

SMART & BIGGAR

Tips & Tricks on Canadian & U.S. trademark prosecution & enforcement.

Speakers: Tierney GB Deluzio & Mark Biernacki

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Our speakers



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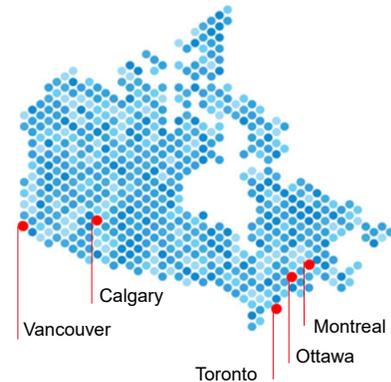
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Who we are

Canada's leading IP law firm
with expertise at the interface of
technology and business law

- Expertise in all areas of IP
- 130+ years serving clients
- 125+ lawyers, agents and technical consultants
- 12,000+ patents & trademarks filed annually
- Litigation bench strength and record of success



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Agenda

A. Prosecution

1. Goods and Services
2. Confusion
3. Distinctiveness
4. Geographic Descriptiveness
5. Prohibited Marks

B. Litigation & Enforcement

1. Expert Court
2. Actions and Applications
3. Discovery
4. Relief and Remedies

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1. Goods & Services

Prosecution

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What can you do?

- Consult the Canadian *[Goods and Services Manual](#)*
- Request to add terms to the *Manual*

Accelerated examination

- From > 55 months to ~ 17 months from filing
- ****only national applications****

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2. Confusion

Prosecution

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What can you do?



Do not file a “bare bones” consent

- *Tweak-D Inc v Canada*, [2023 FCA 238](#)
- Consult the Canadian [Trademarks Examination Manual](#)
- Include information that will persuade the Examiner
 - The parties operate their businesses in different areas
 - The applied-for trademark has acquired distinctiveness
 - The marks co-exist without actual confusion

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3. Distinctiveness

Prosecution

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What can you do?



File response to
Examiner's Report



File evidence
of acquired
distinctiveness

**** prior to the filing date
of the application ****



Consider
distinctiveness as
part of filing strategy



Reminder:
no Supplemental
Register

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4. Geographic Descriptiveness

Prosecution

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What can you do?



If no one has ever heard of the location, they can't be deceived



Warning: distinctiveness



Reminder: no disclaimers



Consider as part of trademark clearance

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5. Prohibited Marks

Prosecution

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What can you do?

1. File a written response
2. Obtain the owner's consent
3. Submit evidence that the owner no longer exists
4. Challenge the validity of the public authority



Legislative changes on the horizon may make it easier to apply to the Trademarks Office to inactivate Prohibited Marks

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1. Expert Court

Litigation & Enforcement

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Advantages and Key Differences

- Federal Court – Single Unitary Court
 - No circuits or districts
 - Canada-wide injunctions
- No Juries
- Judges with IP Expertise



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2. Actions and Applications

Litigation & Enforcement

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Options and Flexibility

Actions

- Traditional procedure
- Full discovery
- Live testimony at trial
- 2-3 years to trial

Applications

- Streamlined procedure
- No discovery
- Affidavit evidence
- More expeditious
- Less expensive

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3. Discovery

Litigation & Enforcement

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Streamlined Pre-Trial Discovery

- Relatively restricted scope
 - Scope = relevant to material facts (not merely related)
 - Stricter application of proportionality
- Single deponent per party
- Shorter
- Less expensive

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4. Remedies & Relief

Litigation & Enforcement

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Flexible and Effective Relief

Damages or Accounting of Profits

Costs - "loser pays"

Punitive damages

Nominal damages

Injunctive Relief

- Interim, interlocutory and permanent injunctions
- Destruction or delivery up
- Transfer of infringing domain names and social media accounts

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Questions?

Please type into Q&A panel

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Thank you!

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