



TRADE-MARK USE GUIDELINES

One of the most important requirements for obtaining and maintaining trade-mark rights in Canada is proper use of the mark in accordance with the requirements of the *Trade-marks Act*. Trade-mark rights arise from adoption and use of a trade-mark. Generally, a trade-mark will not be registered in Canada unless and until it is used by or on behalf of its owner in Canada. The manner in which a trade-mark is used may enhance the practical and legal value of the mark. The opposite is also true.

Under the *Trade-marks Act*, a trade-mark is considered to have been used in association with: (a) wares, when the mark appears on the wares themselves, on the packaging of the wares or is otherwise brought to the attention of the purchaser at the time title to the wares is passed; and (b) services, when the mark is displayed in the performance or advertisement of the services which are currently offered. Mere promotion or advertisement before a business actually starts is not adequate.

The following are some general guidelines that can contribute to the enhancement of a trade-mark and help prevent its erosion.

- Use the trade-mark together with the generic name of the ware or service to prevent the mark from becoming a generic term. Once a mark becomes generic, it is no longer protectable.
- Depict the trade-mark in a way that sets it apart from surrounding words and designs. Capital letters or special script can identify and distinguish the trade-mark from surrounding text.
- Use standard trade-mark markings, such as \circledR for registered or unregistered trade-marks or \circledR or Reg'd TM for registered trade-marks. Those markings distinguish the trade-mark from surrounding text, and give notice to the world that you claim ownership in the mark and that it is not intended to be generic.
- Do not use the \circledR symbol in the U.S. if the mark is not registered in the U.S. Improper use of this symbol in the U.S. could prevent you from obtaining a trade-mark registration in the U.S. for the same mark in the future. Instead, use the \circledR marking.
- Avoid altering the look of a registered trade-mark. Modifications to a trade-mark weaken the mark and may expose it to attack for non-use or abandonment.
- Use trade-marks as proper adjectives rather than nouns. E.g. "A box of KLEENEX tissues", as opposed to "A box of KLEENEX".
- Monitor the use of similar trade-marks by others. Consider engaging professional watching services to monitor the Trade-marks Registry for potentially confusing trade-marks.
- Maintain business records evidencing use of the trade-mark.
- Maintain up-to-date records at the Trade-marks Office so that all pertinent correspondence from the Trade-marks Office is received.
- Ensure trade-mark renewals are dealt with in a timely manner. Canadian registrations must be renewed every 15 years. Failure to renew may limit trade-mark protection to territorial rather than country-wide protection.
- Consult with your trade-marks counsel if licensing, franchising, merger, acquisition or other situations arise which may affect the use and ownership of the trade-mark.

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