



# Protect your brand

## Why trademarks matter

# Agenda

IP overview

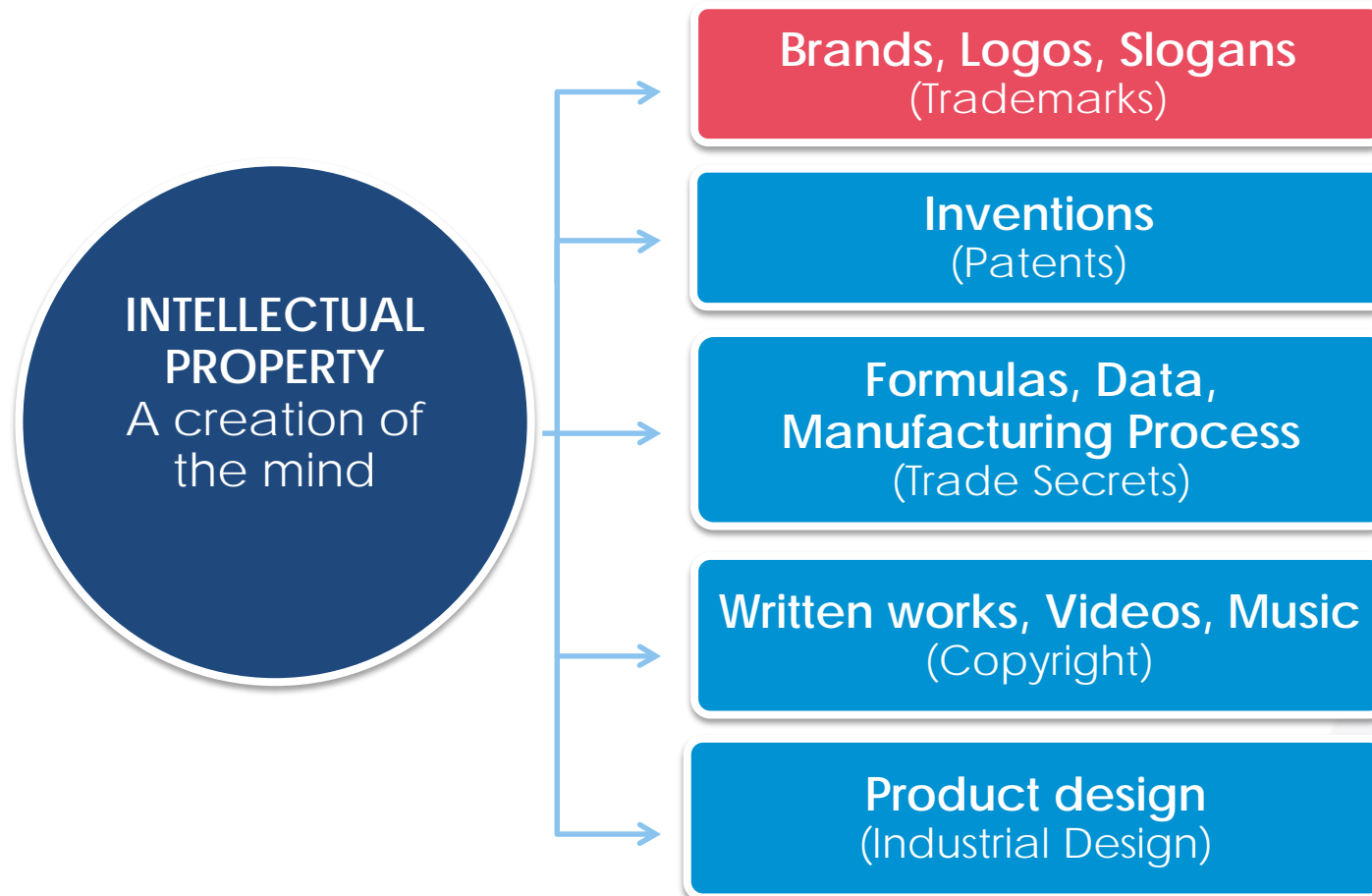
Defining trademarks

Considerations

Value added

Summary

# IP overview



# Types of IP

Intellectual property is a creation of the mind.

