



ICLG

The International Comparative Legal Guide to:

Trade Marks 2013

2nd Edition

A practical cross-border insight into trade mark work

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Canada

Daniel R. Bereskin, Q.C.



Cynthia Rowden



Bereskin & Parr LLP

1 Relevant Authorities and Legislation

1.1 What is the relevant Canadian trade mark authority?

The Canadian Intellectual Property Office (CIPO) is the relevant authority.

1.2 What is the relevant Canadian trade mark legislation?

The relevant legislation is the Trade-Marks Act (R.S.C., 1985, c. T-13, as amended (“TMA”)), and Trade-marks Regulations (SOR/96-195). Bill C-56 entitled Combating Counterfeit Products Act (“CCPA”) currently is before Parliament, and, when enacted, will make several substantial changes to Canadian trade mark and copyright law.

2 Application for a Trade Mark

2.1 What can be registered as a trade mark?

Words, numerals, designs, three-dimensional shaping of wares or their containers, modes of packaging wares, and marks consisting of distinctive sounds, can be registered. Under the CCPA, “signs” capable of registration additionally include scent, taste, texture and positioning of a sign.

2.2 What cannot be registered as a trade mark?

The following cannot be registered:

- names and surnames;
- clearly descriptive marks;
- “deceptively misdescriptive” marks;
- words that denote a geographical location;
- the name of the goods or services in any language; words or designs that are considered confusing with a previously registered trade mark or prior pending trade mark;
- marks dictated primarily by utilitarian function; and
- words or designs that are the same or virtually the same as marks protected under ss. 9 and 10 of the TMA, e.g. certain protected flags and crests, words and symbols of the Canadian armed forces and other institutions, of universities, “official marks” of public authorities in Canada, and Olympic marks (note, such marks may be registrable if consent is obtained).

In addition, marks that resemble protected marks under the Plant

Breeders’ Rights Act and as geographic indications (for certain alcoholic beverages) are also unregistrable. Descriptive marks may be registrable upon proof of acquired distinctiveness at the filing date of the application. The CCPA adds marks that are not distinctive at the filing date to the list of unregistrable marks.

2.3 What information is needed to register a trade mark?

The following information is needed:

- the applicant’s name and address;
- the name of each predecessor in title;
- graphical representation of the mark, in the case of a design mark;
- description of goods or services set out in ordinary commercial terms;
- date of first use in Canada for specified goods or services, if applicable;
- priority claim;
- any colour claims; and
- particulars of home registration or application, list of goods/services for which use has occurred abroad as at the filing date in Canada, and the name of the country or countries where such use has occurred (when relying on home registration and use in any country as a ground for filing).

2.4 What is the general procedure for trade mark registration?

Trade mark applications are filed based on the information indicated in question 2.3 above; no power of attorney or other similar documentation is required. After filing, an examiner reviews the application on both relative and absolute grounds and may issue an official letter if there are any objections. After all objections have been overcome, the application is advertised for opposition. If no opposition is filed within two months following advertisement, the application is allowed, and the registration will be issued if the application has been based on use in Canada, or on a home registration and use in any country. If the application is based on proposed use in Canada, the registration is not issued unless and until a declaration of use in Canada is filed on behalf of the applicant.

2.5 How can a trade mark be adequately graphically represented?

Representation is by a drawing in black and white with sharp lines

and edges. Filled areas should be in solid black unless lines are used to indicate colour. If colour is claimed as a feature of the trade mark, the colour must be described in the application. It is not possible at present to submit colour depictions of trade marks even if colour is claimed: drawings must be in black and white.

2.6 How are goods and services described?

The statement of wares and services is required to be in “ordinary commercial terms”. CIPO provides a guide for the description of wares and services on its website, at <http://www.ic.gc.ca/app/opic-cipo/wrs/dsplyPbleSrch.do>. The description of wares and services normally must be quite specific; class headings and broad descriptions are not acceptable.

