



**Canadian  
Intellectual Property  
Office**

An Agency of  
Industry Canada

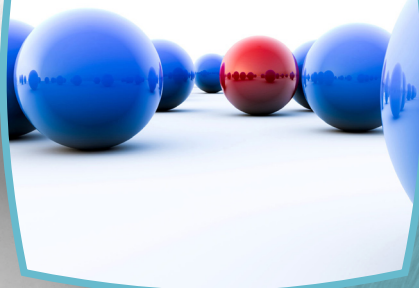
**Office de la propriété  
intellectuelle  
du Canada**

Un organisme  
d'Industrie Canada

## A GUIDE TO TRADE-MARKS



**Stand-out!**



**Canada**

CIPO  OPIC







## A GUIDE TO TRADE-MARKS

This publication is available upon request in accessible formats.

For further information or to obtain additional copies of this publication, please contact:

### Client Service Centre

Canadian Intellectual Property Office  
Industry Canada  
Place du Portage I  
Room C-229, 2nd floor  
50 Victoria Street  
Gatineau QC K1A 0C9

Tel.: 1-866-997-1936 (toll-free)

TTY: 1-866-442-2476

Fax: 1-819-953-7620

Email: [cipo.contact@ic.gc.ca](mailto:cipo.contact@ic.gc.ca)

This publication is also available online ([www.cipo.ic.gc.ca/tm](http://www.cipo.ic.gc.ca/tm)).

### Permission to reproduce

Except as otherwise specifically noted, the information in this publication may be reproduced, in whole or in part, and by any means, without charge or further permission from the Canadian Intellectual Property Office (CIPO), provided that due diligence is exercised in ensuring the accuracy of the information reproduced, that CIPO is identified as the source institution, and that the reproduction is not represented as an official version of the information reproduced, nor as having been made in affiliation with, or with the endorsement of, CIPO.

For permission to reproduce the information in this publication for commercial redistribution, please write to: [copyright.droitdauteur@pwgsc.gc.ca](mailto:copyright.droitdauteur@pwgsc.gc.ca).

Cat. No.: Iu71-4/7-2008

ISBN: 978-0-662-06185-4

Aussi offert en français sous le titre *Le Guide des marques de commerce*.



# Table of Contents

## UNDERSTANDING TRADE-MARKS — THE BASICS ..... 1

Purpose of this guide.....	1
Who we are.....	1
Visit CIPO's website.....	2
<i>General enquiries</i> .....	2
Your identity in the marketplace.....	3
What is a trade-mark?.....	3
Trade name vs. trade-mark.....	4
Registered trade-mark vs. unregistered trade-mark.....	5
What can you register?.....	5
What can't you register?.....	6
<i>Names and surnames</i> .....	6
<i>Clearly descriptive marks</i> .....	6
<i>"Deceptively misdescriptive" marks</i> .....	6
<i>Place of origin</i> .....	7
Additional information.....	7
<i>Words in other languages</i> .....	7
<i>Avoiding confusion</i> .....	7
<i>Prohibited marks</i> .....	8
<i>Further prohibitions</i> .....	8
Who can apply for registration?.....	9
How long does registration last?.....	9
How much does registration cost?.....	9
What to consider before filing an application.....	9
<i>Conducting a preliminary search</i> .....	9
<i>Searching the Canadian Trade-marks     Database</i> .....	10
<i>Conducting a search of trade names</i> .....	10
Consider hiring a registered trade-mark agent....	11

## FILING A TRADE-MARK APPLICATION — GETTING STARTED ..... 12

Preparing a trade-mark application.....	12
<i>Your application</i> .....	12
<i>Formal drawings</i> .....	13
Filing fees.....	13

Filing your application.....	13
Filing date.....	14
The examination process.....	14
<i>Search</i> .....	14
<i>Examination</i> .....	14
<i>Disclaimers</i> .....	15
<i>Pre-publication search</i> .....	15
<i>Publication</i> .....	15
<i>Opposition</i> .....	15
<i>Allowance and registration</i> .....	16
Abandonment.....	17
Corresponding with the Office of the Registrar of Trade-marks.....	17
Electronic services.....	18

## TRADE-MARK INFORMATION — BEYOND THE BASICS..... 19

Other trade-mark procedures.....	19
<i>Registering a trade-mark outside     Canada</i> .....	19
<i>Applicants residing outside Canada</i> .....	19
Expungement of a trade-mark registration.....	19
Renewal fee.....	20
Use in Canada (section 45 proceedings).....	20
Transfers.....	20
Marking requirements.....	21
Policing your trade-mark.....	21
Websites of interest.....	22

## APPENDIX I FREQUENTLY ASKED QUESTIONS..... 24

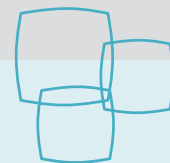
## APPENDIX II FILING A TRADE-MARK APPLICATION — TWO (2) SAMPLE APPLICATIONS..... 27

## APPENDIX III COMMON ERRORS TO AVOID..... 29

## GLOSSARY ..... 31







# UNDERSTANDING TRADE-MARKS — THE BASICS

## Purpose of this guide

A *Guide to Trade-marks* is available in electronic form on the Canadian Intellectual Property Office (CIPO) website ([www.cipo.ic.gc.ca/tm](http://www.cipo.ic.gc.ca/tm)). The electronic form of this guide is the official version.

This guide explores what trade-marks are, how they can benefit you and your organization, and why registration is important.

Further, this guide provides an overview of the trade-mark registration process. It is not intended as a complete text on Canadian law regarding trade-marks or a substitute for professional advice from a registered trade-mark agent.

For more detailed information on trade-mark procedures, please consult the *Trade-marks Act*, the *Trade-marks Regulations*, the *Trade-marks Examination Manual*, the *Wares and Services Manual*, as well as the publication *What's in a Name?*, all available online ([www.cipo.ic.gc.ca/tm](http://www.cipo.ic.gc.ca/tm)). Additional information on trade-marks may be obtained from the CIPO Client Service Centre (please see page 2).

Definitions of terms used in this guide are listed in the glossary (please see page 31).

**Note:** In the event of any inconsistency between this document and the applicable legislation, the legislation must be followed.

## Who we are

The Canadian Intellectual Property Office, an agency of Industry Canada, is responsible for the administration and processing of intellectual property (IP) in Canada. CIPO's areas of activity include trade-marks, patents, copyrights, industrial designs, and integrated circuit topographies.

The Office of the Registrar of Trade-marks (Office) oversees the trade-marks process in Canada and is the governing authority on matters relating to trade-marks.

### *The main functions of the Office:*

- *receive and examine applications for trade-mark registration;*
- *maintain an electronic inventory of trade-mark registrations and pending marks;*
- *record transfers of trade-marks;*
- *record licensing agreements relating to trade-marks;*
- *provide a search room in which these records may be consulted by the public;*
- *provide general information to the public about the trade-marks registration process;*
- *publish the Trade-marks Journal;*
- *maintain a listing of registered trade-marks agents; and*
- *administer opposition and summary expungement proceedings (section 45 proceedings).*

The Office processes approximately 45 000 applications for trade-mark registration every year.

## Visit CIPO's website

The CIPO website ([www.cipo.ic.gc.ca](http://www.cipo.ic.gc.ca)) provides useful information about CIPO programs and services. The website is also the best way to contact CIPO.

Visit the "Trade-marks" section of the website ([www.cipo.ic.gc.ca/tm](http://www.cipo.ic.gc.ca/tm)) for the following:

- instructions on getting started, including a tutorial on consulting the Canadian Trade-marks Database;
- access to the Canadian Trade-marks Database;
- publications, including the *Trade-marks Journal*;
- legislation, including the *Trade-marks Act* and the *Trade-marks Regulations*;
- online and printable sample forms; and
- a list of registered trade-marks agents.

Visit the "Trade-marks Opposition Board" section of the website ([www.cipo.ic.gc.ca/tmob](http://www.cipo.ic.gc.ca/tmob)) for the following:

- information about opposition proceedings;
- information about summary expungement proceedings based on non-use (section 45 proceedings); and
- publications, including legislation and practice notices regarding these two types of proceedings.



