



TRADEMARK TOOLKIT

The RULES for Proper Use of Trademarks

1. **ALWAYS** use capital letters:
 - For REALTOR®, REALTORS® and MLS®
 - For the first letters of Multiple Listing Service®
 - For the “S” in “System” in the phrase “MLS® System”
2. **ALWAYS** include the ® registration mark in superscript.
3. **ALWAYS** include trademark ownership text with any use of the REALTOR® or MLS® trademarks if possible.
4. **ALWAYS** use the term “MLS® System of the XYZ Board” or “XYZ Board’s MLS® System” when referring to the co-operative selling system of a Board/Association.
5. **NEVER** alter or distort the words or the design marks.
6. **NEVER** combine the marks with any other words or designs.
7. **NEVER** use adjectives with the marks.
8. **NEVER** use the marks in slogans, product or business names.
9. **NEVER** use REALTOR® or REALTORS® in a way that implies it means “real estate agent”.
10. **NEVER** use MLS® in a way that implies it means a database.
11. **NEVER** use MLS® as a noun.
12. **NEVER** use MLS® in domain names.
13. **ONLY** use REALTOR® in domain names in accordance with CREA’s policies.

TRADEMARK Toolkit

Foreword

The primary purpose of this Trademark Toolkit is to explain certain simple but essential policies and guidelines that have been adopted by The Canadian Real Estate Association (CREA) to govern and protect the usage of its trademarks. These CREA guidelines and policies are designed to encourage the widest possible consistent use of the trademarks while at the same time preserving and perpetuating their meaning. Without these guidelines and policies, and the cooperation and assistance of member Boards and Associations in ensuring proper use, the trademarks might become confused in the public mind and lose their valuable qualities that can be protected. To remain effective in identifying unique services or identification, the trademarks must be used consistently and correctly.

Protection is everyone's business

Trademark owners, including CREA, can protect and even enhance the value of trademarks through proper trademark usage. Protection of a trademark begins at home. We need to ensure that REALTORS®, Boards and Associations know how to use our trademarks.

CREA has historically assumed the primary responsibility for protection and enforcement of the MLS® and REALTOR® marks. However, the advances in electronic communication, most importantly the Internet, have resulted in a morass of trademark infringements that no one body can adequately police.

The MLS® and REALTOR® trademarks are assets of organized real estate as a whole and it is absolutely critical to the strength of these industry trademarks that misuses be identified and stopped. A local Board is in the best position to see what is happening in its jurisdiction. With this in mind, CREA amended its By-Laws and Rules in 2009 to make Boards and Associations the primary enforcement authorities for the trademarks.

The Trademark Toolkit

This Trademark Toolkit has been developed with a number of broad objectives in mind:

- to provide a background primer on trademarks, including a review of what a trademark is, how it adds value to your organization, what a trademark infringement is, and how trademark law in general works;
- to explain how CREA's Rules, policies and guidelines relate to the use of the MLS® and REALTOR® family of marks;
- to act as a resource manual for Boards and Associations, and to provide them with the tools necessary in developing their own trademark compliance programs.

RESOURCES

This Trademark Toolkit is available on REALTOR Link®.

You can also refer to the federal Trade-marks Act by going to the Department of Justice website <http://laws-lois.justice.gc.ca/eng/acts/T-13/index.html>.

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INTRODUCTION

I. The importance of trademark protection

Trademark protection is everyone's business, and effective trademark protection begins at home. The subject of trademarks often conjures up images of a complex law reserved for the legal departments of multi-national companies. Nothing could be further from the truth. In fact, membership support and compliance with trademark rules are the first steps to building a strong national trademark.

CREA is the owner of various trademarks that serve to identify and brand the services of CREA, Boards/Associations and member salespeople and brokers. While CREA owns a number of trademarks, the most prominent are the MLS® and REALTOR® family of marks.

The purpose of this Trademark Toolkit is to assist Boards/Associations and members in protecting and enhancing these marks. However, before we begin talking about the "how to's" of trademark protection, we need to address a much more fundamental question –why?

The simple answer is that trademarks are not just ethereal concepts – they are valuable corporate assets and need to be treated as such. This concept is discussed in greater detail in this Toolkit, but for the time being, suffice it to say that a trademark owner uses trademarks properly and enforces improper use for the same reason he locks his office doors – to protect the assets of the company.

The MLS® and REALTOR® marks may be owned by CREA, but they are assets of organized real estate. They identify our membership and the services provided by that membership. Boards, Associations and CREA have spent millions of dollars at the local, provincial and national levels promoting the MLS® and REALTOR® marks. This advertising is an essential element of trademark protection, but is not enough on its own. True trademark protection is the result of a comprehensive strategy of registration, licensing, advertising and enforcement, undertaken jointly by all members at every level of organized real estate. This Toolkit is part of that strategy.



II. Intellectual Property and Trademarks

1. Definition of Intellectual Property

A trademark is a sub-set of intellectual property. Intellectual property is a phrase used to describe rights in property of an intangible or “intellectual” nature. This can be a trademark, a process for manufacturing a chemical, or the name of a product. These rights may include the right to sell or transfer the property, the right to manufacture a product using certain technology, the right to exploit a name or famous character to market a product, or the right to reproduce a literary or musical work.

Intellectual property rights are different than physical property rights. Ownership of the physical property does not necessarily lead to ownership of the intellectual property, or vice versa. **For example**, when you own the physical property in a book you have the right to read the book, and to loan or sell the book to a friend. You do not have the intellectual property right to make a photocopy of the book, to adapt the book as a screenplay, or to publish the book.

Intellectual property generally includes five main areas: patents, copyrights, industrial designs, confidential information and trade secrets, and trademarks. These rights are protected in Canada by a combination of common law and legislation.

2. Defensive and Offensive Use of Intellectual Property

While this concept of intellectual, as opposed to physical, property may seem ethereal, it is important to remember that intellectual property can be as – or more – valuable to a business operation as the technology that runs it.

Ownership carries with it, substantial rights. The owner of a copyright, **for example**, is the only person authorized to reproduce, distribute or sell the copyrighted work. The owner of a trademark is the only person authorized to use it in association with certain goods or services. The owner of a patent is the only person authorized to incorporate the design or functionality into a product. Anyone else who wishes to do any of these things must deal with the owner and work out a license agreement. Using someone else’s intellectual property without consent may result in enormous financial consequences.

As a result, intellectual property ownership is a powerful tool that can be used as a sword or a shield.

The defensive use of intellectual property involves conducting due diligence before you launch any new product or service to ensure that you are not stepping on any intellectual property toes. If you are developing hardware or software, you will want to research current patents and copyrights to avoid infringement problems. If you are branding your product or yourself in some way, you should not introduce that brand without making sure there are no similar trademarks. **For example**, in expanding the functionality of REALTOR.ca, CREA considered a marketing program called HOUSE BY MOUSE, with a cute little stylized computer mouse with a tail. Before launching the program, a search of registered trademarks revealed that the idea was apparently so clever, many, many persons had registered variations on that theme. So the idea was dropped.

The offensive use of intellectual property refers simply to the process of protecting your original ideas once you have satisfied yourself that they are indeed original. Ideas, by themselves, are nothing, until they have been reduced to some form of product. Once you have conceived of the perfect mousetrap, you must flesh out that concept and register a patent. Otherwise, your idea becomes someone else’s retirement plan.



PART 1 – A TRADEMARK PRIMER

3. Intellectual Property as a Valuable Business Asset

The information age is upon us. And what that means is that the business world has moved away from putting value exclusively on bricks and mortar, and now looks at the value of information, in its many forms when it assesses businesses. The North American economy is now knowledge based and technology driven. The vast majority of successful Internet based companies leverage nothing more than information. The shares of GOOGLE, **for example**, have not skyrocketed because of its knack in real estate investments. The foundation for Google's worth is its constant innovation in how to find and present information to consumers.



Officials of Google estimate that 20 per cent of search requests every day are new. They interpret this as a strategy that 20 per cent of their business changes daily.

If you look at the buyouts and mergers taking place every day, particularly in the high-tech sector, you will see in almost every case, they are simply the joining of complementary technologies – I've got a piece of software that, when combined with your hardware, will produce information in a totally novel manner. Or, my functionality, when marketed through your branding, will triple our customer base.

What is being bought and sold in these scenarios is really nothing more than intellectual property. For this reason, it is crucial to consider intellectual property in every aspect of business operations.

4. Intellectual Property as Part of a Strategic Plan

Because intellectual property has a very real, very tangible and very assessable value, it is in the best interests of any organization to leverage its intellectual property with its strategic plan. Intellectual property is inextricably bound up with effective commercial activity.

Every strategic plan has key elements. **For example**, the marketing plan, the financial plan, the sales plan, and the operational plan or strategy for implementation. These elements all combine to become the foundation for the strategies that will help the business deliver on its objectives for the coming year.

When considering the strategic plan, businesses should always be aware of the intellectual property tie-ins. **For example:**

- Databases are subject to copyright. If you are developing a database, what ownership rights do you want to assert - rights in the database as a whole or in the individual things that comprise the database? What kind of protection do you need in contracts with the users of the database and any other third party technology and content providers?
- Most of the material you produce is subject to copyright. What controls do you need to protect that right? Are third parties creating any of the documentation? If so, do you have contracts with them confirming your ownership? Have your employees waived their moral rights to the documents they are creating on your behalf?
- What are you doing to brand yourself or create consumer recognition? Any advertising, communication, packaging and consumer or customer activity involves trademarks and copyrights.



5. How Intellectual Property Fits With Business Objectives

It is important to give thought to how intellectual property fits with your business objectives. Some of the questions you need to ask when developing any new initiative are:

- Can intellectual property be leveraged for the product or service?
- If yes, what intellectual property rights are available to best protect this product?
- Is it to your advantage to create some brand and positioning?
- Is it even worthwhile to use intellectual property to protect this product (cost benefit analysis)?
- Is the branding you are thinking of “ownable”?

The bottom line is that in today’s knowledge-based economy, intellectual property must be a key consideration in day-to-day business decisions, and should be exploited at every possible opportunity.

Wrapping your products and service up with an intellectual property component serves 4 main purposes:

1. It turns ideas into assets;
2. It prevents competitors from copying or closely imitating your organization’s products or services;
3. It creates a recognizable corporate identity through branding strategies; and
4. It increases the market value of your organization.



PART 1 – A TRADEMARK PRIMER

III. Trademarks

1. Definition

A trademark is a word or a symbol that is used to distinguish the products or services of one person or organization from those of another in the marketplace. A word does not gain trademark significance simply because it refers to a particular product. In order to “distinguish” a product or service, the mark itself must be distinctive. **For example**, a toothpaste manufacturer cannot coin the word “toothpaste” to



identify its product exclusively. Toothpaste is a common word of the English language used to identify any of the products used to clean teeth. No-one can “own” that word. But when you see the word CREST, you immediately conjure up an image of a particular brand of toothpaste.



Trademarks are not limited to just words and symbols. Even shapes can be imbued with trademark rights when they are sufficiently well known. The shape of a product or the way it is wrapped or packaged is known as a “distinguishing guise”. If the shape is sufficiently distinctive to “distinguish” or identify the owner’s goods from those of others, it may be given trademark protection. **For example**, look at the shape of the TOBLERONE bar. Those distinctive points, somewhat reminiscent of Bart Simpson’s head, are unique to this product, and can be protected by law from dubious chocolate makers who try to pass themselves off as pseudo Toblerones.



Colour may also form part of a trademark. The distinctive red, white and blue colour contrasts of the PEPSI logo, as an **example**, are integral to the identification of the mark.

2. Certification Marks Versus Ordinary Trademarks

CERTIFICATION MARK

A certification trademark is one that is used to distinguish the products or services that are of a defined standard from others that do not meet that standard.



Both **REALTOR®** and **MLS®** are registered as certification marks.

A certification mark is a particular type of registration that is permitted by the Trade-marks Act. An understanding of the place of certification marks in the universe is essential to a discussion of CREA’s trademarks, as the bulk of those marks are, in fact, certification marks.

A certification trademark is one that is used to distinguish the products or services that are of a defined standard from others that do not meet that standard. This standard can relate to one or more of the following characteristics:

- the character or quality of the wares or services;
- the working conditions under which the wares have been produced or the services performed;



- the class of persons by whom the wares have been produced or the services performed; or
- the area within which the wares have been produced or the services performed.

The owner of the certification mark cannot be involved in the services described by the mark. The mark itself is licensed to a group of people or organizations that meet the defined standard. The nice thing about a certification mark is that the owner does not have to enter into separate licensing agreements with each member of the defined group. The Trade-marks Act provides that use by any of the members of the group is deemed to be use by the owner.

A good **example** of an effective certification mark is the GOOD HOUSEKEEPING SEAL OF APPROVAL. This mark is licensed to those companies that meet a defined standard of service or quality of product. Those organizations that have raised the bar to that degree may apply to display the mark in association with that service or product. It says to the world that they have met a standard beyond that provided by other companies.



With this in mind, you can see how certification mark registrations mesh with the services provided by members of organized real estate. Many business organizations, unions, and professional associations have established a set of standards which members are required to maintain. The Canadian Real Estate Association is one of them.

These associations pride themselves on their standards and encourage members of the public to deal with association members. CREA's REALTOR® and MLS® families of trademarks are registered as certification marks because they denote a standard of excellence that CREA members must meet in order to maintain their membership. These concepts are discussed in greater detail in Part 2 of this Toolkit.

3. Trademarks and the Internet

Domain Names

Domain names are the unique Internet addresses assigned by various Internet administrators, such as "yahoo.com", "harvard.edu" or "cbc.ca". The domain names proprietary to the owners in these examples are Yahoo, Harvard and the Canadian Broadcasting Corporation (CBC). The endings ".com", ".edu" and ".ca" define the type of organization or the location of the organization – ".com" for commercial organization, ".edu" for educational organization and ".ca" for a Canadian organization.



A person who is searching the Internet for information on a certain company or product will often try to locate the company by using its company name or its main product name. In this way, a domain name can be an important marketing tool for a company, and a very effective way to promote use of the trademark.

Various court decisions over the last ten years have made it clear that trademark law applies to domain names. A prudent trademark owner will want to make sure it has registered its company name, its major brands, and its trademarks as domain names.



PART 1 – A TRADEMARK PRIMER

Meta-tags

Meta-tags can be used to lure Internet users away from competing sites. This is possible because all websites are created using a programming language called hypertext mark-up language (HTML). Like any computer program, a programmer may include non-operational lines of code in the program (i.e. programmer's notes), also known as meta-tags. When a website is viewed, the reader only sees text and graphics produced by the HTML programming, not the source code or the meta-tags. When an Internet user is searching for a website containing specific information, he or she will normally employ a search engine, such as "Yahoo" or "Google" to find the site. The user will enter a word or phrase and the search engine will produce a list of sites that contain the word or phrase. Most search engines will list sites by giving a higher rank to those sites with a greater frequency of the desired word or phrase.

The meta-tag problem occurs because some of the major search engines will consider the meta-tags to be part of the text of the website when conducting a search. An unscrupulous website operator may take advantage of this by including the names or trademarks of its competitors in the form of a meta-tag, often repeating the key words dozens of times.

The courts have confirmed that meta-tags are comparable to advertising and will be subject to the usual rules of trademark protection.

