



# Trademarks and why they matter



# Caravel Law's trademark and intellectual property practice



One of the most important assets in a business is often its intellectual property. At Caravel Law, our lawyers bring years of rigorous training and practical insight to the table. Having worked as in-house lawyers responsible for protecting their company's IP portfolio, and at IP-focused law firms, our team is among the best in the business.

We can help your company protect and monetize its trademarks, patents and other intellectual property. These are just a few of our services.

## Our services

- ✓ Freedom to operate analyses
  - ✓ Trademark applications and management (Canada and Internationally)
  - ✓ Patent applications and management (Canada and Internationally)
  - ✓ Information technology agreements and issues
  - ✓ Intellectual property licensing and monetization
  - ✓ Strategic review and management of IP portfolio
  - ✓ Copyright advice and registration
- ... And more!

# Why trademarks matter

Today's complex and fast-paced business landscape presents more challenges than ever before. Success means having an edge or a new way of doing things, and your brand is your calling card. By registering a trademark, you can protect the identity of your business from unnecessary complications down the road. Let's start with the basics.

## What is a trademark?

A trademark is a word or design (e.g., a logo) used to sell goods or services to the public. Trademarks can be registered or unregistered.

## Registered versus unregistered trademarks

One of the most common misconceptions about trademarks is that you have exclusive use of a business name or slogan simply because it's your corporate or

personal name. The truth is, by using a word or design, you may have an unregistered trademark. The issue with unregistered trademarks is that they are only enforceable to the extent you can prove a reputation in the mark, and to do so is costly and time-consuming. In fact, you may not be able to use your business name as a trademark at all.

A registered trademark is a distinctive word or design that

is publicly registered with the Canadian Intellectual Property Office (CIPO).

The bottom line: A registered trademark is not the same as having business name; it must be filed with CIPO. We can help.



**Simply putting a <sup>TM</sup> in your logo doesn't mean it's protected.**

Having a <sup>TM</sup> symbol next to your logo or company name may deter others from using it, but it offers no real legal protection. In fact, anyone can use a <sup>TM</sup> symbol on anything; CIPO doesn't regulate its use. The best way to truly protect your trademark is to register it. Once issued, you should use the official registered symbol ® to help identify your brand.

# What are the benefits of registering a trademark?

Trademarks are essential in differentiating your business so that clients can recognize and find it. Here are the five key benefits of registering your trademark.



## **Stronger protection**

With a registered trademark you have a government granted right for exclusive use. Registration is a deterrent to other businesses which makes copying less likely.



## **Easier enforcement**

It's easier and less expensive to enforce a registered trademark by sending a "cease and desist" letter. You don't have to prove your use of the mark in court. Once it's filed and issued, it is presumed to be valid.\*



## **Invest with confidence**

Invest in your brand knowing it's protected, rather than risk having to change things down the line with an unregistered trademark.



## **Grow your brand**

Registration applies across Canada, and we can help streamline the application process in other countries as well.



## **It's a business asset**

A registered trademark is a valuable asset. If you decide to sell your business, or if a larger brand wants to buy it, you have the right to transfer it to another owner.

# Is trademarking right for small or new businesses?

Trademarking is for businesses of any size that want to protect their brand identity. You don't have to be a large or established name brand to register a trademark. In fact, it's best to register as early as possible – as soon as the brand identity is complete.

By involving us early on, we can help identify potential issues before you finalize your brand. This is much more cost effective when compared to the cost of a rebrand if an issue arises.

Registering a trademark ensures you are able to advertise your business name and can significantly reduce the likelihood of future conflicts.



# How can Caravel Law help?

At Caravel Law we take a hands-on approach and work closely with our clients to achieve successful outcomes. Registering a trademark can be a long process but we handle all the details and keep you updated every step of the way. Here's how it works.



## 1. Contact us before you finalize your brand identity

We can help you avoid potential issues before you finalize your brand identity, so contact us early on. Regardless of what stage you're at, we can help.



## 2. We file a trademark application on your behalf

Every country has its own patent and trademark system. We'll work closely with you to understand your business needs, then we'll draft and submit your application.



## 3. Your trademark is approved

Congratulations! You now own one of the most valuable assets for your business. After five years, your trademark becomes incontestable.

## What exactly can I register as a trademark?

You may register multiple trademarks for your business including your:

- ✓ Company name
- ✓ Product name
- ✓ Slogan
- ✓ Company logo – whether it's a word mark (e.g. Coca Cola's logo) or a symbol (e.g. Nike's swoosh)

# Overview of costs

Item	Cost
Initial filing	\$600
Government filing fee in respect of initial filing	\$300*
Per Additional Class	\$100
Handling Advertisement in Trade-Mark Journal (required)	\$200
Handling Registration Process	\$200
<b>TOTAL</b>	<b>\$1,455*</b> plus applicable HST

Optional items (as applicable)	Cost
Reporting an office action	\$200
Responding to an office action	\$320/hr
Preparing revised application	\$100
Requesting extension of time	\$200
Third party opposition – prepare and file counterstatement to opposition	\$400
Third party opposition – work re: contesting the opposition	\$320/hr

## Canadian trademark preapplication searches

If desired, Caravel Law can perform a “knock out” search, which costs approximately \$400 (plus HST) and involves a computer search of the Canadian Intellectual Property Office database to look for obvious barriers to trademark registration and use.

We can also do a more extensive search which costs approximately \$1100 (plus HST) and includes a search by a professional search company (Thomson Reuters).