## TRADEMARKS



A “sign” or a combination of “signs” used to distinguish the goods or services of one person or organization from those of others

## PATENTS



New, useful and non-obvious inventions or improvements to an existing invention

## COPYRIGHT



Original works such as literary, artistic, dramatic or musical works

## INDUSTRIAL DESIGNS



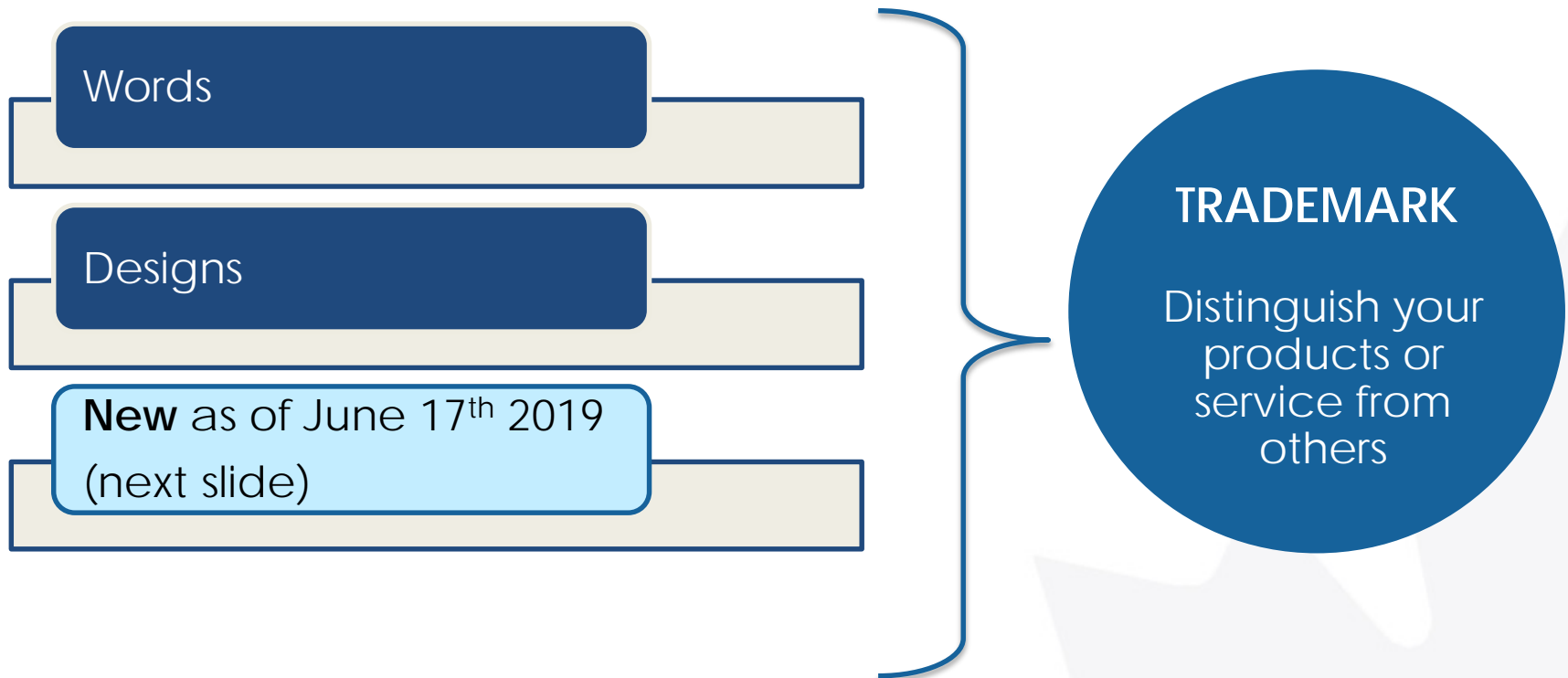
Novel visual features of shape, configuration, pattern or ornament as applied to a finished article