## General enquiries

The **CIPO Client Service Centre** is the central contact point for communicating with CIPO. The Centre provides general information on a range of topics relating to intellectual property, including procedures for registering trade-marks.

You may consult our information officers for general information on intellectual property, assistance in navigating the online Canadian Trade-marks Database, and information on CIPO's products and services.

The **CIPO Client Service Centre** is located at:

Canadian Intellectual Property Office  
Industry Canada  
Place du Portage I  
Room C-229, 2nd floor  
50 Victoria Street  
Gatineau QC K1A 0C9

**General enquiries:**

Telephone: 1-866-997-1936 (toll-free)

**TTY:** 1-866-442-2476

**Email:** [cipo.contact@ic.gc.ca](mailto:cipo.contact@ic.gc.ca)



# Your identity in the marketplace

Success in the business world depends largely on the message you convey and the image you project. If people cannot pick you out easily from the crowd, you are likely to be overlooked in favour of an individual or firm with a stronger presence.

A trade-mark is what identifies your goods or services in the public mind and shapes how your products or services are perceived in the marketplace.

It is no coincidence that some brand names that dominated the North American market in the 1920s are still leaders today. The public gravitates towards familiar names and designs that have become associated with quality and reliability. This is why companies spend millions of dollars nurturing their corporate image.

A registered trade-mark is a key way of protecting your corporate identity. Registration of your trade-mark provides legal title to intellectual property in much the same way as a deed gives title to a piece of real estate.

## What is a trade-mark?

*A trade-mark is a word (or words), a design, or a combination of these, used to identify the goods or services of one person or organization and to distinguish these goods or services from those of others in the marketplace.*

Trade-marks come to represent not only the actual goods or services, but also the reputation, of the producer. As such, trade-marks constitute valuable IP.

There are three types of trade-marks:

- An **ordinary mark** consists of a word (or words), a design, or a combination of these, used to identify the goods or services of one person or organization and to distinguish these goods or services from those of others in the marketplace. For example, suppose that you started a courier business, which you chose to call “Giddy-up.” You could register these words as a trade-mark (assuming all legal requirements were met) in regard to the service that you offer.
- A **certification mark** is used by an individual or organization and licensed to others for the purpose of identifying goods or services that meet a defined standard, for example, the Woolmark design, owned by Woolmark Americas Ltd., for use on clothing and other goods.
- A **distinguishing guise** consists in the shaping of goods or their containers, or a mode of wrapping or packaging goods, which distinguishes them as being produced by a specific individual or firm. For example, if you manufactured butterfly-shaped candy, you could register the butterfly shape as a distinguishing guise.

***Fast fact: A trade-mark is a word (or words), a design, or a combination of these, used to identify the goods or services of one person or organization and to distinguish these goods or services from those of others in the marketplace.***

People occasionally confuse trade-marks with patents, industrial designs, copyrights, and integrated circuit topographies. Although all of these are forms of intellectual property, they differ as follows:

- a **trade-mark** is a word (or words), a design, or a combination of these, used to identify the goods or services of one person or organization and to distinguish these goods or services from those of others in the marketplace;
- a **patent** covers a new invention (process, machine, manufacture, composition of matter) and any new and useful improvement to an existing invention;
- an **industrial design** consists in the visual features of shape, configuration, pattern, or ornament (or any combination of these), applied to a finished manufactured article;
- a **copyright** provides protection for a literary, artistic, dramatic, or musical work (including a computer program), as well as three other subject matter, namely; performances, sound recordings, and communication signals; and
- an **integrated circuit topography** refers to the three-dimensional configurations of the electronic circuits in integrated circuit products or layout designs.

## Trade name vs. trade-mark

A trade name is the name under which you conduct your business. A trade name can be registered under the *Trade-marks Act* only if it is also used as a trade-mark, that is, if it is used to identify goods or services.

For example, let us suppose that you own an ice cream business and that your company is called “A.B.C. Ltd.”:

**Example 1:** People know your ice cream under the name “A.B.C. Ltd.” because you use this name as a trade-mark which you place on your ice cream or you use this name in association with your product. You can therefore apply to register the trade name “A.B.C. Ltd.” as a trade-mark.

**Example 2:** People know your ice cream by the name under which you have promoted this product, for example, the name “North Pole.” Even though the official name of your company is “A.B.C. Ltd.”, no one associates this name with your goods. Therefore, the name “A.B.C. Ltd.” cannot be considered a trade-mark unless you begin to use it as such.

However, a trade-mark registration may be invalidated if a third party in Canada has made prior use of a similar trade name or trade-mark.

## Registered trade-mark vs. unregistered trade-mark

*A registered trade-mark is one that has been entered in the Register of Trade-marks. The Register of Trade-marks is the record of all trade-marks that have been formally applied for and registered in Canada. The Office of the Registrar of Trade-marks is the body that administers the Register.*

*You are not required to register your trade-mark — using a mark for a certain length of time can establish your ownership under common law.*

*For information on registering trade-marks outside Canada, please refer to page 19.*



Registration of your trade-mark gives you the exclusive right to use the mark across Canada for 15 years; registration is renewable every 15 years after that.

**Note:** You must apply for registration of any mark relating to precious metals. A filing receipt must be shown when such goods go through customs.

Registration is *prima facie* (direct) evidence of your ownership — in a dispute, the registered owner does not have to prove ownership; the onus is on the challenger. Use of an unregistered trade-mark, however, can lead to a lengthy and expensive legal dispute over who has the right to use it.

If you fail to use the mark for an extended period, your registration may be removed from the Register of Trade-marks. As a result, it may be more difficult to establish legal ownership of the trade-mark. For information regarding “Use in Canada”, please refer to page 20.

## What can you register?

Your trade-mark will qualify for registration as long as it does not contravene the *Trade-marks Act*, which sets out the requirements for registration. For more detailed information, consult the *Trade-marks Act*, available on the CIPO website ([www.cipo.ic.gc.ca/tm](http://www.cipo.ic.gc.ca/tm)).

# What can't you register?

The kinds of marks that you may not register include the following:

- names and surnames;
- clearly descriptive marks;
- “deceptively misdescriptive” marks;
- words that denote a geographical location commonly known to be the place of origin of such goods or services;
- words or designs that are considered confusing with a previously registered trade-mark or pending trade-mark; and
- words or designs that nearly resemble a prohibited mark (please see page 8).

## *Names and surnames*

A trade-mark may not be registered if it is nothing more than a name or surname (for example, John Doe or Jane Smith, Wong, Cohen, etc.).

An exception to this rule is if you can prove that your goods or services have become distinctive under the name or surname so that the word has acquired a secondary meaning in the public mind. Another exception is a name or surname that has meaning other than strictly as a name or surname, that is, it is also a recognizable word or the name of a community, city, town, river, castle, etc. In such cases, you could register your last name for use in association with your business, as long as there were no other reasons to refuse your application.

## *Clearly descriptive marks*

You may not register a word that describes an inherent feature of the goods or services, i.e., a word that is clearly descriptive.

*For example, the words “sweet” for ice cream, “juicy” for apples, and “perfectly clean” for dry-cleaner services could not be registered as trade-marks. All good apples could be described as “juicy” and all ice cream as “sweet”; these are natural characteristics of the items. If you were allowed to register these words, no other apple sellers or ice cream vendors could use them to promote their goods; this would be unfair. But, again, if you can establish that “Sweet Ice Cream” has become so well-known that people will immediately think of your product (and no one else’s) when they read or hear these words, you may be allowed to register the trade-mark.*

## *“Deceptively misdescriptive” marks*

A further restriction arises when a mark is “deceptively misdescriptive” (clearly misleading). For example, you could not register “sugar sweet” for candy sweetened with artificial sweetener or “air express” for a courier service that uses ground transportation.



## Place of origin

You may not register a word that uses a geographical location commonly known to be the place of origin of the goods or services. Allowing you to use such place names as part of your trade-mark would give you a monopoly with respect to a geographical term; this would be unfair to others. For example, you could not register “Italy” for lasagna. However, you conceivably could register the words “North Pole” as your trade-mark for bananas, since one would not normally expect bananas to come from the North Pole.