Sponsored Keyword Searches

Sponsored keyword searches are used like meta-tags to attract Internet users to certain websites. A website owner can purchase a keyword from a provider, like Google Adwords, and their website will then be featured in the search results when an Internet user conducts a search for that word.

Keyword searches can be problematic where a website owner purchases the trademark or tradename of their competitors. Internet users may then be confused into thinking that the website featured in the search results is actually the website of the trademark owner or tradename owner. Canadian courts have confirmed that keyword searches must not be used in a manner that would result in Internet user confusion.

Hyperlinks

Hyperlinks allow Internet users to switch from web page to web page without typing in new Internet addresses. Web pages often include links to other websites with similar content, or which complement the original site. **For example**, a running shoe company may provide "links" to professional sport websites. Hyperlinks usually appear on web pages in the form of words or logos, also the primary forms of trademarks. Thus, hyperlinks also can be used to imply association with a trademark holder, when none really exists, resulting in either the infringement or dilution of a trademark.

You must always obtain the prior written approval of the owner before creating a hyperlink in any form from a third party website to any page of the owner's website. The company may or may not give such approval at its absolute discretion.

Many companies will only allow a plain-text link and will reserve the right to rescind their approval at any time. Many of these agreements contain clauses that ensure that the person using the links will do so without alteration or deletion or without infringing the trademarks. The company will usually also reserve the right to review and approve the manner in which the company's content is displayed on the website.



4. The Four Step Formula to Protecting Your Trademarks

Trademark law is a harsh mistress, and effective trademark protection involves much more than simply registering a mark, or using it properly. In order to solidify and maintain one's rights, a trademark owner must actively and diligently follow this four-step formula:

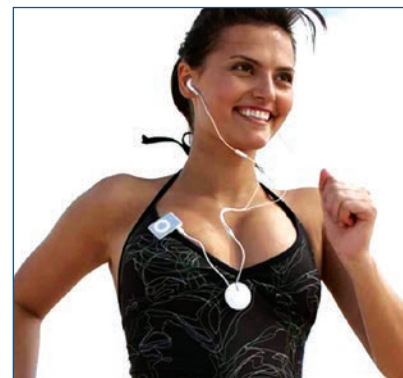
1. **Acquisition of Rights;**
2. **Licensing;**
3. **Marketing; and**
4. **Enforcement.**

Acquisition of Rights

Before trademark rights can be enforced, they must be acquired.

Trademark rights are acquired, in a nutshell, by use. The Trade-marks Act is federal legislation that establishes a regime for the registration of trademarks, but registration is not necessary in order to protect a trademark. It is the use of the mark, not its registration, which creates ownership rights.

The use must be specific – i.e. the mark must be used for the purpose of distinguishing goods or services emanating from a particular source. It is not essential that the public know exactly who or what the source is, but they must be able to associate the mark with a particular product or service. The iPod MP3 player, for example, is distinguishable from all other MP3 players on the market today. You may not know or remember the name of the company that developed the iPod (*Apple Computer Inc.*) but that doesn't matter. The important thing is that the iPod name carries with it immediate brand recognition because of its extensive use, its massive sales and the large-scale advertising campaign that supports the product.



Trademark rights based on use are territorial in nature. A trademark owner relying on simple use may only be able to assert trademark rights in the jurisdiction in which the product is actually used or the service is rendered. If a roofer in Winnipeg has branded himself as the SHINGLE GUY, he can defend that phrase against other persons in the same type of business in the Winnipeg area where he does business and where his service is known. However, he may not be able to assert a case against another roofer in Halifax who adopts the SHINGLE GUY moniker because his use has been restricted to Winnipeg. If for some reason, the notoriety of the Winnipeg SHINGLE GUY has spread far and wide, and his reputation as a world-class roofer has become well known across Canada, this may be sufficient for him to have developed trademark rights in Halifax. It would, in each case, be a matter of fact.



PART 1 – A TRADEMARK PRIMER

Registration of a Trademark

The application can be filed online with the Canadian Intellectual Property Office (CIPO). More information on process and costs can be obtained from the CIPO website, which can be accessed from the federal government site located at <http://strategis.ic.gc.ca>. While it is possible to file a trademark application yourself, the process can be complex, and it is therefore recommended that you retain a lawyer or trademark agent to act on your behalf.

Registration of a trademark is done in accordance with the provisions of the Trade-marks Act. This legislation sets out the structure and rules regarding the registration and enforcement of trademark rights, including:

- What trademarks are registrable;
- What trademarks are prohibited;
- Who is entitled to register a trademark;
- The application and opposition process;
- What constitutes trademark infringement;
- The rights and obligations of trademark owners;
- How rights are lost.

Advantages of Registration

Even though trademark rights can arise and can be enforced from a common law perspective simply as a result of use, there are a number of advantages to registration.

- A registered trademark gives the owner the exclusive right to its use throughout Canada even though the registered owner may have used it in only one location;
- A registration is good forever provided a nominal renewal fee is paid and the trademark continues to be used;
- A registered trademark is, for all practical purposes, a prerequisite for business expansion through licensed franchisees, or licensing agreements;
- A registered trademark is deemed to be distinctive to the products and services of the trademark owner and the onus is on the defendant to prove otherwise. In an action based on an unregistered mark, the owner must prove it is distinctive;
- A registration is a defined right that can be asserted against others. An owner has the legal right to defend his or her trademarks;
- As a definable right, it will enhance the value of a business by more clearly defining goodwill as an asset;
- The owner of an unregistered trademark can only sue if there is actual infringement by another party. The owner of a registered trademark can prevent the use of another mark in any manner that is likely to have the effect of depreciating the goodwill of the registered mark whether or not that use constitutes trademark infringement;
- A registration is property that can be bought and sold like any other asset;
- The registration is recorded in the Trade Marks Office. Confusing or similar trademark applications will be denied by the Office without any opposition or comment from the public or other trademark owners;
- Registration also serves as notice to others of the owner's trademark rights, in effect encouraging them to select non-confusing alternatives.



Who is Entitled to Register a Trademark?

As a general rule, the person entitled to register a trademark is the person who first “adopted” it. A trademark is adopted either when the person begins to use the trademark or make it known in Canada, or when the person makes application to register the trademark, whichever is the earliest.

The Basis for Trademark Registration

A trademark application may be based on one or more of 4 grounds:

1. Use of the trademark in Canada - Using a trademark in association with services generally means displaying it in the course of performing the services. While the advertising of the services may be “use” to some degree, the fact is, advertising services without having actually performed the services or without having the ability or facilities to perform the services is likely not “use” within the meaning of the Trade-marks Act. Promoting or advertising your services is not performing the services. It is a secondary act. It could be that being available and willing to do to the services is enough, but it would depend on the circumstances.
2. Making the trademark known in Canada - A trademark is “made known” in Canada if:
 - It is used in a country which is a member of the World Trade Organization;
 - The products and services are distributed or advertised in Canada in association with the trademark in printed publications, radio and television broadcasts or on the Internet; and
 - The products or services have, in fact, become well known in Canada because of such distribution or advertising.
3. Proposed use of the trademark in Canada - An application for registration can be filed on the basis of proposed use. The advantage to this is that the registrant reserves the mark. However, before the trademark can actually be registered, the owner must have started using it, and must file a statutory declaration to that effect.
4. Registration in another country - If the applicant owns and uses the trademark in his or her country of origin in association with the same products or services, and is using the mark in any convention country, he or she may apply for a trademark registration in Canada.

Licensing

Never allow your trademarks to be displayed by any other person or company without a written license agreement. Proper use strengthens a trademark. The more extensive the proper use, the larger the group using it, the stronger the mark becomes. By the same token, improper use by anyone, and any use by unauthorized persons, weakens the mark. The more extensive the improper use, the weaker the mark becomes, until eventually, it is lost. It is therefore crucial for trademark owners to ensure that any uses of the marks are within the limits of allowed uses and are properly controlled by the owner. This control is exercised through licensing agreements.

Trademark owners have the exclusive right to license the use of their marks to third parties. In these situations, the licensee has the authority from the owner to use the mark and the owner maintains the direct or indirect control over the quality or character of the wares or services with which the mark is used. Generally, these agreements contain clauses providing for the proposed uses of the marks and are subject to certain terms and conditions as established by the trademark owner. Through these license agreements, trademark owners exert the control necessary to meet the requirements of the Trade-marks Act.



PART 1 – A TRADEMARK PRIMER



Marketing

Trademark rights that you have acquired are not particularly valuable if you are the only one who knows the trademark exists. In order for a mark to be distinctive of a product or service, it has to be recognized by the public. The greater that recognition, the stronger and more valuable the mark will become.

Part of successful marketing of a trademark is branding it to ensure that a consumer, when reading that word or looking at that design thinks of you. **For example**, a word or design may, through constant use and extensive advertising, attain a secondary meaning that relates directly to a particular product or service. The word McDONALD'S and the stylized "M" logo (known to the world as the "Golden Arches") are now synonymous with the restaurant services and products of the most famous hamburger joint in the world.

This did not happen by accident. The company

has spent tens of millions of dollars in advertising, which ties its symbols to its products. This is known in the business as "branding". A successful branding campaign—which invariably also includes many, many years of use—results in consumers immediately identifying your product or service with that word or symbol.

Enforcement

Enforcement is really the other side of the coin to licensing. Licensing ensures that all authorized users are documented. Enforcement ensures that all unauthorized users are detected and stopped. There is no point in carefully documenting proper uses if there is rampant misuse of your mark by others in the commercial arena. In other words, if you are going to own trademarks, you need to take extreme care to monitor improper uses and establish effective procedures to deal with them.



IV. How Trademarks are Violated

As already discussed, if you are going to own trademarks, you need to take extreme care to monitor improper uses and establish effective procedures to deal with them. The question now is what are improper uses?

People are familiar with the words “trademark infringement” and tend to think of that term as a catchall category for any type of improper use of another’s trademark. As with so many areas of the law, it isn’t quite that simple. While trademark infringement itself is a cause of action available to the owners of both registered and unregistered trademarks, the owners of registered trademarks have additional causes of action on which they can rely, all of which are explained further below.

1. Passing Off

As you probably realize by now, trademarks are not just words and symbols that serve no purpose but to decorate the page. They are very real, and very valuable, corporate assets. The value inherent in a trademark is known as “goodwill”. Goodwill is really the reputation of the company. The stronger a mark gets, the more clearly it identifies your product or your service or your company, with the result that your brand recognition—or goodwill—increases.

This reputation has monetary worth when your company is being valued. So, if someone is acting in a way that depreciates or lessens the value attributable to a trademark, you may take action. This conduct may or may not be an actual trademark infringement, but that is irrelevant for the purposes of this action.

Passing off is the only cause of action available to owners of unregistered trademarks. Passing off occurs when a trademark is used in such a way as to misrepresent to a consumer that the services or products of that person were offered, manufactured, performed or endorsed by the trademark owner.

Passing off is a powerful weapon for registered trademark owners, as it is based on “likely result” and therefore has a basis in common sense business practice. A plaintiff in a passing off action must prove 3 things:

1. It operates a business, which includes goodwill (or reputation), and that goodwill is connected with the trademark used by the business to identify its products or services;
2. There has been a misrepresentation by the defendant;
3. There is a likelihood of damage.

Providing evidence to establish the goodwill connected with the use of a trademark can be a very onerous task. Further, not all misrepresentations result in a likelihood of damage. Therefore, proving passing off can be very difficult. Establishing infringement of a registered trademark, on the other hand, is much easier, and yet another good reason why trademark owners should register their trademarks.



PART 1 – A TRADEMARK PRIMER

2. Infringement

The Trade-marks Act gives the owner of a registered trademark the right of “exclusive use” of a trademark. This means that, unlike the situation in passing off actions, owners of registered trademarks do not have to introduce evidence of goodwill associated with the use of their trademark. That exclusive use is infringed upon when, in the words of the Act, “...a person not entitled to its use under this Act...sells, distributes or advertises wares or services in association with a confusing trade-mark or trade-name...”.

An infringement is therefore not limited to identical marks, but also includes confusingly similar marks.

In order to bring an infringement action, it is not necessary to establish any kind of loss, which is again different from passing off where there has to be at least a likelihood of damage. There is a presumption that if a confusing trademark is being used, a loss occurs.

Generally, confusion is deemed to have occurred if the use of two trademarks in the same area would lead to the inference that the products or services are manufactured or performed by the same person. The basic test is a variation on the classic “reasonable man” test used in tort litigation. In this case, the question is what the reaction would be of a reasonable consumer who was familiar with one product and subsequently came into contact with the other. Would he or she be “confused”? While it is a test that is fact-based and will vary with the circumstances, the Trade-marks Act sets out some factors that will be considered in assessing confusion:

- The inherent distinctiveness of the trademark and the extent to which it has become known;
- The length of time the trademark has been in use;
- The nature of the wares, services or business; and
- The degree of resemblance between the trademarks in appearance or sound or in the ideas suggested by them.

3. Depreciation of Goodwill

Depreciation of goodwill is another cause of action that is available to owners of registered trademarks. In the words of the Trade-marks Act, this cause of action prevents the “use a trade-mark registered by another person in a manner that is likely to have the effect of depreciating the value of the goodwill attaching thereto”. While this may only be obvious to lawyers, this cause of action is actually a lot broader than regular infringement.



In order to establish regular trademark infringement, the trademark owner has to show that there has been an unauthorized use of their mark (or a confusingly similar mark) when selling, distributing, or advertising goods or services. To establish depreciation of goodwill, the unauthorized use does not have to involve selling, distributing, or advertising goods or services – the cause of action arises from *any unauthorized use* of a mark that may depreciate the goodwill.

That said, proving that a particular use depreciates the goodwill of a trademark is a difficult task, which can usually only be achieved if the trademark in question is very famous.



LET YOUR FINGERS DO THE WALKING



A Federal Court decision in the case of Tele-Direct (Publications) Inc. v. Canadian Business Online Inc. is an example of a Canadian court enforcing trademark protection against a Canadian website operator.

In this case, Canadian Business Online Inc. had set up web sites that provided basic contact information for individuals, companies and institutions including telephone number. The plaintiffs, the owners of the “Yellow Pages” and “Walking Fingers” trademarks, sought and received an injunction restraining the defendants from using the expression “Canadian Yellow Pages on the Internet” alongside a Walking Fingers design on its Internet website. Tele-Direct took the action to defend its “Yellow Pages” trademark and its well-known slogan, *“Let your fingers do the walking”*.

Canadian Business Online was ordered to cease and desist using the term “Yellow Pages” and the walking fingers design.



PART 1 – A TRADEMARK PRIMER

V. What Constitutes Trademark Infringement?

It would be considered an infringement of CREA's trademarks if any of the following rules were not complied with.

1. The Golden Rule

In the world of trademarks, there is one primary rule, one overriding principle from which all-else flows. It can be simply expressed as follows:

“Trademarks must always be displayed in a way that enforces their distinctiveness as registered marks and emphasizes that they are not words of common usage in the English language.”

This is pure logic, and if you understand this Rule, you understand everything there is to know about why users of trademarks must respect them, and why owners of trademarks must be vigilant in monitoring and enforcing proper use.

There are innumerable general rules that flow from this Golden Rule, and apply to all trademarks—for example, you can't combine the trademark with any other text or design, you must comply with sizing restrictions, etc. but most of the rules for use fall under one of these two headings: FORM and CONTEXT.

