

Making your mark and protecting your brand online in Canada

Part 3 - Effective registration and branding strategies

Not for distribution

Jordana Sanft

Partner, Lawyer, Trademark and Patent Agent, Toronto

Catherine Daigle

Partner, Lawyer, Trademark Agent, Montreal

Mihaela Dumitrean

Trademark Agent, Montreal

Al Hounsell

Senior Innovation Lawyer, Toronto

Jeffrey Kang

IP Strategist, Lawyer, Trademark and Patent Agent, Toronto



Agenda

- Welcome and introductions
- Nice and Madrid implementation, one year later: Lessons learned and what to expect
- Distinctiveness objections: Navigating a new frontier
- IP strategy and risk management
- AI and innovative solutions
- Closing remarks
- Breakout sessions



Nice and Madrid implementation, one year later: Lessons learned and what to expect

Catherine Daigle
Partner, Lawyer, Trademark Agent, Montreal

Nice and Madrid implementation, one year later: Lessons learned and what to expect

Nice Agreement

- Nice Classification
 - Requires that all goods and services associated with a mark be grouped under one or more of the 45 classes available
 - Filing and renewal fees will depend on the number of classes covered by the application or registration
 - Applies to new applications, existing applications that had not been published on June 17, 2019 and to registrations upon renewal
 - In addition to grouping the goods and services according to the Nice Classification, CIPO still requires that goods and services be specific and listed in ordinary commercial terms

Nice and Madrid implementation, one year later: Lessons learned and what to expect

Madrid Protocol

Advantages

- Possible to file an international application in 120 member countries
- Possible to pick any number of countries and extend protection in other countries once you have an international registration
- Cost savings if the filing extends to multiple countries
- Simplified prosecution depending on the jurisdiction
- No need to retain local trademark counsel in the designated countries

Possible issues and other considerations

- International rights are dependent on the validity of the original home country application or registration for a period of five years after the date of the international registration
- Rights granted by the international registration cannot be any broader than the home country mark
- No savings if the international application only covers a few countries
- No advice from local counsel on possible pitfalls

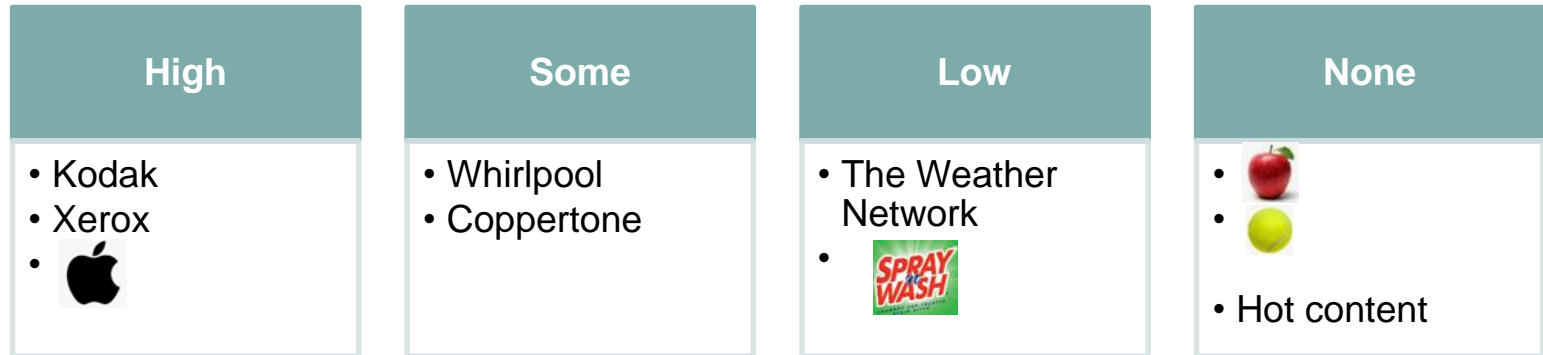
Distinctiveness objections: Navigating a new frontier

Mihaela Dumitrean
Trademark Agent, Montreal



Distinctiveness

- Serves to identify the origin of goods or services in order to avoid confusion
- Levels of distinctiveness:



