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Trademarks between Friends.

Key Differences in Canadian and U.S.
Trademark Practice.

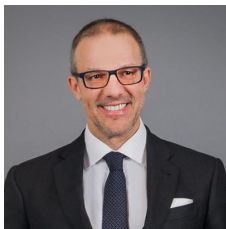
Speakers: Christian Bolduc, Graham Hood

May 19, 2022

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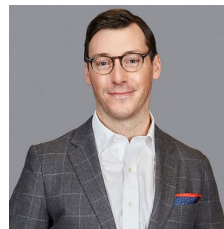
Our Speakers



Christian Bolduc

Partner,
Barrister & Solicitor
Trademark Agent

- **Leading Lawyer in IP**
(Chambers & Partners: Canada 2021 - 2022)
- **Expert-Ranked – Intellectual Property**
(Canadian Legal Lexpert Directory: 2005 - 2021)
- **Expert Guides: Trade Mark**
(Euromoney LMG: 2012 - 2020)



Graham Hood

Partner,
Barrister & Solicitor
Trademark Agent

- **Future Star**
(Benchmark Litigation: 2022)
- **Rising Star in Trademarks**
(Expert Guides: Rising Stars 2019 - 2021)
- **Ranked for Anti-Counterfeiting, Enforcement & Litigation**
(World Trademark Review 1000 – The World's Leading Trademark Professionals: 2022)

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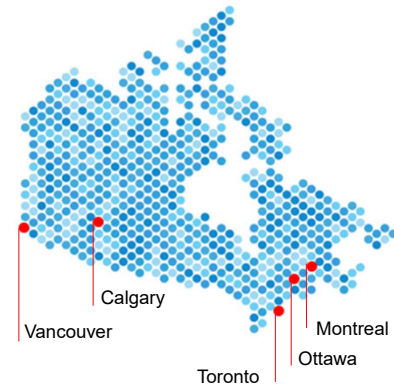
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Who We Are

Canada's **leading IP law firm**
with expertise at the interface of
technology and **business** law

- Expertise in all areas of IP
- 130+ years serving clients
- 100+ lawyers, agents and technical consultants
- 8,000+ patents & trademarks filed annually
- Litigation bench strength and record of success



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Outline

Trademark registrations

Trademark application process

Opposition proceedings

Maintenance

Expungement for failure to use

Official marks

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Trademark registrations.

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Rights granted by trademark registrations

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Canada

- **One national register**
 - Available to all applicants
- **No provincial trademark registers**

U.S.

- **Two national registers**
 - Available to all applicants involved in interstate commerce
 - Principal Register
 - Supplemental Register
- **State registers**

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Rights granted by trademark registrations

Canada

- Rights extend to entire country, unless expressly limited geographically
 - Proof of acquired distinctiveness
- **Negative rights:** can enforce against all infringers, unless registration invalidated
 - No use required in the first 3 years (**subject to change**)

U.S.

- Rights extend to entire country, except where prior rights exist
- **Negative rights:** can enforce against all infringers, except those with prior rights
 - Use required

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Rights granted by trademark registrations

Canada

Positive rights

- Title in the mark itself
- Right to use
- Defense against 3rd parties' rights and claims
 - TM infringement
 - Passing off

U.S.

Positive rights

- Title in the mark itself
- Presumption of right to use
- Defense against 3rd parties' rights and claims
 - Except where prior rights exist

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Rights granted by trademark registrations

Canada 

Incontestability

- Automatic, 5 years from registration
 - Expungement on the ground of prior use or making known available only if applicant can demonstrate registrant's knowledge of applicant's prior use

U.S. 

Incontestability

- Requires proof of continuous use for 5 years without a validity challenge
 - No longer susceptible to expungement on the basis of lack of distinctiveness
- Deemed valid, rightful ownership

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Trademark application process.

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Prosecution

Canada

Application

- **No** filing bases
- Use or intent to use required*
- Classification: Based on WIPO
- Specificity: “ordinary commercial terms”
- Can extend an existing registration

U.S.

Application

- Filing bases
- Use or intent to use required
- Classification may differ from WIPO
- Specificity: Yes, but less stringent

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Prosecution

Canada

Examination

- 3+ year delay, except for
 - Goods and services from the *Goods and Services Manual* (< 2-year delay)
 - Madrid filings
 - Expedited examination
- Absolute and relative grounds
 - Proof of acquired distinctiveness (at filing date)

U.S.

Examination

- 8-12 months
- Absolute and relative grounds
 - Proof of acquired distinctiveness (when filed)
 - 5 years as *prima facie* evidence of acquired distinctiveness
 - Supplemental Register

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Prosecution

Canada

Examination

- Extension of time available only when substantive objections raised
- Suspension not readily available
- Consent agreements
 - Limited weight
 - Useful in certain cases
 - Content
- Disclaimers not required, recognized

U.S.

Examination

- Extension of time not available
- Suspension available when
 - Cited application pending
 - Foreign registration pending
- Consent agreements have weight
- Disclaimers may be required

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Prosecution

Canada

- No declaration of use
- No registration fee
- No specimens of use

U.S.

- Statements of use, if application based on ITU
- No registration fee
- Specimens of use

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Opposition proceedings.

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Opposition proceedings

Canada 

Process

- Statement of Opposition
 - Frames the entire proceeding
- Requests for interlocutory ruling*
- Counter Statement
- Evidence*
 - Affidavits & Cross-examinations
 - Reply evidence
- Written arguments*
- Oral hearings*

U.S. 

Process

- Akin to litigation, in process (and costs)

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Opposition proceedings

Canada

- **Withdrawal:** impact (without prejudice)
- **Timeframe:** 5-6 years
- **Costs:** \$50-\$100K CAD

U.S.

- **Withdrawal:** impact (with prejudice)
- **Timeframe:** shorter
- **Costs:** (much) more expensive

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Maintenance.

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Maintenance

Canada

- **No maintenance required within 1st 10 years**
- **Renewal:** No proof of use required
- No statements/specimens of use required
- In certain cases, Nice classification will also be required around the time of renewal

U.S.

- **Maintenance required between 5th and 6th year**
- **Renewal:** proof of use required
- Statements/specimens of use required

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Expungement for failure to use.

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Expungement for failure to use

Canada

Section 45 proceedings

- Request for evidence of use
 - Anyone may commence a proceeding
 - May narrow the request to certain goods/services
- Notice to registrant
- Evidence of use (no XX)
 - Failure to file leads to cancellation
- Written arguments*
- Oral hearing*

Typically *inter partes*

U.S.

Several options

- Expungement (regular course)
 - Akin to litigation
- *Ex parte* expungement (new)
 - Never used in commerce
 - Initial evidentiary burden on the petitioner
- *Ex parte* re-examination (new)
 - Not in use at material date (app/specimens)
 - Initial evidentiary burden on the petitioner

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Expungement for failure to use

Canada

- **Who:** Anyone (even the Registrar)
- **Outcome:**
 - Maintain/narrow registration
 - Expunge registration
- **Timeframe:** 1-5 years
- **Costs:** \$1K-\$60K CAD
- **Additional evidence may be filed on appeal (still no XX)**

U.S.

- **Who:** An interested party
- **Outcome:**
 - Maintain/narrow registration
 - Expunge registration
- **Timeframe:** shorter
- **Costs:** more expensive (regular course)

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Official marks: Particularly Canadian

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Official marks


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Canada 

- **What:** prohibition to apply, use and register
- **Who:**
 - Her Majesty's Forces
 - a "public authority"; or
 - a university (anywhere in the world)
- **Process and maintenance**

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Questions?

Thank You.

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