

INTELLECTUAL PROPERTY

TRADE-MARKS IN CANADA: PROPER USE & MAINTENANCE

by Paul Bain

Proper usage is essential to protecting and maintaining valuable rights in trade-marks. The general rule is 'use it or lose it': unless a trade-mark is actually used continuously in connection with products or services, rights will erode and eventually be lost. Should a trade-mark be used improperly, it can become unenforceable and therefore of no value. The primary rule is that a trade-mark must indicate the source of goods or services and distinguish those goods/services from others. It is important to ensure that when the trade-mark is adopted and used, it is regarded by the public as being a trade-mark and not as a generic usage.

The following is a brief list of the most important considerations in using any trade-mark, whether registered or not:

1. Trade-marks as Adjectives Only – Not Generic

Trade-marks should be used as adjectives, and not as nouns or verbs, in order to avoid becoming generic or descriptive terms for the relevant product or service. Examples of proper usage (identifying the wares/services) are as follows: "*Pass the KLEENEX tissue*", or "*KODAK cameras take the best pictures*." A trade-mark should not be pluralized.

2. Emphasize the Trade-mark and Use it Consistently

Trade-marks should be highlighted in such a way that they are easily distinguished from any accompanying text or design elements. If the trade-mark is a word or phrase and is usually presented in a design or stylized form, then it should *always be depicted in that form* (or at least wherever practical). If there is no accompanying design, the letters should be capitalized, or alternatively, italic type or quotation marks should be employed in order to distinguish the trade-mark in a body of text.

Trade-marks should be presented in a consistent, constant form. The spelling of the trade-mark should *never be changed*, nor should any extraneous punctuation be inserted unless such punctuation is always used in connection with the trade-mark. Trade-marks that are registered should always be used in the exact form as registered. Small changes to a registered mark can lead to difficulties in enforcing trade-mark rights down the road.

3. Give Notice to Public

Canada does not require the use of trade-mark notices, but it is advisable to use notices as a matter of prudence. In any advertising, Websites, promotional materials, packaging or labelling in which a trade-mark is to be used, it must be *emphasized that the trade-mark is regarded as a trade-mark and that it is the owner's property*.

- The TM symbol should be used with trade-marks which are in use but not registered. The [®] symbol should be used with trade-marks that are registered in Canada.
- The following legend (or footnote) should also be used wherever possible, including Websites and advertising: "*BRAND-X is a trade-mark [or registered trade-mark, if applicable] of ACME Industries Inc.*"

4. Licensing

If someone other than the owner is using the trade-mark (with the authority of the owner), that use should be documented in a written license agreement and a proprietary notice should be used which indicates that there is a licence in place. The registered owner should maintain direct or indirect control of the quality of the wares/services.

5. Foreign Rights

The rights obtained by registering the trade-mark in Canada do not extend outside Canada. Separate registrations must be obtained for each country or jurisdiction, eg. the European Union, where use of the trade-mark is proposed. In many countries, a Canadian trade-mark registration may form the basis of the foreign application.

6. Infringement

Infringement involves use of a trade-mark or of a confusing trade-mark by a party other than the registered owner, or who is not authorized by a license agreement. Steps should be taken to protect and to enforce trade-mark rights, eg. by monitoring trade literature carefully to identify potential infringers, and to prevent loss of distinctiveness or the registration of confusing trade-marks by others. 'Watch' services are available to identify confusing trade-marks which are applied for in Canada or elsewhere, so that opposition and other steps may be undertaken where necessary to protect marks.

FOR MORE INFORMATION CONTACT:



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