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Intellectual Property Law for Non-IP Lawyers

Edmonton, Alberta

Calgary, Alberta

Chair

Rob McDonald QC

Bennett Jones LLP

Edmonton, Alberta

Faculty

Gordon Sustrik QC

Gordon D. Sustrik Professional Corporation

Sherwood Park, Alberta

Patrick Smith

Gowling WLG (Canada) LLP

Calgary, Alberta

Christine Hicks

Hicks Intellectual Property Law

Canmore, Alberta

Edward (Ted) Yoo

Bennett Jones LLP

Edmonton, Alberta

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ISBN-10: 1-55093-709-X
ISBN-13: 978-1-55093-709-1

What's in a Name? Trademarks and How They Affect Brand Strategy

Intellectual Property Law for Non-IP Lawyers

Prepared by:

Rob McDonald QC
Bennett Jones LLP
Edmonton, Alberta



Legal Education
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For presentation in:

Edmonton, Alberta – February 5, 2019
Calgary, Alberta – February 12, 2019

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Every business is concerned about its name and reputation, and trademark law is an important tool for protecting and enforcing corporate brands. This paper will discuss how your clients can preserve their intangible assets, commercially exploit these valuable intellectual property rights, and avoid falling prey to the increasing number of squatters, trolls and pirates. A major change to Canada's trademark law is taking effect in 2019 and this paper will review this law, discuss the risks, and provide suggestions for how to best protect brands locally, nationally and globally. In addition, the law surrounding ownership of intellectual property rights will be explained, including a discussion on the complexity of determining ownership rights at the outset of a commercial relationship and how disputes can be avoided. The goal of this paper is to provide practical information and guidance to a lawyer whose area of expertise may not include intellectual property law but whose practice may touch upon these issues from time to time.

TRADEMARKS 101 – THE BASICS

Before discussing some of the more complex areas of trademark law and brand protection, it is important to understand the basics of trademark law.

Definition of Trademark

A trademark is essentially any mark (which can be a word, several words, a logo, a slogan, or even a sound or colour) that is used by a person to distinguish his or her goods and services from those of a competitor. Although there are different types of trademarks, this paper will focus on the type of trademark typically referred to as a “brand”, which identifies the source of a particular product or service. For example, Nike is a well-known brand name and trademark in relation to shoes and athletic apparel.

Unregistered vs Registered Marks

Canadian law provides protection for both unregistered (or common law) trademarks, as well as trademarks registered in accordance with the Federal *Trademarks Act*. Therefore, it is not necessary to have a registration in order to own and enforce trademark rights, however, a registration does provide a much broader scope of protection and enforcement. The major difference between unregistered common law trademarks and registered trademarks relates to the scope of protection afforded to the mark. Unregistered marks gain common law protection as soon as they are used in commerce, but this protection is limited to the geographical territory in which the mark has been used and has developed a reputation. For example, an Edmonton bike repair shop may be able to prevent a competitor from using a confusingly similar trademark elsewhere in Edmonton, but likely not in Calgary, and certainly not in Ontario (unless the reputation of that mark extends to those