

## Protecting Your Brand: A Primer on Canadian Trademarks

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Business owners will occasionally express a desire to protect their brand without much knowledge as to the purpose of a trademark or the intricacies involved in the trademark application process.

### **What is a Trademark?**

A trademark can take a variety of forms, including, without limitation, a word or combination of words, a design, a sound or even a smell. A word mark is a fairly common type of trademark, if not the most common, and so it will be the focus of this article. A trademark is meant to distinguish the goods and services of one person from the goods and services of another. A trademark is not a corporate name unless that corporate name is used to distinguish goods and services from those of another. By way of example, consider a situation in which a manufacturer of sparkling water is incorporated with the corporate name "Windsor Sparkling Water Inc.," but it manufactures and sells bottles of water under the name "H2OSpritz." Windsor Sparkling Water Inc. uses "H2OSpritz" to distinguish its bottled water from that of its competitors. In this case, the trademark is "H2OSpritz" since the corporate name, Windsor Sparkling Water Inc., is not used to distinguish its bottled water from that of others.

### **Is Registration Required?**

Having a registered trademark is not required to protect a brand, but depending on the circumstances, it may be recommended. A registered trademark will provide protection to the owner across Canada. An owner of an unregistered trademark can establish common law rights to the trademark, but those common law rights are more limited in the scope of protection afforded. It is also much more challenging to defend common law rights to an unregistered trademark than rights granted to a registered trademark under the *Trademarks Act*.

Continuing with the above example to appreciate the limits of the common law protection, if Windsor Sparkling Water Inc. only distributes H2OSpritz to local stores in Windsor, Ontario, and has no intention of branching out to the rest of Canada and another business decides to sell bottled water under the name "H2OSpritz" in Southwestern Ontario, then Windsor Sparkling Water Inc. may be able to stop this activity by relying on its common law rights to the trademark. If, however, the same competitor sold "H2OSpritz" in Vancouver, British Columbia, Windsor Sparkling Water Inc. will likely have no grounds to stop the competitor from doing so unless Windsor Sparkling Water Inc. has a registered trademark.

### **Is the Trademark Available?**

Before going through the time and expense of applying for a trademark, consideration should be given as to whether the trademark is even available. This process includes, among other due diligence, searching the Canadian Intellectual Property Office database for users of the same or similar trademarks. Even if the spelling or visual appearance of the word marks are different, a trademark could be confusingly similar to another trademark if the words are phonetically the same (for example, "H two O Spritz"). A trademark agent can help assess and provide an opinion as to whether a particular trademark is available.

### **What Goods and/or Services are used with the trademark?**

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The goods and services used in association with a trademark are a critical component of a trademark application and brand protection. Every trademark application in Canada must set out a description of the goods and services that are used or will be used in association with the trademark, and that description will be scrutinized by the Canadian Intellectual Property Office at the time of examination of the application to ensure that the description is, for example, sufficiently specific. Fortunately for applicants and their agents, the Canadian Intellectual Property Office publishes a Goods and Services Manual that provides acceptable descriptions of goods and services. A trademark agent can assist in crafting a description that will face less scrutiny by an examiner.

It is important to keep in mind that there can be two owners of the same trademark, so long as the trademarks are used in distinctly different industries or the goods and services are sufficiently different so as not to cause confusion. Continuing with the above example, if a lawn care company developed a water sprinkler under the name "H2OSpritz" and wanted to trademark that name, it could argue that its use of "H2OSpritz" in the context of lawn care is sufficiently different from Windsor Sparking Water Inc.'s use of H2OSpritz for bottled water for consumption.

Brand protection through trademarking is not simple or straightforward but the benefits of a registered trademark can be significant. A registered trademark agent can help guide an owner through the process. If you have questions about protecting your brand through the registration of a trademark, please contact your Miller Canfield attorney or one of the authors of this alert.