

MODULE 1.5 – TRADEMARKS – LEARN THE BASICS



UNIVERSITY OF
TORONTO

This presentation is adapted from the IP foundation series on the Canadian Intellectual Property Office (CIPO) website.



Will incorporating my company's name also give me the trademark rights?

What can be trademarked?

In this section, we will introduce trademarks, the value they provide, and things to consider when choosing a trademark.

LEARNING OBJECTIVES FOR TRADEMARKS – LEARN THE BASICS

By the end of this section, you will be able to:

- Describe what a brand is
- Describe what a trademark is
- Explain the value that a registered trademark can provide
- Explain recommendations and restrictions to consider when choosing a trademark



UNDERSTANDING TRADEMARKS

WHAT IS A BRAND?

Simply put, your brand is your image. It represents your **reputation** in the eyes of consumers.

It is built over time and can be a synonym of quality and reliability in the marketplace.

Take a moment to think of brands you like.

...

Why did you specifically think of these brands?



UNDERSTANDING TRADEMARKS

WHAT IS A TRADEMARK?

A trademark is a combination of letters, words, sounds or designs used or proposed to be used by a person to distinguish their goods or services from those of others.

A trademark **protects** your brand identity, which represents your company and your goods or your services.



UNDERSTANDING TRADEMARKS

TRADEMARK, COMPANY NAME, AND DOMAIN NAME

Trademarks, company names and domain names are often confused:

Trademark

Your company name, your logo or the way you identify or refer to your goods or services

Company name

The name under which you conduct your business, your business name or your trade name

Domain name

The name of your website address on the internet

Registering your domain name or incorporating your business does not automatically give you any trademark rights.



UNDERSTANDING TRADEMARKS

EXAMPLES

The Tim Hortons trademark has been used in Canada in association with coffee, donuts and restaurant services since the 1960s. It has been registered (with the "s") since 1991 and is still registered today.

When you hear "Tim Hortons," you may immediately think of a particular type of coffee and an array of donuts served in a particular type of restaurant. That association is exactly what trademarks are meant to do.

Tim Hortons.

- The company name in this example is "Tim Hortons Inc."



- The domain name is "timhortons.com."



- The company uses its trademark in its domain name, but its domain name as a whole is not necessarily a trademark.



UNDERSTANDING TRADEMARKS

TYPES OF TRADEMARKS

There are 2 types of trademarks:



An **ordinary mark** may include words, designs, tastes, textures, moving images, modes of packaging, holograms, sounds, scents, 3-dimensional shapes, or colours. A trademark may consist of **one or any combination** of these to distinguish goods or services.



A **certification mark** can be licensed to many people or companies for the purpose of identifying that certain goods or services meet a defined standard.



IP RIGHTS

COMPONENTS OF A TRADEMARK



Words



Tastes



Moving Images



Designs



Textures



Mode of Packaging



IP RIGHTS

COMPONENTS OF A TRADEMARK



Holograms



Scents



Colours



Sounds



Three-dimensional Shapes

Reminder:

A trademark may consist of **one** or **any combination** of these.



UNDERSTANDING TRADEMARKS

REGISTERING A TRADEMARK

Registering a trademark means it is entered in the **Canadian Register of Trademarks**.

Registering a trademark gives you the **sole right** to use it across Canada for **10 years**. Trademarks are **renewable every 10 years**.

Start the registration process by submitting a trademark application with the Canadian Intellectual Property Office (CIPO).



UNDERSTANDING TRADEMARKS

WHY REGISTER TRADEMARKS?

A registered trademark:

- Constitutes direct evidence that you own the trademark
- Prevents others from registering and using a confusingly similar trademark
- Gives you the ability to enforce your trademark right
- Becomes more valuable if you license your trademark for others to use



UNDERSTANDING TRADEMARKS

TRADEMARK SYMBOLS

There is no legal requirement to mark your trademark with any particular symbol.

However, you may come across the following symbols when searching for trademarks:

The ® symbol indicates that the trademark is **registered**.

The ™ symbol indicates that the trademark is **unregistered** or **in the process of being registered**.



UNDERSTANDING TRADEMARKS

CHOOSING A TRADEMARK

Choosing a trademark is not always a straightforward task.