2. The FORM Rule

The FORM Rule is straightforward. A trademark must always be displayed in the exact form and manner in which it is registered. If a design mark has a required colour scheme, those colours must always be used. If a word is spelled in all capitals, then it must be spelled exactly the same way whenever used.

Adhering perfectly to the FORM Rule requires attention to at least three points:

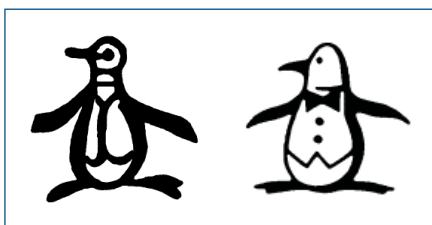
1. Always use the ® symbol to identify a registered trademark and the ™ symbol to identify an unregistered trademark. These symbols traditionally appear on the “shoulder” of the trade mark, i.e. in the upper right hand corner. Canadian trademark law does not require the ® or ™ symbol to be used, but CREA's Rules do require their use;
2. Always spell the word exactly as used in the trademark registration, including using capitals, where required. Always duplicate a logo or design mark in its registered form, ensuring that colour schemes, sizing and any other requirements are respected;
3. Include a notation somewhere on the page on which the trademark is displayed, identifying the owner of the trademark. A note of this sort assists trademark owners in exercising the kind of control required under the Trade-marks Act.

Some people may think that these are picky requirements and that straying from the exact form that a trademark is registered would not have significant consequences. However, there are good reasons why it is important to always use the correct form of a trademark.



First, it reinforces the mark in the minds of consumers. Use of several slightly different variations of a trademark might cause confusion and lead consumers to believe that the wares they are looking at do not come from the supplier in question.

Secondly, using the same form all the time helps ensure that the trademark rights will not be lost. The Trade-marks Act contains provision that provide a registration will be invalid if the mark is abandoned. The use of a mark that is in a different form than what was registered could lead to allegations that the original mark was abandoned. **For example**, in *Promafil Canada Ltée. v. Munsingwear Inc.*, Promafil alleged that Munsingwear’s trademark over the penguin logo on the left below was invalid because they had abandoned that mark and started using the penguin logo on the right.



3. The CONTEXT Rule

The CONTEXT Rule says that a trademark must always be displayed in a way that emphasizes its registered meaning. In other words, whenever readers, for example, come across a reference to a trademark in written text, they should immediately be aware of 2 things:

1. That they are dealing with something more than mere words of the English language (the FORM Rule should ensure this); and
2. The trademark should associate the reader with the owner of the product or service simply from the manner in which it is used.

Jacuzzi®, **for example**, is a registered trademark owned by Jacuzzi Brands, Inc., and is used to identify the hot tubs, whirlpools and other products sold by that company under the Jacuzzi® brand. When the Jacuzzi® mark is being displayed, it must conform to the Form and Context Rules.

WRONG: *“I just bought a new jacuzzi”.*

This violates the FORM Rule as it is not spelled with a capital “J” and does not contain the ® symbol. It also breaches the CONTEXT Rule because it is not written in such a way as to identify the owner of the product, as opposed to the product itself. On the contrary, it is written to make it look like “Jacuzzi” is just another word for “hot tub”-a usage that is extraordinarily dangerous to the trademark.

RIGHT: *“I just bought a new Jacuzzi® hot tub”.*

This sentence clearly identifies the word Jacuzzi® as a trademark and makes it clear that the Jacuzzi® term represents not just a hot tub, but the hot tubs sold by Jacuzzi Brands, Inc.



VI. Consequences of Allowing Misuse

Monitoring and ensuring proper use of trademarks is not just an academic exercise for trademark owners. It is a necessary and crucial strategy directed at protecting an extremely valuable asset. If misuses are allowed to continue, if trademarks are used to identify a “thing” rather than the maker of that “thing” (see Jacuzzi® above), if members of the public come to view a trademark as nothing more than another word in the English language, then all rights in that mark may be lost. Perception becomes reality, and that trademark becomes just another word. And when it becomes just another word, there is no longer any special meaning attributed to it. Nor is there any special protection afforded it. And perhaps most importantly- there is no longer any special value to the mark. It is gone. A corporate asset that may have been worth thousands or millions or tens of millions of dollars, has been lost forever to the owner.

There are literally hundreds, if not thousands, of words in the dictionary that at one time or another were strong, valuable trademarks identifying the owners or creators of products. But they were victims of their own success. Members of the public so identified with the products themselves, that eventually, they lost their distinctiveness.

A **few examples** are:

- Ju Jubes
- Escalator
- Brassiere
- Thermos
- Cellophane

And the list goes on. One lost trademark that should serve as an object lesson to organized real estate is Mortician. The trademark Mortician once referred to an undertaker who was a member of the Mortician’s Association. Every Mortician was an undertaker, but every undertaker was not a Mortician. Eventually, people started referring to undertakers as “morticians”, the terms became synonymous, and were used interchangeably by members of the public. The trademark was not adequately protected, became generic, and all rights to it were extinguished. The similarities to the REALTOR® trademark are striking, and underline the need for constant diligence in defending this very valuable asset of organized real estate.



VII. A Summary of CREA's Trademarks

The Canadian Real Estate Association (CREA) owns a number of marks that are trademarks, and can therefore only be used by CREA, and a number of certification marks that can be used and displayed by CREA members who are licensed practitioners. As the primary purpose of this Trademark Toolkit is to act as a resource for Boards/Associations in establishing trademark compliance programs, the focus will be on CREA's two primary families of certification marks—namely MLS® and REALTOR®. However, the following non-exhaustive list of CREA trademarks and certification marks is included for reference purposes.

1. CREA Trademarks REALTORS® are Licensed to Use

MLS® Family of Marks

The initials “MLS®”.

The phrase “Multiple Listing Service®”.

The **MLS® Design Mark**.
(including Multiple Listing Service® phrase)



The **MLS® Design Mark**.
(without Multiple Listing Service® phrase)



REALTOR® Family of Marks

The word “REALTOR®”.

The word “REALTORS®”.

The **REALTOR® Design Mark**.
(including REALTOR® word)



The **REALTOR® Design Mark**.
(without REALTOR® word) –for use in province of Quebec only





PART 2 – CREA'S TRADEMARKS

REALTORS Care® Family of Marks

The phrase “REALTORS Care®”.

The REALTORS Care® Design Mark:



For more information see www.realtorscare.ca.

The ICX™ Family of Marks

The word “ICX™”.

The logos:



The ICX™ logos, or their French equivalents, may only be displayed in the exact form shown above. No modification in either style or colour is permitted.

The MLS® Home Price Index Logos

The logos:





2. Other Trademarks

(for use only by CREA – cannot be used by members without permission)

CREA

The registered trademark CREA may be used by members only when referring to The Canadian Real Estate Association or its activities, initiatives, products, publications and services.

The mark may not be used in connection with any person or private business or activities, or in any other manner that falsely suggests that the activities of other individuals or groups are associated with or endorsed by The Canadian Real Estate Association.

There are no associated logos for member use. The word mark CREA must only be used with capital letters without periods or gaps. It may not be used by anyone as part of a corporate name or trade name, or in connection with or as part of any other trademark, terminology, or designation.

The French language equivalent, ACI or l'Association canadienne de l'immeuble, is not a registered trademark.

REALTOR Link® Family of Marks

The phrase “**REALTOR Link®**”.

The phrase “**Lien IMMOBILIER^{MC}**”.

The logos:

DDF®

The word mark “**DDF®**”.

The French language equivalent, “**SDD^{MC}**”.

Members may use the DDF® mark provided they comply with the following rules:

1. The letters DDF® must all be capitalized and followed by the registered trademark symbol;
2. The DDF® trademark can only be used by members of CREA to indicate their participation in the CREA DDF®;
3. Use of the DDF® mark must be accompanied, where possible, with the following statement “The trademark DDF® is owned by The Canadian Real Estate Association (CREA) and identifies CREA’s Data Distribution Facility (DDF®)”.



PART 2 – CREA'S TRADEMARKS

WEBForms® Family of Marks

The word “**WEBForms®**”.

The logos and their French equivalents:





VIII. Identifying Improper Uses of the MLS® and REALTOR® Certification Marks – A Four Step Procedure

Let's look at the right and wrong ways of using the MLS® and REALTOR® certification marks.

NOTE: These considerations apply only to uses by CREA members. The idea being that members have the right to display the marks, and the question is whether that display conforms to CREA's Rules and policies. If the use is by a non-member, it is not necessary to go through this analysis. A non-member has no right to use the marks, and that is the end of the discussion. It is not necessary to look at "how" the marks are used.

Whenever you are asked to look at a particular use of the MLS® or REALTOR® marks, you must go through the following steps:

1. Know what MLS® and REALTOR® mean

Enforcing a trademark you don't understand is like trying to speak a language you never heard before. Without that basic background information, you are fumbling in the dark, and you will get nowhere. How can you tell if a mark is being improperly used to mean something other than its registered meaning when you have no idea what that registered meaning is? That may sound trite, but the fact is that much of the uncertainty that exists surrounding the use of these marks results directly from a complete lack of understanding as to what they mean. So begin at the beginning—learn the meaning of the marks.

2. Determine if the marks are used in the correct form

Does the manner of use comply with all three requirements of the FORM Rule?

3. Determine if the marks are being used in the correct context

Does the manner of use comply with the CONTEXT Rule that states that the actual meaning of trademarks must be obvious from the context of its use? **For example**, would a consumer looking at this use of REALTOR® ever think that it means "real estate agent". If yes, the context rule has been offended.

4. Determine if use of the marks complies with CREA's policies

In addition to the "general" trademark rules, CREA has developed specific restrictions that appear in CREA's Rules and various trademark policies. These include, **for example**, rules for use of the marks in domain names, e-mail addresses, meta tags and business names.

The following sections of this Toolkit will take you through these steps in more detail.



PART 2 – CREA'S TRADEMARKS

IX. Applying the Four Step Procedure

1. The Meaning of the Marks

The meaning of the MLS® Marks

The four MLS® certification marks were registered at different times, with the earliest registration taking place in 1959. However, the MLS® marks have been used since at least 1954—over half a century ago—to describe the standard of service provided by members of organized real estate.

And this is the important point—as certification marks, the MLS® marks must refer to a standard of service, and not to a “thing”. The MLS® marks do not identify a computer database of real estate listings or any product related to how a database works.

The meaning of the four MLS® Marks is set out in **Rule 9.2.3** of CREA's Rules as follows:

9.2.3 The MLS® Marks identify professional services rendered by members in good standing of CREA to effect the purchase and sale of real estate as part of a “plural system arrangement”, also known as a co-operative selling system (the “MLS® Services”), in compliance with CREA's By-Laws and Rules, and the REALTOR® Code as amended from time to time, and in compliance with all applicable federal and provincial/territorial laws and regulations. The MLS® Marks do not identify or describe a computer database of real estate listings.



Trademark protection has been an issue since ads like this appeared in the 1950s.

MLS® versus “MLS® System”

The co-operative selling systems operated by real estate Boards under the MLS® certification marks are critical to the provision of MLS® Services. These systems contain the real property listings of member brokers, and are unique in the commercial world in the sense that competitors are sharing their inventory with each other, all for the purpose of better serving the consumer.



CREA, as the owner of the MLS® marks, licenses its member real estate Boards to use those marks in association with the operation of their co-operative selling systems. Accordingly, the proper identification of these systems is “MLS® Systems”.

Having said that, it is important to understand that the power of a Board’s MLS® System does not come from the number of listings in the database or the computer functionality. The power of an MLS® System emanates from the underlying standards of the MLS® mark that are applied to its operation. Those members who access the MLS® System do so to provide a high standard of service in accordance with the MLS® mark –the MLS® Services.

Describing an MLS® System as a “database” is akin to describing the theory of relativity as a “bunch of numbers”. It is so much more.

Rule 9.2.4 of CREA’s Rules contains a proper description of an MLS® System:

9.2.4 An MLS® System is a co-operative selling system operated and promoted by a Board or Association in association with the MLS® Marks. An MLS® System includes an inventory of listings of participating REALTOR® members, and ensures a certain level of accuracy of information, professionalism and co-operation amongst REALTOR® members to effect the purchase and sale of real estate.

The standards inherent in the MLS® Marks and the operation of MLS® Systems include the integral concepts of membership in organized real estate, agency, co-operation, and offers of compensation.

Why are we spending so much time explaining the differences between these concepts? The distinction is critical because trademarks must always be used to clearly reflect their registered meaning. Failure to do so weakens the marks and may result in trademark rights being lost. Every time someone refers to a Board’s MLS® System as “the MLS®”, or defines MLS® as being a database of listings, they are pounding another nail into the coffin of the MLS® marks.

Why? For a multitude of reasons: MLS® is not a “noun”—It is not a “thing”—it is a certification mark and as such is only being properly used when it is used as an adjective. Secondly, MLS® refers to a standard of service—the MLS® Services—not a listing system. Even if MLS® were the proper term to refer to a Board’s MLS® System (which it is not), that system is not a “database of listings”. It is a co-operative selling system operating under the MLS® certification mark.

Proper use is incredibly important. And proper use requires an understanding of the meaning of the marks.

The Meaning of the REALTOR® Marks

The REALTOR® family of certification marks has a long and checkered history, both in Canada and the United States. The term has been used by the National Association of REALTORS® (NAR) in the U.S. since 1916, and by CREA, or its Boards, since at least 1921, to identify members of organized real estate who adhere to a Code of Ethics.

Historically, both CREA and NAR took steps to protect the REALTOR® mark in their respective countries for the mutual interests of both. Many facets of organized real estate developed more or less simultaneously in both countries, and the issues of consistent usage of the REALTOR® mark on both sides of the border has been a constant focus of concern in terms of protecting the distinctiveness of the marks.



PART 2 – CREA'S TRADEMARKS

The REALTOR® family of marks is owned in Canada by REALTOR® Canada Inc. (RCI), a non-profit company owned equally by CREA and NAR. This “split ownership” was undertaken to effectively protect and strengthen the REALTOR® marks in the United States and Canada and to make the meaning of the term uniform and consistent in the two countries.

The Shareholders Agreement within RCI provides that CREA controls all aspects of licensing REALTOR® in Canada. On the other side of the coin, the obligation to monitor and protect the mark in Canada is the responsibility of CREA and its member real estate Boards and provincial Associations.

The trademark legislation in the United States recognizes something called “collective membership marks”, which refer to persons. So NAR has registered REALTOR® to mean “member of the National Association of REALTORS®”. That’s nice and neat and simple.

Things are less neat and simple in Canada, however, because no such designation exists in our Trade-marks Act. Organizations wishing to identify “members” must do so through the use of certification marks. As discussed in **Part I**, certification marks refer to a standard of service provided by an identified group of people.

Since the REALTOR® registration in Canada cannot directly identify a “member”, it instead refers to the standard of brokerage services provided by members of CREA. In effect, it identifies members based on the services they provide.

But the branding of the REALTOR® marks go beyond pure service. REALTOR® is synonymous with professionalism. And professionalism means at least three things –service, competence and ethics. All three are essential ingredients in the REALTOR® recipe:



Competence is a result of education and training;

Service includes the provision of the MLS® Services discussed above;

Ethics, as established by the REALTOR® Code, governs the essence of how a REALTOR® provides this service and the relationship between a REALTOR® and the public.

