



**Susannah C. Rolston, Partner**  
Intellectual Property  
Toronto  
(416) 862-4634  
susannah.rolston@gowlings.com

Susannah is involved in all aspects of researching the availability of trade marks, preparing and prosecuting applications for the registration of trade marks and all other business conducted before the Canadian Intellectual Property Office, including opposition and expungement proceedings, filing assignments and security documents.

## Proper Use and Notice of Technology Trade Marks

*Susannah C. Rolston*

For a fledgling, cash-strapped technology company, investing in the brand may not be a high priority. However, it is an important consideration for any sized technology company.

To protect your trade mark rights, it is advisable to register your trade marks. Registration can secure the exclusive right to use your trade mark in Canada. While some degree of trade mark protection can be achieved without registration, by virtue of the use of the trade mark on products, your rights will be limited to the geographic area in which you conduct business and where your products and/or services are known.

A central issue in trade mark protection is the use of the trade mark in association with products and/or services. If your trade mark is not used properly, you may be unable to prevent others from using it. This can be avoided by following the rules for the proper use of trade marks.

### 1. Use Your Trade Mark Correctly

Failing to use your trade mark correctly could result in its becoming generic, and a generic trade mark cannot easily be identified as yours. Marketers who work hard to make a brand a household name must, at the same time, safeguard against unlawful uses of their trade mark.

How to use your trade mark correctly:

- Avoid using your trade mark as a modifier. Use your trade mark as an adjective, not a noun.
- Avoid pluralizing a trade mark.
- Avoid using a trade mark in the possessive form.
- Avoid using a trade mark as a verb.
- Always follow a trade mark with a generic noun.

### 2. Distinguish Your Trade Mark from Other Words

Set your trade mark apart from other words by capitalizing your trade mark or using a different typeface and/or colour.

### 3. Use Trade Mark Notices

Identify your trade mark using the proper <sup>TM</sup> or ® symbol.



- Registered trade marks: If your trade mark is registered in Canada, use the symbol ® (French version: MD).
- Unregistered trade marks: If your trade mark has not been registered in Canada, use ™ (French version MC).
- Placement of symbols: The ®, ™, MD, and MC symbols may be placed on the shoulder or heel of the trade mark.
- A trade mark notice should appear at the end of the report or newsletter or at the bottom of the article in which the trade mark appears.

#### 4. Use Your Trade Mark as Registered

Ensure your trade mark is used exactly as registered. Designs should not be changed from the registered format and should use the colours claimed in the registration. If your trade mark has been modified in any way, you should re-register the new version immediately.

Here are some tips on using your trade mark as registered:

- Avoid abbreviations;
- Do not hyphenate, coin new words from, or change the spelling of the trade mark.

#### 5. Keep Your Trade Mark Register up to Date

Changes to the name or address of the trade marks' owner, or any change of ownership of a trade mark registration, should be recorded with the Canadian Trade Marks Office. Furthermore, if you are now using your trade mark on products and services not listed in the original registration, the registration should be updated to add the products and services.

#### 6. A Trade Mark Needs to be Used

You should make every effort to continue to use your trade mark after registration. A registered trade mark that is no longer in use risks being expunged from the register.

Meeting requirements for use of a trade mark can be difficult. For example, merely placing a trade mark on letterhead and business cards may not meet the requirements. Token sales of products, as well, are not likely to meet the use requirements.

#### 7. Licensing

Care should be taken to ensure that a trade mark is not used by entities other than the owner, unless proper licences are in place.

#### 8. Policing

Protection of a trade mark is a matter of continuing awareness and periodic review. To maintain your trade mark rights, you must diligently police your trade marks against infringement. If you become aware of an infringement, you should seek assistance as soon as possible so that the appropriate action can be taken.



These guidelines are not meant to be exhaustive, but are a starting point on taking appropriate action to protect your trade mark assets. Broadly speaking, as technology changes, different issues may arise in the appropriate use of a trade mark. It is a good idea to develop a comprehensive, far-reaching trade mark strategy to secure your trade mark rights over the long-term.