A trademark should be **unique and not easily confused** with any existing trademark. In order to be registrable, it will also need to comply with the [*Trademarks Act*](#), which is the federal legislation governing trademarks in Canada.



UNDERSTANDING TRADEMARKS

CHOOSING A TRADEMARK

The strongest and most potentially valuable trademarks are usually the **least descriptive, but most distinctive**.

Consider using:

- a coined term or made-up word
- a trademark that is unrelated to the goods or services offered

Consider the translation of your mark if you are thinking of exporting your brand. Translating a trademark into other languages could result in different meanings or interpretations.



UNDERSTANDING TRADEMARKS

A COINED TERM OR MADE-UP WORD

The following are successful Canadian companies and brands that use a coined term or made-up word for their trademark.



Synthetic crude from
oil sands



Outdoor clothing
and sporting goods



Frozen yogurt and
smoothies



UNIVERSITY OF
TORONTO

Entrepreneurship

UNDERSTANDING TRADEMARKS

A TRADEMARK THAT IS UNRELATED TO THE GOODS OR SERVICES OFFERED

The following are successful Canadian companies and brands that use a trademark that is unrelated to the goods or services they offer.

The BlackBerry logo consists of a stylized icon of a berry with three leaves on the left, followed by the word "BlackBerry" in a bold, sans-serif font.

Smartphones
and tablets

The Indigo logo features the word "Indigo" in a white, sans-serif font, centered within a solid dark blue rectangular background.

Books, gifts and
specialty toys

The President's Choice logo features a red square containing a white stylized "PC" monogram, followed by the words "President's Choice" in a black, cursive script font.

Grocery and
household products



UNIVERSITY OF
TORONTO

Entrepreneurship

UNDERSTANDING TRADEMARKS

CHOOSING A TRADEMARK

Trademarks that cannot be registered include the following:

- Clearly descriptive marks
- Trademarks based on a place of origin

 **SUPER FRESH FRUITS AND VEGETABLES**

- Words that are the name of the goods or services in other languages

 **Owoce i Warzywa**



UNDERSTANDING TRADEMARKS

CHOOSING A TRADEMARK

Trademarks that cannot be registered include the following:

- Names and surnames

⊘ **Leblanc's**

- Trademarks that could be confused with other registered or pending trademarks

⊘ **LIKE A LITTLE**
Loblaws

- Deceptively misdescriptive trademarks



UNDERSTANDING TRADEMARKS

USING YOUR TRADEMARK

As the owner of a registered trademark in Canada, you have the responsibility to use the trademark in regard to the goods or services that are identified in the trademark registration.

If you do not use it, your trademark may be expunged from the Register of Trademarks.



CHECK FOR UNDERSTANDING

TRUE OR FALSE: You can lose protection of your trademark, registered or not, if not used.

- A. True
- B. False



CHECK FOR UNDERSTANDING

TRUE OR FALSE: You can lose protection of your trademark, registered or not, if not used.

- A. True
- B. False

Answer: True. An owner may have to prove their use of a trademark, and if not used over a certain period of time, those rights can be expunged (removed).



CHECK FOR UNDERSTANDING

Which of the following are good attributes of a strong trademark? (Check all that apply)

- A. are very descriptive
- B. trademarks that are abstract or fanciful
- C. contain inventive (made-up) words
- D. contains words that are related to the industry



CHECK FOR UNDERSTANDING

Which of the following are good attributes of a strong trademark? (Check all that apply)

- A. are very descriptive
- B. trademarks that are abstract or fanciful
- C. contain inventive (made-up) words
- D. contains words that are related to the industry

ANSWER: B and C. Abstract or fanciful words can make a strong trademark. Strong trademarks are usually the least descriptive and descriptive trademarks may not be eligible for registration. Strong trademarks are usually unrelated to goods or services offered. Many successful companies have used made-up words for their trademark.



SUMMARY OF LEARNING OBJECTIVES FOR TRADEMARKS – LEARN THE BASICS

You should now be able to:

- Describe what a brand is
- Describe what a trademark is
- Explain the value that a registered trademark can provide
- Explain recommendations and restrictions to consider when choosing a trademark

