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Trademarks, what are they, and how do businesses apply for them?

Per the Government of Canada website, “a trademark is a combination of letters, words, sounds or designs that distinguishes one company’s goods or services from those of others in the marketplace.” Trade names, the name of your business, can be registered under the Trademark Act if the business name is used to distinguish your product or service from others. Trademarks may be “combination of words, sounds, designs, tastes, colours, textures, scents, moving images, three-dimensional shapes, modes of packaging or holograms, used to distinguish the goods or services of one person or organization from those of others.”¹This is of key importance to ensure that companies are protecting the goods and services they produce and by extension creating a brand. The question is how does a company seeking government protection do so and what are the associated fees?

Canada has adopted a “first to file” system which is aligned with international standards. This means that the first company to file and register their trademark will be protected. While businesses do have the option of not filing a trademark and proceeding as an unregistered trademark, those that do so run the risk of litigation in the future if their product does get stolen by another company. Registration of a trademark gives companies protection and sole use of that trademark for 10 years.

The Trademarks Act has listed several categories which cannot be trademarked. These include family names and surnames (Example: Dave’s Deli), clearly descriptive marks (Example: The cupcake store), Deceptively mis descriptive marks (example: Registering the word RED for a blue dish soap), place of origin (Example: Toronto donuts), words in other languages, trademarks that are pending or registered already, and trademarks that are identical or likely to be mistaken for identical marks (Example: Raptourz- this can be mistaken for Raptors). For more detailed information please see the Trademarks Act

Below we will discuss a summary to assist with filing and registering a trademark, this is purely for educational purposes- businesses must conduct their own research when filing a trademark. Further information can be found on the government of Canada website and the Trademarks Act.

¹ https://www.ic.gc.ca/eic/site/cipointernet-internetopic.nsf/eng/h_wr02360.html?Open&wt_src=cipo-tm-main&wt_cxt=learn



Filing a trademark application:

1. Conduct a trademark search through the Canadian Trademarks Data base:
 - Businesses need to ensure that they are complying by the rules in the Trademarks Act- thus they must be trying to ensure that their trademark is unique and distinguishable to them alone.
 - Canadian Trademarks Database: <http://www.ic.gc.ca/app/opic-cipo/trdmrks/srch/home?lang=eng>
2. Decide whether to hire a registered trademark agent or apply for the trademark on their own
 - While it is not a requirement to hire a filing agent, filing a trademark is a complex process requiring in depth knowledge of trademark law an understanding of the trademark process.
 - A list of registered trademark agents can be found on the government of Canada website if businesses choose to go that route: https://www.ic.gc.ca/eic/site/cipointernet-internetopic.nsf/eng/h_wr04549.html
3. Finding the trademark form:
 - The online form for filing a trademark can be found here: https://www.ic.gc.ca/app/scr/opic-cipo/mc-tm/depot-filing/connexion-login_eng.htm
 - You may file your trademark application online or send the application through the mail. However, an additional \$100 fee will be required if the application is not submitted online to the Office of the Registrar of Trademarks.
4. Filling out your trademark application:
 - Trademark application must include:
 - o Full name and mailing address of the applicant applying for the trademark
 - NOTE: “Applicant” refers to “an individual, partnership, trade union, association, joint venture, or corporation. 2 or more applicants may fill out a trademark application
 - o A description and/or representation of the trademark which is the subject of the application.
 - o a statement in specific and ordinary commercial terms of the goods and services associated with the trademark
 - o the statement of goods and services grouped according to the Nice Classification
 - o the application fee must be attached
 - o any specific information relevant to your trademark must also be attached
5. Application fees:
 - The fee for each trademark application is \$330. This fee covers the first class of goods or service to which the application relates as of the filing date. An additional fee of \$100



must be paid for each additional class of goods or services to which the application relates as of the filing date

- For businesses seeking to renew their trademark application the fee is \$ 400 for the first class of goods or service to which the request for renewal relates and \$125 for any additional classes of goods.
- An additional fee of \$100 must be paid if the applicant does not submit their application online.

6. Filing date:

- Canada has a “first to file” system thus the filing date is essential as this date will determine whether or not you are entitled to the trademark.
- Upon submission of your application, the registrar will review your application material and ensure that all required information is present. Any ambiguities or missing required information in the application may be noted and the applicant may be asked to provide more information.
- Once the application has all of the requisite information and has met the filing requirements the application will be filed.
- Note: the date that the application is filed with your application is the filing date of the trademark

7. Examining your application for a trademark

- When the filing date has been granted by the registrar, they will search the trademark database to make sure there are no conflicting current or pending trademarks that may be confused with the applicant’s trademark
- They will also assess the trademarks to ensure it complies with the Trademarks Act and Regulations
- Ensure that there is no challenge from the general public of your trademark by publishing the application in the *Trademarks Journal*. If there is no challenge to the trademark, it will be registered.