



## REGISTERING YOUR TRADE-MARK... SOMETHING TO THINK ABOUT

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It is well known that the value of a trade-mark may sometimes be greater than the value of the tangible assets of a company. For example, salicylic acid molecule is no longer under patent protection, but the trade-mark Aspirin ®, registered in Canada since 1899, is extremely valuable to its owner. Every company has an interest in evaluating the opportunity to register a trade-mark application that could potentially become one of its most important assets

A trade-mark serves to identify the source of the goods or services in association with which it is used, and it serves as a reference for consumers who often perceive it as a sign of quality. Consumers know that the drug Aspirin ® is a product of Bayer and some even have the perception that the original product is more effective than the generic. The mark may therefore also be seen as a reflection of the reputation of the company that owns it. One only needs to think of luxury goods such as Christian Dior ® perfume products or Cirque du Soleil ® entertainment services.

With such a crucial function, and sometimes a priceless value, it is normal that trade-mark owners look into maximizing the protection of their trade-marks. One way to do so is to obtain a trade-mark registration with the Canadian Intellectual Property Office (CIPO).

In Canada, a trade-mark creates rights through its use, but the registration confers countless advantages to its owner, including advantages regarding:

- a) use of the trade-mark,
- b) registration of title,
- c) its protection,
- d) registration abroad,
- e) proposed use of the mark,
- f) registration of a domain name,
- g) use of the mark in a language other than French,
- h) licensing of the mark.

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The following examples will illustrate some of the numerous benefits of obtaining a trade-mark registration in Canada:

#### **a) Right to the Exclusive Use of the Trade-Mark**

Registering a trade-mark gives its owner the exclusive right to use it (and thus to protect it) across Canada, even if the mark is actually used only in a limited area of the country. On the other hand, an unregistered trade-mark can only be protected within the limits of the territory where it is used and where it has acquired some goodwill due to its recognition and reputation (which the owner has the burden of proving).

#### **b) Registration of the Trade-Mark's Title**

The registration of a trade-mark on the federal register makes it "public". It becomes concrete evidence and a public recognition of the exclusive right held by the owner of the mark throughout Canada. Others will not be allowed to register the same trade-mark or a confusingly similar trade-mark. The Trade-marks Office will indeed refuse the registration of a subsequent trade-mark if it creates confusion with a previously registered trade-mark (or with a trade-mark for which an application is pending).

The registration may also serve as a disincentive for people to use a similar trade-mark if they conduct searches on the trade-mark register to determine the availability of such a mark.

#### **c) Protection of the Trade-Mark**

The registration of a trade-mark gives to its owner a wider range of legal remedies to consider in case of infringement of its trade-mark rights and against a third party who would use, in Canada:

- i) an identical mark designating identical goods or services ("knock off" goods for instance),
- ii) a mark which creates confusion with its own mark, or
- iii) a mark likely to depreciate the value of the goodwill attached to its registered trade-mark.

As a shield, a trade-mark registration can be used as a defense by its owner sued in an action for unfair competition (known as "passing off").

Once registered, the trade-mark, whether displayed on a product, on a package or in an advertisement, may be accompanied by the symbol ®, indicating to consumers (and to competitors!) that this trade-mark is duly registered with the CIPO.

#### **d) Registration Abroad**

For Canadians (whether individuals or corporations) doing business abroad or with export projects, the registration of a trade-mark in Canada can facilitate the registration in foreign countries, insofar as it can be used as a filing basis in these other countries, without having to show or to declare the use of the trade-mark in the countries where registration is sought.

In addition, and subject to certain conditions, an application for registration abroad filed within six months of the Canadian application allows the applicant to claim the same filing date as the Canadian application, which gives some flexibility to those seeking trade-mark protection outside the country.

#### **e) Proposed Use**

Filing an application for the registration of a trade-mark on the basis of proposed use in Canada, i.e. when the mark is not on the market yet, also has its advantages. Such a filing, used to "reserve" a trade-mark during the development of products that would be commercialized under said mark, may therefore serve as a barrier to subsequent applications for confusingly similar trade-marks.

#### **f) Domain Names**

Trade-mark owners often wish to protect associated domain names, i.e. unique addresses used on the Internet. Sometimes, third parties will try to register domain names including names or marks that they do not use themselves. Fortunately, in arbitration cases concerning domain names, a trade-mark registration corresponding to the domain name which is the subject of the dispute will be considered as sufficient evidence to prove the plaintiff's rights in the trade-mark. A trade-mark registration will also facilitate the plaintiff's burden of proof in court proceedings initiated against "cybersquatters".

#### **g) Use of a Language other than French in a Trade-mark**

For goods and services commercialized or offered in the province of Quebec, trade-marks composed of terms in a language other than French may constitute problems with respect to the various language requirements imposed by the Charter of the French language and its regulations. However, the Quebec Office of the French language considers that a registered trade-mark (in English for instance) is an exception to these requirements and therefore allows the use of a registered trade-mark in a language other than French.

#### **h) Trade-mark Licensing**

A registered trade-mark may represent an additional source of income when it is used under license (i.e. when its owner authorizes a third party to use it under certain conditions, while preserving ownership ) or when it is the subject of a franchise, for particular goods or services and/or for a particular territory.

This short list of advantages of registering a trade-mark is of course not exhaustive. It would be difficult to list them all, not to mention that each trade-mark registration has its own advantages, within its specific context and depending on the products and services covered by each mark. Regardless of the situation, one thing is clear, registering a trade-mark is always something to think about.



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