



INTELLECTUAL PROPERTY

Answers To Your Frequently Asked Questions

905.572.9300 | mail@blaze-ip.ca | www.blaze-ip.ca

DEFINITIONS

1 What is a trademark?

A trademark may be registered in Canada for almost any means used by a business to

distinguish its goods or services from those of its competitors in the marketplace. A Canadian trademark registration may be composed of one or more words, a graphic design, a unique form of packaging, colours, sounds, scents, and flavours, or any combination thereof.

2 What is the difference between an unregistered trademark and a registered trademark?

Registration in Canada grants the owner the exclusive right to use the trademark across Canada in association with the goods and services listed in the registration. A common law or unregistered trademark is entitled to protection only in the geographic region where it has an established reputation.

TM

In addition to giving notice to the public of your exclusive right to the trademark, a registration sets up a legal presumption that the registrant is the lawful owner of the trademark. This is especially helpful in protecting that right when a dispute subsequently arises.



3 What is an international trademark registration?

An “international trademark registration” is recorded on the “international register” maintained by WIPO but recording an “international trademark registration” on the international register does not automatically grant the registrant exclusive worldwide rights in the mark.

The international register may be better described as an international database of trademarks registered in multiple jurisdictions. Each trademark on the international register is referred to as an “international trademark registration”, but it is in fact a collection of protocol applications/registrations for the same mark in multiple countries. The international register serves a central register for coordinating the filing and management of trademark registrations for the same mark in multiple countries.

The system for recording trademarks on the international register is governed by an international treaty known as the Madrid Protocol.

4 What is an official mark?

The marks, arms, crests, and flags adopted by the following entities may be eligible for protection as so-called “official marks” in Canada:

- any level of government in Canada
- an agency of any level of government in Canada
- the Canadian military
- foreign and domestic universities
- foreign government
- “public authorities”

A “public authority” is limited to:

- a) An entity that is subject to a significant degree of control by a Canadian government.
- b) An entity whose activities benefit the public.

In this context, a government must, either directly or through its nominees, exercise a degree of ongoing influence over the entity’s governance and decision-making. Non-profit or charitable status does not, on its own, make an entity eligible to record official marks.

Unlike traditional trademarks, official marks enjoy a monopoly for all goods and services in the Canadian marketplace. The applications are not subject to potential opposition by third parties and, once recorded, official marks never require renewal.

5 What is a certification mark?

A certification mark is used to identify goods or services that meet a defined standard.

This standard may refer to:

- a) the character or quality of the associated goods or service.
- b) the working conditions under which the goods have been produced or the services performed.
- c) the class of persons involved in producing the goods or performing the services.
- d) the geographic area within which the goods have been produced or the services performed.

The entity to which a certification mark is registered may not be engaged in the business of producing or performing the associated goods or services. For this reason, certification marks are typically registered to trade associations who are then responsible for monitoring their use to ensure compliance with the defined standard.

The most familiar example of a certification mark protected in Canada is likely:



This certification mark is registered by the Canadian Standards Association and is licensed to, among others, the manufacturers of small appliance and household products which meet their defined standards.

6 What is a geographical indication?

Geographical Indications (GIs) identify agricultural products as originating from a region where a characteristic of the product is essentially attributable to its geographical origin. Canada has historically only recognized GIs in relation to wines and spirits. However, it has recently been expanded to include other food and agricultural products, including cheeses, oils, spices, cured meats, vinegars, fruits, etc.

Well-known examples of GIs in Canada include Cognac, Champagne and Beaujolais from France, Scotch Whisky from the UK, and Canadian Rye Whisky.

GIs are typically registered to a trade association which is then responsible for monitoring their use to ensure compliance with the defined geographic source.

7 What is a distinguishing guise, trade dress or get up or 3D mark?

A distinguishing guise, also known as a “trade dress” or “get up”, is:

- a) a shaping of wares or their containers
- b) a mode of wrapping or packaging wares

The appearance of which is used as a trademark to distinguish the goods and services of one business from those others in the marketplace.

For registration, such marks must be distinctive in Canada, and this may require the support of affidavit evidence to demonstrate extensive and exclusive use of the mark in Canada prior to the filing date.

Some famous marks registered as a distinguishing guise in Canada include:

- the shape of the Coca Cola beverage bottle.



- the foil wrapper and paper tag used to package Hershey Kisses.



Some three-dimensional marks are considered inherently distinctive and do not require the support of affidavit evidence to prove distinctiveness prior to filing a trademark application. A three-dimensional mark that is arbitrary and not inherently related to the associated goods or their packaging will not require evidence to prove that they are distinctive prior to filing.

Good examples of three-dimensional marks that would not be considered inherently distinctive without evidence include:

- the appearance of hood ornaments since these do not normally constitute a shaping of the automobile itself and are not typically items of trade on their own.
- the appearance of mascots, like Ronald McDonald and Colonel Sanders, to promote restaurant services since such figures have no inherent relationship with food products or services.

8 What is a trademark agent?

In Canada, a trademark agent is a professional licensed to represent applicants in the process of applying for and obtaining trademark registrations with the Canadian Intellectual Property Office (CIPO). Trademark agents are knowledgeable about trademark law and practice, including the filing and prosecution of trademark applications, managing trademark portfolios, and providing strategic advice on trademark protection.

A trademark agent must be registered with the College of Patent Agents and Trademark Agents (CPATA). While many trademark agents are also lawyers, it is not a requirement and unlike the United States, lawyers cannot practice before CIPO without also being licensed as a trademark agent. To become a registered trademark agent in Canada, individuals must apprentice for two years, pass the trademark agent examination administered by CPATA, and satisfy Canadian residency requirements.

BUSINESS NAMES & DOMAIN NAMES V. TRADEMARKS

9 What is the difference between business names, domain names and trademarks?

Although the terminology is often confused and confusing, there are important legal differences between corporate names, tradenames, domain names and trademarks:

- a corporate name is the name assigned to a corporation when it is incorporated

- a tradename is the business name under which the corporation (or other type of business enterprise) carries on business
- a domain name is an Internet address that is used as a means of locating your business or information about your business via the Internet; and
- a trademark is a mark used for the purpose of distinguishing goods and services sold by one business from those sold by another business.

For example, many corporations incorporate as a numbered company, but never carry-on business under this name, such as 123456 Ontario Inc. The same company may register a business name, such as “Happy Clothing Company” and a domain name such as “www.happyclothingcompany.ca”.

The same company may also decide to use a family of marks to distinguish its goods and/or services from its competitors, such as HAPPY SOX, HAPPY PANTS, and HAPPY SHOES.

In this example,

- the corporate name is 123456 Ontario Inc.
- the tradename is “Happy Clothing Company”
- the domain name is www.happyclothingcompany.ca; and
- the trademarks are HAPPY SOX, HAPPY PANTS, and HAPPY SHOES.

However, each of these names may also serve as a trademark depending on how it is used.

- Is the tradename incorporated into a logo or graphic design? If so, the tradename is probably also a trademark.
- Does the business use the domain name prominently in its signage? If so, the domain name is probably also a trademark.
- Does the corporate name or domain name only appear together with the corporate address and contact information on business cards and flyers? If so, they are only corporate names or domain names, and not trademarks.

10 Can I register a business name or a domain name as a trademark?

Yes, you can register a business name or domain name if you are using it as a trademark.

In legal terms, a trademark is a mark “used” for the purpose of distinguishing goods and services