Examples of trademarks considered not inherently distinctive

- One- or two-letter or one- or two-number trademarks: **GT, LE**
- Primarily merely a name or surname
- Names and honorifics: **MRS., MR., DR., DAME, SIR, ESQ. SMITH**
- Laudatory words and phrases: **WONDERFUL, AUTHENTIC, ORIGINAL, CANADA'S BEST**

Old law	New law
✓	✗



Old law	New law
⚠	✗



Old law	New law
✓	✗



Old law	New law
⚠	✗

Examples of trademarks considered not inherently distinctive

- Geographic locations: **TORONTO, SHECAWGO, CANADA'S LAW FIRM, AMERICAN**
- Phone numbers: **514 508-0808**
- Trademarks that other traders should be able to use in the ordinary course of their businesses in association with the same goods or services

Old law	New law
	

Old law	New law
	

Old law	New law
	

How to respond to this kind of objection?

- File written arguments against the objection
- File evidence establishing that the trademark was distinctive at the filing date of the application



IP strategy and risk management

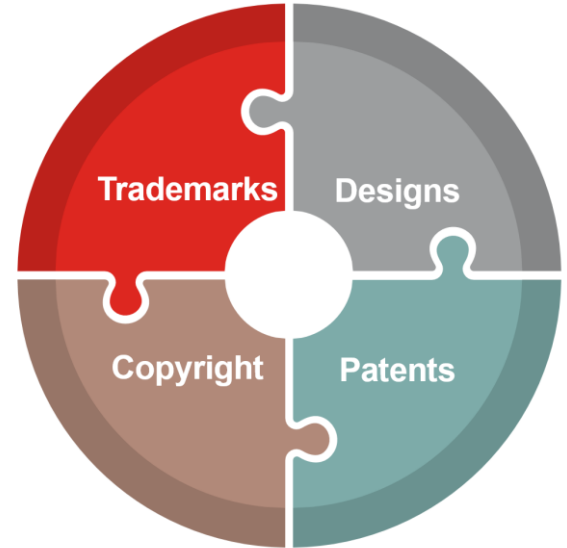
Jeffrey Kang
IP Strategist, Lawyer, Trademark and Patent Agent, Toronto

What is an IP strategy?

- An IP strategy is a framework for directing resources to capture value and manage risk of intangibles such as brands, technology, and data.
- A comprehensive IP strategy spans protection, commercialization, and enforcement.
- A useful IP strategy includes an implementation plan.