2.7 What territories (including dependents, colonies, etc.) are or can be covered by a Canadian trade mark?

A trade mark registration confers protection throughout Canada, which has no dependents or territories.

2.8 Who can own a Canadian trade mark?

Companies, individuals, partnerships, trade unions, and lawful associations, can own a Canadian trade mark.

2.9 Can a trade mark acquire distinctive character through use?

Yes. A non-functional trade mark otherwise not registrable may be registered if it can be shown that the trade mark has become distinctive at the date of filing of the application. The CCPA permits the Registrar to require evidence of distinctiveness at the filing date for many non-traditional marks.

2.10 How long on average does registration take?

Assuming no objections (or objections easily and quickly met), and no oppositions, it generally takes between about 12-14 months for an application to receive a Notice of Allowance. If the application is based on use in Canada or home registration and use abroad, registration follows shortly after payment of the final fee, otherwise it is delayed until after a Declaration of Use in Canada is filed.

2.11 What is the average cost of obtaining a Canadian trade mark?

The government filing fee for filing a trade mark application in Canada, for wares or services irrespective of the number of classes, is CAD\$250 if the application is filed online) and approximately CAD\$685 for the agent’s fee. Additional expenses will be incurred depending upon filing grounds, examination and/or opposition. It is also necessary to pay a government fee before registration.

2.12 Is there more than one route to obtaining a registration in Canada?

Yes, registration can be obtained either based on use in Canada, or based on a home registration and use in any country.

2.13 Is a Power of Attorney needed?

No, it is not.

2.14 How is priority claimed?

Priority is claimed by a declaration contained in the application, setting out the filing date and country of filing of the priority application. It is not necessary to file certified or uncertified copies of convention applications, unless specifically asked to do so by the Trade-marks Office.

2.15 Does Canada recognise Collective or Certification marks?

Canada recognises Certification marks, which are used to distinguish goods or services of a defined standard. The CCPA will permit, for the first time, filing applications for the registration of proposed Certification marks.

3 Absolute Grounds for Refusal

3.1 What are the absolute grounds for refusal of registration?

The absolute grounds for refusal are:

- a word that is primarily merely the name or the surname of an individual who is living or has died within the preceding thirty years;
- whether 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 or proposed to be used or of the conditions of or the persons employed in their production or of their place of origin;
- the name in any language of any of the wares or services in connection with which it is used or proposed to be used;
- confusion with a registered trade mark; or
- a mark which consists of, or so nearly resembles as to be likely to be mistaken for, a mark prohibited under s. 9 or 10 of the TMA, a protected geographic indication or a mark protected under the Olympic and Paralympic Marks Act. The CCPA also prohibits registration of marks that are primarily utilitarian or non-distinctive.

3.2 What are the ways to overcome an absolute grounds objection?

Objections on absolute grounds may be overcome by argument. A trade mark that is not otherwise registrable under section (a) or (b) in question 3.1 above may be registrable if it can be shown that use of the mark in Canada in association with the associated goods or services has become distinctive at the date of filing of the application in Canada. A somewhat lesser standard of proof of acquired distinctiveness may be available to a foreign applicant who has a home registration for the same or substantially the same mark and can prove that the trade mark “is not without distinctive character” at the filing date of the application in Canada.

3.3 What is the right of appeal from a decision of refusal of registration from the Intellectual Property Office?

An appeal may be filed with the Federal Court of Canada.

3.4 What is the route of appeal?

The Trial Division of the Federal Court of Canada is the Court of First Instance for appeals from decisions of the Registrar of Trade-marks. Appeal from the Federal Court is to the Federal Court of Appeal without leave. Appeals from decisions of the Federal Court of Appeal are made to the Supreme Court of Canada, with leave.

4 Relative Grounds for Refusal

4.1 What are the relative grounds for refusal of registration?

The relative grounds of refusal are: confusion with a registered trade mark; confusion with a mark previously used or made known in Canada; confusion with a trade mark for which an application for registration had previously been filed in Canada by another person; and confusion with a trade name that had previously been used in Canada (opposition ground only).

