



Trade-mark Truisms

Best Practices for Acquiring and
Managing Trade-marks in Canada

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“The early bird gets the worm”

- Generally, the person who uses a trade-mark first in Canada has rights in the mark.
- Trade-mark applications are generally considered on a “first come, first served” basis by the Canadian Trade-marks Office.



“Use or lose it”

- Trade-mark rights in Canada are acquired and maintained by use.
- Use claims for trade-mark registration applications must be accurate to have a valid registration.

“An ounce of prevention is worth a pound of cure”



- It is recommended to order searches and obtain a legal opinion to assess a trade-mark's availability before trade-mark use and filing an application.

“An ounce of prevention is worth a pound of cure”



- Domain name and social media account registrations are also key to protecting any rights and reducing costs.

“An ounce of prevention is worth a pound of cure”



- Franchise agreements, as well as operations manuals, should address trade-marks use on the Internet and in social media.

“You don’t know what you’ve got ‘til its gone”

- “Policing” your trade-marks can help to maintain their distinctiveness and may also help to prevent customer confusion and lost revenue.

“You don’t know what you’ve got ‘til its gone”

- Documenting trade-mark use is critical in the event you need to assert or defend your rights in your trade-marks.
- Such documentation can also be useful for obtaining financing or selling your business.

“You don’t know what you’ve got ‘til its gone”

- Avoid “naked” licensing – ensure your business has direct or indirect control over the quality or character of the goods/services offered under your company’s trade-marks to ensure that trade-mark use is attributed to your business.

“You don’t know what you’ve got ‘til its gone”

- Inaccurate use claims in trade-mark applications can void the application – resulting in a piece of paper as opposed to assertable rights.



Thank you

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These slides do not constitute legal advice.