In addition, you may not register a word that misleads the public into thinking that the goods or services come from a certain place when they do not. For example, “Paris Fashions” or “Denmark Furniture” could not be registered as a trade-mark for those particular goods or services if those goods or services did not originate from that geographical location.

## Additional information

### Words in other languages

Words that constitute the name of the goods or services in another language such as: “gelato,” Italian for “ice cream”; “anorak,” Inuktitut for “parka”; or “wurst,” German for “sausage” may not be registered.

### Avoiding confusion

Beware of words, designs, and ideas that are similar to another person’s or another organization’s trade-mark. If your trade-mark is confusingly similar to a registered trade-mark or a pending trade-mark, it will be refused.

Trade-mark examiners take into account various factors when determining whether trade-marks are confusing, including:

- whether the trade-marks look or sound alike and whether they suggest similar ideas; and
- whether the trade-marks are used to market similar goods or services.

Let us go back to the **example** of “North Pole” ice cream. Suppose another company were manufacturing and selling frozen-water products under the registered trade-mark “South Pole.” The public could easily conclude that “North Pole” and “South Pole” products are manufactured and sold by the same company, and may expect that the trade-marks would be owned by the same organization. Hence, your application to register “North Pole” may be turned down on grounds of causing confusion with the registered mark “South Pole,” which is owned by another company.

For more information on confusingly similar trade-marks, please see subsection 6(5) of the *Trade-marks Act* ([www.cipo.ic.gc.ca/tm](http://www.cipo.ic.gc.ca/tm)).

## Examples of what you may register

- “North Pole” ice cream (if it is not confusing with a registered trade-mark or an “entitled” pending trade-mark, that is, one with an earlier filing date).
- “Venus” ice cream (mythical, not actual, name)
- “Scrumptillus” ice cream (coined word)
- “True Blue” ice cream (words not normally associated with ice cream)

## Examples of what you may not register

- “Sweet” ice cream (unless you can prove that the trade-mark is distinctive of the applicant)
- “Devonshire” ice cream (unless you can prove that the trade-mark is distinctive of the applicant)
- “North Pole” ice cream (if “South Pole” is a registered trade-mark for frozen-water products)
- “RCMP’s Favourite” ice cream

## Prohibited marks

You may not register a trade-mark that bears resemblance to certain official marks unless you have the consent of the authority in question. These official designs include the following:

- official government designs, for example, the Canadian flag;
- coats of arms of the Royal Family;
- badges and crests such as those of the Armed Forces and the letters RCMP;
- emblems and names of the Red Cross, the Red Crescent, and the United Nations;
- armorial bearings, flags, and symbols of other countries; and
- symbols of provinces, municipalities, and public institutions.

Subject matter that is obscene, scandalous, or immoral is also prohibited. For example, your trade-mark may not include profane language, obscene visuals, or racial slurs.

Another prohibition applies to the use of portraits and signatures of living persons or of persons who have died within the preceding 30 years. For example, using the photo of an existing rock group to promote your record store would be prohibited unless you had formal consent to do so.

## Further prohibitions

A trade-mark will not be allowed to be registered if it consists of a plant variety denomination (right granted to the owner with respect to control over the multiplication and sale of reproductive material for a particular plant variety), or is a mark so nearly resembling a plant variety denomination that it is likely to be mistaken for it, where the application covers the plant variety or another plant variety of the same species.

A trade-mark will not be registered if it is, in whole or in part, a geographical indication of origin for wines or spirits, where the application is in respect of a wine or spirit that is not produced in the territory indicated by the designation.

## Who can apply for registration?

Companies, individuals, partnerships, trade unions, and lawful associations may obtain registration of their marks of identification for goods or services, provided they meet the requirements of the *Trade-marks Act* and the *Trade-marks Regulations*.

## How long does registration last?

Your registration is valid for 15 years. You may renew it every 15 years thereafter for a fee.

## How much does registration cost?

The cost of registering a trade-mark depends on the individual applicant's requirements. In some cases, only a filing fee and a registration fee may be required. However, other fees may also apply. If you appoint a trade-mark agent to represent you, additional fees will be required for his or her services.

The list of fees payable to the Registrar of Trade-marks can be found on the CIPO website ([www.cipo.ic.gc.ca/tm](http://www.cipo.ic.gc.ca/tm)).

## What to consider before filing an application

The Office of the Registrar of Trade-marks will provide you with the basic information that you need in order to file an application for trade-mark registration. However, the Office cannot prepare your application, advise you on whether your mark is registrable, or conduct a preliminary search of existing trade-marks for you.

### *Conducting a preliminary search*

A good first step is to carry out a preliminary search of existing trade-marks to check whether your trade-mark could be confused with someone else's. Although not mandatory, this step will assist you in determining whether a similar trade-mark already exists, in order to avoid trade-mark infringement (unauthorized use) and potential lawsuits.

## Searching the Canadian Trade-marks Database

You can do a preliminary search of registered and pending applications through the Canadian Trade-marks Database, which is accessible online. The listings contained in the Canadian Trade-marks Database cover word marks, slogans, numbers, pictures, and combinations of these. As soon as your application is received, it too becomes part of the public record.

Searches can be conducted using any of several methods, including by trade-mark type or status.

To conduct a proper search, you will have to check for different possible versions of the mark that you wish to register. In the case of a word mark, you should look for all conceivable spellings, including in French. For example, if your trade-mark is “North Pole,” you would search for “North,” “Nord,” and “Pole.”

Also in the online records are crests, badges, and official symbols that fall into the category “Prohibited Marks” in the *Trade-marks Act*. These records can assist you in making certain that your trade-mark does not fall into a prohibited category.

To begin your search, visit the Canadian Trade-marks Database ([www.cipo.ic.gc.ca/tm](http://www.cipo.ic.gc.ca/tm)). A tutorial on the Canadian Trade-marks Database is also available on the website. The tutorial will help you make the most of this information source.

## Conducting a search of trade names

Before going any further, you should also consider a search of trade names. Trade names are often also used as trade-marks; trade names can be used as trade-marks even when they are not registered as such.

**Example:** *The name of your company is “North Pole.” “South Pole Inc.” has never have filed for trade-mark registration. However, if the name “South Pole” is known for frozen-water products, the company could argue ownership of the name “South Pole” as a trade name, as well as prior use of a trade-mark.*

*The Office of the Registrar of Trade-marks would not have the name “South Pole” in its trade-mark records, because it does not register trade names. “South Pole Inc.,” however, could easily find out about your application for “North Pole,” either by doing a search of the Office of the Registrar of Trade-marks records or a search at the time your application is published in the Trade-marks Journal. “South Pole” may then challenge your application during the opposition stage in the registration process (please see page 15).*

As trade names may be recorded separately in each province under provincial legislation, there is no complete central inventory containing all current names for Canada as a whole. As conducting a search of trade names is quite complex, we suggest that you hire a trade-mark agent to do the work for you.



## Consider hiring a registered trade-mark agent

Preparing and following through on a trade-mark application is a complex process requiring broad knowledge of trade-mark law and Office of the Registrar of Trade-marks practice — knowledge one can expect a registered trade-mark agent to have.

A resident of Canada who is a barrister or solicitor, or a notary in the province of Quebec, may become a trade-mark agent by passing the qualifying examination or working in the area of trade-mark law for at least 24 months.

Beware of unregistered trade-mark agents! They are not authorized to represent applicants in the presentation and prosecution of applications for trade-marks or in other business before the Office of the Registrar of Trade-marks.

A trained trade-mark agent will make sure that your application is properly drafted in order for your trade-mark to be adequately protected; such protection would be important particularly if a third party should challenge your right to the mark. Hiring such an agent is not mandatory, but is highly recommended.

Once you have appointed an agent, the Office of the Registrar of Trade-marks will correspond with your agent. Should you revoke the appointment of your agent, the Office will then correspond with you directly. You may, however, change trade-mark agents or choose to no longer have one at any time.

The Office of the Registrar of Trade-marks maintains a listing of registered trade-mark agents, but cannot recommend any particular one to you. For a list of trade-mark agents, visit the CIPO website ([www.cipo.ic.gc.ca/tm](http://www.cipo.ic.gc.ca/tm)).



