

TRADE-MARK REGISTRATION PROCESS

A trade-mark registration allows the owner of the trade-mark to prevent others from using a confusing mark in the country(ies) where registration exists. To register his mark, the owner must first file a trade-mark application before one or more Trade-Mark Offices, each with jurisdiction to grant a registration in the geographic area over which coverage is applied for. Usually, a distinct trade-mark application is filed in each country where protection is sought, although some regional protections are available such as in Europe. Once the trade-mark application specification complies with the laws of the Trade-Mark Office concerned, a registration is granted. This may take up to a few years, depending on the Trade-Mark Office.

Choosing a trade-mark

The choice of a trade-mark must of course be accomplished very carefully. The business insight of the person responsible for this choice is probably the most important aspect. Yet, there are other elements to consider when choosing a trade-mark.

First, the trade-mark should be evaluated to verify whether it is more descriptive, for example a name describing the wares or services being sold, or more distinctive, for example an invented word or a word having no meaning with regard to the wares or services. Purely descriptive marks are often not registrable; and even if a mark with an important descriptive character does become registered, it is likely to benefit from a limited scope of protection. On the other hand, a highly distinctive mark is usually more likely to be considered registrable and will also usually benefit from a much greater scope of protection.

Also, the choice of the trade-mark should be made so as to distinguish the owner's wares and services from those of his competitors. For this purpose, it is advisable to choose a mark that is different from those of the competitors.

Consequently, before filing a trade-mark application, it is usually recommended to accomplish a preliminary availability search that aims to assess the likelihood that the trade-mark will be available for use and registration; and the likelihood that the mark will be considered registrable in itself and distinctive.

Filing a trade-mark application

Assuming the search is favourable, the registration process itself may begin. This starts with the trade-mark agent preparing a trade-mark application that includes among other elements a list of wares and services that are associated to the mark, together with a date of first use of the mark, if any. The application may be filed even if the mark has not been used at the time of filing; however in such a case a declaration of use will usually be required at a later date by the Trade-Mark Office as a condition for grant of a registration. It is consequently important to diligently record the date of first use of a trade-mark in each country where it is being used.

The application for registration of the trade-mark is then filed. The date at which the application is filed will be recorded by the Trade-Mark Office. The date of first use of the mark, together with the filing date of the application, will be important in determining who has prior rights on a trade-mark if conflict arises.

About six to twelve months after filing, substantive examination is carried out by the Trade-Mark Office for the trade-mark application. Examination is the process during which a trade-mark application will be evaluated for compatibility with the requirements of the relevant trade-mark laws. Examination is generally an iterative process, whereby the Trade-Mark Office notifies the applicant of its objections, if any. The applicant must respond with

arguments and amendments to overcome the objections. The amendments and the arguments may then be accepted or objected to, triggering further responses, and so forth, until agreement with the Trade-Mark Office is reached and a registration is issued, or alternately disagreement persists and the trade-mark application becomes finally refused (in which case an appeal process is available). In many cases, one or two responses to Trade-Mark Office objections are sufficient for the examination procedure to reach a conclusion. In some cases, the application may be accepted as filed without raising objections at all.

Once the trade-mark application complies with the requirements of the Trade-Mark Office, the mark will in most countries be published to allow third parties to oppose the registration of the mark if they wish. If a third party opposes the registration of the mark, opposition proceedings may then arise. This is a rare occurrence but if it happens it will usually lead to negotiation between the parties. The opposition proceedings will result either in the acceptance or the refusal by the Trade-Mark Office to register the mark.

Obtaining a trade-mark registration

If no opposition occurs or if the opposition proceedings are successful, the application will be allowed, after which a trade-mark registration may be granted upon payment of a registration fee to the Trade-Mark Office.

A trade-mark may remain registered indefinitely for renewable periods, for example fifteen (15) year periods in Canada and ten (10) year periods in the United States and in Europe.

Please refer to our Notice entitled PRESERVING A TRADE-MARK REGISTRATION for important actions that help avoid mistakes that could accidentally lead to reduction of scope of protection or even cancellation of a trade-mark registration. If you do not have it already, this Notice will be provided to you on demand.

False payment requests

Many trade-mark registration applicants or registrants receive unsolicited payment requests directly from companies located in different countries in the world. They obtain coordinates of trade-mark applicants and registrants in publicly accessible data bases. These payment requests often have a somewhat official appearance and may look like invoices. The amounts requested usually vary between several hundred dollars to a few thousand dollars.

You should contact us to check the legitimacy of such payment requests. Generally, no payment should be made pursuant to these payment requests. To our knowledge, these companies try to acquire money from trade-mark owners in exchange for no service whatsoever, by pretending for example to be official governmental agencies. We remind you that by hiring LESPÉRANCE & MARTINEAU as your agents, all transactions that pertain to filing and prosecution of your trade-mark application, and maintenance of your trade-mark registration, will be handled by us on your behalf. Consequently all payments and actions should be accomplished through our firm.

LESPÉRANCE & MARTINEAU as your trade-mark agent

Our registered trade-mark agent is a trained professional who has years of experience handling trade-mark prosecution files. We strongly recommend contacting us as early as possible, preferably early in the trade-mark selection stage, to obtain proper professional advice towards obtaining the best protection for your trade-mark.

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