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Version visionnée sur le site Internet d'origine le 20 mars 2009.

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[IPC Services](#)

[Trade-Mark registration process](#)

[Contact us](#)

[About IPC](#)

[Previous newsletters](#)

In 2007, nearly 10 000 trade-mark applications were filed in the USA by Canadians<sup>1</sup>. In this newsletter, Ms. Johanne Muzzo<sup>2</sup>, attorney-at-law and trade-mark agent registered at the Intellectual Property Office in Canada answers to some of the most frequent questions asked by our clients regarding the registration process in the USA.

**If I have a trade-mark registration in Canada, is it protected in the United States?**

No. The Canadian trade-mark registration protects the owner's rights in Canada only. Generally, trade-mark rights are national. The only exception is the European Community trade-mark that offers a protection in the 27 Member States with one filing. For the other countries, you must proceed distinctly.

**Is it necessary to proceed with an availability search for the USA?**

If you wish doing business in the USA in a near future, it is strongly recommended to be diligent in protecting your trade-mark rights and to do a complete availability search before adopting your mark. Some clients had to choose a different mark than the one registered in Canada because said mark was no more available in the USA. Our turnaround time to deliver a complete availability search is approximately 2 to 3 business days after your order.

**What is the registration process in the USA?**

The process is similar to Canada (examination, approval (if no objection), publication, allowance, registration (if no opposition)). [\(see diagram\)](#)

If there are similarities, there are also differences. Regarding the formalities, the principal distinctions are the following:

- the goods and the services are divided in different classes (for example, clothing is in Class 25, cd roms are in Class 9, sporting activities are in Class 41 and restaurant services are in Class 43). The applicant must pay government fee for each class requested.
- A specimen showing use of the mark must be filed if the applicant claims a date of first use in the United States (for example a tag).

### How much does it cost to register?

A non-contested file will usually cost less than 2000\$ CAD, for an application for a word mark in one class and based on a Canadian Registration Certificate.

**Please contact us for a free estimate.**

### How long does the registration last?

A registration is valid for 10 years after the registration date. It can be renewed every 10 years. A declaration of use must be filed together with a specimen of use per class. A declaration of use must also be filed between the 5<sup>th</sup> and 6<sup>th</sup> year following the first registration date. We send a reminder to our client a few months before the due date.

### What are the benefits of a USA trade-mark registration?

A registration is evidence of ownership of the trade-mark. The mark will be recorded in the trademark register, which provides an efficient means of discouraging the adoption of confusing marks or corporate names by third parties. Once registered, the mark may be recorded with the U.S. Custom and Boarder Protection Bureau in order to prevent the importation of goods bearing infringing mark.

### How long does it take to register a mark?

An application for registration can be processed in approximately 12 to 18 months for a non-contested file.

### Can the IPC help me with the registration process in the USA?

You can rely on our expertise and professionalism for you trade-mark files in the United States. My colleague Caroline Guy and myself are authorised to practice before the United States Patent and Trademark Office in trademark cases for Canadians. We have several years of experience and we can rely on the precious assistance of our US collaborator for some more complex files.

<sup>1</sup> United States Patent and Trademark Office, [2008 Performance and Accountability Report, p. 135 \(pdf format\)](#)

<sup>2</sup> *Johanne Muzzo is Director of the IPC trade-mark department a division of CRAC. She gives regularly lectures on trade-mark topics and recently contributed to the "Guide de démarrage de l'entreprise" published by the YBAM (Young Bar Association of Montreal) and available at [www.ajbm.qc.ca](http://www.ajbm.qc.ca)*

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