

What's In A Name: The Do's and Don'ts of Trademark and Copyright for Non-Profits

CASE STUDY: PuSh FESTIVAL SOCIETY

PuSh is non-profit organization that organizes two annual events in Vancouver: the PuSh Festival, a multi-disciplinary performing arts festival, and the PuSh Assembly, a networking event for artists and industry professionals. It also organizes off-season public programs and workshops for professional development. PuSh is known for being innovative, edgy, international, and accessible industry leaders that encourage the exchange of ideas.

What goods or services are the PuSh Festival's logo associated with?

Is the PuSh Festival's logo distinctive?



An example of a possible competitor:

The **PUSH Conference** is an annual conference and networking event held by the Walker Arts Centre in Minneapolis. It features multi-industry speakers, performers and workshops. PUSH is marketed as a place for the exchange of ideas on how to change the world through forward-thinking and leadership.

Their logo:



Are these trade-marks confusing? What would you do if you were representing PuSh?

INTRODUCTION TO TRADE-MARKS

What is a trade-mark?

A trade-mark is used to identify an organization's wares (its goods or merchandise), services and reputation. A trade-mark can be a word, name, numerals, image, logo, design, slogan, colour combination, the shape of packaging or a combination of these elements. A trade-mark is not necessarily the same name as your trade-name or the name of your organization. Registering your name with the Registrar of Companies does not grant you any trade-mark rights.

Why is a trade-mark important?

A trade-mark distinguishes your association and its goods and services from other organizations and competitors. It reflects the goodwill and reputation that the organization has established in the sector. It is a valuable asset.

Why register a trade-mark?

There are two types of trade-marks:

Common law trade-mark: You acquire a common law trade-mark simply by using it in the day-to-day operation of your society. Common-law trade-marks are identified by the letters "TM".

Registered trade-mark: A registered trade-mark is a trade-mark registered with the Canadian Intellectual Property Office (CIPO). Your society becomes the registered owner of the trade-mark, preventing others from using similar trade-marks. These can be identified by the ® symbol.

Examples: **Common law trade-marks (not registered):**



Registered trade-mark: ®



Registering your trade-mark gives you the exclusive right to use the mark across Canada for 15 years. Registering a trade-mark enables the organization to better protect that trade-mark from being misused or imitated by other associations or businesses

For example, Society X and Society Y are using the same trade-mark, but only Society X has registered the trade-mark. A court would most likely find that Society X was the owner of the trade-mark and Society Y would be prevented from using it.

How do I register a trade-mark?

An organization or an individual can register a trade-mark by applying to the Trade-marks Registrar at the Canadian Intellectual Property Office (www.cipo.ic.gc.ca).

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TRADE-MARKS: Distinctiveness and Use

Elements of a Trade-mark

The trade-mark must be distinctive.

5 categories of distinctiveness: a trade-mark can be more or less distinctive, depending upon the elements of the trade-mark. The more distinctive the trade-mark, the better.

Most distinctive *Fanciful:* an invented name or mark that has no previous dictionary meaning. E.g. Lululemon

Arbitrary: an existing word or images that is used in relation to goods or services that are not related to their dictionary meaning. E.g. Apple Computers, Blackberry device

Suggestive: indirectly suggests a quality or characteristic of the goods or services. E.g. Jaguar

Descriptive: describes the goods or services being marketed.
Example: Festival International de Jazz de Montreal, Yellow Pages, Seniors Services Society

Least distinctive *Generic:* a word or a name that is or has become the common term for those wares or services.
Example: Band-Aid, Kleenex

Use is evidence that an organization has used its trade-mark in such a way that stakeholders in the sector will associate the trade-mark exclusively with the goods or services with which it is identified. The more that a trade-mark is used and identified with the specific goods or services of an organization, the more distinctive it is. Use is an important factor if a dispute arises over who owns a trade-mark.

9 Guidelines for Proper Trade-mark Use

1. Distinguish the trade-mark from surrounding text that is descriptive or generic (use distinctive type, capitalize the letters of the trade-mark, etc.).
2. Use the trade-mark as an adjective only, not as a noun or a verb. If the trade-mark is used in a way other than as an adjective, you run the risk that the trade-mark may become a generic term.
3. Follow the trade-mark by the generic name of the goods or services. The generic name for the product should be highly descriptive, relatively short, easily pronounceable and be more attractive as a generic term than the trade-mark itself.
4. Avoid variations of the trade-mark. The trade-mark should always be in the same form and spelling, never used in the plural, as a possessive, descriptively or to modify any words. Do not abbreviate the trade-mark, compound it with another term, or use it to coin another word or phrase.
5. If possible, use the trade-mark for diverse products so that stakeholders and the sector are directed toward recognition of the mark as a source-indicative house mark rather than as a generic name for any particular product.
6. Avoid using the words "original" or "genuine" in association with the trade-mark since this implies there may be other products or services bearing the same trade-mark.

7. A proper trade-mark notice should be used with each trade-mark at least once, preferably the first time the trade-mark appears (i.e. ® for registered trade-marks; TM for unregistered trade-marks).
8. Use your trade-mark on and in association with the products or services that the trade-mark identifies.
9. Continue to use the trade-mark so that you do not lose your rights in that trade-mark.

THE INTERNET

Copyright

Copyright applies to original artistic works. This includes designs and logos.

Copyright does not have to be registered. The *Copyright Act* automatically grants copyright to the creator of a work for the life of the author plus 50 years.



Domain Names

A domain name is the equivalent of a telephone number for a computer. The Canadian Internet Registration Authority (CIRA, www.cira.ca), assigns domain names on a first come, first served basis. An effective domain name will assist an organization in communicating, fundraising, event planning, recruiting and supporting advocacy initiatives.

Many organizations want a domain name that reflects their trade-mark. As a result, these domain names can be similar or confusing. Examples: www.csse.ca (Canadian Society for the Study of Education)
www.csce.ca (Canadian Society for Civil Engineering)
www.cses.ca (Canadian Special Events Society)

Registering a domain name does not automatically give you any rights to the trade-mark. When a domain name is registered, the registry does not check for conflicts between domain names and other similar domain names or trade-marks. While trade-marks must be registered in relation to specific goods and services, domain names do not. This means organizations can use similar domain names for different or competing purposes.

CIRA has developed a procedure to resolve disputes between domain name owners and trade-marks owners in Canada. Courts have recognized that a trade-mark can be infringed through the use of a domain name on the basis of imitation, confusion, depreciation of goodwill and passing-off.

Terms of Use

Websites should contain a statement that all the content of that site belong to the organization, including all text, images and trade-marks. It should alert users to how they are allowed to access and use the information on the website. For example, the statement may say that users are not allowed to use any text or images on the website without permission from the organization.

Please note that the information provided above should be viewed as general information, not legal advice. Copyright and trade-mark are complex subjects and the foregoing information is only a brief introduction. If you have a legal or business issue, we recommend that you consult a lawyer who is knowledgeable about the area in question to obtain tailored legal advice.