The “standards” inherent in a certification mark are found in these elements. And that leads to what the REALTOR® certification mark has come to mean in organized real estate—a real estate professional who is a member of The Canadian Real Estate Association and, as such, subscribes to a high standard of professional service and a strict Code of Ethics.

What REALTOR® absolutely does not mean is “real estate agent”. It identifies only membership in CREA. It is not a synonym for salesperson, broker, or any other job that a real estate practitioner does. Any reference to REALTOR® in a context where a consumer might interpret the terms as meaning “real estate agent” is a misuse of the mark that could result in it becoming generic.



2. Applying the FORM Rule

REALTOR®, REALTORS®, MLS®, and Multiple Listing Service®

The 3 elements of the Form Rule are:

1. The marks must be spelled exactly as registered
 - This means that the words MLS® and REALTOR® are to be spelled all in capitals, as are the first letters in Multiple Listing Service®; and
 - The marks cannot be distorted;
 - The mark REALTOR® should not be hyphenated (REAL-TOR), abbreviated (RLTR), expanded upon (REALTORIFIC), or combined with other words (REALTOR-Assistant or non-REALTOR).
2. The ® registration symbol must be displayed in superscript with every use of the marks;
3. Trademark ownership text must be included with the marks, where possible. The only exception is where the medium doesn't allow for such a statement (e.g. a REALTOR® pin).
 - The trademark ownership text for the REALTOR® marks is as follows: "The trademarks REALTOR®, REALTORS® and the REALTOR® logo are controlled by The Canadian Real Estate Association (CREA) and identify real estate professionals who are members of CREA. Used under license."
 - The trademark ownership text for the MLS® marks is as follows: "The trademarks MLS®, Multiple Listing Service® and the associated logos are owned by The Canadian Real Estate Association (CREA) and identify the quality of services provided by real estate professionals who are members of CREA. Used under license."

A few **examples** of "form" problems are listed below for illustrative purposes. They are not by any means intended to be all-inclusive. The examples are endless. For the purposes of this illustration, it is assumed that the trademark "statement" set out above is included.



PART 2 – CREA'S TRADEMARKS

Some Improper “Form” Uses

WRONG	WHY
mls	1. All letters must be capitalized (MLS). 2. The ® registration symbol is missing.
M.L.S®	The MLS® mark does not contain any periods.
ML [®] S®	The mark cannot be distorted.
realtor	1. All letters must be capitalized. 2. The ® registration symbol is missing.
Realtor®	All letters must be capitalized.
REALTOR®-Assistant	CREA's marks must never be combined with any other words or designs.
realtor.ca	The REALTOR® term must be capitalized when referring to CREA's website – REALTOR.ca.
REALTOR [®]	The mark cannot be distorted.

Design Marks

The design marks must also be used in the same form as they were registered. This is set out in CREA's **Rules 9.5.2.4**, which states “the MLS® and REALTOR® logos must only be used, reproduced, and displayed in the form as registered”.

While the REALTOR® and MLS® design marks each have their own required elements, there are two very important restrictions that apply to both:

- The design marks must never be altered, reshaped, distorted or combined with any other logos in any way.
- The design marks must never be used as hypertext links to REALTOR.ca

To avoid inadvertent infringements, members are encouraged to only use the authorized versions of the design marks, which are available for download on REALTOR Link®. Buttons to use as hypertext links to REALTOR.ca are also available on the same site.

It would also be a misuse of the design marks if they were combined with other words or designs.

PART 2 – CREA'S TRADEMARKS



The MLS® design is generally described as three identical shaped boxes designed to look like a house, rising to a point at the top. The letters “M”, “L” and “S” are each located in one box in that order, in bold block letters. If the full designation of “Multiple Listing Service®” is used, the words must be printed all capitals in block to fit exactly below the three “houses”, followed by the ® superscript.

The standard colour combinations involve the left and right boxes in solid red, with the letters “M” and “S” in white. The centre box is outlined in black, with the letter “L” also in black. Members are encouraged—but not required—to use this original black, white and red design (graphically referred to as black and one colour). A display using black only is also permitted.

WHAT'S WRONG WITH THIS PROMO?

Mike Likely Serves
up the power of



ANSWER

The MLS® initials must never be used to create a new logo or design, or as part of “branding”. The logo must also never be combined with any other logo.

The official REALTOR® logo consists of an “R” in the Futura font, or typeface, on a contrasting rectangular background to form a block “R”. The word REALTOR® is then centered under the rectangle. Only members in Quebec are permitted to use the REALTOR® “R” logo without the term REALTOR® below the “R” block.

The dimensions of the rectangle, the size of the Futura “R” in relation to the rectangle’s dimensions, and the length and font size of the word REALTOR® are important design features of the REALTOR® logo. So is the space between the rectangle and the word REALTOR®. You can reduce the size of the overall logo to meet the needs of the intended application, but it must never be reduced to the point where the word REALTOR® cannot be read.

There is no official colour for the REALTOR® logo, but the following 3 rules must be adhered to:

1. Any 2-colour combinations may be used but the colours must be sharply contrasting.
2. The block surrounding the “R” and the REALTOR® term must be the same colour (i.e. if the block surrounding the “R” is black, then the REALTOR® term must also be black).
3. The “R” must be a sharply contrasting colour to the block and the REALTOR® term. If the block is dark, the “R” should be light. It is preferable, but not required, to have the “R” the same colour as the paper background.







If you are using the logo on a dark background and intend to reverse the logo elements, make sure you reverse ALL of the elements. The usual colours must be reversed so both the rectangle and the word REALTOR® appear in a light colour on the dark background.

The REALTOR® logo must be separated from other logos or lettering, designs or emblems by a minimum distance of one-half the width of the rectangle, or “block R”. If the block “R” is one inch wide, it must be a half-inch away from any other logo. The logo must never be framed or outlined.



PART 2 – CREA'S TRADEMARKS

Below are some **examples** of how the design marks can be misused.

WRONG	WHY	RIGHT
	The mark is distorted to extend the text beyond the houses.	
	The mark is combined with other words.	
	An extra frame has been added around the outside of the mark.	

3. Applying the **CONTEXT** Rule

The “Form” requirements are fairly straightforward in the sense that they are purely visual. You can look at the way a mark is written and, without a lot of effort, determine whether or not it complies with the way it is “supposed to look”.

The “Context” rule, however, is more complicated, because it is directed not just at the way the mark looks, but at the message it conveys. When someone looks at what has been created, does the registered meaning of the mark jump out at him or her? Or is some other meaning implied?

This is much more subjective and subtle, and requires thoughtful consideration. In fact, many people are only aware of the form requirement and give no thought to context. They take great care to make sure capitals are used in the lettering, but pay no attention at all to the message they are conveying with the way they use the mark.

PART 2 – CREA'S TRADEMARKS



MLS®

The message that the MLS® marks are supposed to convey to consumers is set out in **CREA's Rule 9.5.5.1**:

The MLS® Marks must only be used to identify the professional services provided by Members of CREA to effect the purchase and sale of real estate as part of a "plural system arrangement," also known as a co-operative selling system. The MLS® Marks must never be used as a synonym for a "database of real estate listings."

The key here is that the MLS® trademark should convey the notion of "MLS® Services", not the idea of a database. MLS® is an adjective, not a thing, and therefore should never be used as a noun. Saying that a person has posted a listing on "the MLS®" is an example of using the MLS® trademark as a noun and in a manner that suggests it represents a database, both of which are unacceptable. Every time someone refers to a Board's MLS® System as "the MLS®" or defines MLS® as being a database of listings, they add to consumer confusion and detract from the value of the mark.

Advertisements that refer to the MLS®# of a property listed on a Board's MLS® System also perpetuate the false belief that the MLS® trademark refers to a database of listings as opposed to cooperative services of REALTORS®. For this reason, it is recommended that advertisements of properties listed on MLS® Systems refer to ID# or Listing# instead of MLS®#.

As **CREA's Rule 9.5.5.2** provides that, when referring to a cooperative selling system, the proper terminology is the MLS® System of the Board or Board's MLS® System. This is how the marks should be used in their correct context.

CREA's Rule 9.5.5.3 also establishes ground rules for using the MLS® marks in the correct context. It provides that the MLS® marks must never be used as part of a business name, trade name, or corporate branding. This means that the mark must not be combined with other words to create slogans or product names, such as "flat fee MLS®".

Below are some **examples** of incorrect usage of the MLS® marks and explanations of how those uses could be corrected.

WHAT'S WRONG WITH THIS PROMO?

ANSWER

The MLS® mark cannot be used in combination with other letters or another mark to "create" something else. In this case MLS® is also being used as a noun, which is also not permitted.



PART 2 – CREA'S TRADEMARKS

Some Improper “Context” Uses of MLS®

WRONG	WHY	RIGHT
“I placed a listing on the MLS®.”	<ol style="list-style-type: none">1. MLS® is NOT a NOUN. It is a certification mark identifying a standard of services and must always be used as an ADJECTIVE. References to “the MLS®” are ALWAYS wrong.2. MLS®, by itself, is never to be used to identify a real estate board’s co-operative listing system.3. CREA’s Rules define a Board’s listing system as an “MLS® System. And, when using the term “MLS® System”, you must clearly be referring to a real estate Board.	“I placed a listing on the Ottawa Real Estate Board’s MLS® System.”
“ABC Realty just set up their own MLS® System (or Multiple Listing Service®).”	Only a member real estate Board is licensed by CREA to operate an “MLS® System”. Any company or individual can operate a property listing website or database, but it is NOT an MLS® System unless it is operated by a real estate Board under license with CREA.	“ABC Realty just set up their own listings site.”
“Remember this name for all of your real estate needs - Mary Louise Smith. ”	The MLS® mark cannot be combined with other words or designs to create another image or branding.	“Remember this name for all of your real estate needs - Mary Louise Smith.”
Mr. MLS®	<ol style="list-style-type: none">1. This is another attempt to develop a personal “branding” using the MLS® certification mark by combining the mark with text to “create” something else, which is not permitted.2. MLS® is being used as a noun.3. MLS® is a mark identifying the quality of services rendered by a group of people. It is improper for an individual to imply in advertising that he or she somehow has “better” access to the mark than someone else.	N/A
“Ultimate MLS®”	<ol style="list-style-type: none">1. MLS® is being used as a noun, which is not permitted.2. Never use adjectives with certification marks as adjectives tend to give the marks a generic meaning –a “thing” rather than a certification mark.	N/A
MLS® Explorer (as computer program name)	The MLS® mark cannot be used in “product” or program names. MLS® is being used as a noun.	N/A
Flat Fee MLS®	The MLS® mark cannot be used as a product name.	Flat Fee Listings

PART 2 – CREA'S TRADEMARKS



REALTOR®

The correct context for using the REALTOR® trademarks is set out in **CREA Rule 9.5.4.1:**

The REALTOR® Marks must only be used to identify the real estate brokerage services and related professional services provided by members of CREA. The REALTOR® Marks must never be used as a generic or descriptive name to identify a salesperson, broker, or other real estate professional.

REALTOR® does not mean salesperson, broker, real estate agent, or any other job that a real estate practitioner does. Any use of the mark that implies “real estate agent” instead of “member of CREA” is wrong.

The REALTOR® certification mark is really intended to be a stand-alone mark. It should be displayed on its own in letterhead and on business cards to identify the individual as a member of CREA. It should never be used with adjectives, like in “green REALTOR®”. In fact, to really reinforce the meaning of the marks, an ideal usage would be to follow the use of REALTOR® with the word “agent”. This would help convey the message to consumers that REALTORS® are more than just real estate agents – they are members of CREA.

Like the MLS® marks, the REALTOR® marks must never be used as part of a business name or trade name or corporate branding (see **CREA Rule 9.5.4.2**). This means that the REALTOR® marks can never be used in slogans, product names, or business names. Members of CREA can use the REALTOR® marks in association with their name, but not as part of their name.

For example, a person could have on their business card “ABC Realty, REALTORS®”, but they could not use “ABC REALTORS®”.

What follows are some **examples** of misuses of the REALTOR® trademarks and explanations of how those uses can be corrected.



Use of REALTOR® logo as stand alone mark on business card.



PART 2 – CREA'S TRADEMARKS

Some Improper “Context” Uses of REALTOR®

WRONG	WHY	RIGHT
Top Selling REALTOR® The Community REALTOR® The Virtual REALTOR® Your Toronto REALTOR®	Never use adjectives with the REALTOR® mark. Adjectives give the mark a generic meaning. Consumers read that as meaning “top selling real estate agent”, which is an infringement.	Top Selling Salesperson The Community Real Estate Professional N/A Your Toronto Real Estate Professional
REALTOR® Connection REALTOR® Products	Never use REALTOR® in product or program names.	N/A
ABC REALTORS®	REALTOR® can be used in conjunction with a corporate name, but cannot be part of the name. In other words, you can display the REALTOR® mark after the corporate name, with proper punctuation separating it, but you cannot include the certification mark in the name itself.	ABC Realty, Inc, REALTORS®
“What do I do for a living? I’m a REALTOR®.”	REALTOR® is not a job description. It does not identify what someone does to earn a living. It identifies a person as a member of CREA. Using the mark to mean “real estate professional” is an infringement.	“What do I do for a living? I’m a real estate professional. I’m also a REALTOR®.”
REALTOR® king	Members can only use the REALTOR® mark in association with their name, preferably separated by punctuation.	John Doe, REALTOR®



4. Determine if use of the marks complies with CREA's policies

CREA's Rule 9.7.1 states that CREA's trademarks shall not be used in domain names, email addresses, meta-tags or other Internet search fields unless specifically authorized by CREA's Policies. The question is: what do CREA's policies allow?

Use in Domain Names and E-mail Addresses

All of the Form and Context Rules are violated when trademarks are used in domain names, with the result that the marks are weakened. For that reason, CREA has developed specific policies for use of the MLS® and REALTOR® family of marks on the Internet.

The policies provide as follows:

1. MLS® and Multiple Listing Service® must never be used by members in domain names or e-mail addresses.
2. REALTOR® and REALTORS® can be used in domain names only in conjunction with the name of the member or the member's firm and ideally separated by punctuation. The use of punctuation, particularly a dash, visually sets off or distinguishes the REALTOR® mark from the balance of the domain name or email address. This highlights the significance of REALTOR® as describing the "class of persons" offering the service, which is precisely what the REALTOR® mark is intended to convey. To some extent this message gets lost if there is no punctuation. They can never be used alone or with geographical, descriptive or other modifiers.
3. None of the marks can never be used in meta tags, in the name of any website computer directory, or as sponsored keyword search terms.
4. In all advertising where the domain name is displayed, there must be an acknowledgment that the terms are trademarks of The Canadian Real Estate Association.

Some **examples** of proper and improper use of REALTOR® and REALTORS® in domain names are as follows:

Improper Use in Domain Names	Proper Use In Domain Names
<p>www.calgaryrealtor.ca</p> <p>www.professionalrealtor.ca</p> <p>www.simontherealtor.ca</p>	<p>www.johndoerealtor.ca</p> <p>www.johndoe-realtor.ca</p> <p>www.remaxseasiderealtor.ca</p> <p>www.remaxseaside-realtor.ca</p>
Improper Use in E-mail Address	Proper Use in E-mail Address
<p>realtor4@rogers.com</p> <p>superrealtor@shaw.ca</p> <p>thebestrealtors@sympatico.ca</p>	<p>johndoe-realtor@sympatico.ca</p> <p>johndoerealtor@sympatico.ca</p>



PART 2 – CREA'S TRADEMARKS

Use in Social Media

MLS®

Members are not permitted to use the MLS® and Multiple Listing Service® trademarks in their user names, email addresses or other forms of identification information in Social Media.