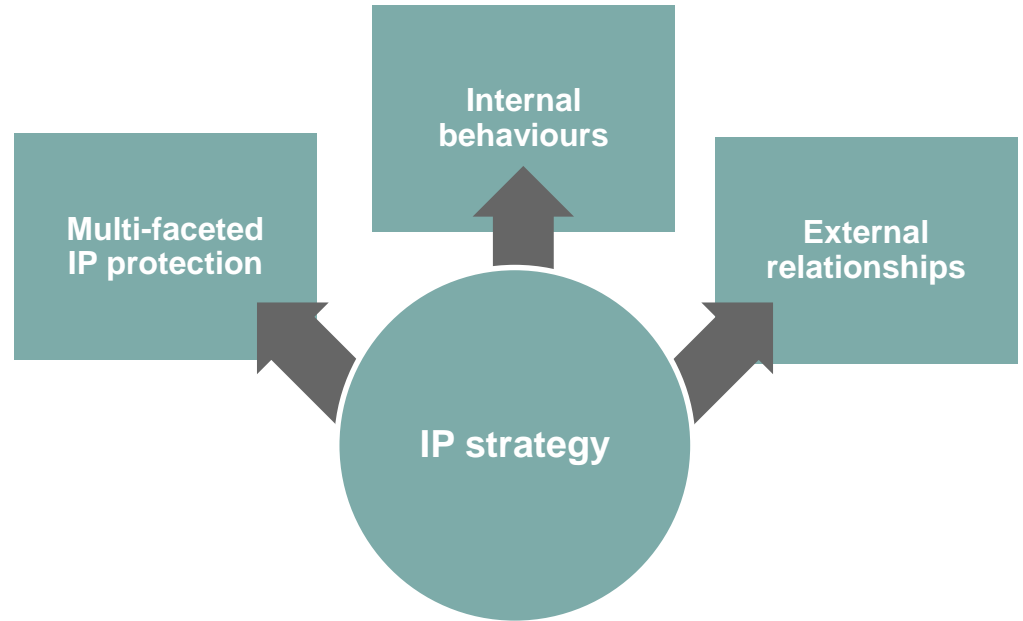
Multi-faceted IP coverage for brands

- An IP strategy uses multi-faceted IP coverage for brands
 - Greater scope of protection
 - More options for commercialization and enforcement
 - Enhanced asset value
- The IP strategy should be bespoke. There is no one-size-fits-all solution across all brands and all jurisdictions



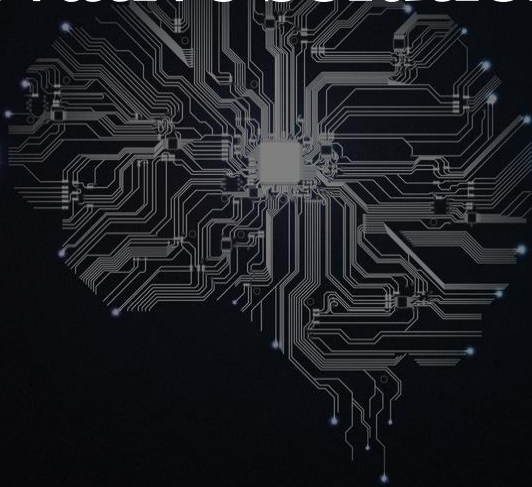
Capturing value and managing risk

- Capture value and manage risk from both internal and external sources
- Shape internal behaviours through policies and education
- Manage external relationships by layering IP rights with contractual rights



AI and innovative solutions

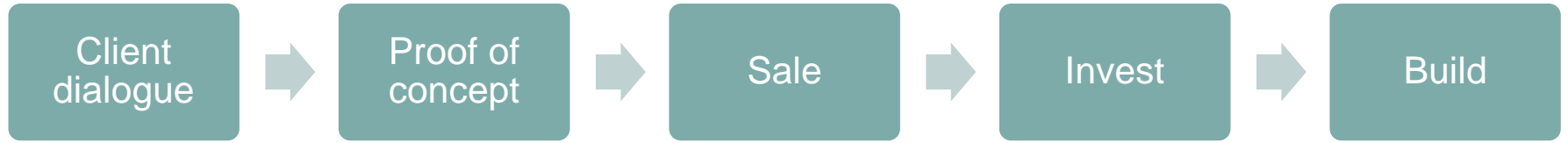
AI Hounsell
Senior Innovation Lawyer, Toronto



Overview

- Collaboration process
- Types of clients facing innovation:
 - Value-added services
 - Bespoke legal engineering services
 - Innovative products

