

Goodmans^{LLP} Update

Police Your Trademarks to Protect Your Brand

Trademarks can be integral to the identity and growth of your business. However, simply creating distinctive and recognizable trademarks is not enough. To maintain the strength of your trademarks, steps must be taken to protect those trademarks against the actions of others that could diminish both their value and their effectiveness in an overall brand strategy.

An important initial action in protecting any trademark is registering your trademark with the Canadian Intellectual Property Office. Registration of a trademark affords the owner the exclusive right to use the trademark throughout Canada in respect of the goods or services with which it is associated.

However, registration is only a first step toward securing your mark. Another critical step is ensuring that your trademark remains distinctive. Distinctiveness refers to the uniqueness of your trademark and its ability to distinguish your goods and services from those of others.

The distinctiveness of a trademark, even one that is registered, can be eroded if others make use of the same or similar trademarks in respect of the same, or related, goods or services. The more saturated the marketplace becomes, the less distinctive your trademark will be. In the extreme case where your trademark is used heavily by third parties, the trademark may become “generic” as a result of its success, exemplified best by references to “Kleenex” and “Xerox” to refer to products not made by the original trademark holders. Accordingly, it is important to “police” your trademark and actively monitor trademarks used by others to ensure that your rights are not diminished.

Policing your trademark and actively pursuing those who encroach upon its distinctiveness mitigates the risk of its dilution. Additionally, the risk of adverse proceedings aimed at diminishing your exclusive rights is also increased where your trademark lacks distinctiveness. Parties may initiate proceedings to expunge or revoke your trademark registration, or oppose your application to register a trademark. One of the factors a court will consider in assessing a claim for trademark infringement or expungement is the distinctiveness of the trademark.

Finally, policing your trademarks will help avoid situations where potential customers may confuse another trademark with yours. For example, they may purchase products believing them to be that of your company, or engage with other companies in ways that depreciate your brand’s goodwill. If a company uses a similar trademark in an inappropriate manner, for example, by selling lesser quality goods or promoting causes or ideas incompatible with your consumers’ preferences, your market reputation can suffer. A vigilant eye and appropriate legal action can help to quell such activity.

If you are interested in learning more about policing your trademarks, please contact any member of our [Intellectual Property Group](#).

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