The MLS® and Multiple Listing Service® trademarks may be used in a tweet or posting on Social Media provided they comply with all of the general form and context rules. In particular:

1. The marks must be spelled exactly as registered. The term MLS® is to be spelled all in capitals, as are the first letters in Multiple Listing Service®.
2. The ® registration symbol must be displayed with every use of the marks.

When using the MLS® and Multiple Listing Service® trademarks in a tweet or posting, members are encouraged to include a statement that MLS® and Multiple Listing Service® are trademarks of The Canadian Real Estate Association, where possible.

Some **examples** of proper and improper use of MLS® in Social Media are as follows:

Example	Improper Use in Social Media	Proper Use in Social Media
Facebook Professional Page Name	ABCRealtyMLS	N/A
Twitter user name	@ABCRealtyMLS	N/A
In Facebook posting or Tweet	"I placed a listing on the Ottawa Real Estate Board's mls® System."	"I placed a listing on the Ottawa Real Estate Board's MLS® System."
In Facebook posting or Tweet	"I placed a listing on the Ottawa Real Estate Board's MLS System."	"I placed a listing on the Ottawa Real Estate Board's MLS® System."

PART 2 – CREA'S TRADEMARKS



REALTOR®

The REALTOR® trademarks may be used in user names, email addresses and other forms of identification information in Social Media. All of the general context and form rules apply, with the following exceptions:

1. The REALTOR® trademarks do not need to be entirely capitalized.
2. The ® registration symbol does not need to be displayed with every use of the marks.

Although not required, members are encouraged to use capitalization and the ® registered symbol in user names, email addresses and other forms of identification information where possible.

The REALTOR® trademarks may be used in a tweet or posting on Social Media provided they comply with all of the general form and context rules. In particular:

1. The marks must be spelled exactly as registered. The terms REALTOR® and REALTORS® are to be spelled all in capitals.
2. The ® registration symbol must be displayed with every use of the marks.

Members are encouraged to include a statement that REALTOR® is a trademark of The Canadian Real Estate Association, regardless of how the REALTOR® trademarks are used in Social Media, where possible.

Some **examples** of proper and improper use of REALTOR® and REALTORS® in Social Media are as follows:

Example	Improper Use in Social Media	Proper Use in Social Media
Facebook Professional Page Name	ABCRealtyTorontoREALTORS JohnDoeTopSellingREALTOR	ABCRealty, Realtors John Doe, Realtor
Twitter user name	@JohnDoeTopSellingREALTOR	@JohnDoe_REALTOR
In Facebook posting or Tweet	I am a real estate professional. I'm also a realtor®.	I am a real estate professional. I'm also a REALTOR®.
In Facebook posting or Tweet	I am a real estate professional. I'm also a REALTOR.	I am a real estate professional. I'm also a REALTOR®.



PART 2 – CREA'S TRADEMARKS

X. Use of the MLS® and REALTOR® Certification Marks by Boards and Associations

1. Letterhead and Business Materials

Member real estate Boards and provincial Associations may display the REALTOR® and MLS® design marks on their business material in the same manner as other members.

The one exception to this rule is that real estate Boards that do not operate MLS® Systems or otherwise provide their members with access to an MLS® System are not permitted to display the MLS® marks. This restriction does not apply to provincial Associations.

2. REALTOR® in Board/Association Names

Real estate Boards and provincial Associations may incorporate REALTOR® or REALTORS® as part of their business names. Realty firms are not permitted to do this, but an exception is carved out for Boards and Associations, provided that they have received the approval of CREA and have signed a license agreement for the use. Real estate Boards are also required to obtain the permission of the appropriate provincial Association.



3. Domain Names and E-mail Addresses

Real estate Boards and provincial Associations may use the MLS® marks in their domain names and e-mail addresses, provided firstly that they are used in conjunction with appropriate geographical modifiers, and secondly that they are separated from other text by punctuation. A license agreement with CREA must also be signed. Boards and Associations that have REALTOR® or REALTORS® as part of their business name, may use domain names and email addresses that include their name, provided that a license agreement with CREA has been signed.

4. Board/Association Logos and Awards

The REALTOR® and/or the MLS® design marks may be incorporated into a Board/Association logo, provided the design has been pre-approved by CREA and a license agreement with CREA has been signed. The word "REALTOR" may, at the option of the Board/Association, be removed from the block "R" REALTOR® logo for this purpose.



REALTORS®
Association of
Edmonton



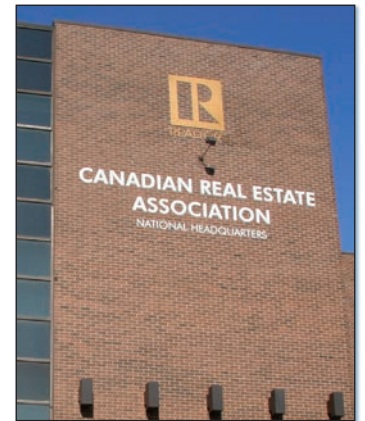
PART 2 – CREA'S TRADEMARKS



Some Boards/Associations may also wish to develop other types of branding, such as design marks for award designations. As an example, a Board/Association may give out performance awards that incorporate CREA's trademarks, such as "MLS® Award" or "REALTOR® Excellence Award". These terminologies always require CREA's approval and, at CREA's option, the signing of a license agreement. This is particularly important where the designation includes a design element.

5. Names of Buildings or Publications

Boards and Associations may incorporate REALTOR® or REALTORS® into the name of its building, the titles of its publications, and educational courses, provided that CREA has approved each use in writing and the involvement of the Board or Association is noted with each use.



6. Incentive Items

Boards/Associations may display the MLS® and REALTOR® marks on incentive and promotional material such as clothing, pens, etc...provided the name of the Board/Association is included on the material.





PART 2 – CREA'S TRADEMARKS

XI. Use of the MLS® and REALTOR® Certification Marks by Non-Members

1. General

Non-members are never authorized to use the marks. Only licensed real estate practitioners who belong to CREA (i.e. REALTORS®) are authorized to display the MLS® and REALTOR® marks. The marks may not be displayed by persons in other categories of Board membership (e.g. affiliate members), nor may they be displayed by non-members. When a non-member is using the marks, all of the policies and guidelines for proper use of the trademarks are irrelevant. It doesn't matter if the use would comply with the guidelines if used by a member.

Common unauthorized uses by non-members appear in various forms, including use of the trademarks in non-member trade names, corporate names, newspaper ads, business cards, website, letterhead, domain names and e-mail addresses, or in various forms of advertising. In addition, unauthorized uses may take the form of imitations or variations of the logos or the word marks.

Remember, however, that some trademark use may be unauthorized, but is known as permissible "collateral use". **For example**, a non-member broker cannot use the REALTOR® or MLS® marks in his advertising or on his website in a manner that implies an association with those marks or a right to use them.

However, it would be acceptable for the broker to state on his website that he was not a member of a real estate Board and therefore was not a REALTOR® and was not able to access an MLS® System. He is, in this case "displaying" the marks, but is not "using" them in the trademark sense because he is only referring to them for the purposes of clarifying to the reader that he is not an authorized user of the marks. This type of use is not an infringement.

Non-members working with members may say that a real estate company that is a member of a real estate Board has placed a listing for the property on a real estate Board's MLS® System. **For example**, a seller could say the following in an advertisement: "ABC Realty has placed a listing for this property on the MLS® System of the XYZ Real Estate Board, under N°. 123456". However, REALTOR® members are personally responsible for any improper use or display of CREA's trademarks by non-members with whom they have contracted. In those situations, REALTORS® must, pursuant to **Rule 9.4.3**:

- enter into a written agreement with the non-member;
- ensure that the written agreement requires the non-member to comply with these restrictions; ensure that the written agreement gives the member the right to terminate the agreement if the non-member violates these restrictions; and
- the member must terminate the agreement in the event of unrectified breaches.



2. Media

Editors, publishers and broadcasters-including publications catering to the real estate industry- improperly use CREA's trademarks with frightening regularity. Even more distressing, many of the articles involve CREA members or even CREA Boards and Associations, where the opportunity existed to correct the improper uses before the offending article or interview was ever published or aired, yet the opportunity was lost.

Most newspapers follow the Associated Press or United Press Style Books in preparing news items for publications. These stylebooks do not call for use of full capitals or a federal registration symbol "®" even for registered marks.

To acknowledge the reality of this limitation, CREA's **Rule 9.5.3.1** allows the media to display REALTOR® by only capitalizing the "R". The Rule also provides that the ® is not necessary.

NOTE: CREA Rules only allow a limited exception to the Form Rule. It is still critical that whenever the word is used, it conforms to the Context Rule and clearly refers to membership in CREA. If the usage implies "broker" or "salesperson" or any other "job" a real estate professional does be sure the context of usage is proper.

Similarly, the MLS® mark may be used by media without the ® symbol. However, there is no other exception from the Form Rule, and it must be displayed all in capital letters. As with REALTOR®, there is no exception to the Context Rule. It must always be used in media in a manner that emphasizes its proper trademark meaning. This includes ensuring that Boards' MLS® Systems are never referred to as "MLS®'s" or "the MLS®".

Each time a Board/Association interacts with the media the trademark message should be at least included in the communication. This should include passive messages such as including the definition of the term REALTOR® and Multiple Listing Service® or MLS® on releases provided to the media.



PART 3 – A TRADEMARK PROTECTION AND COMPLIANCE PROGRAM FOR BOARDS/ASSOCIATIONS

There are at least 3 essential elements to an effective trademark compliance program:

1. An internal audit
2. Ongoing member audits
3. An effective enforcement process

XII. Conducting an Internal Audit

Before a Board can start seeking out improper trademark uses amongst its members, it is critical that it takes a good hard look at how it is using the marks itself. Based on the “physician, heal thyself” principle, putting your own house in order is always a good first step to asking others to clean up theirs.

This is good business practice for 2 reasons. Firstly, it is an educational opportunity. The best way of learning the trademark rules is to actually apply them. It is very easy to fall into questionable usage practices, and many Boards will surprise themselves by discovering a host of trademark uses that do not comply. By going through the processes of analyzing the Board’s use of the trademarks, the Board staff is learning by doing. This will be an enormous asset in dealing with member use.

Secondly, members who are asked to correct trademark problems in their own business or promotional material will be quick to point out any irregularities with Board uses, and that will erode the Board’s “moral high ground” in asking for member compliance. We don’t have the luxury of saying “do like I say, not like I do”.

An internal audit does not have to be a complicated process. Think of it as a little look around to see what’s going on. It’s a relatively simple matter of determining what uses are made of CREA’s certification marks by the Board, and ensuring that they all comply with the usage guidelines.

Obviously, if this audit is undertaken with absolutely no concept of what constitutes a trademark infringement, what uses are allowed by CREA’s policies and what uses require license agreements, you are wasting your time. But if you understand the general rules and the allowable Board uses outlined in this Toolkit you should be able to quickly identify any problems.

The areas of review would include:

- Board Name;
- Board Logos;
- Letterhead;
- Board Newsletters, Publications, Educational Courses;
- Board Websites.



1. Board Name

If the REALTOR® mark (or a variation of the mark) is part of the Board name, ensure that:

- CREA's approval was obtained prior to using the name;
- A license agreement for the use of REALTOR® in the name has been executed;
- REALTOR® complies with the "Form" rule in that it is spelled all in capitals and includes the ® registration symbol.

NOTE: The Corporations Branch of the applicable government agency responsible for registering corporate names may not allow the "®" symbol to accompany the corporate name for registration. That's fine. However, the "®" symbol must appear in all uses of the name on business and promotional material, as well as websites.

2. Board Logos

There are 2 logo situations—a design mark developed to identify the Board, and other design marks or phrases used by the Board to identify specific services or awards (e.g. "The Million Dollar MLS® Club" or the "REALTOR® Achievement Award").

If the Board incorporates any of CREA's trademarks—including both word and design marks—then the Board must ensure that:

- CREA's approval was obtained prior to using the design or the phrase;
- A license agreement for the use of REALTOR® or MLS® in the design or phrase has been executed;
- The REALTOR® or MLS® word (if applicable) complies with the "Form" rule in that it is spelled all in capitals and includes the ® registration symbol;
- The REALTOR® or MLS® design mark (if applicable) conform CREA's design mark specifications.

NOTE: CREA permits the word "REALTOR®" to be removed from the logo for the purpose of incorporating the logo into a Board/Association logo.

3. Letterhead

Does the Board display any of the REALTOR® or MLS® family of marks on letterhead or other promotional material? If yes, the Board must ensure that:

- The word or design marks conform to CREA's guidelines for proper usage (capital letters for the word marks, proper size and colour contrast for the design marks, ® registration symbol with all marks);
- The marks should always be used in a "stand-alone" fashion, in that they are not combined with any other text or design.



PART 3 – A TRADEMARK PROTECTION AND COMPLIANCE PROGRAM FOR BOARDS/ASSOCIATIONS

4. Board Newsletters, Publications, Educational Courses

These documents must be reviewed with 2 things in mind:

1. Do any of CREA's trademarks appear in the title of the publication (e.g. "The REALTOR® Connection")? If yes, ensure that CREA has approved the use in writing.
2. Are any of CREA's trademarks used in the body of the publication? If yes, ensure that:
 - The REALTOR® or MLS® words comply with the "Form" rule in that it is spelled all in capitals and includes the ® registration symbol;
 - The REALTOR® or MLS® word comply with the "Context" rule in that no-one reading it would mistake the word REALTOR® for "real estate agent" or MLS® for a "database". Ask yourself these questions -Have you properly used the term "MLS® System" to identify your listing system? Have you improperly used MLS® as a noun (e.g. "our members access the MLS®...");
 - All design marks conform to CREA's design mark specifications.

5. Board Websites

Domain Names

Does the Board own domain names or e-mail addresses that contain the MLS® or REALTOR® marks? If yes, ensure that:

- CREA has pre-approved the use;
- A license agreement with CREA has been signed.

NOTE: CREA's MLS® marks may only be used in Board domain names and e-mail addresses in conjunction with a geographical modifier AND a separation between the MLS® mark and any other words (e.g. www.toronto-mls.ca). While Boards are encouraged to buy "offending" domain names (www.topsellingrealtor.com, www.ultimatemls.com etc...) in order to protect them, they are not allowed to activate those names or have them point to the Board's website.

Content of Website

Review the interior of the Board website in the same manner as you would with publications, as discussed above. The Board website is another advertising vehicle and subject to the same usage guidelines.

NOTE: All publications intended for consumer use and all websites that contain the REALTOR® or MLS® marks:

- **must include the disclaimer "Trademark owned or controlled by The Canadian Real Estate Association. Used under license".**
- **should include a definition of what a REALTOR® is, what MLS® means, and what an MLS® System is.**

This audit process may initially take some time, but should only need to be done once in this kind of detail. It is essential that Board staff be educated on proper trademark use, and become familiar with CREA's policies for use, as well as this toolkit. Going forward, then, basic maintenance should be all that is required.