Collaboration process

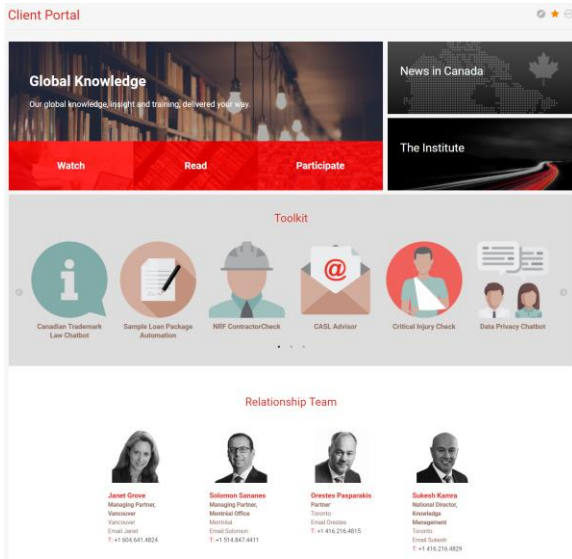


Valued-added services

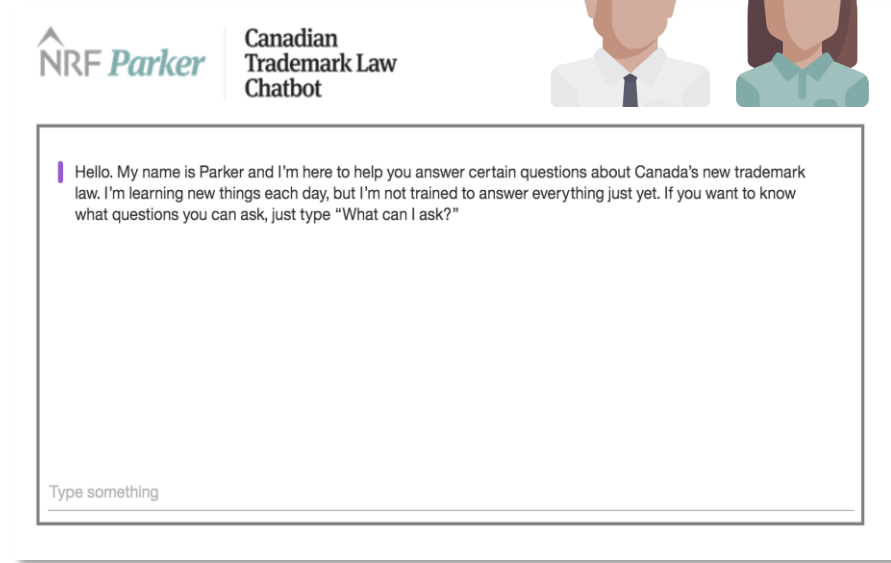
- Client portals
 - Collaboration portals designed to solve common workflow challenges and promote efficiency in client communication
- Legal expert system apps
 - Tools to guide clients through a decision tree to common legal answers
- AI tools
 - AI tools and chatbots to interact with users surrounding hot topics and frequently asked questions
- Document automation
 - Automated templates for common, usually low-value legal precedents

Examples

- Client portals



- Madrid TM - Chatbot



Bespoke innovation

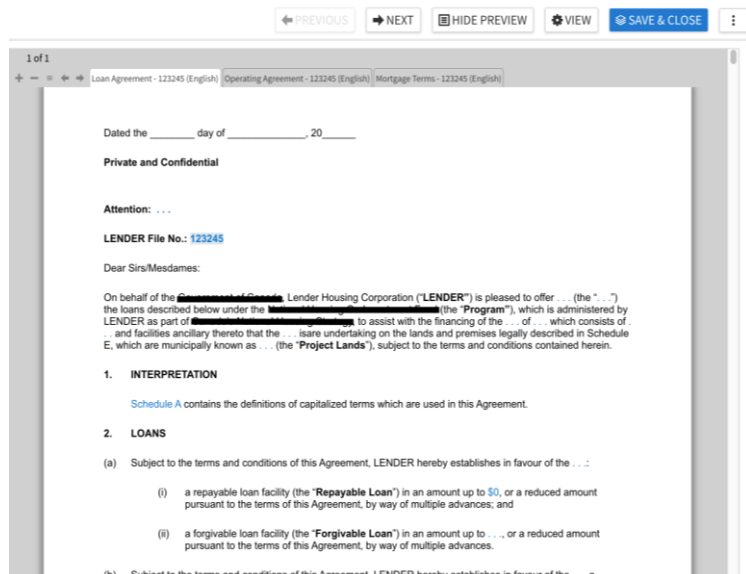
Selling innovation & legal engineering services

Types of bespoke innovative services

- Workflow systems
 - Tools focused on workflow and process automation for processes that are well known to law firms and clients
- Data analysis
 - Work spent on cleaning, analyzing and interpreting client data by reason of legal expertise and/or legal privilege
- AI tools
 - AI tools and chatbots to interact with users surrounding client-specific frequent questions
- Document automation
 - Automated templates for bespoke, client-specific legal precedents

Examples

- Document automation



- IP clinic - Chatbot



Hello. My name is Isaac Pewton. I can provide basic intellectual property (IP) information and assistance with IP related matters. If you are looking for legal advice, please contact an IP lawyer. How can I help you?

who can apply for a trademark?

