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TRADEMARK CONSIDERATIONS

By: RBS' Trademark Agents

I incorporated my company or registered my business name in British Columbia so I'm protected... right? Wrong!

Unfortunately, the incorporation of a company or the registration of a business name provides little protection of that name in Canada. Even if a provincial or federal corporate authority accepts your name, there could be a competitor operating a business under a similar name in the same industry. Also, another company could have applied for or registered the name with the Federal Trademarks Office. If another person has already incorporated a company, registered a business name or applied for a trademark using similar words, you very well may be open to liability.

It is important for you to ensure that there are no similar existing corporate names, trade names or trademarks in Canada. If a person incorporates a company or registers a business name, and does not conduct preliminary searches, they could face legal action by another company who has pre-existing rights.

Imagine this scenario: You incorporate a company in British Columbia for the purposes of producing a line of food products. After a year of blood, sweat and tears in securing investors/financing, conducting market research, creating distinctive packaging and commencing production of your products, you are now generating an appreciable amount of revenue and have developed a valuable reputation in the marketplace. However, you receive a demand letter from a lawyer for an Ontario corporation operating under a similar name. The Ontario corporation has been selling similar products in Canada for at least two years and registered its name with the Federal Trademarks Office. Their lawyer advises you that if you do not change your name, packaging and logo designs within one month, their client will commence legal action against you claiming damages. Unfortunately, you have a warehouse of products ready for distribution but you cannot sell the products without facing court action and the possibly seizure of the products. And you face considerable time and money in developing a new business name, new product packaging and new logo designs. Unfortunately, you need to start from the beginning again because consumers no longer recognize you.

Another scenario: You registered a business name in British Columbia for the purposes of selling computer software. You developed your website and started the marketing of the software. A large amount of sales in





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BC has been generated, and you are ready to expand into Alberta. You attempt to register your business name in Alberta only to find out that another person already has registered the same business name and started to sell a similar type of computer software. You unfortunately have not sold or advertised your software in Alberta. You now face the real possibility of being blocked from expanding your business.

What can I do to protect my name and reputation, and reserve the ability to expand my business?

Regardless if you are choosing a new business name or already are operating under a name, we recommend that you contact one of our firm's Registered Trademark Agents to conduct background research to determine whether there are any confusingly similar names or trademarks of record in Canada. If the search results are positive, we can protect your name by registering it as a trademark with the Federal Trademarks Office. The registration of your name as a trademark will provide you with the exclusive right to use the name 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.



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