## TRADE SECRETS



Confidential and valuable business information

# Defining trademarks



# Defining trademarks

As of June 17<sup>th</sup> 2019, trademarks also include:

- Tastes
- Textures
- Moving images
- Mode of packaging
- Holograms
- Scents
- Three-dimensional shapes
- Colour

# Defining trademarks

## Trademark

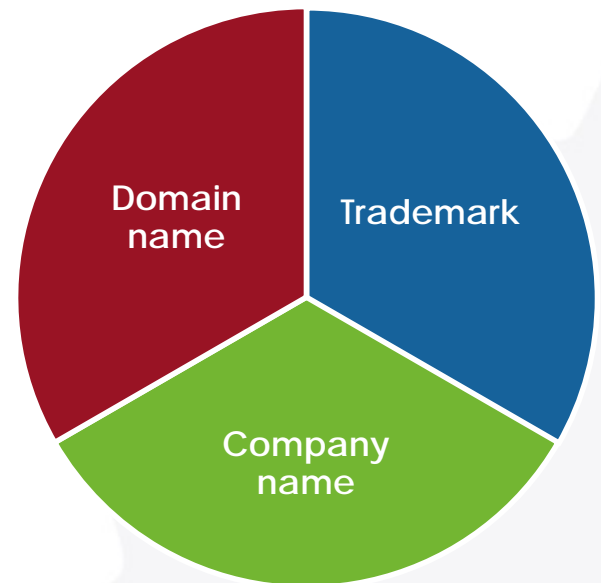
- A trademark is a “**sign**” or **combination of “signs”** used or proposed to be used by a person or organization to distinguish their **goods or services** from those of others.

## Company Name

- The **legal name** under which any **business** is carried on.

## Domain Name

- The **name** used to identify one or more **internet addresses**.



# Defining trademarks - Example





# Considerations – Choosing a TM

- **Several IP rights** may be attached to the **same** trademark



e.g. “Michelin Man”:  
trademark & copyright



e.g. Coca-Cola bottle:  
trademark & industrial design

# Considerations – Choosing a TM

 **SUPER FRESH  
FRUIT & VEGETABLES**

Not Clearly Descriptive

 **Mckay's**

Not Primarily a Person's Full Name or Surname

 **OWOCE I  
WARZYWA**

Not the Name of Products and Services  
– in Any Language

 **LIKE A LITTLE  
Loblaws®**

Not Confusing with Another TM

# Considerations – Choosing a TM

*Italy*



Not Descriptive of a geographical location

Air express



Not Deceptively misleading

*Joe's Maple Syrup*



Not Identical or likely to be mistaken with prohibited trademarks

# Considerations – Choosing a TM

- A person's name or a clearly descriptive mark can sometimes function as a trademark **after extensive use in the marketplace.**

**Mckay's**

**SUPER FRESH  
FRUIT & VEGETABLES**

# Considerations – Search the Database

Find out what trademarks are already registered:

- In **Canada**: [cipo.ic.gc.ca/searchtm](http://cipo.ic.gc.ca/searchtm)
- In the **United States**: [uspto.gov/trademarks-application-process/search-trademark-database](http://uspto.gov/trademarks-application-process/search-trademark-database)
- In the WIPO Global Brand Database : <https://www.wipo.int/branddb/en/>

# You should know

## Time to register

- 1 – 1.5 years

## Length of protection

- 10 years

## Renewable

- Every 10 years

# Registration cost and other fees

Cost will vary depending on your needs. The following is for information purposes only:

Activity	Fees
<b>Application</b> (includes the <u>first Nice class of goods or service</u> to which the application relates as of the filing date)	\$330
Each <u>additional class</u> of goods or services to which the application relates as of the filing date	\$100
<b>Renewal</b> (includes the <u>first Nice class of goods or service</u> to which the request for renewal relates)	\$400
Each <u>additional class</u> of goods or services to which the request for renewal relates	\$125
*IP Professional Fees (generally hourly-based fee)	\$500 – \$2,000

\* IP agent cost varies based on the complexity of the work and the experience of the agent. Most agent work is charged hourly

