



## THE BEST TRADEMARKS : 6 TIPS TO KEEP IN MIND

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A trademark can be a valuable asset for a corporation. It is therefore recommended that careful consideration and importance be given to the selection of a trademark.

What is a trademark? It can consist of a word, a drawing or even a sign, a sound, or a shape which aims to distinguish your products or services from those of your competitors. Its value will be based on its "distinctiveness".

Here are a few useful tips that can assist you in choosing the best trademark.

### 1) SIMPLICITY

Your trademark should be very easy for the consumer to remember.

### 2) ORIGINALITY

Be inventive. The trademark should be the result of careful consideration; it is important to come up with a trademark that does not exist. There are cases where companies inadvertently choose existing trademarks: this is a mistake that can prove to be costly as its registration may be refused and/or will not allow to differentiate your products or services from others. In this regard, it is always recommended to search the availability of a trademark before adopting it.

Since approximately 45 000 trademark applications are filed in Canada every year, you must find a way to stand out! This does not even include the Common Law trademarks, used without any registration...

### 3) NON-DESCRIPTIVE CHARACTER

Avoid choosing a descriptive trademark of the products and/or services in association with which you intend to use it. Under Canadian law (and even elsewhere), a trademark is not registrable if it is "depicted, written or sounded, either clearly descriptive or deceptively misdescriptive in the English or French language of the character or quality of the wares or services in association with which it is used

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or proposed to be used or of the conditions of or the persons employed in their production or of their place of origin”.

Examples of refused trademarks:

The trademark CHEAP TICKETS for the services of a travel agency was revoked in 2007 by the Federal Court on account of the basis of descriptive character of its services.

The trademark PHARMACIE.CA for human and animal health pharmaceutical products and for the manufacturing services of these products was refused by the Trademark Opposition Board in 2007 because the trademark, in the eyes of the consumer, advertises products related to a pharmacy and that are available electronically.

#### 4) METHOD OF USE

How a trademark is used is important and must allow consumers to recognize it. It is often useful to provide staff with training in this regard.

A few points to bear in mind:

- the trademark should always stand out from the rest of the text; in the case of a word trademark (made up of one or several words without a logo), boldface or capital letters can be used, for example, in addition to the marking;
- in the case of a graphic trademark (with a logo), always use the same graphics. If the graphic of your trademark changes over the years, a) the registration of a new trademark will need to be considered, and b) you may be at risk of a third party requesting the cancellation of your registration for lack of use of the trademark as registered;
- the product or service must not be confused with the trademark (for example, the right use of words would be "do you have KLEENEX tissue paper?" and not "do you have a KLEENEX?") in order to prevent your trademark from becoming a generic term and losing its distinctiveness.

#### 5) DURATION

Think long-term. A trademark must be 'built to last'. A trademark registration in Canada lasts 15 years, whereas elsewhere it's often 10 years, renewable.

#### 6) INTERNATIONAL

If you are forecasting future developments for your products or services in the international market, you will need to consider how your trademark will be perceived by these consumers. For example, a trademark that you have adopted in Canada may have negative connotations in a foreign culture. This would have a direct effect on the interest given to your products or services.

## CONCLUSION

The strongest trademarks are undoubtedly those that provide an image or expression that is completely new, simple and has no defined meaning or at least not a meaning related to the goods and/or services being offered (i.e., an apple for a computer). Also remember that the first impression for a consumer is often a decisive one.

## THE STRONGEST TRADEMARKS:

According to Millward Brown's Top 100 strongest trademarks of 2010, the following are the 5 most valuable trademarks :

- 1) GOOGLE (& design), worth \$114,260M
- 2) IBM (& design), worth \$86,383M
- 3) APPLE (& design), worth \$83,153M
- 4) MICROSOFT (& design), worth \$76,344M
- 5) COCA-COLA (& design), worth \$67,983M