XIII. Conducting a Member Audit

When we talk about member audits, it is important to understand that we are not suggesting that Boards take each member individually and perform an audit on his or her operations in the same manner as described above for Board audits. Nor are we suggesting that Boards institute some kind of mandatory review process that requires members to get Board approval for business and promotional material or websites.

What is being suggested, however, is that Board staff persons educate themselves on trademark infringements and apply that knowledge to assist members in complying with the usage guidelines when displaying CREA's trademarks.

The fact is that the local Board is in the best position to see what is happening in its jurisdiction. In the normal course of business, Boards see much of the material produced by their members. Some of it comes across the desks of Board staff persons. Some is in the local newspapers that staff reads. And yet, a vast amount of member advertising and communication violates CREA's rules for the use of its trademarks. If Board personnel were able to look at this material with a critical eye, based on an understanding of the trademark rules, many of the problems would be stopped in the first instance before they become critical.

Here is a list of some of the most common problems with member use of the CREA trademarks.

1. Realty Firm Names

CREA's Rules provide that the REALTOR® and REALTORS® certification marks cannot form part of a business or trade name.

For example, the name "Riverside REALTORS®" violates the usage rules. The name "Riverside Realty, Inc., REALTORS®" is acceptable because the REALTORS® mark is not part of the firm name, but rather is used as an identifier after the name, properly separated by punctuation.

Neither the regulators nor the various government bodies charged with approving business names deal with trademarks, and they will not refuse names because they infringe trademark rights. It is not their job. Trademark protection is legally the responsibility of the owners of the mark.

So brokers can easily register firm names that violate CREA's rules.

However, as such names violate CREA's rules, as well as the REALTOR® Code, no broker should be allowed membership in these circumstances. They are in breach of the contractual obligation contained in the membership application and the Board bylaws.

Yet many infringing firm names make their way onto Board membership databases. That information is then directly uploaded to CREA's membership database, and may reside there for years before it is noticed that a problem exists. At that time, the member is arguing that he or she has been allowed this non-conforming use for years, and CREA now has no right to require compliance. This puts both the member and CREA in a difficult position.



PART 3 – A TRADEMARK PROTECTION AND COMPLIANCE PROGRAM FOR BOARDS/ASSOCIATIONS

Therefore, it is incumbent on Boards to:

- Refuse to process firm names that violate CREA's rules.
- When uploading firm names to the CREA database that use REALTOR® properly after the name, do not include the REALTOR® mark in the firm name. In the **example** Riverside Realty, Inc., REALTORS®, the trademark REALTORS® is not part of the firm name. It should be uploaded as "Riverside Realty Inc.", not as "Riverside Realty Inc., REALTORS®".

2. Member Advertising in Board Publications

All advertising containing any of CREA's trademarks, submitted to a Board for insertion in a Board publication should be reviewed for compliance with CREA's rules before it is accepted. Improper uses of the trademarks are particularly harmful when communicated in a Board publication.

3. Member Advertising in Other Media

When a Board staff person reads a local newspaper or gets a flyer from a member at their home, he or she should review the content for trademark problems. If any are identified, the Board should contact the member, pointing out the problem and requesting it be rectified.

4. Domain Names

Domain names that infringe CREA's trademarks represent the largest single challenge in trademark enforcement today. CREA has dealt with hundreds of non-compliant names, but on our own, we are barely scratching the surface of the problem.

Boards, however, are in a unique position to assist with compliance. Most Boards have the e-mail addresses of their members in the Board database. Many of these e-mail addresses are themselves trademark infringements (e.g. realtor@hotmail.com). But even the ones that are not, will in most cases lead to a website. **For example**, if the e-mail address is john@professionalrealtor.com the website is www.professionalrealtor.com. And we can tell right away that there is a problem—the website violates the rules for use of REALTOR® in domain names.

Therefore, Boards should:

Review the email addresses and websites currently on their membership database, compile a list of offending sites, and advise the members of the need to deactivate the domain names;

Review the contact information provided by new members, and any new information from existing members for compliance with the trademark rules.

NOTE: If the domain name would be considered "popular"—for example, something that contains a geographical reference such as www.winnipegmls.com, then the Board should require not only that the domain be deactivated, but also that it be transferred to the Board. That is the only way of protecting the domain from being bought by another person as soon as it is handed in by the member. CREA presently owns a multitude of offending domain names, but we are asking Boards to assist protecting these valuable marks.



5. Member Websites

Websites are advertising vehicles and Boards should review the content of websites in the same manner as any other member advertising, with an eye on the use of both REALTOR® and MLS®. In addition to domain name problems, the improper uses in websites mirror the most common misuses that appear in other media. They include:

- Displaying MLS® improperly by using by using small letters or periods or omitting the ® symbol;
- Using MLS® as a noun (“I have access to the MLS®”);
- Displaying REALTOR® improperly by not using all capitals and/or not using the ® symbol;
- Using REALTOR® to mean “real estate agent” instead of “member of CREA”;
- Using REALTOR® or MLS® with adjectives or as part of a marketing “slogan” (“I’m Your Condo REALTOR®”; “Talk to me about our “MLS® Advantage” Program”).

WHAT’S WRONG WITH THIS PROMO?



Meet John Doe
of ABC Realty Inc.

He’s **REALTORific!**

ANSWER

The REALTOR® term should never be used to create a new term or phrase, such as “REALTORific”. Modification of the term, in any manner, tends to weaken the distinctiveness of the mark and undermine its identifying functions.



PART 3 – A TRADEMARK PROTECTION AND COMPLIANCE PROGRAM FOR BOARDS/ASSOCIATIONS

BRAMPTON REAL ESTATE BOARD

10 – 35 Van Kirk Drive

Brampton, Ontario L7A 1A5

Tel: (905) 791-9913

Fax: (905) 791-9430

www.breb.org

www.realtorlink.ca

www.realtor.ca

E-mail sent February 15, 2009 to info@crea.ca

In browsing some of the real estate websites I found several, well, sad to say but most of them, that had trademark infringements. I e-mailed the contact person of each of the sites in regards to this and asked them to correct the situation. To my surprise, I have received e-mail replies very quickly thanking me and said they will make these changes right away. I have also not turned my head when I see a sign "REALTOR ON DUTY" outside an office. I have e-mailed the Broker of Record and within a couple days, a new sign has appeared "REALTOR® ON DUTY".

It's been great to see this and it's become a great tool I use with my Members. Asking them all too randomly search a few sites and then e-mail explaining the trademark issue and that they are adding to the risk of losing these trademarks. I've used the scenario; there are approx. 2,500 REALTORS® in our area, approx. 35,000 in Ontario and approx. 94,000 in Canada. What a statement they would make if they all just emailed a couple. Once they receive the replies they realize they do make a difference and then it starts, they become addicted to checking the trademarks.

Below is an e-mail I received from [REDACTED]. When searching 'real estate Ontario' a link comes up - [REDACTED]. This is how I found it. Throughout their material they reference REALTOR®, Multiple Listing Service® and MLS®; all incorrectly.

The emails I have been sending up until now basically reference the fact that these are owned by CREA, can only be used by Members of CREA and can never be used without permission.

I am starting to receive emails, such as this one below asking for more details and not being a lawyer, I would like to know if CREA has wording we could use in answering these types of questions. My first reaction would have been to tell them to get permission to use the two trademarks in their marketing materials, and then make sure they have the proper rules for the trademarks. I reference the Canadian Trademark Guidelines but now would like to know exactly what we should be saying.

Some of my members have been doing the same thing and are now asking the same question. Several I have heard back from know the answers and have agreed to make the corrections or replace the wording.

I present the Trademark issues every time I'm in front of my members, whether it's a Member's meeting, a education session or a Broker/Manager Forum. They are finally coming on board and I would really appreciate your help in letting them know exactly how they can pursue this.

Thank you in advance for any advice or suggestions you can give me,

Lynn M. Martin
Executive Officer
Brampton Real Estate Board



XIV. Enforcement Process

1. Getting Ready

As preparation for processing trademark complaints, the Board should ensure that following has been done:

Know the Rules

Trademark misuses fall into 2 general categories—unauthorized use by non-members, and improper use by members who are authorized to use the marks, but violate CREA's policies for use. Before you can recognize a misuse, you must know the rules and the reasons behind the rules. This toolkit sets out in considerable detail all of the usage rules and the rationale for them.

All Board staff should understand at least at a basic level how the rules work so that they all recognize obvious trademark infringements when they see them.

Appoint a Trademark Officer

One individual in the Board office should be appointed the person responsible for trademark compliance. The duties of this person would include training the staff on trademark issues, educating the members, responding to questions and complaints from members and other third parties, and establishing and supervising an internal procedure for dealing with trademark complaints. To be effective, a program of this nature should have one point of contact.

Develop a Record Keeping and Tracking System

It is critical to keep detailed records of everything that has transpired in the course of efforts to ensure compliance. A few of the things to keep in mind are:

- Maintain separate files for each trademark infringement, which are kept up to date. If you maintain only electronic files, ensure that all hard copy documentation is scanned and filed.
- Always maintain a paper or electronic trail of contacts with the complainant and the offending party. Written notes should always be taken during telephone conversations and should subsequently be filed. Where possible, always confirm discussions in writing or electronically. Remember, any individual enforcement process may end up either in court or before a Board discipline panel, and it is imperative that a complete file is available.
- Institute a tracking system that tells you at a glance what stage any particular trademark action is at. As an **example**, CREA created an electronic spreadsheet that includes the name of the offending party, the nature of the infringement, the date of first letter, the date and content of any response, the date of any second letter, the date of compliance (if any) and whatever follow-up action has been taken. This spreadsheet is cross-referenced so that if you have any piece of information—**for example**, the domain name that was the subject of the complaint—you can search that, and retrieve all of the information about that particular complaint.
- Create a tickler system that brings forward files when the next step has been reached. If, **for example**, an offending party has been given 10 days to cure an infringement, the Board's operational system should be structured so that a reminder comes forward that something needs to be done on this file.



PART 3 – A TRADEMARK PROTECTION AND COMPLIANCE PROGRAM FOR BOARDS/ASSOCIATIONS

2. Handling a Trademark Complaint

(See Enforcement Process Flowchart in Appendix A for summary of complaint procedure)

When the Board has received a complaint, here are the considerations to look at and the steps to take.

Are the marks (or similar marks) being used in connection with real estate products or services?

The focus of a trademark infringement is the possibility of “confusion”. If one person uses a mark to identify the quality of a service and another person is using that mark, or a similar mark, to identify the quality of the same or a similar service, the result is confusion in the minds of consumers. However, if similar marks are being used to identify completely different services, then no trademark infringement exists.

For example, Major League Soccer, Inc., a New York company, has registered an “MLS®” design mark in Canada that refers to soccer games and related apparel. As this has absolutely nothing to do with any aspect of real estate, it is not an infringement. If the registration had anything to do, directly or indirectly, with the purchase and sale of real property, or databases of real property, or products related to real estate it would be an infringement.

ACTION

If the mark only refers to activities or products that have nothing to do with real estate, it is not an infringement.

If the mark does refer to such activities, proceed to the next step.

NOTE: If there is any doubt, contact CREA.

Is the trademark being used in Canada?

(a) No use at all in Canada

CREA’s trademark registrations are valid throughout Canada. They have no application in other countries. A particular use that would be a problem in Canada is fine if the use is restricted to another country.

So the first thing a Board wants to determine is whether the use actually is in Canada. In most cases, this is obvious. But when the complaint involves a domain name or website, you need to be careful.

Let’s say, **for example**, the Board gets a complaint about the domain name www.supermls.com. On the face of it, this is a clear violation of CREA’s rules, which do not permit the use of MLS® in domain names. In any case, MLS® can never be used with adjectives, so it looks like it offends a number of usage guidelines.

However, if you click on the domain and look at the site, it is a property listings site, located in the United States. You can only search for properties located in the U.S., and there is no connection whatsoever to Canada. MLS® is not a registered trademark in the U.S., and CREA’s rights end at the border. Therefore, it is not a trademark infringement, and the Board’s investigation is done.

PART 3 – A TRADEMARK PROTECTION AND COMPLIANCE PROGRAM FOR BOARDS/ASSOCIATIONS



While this type of analysis usually comes up when dealing with Internet applications, it may very well apply to other types of communications or advertising.

ACTION

If the alleged infringement only involves MLS[®], there is no more that can be done. Advise the complainant accordingly, and close the file.

If the complaint involves REALTOR[®], then forward it to the National Association of REALTORS[®] (NAR). That organization is the owner of the REALTOR[®] trademark in the U.S. Send problems to:

The National Association of REALTORS[®]

Attention: Mary Newill, Trademark Administrator

E-mail address: trademark@realtors.org

(b) Server/Company located in U.S. but cross-border marketing

The situation is different if the company or website originates in the U.S., but is marketing products or services in Canada. **For example**, e-mails or other advertising materials may come from a U.S. site, marketing a product like “MLS[®] Explorer” or soliciting listings on their website. Alternatively, when you look at the website, it may offer listings from Canada. In both of those circumstances, even though the site is located in the U.S., because the products or services are marketed or sold in Canada, all of the usual trademark rules apply. Even though MLS[®] is not a trademark in the United States, if it is being used by a U.S. company in Canada, any uses must comply with Canadian law and CREA’s Rules.

ACTION

Report the use of REALTOR[®] to NAR, as described above.

Analyze the use of REALTOR[®] and/or MLS[®], based on CREA’s rules and determine whether a violation exists. Proceed to the next step, as if the violation originated in Canada.

Identify User

Is the offending party a member or a non-member? If it is a non-member, it is not necessary to determine whether the use conforms to CREA’s usage guidelines. That is irrelevant. A non-member is not licensed to use the marks and therefore has no right to display them unless the use is purely for reference purposes.

Categorize Infringement (if offending party is a member)

If the offending party is a member, it is necessary to examine the particular use and determine whether or not it complies with CREA’s guidelines for use. If the use conforms, advise the complainant and close the file. If the use is not compliant, proceed to the next step.

NOTE: If there is any question as to whether a particular use is problematic, contact CREA.



PART 3 – A TRADEMARK PROTECTION AND COMPLIANCE PROGRAM FOR BOARDS/ASSOCIATIONS

Gather the Information

When the Board is satisfied that the use is problematic, it should obtain and document as much of the following information as possible:

- A description, sample or copy, or website address (URL) of the alleged unauthorized use;
 - The person or firm responsible for the use;
 - The address of such person or firm;
 - The date of the use and/or the publication where the use appeared;
 - Whether the use is continuing;
 - Any information available regarding any possible relationship between the one misusing a trademark and any member should also be documented;
 - A note about domain names and websites;
 - CREA's experience has been that the vast majority of complaints involve the misuse of the marks in domain names. In view of that, a couple of comments specific to the handling of domain name complaints are warranted.
1. You need to find the owner of the domain name. A number of sites on the Internet can provide you with this information. If the domain name in question is a ".ca", you can do a search at www.cira.ca. This is the site of the Canadian Internet Registration Authority, the governing body for .ca domain names. A broader search of any URL's, including .ca, can be conducted at www.networksolutions.com. There are also numerous other websites that provide this information.
 2. A non-compliant domain name is usually just the tip of the iceberg, and your investigation should not be considered concluded once you have determined the name violates CREA's policies. The next step is to look at the website itself. CREA's experience has been that websites with infringing domain names are likely to be breeding grounds for all kinds of trademark misuses. Go into the site and review all of the uses of REALTOR® and MLS® throughout. Are the form and context rules being adhered to? Are any logos being used as hypertext links? Does the site refer to "mls.ca", which is now antiquated terminology? Does it refer to REALTOR.ca as an "MLS® system"? Are REALTOR® or MLS® used as meta-tags? You can find this out by right-clicking on the webpage and choosing 'View Source'. There is no point in fixing one problem (the domain name) and ignoring twenty other ones. Deal with everything at the same time.
 3. When a review of the website discloses misuses of the marks, make sure that the infringing web pages are either saved electronically or printed off. A number of software programs that capture and save web pages with the click of a mouse, are available.
 4. If the infringing domain name is unusual, in the sense that it is not likely to be of interest to another party—for example, www.zootsuitrealtor.com the request is that the domain name be deactivated.
 5. If the domain name is something that will likely be purchased by someone else if it is deactivated by the current owner—for example, one that includes a geographical reference such as www.reginarealtor.com - the only way of fully protecting the marks is to require the current owner to transfer the domain name to the Board. That way, the Board keeps the name "off the market". The Board should automatically require any domain names with geographical references to be transferred to it.



