

**TRADE-MARK DO'S & DON'TS**

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**What is a Trade-mark?**

- Words, logos
- Distinctive
- Distinguish wares or services
- New areas

**Problems with an Unregistered Trade-mark**

- Common law rights
- Other places in Canada
- Conflict - proof
- Expense

**British Columbia Corporate Registry**

- Registry name search
- Separate for each province
- No assurance of trade-mark rights
- Trade-mark search

**Use of a Trade-mark**

- Use in the normal course of trade
- Correct use - no changes
- Continuous use - 3 years
- Expiry - 15 years

### **Advantages of Registration**

- All of Canada
- Reduces potential conflicts
- Free policing
- Infringement action
- Incontestable elements after 5 years
- Helps international registration

### **Symbols**

- TM      Trade-mark status - unregistered
- R      Registered - after registration
- MC      Marque de Commerce - trade-mark status - unregistered
- MD      Marque DJposJe - registered - after registration
- \*      Asterisk

**Success**

- Xerox, kleenex, hoover
- Trampoline, nylon, cellophane

**Buying and Selling a Business**

- Value of a trade-mark
- Transfer of all rights

### **Steps to registration: Start to Finish**

- Create a Name
  - Unique words
  - Distinctive
- Research
  - CIPO database
- Searches
  - Canadian & US searches
  - Confusingly similar in sound
  - Confusingly similar in meaning
  - Confusingly similar in appearance
- Investigation
  - Trade-mark no longer used
  - Assignment
  - License

**Steps to registration: Start to Finish**

- Opinion
  - Potential conflict
  - Confusingly similar
  - Type of product
- Filing of a Trade-mark Application
  - Filing - start of protection
  - Examiner's first report
  - Publication
  - Objections - abandonment
  - Opposition
  - Renewal in 15 years

**Choose A Name Early**

- Business disruption
- Delay
- Expense

### **Domain Name Disputes**

- Litigation
- bc.trademarksearches.com
- bc.trademarksearches.ca
- trade-mark application
- not registerable
  - Place of origin
  - Top level domains .ca .com
  - Clearly descriptive words



### **Domain Name Registration in Canada**

- Canadian Internet Registration Authority (CIRA)
- .ca

### **Domain Name Dispute Resolution**

- Internet Corporation for Assigned Names and Numbers (ICANN)
- Informal
- Resolved via Internet

**Trade-marks Infringement Through Domain Name Use**

- "Initial interest" confusion