# FILING A TRADE MARK APPLICATION — GETTING STARTED

## Preparing a trade-mark application

A complete application includes:

- an application for registration;
- a formal drawing, if applicable; and
- the filing fee.

### *Your application*

The principal document in the registration process is your application. **There is no set application form for registering trade-marks;** applicants are asked to create their own application from the samples provided in Appendix II of this guide as well as the other suggested trade-marks forms found on the CIPO website.

If you believe that your application falls under one of the categories discussed at right, we encourage you to contact CIPO's Client Service Centre (please see page 2) or your trade-mark agent, if applicable.

**You must file a separate application for each trade-mark that you wish to register**, although one application may cover both goods and services, or a number of goods or services, in respect of a given trade-mark.

The two samples discussed in Appendix II apply to the majority of requests received. It is important to note that,

in some cases, an application may require additional information. Cases where additional information may be required include applications with regard to:

- certification marks;
- marks registered and used abroad; and
- registration of a trade-mark “made known” in Canada.

Sample applications are available in Appendix II of this guide; additional suggested trade-mark forms are available on the CIPO website ([www.cipo.ic.gc.ca/tm](http://www.cipo.ic.gc.ca/tm)).

## Formal drawings

If your trade-mark is anything other than a word or words, then a formal drawing of the design is required at the time you file the application.

The formal drawing should:

- be in black and white; and
- include a description of the colour(s) if colour is claimed as a feature of your trade-mark.

If you wish, you may use the special chart set out in section 28 of the *Trade-marks Regulations* (available on the CIPO website ([www.cipo.ic.gc.ca/tm](http://www.cipo.ic.gc.ca/tm))) to indicate your colours.

For detailed designs, a drawing as large as possible, but not exceeding 22 cm x 35 cm (8.5 inches x 14 inches), will allow for the clearest reproduction.

**Note:** In order to maintain registration, the mark must be used as registered, without alteration, including description of colour.

## Filing fees

When you submit an application to register a trade-mark, you must pay the prescribed filing fee. Details about filing fees are available on the CIPO website ([www.cipo.ic.gc.ca/tm](http://www.cipo.ic.gc.ca/tm)).

Payment may be made by credit card (VISA, MasterCard, or American Express), direct payment, postal money order, or cheque (postal money orders and cheques must be made payable, in Canadian dollars, to the Receiver General for Canada). Do not add federal and provincial taxes.

## Filing your application

You may file your application and pay the prescribed fee **online** through the CIPO website ([www.cipo.ic.gc.ca/tm](http://www.cipo.ic.gc.ca/tm)).

Or you may send your completed application with payment **by mail** to:

Office of the Registrar of Trade-marks  
Canadian Intellectual Property Office  
Industry Canada  
Place du Portage I  
50 Victoria Street  
Gatineau QC K1A 0C9

## Filing date

Once the Office of the Registrar of Trade-marks has received your application, staff will review it to make sure it is complete. If anything is missing, the Office will contact you to ask that you provide additional information. Once this process is finished, the Office will acknowledge receipt of your completed application and assign a filing date, that is, the date on which your application met all the filing requirements. This filing date is particularly important since it is the date used to assess entitlement to registration.

You may amend your application after filing. However, not all amendments are acceptable. As a result, you may be required to file a new application.

## The examination process

When the Office of the Registrar of Trade-marks receives your application, it:

- **conducts a search** of trade-mark records to locate any existing or pending trade-mark with which your trade-mark may be in conflict; if one is found, the Office will inform you of this fact;
- **examines** the application for compliance with the requirements of the *Trade-marks Act* and *Trade-marks Regulations*, and informs you of requirements which are not met by the application or of any objection to the registrability of your trade-mark;
- **publishes** the application in the *Trade-marks Journal*, leaving time for opposition (challenges) to the application; and
- **allows and registers** your trade-mark if no one files an opposition to your application (or if any opposition filed has been decided in your favour).

### Search

Examiners conduct a thorough search of records to verify that your trade-mark does not conflict with one already filed or registered.

### Examination

The trade-marks examiner assigned to your file then reviews the search results and decides whether your application can be approved for advertisement. The examiner will notify you (or your agent, if you have one) of any objections should he or she determine that there are any. You then have opportunities to respond. If your answers still fail to satisfy the examiner, you will receive a letter informing you that your application has been refused and stating the grounds for this refusal. In the event of refusal, you have the right to appeal to the Federal Court of Canada.

**Note:** There is no special form required to be used when responding to an examiner's report, unless you are asked to submit a revised application.



## Disclaimers

The examiner may request that you disclaim the right to the exclusive use of a portion of the trade-mark if the appropriate disclaimer statement has not already been included in the application.

## Pre-publication search

Prior to advertisement in the *Trade-marks Journal*, the Office conducts a second search (pre-publication search) to ensure that, in the intervening months, no one has registered, or applied for registration of, a trade-mark that would be in conflict with the one you are seeking to register. The Office will inform you (or your agent if you have one) of any conflicting trade-mark should one be identified and will seek your comments on any such trade-mark.

## Publication

If the pre-publication search does not unearth any new objections to your application, it is ready for advertisement in the *Trade-marks Journal*. The Journal is the official publication listing every application that has been approved for advertisement in Canada. It provides information about your application, including your name and address, the file number, the filing date, the trade-mark, whether the application for registration is based on “use” or “proposed use”, the goods and services in respect of which the trade-mark is used or intended to be used, and any other claims, as applicable (such as, colour claims, disclaimers, etc.). Advertising applications gives any person an opportunity to raise objections to any pending application before it is registered.

The *Trade-marks Journal* is published every Wednesday, and is available on the CIPO website ([www.cipo.ic.gc.ca/tm](http://www.cipo.ic.gc.ca/tm)).

## Opposition

Any person with valid grounds for doing so may oppose a trade-mark application advertised in the *Trade-marks Journal*. An opposition must be made within two months of the publication date by either filing a statement of opposition or requesting an extension of time to oppose (the prescribed fee must accompany the statement of opposition or request for extension). The list of applicable fees is available on the CIPO website ([www.cipo.ic.gc.ca/tmob](http://www.cipo.ic.gc.ca/tmob)), and can also be obtained by contacting the Client Service Centre. The Office of the Registrar of Trade-marks will dismiss any opposition that it considers to be frivolous.

If your application is opposed and you do not already have an agent, you are urged to hire one at this point. The same holds true if you wish to oppose someone else's application. Opposition is a complex and often lengthy process. Opposition proceedings are adversarial in nature and similar to court proceedings. Both parties may file evidence and counter-arguments, cross-examine the evidence of the other party, and make representations at an oral hearing. After a final decision is rendered, it may be appealed to the Federal Court of Canada.

For further information regarding trade-mark opposition proceedings, you may visit the Trade-marks Opposition Board section of the website ([www.cipo.gc.ca/tmob](http://www.cipo.gc.ca/tmob)), or call the Trade-marks Opposition Board directly at 1-819-997-7300 or the CIPO Client Service Centre, toll-free at 1-866-997-1936 (ask to be transferred to the Trade-marks Opposition Board).

## *Allowance and registration*

If there is no opposition, or if an opposition has been decided in your favour, your application will be allowed, and the Office of the Registrar of Trade-marks will not consider any further challenges. You will receive a notice of allowance and be asked to pay the prescribed registration fee.

If your application is based on "proposed use," you will also be asked for a declaration stating that you have commenced use of the trade-mark. If you have not yet commenced using the trade-mark, you may request extensions of time until your trade-mark is actually in use.

The final step, once you have fulfilled these requirements, is for the Office to issue a certificate of registration and to enter the trade-mark in the Register of Trade-marks.

## Steps to registration

- 1) preliminary search of existing trade-marks;
- 2) filing of your application with the Office of the Registrar of Trade-marks;
- 3) examination of your application by the Office of the Registrar of Trade-marks;
- 4) publishing of the application in the *Trade-marks Journal*;
- 5) waiting period to allow for oppositions, if any, to your application;
- 6) allowance of your application (if there is no opposition or if any opposition raised is decided in your favour); and
- 7) registration of your trade-mark by the Office of the Registrar of Trade-marks.