To apply for a trademark registration, you must be a "person" under Canadian law. A "person" can be an individual, partnership, trade union, association, joint venture, or corporation. Moreover, two or more persons can be applicants for a trademark.

What is needed in a trademark application?

A complete application includes: 1) the name and mailing address of the applicant, 2) a representation or description, or both, of the trademark, 3) a statement in specific and ordinary commercial terms of the goods and services associated with the trademark, 4) the statement of goods and services grouped according to the Nice Classification, 5) the application fee, 6) any other requirements specific to the type of trademark sought to be registered. You must file a separate application for each trademark that you wish to register. However, one application can cover a number of goods or services for a given trademark. To learn more about the trademark application process, please visit [here](#).

Products

Legal engineering to build scalable products

Developing innovative products

- Regulatory databases
 - Firm sells subscription to database of regulatory information as well as tools for associated workflows
- Reporting dashboards
 - Firm sells workflow tools that are universally applicable to many clients
- Training modules
 - Firm sells access to e-training apps that apply to many clients

Example – Trademark portal



< Close Save and new < Close

Trademark

Name

Official name

Is foreign language

Applicant

Filing Country

Trademark already filed

Run registrability search

Applicant (New)

Adverse trademarks +

Generate Trademark CSV

Trademark Type

Trademark goods

Trademark services

Trademark

services

- Standard character (letters, numbers and other characters)
- Design trademark (graphics of word, design/logo or both)
- Colour
- Hologram
- Moving Image
- Sound
- Texture
- Taste
- Positioning of Image
- Mode of Packaging
- 3D image

Example – Trademark portal



Trigger + New Import Trademarks < Close

AI Hounsell
al.hounsell@nortonrosefulbright.com

DESKTOP

- Countries
- Entities
- Trademarks**
- Adverse trademarks

SETTINGS

<input type="checkbox"/>	Name	Applicant name
<input type="checkbox"/>	[Faded]	[Faded]
<input type="checkbox"/>	[Faded]	[Faded]
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Adverse Trademark

Display name

URI

Owner name

Status

- registered
- formalized
- allowed
- searched
- advertised
- other

First use

International classes

Identification statement

Desired action

- ignore
- watch
- oppose

Example – IP portfolio dashboard



NORTON ROSE FULBRIGHT
IP Portal

Patent Portfolio

Show 25 entries

Column visibility Filter Excel PDF Patents Search Manual

Search:

Family ID	Representative Patent Image	Family title	Synopsis	Earliest Application date	Business Group	Sub Business Group	Technology
							Financial Product

Lessons learned

- Avoid bespoke customization
 - Costs can be kept lower for clients by focusing on features that are applicable to many situations
- Look for partnerships
 - Cost-sharing arrangements and bespoke opportunities with product potential to minimize upfront risks
- Carefully think through support models
 - Carefully consider how to provide high-quality support similar to other software products

Closing remarks

Learn more

- **Breakout sessions now**
 - Technical support available by emailing rsvp.canada@enortonrosefulbright.com
- **Missed one of our webinars? Watch them on demand:** www.nortonrosefulbright.com
 - October 15, 2020 | Part one | Brand enforcement online
 - October 22, 2020 | Part two | Mitigating branding risks on social media and e-commerce

Moderator



Jordana Sanft

Partner, Lawyer, Trademark and Patent Agent
Toronto

Tel: +1 416 216 4798

jordana.sanft@nortonrosefulbright.com

Our speakers



Catherine Daigle

Partner, Lawyer, Trademark Agent
Montreal

Tel: +1 514 847 4560

catherine.daigle@nortonrosefulbright.com



Al Hounsell

Senior Innovation Lawyer
Toronto

Tel: +1 416 216 1884

al.hounsell@nortonrosefulbright.com



Mihaela Dumitrean

Trademark Agent
Montreal

Tel: +1 514 847 4246

mihaela.dumitrean@nortonrosefulbright.com



Jeffrey Kang

IP Strategist, Lawyer, Trademark and
Patent Agent
Toronto

Tel: +1 416 216 3903

jeffrey.kang@nortonrosefulbright.com



Law around the world

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