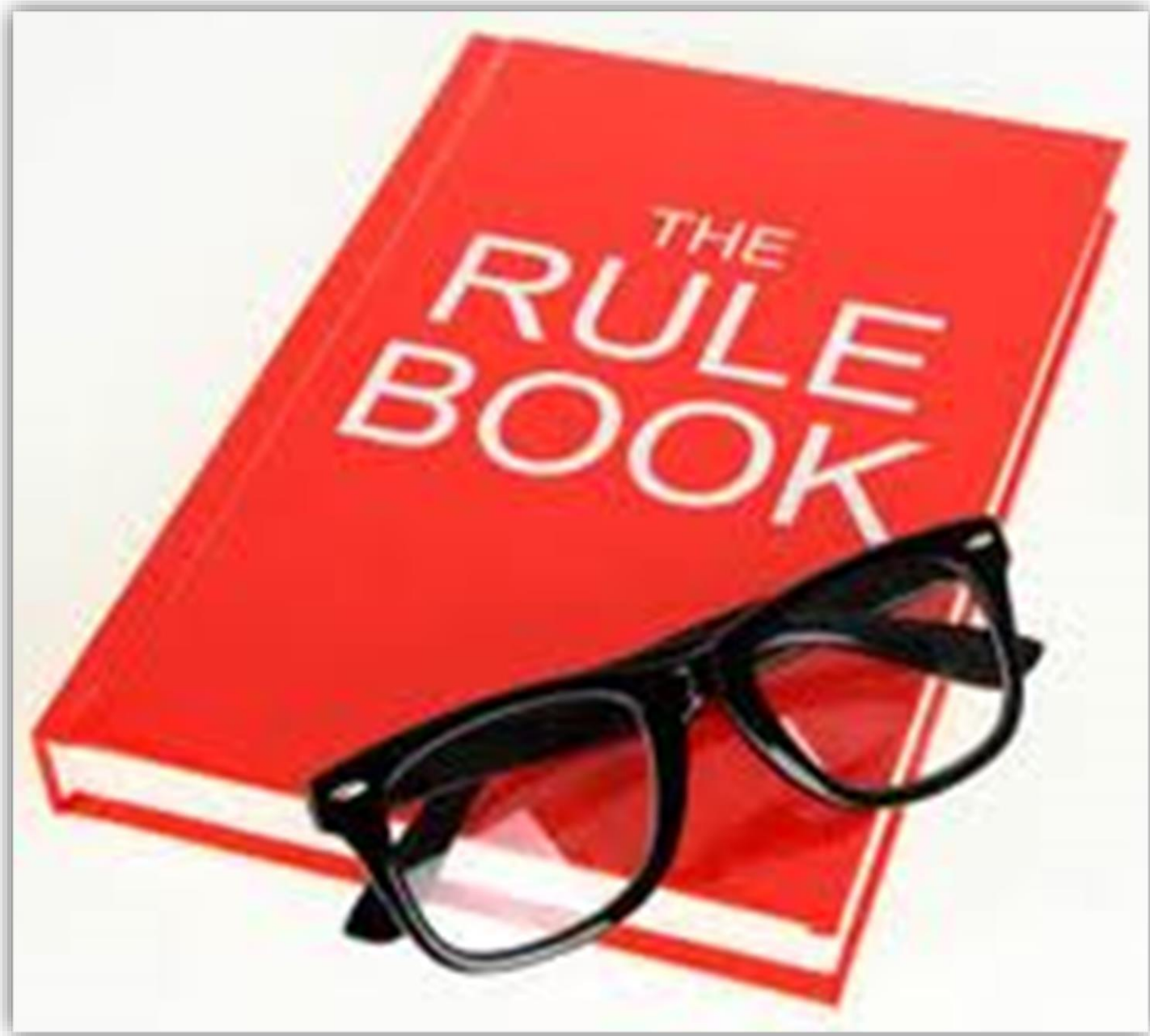
Canada has adopted a new request for assistance regime where all you have to do is

- Register your rights as the owner of registered marks with Canada Border Services Agency .
- And, it may detain goods for five to ten days and exchange information with trademark owners, allowing them to take civil action.

What rules and procedures govern the assignment of trademark rights?

- There are no legal rules or procedures that govern the assignment of trademark rights.
- A trademark, regardless of its registration status is transferrable

What rules and procedures that govern trademark licencing?



- Your trademark may be written or unwritten and may relate to registered or unregistered marks
- There is no provision to record a license against registered marks
- CIPO will permit the placement of licensing agreements on licensed trademark files and a note will be entered on the register

Can trademarks be protected under
other IP rights?

Copyright Act

- Where the conditions set out in the act are met

Industrial Design

- It protects the visual features of shape, configuration, pattern or ornament



Who governs the protection of trademarks
online and domain names?



CIRA manages the '.ca' internet domain on behalf of all Canadians

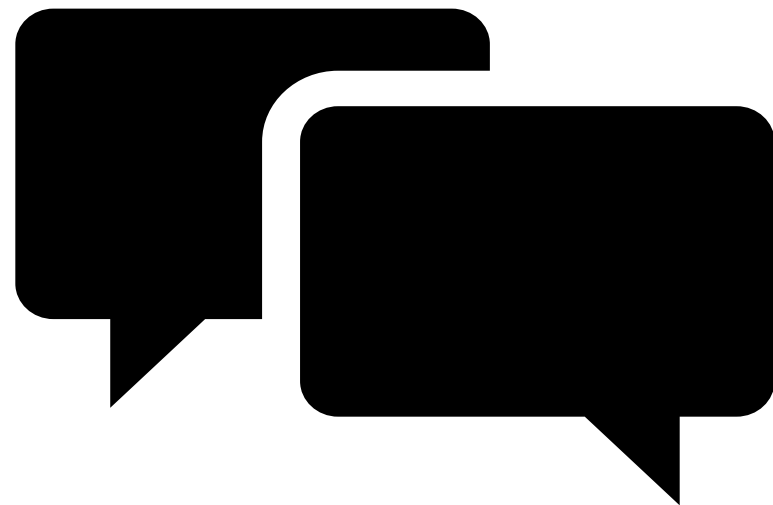


CIRA's Dispute Resolution Policy provides mechanism for arbitration for individuals and businesses that meet CIRA's requirements



Seek relief from Federal Court or provincial Superior Courts based on passing off, infringement and depreciation of goodwill of existing trademark rights.

For More Insights



About the world of intellectual property protection, visit our website at
<https://tm.witmart.com>

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Up Next

Upcoming Changes to Canada's Trademark Law