

# TOP THINGS YOU CAN DO TO ANNOY YOUR TRADE-MARKS LAWYER

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Trade-marks lawyers are for the most part a reasonable lot. We like our work and get satisfaction from a job well done. But there are a few things that make our blood boil and while I am not saying that the result is anything like the Incredible Hulk® transformation, you may not want to witness it. Therefore, I have put together a few tips to help you avoid such a scenario by listing the things that we find the most aggravating.

## 1. Picking a trade-mark that describes your product or service

We want to do our best to help you but we cannot register something that clearly describes your products or services. Please, if you are offering a cupcake product do not try and call it GREAT CUPCAKES. A trade-mark has to be somewhat distinctive to be registrable and you are not supposed to try and monopolize words that competitors might need to use to describe their products or services. So be creative and make up a word (which is the strongest kind of trademark), or use something arbitrary like the word BLACKBERRY is when used for mobile phones. This will result in a stronger mark that is easier to protect and enforce.

## 2. Using variations of your registered mark

A registered trade-mark is a valuable asset and no doubt your trade-marks lawyer worked hard to make that happen. So make sure you protect that asset by using it in the form in which it was registered. Using variations of the mark, especially when it was registered in design form, can be dangerous because if someone attacks your mark and you have to demonstrate use, a court might find that you are not using your registered mark. This could lead to the registration being expunged (struck from the trade-marks register)! So use the mark in the way that it was registered, and throw in an ® after the mark to accentuate this and everyone will be happy. If you do want to alter the mark in some way, then give your trade-marks lawyer a quick call and check with them as to whether this difference is significant enough to jeopardize your registration. We are here to help.

## 3. Allowing third parties to use your mark without a proper license

Another sure fire way to put your trade-mark registration at risk and frustrate your trade-marks lawyer is to allow third parties to reproduce your mark on their own material without a license. Once a mark no longer

distinguishes your wares and services from those of others (because it is being used indiscriminately by others), then it has ceased to function as a trade-mark and can be expunged from the register. So you need to make sure that only authorized people use your mark, and any use they make of it should be subject to strict rules governing things such as how it should look, what it can be used on, any special markings that should accompany it, where it can be used, for how long, and your right to pull the license if they breach any of these terms. If you follow these rules then their use is attributed to you and your mark does not lose its distinctiveness. But if you let others use your mark without these parameters in place, then you could lose your registration.

#### **4. Using your trade-mark as the name of your product or service**

There is a big difference between using your mark to distinguish your products and services (please buy our JELL-O brand dessert) and using it as the name of your product or service (please buy our JELL-O). ESCALATOR used to be a trade-mark before it became known as the name of the product. So do not use your trade-mark without following it with the common name of the product or service. Trade-marks lawyers cannot be with you every moment, so we need to be able to trust you to use the mark which we have worked so hard to register in the proper manner. If you could also use different script for the mark, or bold it, and use a <sup>TM</sup> or ® next to it, we would be ecstatic.

#### **5. Keeping quiet when you see others infringing your mark**

If you have registered your mark, that gives you the exclusive right to use that mark across Canada in association with your products and services. That is a powerful tool, but if you do not enforce it then your rights diminish and eventually might disappear altogether. Remember that a mark has to be able to distinguish your products and services from those of others in order to function as a trade-mark. So if you allow third parties to infringe your rights without stopping them, then eventually people will no longer associate your mark with just you and that is the death knell for a trade-mark. When you notice third parties using your mark or even one very similar, in a manner that you think might confuse the public, then call your trade-marks lawyer! You have to take action and you have to do it in a timely manner or you may lose your right to take any action at all.

We are all on the same side; we all want strong, healthy trade-marks being used throughout Canada, so let's work together to make sure that happens. Follow these simple guidelines, and you will keep your trade-marks lawyer happy, and hopefully your life will be a little better too.

by Sharon E. Groom

#### **A Cautionary Note**

The foregoing provides only an overview and does not constitute legal advice. Readers are cautioned against



making any decisions based on this material alone. Rather, specific legal advice should be obtained.

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