# Considerations - TMs in Canada

## Registered

- Trademark must be used during the course of trade
- Exclusive rights to prevent others from using your TM



# Considerations - TMs in Canada

## Unregistered (Canadian common Law TMs)

- Depends on evidence of distinctiveness
- Limited to the geographical region where you can prove sufficient reputation / good will
- Some countries only enforce registered TMs

# Consult an IP professional

Advantages of leveraging the expertise of an IP Professional early in the process:

- Establish precise scope of **IP rights**
- Obtain complete **fee estimates for budgeting**
- Create comprehensive strategy for **national and international protection**

## Tips

Prior to consulting with an IP professional:

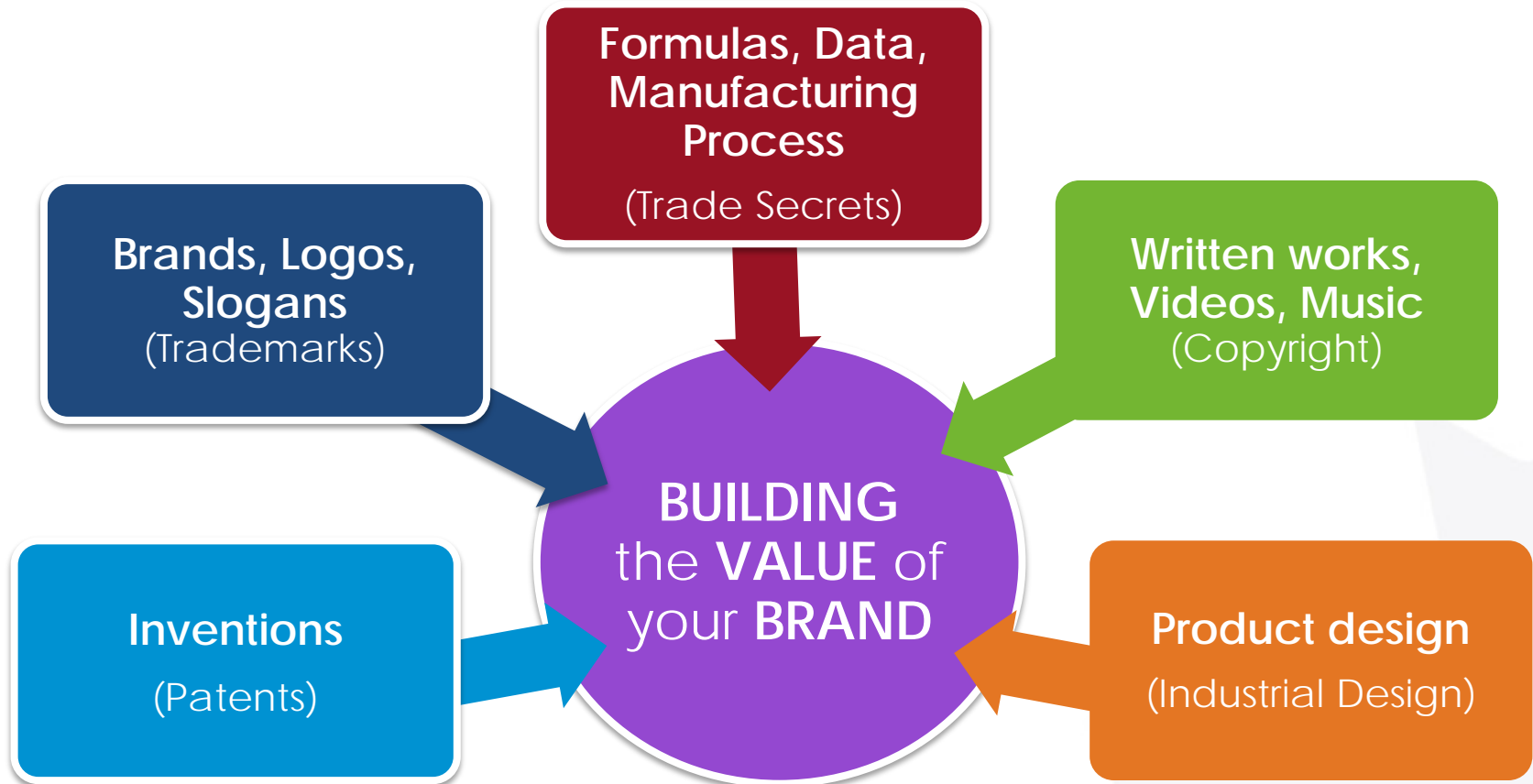
- **Understand** the different types of IP
- Do a **quick search** to see if your IP is available
- Consider in **which countries** you want to protect your IP rights