## Abandonment

If you fail to prosecute your application, it may be considered abandoned. Before this happens, you will be notified and given an opportunity to correct the situation within a specified time period. If you do not respond within the prescribed time limits, you will have to file a new application (along with the prescribed fee).

**Note:** Should you fail to notify the Registrar of Trade-marks of a change of address, the Registrar of Trade-marks would not be responsible for any correspondence not received by you, your representative for service, or your agent.

## Corresponding with the Office of the Registrar of Trade-marks

Business with the Office of the Registrar of Trade-marks is normally done in writing. All paper correspondence should be addressed to:

Office of the Registrar of Trade-marks  
Canadian Intellectual Property Office  
Industry Canada  
Place du Portage I  
50 Victoria Street, Room C-114  
Gatineau QC K1A 0C9

**Fax:** 1-819-953-CIPO (2476)

Correspondence regarding opposition or summary expungement must be clearly marked “Attention: Opposition Board” or “Attention: Section 45 Proceedings,” respectively, and addressed to:

Trade-marks Opposition Board  
Canadian Intellectual Property Office  
Industry Canada  
Place du Portage I  
50 Victoria Street  
Gatineau QC K1A 0C9

**Fax:** 1-819-997-5092

More information about CIPO’s official correspondence procedures is available on the CIPO website ([www.cipo.ic.gc.ca](http://www.cipo.ic.gc.ca)).

If you are enquiring about the status of your application and an examiner has not yet been assigned to it, you should contact the Client Service Centre. If your application has been assigned to an examiner, please refer to the contact number found on the report sent to you by that examiner.

Personal interviews with trade-mark examiners can be arranged by appointment. This allows examiners time to review your application before seeing you.

The Office of the Registrar of Trade-marks will respond to all general enquiries, but cannot:

- conduct a search of the Canadian Trade-marks Database for you;
- submit documents for registering transfers of ownership; or
- provide legal advice, other than informing you of the Act, the Rules, and other information that can be obtained via the CIPO and Industry Canada websites.

To find out the status of active opposition or summary expungement files, please consult the Canadian Trade-marks Database.

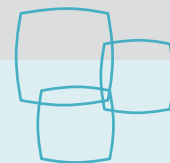
## Electronic services

CIPO's electronic service delivery allows you to:

- file a trade-mark application;
- file a revised application;
- register a trade-mark; and
- renew a registration.

To use our services online, simply visit our website ([www.cipo.ic.gc.ca/tm](http://www.cipo.ic.gc.ca/tm)).





# TRADE-MARK INFORMATION — BEYOND THE BASICS

## Other trade-mark procedures

### *Registering a trade-mark outside Canada*

Registering your trade-mark with the Office of the Registrar of Trade-marks protects your rights in Canada only. If you wish to sell goods or services in other countries, you should consider registration in those countries.

Contact a trade-mark agent or the embassy of each of the countries in which you will be selling goods or services, for information on foreign registration. A list of trade-mark agents and a list of international IP offices are available on the CIPO website ([www.cipo.ic.gc.ca](http://www.cipo.ic.gc.ca)).

### *Applicants residing outside Canada*

If you are applying for registration of a trade-mark in Canada, but reside in a country other than Canada, you must appoint a representative for service in Canada to whom correspondence from the Office of the Registrar of Trade-marks will be directed.

It is important to note that, contrary to a registered trade-mark agent based in Canada, a representative for service is not entitled to act on your behalf in any business before the Office of the Registrar of Trade-marks. The role of a representative for service is solely to act as a point of correspondence within Canada (from CIPO to you via your representative for service).

A registered trade-mark agent in Canada can also act as your representative for service if you choose to appoint this registered trade-mark agent to act in this capacity.

Please contact the CIPO Client Service Centre (please see page 2) for further information.

## Expungement of a trade-mark registration

The registration of a trade-mark provides the registered owner with a very valuable right. However, in order to retain such a right, the registered owner must fulfill specific responsibilities; nonfulfillment of these responsibilities may result in expungement of the trade-mark from the Register of Trade-marks. Grounds for expungement include ownership of a trade-mark, distinctiveness of a trade-mark, abandonment of a registered trade-mark, and non-use of a trade-mark. The Office of the Registrar of Trade-marks is responsible for administering only the summary expungement proceedings based on non-use. Please see section “Use in Canada (section 45 proceedings),” below.

## Renewal fee

To maintain registration, the registered owner must pay a renewal fee every 15 years. Failure to pay such a fee on time will result in the expungement of the trade-mark registration from the Register of Trade-marks. The Registrar of Trade-marks will send a notice stating the deadline by which the applicant is required to pay the prescribed renewal fee.

A list of fees is available on the CIPO website ([www.cipo.ic.gc.ca/tm](http://www.cipo.ic.gc.ca/tm)).

## Use in Canada (section 45 proceedings)

Another responsibility of the owner is to use the trade-mark in Canada. If the trade-mark is not in use, the registration is liable to be expunged from the Register of Trade-marks by either the Registrar of Trade-marks or the Federal Court. Summary expungement proceedings may be instituted by the Registrar, either on his or her own initiative at any time during the life of the registration, or at the request of a third party upon payment of the prescribed fee, after three years from the date of the registration. The procedure begins when the Registrar issues a notice to the registered owner asking him or her to provide evidence showing use of the trade-mark in Canada during the preceding three years or proof of special circumstances excusing non-use. Failure to reply to the Registrar's notice will result in expungement of the trade-mark registration.

Once the Registrar has received the necessary evidence, the registered owner and the requesting party have an opportunity to submit written arguments and to make representations at an oral hearing. After a final decision to expunge, amend, or maintain the registration is handed down, it may be appealed to the Federal Court of Canada.

In view of the complicated nature of these proceedings, parties are advised to use the services of a registered trade-mark agent.

For further information regarding section 45 proceedings, you may visit the Trade-marks Opposition Board section of the website ([www.cipo.ic.gc.ca/tmob](http://www.cipo.ic.gc.ca/tmob)) or call the Trade-marks Opposition Board directly, at 1-819-997-7300 or the CIPO Client Service Centre, toll-free in Canada at 1-866-997-1936 (ask to be transferred to the Trade-marks Opposition Board).

## Transfers

A trade-mark is a form of property. You can sell, bequeath, or otherwise transfer your IP rights to another party through a transaction known as an "assignment." In order to avoid ownership disputes, you should formally notify the Office of the Registrar of Trade-marks of changes in ownership.

The Office should also be informed of other transactions affecting ownership of a trade-mark such as a change of name or business mergers.

# Marking requirements

Canada's *Trade-marks Act* does not include any marking requirements. However, the following symbols are commonly used by trade-mark owners to indicate registration:

- *R* (registered)
- *TM* (trade-mark)
- *SM* (service mark)
- *MC* (*marque de commerce*)

**Note with respect to precious metals:** The *Precious Metals Marking Act*, which applies to trade-marks registered in Canada, states that you must file a trade-mark application for the trade-mark that you use on the goods that you sell if you wish to stamp a quality mark, for example, “10K gold,” on your goods. The quality mark itself is not mandatory.

## Policing your trade-mark

It is your responsibility to monitor the marketplace and to take legal action if you find that someone has used your registered trade-mark without permission, or if you come across a trade-mark or a trade name that is confusing with your mark.

Preventing imitation by competitors is not the only reason for policing a trade-mark. If your business is successful, your mark may be in danger of becoming a generic term. For example, if consumers start saying “North Pole” when they mean any ice cream, in the same way that the trade-mark “zipper” is now used to denote all slide fasteners, your trade-mark may no longer be distinguishable from others.

## Websites of interest

The following are a few additional websites you may find helpful:

### *General Interest*

#### **Industry Canada**

The Canadian Intellectual Property Office, which includes the Trade-marks Office, is a Special Operating Agency of Industry Canada.

([www.ic.gc.ca](http://www.ic.gc.ca))

#### **Corporations Canada**

Helps Canadians incorporate, maintain, and operate businesses, not-for-profit corporations, and other corporate entities.