6. Domain names are not being “used” if they are not active. If a person owns a domain name that would otherwise be an infringement, but it has not been activated, there is nothing that can be done. Nevertheless, they should still be contacted and put on notice that if they activate it or sell it to third party, an infringement has occurred.
7. Domain names are still active if they “point” to another site. **For instance**, someone with a site at www.kelownamls.com may, after being contacted by the Board, set up another site at www.johnsmith.com, and “move” the content to that site. So far, so good. But instead of deactivating the “kelownamls” name, they “point” it to their new site, so that if users type in www.kelownamls.com, they get sent to www.johnsmith.com. Many people think this complies with the request to deactivate the name, but it does not. If the domain name takes you to any site at all, it is still “active” and is an infringement. In this particular example, of course, the Board requires the owner to transfer the name to the Board.

Initial letter to offending party

When the initial investigation has been completed, and the information gathered, the Board should communicate with the individual or company identified as misusing a CREA trademark.

Template letters directed to both members and non-members, covering all of the most common types of infringements, are included on a CD in the Appendices. These letters may be customized for Board use.

Non-members

When the offending party is not a member, a letter should be sent explaining that the trademark used is a registered mark owned or controlled by CREA in Canada, and that the trademark is reserved for the exclusive use of, or in reference to, members of CREA. The letter should conclude with a polite but clear and direct request that the unauthorized use of the trademark be promptly terminated. If the user is a real estate practitioner or a brokerage, this is an opportunity for the Board to explain the benefits of membership. Do not threaten litigation at this stage. The letter should include a request that the party confirm their intention to comply by a certain date.

Members

When a member is using the marks improperly, the letter should include a description of CREA's trademarks and their definitions, the fact that the member is licensed to use the marks, but must do so in accordance with usage rules, and an explanation of the misuses that were found. The member should also be politely asked to make the necessary changes within a certain time frame (e.g. within 2 weeks from when the letter is sent). The letter should include a request that the member confirm his or her intention to comply by a certain date.

NOTE: If the alleged infringement involves a domain name, a decision must be made ahead of time as to whether the Board will require the domain name to be transferred to them, so that the letter can reflect that request.

NOTE: The vast majority of member infringements result from a simple misunderstanding of the usage rules. The letter should therefore be extremely polite and as helpful as possible in explaining the problem. It is not appropriate to be in any way threatening in the initial letter.



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Review file status at deadline

The initial letter will result in one of five scenarios:

1. The party responds indicating they have complied. In this case:
 - Confirm compliance by checking website or materials;
 - Write a letter thanking the person for their co-operation;
 - Copy the file to CREA;
 - Close the file.
2. The party responds refusing to comply. In this case, send the second letter as described below.
3. The party does not respond. In this case, send the second letter as described below.
4. The party responds asking for clarification. In this case, politely respond to any questions. The greater the understanding, the more likely they will comply. At the same time, it is important to reinforce the need to comply, and a deadline should be agreed on at this time. If the party asks any questions the Board is uncertain about, CREA is happy to assist.
5. The party responds, agreeing to comply, but asks for more time to cure the problem. This is quite common in domain name and website issues. The party may be prepared to comply, but needs time to change over the domain name or revise the site content. CREA's policy is to allow any reasonable extension of time for people who are honestly trying to comply.

Sending Second Letters

Given the fact that the offending party at this juncture is either ignoring the Board or choosing to defy its request, the second letter should be more direct and set out a new deadline for compliance—one that is considerably shorter than the original one in the first letter. It is suggested that the deadline be no more than 5 days from the date of the letter, if the letter is being sent electronically, or 8 days if the letter is being sent by mail.

If the offending party is a non-member, the letter should indicate that if the misuse is not rectified within the timeframe set out, the matter will be referred to legal counsel for further action.

If the offending party is a member, the letter should point out the following:

- The misuse of CREA's trademarks is a violation of **Article 26** of the REALTOR® Code and if the problem is not rectified within the timeframe set out, the matter will be sent to the Board's professional standards committee as a discipline complaint.
- The misuse of CREA's trademarks is also a violation of CREA's Rules, and if the problem is not rectified within the timeframe set out, the matter will be forwarded to CREA, who has the right to terminate or suspend the member's access to any of CREA's trademarks, as well as to REALTOR Link® and REALTOR.ca.
- Copy this letter to the offending party's broker.



If, following receipt of the second letter, the offending party agrees to comply:

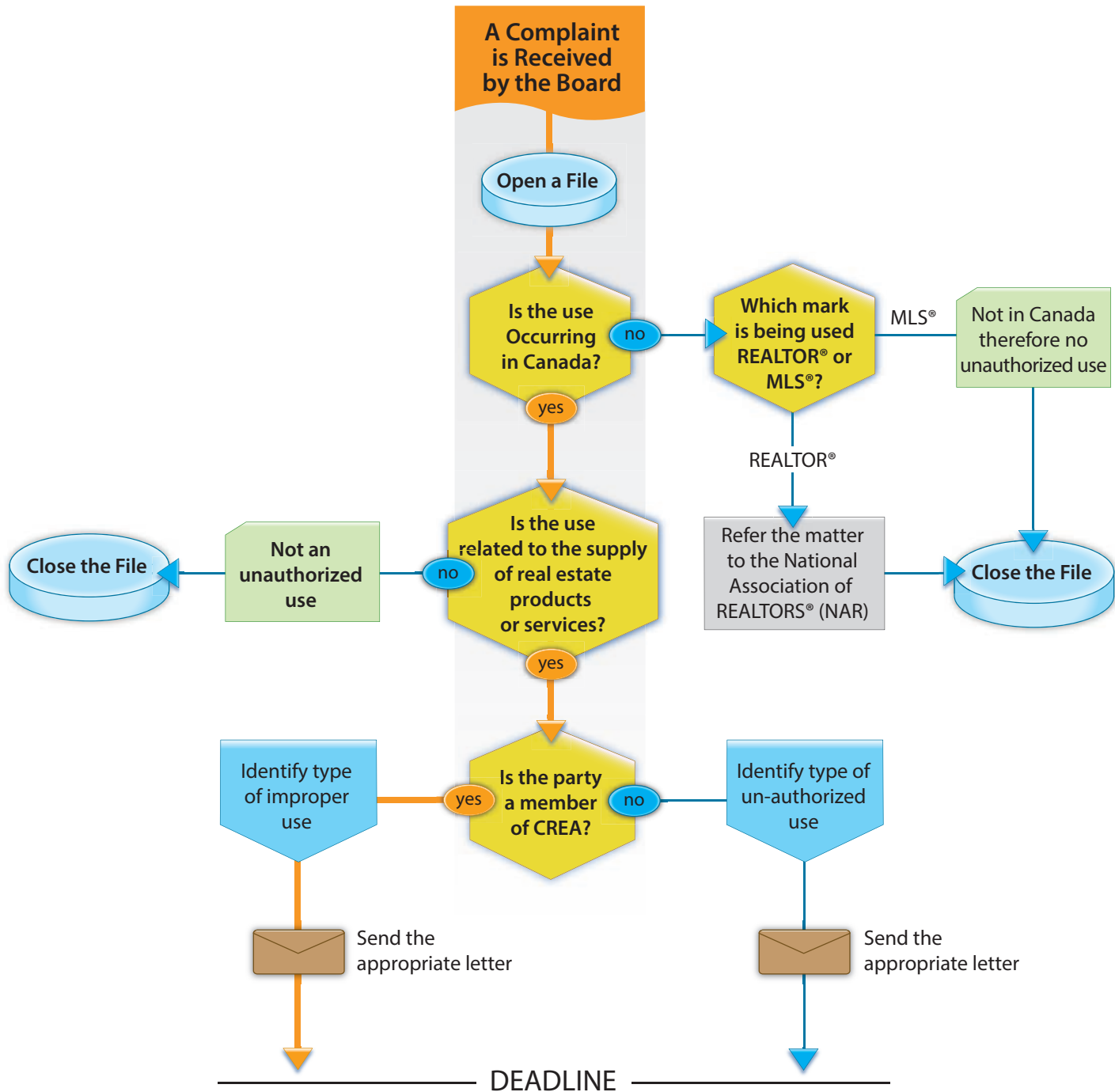
- Confirm compliance by checking website or materials.
- Write a letter thanking the person for their co-operation.
- Copy the file to CREA.
- Close the file.

If the offending party ignores the second letter or continues to refuse to comply:

- If the offending party is a non-member, forward the entire file to CREA for action.
- If the offending party is a member:
 - Forward the file to the appropriate Board body as a professional standards complaint;
 - Forward the entire file to CREA, confirming that the matter is the subject of a discipline complaint;
 - Update CREA regularly on the status of the discipline matter;
 - CREA will handle the matter from this point onwards.



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(This is how the enforcement process should have gone so far.)

NOTE: That template letters you can use for any trademark infraction are available on www.realtorlink.ca, or on the CD that was included with this Toolkit. There are more than 30 templates in all, covering the misuse of REALTOR® or MLS®, involving either a member or a member of the general public. If you have any questions about the use of these letter templates, please contact CREA.



3. CREA's Role in Enforcement

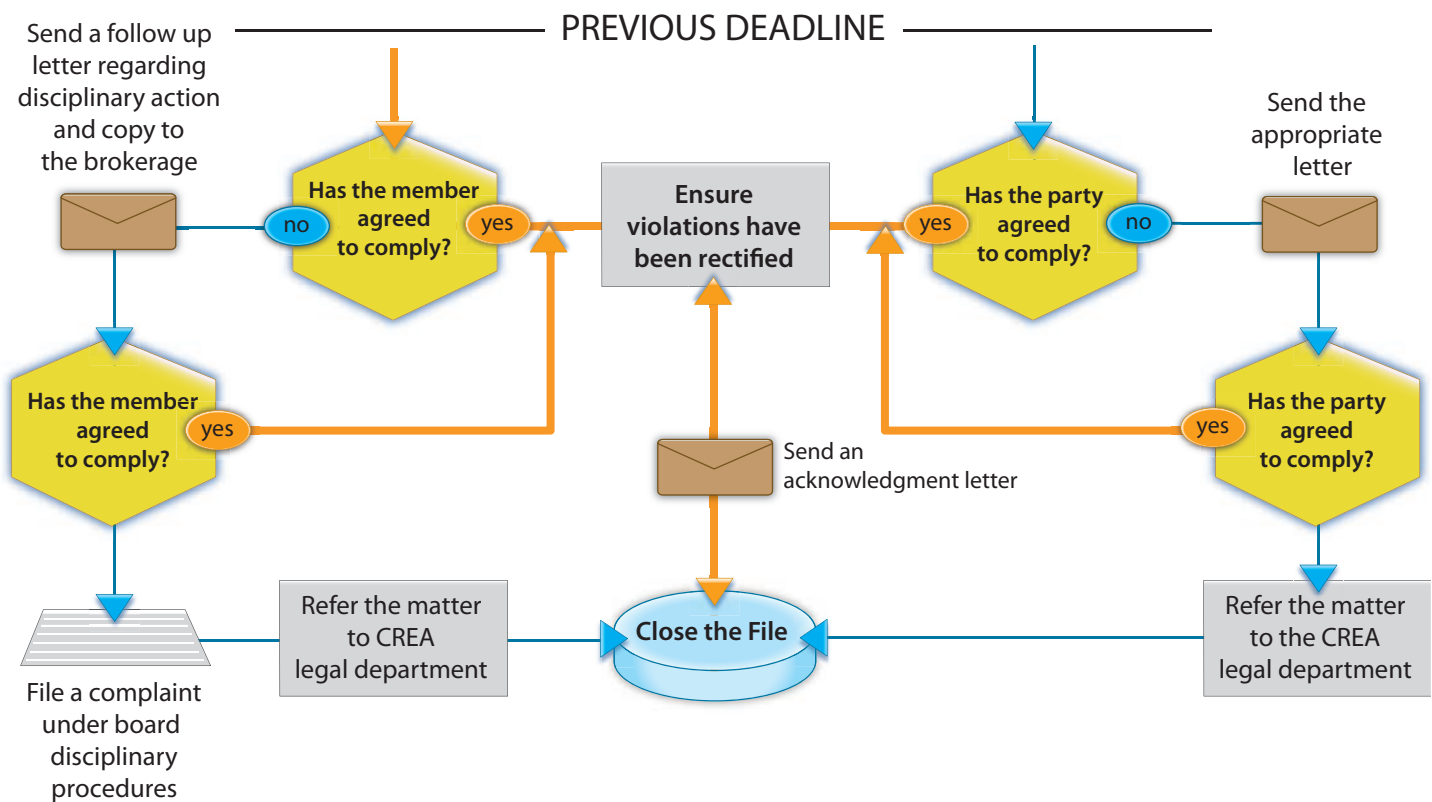
CREA is involved in the trademark enforcement process both as a resource and as the body primarily responsible for the proper use of the marks.

CREA as a Resource

As part of the enforcement process, CREA's legal department is available to provide advice and assistance to Boards at any stage of the enforcement process. CREA will work with Boards to help them understand how the trademarks work, and to answer questions at any stage of enforcement. If there is any issue as to whether a particular use of the marks is improper, or if an offending party requires clarification that the Board is unable to provide, CREA will help.

CREA also plays a role as part of the discipline process. If a member infringement has been referred by the Board to discipline, CREA will work with the Board in putting together the evidence. CREA can provide affidavit material analyzing the misuse and confirming it violates CREA's policies. If necessary, CREA can provide expert evidence at the hearing.

CREA can act as an enforcement body. CREA does not expect Boards to commence litigation against infringers. If the Board has gone through the enforcement process and the offending party has not ceased the misuse, CREA will take over the file at that point, and deal directly with the offending party.