## US and international trademark filings

We can also assist with trademark filings and searches in the United States and other foreign countries. Contact us for more information.

*\* Assuming no office actions or third-party oppositions.*

# Trademark and intellectual property team at Caravel Law

Our lawyers are recognized leaders in their field offering years of expertise to a diverse group of clients in a wide range of industries.



**Alexander Stack**

Lawyer, Registered Patent & Trademark Agent



**Ian Bies**

Lawyer, Registered Patent & Trademark Agent



*“Caravel Law is a great legal support system for any entrepreneur looking for business matters to be taken care of.”*

– COO, Technology Company

# Recent work



Managing the portfolio of hundreds of trademark registrations and applications for a major Canadian charity.



Advising on opposition proceedings and negotiating worldwide settlement for Canadian information technology company in dispute with a global telecommunications company.

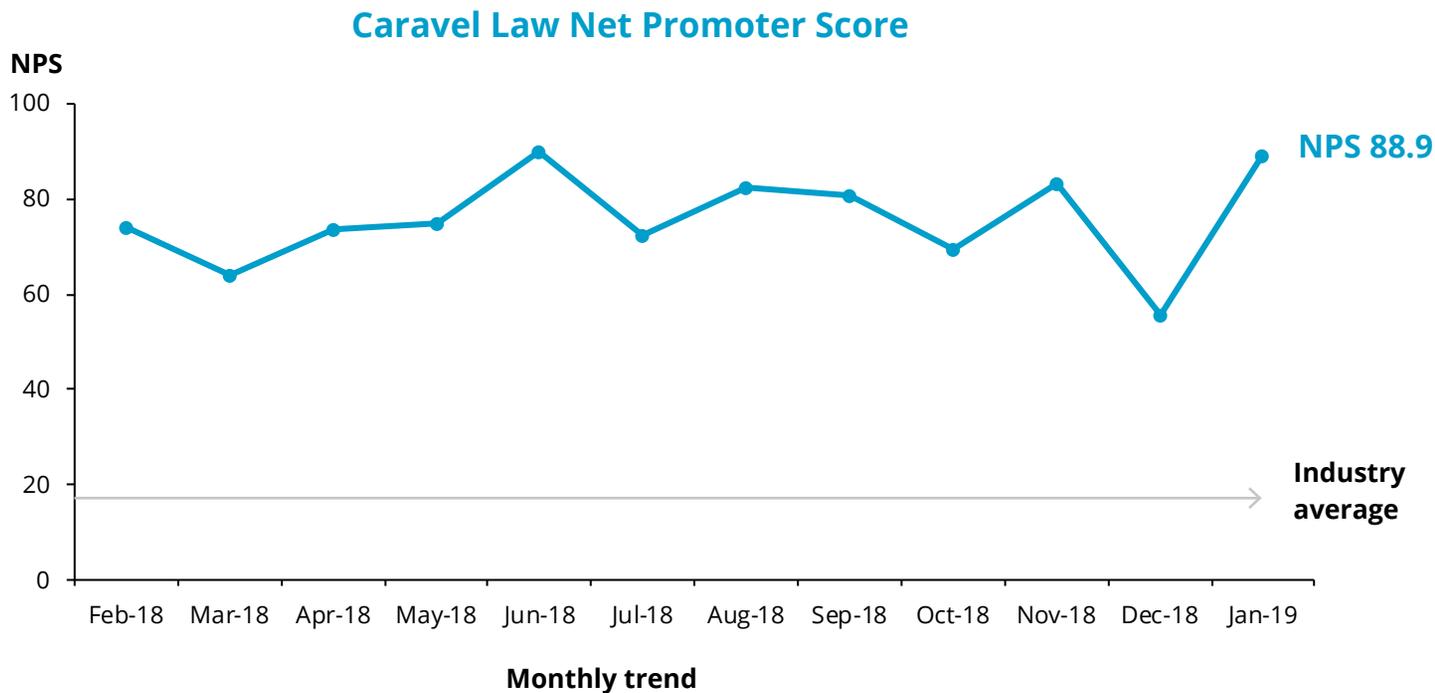


Advising on brand selection and clearance, and obtaining Canadian trademark protection, for a major automotive company.



# Client satisfaction

Since 2005 we've been revolutionizing legal services and making clients happy. Our net promoter score for January 2019 is 88.9 and averages at at 76.7. Compare that to the industry average of 19! The reality is, most firms don't even ask their clients if they're happy with the experience.



## A few of our clients

bluedot



PROVINCE APOTHECARY



Health Quality Ontario

# About Caravel Law

Your business. Your counsel. Your way.

At Caravel Law, we do business differently. We don't have a mahogany-panelled boardroom, an army of receptionists, or an oil painting of our founders hanging on the wall.

For over ten years, Caravel Law has attracted the best lawyers and staff by providing them with a more satisfying way of doing business.

We have over 40 partner-level lawyers across Canada with years of experience working at large companies and corporate law firms.

Our approach is simple – we invest the time to get to know you and your company so we can match you with the right legal counsel from our diverse team.

When you hire outside counsel for your business, it's important to work with a firm that really gets what you do. At Caravel Law, we pride ourselves on providing outside counsel that almost feels like in-house expertise. It's advice from seasoned lawyers you can count on.

Contact us and let's get started today.



## **Caravel Law**

c/o WeWork

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**caravellaw.com**

# Let's get started

Our team represents a diverse group of clients in a wide range of industries. Contact us and we'll match you with a lawyer that best meets your needs.



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