

Filing Trade-mark Applications In Canada

Quick Reference Guide

Goodmans^{LLP}

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Requirements To File Canadian Trade-mark Applications

- To proceed with preparing and filing a new trade-mark application, the following information is required:
 1. Applicant's legal name
 - ~ *Applicant may be a corporation, an individual, a partnership, a joint venture, a trade union or a lawful association.*
 2. Applicant's address
 3. Identification of the mark
 4. Identification of wares and/or services to be applied for
 - ~ *Canada does not maintain a numbered classification system for wares and services.*
 - ~ *Application may include an unlimited list of wares and/or services in a single application. The government filing fee is not subject to increase depending on the number of wares and services covered.*
 - ~ *Application may cover both wares and services.*
 5. Ground(s) of application (one or more of the following may be relied upon)
 - ~ *Proposed use (by applicant and/or licensee)*
 - ~ *Use in Canada*
 - Need date of first use in Canada
 - Identify if use by applicant and/or predecessor(s)-in-title, which must be named.
 - ~ *Use and pending application or registration abroad*
 - Mark must be in use abroad and country where use has taken place must be identified in application
 - Particulars of foreign application or registration required: photocopy thereof is helpful but a certified copy is not required at time of filing.
 - A certified copy of the foreign registration and, if in language other than English or French, an English or French translation thereof, must be submitted prior to advertisement.
- Claiming Convention priority (if applicable)
 - ~ *Need particulars of foreign application*
 - ~ *Application to be relied on must meet the following criteria:*
 - must have been filed within past six months;
 - must be the first filing in a member country of the Union; and
 - the applicant or its predecessor in title, at the date of filing of the foreign application, must have been a citizen of, a national of, domiciled in or had a real and effective establishment in the country of the Union where the first foreign application was filed.
 - ~ *No separate documentation, such as a certified copy of the foreign application or resulting registration, is required to support or perfect a claim for Convention priority, at the time of filing the application or thereafter.*
- We can sign the application on applicant's behalf.
- No Power of Attorney or Appointment of Agent is required.
- No specimens are required unless requested by Examiner.
- It is currently taking approximately six to eight months from filing for the Canadian Intellectual Property Office to issue the first Examiner's report or to approve an application for advertisement.
- On average, it takes 15 to 18 months from filing to registration, assuming no substantive objections or oppositions.

Goodmans LLP

Goodmans LLP is recognized internationally as one of Canada's premier law firms. Lexpert magazine calls the firm a "corporate powerhouse", and the National Post newspaper says Goodmans is "a testament to smarts over size".

Goodmans is ranked among the top business law firms because our lawyers and clients are industry leaders. Our lawyers excel in their fields to help clients excel in theirs – ensuring ever-higher levels of service and business success. Further, we offer a unique combination of skills – spanning business law and litigation, public and private, tradition and innovation.

With a strategic entrepreneurial history and deal-making mindset, Goodmans professionals deliver intelligent solutions, responsiveness, energy, talent, and determination to get the deal done. It's more than just legal services; it's strategic business advice.

Clients appreciate our dedication to exceptional service, community partnership and mutual respect. That's why so many clients have been with us since their businesses began – for over 30 years in some cases. Even now, with clients among Canada's largest corporations, financial institutions and multinationals, Goodmans honours its roots – in client service and in community service.

Intellectual Property Law At Goodmans

Intellectual property rights can be the key assets of a company. The services provided by Goodmans' Intellectual Property ("IP") Group are a critical element in the protection of these assets and the business strategy of many of our clients.

Our IP Group's wide-ranging services include providing strategic and general advice regarding the development, acquisition, sale and protection of IP and technology assets including patents, trade-marks, trade dress, copyright, industrial

designs, rights of personality confidential information and trade secrets. We provide validity and infringement opinions on all IP assets, including patents, trade-marks, copyright and industrial design.

We offer tremendous experience and knowledge in the area of trade-marks, bringing to the practice both the substantive legal knowledge and practical considerations necessary to effectively protect these valuable assets. We deal with all matters relating to trade-marks including clearing marks for use and registration in Canada, filing and prosecuting trade-mark applications and maintaining the resulting registrations. We are routinely involved in opposition and summary expungement proceedings before the Canadian Intellectual Property Office. We assist our clients in developing and managing trade-mark portfolios and instituting appropriate usage policies, establishing effective strategies for the protection and enforcement of their trade-marks and exploiting their rights through licensing and other forms of agreements.

Given Goodmans' excellence as a business firm, we are regularly engaged in transactional work involving IP including conducting due diligence, transferring assets, taking security interests and conducting intellectual property audits. We negotiate and draft licences and other forms of agreements dealing with the commercialization of all forms of IP. When disputes arise, our IP litigators, who are known nationally for their expertise, provide effective counselling and litigation services.

Discover what our clients already know – that good people really are good for business.

For further information, please contact:

Amalia Berg aberg@goodmans.ca 416.597.4296	Ronnie Hoffer rhoffer@goodmans.ca 416.597.4137
Richard Naiberg rnaiberg@goodmans.ca 416.597.4247	John Alton jalton@goodmans.ca 416.597.4101

Goodmans^{LLP}

Bay Adelaide Centre, 333 Bay Street, Suite 3400, Toronto, Ontario M5H 2S7 goodmans.ca