4.2 Are there ways to overcome a relative grounds objection?

Examiners will consider arguments that the respective trade marks are not confusing based on differences between the respective marks, differences in the goods or services and other factors such as those set out in s. 6 (5) of the TMA.

4.3 What is the right of appeal from a decision of refusal of registration from the Intellectual Property Office?

See question 3.3 above.

4.4 What is the route of appeal?

See question 3.4 above.

5 Opposition

5.1 On what grounds can a trade mark be opposed?

The grounds are:

- non-compliance with section 30 (formalities);
- non-registrability on absolute grounds;
- non-registrability on relative grounds; and
- non-distinctiveness.

5.2 Who can oppose the registration of a Canadian trade mark?

Any person can oppose the registration of a Canadian trade mark, except for oppositions based on prior use of a confusingly similar unregistered trade mark or trade name that has not been abandoned, in which case only the prior user or a successor of the prior user can oppose on this ground.

5.3 What is the procedure for opposition?

The procedure for opposition is to file a statement of opposition, and pay the prescribed government fee. A properly pleaded statement of opposition must set out the grounds of opposition in

sufficient detail to enable the applicant to reply. The Registrar may not permit the opposition to proceed if the statement of opposition fails to raise a substantial issue for decision, although this rarely occurs.

6 Registration

6.1 What happens when a trade mark is granted registration?

The official Certificate of Registration is mailed to the applicant's agent. Registration of a trade mark grants the owner the exclusive right to use the mark throughout Canada for 15 years. Registration is *prima facie* evidence of ownership.

6.2 From which date following application do an applicant's trade mark rights commence?

Common law rights arise in Canada as a result of use or making known of a trade mark in Canada. Rights under a trade mark registration commence with the issuance of the registration.

6.3 What is the term of a trade mark?

The term of a trade mark is 15 years.

6.4 How is a trade mark renewed?

A trade mark is renewed by payment of a government fee, at present CAD\$350 if submitted electronically prior to the expiry of 15 years from the date of the registration or last renewal, subject to a grace period of six months. Proof of use is not required for renewal.

7 Registrable Transactions

7.1 Can an individual register the assignment of a trade mark?

Yes, they can.

7.2 Are there different types of assignment?

Yes, for example, a partial assignment may be recorded with respect to specified wares or services in certain circumstances.

7.3 Can an individual register the licensing of a trade mark?

Registration of a licence is possible, but not necessary, and is seldom done.

7.4 Are there different types of licence?

Licences may be exclusive, non-exclusive, or sole.

7.5 Can a trade mark licensee sue for infringement?

A licensee of a registration can sue for trade mark infringement provided that the owner is also named as a party to the suit.

7.6 Are quality control clauses necessary in a licence?

A licensor must be able to control the character and quality of the wares or services associated with the licensed mark.

7.7 Can an individual register a security interest under a trade mark?

Security interests under a trade mark can be recorded by filing a copy of the security agreement which clearly identifies the property against which the security is granted and payment of the prescribed fee. Recordation is done for information purposes only. The TMA does not deal with the impact of such recordation (or failure to record) on the rights of other parties, including subsequent purchasers.

7.8 Are there different types of security interest?

Any charge for which a trade mark registration or application is submitted as collateral may be recorded.

8 Revocation

8.1 What are the grounds for revocation of a trade mark?

The normal grounds for revocation are invalidity (see below) and non-use. For cancellation based on non-use, after three years from the date of registration, any person may make a written request to the Registrar, accompanied by the required fee, that a notice be sent to the registrant requiring the registrant to submit evidence of use of the trade mark within the period of three years immediately preceding the date of the notice.

