



How to register Trademarks in Canada



Trademarks in Canada

- Canadian Intellectual Property Office
 - Trademarks Branch
- *Trade-marks Act*
- *Trade-marks Regulations*
 - *Examination Manual*
- Federal Court
- Case law

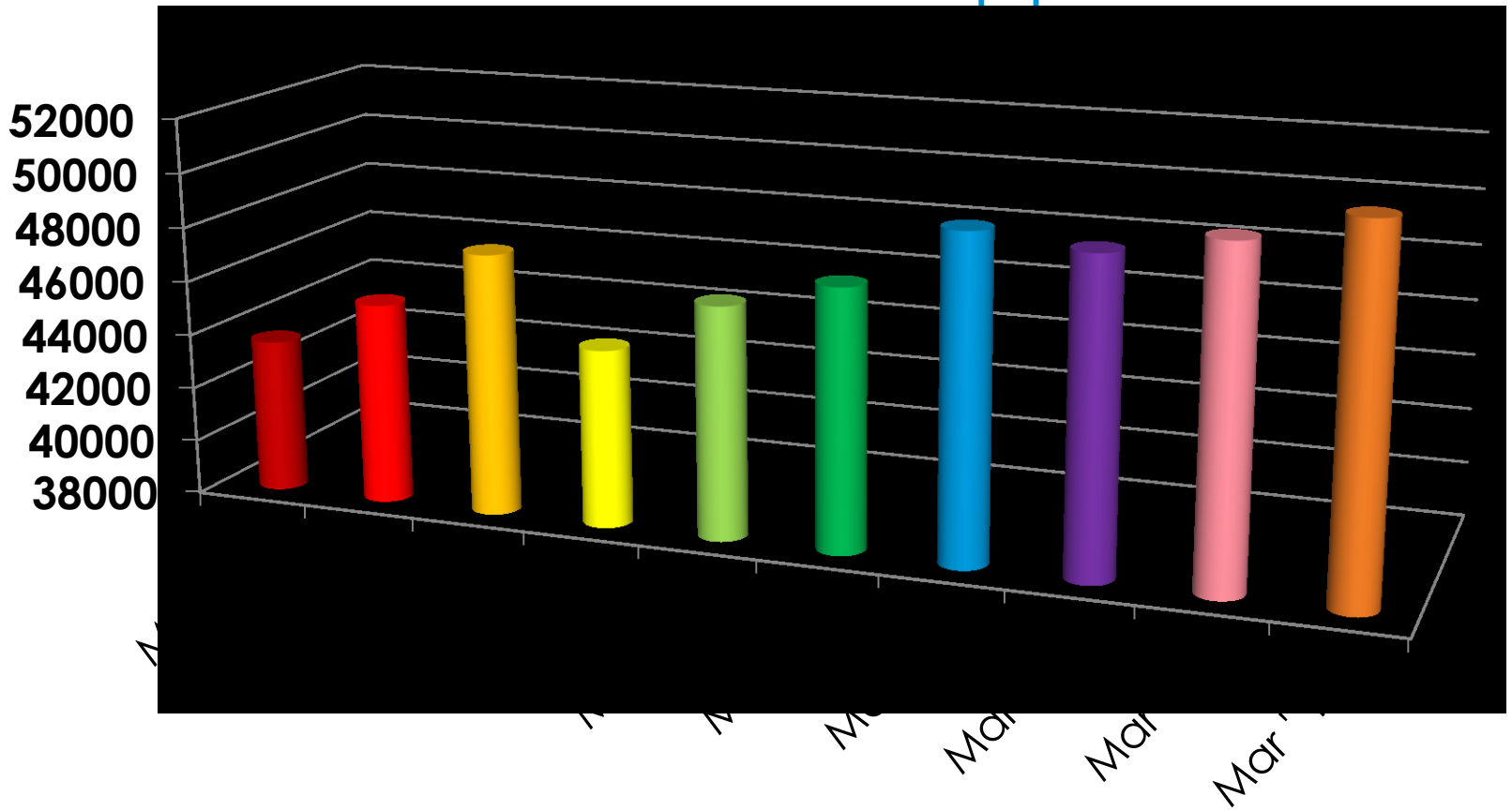
Trademarks Office Main Functions

- Index trademarks to allow for searching
- Receive and examine trademark applications
- Register trademarks and keep a listing of registered trademarks (Trademarks Register)
- Record transfers of trademarks (such as assignments)