([www.corporationscanada.ic.gc.ca](http://www.corporationscanada.ic.gc.ca))

#### **Canada Business**

Provides a single access point for federal and provincial/territorial government services, programs, and regulatory requirements for businesses.

([www.canadabusiness.ca](http://www.canadabusiness.ca))

#### **Plant Breeders' Rights Office** (Canadian Food Inspection Agency)

Administers the *Plant Breeders' Rights Act* and *Plant Breeders' Rights Regulations*, which provide legal protection to plant breeders for new plant varieties.

([www.inspection.gc.ca](http://www.inspection.gc.ca))

### *Intellectual Property*

#### **Canadian Intellectual Property Office (CIPO)**

Administers and processes the greater part of intellectual property in Canada: trade-marks, patents, industrial designs, copyrights, and integrated circuit topographies.

([www.cipo.ic.gc.ca](http://www.cipo.ic.gc.ca))

#### **Canadian Trade-marks Database**

Provides a searchable database of all active and inactive trade-mark applications and registrations in Canada as well as the status of all active opposition and summary expungement (section 45) cases.

([www.cipo.ic.gc.ca/tm](http://www.cipo.ic.gc.ca/tm))

#### **Trade-marks Office**

Provides information, resources, and services relating to trade-marks and their registration in Canada.

([www.cipo.ic.gc.ca/tm](http://www.cipo.ic.gc.ca/tm))

**Trade-marks Opposition Board**

Administers and provides information about trade-mark opposition and summary expungement proceedings (section 45 proceedings) in Canada.  
([www.cipo.ic.gc.ca/tmob](http://www.cipo.ic.gc.ca/tmob))

**WIPO Intellectual Property Digital Library**

Provides access to intellectual property data collections hosted by the World Intellectual Property Organization (WIPO).  
([www.wipo.int/ipdl/en/](http://www.wipo.int/ipdl/en/))

**United States Patent and Trademark Office**

Processes patent and trade-mark applications and provides information, resources, and services with respect to trade-marks and their registration in the United States of America.  
([www.uspto.gov](http://www.uspto.gov)) — English content only

## *Related Acts and Case Law*

***Precious Metals Marking Act***

Sets out the marketplace rules for using quality marks with respect to precious metals, in order to prevent the registration of trade-marks that may be misconstrued as quality marks.  
([www.laws.justice.gc.ca/en/showtdm/cs/P-19///en](http://www.laws.justice.gc.ca/en/showtdm/cs/P-19///en))

***Bank Act***

Regulates Canada's chartered banks, and restricts the use of the term "banking services" in order to prevent unauthorized use of this term.  
([www.laws.justice.gc.ca/en/B-1.01/](http://www.laws.justice.gc.ca/en/B-1.01/))

***Canada Post Corporation Act***

Regulates mail service in Canada, and prohibits unauthorized use of words such as "mail," "letter," and "post," and the unauthorized sale of postage stamps.  
([www.laws.justice.gc.ca/en/C-10/](http://www.laws.justice.gc.ca/en/C-10/))

**Federal Court of Canada**

Provides a searchable database of all decisions rendered by the judges of the Federal Court and the Federal Court of Appeal.  
([www.fct-cf.gc.ca](http://www.fct-cf.gc.ca))

**Supreme Court of Canada**

Provides a searchable database of all decisions rendered by the Supreme Court of Canada.  
([www.scc-csc.gc.ca](http://www.scc-csc.gc.ca))



## FREQUENTLY ASKED QUESTIONS

**Q1. What is a trade-mark?**

- A. A trade-mark is a word (or words), a design, or a combination of these, used to identify the goods or services of one person or organization and to distinguish these goods or services from those of others in the marketplace. Trade-marks are a form of intellectual property.

**Q2. Are there different kinds of trade-marks?**

- A. Yes, there are three basic types: an **ordinary mark** is defined as words or designs that identify the goods or services of one person or organization and distinguish these goods or services from those of others in the marketplace; a **certification mark** is used to identify goods or services that meet a standard set by a governing organization; and a **distinguishing guise** consists in the shaping of goods or their containers, or a mode of wrapping or packaging goods, for the purpose of achieving a distinctive appearance.

**Q3. What is the difference between trade-marks and other forms of intellectual property?**

- A. Trade-marks are only one form of intellectual property that can be protected through federal legislation. The other forms are: **patents**, for new technologies; **copyrights**, for literary, artistic, dramatic, or musical works, as well as performances, sound recordings, and communication signals; **industrial designs**, for the shape, pattern, or ornamentation applied to an industrially produced object; and **integrated circuit topographies**, the three-dimensional configuration of the electronic circuits in integrated circuit products or layout designs.

**Q4. What is the difference between a registered trade-mark and an unregistered trade-mark?**

- A. A registered trade-mark is a mark that has been entered in the Register of Trade-marks. The Office of the Registrar of Trade-marks is responsible for administering the Register of Trade-marks. Registration is proof of ownership. In some circumstances, an unregistered trade-mark may also be recognized through common law as the property of the owner.

**Q5. Why register a trade-mark?**

- A. Registration is direct (*prima facie*) evidence of exclusive ownership across Canada, and serves to ward off potential infringers. It allows you to more easily protect your rights should someone challenge them, since the onus is on the challenger to prove rights in any such dispute.

**Q6. Is registration mandatory?**

- A. No, but it is advisable.

**Q7. Why hire a trade-mark agent?**

- A. Trade-mark registration can be a complex process; an experienced agent can save you time and money, by helping you avoid pitfalls such as poorly prepared applications and incomplete research, as well by assisting in opposition and summary expungement proceedings.



**Q8. Who can register a trade-mark?**

- A. Companies, individuals, partnerships, trade unions, or lawful associations, provided that they comply with the requirements of the *Trade-marks Act* and *Trade-marks Regulations*.

**Q9. For how long is registration effective?**

- A. Registration is valid for 15 years and is renewable every 15 years thereafter upon payment of a fee.

**Q10. How do I register a trade-mark?**

- A. You must file an application with the Office of the Registrar of Trade-marks, which is located in Gatineau, Quebec. The application undergoes stringent examination to ensure that it meets the requirements of the *Trade-marks Act* and *Trade-marks Regulations*.

**Q11. Does registration in Canada protect my rights in other countries?**

- A. No. If your products or services are sold in other countries, you should consider applying for foreign registration in each country where you conduct business. Contact a trade-mark agent or the embassy of the country in question to find out about procedures.

**Q12. What is the difference between a trade-mark and a trade name?**

- A. A trade name is the name under which you conduct your business. It can be registered as a trade-mark, but only if it is used as such, that is, if it is used to identify goods or services.

**Q13. Can I register my own name as a trade-mark?**

- A. Normally, you may not register a proper name — yours or anyone else's — as a trade-mark. An exception may be made if you can demonstrate that the name has acquired trade-mark meaning in the public mind with respect to specific goods or services.

**Q14. What other kinds of marks may not be registered?**

- A. Generally speaking, the following marks cannot be registered: terms that are clearly descriptive (i.e., that denote an inherent feature of the good or service), for example, “sweet” ice cream; terms that are misleading; words that denote a geographical location commonly known to be the place of origin of such goods and services, for example, “Atlantic” cod; terms or designs that are too similar to an existing trade-mark; and terms and designs that are expressly prohibited under the *Trade-marks Act* (which include symbols, such as coats of arms, badges, and crests, of national and international organizations, and terms that are considered immoral or offensive). Other types of marks which cannot be registered are plant variety denominations and protected geographical indications for wines and spirits.

**Q15. What are the steps in trade-mark registration?**

- A. Trade-mark registration usually involves:
- 1) preliminary search of existing trade-marks;
  - 2) filing of your application with the Office of the Registrar of Trade-marks;
  - 3) examination of your application by the Office of the Registrar of Trade-marks;
  - 4) publishing of the application in the *Trade-marks Journal*;
  - 5) waiting period to allow for oppositions, if any, to your application;
  - 6) allowance of your application (if there is no opposition or if any opposition raised is decided in your favour); and
  - 7) registration of your trade-mark by the Office of the Registrar of Trade-marks.