8.2 What is the procedure for revocation of a trade mark?

See question 8.1 above. Upon issuance of the notice from the Registrar, the registrant is required to verify proof of use. After evidence has been filed on behalf of the registrant, the requesting party is then given an opportunity to file written representations concerning the adequacy of the registrant's evidence, to which the registrant is entitled to reply. An oral hearing may be requested. After all of the stages are complete, the Registrar issues a written decision. This decision is appealable to the Federal Court.

8.3 Who can commence revocation proceedings?

Any person is entitled to request that a cancellation notice be issued.

8.4 What grounds of defence can be raised to a revocation action?

Evidence of use must be filed, or, if not available, reasons excusing such non-use must be submitted (rarely accepted).

8.5 What is the route of appeal from a decision of revocation?

An appeal from a decision may be made to the Federal Court.

9 Invalidity

9.1 What are the grounds for invalidity of a trade mark?

The grounds are:

- the trade mark was not registrable at the date of registration;
- the trade mark is not distinctive at the time proceedings bringing the validity of the registration into question are commenced;
- the trade mark has been abandoned; or
- the applicant for registration was not the person entitled to secure the registration.

The CCPA adds the possibility of expungement if the Court finds the mark will unreasonably limit the development of any art or industry.

9.2 What is the procedure for invalidation of a trade mark?

The Federal Court of Canada has exclusive jurisdiction to order that any registration be struck out or amended. In addition, applications may be filed with the Federal Court of Canada or another Court of competent jurisdiction, seeking an order *inter partes* that the registration is invalid. Such applications may be filed by Statement of Claim, Statement of Defence, Counter Claim, etc.

9.3 Who can commence invalidation proceedings?

Any "person interested" may commence an expungement proceeding. A "person interested" is any person who is affected or reasonably apprehends that they may be affected by any entry in the register, or by any act or omission or contemplated act or omission under or contrary to the TMA.

9.4 What grounds of defence can be raised to an invalidation action?

The grounds for defence include that the trade mark was registrable, the trade mark was distinctive, the trade mark has not been abandoned, and that the registrant is the party entitled to registration.

9.5 What is the route of appeal from a decision of invalidity?

A decision of invalidity may be appealed to the Federal Court of Appeal without leave, and Supreme Court of Canada with leave.

10 Trade Mark Enforcement

10.1 How and before what tribunals can a trade mark be enforced against an infringer?

Trade mark infringement and passing off claims may be brought before the Federal Court of Canada or before any provincial Court of competent jurisdiction.

10.2 What are the pre-trial procedural stages and how long does it generally take for proceedings to reach trial from commencement?

Prior to trial before a judge, parties will submit pleadings, conduct

documentary discovery, examinations for discovery, and in some cases the exchange of expert reports. Typically, the period to reach trial from commencement is 4-5 years, but trials can be expedited in some circumstances.

10.3 Are (i) preliminary and (ii) final injunctions available and if so on what basis in each case?

Interim or interlocutory injunctions, as well as permanent injunctions, are available in Canada.

For the grant of an interlocutory injunction, the court will require:

1. that there be a serious question to be tried in the main action;
2. that, in the absence of an interlocutory injunction, the plaintiff will suffer irreparable harm; and
3. that the balance of convenience as between the parties favours the grant of an injunction.

If one of these factors is absent, then the injunction usually will not be granted. In general, it is difficult to obtain interlocutory injunctions in trade mark cases particularly in the Federal Court where such injunctions are seldom granted. A final or permanent injunction may be granted to a plaintiff who has established that the legal rights in issue have been unlawfully invaded.

10.4 Can a party be compelled to provide disclosure of relevant documents or materials to its adversary and if so how?

Yes, if the document is relevant, it must be produced at discovery.

10.5 Are submissions or evidence presented in writing or orally and is there any potential for cross-examination of witnesses?

Evidence at trial is both *viva voce* and through documentary evidence. Each party has the right to cross-examine opposing witnesses at trial.

10.6 Can infringement proceedings be stayed pending resolution of validity in another court or the Intellectual Property Office?

Section 50(1) of the Federal Courts Act gives the Court discretion to grant a stay on the ground that the claim is being prosecuted in another Court or jurisdiction.

