TRADEMARKS — WHAT’S NEW?

What is a trade-mark? A very basic definition of a trade-mark is a word, design or logo that is used by a person for the purpose of distinguishing their goods and/or services from those of others. Some more famous trade-marks are “Coke”, “Sony” and Nike’s “Just do it”.

Regular trade-marks under the Trade-marks Act protect only those goods and/or services specified by the trade-mark owner and must be renewed every fifteen years. The University of Guelph owns a number of regular trade-marks.

Also under the Trade-marks Act, certain sectors (e.g. the Crown, various levels of government, and universities), are eligible to own a different type of mark known as an “official mark”. Official marks are not limited to owner-specified goods and/or services and are not time-limited (i.e. there is no need to renew official marks). University of Guelph holds a number of official marks (including such well-known ones such as “University of Guelph” and “Changing Lives, Improving Life”).

In June 2014, amendments to the Trade-marks Act received Royal Assent as part of omnibus legislation – but the amendments have not yet come into force. The Government’s purpose for making the amendments is to bring the Canadian trade-mark regime into compliance with a number of international treaties. It is expected that the amendments will come into force sometime in 2015 once supporting regulations have been finalized. Pursuant to these amendments, a number of important changes to the Trade-marks Act will occur including the following (all of these changes relate to regular trade-marks, not official marks):

Now: in the course of applying for a regular trade-mark, the applicant must specify the date of first public use of the trade-mark.
Amended: an applicant for a regular trade-mark need not supply information concerning the use of the proposed trademark.
Now: fees charged per application.
Amended: goods and services to which regular trade-marks relate will be classified into categories and, since fees will be charged according to number of categories to which an application relates, it is expected that, generally, fees will increase.
Now: a regular trade-mark cannot be fully registered unless the owner has used it in relation to the goods or services to which the trade-mark relates.
Amended: it will be possible to apply for a regular trade-mark without ever having used it. (After three years from date of registration, anyone may request a registrant to prove use in Canada in the last three years.) Several concerns have arisen regarding this amendment, including:

a) some commentators think that this may lead to trade-mark “trolls” taking advantage of the new system by registering marks for the purpose of selling them or preventing others from using those marks;
b) potential applicants for regular trade-marks or official marks will not be able to assume that the Government’s trade-mark register provides any information regarding the use of a specific trade-mark, which may undermine the legitimacy of that trade-mark.
This may result in potential applicants having to expend greater effort to investigate the legitimacy of trade-marks which appear on the Government’s register; and c) it is anticipated that the lack of information regarding use of trade-marks in the early stages may result in more oppositions or challenges to trade-marks.

Interestingly, while official marks were not the subject of changes under the Government’s omnibus legislation, a Private Member’s Bill is being considered by Parliament which addresses only official marks. Given that Private Member’s Bills rarely pass into law in Canada, it is widely believed that the official mark system will not change in the immediate future.

The TAKEAWAY: If a department or unit is considering investing time and resources in relation to a specific word, design or logo, please consult with our Office regarding the type, content and timing of an applications under the Trade-marks Act, earlier rather than later.

For further information or assistance regarding regular trade-marks and official marks, please contact the Office of Legal Counsel at extension 53082.