

BEFORE FILING A NEW APPLICATION FOR AN ALREADY REGISTERED TRADE-MARK...

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While the owner of a registered trade-mark usually works towards the marketing of the wares and services he has chosen to link to his mark, these activities may reveal unsuspected potential use of the mark for new wares or services. The idea of “extending the family” of wares and services is one that often arises but the question then becomes: how can an owner adequately protect his mark if the original registration does not cover those new wares and services?

Confronted with the possibility of requesting a second registration for an identical mark for those new products and services, the trade-mark owner will have to choose: he can follow this path and start from scratch, that is he can file a fresh application for his trade-mark for his new wares and services, for which the statutory fee is \$250.00. Otherwise, he can opt for the filing with the Registrar of an application to amend his existing registration by extending the statement of wares or services, for which the statutory fee is \$450.00.

Section 41(1)(c) of the *Trade-marks Act* (the “Act”) allows the owner of a trade-mark registration to apply to amend such registration in order to modify the statement of wares or services included therein. Indeed, an owner may seek to extend the statement of wares or services for which a trade-mark is registered, ultimately leading the trade-mark registration to cover his entire range of activities associated with the trade-mark.

An application to extend the statement of wares or services of an existing registration is considered and treated procedurally by the Registrar as a new application, in accordance with section 41(2) of the Act. Consequently, such an application must successfully pass through the same stages as a usual

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application, that is examination and acceptance by the Registrar, followed by publication for opposition purposes, and finally, allowance to registration.

This type of application cannot be considered a short cut to registration, but may be beneficial for the owner once the trade-mark is allowed to registration. The advantage stems from the fact that there will only be one renewal due date, as opposed to the situation where a fresh application would have led to a separate registration having its own registration date.

In short, even if the statutory fee is more costly within the context of an application to extend the statement of wares of an existing registration, such filing will ultimately be profitable in the long run, since only one renewal fee will be required by the Registrar (\$350.00) as opposed to a distinct set of renewal fees for two separate registrations.

In closing, it is important to mention that for an owner to be able to benefit from the extension of an original registration, the trade-mark as used in association with the new wares or services must be identical to the trade-mark originally registered.

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