Protect your brand
Why trademarks matter
Agenda

- IP overview
- Defining trademarks
- Considerations
- Value added
- Summary
IP overview

INTELLECTUAL PROPERTY
A creation of the mind

- Brands, Logos, Slogans (Trademarks)
- Inventions (Patents)
- Formulas, Data, Manufacturing Process (Trade Secrets)
- Written works, Videos, Music (Copyright)
- Product design (Industrial Design)
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.

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**IP Overview**  **Defining TMs**  **Considerations**  **Value added**  **Summary**
Defining trademarks

- Words
- Designs

New as of June 17th 2019 (next slide)

TRADEMARK

Distinguish your products or service from others
As of June 17th 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

Trademark: Tim Hortons

Company Name: Tim Hortons Inc.

Domain Name: timhortons.com
Considerations - Choosing a TM

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

  - **e.g. “Michelin Man”:** trademark & copyright
  
  ![Michelin Man](image)

  - **e.g. Coca-Cola bottle:** trademark & industrial design
  
  ![Coca-Cola bottle](image)
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 Loblaw**: 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™

- 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/search.htm
- In the United States: 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:

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

*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)

- Depend 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

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

BUILDING the VALUE of your BRAND

- **Inventions** (Patents)
- **Brands, Logos, Slogans** (Trademarks)
- **Formulas, Data, Manufacturing Process** (Trade Secrets)
- **Written works, Videos, Music** (Copyright)
- **Product design** (Industrial Design)
Value added by TMs

2019 Brand Value Estimated by Forbes

- Amazon: $187.91 billion USD
- Apple: $153.63 billion USD
- Google: $142.76 billion USD
Value added by TMs

- Revenue Source (Licensing or Franchising)
- Build Goodwill and Reputation
- Boost Investor Confidence

↑ VALUE of your BRAND

Competitive Advantage
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

**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/lZFFIA](http://goo.gl/lZFFIA)

**BRAND** – TMA 787,767
[http://goo.gl/ChEqKQ](http://goo.gl/ChEqKQ)
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
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

- 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
- 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”
  - @CIPO_Canada
https://form.simplesurvey.com/f/l/IPAE
Canada