# IP professional expertise

## IP professional services:

- Patentability Searching/Opinion
- Trademark Availability** Searching/Opinion
- Drafting/Preparing** Application
- Filing** Application
- Examination/Prosecution
- Freedom to Operate Opinion
- Infringement Opinion

# Value added by TMs



# Value added by TMs

## 2019 Brand Value Estimated by Forbes



\$187.91 billion USD

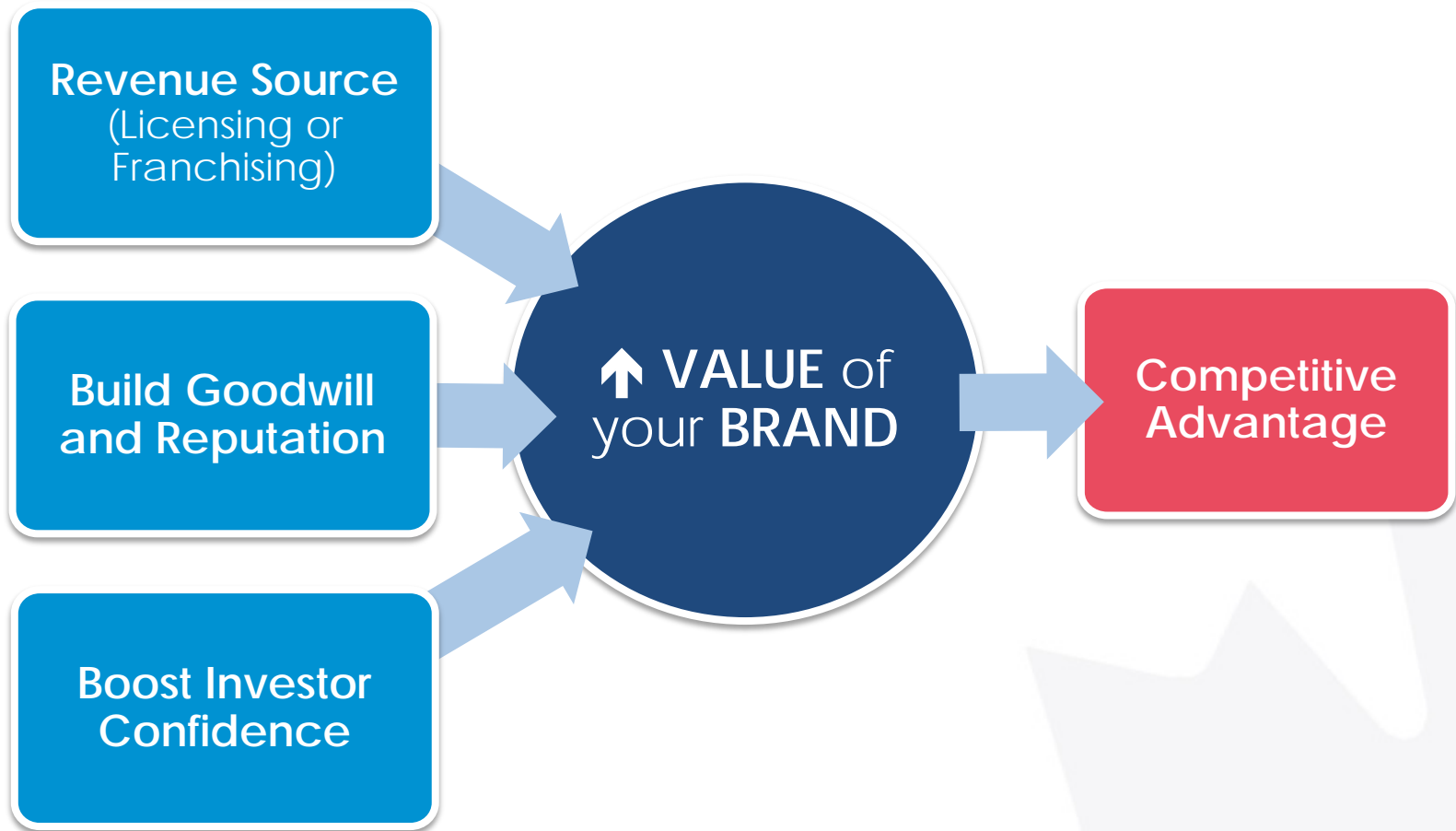


\$153.63 billion USD



\$142.76 billion USD

# Value added by TMs



# Value added by TMs

- **Differentiates** your product or service from the competition
- Builds **reputation** & **goodwill**
- Your **brand** can express:
  - What your business stands for
  - What you want your business to be
  - How your business is perceived in the marketplace.

# Case study – McDonalds

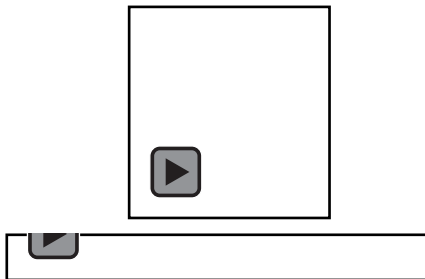
McDonalds Registered Trademarks:



**LOGO** - TMA 626,741  
<http://goo.gl/y5j8D3>

**I'M LOVING IT**

**SLOGAN** - TMA 641,710  
<http://goo.gl/G3qoSX>



**SOUND** – TMA 927,177  
<http://goo.gl/EGfMSN>



# Case study – Shopify

Shopify's Registered Trademarks:

**LOGO** – TMA 700,694  
<http://goo.gl/IZFFIA>



**BRAND** – TMA 787,767  
<http://goo.gl/ChEgKQ>

**SHOPIFY**

# Case study – Canada Goose

Canada Goose's Registered Trademarks:

**LOGO** – TMA 750,591

<http://goo.gl/OCfa98>



**BRAND** – TMA 551,985

<http://goo.gl/cJr10G>