**Q16. *Why is the preliminary search important?***

- A. It helps you to determine whether your application has a chance for success and also may help you to avoid infringing others' trade-marks.

**Q17. *Will the Office of the Registrar of Trade-marks tell me during my preliminary search whether my trade-mark can be registered?***

- A. No, the Office does not provide advice. You will be informed of any decisions regarding your trade-mark application during the examination process.

**Q18. *What do I need to include in my application?***

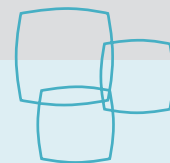
- A. You must include:
- a completed application form;
  - the filing fee; and
  - a drawing of the trade-mark if the application is made for a word or words in a special form or design.

**Q19. *Will the Office of the Registrar of Trade-marks ensure that my trade-mark is not infringed?***

- A. The Office of the Registrar of Trade-marks is not an enforcement agency. You are responsible for monitoring the marketplace to identify any infringement and for taking any legal action if necessary.

**Q20. *Should I incorporate my company?***

- A. The decision whether or not to incorporate depends on your company's situation. Corporations Canada publishes the *Small Business Guide to Federal Incorporation*, which can help you to decide whether you should incorporate federally. You can also choose to incorporate at the provincial level. Please consult the appropriate provincial government's website for further details on provincial incorporation.



# FILING A TRADE-MARK APPLICATION — TWO (2) SAMPLE APPLICATIONS

The following two application samples are the formats most commonly used by applicants. You may also wish to consult the CIPO website ([www.cipo.ic.gc.ca/tm](http://www.cipo.ic.gc.ca/tm)) to view the additional forms available when preparing your application.

The first, *Sample Application for Registration of a Trade-mark in Use in Canada* (please see Example 1 on page 28), is based on use<sup>1</sup> of the trade-mark in Canada. In this sample application, the following has been included:

- the applicant's name and complete mailing address;
- the trade-mark consisting of a design;
- the statements of “use in Canada,” setting out:
  - the goods and services in association with which the applicant has used the trade-mark,
  - the date of first use for each particular category of goods or services; and
- the entitlement paragraph in which the applicant states that he or she is entitled to use the trade-mark in association with the goods and services listed in the application.

When applying  
for a trade-mark,  
you will need  
to adapt one of  
the application  
formats or create  
your own.

The second, *Sample Application for Registration of a Proposed Trade-mark* (please see Example 2 on page 28), is based on “proposed use”; this term refers to the fact that the applicant has not begun using the mark yet, but intends to use it in Canada in the future.<sup>2</sup> In this sample application, the following has been included:

- the applicant's name and complete mailing address;
- the trade-mark consisting of letters/words (e.g., ABC D-LICIOUS);
- the statements of “intent to use” along with the goods and services in association with which the applicant intends to use the trade-mark; and
- the entitlement paragraph in which the applicant states that he or she is entitled to use the trade-mark in association with the goods and services listed in the application.

For assistance or additional information on trade-marks registration applications, visit the CIPO website ([www.cipo.ic.gc.ca/tm](http://www.cipo.ic.gc.ca/tm)) or contact the CIPO Client Service Centre:

### Client Service Centre

Canadian Intellectual Property Office  
Industry Canada  
Place du Portage I  
Room C-229, 2nd floor  
50 Victoria Street  
Gatineau QC K1A 0C9

Tel.: 1-866-997-1936 (toll-free)

TTY: 1-866-442-2476

Fax: 1-819-953-7620

Email: [cipo.contact@ic.gc.ca](mailto:cipo.contact@ic.gc.ca)

1. The term “use” refers to current and prior use of the trade-mark in Canada.

2. The term “future” means within three (3) years from the date of filing or six (6) months from the date of the notice of allowance.

## Example 1

### *Sample Application for Registration of a Trade-mark in Use in Canada*

To the Registrar of Trade-marks, Gatineau, Canada.

The applicant, **DEF Inc.**, whose full post office address of its principal office or place of business is **456 Number Avenue, Ottawa, Ontario, D4E 5F6**, applies for the registration of the trade-mark identified below.

The trade-mark is:



The trade-mark has been used in Canada by the applicant in association with **blouses, sweaters, pants, skirts, socks, underwear and pyjamas** since **June 03, 1973**.

The trade-mark has been used in Canada by the applicant in association with **retail clothing store** since **September 17, 1973**.

The trade-mark has been used in Canada by the applicant in association with **retail jewelry store** since **July 02, 1998**.

The applicant is satisfied that he or she is entitled to use the trade-mark in Canada in association with the **goods and services** described above.

## Example 2

### *Sample Application for Registration of a Proposed Trade-mark*

To the Registrar of Trade-marks, Gatineau, Canada.

The applicant, **ABC Limited**, whose complete mailing address of its principal office or place of business is **123 Alphabet St, Ottawa, Ontario, A1B 2C3**, applies for the registration of the trade-mark identified below.

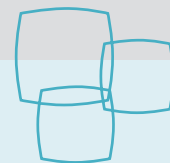
The trade-mark is

**ABC D-LICIOUS**

The applicant intends to use the trade-mark in Canada in association with **prepared meals** and requests registration of the trade-mark in respect of such goods.

The applicant intends to use the trade-mark in Canada in association with **restaurant services and take-out food services** and requests registration of the trade-mark in respect of such services.

The applicant is satisfied that he or she is entitled to use the trade-mark in Canada in association with the **wares and services** described above.



### COMMON ERRORS TO AVOID

*Before filing your trade-mark application, take some time to go through the following checklist for useful information to help you avoid common errors made by applicants that result in delays in the processing of applications.*

#### Filing fee

Remember that each application must be accompanied by:

- a) a fee of \$250 (non-refundable) for each trade-mark applied for where the application and fee are submitted online to the Office of the Registrar of Trade-marks, via the Canadian Intellectual Property Office (CIPO) website ([www.cipo.ic.gc.ca/tm](http://www.cipo.ic.gc.ca/tm)); or
- b) a fee of \$300 (non-refundable) in any other case.

**Note:** Payment may be made by credit card (VISA, MasterCard, or American Express), direct payment, postal money order, or cheque (the postal money order or cheque must be made payable, in Canadian dollars, to the Receiver General for Canada). Do not add federal and provincial taxes.

#### Goods/services

You may not use a trade-mark registered by someone else to describe your goods or services. Registered trade-marks that have become part of everyday language but are nevertheless registered trade-marks include “yo-yo,” “bubble wrap,” and “Kleenex.” Search in the Canadian Trade-marks Database to make sure that the terms you wish to use to describe your goods or services are not already registered trade-marks.

Make sure that you include all the goods or services with which you intend to use, or have used, your trade-mark, as you will not be permitted to list additional goods or services after you have filed the application. Remember that goods or services that have been used should be listed separately from goods or services that are proposed to be used.

There is a requirement in the *Trade-marks Act* that the goods or services applied for be set out in specific ordinary commercial terms. In other words, your application should state common names for the goods and services and use wording that is as complete and as specific as possible (e.g., shirt, bread, sofa, etc.). To assist you in this, the *Wares and Services Manual*, which you can consult on CIPO’s website ([www.cipo.ic.gc.ca/tm](http://www.cipo.ic.gc.ca/tm)), provides acceptable identifications of many goods and services and includes guidelines for identifying those goods and services not listed.

### Date of first use in Canada

If you have used your trade-mark in Canada in association with goods or services, you must provide the Office of the Registrar of Trade-marks with the date of first use. Make sure that the date of first use does not fall AFTER the filing date of your trade-mark application. If the date of first use falls AFTER the filing date, it may be best to file for a proposed trade-mark.

### Acceptable date of first use

When only the month and year are stated as the date of first use, the last day of that month will be deemed the effective date. When only the year is named, December 31 of that year will be deemed the effective date. However, in all cases, the date of first use cannot be subsequent to the date of filing of the application. For example, if you filed your application in 2004, and then state that you have used your trade-mark in association with your goods or services “since 2004,” the Office of the Registrar of Trade-marks will assume that this means that you have been using the goods or services since the last day of 2004. This could render your date of first use unacceptable if you filed in 2004 prior to December 31 since the date of first use would then fall AFTER your filing date.

