

TRADEMARK REGISTRATION (Procedure)

Registering a trademark involves a long and complex process that must be followed to the letter. As such, we recommend that you consult a lawyer to avoid making inadvertent mistakes that will delay registration of your trademark.

A trademark is registered by filing an application with the Office of the Registrar of Trademarks (“**Registrar**”) of the Canadian Intellectual Property Office (“**CIPO**”). The application is then examined to ensure that it complies with all statutory requirements under the *Trade-marks Act*, RSC 1985 c T-13. It should be noted that before it can be registered, the trademark must have been used in Canada prior to registration or at least upon filing the application for registration for proposed use in Canada.

The sections below describe the steps to follow to register a trademark in Canada:

1.00 PRELIMINARY SEARCH OF EXISTING TRADEMARKS;

Prior to filing an application to register a trademark, it is strongly recommended that the applicant (or their agent) conduct a preliminary search of existing trademarks to see whether there are already any registered trademarks that are similar or identical to the proposed name. If this step is omitted the application may be rejected.

This preliminary search may be made in the CIPO database which can be accessed from its website at <http://www.ic.gc.ca/app/opic-cipo/trdmrks/srch/home?lang=eng>. Type the key words of the proposed name in the search box (use both standardized and phonetic spellings) to test whether the proposed trademark could be confused with another existing trademark.

2.00 PRELIMINARY SEARCH OF SIMILAR TRADE NAMES

If the results of the preliminary search of existing trademarks show that there are no identical or similar trademarks, the applicant must also conduct a preliminary search of trade names, because trade names are often used as unregistered trademarks.

Unfortunately, trade names are recorded differently in each province and there is no centralized database for trade names in Canada. However, NUANS is a computerized search tool that is able to search trade names and corporate names in Alberta, Ontario, New Brunswick, Nova Scotia and Prince Edward Island as well as the federal database. For the other provinces, separate searches must be requested through the appropriate provincial registries.

To ensure that the search is sufficiently thorough, it may be best to retain the services of a registered trademark agent.