**CANADA GOOSE**

# Summary

## Trademarks:

- “Sign” or combination of “signs” used or proposed to be used by a person to distinguish their goods or services from those of others
- Help build your [reputation](#) and [goodwill](#) leading to *brand value*

# Summary

**Trademarks** should **NOT** be:

- Clearly descriptive
- Only a person's full name or surname
- The name (in any language) of products or services
- Confusing with another mark
- Deceptively misdescriptive
- The geographical location where the goods or services come from
- Identical or likely to be mistaken for prohibited marks

# More information



INTELLECTUAL PROPERTY INSTITUTE OF CANADA  
INSTITUT DE LA PROPRIÉTÉ INTELLECTUELLE DU CANADA

**IPIC**

- [www.ipic.ca](http://www.ipic.ca)
- 613-234-0516
- In-person meetings by appointment
  - Constitution Square  
360 Albert Street, Suite 550  
Ottawa, ON K1R 7X7
- Bank of Speakers Presentation:
  - Bring your creations to life. Learn why intellectual property matters
  - Protect your brand. Why trademarks matter
  - Inventing the next big thing. Why patents matter
  - It's all in the 'look'. Why industrial designs matter



- [www.cipo.gc.ca](http://www.cipo.gc.ca)
- 1-866-997-1936
- In-person meetings by appointment
  - Canadian Intellectual Property Office  
Place du Portage I  
50 Victoria St., Room C-229  
Gatineau, QC K1A 0C9
- Other CIPO events:
  - Search "CIPO calendar of events"



English



<https://form.simplesurvey.com/f/I/IPAE>

Canada 