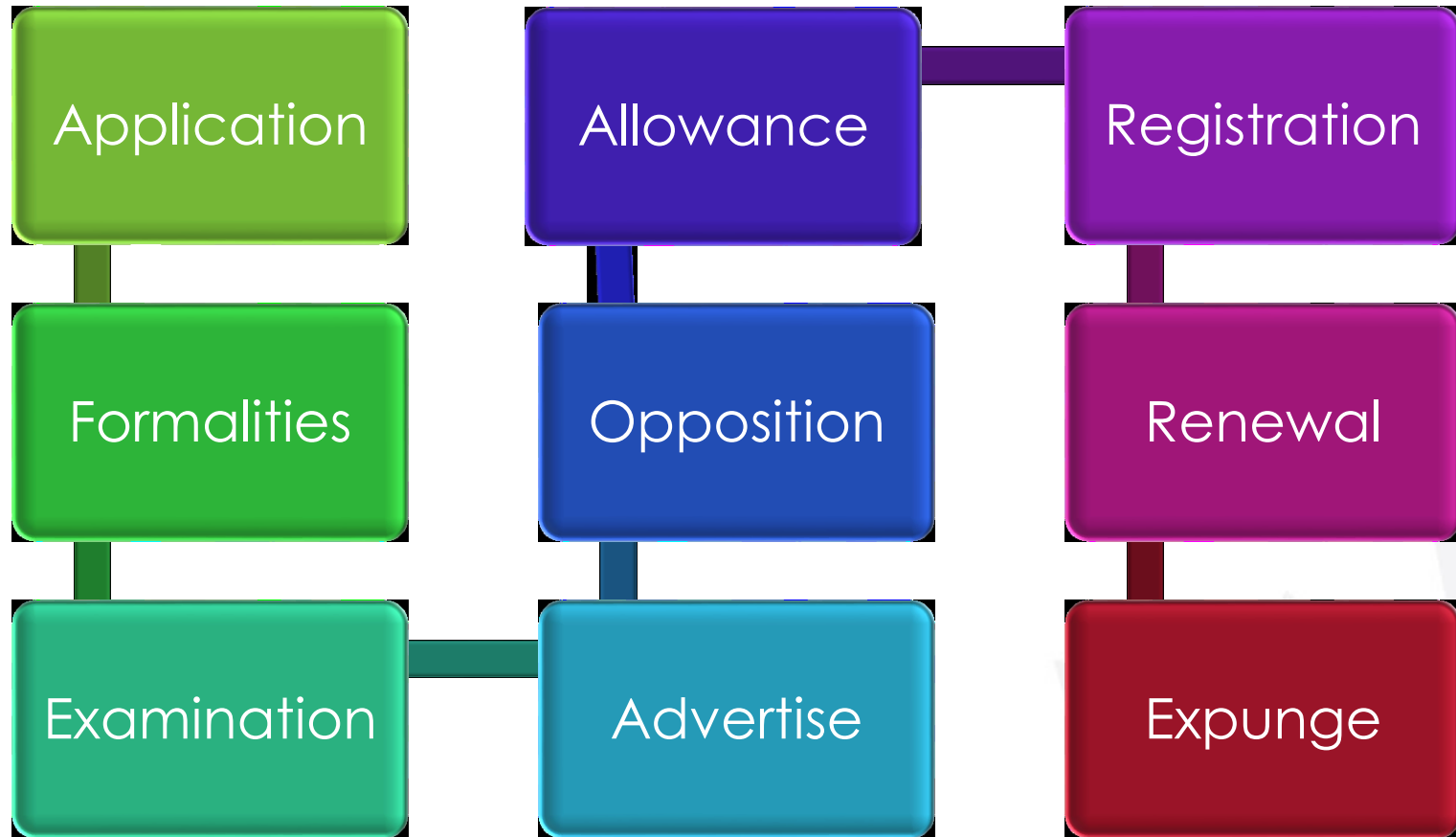
Trademarks Office Main Roles

- Maintain an accessible inventory of applied for and registered trademarks (Trademarks Records)
- Maintain a list of protected geographical indications
- Provide general information to the public about the trademark registration process
- Maintain a list of trademark agents
- Provision of the weekly *Trade-marks Journal*

Volume of Trademark Applications



Filing a trademark application in Canada



Filing

Trademark applications may be filed electronically, by fax, by mail or in person.