10.7 After what period is a claim for trade mark infringement time-barred?

Trade mark infringement usually consists of recurring breaches, and therefore they are not time-barred unless it is determined that the plaintiff is guilty of laches or acquiescence, neither of which is easy to prove. Statutes of Limitations vary from one Canadian province to another, but are seldom involved in trade mark cases.

10.8 Are there criminal liabilities for trade mark infringement?

The Canadian Criminal Code provides for certain offences relating to trade mark infringement, including:

- 1) forgery of a trade mark;
- 2) possessing or disposing of instruments for forging a trade mark; or

- 3) defacing a trade mark.

These offences are punishable by fine or imprisonment.

The CCPA, when enacted, will provide additional criminal as well as civil sanctions against any persons found guilty of dealing in counterfeit trade marked goods.

10.9 If so, who can pursue a criminal prosecution?

Typically, this is done by provincial or federal police (Royal Canadian Mounted Police), on the advice of a Crown prosecutor.

10.10 What, if any, are the provisions for unauthorised threats of trade mark infringement?

Any groundless threat of trade mark infringement that causes damage to the receiving party is actionable under s. 7(a) of the TMA, and at common law. Any such threat also makes the receiving party an “interested person” justifying bringing an application for expungement of the registration with the Federal Court of Canada.

11 Defences to Infringement

11.1 What grounds of defence can be raised by way of non-infringement to a claim of trade mark infringement?

A defendant may defend a claim of trade mark infringement by demonstrating that the respective marks are not confusing, or that the plaintiff is not entitled to equitable relief by reason of the plaintiff’s own conduct.

11.2 What grounds of defence can be raised in addition to non-infringement?

A defendant may also defend an action for trade mark infringement on the ground that the registration is invalid, or that the owner does not have proper title to the trade mark, amongst other grounds.

12 Relief

12.1 What remedies are available for trade mark infringement?

The following remedies are available: an injunction; damages or an accounting of profits; delivery up or destruction under oath of all infringing materials; and costs.

12.2 Are costs recoverable from the losing party and if so what proportion of the actual expense can be recovered?

Yes. The amount varies, but typically it is roughly one-half of the actual out-of-pocket expenditures.

13 Appeal

13.1 What is the right of appeal from a first instance judgment and is it only on a point of law?

An appeal lies to the Court of Appeal (Federal or provincial) from a decision of a Court of First Instance, based on errors of law.

Findings of fact cannot be reversed unless the Court of Appeal concludes that the Court of First Instance made a “palpable and overriding error”.

13.2 In what circumstances can new evidence be added at the appeal stage?

New evidence is not admitted on appeal, except from decisions of the Registrar of Trade-marks.

14 Border Control Measures

14.1 What is the mechanism for seizing or preventing the importation of infringing goods or services and if so how quickly are such measures resolved?

The owner of a registered trade mark may apply to the Federal Court for an order to seize goods when the goods are “about to be imported or have been imported into Canada but not yet released”, pending a final determination of the legality of their importation or distribution at trial. Practically speaking, the Canada Border Services Agency (CBSA) can detain counterfeit or pirated goods only if either the rights’ holder has obtained a court order or the Royal Canadian Mounted Police (RCMP) (or local police officers) agree to seize the goods. In practice, such measures are more theoretical than real.

One of the main objectives of the CCPA is to substantially strengthen border measures in aid of preventing counterfeit trade marked goods entering Canada.

15 Other Related Rights

15.1 To what extent are unregistered trade mark rights enforceable in Canada?

Unregistered trade marks are protected in Canada under the common law action of passing off and under s. 7 (b) of the TMA, which effectively is a codification of the common law of passing off. In general, in order to succeed, it must be shown that the plaintiff has acquired a reputation that is symbolised by the trade mark, that the defendant has caused or is likely to cause confusion in the area in which such reputation exists, and that the plaintiff has suffered or is likely to suffer damage. Normally, it is necessary to demonstrate that the defendant’s conduct consists of a misrepresentation of some kind, express or implied.

