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THE BENEFITS OF REGISTERING A TRADEMARK

By: RBS' Trademark Agents

Richards Buell Sutton has a group of Registered Trademark Agents with extensive experience in the registration of trademarks in Canada, in the United States and around the world. We assist companies, advertising agencies, individuals and foreign law firms by providing advice at the conceptual stage of trademark development, by conducting availability searches and strategically filing trademark applications, by managing national and international trademark portfolios, by prosecuting opposition and cancellation proceedings and by assisting with the enforcement of trademark rights.

There are many benefits in seeking registration of a trademark, some of which are:

- Registration provides a trademark owner with the exclusive right to use the mark throughout Canada. Without registration, a trademark owner relies solely on common law rights which generally are restricted to the territory or province where the mark has been used. For example, if a trademark owner learns that a third party recently adopted the same or similar trademark in another area of Canada, and the trademark owner did not register its mark, it very well may be impossible to have that third party cease use of the mark.
- Registration provides a trademark owner with the freedom to advertise in and/or expand its business into other provinces in the future. For example, registration avoids a trademark owner from later being disintitiled to use its mark or circulate advertisements displaying the mark in another province if a competitor has since adopted the same or similar mark.
- If a business displays its corporate name or trade name on products or promotional materials as a trademark, the business name can be registered as a trademark in Canada. For example, the incorporation of a company and the registration of a sole proprietorship or partnership provides little protection of a trade name. To obtain the exclusive right to the name throughout Canada, and to prevent others from using a similar corporate or business name, it should be registered as a trademark.
- The Trademarks Office will act as a guardian to the trademark and will refuse any application for a confusing mark filed by a third party.
- Registration will discourage potential infringers from using the same or similar trademark.
- After a trademark has been registered for five years, and used continuously by the trademark owner





in that period of time, it becomes “incontestable” which limits the grounds a third party may use to attack the registration. For example, a third party could not seek to have the registration cancelled based on prior use of the same or similar mark in Canada.

- A trademark is considered an asset. Registration will increase the value of a company/business, will assist in securing investors/financing and can be used as security in financial transactions.
- A Certificate of Registration can be deposited with Canada and US customs in order to prevent the importation/exportation of goods bearing an infringing trademark.
- A registered trademark facilitates online brand management. For example, a registered trademark can be enrolled at the Amazon Brand Registry to proactively take action against infringers and other unauthorized users.
- A trademark registration greatly assists in the enforcement of fraudulently used domain names.
- Registration of a mark in Canada can be used as a basis to obtain registration for the same mark in foreign countries.
- Registration provides the ability to initiate legal action in the Federal Court in which decisions are enforceable throughout Canada.

If you have questions about what you’ve read, or have a Trademark-related question you’d like support with, contact Trisha Dore at tdore@rbs.ca, or Karin Binder at kbinder@rbs.ca.

