



## **PRESERVING A TRADE-MARK REGISTRATION**

A registered trade-mark is a valuable asset for a company. It provides the registration owner with very unique exclusive rights to prevent others from using a trade-mark that is confusing with the registered mark. However, a trade-mark registration owner may not benefit from the full leverage of his registration pursuant to inappropriate actions that he undertook or pursuant to the absence of certain actions that should have been undertaken. In certain circumstances, the trade-mark registration may even be expunged, irrevocably cancelling the owner's exclusive rights, against his will.

It is consequently important to follow certain guidelines concerning use, marking and enforcement of a trade-mark registration to favour continuous integrity of the trade-mark registration. These responsibilities of the registration owner are intimately linked to the exclusive rights that derive from the trade-mark registration.

Here is a check-list of examples of what a trade-mark registration owner should to do preserve his registration:

- Use it or lose it : a trade-mark that is not used for a prolonged period of time, usually at least three years or more, may result in its registration being expunged if challenged. In some countries, declarations of use need to be filed at determined time periods.
- Use it as registered : any deviation of the mark wording and/or appearance from the registered mark may result in the registration being expunged if challenged.
- Mark it properly : the trade-mark should be accompanied by the ® symbol.
- Stop unlicensed use : letting infringers use a confusing mark could result in the registration being expunged if it is challenged.
- License its use to others : use of the registered mark by other companies should be authorized through licensing agreements.
- Identify owner properly: any licensed used should be identified as such in ware or service identification, packaging, promotional or other trade-mark display.
- Avoid generic use : do not use or let others use your trade-mark to name the wares or services instead of the wares' or services' actual name.

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