15.2 To what extent does a company name offer protection from use by a third party?

Protection of trade names or corporate names is possible under the law of passing off and s. 7 (b) of the TMA.

15.3 Are there any other rights that confer IP protection, for instance book title and film title rights?

No, but the ambit of the law of passing off is sufficiently broad so as to capture many misrepresentations, express or implied. Copyright may also apply in certain circumstances. Also, s. 22 of the TMA protects against dilution by blurring and tarnishment, and potentially other abuses.

16 Domain Names

16.1 Who can own a domain name?

To own a Canadian domain extension, “.ca”, a registrant must have a connection to Canada and fulfil the Canadian Presence Requirements for Registrants.

16.2 How is a domain name registered?

Applicants wishing to register a “.ca” domain name may register the domain name through a Registrar that has been certified by the Canadian Internet Registration Authority (“CIRA”). Such Registrars are the main point of contact for registrants of “.ca” domain names.

16.3 What protection does a domain name afford *per se*?

Owning and using a domain name, like owning and using an unregistered trade mark, can prevent third parties from using another similar or identical domain name through an action for passing off (see question 15.1).

In the case of a bad faith registration of a “.ca” domain name, a proper complainant (one who satisfies the Canadian Presence Requirements for Registrants or one who owns a registered Canadian trade mark), may initiate a proceeding with CIRA (known as a “CDRP Proceeding”) by submitting that:

- the Registrant’s “.ca” domain name is confusingly similar to a mark in which the Complainant had rights prior to the date of registration of the domain name and continues to have such rights;
- the Registrant has no legitimate interest in the domain name; and
- the Registrant has registered the domain name in bad faith.

17 Current Developments

17.1 What have been the significant developments in relation to trade marks in the last year?

A controversial decision of the Federal Court of Canada, *The Thymes, LLC v. Reitmans (Canada) Limited*, held that, in order for an applicant to rely validly on a home registration, use in the applicant’s country of origin must have occurred at or before the filing date in Canada. It appears that the Court misread the statute, because use anywhere should satisfy the condition. Also, the finding that use must have occurred prior to the filing date in Canada would substantially change the practice in Canada, as many practitioners routinely advise applicants to amend their Canadian applications prior to advertisement to rely on a home application or registration and use abroad. A Notice of Appeal has been filed.

17.2 Are there any significant developments expected in the next year?

The most significant change will be the enactment of the CCPA. It is not clear at the time this chapter is written whether the Bill will eventually be enacted in its original form, or whether changes will be made as a result of representations by various interest groups.

Currently, CIPRO is considering making amendments to the Trade-mark Regulations, which include measures relating to the

opposition regime intended to streamline and simplify procedures relating to filing and serving of evidence, cross-examination, written arguments and hearings, and issuance of notices, and measures relating to trade mark examination.

17.3 Are there any general practice or enforcement trends that have become apparent in Canada over the last year or so?

None of significance, subject to eventual enactment of the CCPA.



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Bereskin & Parr LLP is a leading Canadian intellectual property (IP) law firm serving clients of all sizes, in a variety of industries, both domestic and international. The firm was founded in 1965 and has grown to be one of the largest IP law firms in Canada and serves clients in over 100 countries. Bereskin & Parr LLP offices are located in major economic or technology centres: Toronto; Mississauga; Waterloo Region; and Montréal. The firm has a professional staff of more than 70 lawyers, patent and trademark agents, many of whom are recognised as leading practitioners in their respective fields. The firm's practice encompasses all aspects of intellectual property, and has the following practice groups: Trademarks; Patents (Biotechnology & Pharmaceutical, Electrical & Computer Technology, Mechanical/Industrial, Chemical, Automotive, Clean Tech); IP Litigation; Licensing & Transactions; Regulatory, Advertising & Marketing; and New Media/Copyright.

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