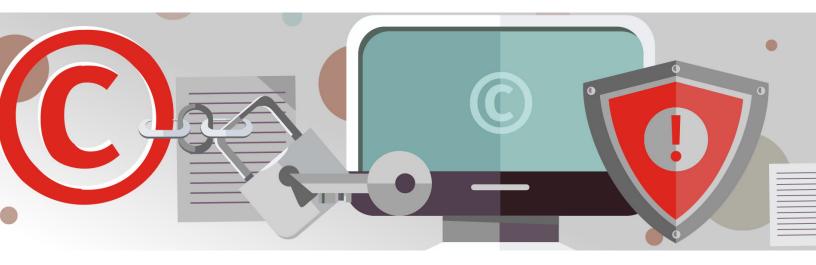
NORTON ROSE FULBRIGHT



Making your mark and protecting your brand online in Canada

Part one - Brand enforcement online

October 2020

In short: Competitors may bid on your trademark in search engine advertising, provided the resulting ad is not confusing.

Title: Trademarks on the Internet

Key takeaways

- Bidding on keywords is generally lawful, unless combined with a confusing advertising message the message to the consumer, as a matter of first impression, is what matters.
- The "first impression" is measured when the ad is first displayed.
- Using a trademark in a domain name to refer to an entity, when combined with a descriptive
 word, such as "bcaaonstrike.com" and "icbcadvice.com", is usually lawful, as it permits
 consumers to distinguish those websites from the 'official' websites.
- However, when ordinarily descriptive words have become distinctive of a business over time, they be protected both as a domain name and as a trademark to stop confusingly similar uses.
- An online marketplace cannot use, or suggest as a search term or "related search", a trademark
 to advertise a product category, class of goods, or competing products, especially if it does not
 also sell the 'authentic' product.
- An online marketplace may lawfully list competing products in addition to authentic products in response to search terms, as long as the overall message is not confusing.

Key contacts



Christopher Wilson
Partner
Tel +1 604 641 4841
chris.wilson@nortonrosefulbright.com



Bianca Pietracupa Associate Tel +1 514 847 4593 bianca.pietracupa@nortonrosefulbright.com