



Find and share the knowledge: Canada

Trademark Knowledge Share focuses on Canada, with Cynthia Rowden of Bereskin & Parr LLP answering questions about trademark litigation and management.

Q1. What conventions, Multilateral or Bilateral agreements are pertinent to the protection of trade identities in your jurisdiction?

Canada is not yet a signatory of the Madrid Protocol, the Singapore Agreement or the Nice Agreement on Classification, but the government has committed to having these implemented shortly. The Paris Convention currently applies.

Q1a. What national legislation is pertinent to the protection of trade identities in your jurisdiction?

Trademarks are protected in the *Trade-marks Act*, the *Olympic and Paralympic Marks Act* and by some provisions of the *Criminal Code*.

Q2. Is your jurisdiction a first-to-use jurisdiction or a first-to-register jurisdiction?

Currently, it is a first-to-use jurisdiction. Priority is established by the earliest of use or application, or between two applicants with no use, the first to file (subject to an earlier priority date).

Q2a. Please describe the rights afforded by use and separately by registration in your jurisdiction.

Unregistered rights are enforceable in an action for passing off, but depend upon the owner showing that it has acquired rights in the area in which it is asserting a claim.

That requires the demonstration of a reputation or goodwill, plus misuse by a third party, with a likelihood of confusion. A registration entitles the owner to the exclusive right to use the mark for the registered goods/services across the country.

Q3. What type of marks are registrable in your jurisdiction, (e.g., trademarks, service marks, collective marks, certification marks)?

Trademarks, including certain shapes or distinguishable designs, are registrable. So are service marks and certification marks.

Q4. Are there any marks prohibited from registration (e.g. flags, symbols) in your jurisdiction?

There is a long list of prohibited marks, including government marks, flags and signs, marks of the Red Cross, and marks protected as published geographic indications or plant breeds. In addition, various Olympic and Paralympic marks are proscribed, as are marks that have been published on behalf of public authorities, colleges and universities, and the Department of National Defense. Many prohibitions are set out in sections 9, 10 and 11 of the *Trade-marks Act*.

Q5. Who is the proper applicant for registration?

Ideally, the applicant should be the entity that will use the mark and/or control the character of the goods and services.

Q5a. Can a partnership, individual, other legal body or non-legal body file and hold trademark rights?

Applicants can be individuals, companies, legal partnerships, joint ventures, and other legal entities.

Q6. Is your jurisdiction a member of the Nice Classification?

Not currently but it is expected very soon.

Q6a. If not, please provide a listing of the goods/services included?

Goods and services must be defined in ordinary commercial terms.

Résumé

Cynthia Rowden, Partner and Head, Bereskin & Parr LLP

Cynthia is a partner and head of one of Canada's largest trademark teams. She specializes in all areas of trademark and copyright law, and manages international trademark portfolios of large Canadian companies and the Canadian portfolios of some of the biggest trademark owners in the world. In addition to being a frequent writer and speaker on trademark law, Cynthia is currently very active with organizations looking into major changes to Canada's TM laws. Cynthia was named *Best Lawyers' 2014 Toronto Intellectual Property Law "Lawyer of the Year"* on *The 2014 Best Lawyers in Canada*, and was awarded "Trademarks Lawyer of the Year" by *Who's Who Legal*.



Q7. Please list the documents required for filing a trademark application.

No specific documents are required, unless an applicant applies to register its mark based on use and registration abroad, in which case it must file a certified copy of its home country registration. That can be filed after application, but must be filed before advertisement.

Q8. Please describe whether your jurisdiction is an examination jurisdiction and if so, please describe the kind of examination, i.e. for formalities, for relative rights or for absolute rights.

Canada is currently an examination country, and examines for compliance with certain formalities, as well as relative and absolute grounds.

Q9. Please describe any marks which are not registrable according to your legislation (e.g., geographical terms, foreign words, surnames, etc.).

Names and surnames are generally unregistrable, as are words, including geographic words, that clearly describe the goods/services in English or French. Words that are the name of the goods/services in any language are unregistrable. In addition, as noted above, there are many prohibited marks.

Q10. Does your jurisdiction have an opposition procedure?

