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From: Office of General Counsel

Re: Trade-marks/Official Marks

This Memo sets out some basic information for individuals at the University who wish to use a name or mark in association with a service or activity being performed by the University. In such a case, it is important to ensure that the University has the right to use the name, and in some circumstances the University will likely want to ensure that it has some ability to prevent others from using the same name. Please note that this information applies to using a name or mark within Canada. If you may wish to use a name or mark outside of Canada, please contact Trademarks & Licensing within the Marketing and Communications Office to talk about that further.

Definitions

A trade-mark is a word, symbol, or design, or combination of these, used to distinguish the wares or services of one person or organization from those of others in the marketplace. The Trade-Marks Act sets out rights in relation to unregistered trade-marks and registered trade-marks. There are two types of registered marks – there are “ordinary” trade-marks, and there are “Official Marks”. The differences between these two will be discussed further below.

You may have also heard about trade names. A trade name is the name under which you conduct a business. In your circumstances, you would be seeking trade-mark protection, and a trade name is not the best way to accomplish that.

In this memo, the word “mark” is used generally to describe the word, symbol, or design for which the University is seeking protection.

Protecting the University from Claims That It Is Infringing Another Person’s Trade-mark

One acquires rights to a mark through the use of a mark, regardless of whether the mark has been registered in any particular registry. Registering a mark as a trade-mark or official mark gives a person certain advantages, including more extensive rights to the mark. It is not, however, required in order to have rights to a mark.

Therefore it is generally very important to do searches when deciding whether or not to use a mark to ensure a third party is not already using the mark (or a confusingly similar one).

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If someone uses or has registered a mark as a trade-mark, then the University may or may not have the right to use the same mark, depending on whether the University's use of the mark would be confusingly similar to the other person's trade-mark. If an ordinary person saw the other person's trade-mark and then saw the University using the mark in association with goods and services provided by the University, would that person be confused about whether those goods and services provided by the University were provided by the other person who uses the trade-mark? A court would look at how similar the goods and services of the University are to the goods and services provided by the other person in association with their trade-mark, and other factors.

Owners of official marks (as the University would be if it were to register the mark as an official mark) have been given more latitude by the courts. Based on some case law, a public authority can adopt as an official mark a mark that is being used by a third party and provided such adoption is not otherwise prohibited under the Act. Some courts have even allowed public authorities to adopt confusingly similar marks of another public authority. Before the University knowingly did this, it would be wise to check the current state of the law on this issue.

It is also wise to check who may be using a mark before the University starts using it for other reasons. A disreputable third party may already be using the mark and the University may wish to avoid using the same mark for that reason. As well, an entity with whom the University has close relations (e.g. another University) may already be using the mark, and the University would not wish to disrupt those relations by adopting the same mark.

Preventing Others from Using the University's Marks

Use by third parties of the same or a confusingly similar mark may impact the strength, value and reputation (goodwill) of the University's mark. If there is any potential that the University's products and/or services could be confused with those of a third party, the University would want to have the ability to prevent such third party from using the mark.

As mentioned above, the University obtains some trade-mark protection as soon as it starts using a mark. It can obtain additional protection by registering the mark. It is only entitled to register a mark after it has started using the mark. The main advantages of registration are:

Registration grants to the registrant the exclusive right to use the trade-mark, throughout Canada, subject to certain exceptions, including prior use by another person;

Registration gives notice to the public of the registrant's claim to rights in a trade-mark and substantially reduces the risk of other businesses adopting a similar mark and claiming that they were not aware of the existing mark;

The registrant receives protection across Canada, notwithstanding that the registrant may only be using the trade-mark in one part of the country (unless the Registrar of Trade-marks specifically limits the registration to that area); and

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The registrant is not required to commence an action for passing off (a difficult litigation process) to protect its exclusive usage rights, but rather obtains more expedient statutory rights and remedies to restrain other parties from using the same or a confusingly similar trade-mark.

There are some additional advantages if the University registers its mark as an official mark rather than an ordinary trade-mark, including:

Ordinary trade-mark registrations are limited to the goods and services in association with which the trade-mark owner has already used the trade-mark. Official marks have no such limitation.

Ordinary trade-marks must be renewed every 15 years, while official marks last indefinitely.

Official marks are easier and quicker to obtain.

If an owner of an ordinary trade-mark cannot prove that it has continuously used the trade-mark over time, then there is a procedure in the Trade-marks Act pursuant to which an owner can lose its rights to the trade-mark; there is no comparable procedure in the Trade-marks Act that would result in an owner losing its rights to an official mark.

Official marks also have the advantage described in paragraph B.

Therefore, official marks are generally more advantageous than regular trade-marks. However, there can be certain circumstances in which a regular trade-mark may be more advantageous than an official mark, e.g. if the University may wish to transfer the registered mark to another entity some day, if the University may wish to obtain a trade-mark registration outside of Canada, if the mark will be used by a licensee rather than by the University itself, or if there are unusually urgent timing considerations with respect to establishing rights to a mark.

Next Steps

As noted above, when you wish to use a mark, it is wise to first conduct searches of other registered and unregistered trade-marks, trade-mark applications, trade names and corporate names. In coordination with the Marketing and Communications Office, we can obtain for you a federal computer-based trade-mark search from a search registry agent to canvas the availability of the mark in Canada. We would ask your unit to cover the costs of obtaining this search. We can also conduct an internal search of the Canadian Trade-marks Office database.

Your office and/or the Marketing and Communications Office should conduct an Internet search and search relevant trade journals and any other sources you can think of to see who else may be using the mark you wish to use, or a confusingly similar mark.

If you wish to proceed with these searches, let us know.

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Once the searches are complete, if you wish to make an application for a trade-mark or official mark, please let us know. Please also let us know when you first started using the mark, and how you started using the mark.

Please note that you must start using the mark before the University can apply for the official mark, and there must be an element of public display in that use, for example, by advertising the mark on a website, in association with services provided by the University.

Please also maintain a record of one of your uses of the mark prior to the application for the official mark – if the University’s registration of the official mark is challenged at some point in the future, the University would have to prove this use prior to registration in order to convince the Registrar and Courts to uphold the registration.

The registration costs for an official mark are \$500 per mark, plus disbursements that are normally not more than another \$500, and, again, your unit would be responsible for covering these costs.

The application process has usually been taking approximately 6-10 months for an official mark. For an ordinary trade-mark, it has been taking approximately 2 years.

Please contact Trademarks & Licensing Office within the Marketing and Communications Office at 780-492-5044 or via email at visualid@ualberta.ca if you have further questions about this.

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