

Why Register Your Trademark?

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published 05/12/2022

Trademarks are everywhere. A trademark is a sign or combination of signs that is used by a person in order to distinguish their goods or services from those of others. Trademarks are one of the ways in which a business connects with the world. Examples include:

- The APPLE logo. When a person thinks of the APPLE logo, they think of specific laptops, tablets, and phones.
- The word TIKTOK and its logo. When a person sees TIKTOK or its logo, they think of a specific app.
- The word YOUTUBE and its logo. When a person sees YOUTUBE or its logo, they think of a particular video streaming platform.



It is likely that as you were reading the above, you were able to imagine the associated logos. Some trademarks have gained a significant reputation that they likely can be identified by description alone. Try to identify the trademarks only by their description:

- The phrase, "Finger Lickin' Good"
- Golden Arches
- The letter "f" in white inside a blue square

The trademarks are KFC®, MCDONALD'S®, and FACEBOOK®, respectively. You likely guessed these trademarks without any hints.

In practice, trademarks are usually words or symbols or a combination of words and symbols. For those who have a business, trademarks can be very important in distinguishing their goods and/or services from those of others. Moreover, a trademark can develop repute such that the consumer associates it with their personal preferences, quality, or some other characteristic. It is an identifier and can help the consumer navigate the marketplace to find a business's products. This article provides an overview of the importance of registering your trademarks.

In Canada, there are common law trademarks and registered trademarks.

Common Law Trademarks

There are generally two requirements to have a common law trademark. First, you must extensively use the trademark in association with specific goods or services. Second, the trademark must gain a reputation in association with the specific goods or services.

With common law trademarks, it is important to note that your ownership will generally be limited to the geographic region in which you have used the trademark extensively and in which it has gained a reputation in association with your goods and services.

If another person were to use your trademark in association with the same or similar goods and services you offer, your only remedy is to claim that the other party is trying to “pass off” as you. This remedy is sought from the courts. The problem, however, is that courts will generally only recognize your right to use the common law trademark in the area in which the use and reputation of the trademark has been established. That is, the protection is **not** Canada-wide. Thus, if you used the trademark in Manitoba but the person you allege to have violated your trademark rights is in British Columbia (where your trademark may not have had prior use or reputation), you will have difficulty enforcing your trademark rights in British Columbia and difficulty stopping the alleged infringers.

Further, the bar for you to meet in order to obtain protection is higher. At trial, you will have to provide evidence of your extensive use and reputation. This can be more costly than registration.

In brief, for common law trademarks, you get limited protection to a geographic region, you bear a greater burden of showing your entitlement to exclusive use of the trademark, and the cost of stopping the alleged infringer can be more than registration.

Registered Trademarks

Ownership of a registered trademark is achieved via registration with the Canadian Intellectual Property Office (“CIPO”).

Registration provides much more extensive protection of a trademark. In fact, it adds to your common law rights.

First, your trademark rights are protected **throughout** Canada. This is the biggest benefit of registration. Even if you are only using the trademark in Manitoba, you can stop another person in British Columbia from infringing your rights after the registration date regardless of whether you have products or a reputation there if the infringer starts to use your trademark. This reduces competition for you to enter that geographic market for when you are ready.

Second, upon further steps, you can have the Canadian Border Services Agency monitor commercial shipments for possible counterfeit goods that may be entering or leaving Canada.

Third, subject to its validity, ownership of a registered trademark is a defence to claims of trademark infringement or passing off.

These are only some of the benefits you can acquire by registering your trademark. Overall, registration offers a number of advantages over unregistered trademarks.

To determine whether brand protection through trademark registration is right for you, please contact us.

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