### Is it a word, or is it a design?

You must be clear about what you wish to register. Is it a word or words not depicted in a special form? Is it a design that includes a special form? In the first instance, where there is no special form, simply state “The trade-mark is,” and, following this statement, set out the word or words in upper- or lower-case letters. In the second instance, where the trade-mark is a design, state “The trade-mark is shown in the accompanying drawing,” and attach the drawing to the application in the appropriate area on your application. If you are having trouble deciding what you want to register, you can refer to the Application section of this guide.



# GLOSSARY

**Abandonment**

An application for trade-mark registration may be considered abandoned if the applicant does not complete all steps in the application process.

**Advertisement**

Publication of a trade-mark application in the *Trade-marks Journal*. Details are published in order to allow opportunity for opposition (challenges) to the application.

**Allowance**

Acknowledgement by the Office of the Registrar of Trade-marks that an application is eligible for registration. The applicant receives a “Notice of Allowance”.

**Assignment** (please see also *Transfer*)

Transfer of trade-mark rights from the owner to another party.

**Certificate of registration**

Official document acknowledging that a trade-mark has been registered in the Register of Trade-marks.

**Certification mark**

Mark identifying goods or services meeting a defined standard, e.g., the Woolmark design used on clothing.

**Clearly descriptive mark**

A word (or words) that describe an inherent feature of a product or service.

**Copyright**

Provides protection for literary, artistic, dramatic, or musical works (including computer programs), as well as three other subject matter: performances; sound recordings; and communication signals.

**Corporate name**

The name registered by a legal organization for the purpose of carrying on business. A corporate name can also be a trade-mark.

**Deceptively misdescriptive mark**

A word that may not be registered as a trade-mark or part of a trade-mark because it is misleading.

**Disclaimer**

A statement to the effect that the applicant does not have exclusive rights to a given word or to a portion of a trade-mark.

**Distinguishing guise**

The shaping of goods or their containers, or a mode of wrapping or packaging goods, which results in a distinctive appearance and thus distinguishes the goods or services from others in the marketplace.

**Examination**

The process through which the Office of the Registrar of Trade-marks determines whether an application for trade-mark registration may proceed to registration.

**Expungement**

The removal of a trade-mark from the Register of Trade-marks.

**Fee**

A specific sum payable to the Office of the Registrar of Trade-marks for a given service.

**Filing date**

The date on which a completed application is filed with the Office of the Registrar of Trade-marks (this is different from the date on which a trade-mark is registered in the Register of Trade-marks).

**Goods** (please see also *Products and Wares*)

Any articles that would normally be the subject of trade, i.e., sold, leased, or otherwise distributed in the marketplace.

**Incorporation**

The act of establishing a corporation under the law by filing the required documents.

**Industrial design**

The visual features of shape, configuration, pattern, or ornament (or any combination of these features), applied to a finished article of manufacture.

**Infringement** (of a trade-mark)

Violation of trade-mark rights through unauthorized use of a trade-mark.

**Integrated circuit topographies**

The three-dimensional configuration of the electronic circuits in integrated-circuit products or layout designs.

**Intellectual property**

A form of creative effort that can be protected through a trade-mark, patent, copyright, industrial design, or integrated-circuit topography.

**Licensee**

Individual or organization licensed by the owner of a trade-mark to use this trade-mark subject to specific terms and conditions. When an individual or organization is licensed by the owner, or with the authority of the owner, to use the mark, where the owner has direct or indirect control over the character or quality of the goods or services in respect of which the mark is used, then the licensee's use of the mark or a trade-name including the mark is deemed to have, and to always have had, the same effect as use by the owner.

**Office of the Registrar of Trade-marks**

The federal agency responsible for administering the trade-marks process in Canada.

**Opposition**

The process followed when members of the public object to the granting of a trade-mark registration, where they have valid grounds for doing so (anyone filing an opposition must pay the applicable fee).

**Ordinary commercial terms**

The generic description customarily used in the trade to refer to specific goods or services.

**Patent**

A government grant giving the right to exclude others from making, using or selling an invention. A Canadian patent applies within Canada for 20 years from the date of filing of a patent application. The patent application is available to the public 18 months after filing.

**Plant breeders' denomination**

A right granted to the owner for the control over the multiplication and sale of reproductive material in respect of a particular plant variety.

**Place of origin**

A word or depiction denoting the origin of a product or service.

**Preliminary search**

The search of Office of the Registrar of Trade-marks records one should carry out before filing an application for trade-mark registration.

**Pre-publication search**

A second search of Office of the Registrar of Trade-marks records to ensure that no trade-mark exists that could be confused with the one for which an application for registration is being made, before this application is advertised in the *Trade-marks Journal*.

**Prima facie evidence** (direct evidence)

Evidence legally sufficient to establish a fact or to raise a presumption of fact, unless rebutted.

**Products** (please see also *Goods and Wares*)

Any articles that would normally be the subject of trade, i.e., sold, leased, or otherwise distributed in the marketplace.

**Prohibited marks**

Marks specifically prohibited from use and which may not be registered under the law.

**Proposed use**

The use which an owner intends to make of a certain trade-mark and how that use will occur.

**Protected geographical indication**

An indication identifying that a wine or spirit originates from a given territory, whereby a specific quality, the reputation, or other characteristic of the wine or spirit is essentially attributable to its geographical origin, and where the wine or spirit is included in the List of Geographical Indications maintained by the Registrar of Trade-marks.

**Registration**

The inclusion of a trade-mark in the Register of Trade-marks, in accordance with the *Trade-marks Act*.

**Registered trade-mark**

A trade-mark entered in the federal government's Register of Trade-marks; this formally recognizes the owner's right to the mark.

**Register of Trade-marks** (please see also *Trade-marks Register*)

The official listing of registered trade-marks for Canada.

**Representative for service**

A person in Canada appointed by the applicant to receive notices and upon whom service of any proceedings in respect of the application may be given, with the same effect as if they had been given to, or served upon, the applicant.

**Services**

Any activity or intangible that benefits others which would normally be the subject of trade, i.e., performed or offered in the marketplace.

**Summary expungement** (section 45 proceedings)

The process followed when the Registrar issues a notice to a registered owner of a trade-mark asking him or her to provide evidence showing use of the trade-mark in Canada in the preceding three years (anyone requesting the issuance of such notice must pay the prescribed fee).

**Trade-mark**

A trade-mark is a word (or words), a design, or a combination of these, used to identify the goods or services of one person or organization and to distinguish these goods or services from those of others in the marketplace.

**Trade-mark agent**

A trade-mark agent is a person whose name is entered on the list of officially recognized trade-mark agents and who is therefore entitled to practice before the Office of the Registrar of Trade-marks.

**Trade-marks Act**

The federal legislation governing trade-mark registration in Canada.

**Trade-marks Examination Manual**

A guide explaining the statutory guidelines for examining trade-marks applications, which sets out the interpretation of provisions of the *Trade-marks Act* and the *Trade-marks Regulations* made by the courts; this guide is used primarily by trade-mark examiners for purposes of the examination process.

**Trade-marks Journal**

A weekly publication of the Office of the Registrar of Trade-marks containing all approved applications and all Office rulings.

**Trade-marks records**

The index of registered trade-marks and pending applications maintained electronically by the Office of the Registrar of Trade-marks.

**Trade-marks Register** (please see also *Register of Trade-marks*)

The official listing of registered trade-marks for Canada.

**Trade-marks Regulations**

Federal regulations made pursuant to section 65 of the *Trade-marks Act* for carrying into effect the purposes and provisions of the Act.

**Trade name**

The name under which a business or individual chooses to operate. Trade names may also be considered trade-marks, under certain conditions.

**Transfer** (please see also *Assignment*)

An act by which the rights in respect of a trade-mark are conveyed from one person or organization to another.

**Wares** (please see also *Goods and Products*)

Any articles that would normally be the subject of trade, i.e., sold, leased, or otherwise distributed in the marketplace.

**Wares and Services Manual**

A guide used for specifying goods and services in trade-mark applications pursuant to paragraph 30(a) of the *Trade-marks Act*.

**Word mark**

A trade-mark consisting of words in standard character, without regard to colour or font type.