Yes. Once the mark is approved by the Trade-marks Office, it will be advertised for opposition.

Q10a. Please describe the opposition procedure, including the bases for filing an opposition and also the opposition term, whether there is a possibility for extension for filing an opposition. Can oppositions be suspended?

The initial term for opposing or requesting an extension of time to oppose, is two months from advertisement of the mark in the *Trade-marks Journal*. An extension is permitted. Oppositions cannot be suspended in the sense of being put into a pending status, except pursuant to specifically permitted extensions of time. The opposition is formally commenced by filing a statement of opposition, followed by the applicant's counter statement. Each party may file evidence by affidavit, or by filing certified copies of documents from the *Register of Trade-marks*. Any witness may be cross-examined. Both

parties may file written submissions and may also request a hearing. The decision of the Registrar may be appealed to the Federal Court, and new evidence is permissible on appeal.

Q11. Please describe any documents which are required to place an opposition on file.

See above. A statement of opposition is required.

Q12. Is it possible to file cancellation proceedings in your jurisdiction?

Yes. A registration may be cancelled for non-use and for abandonment, at any time, three years from the date of registration. In addition, a registration may be expunged if it is no longer distinctive, or if the mark was not originally registrable, or the owner was not the person entitled to register the mark.

Q13a. If so, please set out the procedure, including who has standing to cancel and the bases of cancellation.

Any person may request the Registrar to forward a notice to a registrant of a mark once the third anniversary of that registration has passed. That will commence non-use proceedings. The other challenges to a registration must be commenced by an interested party as part of expungement proceedings in the Federal Court.

Q14. What is the term of a registration and can a registration be renowned early without shortening the terms of registration?

Currently the term is 15 years, but it will change to 10 upon Canada's accession to international treaties for the protection of trademarks. There is no procedure to "renown" a mark.

Q15. Please describe the renewal requirements for renewing a registration setting out the procedure.

Renewal is upon written or online request and payment of the required fee. No other formalities or proof of use are required.

Q15a. Is proof of use of the mark required to be filed on renewal?

No.

Q15b. Is it possible to file later renewal?

Yes, there is a grace period of six months that runs from notice from the Registrar.

Q16. What are the requirements for maintenance of a registration in your country? That is, is it necessary during the life of a registration, to file any proof of use to maintain the registration?

There is no requirement to file proof of use of a mark, either to obtain a registration or to renew a registration. However, a registration may be cancelled for non-use.

Q16a. Are there marking requirements for your jurisdiction?

There are no statutory marking requirements, but they are recommended to ensure that a trademark is identified as such by the public. However, if a mark is used by a licensee, and notice is given of the identity of the trademark owner and the fact that use is under license, the trademark owner is deemed to control the quality and character of the use, a requirement for maintaining distinctiveness of a licensed mark.

Q16b. If so, what is the appropriate wording for any notice as to the registration?

Trademark of X Company. Used under license by Y Company. A shorter version could be TM of X Company, used under license. If a mark is registered, the ® symbol is also used.

Q16c. What is the effect of using the notice and is it forbidden to make a false claim of registration?

Trademark notices help to ensure that the public recognizes the trademark significance of words/designs and other marks. As noted above, a notice is recommended where a mark is used by a licensee. A false claim of registration is not actionable under the *Trade-marks Act*, but could be viewed as false advertising (there is no case law to that effect).

Q16d. Can the ® (registered trademark symbol) be used to notify that a mark is registered?

Yes.

Q17. Please describe the procedure for the proper licensing of trademarks.

To avoid any issues of non-distinctiveness, a trademark owner should license all licensees, and pursuant to the terms of the license, should control the character and quality of the goods and services. A written license is preferable. The trademark owner should be in a position to demonstrate how it actually exercises control – that is, a written license with no supervision by the trademark owner, directly or indirectly, may not be sufficient to permit the owner to rely upon the provisions of the *Trade-marks Act* that deem use by a licensee under the control of the owner to have the same effect as use by the owner.

Bereskin & Parr LLP
40 King Street West, 40th floor
Toronto, ON, Canada M5H 3Y2
Tel: 416.364.7311
Fax: 416.361.1398
Toll-free: 1.888.364.7311

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