

Memorandum

To: The University of British Columbia community

From: Office of the University Counsel

Re: General Information on UBC Trade-marks

Disclaimer: The information in this memorandum is intended to provide general guidance with respect to trade-mark law. It is not a substitute for proper legal advice.

Information Sheet on UBC Trade-marks

The University of British Columbia enjoys a reputation as one of the most prestigious universities in Canada and the world. In order for UBC to continue to attract and retain talented students, faculty and staff, it must take active steps to protect its reputation and identity. One way in which the University protects its reputation is by registering and policing its trade-marks. This ensures that third parties cannot use the name, slogans, or visual identity of UBC for their own purposes or to confuse the public into thinking that they are affiliated with UBC. This memorandum is organized in two parts:

1. A brief overview of Canadian trade-mark law;
2. An introduction to UBC's trade-mark portfolio.

The Trade-marks Act

In common law Canada (i.e. outside of Quebec), trade-marks are protected in two ways: at common law and by statute. UBC usually seeks statutory protection, because it affords more definitive protection to the mark holder than common law protection. In addition, statutory protection is applicable throughout Canada, including in Quebec. Under the *Trade-marks Act* R.S.C. 1985 c. T-13 (the "*Act*"), an applicant can apply to have a trade-mark registered with the Trade-Marks Office. If the applicant is successful, the trade-mark will enjoy protection across Canada as a regular trade-mark.

In order for an applicant to successfully register a regular trade-mark, the mark must meet certain criteria. It must be in use at the time of registration, it must be inherently distinctive or have become distinctive through its use, and it must be registrable. A proposed trade-mark can be unregistrable for a number of reasons, including if it is confusingly similar to an existing trade-mark, if it is overly generic or if it is "scandalous, obscene or immoral" pursuant to section 12 (1e) of the *Act*.

Trade-marks do not exist in the abstract, but rather must be associated with certain wares and services. It is possible for two trade-marks with the same name to co-exist if they are associated with

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different wares and services so long as they are not confusingly similar. Marks are said to be confusingly similar pursuant to section 6(2) of the *Act* if:

use of both trade-marks in the same area would be likely to lead to the inference that the wares or services associated with those trade-marks are sold, leased, hired or performed by the same person, whether or not the wares or services are of the same general class.

In addition to regular trade-marks, certain public bodies, including universities, can request that the Registrar of Trade-marks give public notice of their Official Marks pursuant to section 9 of the *Act*. Official Marks are also often called Section 9 marks, or prohibited marks. Official Marks are not technically trade-marks, though in practice they function in much the same way. Official Marks offer very broad protection for the public bodies whose interests they protect. There is no need to apply to register an Official Mark: simply giving public notice is sufficient to prove the existence of the Official Mark. In practice, giving public notice is similar to registration. However, the registrar has no discretion to refuse a mark for which public notice has been given pursuant to Section 9.

Furthermore, Official Marks offer broader protection than any other trade-mark interest. Marks that would be unregistrable as regular trade-marks for being confusingly similar to existing trade-mark interests can nonetheless be protected under section 9. Therefore, a public body can seek section 9 protection for virtually any mark. However, adoption of an Official Mark will not prevent a prior registered trade-mark holder from continuing to use their trade-marks. In that sense, Official Marks cannot defeat existing trade-mark interests. One potential drawback of section 9 marks is that it is unclear if they can be licensed to third parties. As a result, many public bodies will seek regular trade-mark protection in addition to section 9 protection for some of their marks. It should be noted that Section 9 has no equivalent in the United States.

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UBC's Trade-marks Portfolio

UBC has a number of Official Marks and regular trade-marks, including regular trade-marks registered in Canada, China, and the United States. The portfolio of trade-marks is managed by the Office of the University Counsel. A complete list of UBC's marks is available on the Office of the University Counsel's website at:
http://www.universitycounsel.ubc.ca/univ_tm/UBC_Marks.pdf

Policing the unauthorized use of trade-marks and Official Marks is the responsibility of the mark holder. Therefore it is UBC's responsibility to monitor the marketplace for unauthorized use of its trade-marks, official marks or confusingly similar marks. This requires the involvement of the broader UBC community. Should you become aware of any unauthorized use, or suspect any unauthorized use, please advise the Office of the University Counsel so that we may take appropriate action.

If UBC wishes to allow others to use one of its trade-marks, it must do so pursuant to a license agreement and all such use must be accompanied by a public notice of the fact that the trade-mark is licensed and that UBC is the owner. All such licensing activity should be coordinated through the Office of the University Counsel in accordance with UBC Policy #110 (Third-Party Use of University Trade-Marks), a copy of which is available on the Office of the University Counsel website at:
<http://www.universitycounsel.ubc.ca/policies/policy110.pdf>