- Electronic applications are downloaded by the formalities section daily.
- Fax and mail applications are received by the CIPO mail room.
- Client Service Centre receives walk-ins.



Trademark Application

- Online filing:
 - http://www.ic.gc.ca/eic/site/cipointernet-internetopic.nsf/eng/wr01369.html?Open&wt_src=cipo-tm-main
- Applying by paper, forms are located here:
 - http://www.ic.gc.ca/eic/site/cipointernet-internetopic.nsf/eng/h_wr00021.html?Open&wt_src=cipo-tm-main#trade-marks

Goods and Services

- Paragraph 30(a) of the *Trade-marks Act*
- ***Goods and Services Manual***
 - Pre-approved list
 - Nice classification

<https://www.ic.gc.ca/app/scr/ic/cgs/ext/home.html?lang=eng>

Official Languages

- French and English
- May apply in either language
- All websites and information is available in both languages



Foreign applicants

- Does the applicant need a place of address within Canada?
- Representative for service
- Do you need a trademark agent to apply?
- How to find a trademark agent
 - www.cipo.gc.ca

Registrability of a Trademark

Whether a trademark can be registered is based on the interpretation and application of the *Trade-marks Act*, *Trade-marks Regulations*, Office Practices and case law.



Examination Process

- Contents of the application
- What cannot be registered?
- Search for confusion
- Review of Goods and Services & Nice Classes
- Approval for publication
- Refusal

Search for confusion

- Database
 - CIPO website
 - <http://www.cipo.ic.gc.ca/app/opic-cipo/trdmrks/srch/bscSrch.do?lang=eng>
- Purpose of the search
- Test for confusion

Refusal

- Grounds for Refusal
- Appeal the decision
- Federal Court

Advertisement

Trade-marks Journal

- Published every Wednesday.
- Contains all approved applications, official marks, erratums and Office rulings.
- Application details allow others to protect their trademark rights by filing an opposition.

Opposition

Any person may oppose an advertised trademark within 2 months from the date the application is advertised in the *Trade-marks Journal*.

The statement of opposition must set out the grounds relied upon by the opponent.

Allowance

- After the opposition period, if an application is not refused or abandoned, the application is allowed.
- The Trademarks Office will acknowledge that an application is eligible for registration.
- A notice of allowance is sent requesting the \$200 registration fee AND a declaration of use if the application is based on proposed use in Canada.

Registration

Once the trademark is registered, a certificate of registration is issued to the applicant.

A registration is valid for 15 years and is renewable indefinitely.



Registration

A trademark registration can be protected through legal proceedings from misuse and imitation.

Example:

***Coca-cola* is a registered trademark. If someone uses the mark *Coca-cola* on similar goods and sells them as their own, they will be violating the trademark rights of the owner. Such unauthorized use of a trademark is called infringement.**

Renewal

- May be renewed every 15 years from the date of registration.
- A renewal notice is sent.
- A 6-month period is given to renew after 15 years from the date of registration.

Expungement

Failure to renew

Order from the Federal Court

Section 45 proceedings

Transfer

- The applicant or owner of a trademark can transfer their rights to another party at any time.
- A transfer is recorded by the trademarks Office upon submission of evidence and the prescribed fee (\$100 for each trademark).
- The most common type of transfer is an “assignment”.

Fees

- **List of fees found on CIPO website**
 - Filing an application is \$250 if filed **online**, or \$300 if filed by **paper** or **fax**.
 - **This fee is NON-REFUNDABLE.**
 - Registration fee - \$200
 - Transfer of trademark - \$100
 - Renewal fee - \$350 if renewed online, or \$400 by other means.

Need Help?

- Website
 - Guide to trademarks
 - How your application is processed
 - Trademark Examination Manual
- Client Service Centre
 - 1-819-934-0544
 - You can also schedule a phone appointment with an information officer on our website
- Call the examiner on file
- Call your Canadian trademark agent



Questions??

Thank You / Merci

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