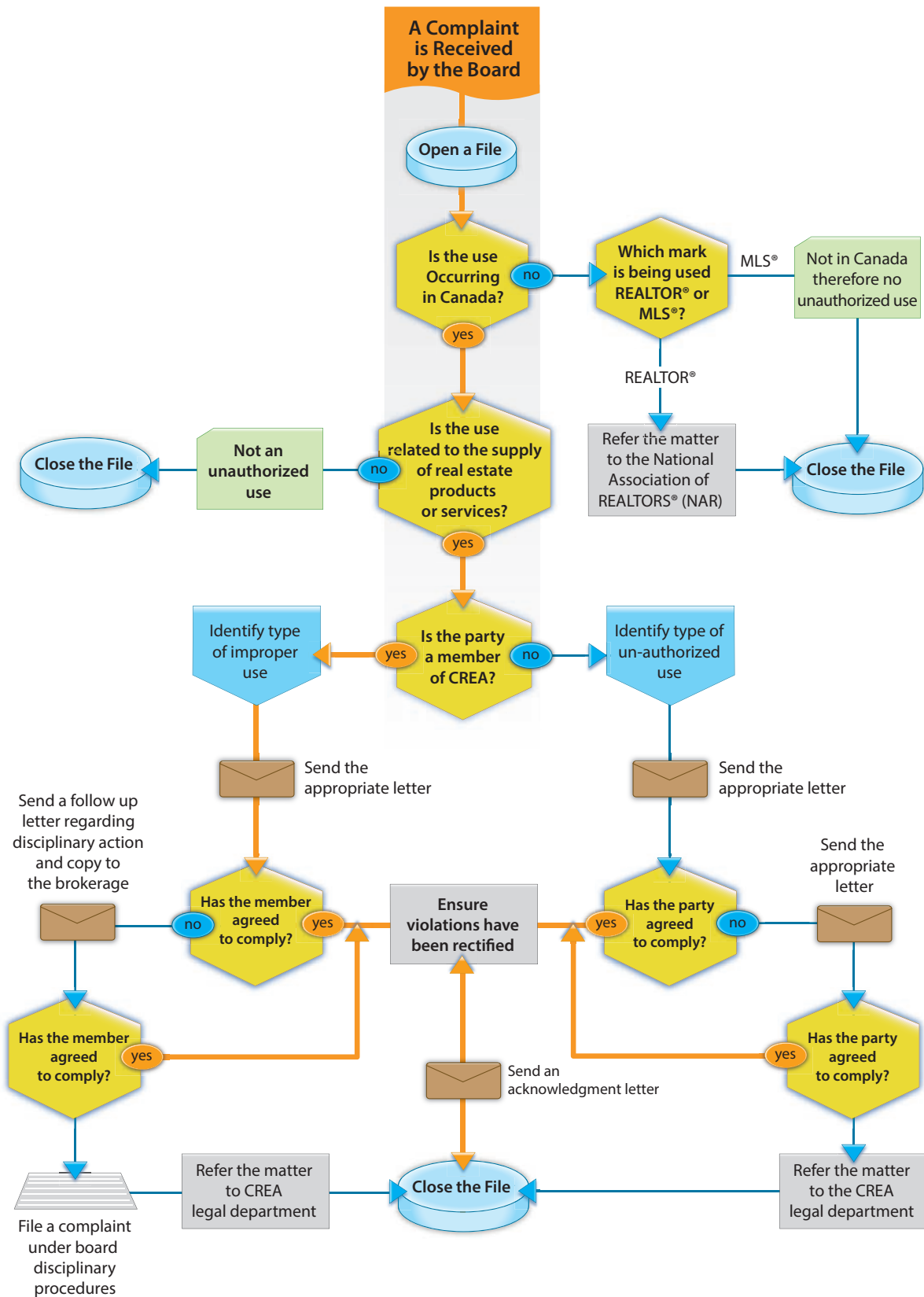


APPENDICES

- A. Enforcement Process Flowchart.**
- B. Article 26 of the REALTOR® Code.**
- C. Rule 3.2 of CREA's Rules.**
(Failure To Comply With Requirements of Membership – REALTORS® and Individual Members)
- D. Rule 9 of CREA's Rules.**
(Certification Marks)
- E. CREA Policy for Use of REALTOR® in Domain Names and E-mail Addresses.**
- F. CREA Policy for Use of MLS® in Domain Names.**
- G. Domain Name Transfer Procedure.**



The Complete Enforcement Process





REALTOR® Code

ARTICLE 26: CREA Trademarks

A REALTOR® shall only use the trademarks of The Canadian Real Estate Association in accordance with CREA's rules, regulations and policies.

Interpretations

- 26.1** A REALTOR® shall not challenge the validity of CREA's Trademarks.
- 26.2** A REALTOR® shall not use any of CREA's Trademarks in domain names, e-mail addresses or meta-tags unless specifically authorized to do so by CREA policies.
- 26.3** CREA's Trademarks are not to be used as hypertext links in Internet websites.
- 26.4** A REALTOR® shall not use, display, or attempt to register as trademarks any word, phrase, term, initials or design marks that incorporate, or are confusingly similar to, any trademark of CREA.
- 26.5** A REALTOR® shall not incorporate into corporate or trade names any trademark of CREA or any confusingly similar mark.



CREA's Rules

RULE 3.2: Failure to comply with requirements of membership

3.2: REALTOR® members

- 3.2.1:** Complaints relating to the conduct of REALTOR® members will be referred by CREA to the executive officer of the Board or Association to which the Member belongs, with the request that the matter be dealt with through the Board's professional standards process.
- 3.2.2:** If the complaint involves the misuse of CREA's trademarks — including the MLS® and REALTOR® family of marks — or other intellectual property (including, but not limited to, REALTOR.ca, ICX.ca, realtorlink.ca and crea.ca), the complaint may, at the same time, be dealt with by the CREA Chief Executive Officer, who may make such determination as he or she deems expedient, including:
- 3.3.2.1: Suspending or revoking the Member's license to display CREA's trademarks;
 - 3.3.2.2: Suspending or terminating the Member's passwords to CREA's websites; or
 - 3.3.2.3: Otherwise preventing access by the Member to any of CREA's intellectual property.
- 3.2.3:** Any decision of the Chief Executive Officer may be stated to be effective immediately or at such time as a determination is made on the complaint by the appropriate Board or Association.
- 3.2.4:** A Member affected by a decision under 3.2.2.2 above may appeal to the CREA Board of Directors within ten (10) days of notification of the decision.
- 3.2.5:** The Board of Directors shall review and consider the complaint and may make such determination as it deems reasonable. Any suspension or termination of rights imposed by the Chief Executive Officer shall remain in effect pending the decision of the Directors.



APPENDIX D

RULE 9: Certification Marks

9.1: The Marks

- 9.1.1:** The Certification Marks (collectively, the “Marks”) owned or controlled by CREA, and that are licensed by CREA pursuant to the terms and conditions herein, are as follows:
- MLS®;
 - Multiple Listing Service®;
 - MLS® logos as shown in existing registrations, and such variations as may be permitted by CREA in writing (collectively, the “MLS® Marks”);
 - REALTOR®;
 - REALTORS®;
 - REALTOR® logos as shown in existing registrations, and such variations as may be permitted by CREA in writing (collectively, the “REALTOR® Marks”).
- 9.1.2:** CREA may in the future adopt other marks as certification marks, and may license them in CREA’s sole discretion, and on such terms and conditions as CREA may subsequently specify in writing.

9.2: Standards Associated with the Marks

- 9.2.1:** The Marks are registered under the Trade-marks Act as certification marks and are protected throughout Canada.
- 9.2.2:** The REALTOR® Marks identify Members of CREA who provide real estate brokerage services (the “REALTOR® services”) in compliance with CREA’s By-Laws and Rules, and the REALTOR® Code, as amended from time to time, and in compliance with all applicable federal and provincial/territorial laws and regulations.
- 9.2.3:** The MLS® Marks identify professional services rendered by members in good standing of CREA to effect the purchase and sale of real estate as part of a “plural system arrangement”, also known as a co-operative selling system (the “MLS® services”), in compliance with CREA’s By-Laws and Rules, and the REALTOR® Code as amended from time to time, and in compliance with all applicable federal and provincial/territorial laws and regulations. The MLS® Marks do not identify or describe a computer database of real estate listings.
- 9.2.4:** An MLS® System is a co-operative selling system operated and promoted by a Board or Association in association with the MLS® Marks. An MLS® System includes an inventory of listings of participating REALTOR® members, and ensures a certain level of accuracy of information, professionalism and co-operation amongst REALTOR® members to affect the purchase and sale of real estate.



9.3: Licensees of the Marks

- 9.3.1:** Subject to the terms of this Rule, the following Members of CREA (collectively, “Licensees”) are licensed to use, reproduce and display the Marks:
- 9.3.1.1: Boards;
 - 9.3.1.2: Associations;
 - 9.3.1.3: REALTOR® members.
- 9.3.2:** A corporation, partnership, or other entity operating as a licensed real estate firm may use, reproduce and display the Marks in the course of its business, provided that all licensed practitioners in any way affiliated with the real estate firm are REALTOR® members.
- 9.3.3** An individual, corporation, partnership or other entity who has been licensed by CREA in writing may use, reproduce and display one or more of the Marks for certain specific wares or services.
- 9.3.4:** Former REALTOR® members who are no longer licensed, but who are: honorary life members or equivalent of a Board/Association; or Honorary Affiliates of CREA, may display the REALTOR® Marks in a manner consistent with their honorary status provided that:
- 9.3.4.1: any such display is solely for the purpose of promoting membership in CREA, and not for any commercial or business purpose;
 - 9.3.4.2: the REALTOR® Marks are not displayed in any manner that would lead a consumer to believe that the person is a licensed real estate practitioner;
 - 9.3.4.3: the person agrees in writing:
 - 9.3.4.3.1: to be bound by the REALTOR® Code and CREA’s By-Laws, Rules and Policies;
 - 9.3.4.3.2: to immediately cease displaying the REALTOR® Marks if requested to do so by CREA or the appropriate Board/Association.

9.4: Restrictions on License

- 9.4.1: Licensed Wares and Services**
- 9.4.1.1: The Marks may only be used, reproduced and displayed in association with the REALTOR® services or the MLS® services, as the case may be, and such other wares, services or business as CREA may specifically permit in writing.
 - 9.4.1.2: All Licenses granted pursuant to this Rule shall be non-exclusive.
- 9.4.2: Compliance with Standards**
- 9.4.2.1: CREA owns or controls the Marks. As such, CREA has the absolute right to withhold, withdraw or suspend any Licensee’s right to use, reproduce or display the Marks, or any one of them, at any time, subject only to the terms of any specific written license agreement between CREA and each Licensee.
 - 9.4.2.2: The terms and standards of the license to use the Marks are established in CREA’s By-Laws, Rules and Policies, as amended from time to time. The right to use the Marks is conditional on strict adherence to all terms and standards.



APPENDIX D

- 9.4.2.3: At the request of CREA, each Licensee shall promptly provide samples of all use of the Marks, or any of them, for CREA's review, and each Licensee shall promptly take such steps or make such changes as CREA may request to rectify any non-compliance with these terms and standards.
- 9.4.2.4: Licensees shall have no right to use, reproduce or display the Marks, except as specifically provided for in this Rule. All other rights are reserved to and remain with CREA. Without limiting the generality of the foregoing, Licensees shall have no right to sub-license or assign their right to use, reproduce or display the Marks, or any of them, except as may be permitted by CREA in writing.

9.4.3: Licensee Responsibility For Use of Marks By Third Parties

- 9.4.3.1: Licensees are responsible for ensuring that buyers and sellers for whom they are providing any service, as well as any other third parties in any way involved in transactions, do not use the Marks in any unauthorized manner.
- 9.4.3.2: Any Licensee who partners with a non-member in the provision of real estate related services and wishes to permit that non-member to display CREA's marks must:
 - 9.4.3.2.1: Provide the non-member with a CREA notice of allowed displays of the Marks;
 - 9.4.3.2.2: Enter into a written contract with the non-member which provides as a minimum that:
 - 9.4.3.2.2.1: The non-member may only display the Marks in the manner specifically approved by CREA from time to time;
 - 9.4.3.2.2.2: The Licensee has the right to terminate the agreement at any time in the event of non-compliance by the non-member;
 - 9.4.3.2.2.3: Licensees are required to terminate these agreements in the event of a breach by a non-member.

9.4.4: Term and Termination

- 9.4.4.1: All Licenses granted pursuant to this Rule shall commence upon each Licensee satisfying the terms and conditions of CREA's By-Laws and Rules, and shall terminate upon each Licensee ceasing to be a Member in good standing of CREA, or upon CREA terminating the License as provided for in CREA's By-Laws and Rules, as amended from time to time.
- 9.4.4.2: Upon termination, each Licensee shall immediately cease any and all use, reproduction and/or display of the Marks, or any of them, and any and all similar marks, as, or as part of, any trademark, trade name, corporate name, domain name, or otherwise.

**9.4.5: Estoppel**

Licensees agree that they will not at any time, either during the term of, or following the termination of this license:

- 9.4.5.1: Challenge the validity or distinctiveness of the Marks or any other trademarks of CREA, or CREA's ownership thereof;
- 9.4.5.2: Use, display or attempt to register (as trademarks, trade names, corporate names or domain names) any word, phrase, term, acronym, initials or design that incorporate, or are confusingly similar to the Marks or any of them or any other trademark of CREA.

9.4.6: Business Restriction

The Marks may only be used by REALTOR® members in connection with their brokerage services relating to real estate transactions, as permitted by the relevant provincial or territorial real estate licensing legislation.

9.5: Usage Rules**9.5.1: General Rule**

- 9.5.1.1: The Marks must always be displayed in a manner that enforces their distinctiveness as certification marks, and emphasizes that they are not generic or descriptive words.
- 9.5.1.2: The detailed usage requirements found in CREA's Policies must be complied with in every use, display or reproduction of the Marks. Any repeated failure to comply with these requirements shall entitle CREA to terminate the license.

9.5.2: Form Requirements

- 9.5.2.1: The Marks must always be displayed in the exact form and manner in which they are registered, as follows:
 - MLS®, Multiple Listing Service®;
 - REALTOR®, REALTORS®.
- 9.5.2.2: The ® registration symbol must always be displayed in conjunction with the Marks except in the case of any permitted new Marks that are not registered.
- 9.5.2.3: All business and promotional material displaying any of the Marks must, where possible, include the statement "Trademark owned or controlled by The Canadian Real Estate Association. Used under license."
- 9.5.2.4: The MLS® and REALTOR® logos must only be used, reproduced and displayed in the form as registered, or in such other form as may be approved by CREA in writing, as detailed in CREA's Policies as amended from time to time.



APPENDIX D

9.5.3: Exceptions to Form Requirements

- 9.5.3.1: National and local media outlets may display the REALTOR® marks by capitalizing only the “R”, and are not required to display the ® symbol following the Marks, all in accordance with the Associated Press Style Book or the United Press International Style Book.
- 9.5.3.2: Textbooks and other educational material may use the Marks without the ® symbol provided that there is, at the beginning of the book or document, an explanation of the meaning and ownership of the Marks which has been approved by CREA.

9.5.4: Specific Additional Requirements – REALTOR® Marks

- 9.5.4.1: The REALTOR® Marks must only be used to identify the real estate brokerage services and related professional services provided by members of CREA. The REALTOR® Marks must never be used as a generic or descriptive name to identify a salesperson, broker, or other real estate professional.
- 9.5.4.2: The REALTOR® Marks must never be used as part of a business name or trade name or corporate branding except as may be permitted by CREA in writing.

9.5.5: Specific Additional Requirements – MLS® Marks

- 9.5.5.1: The MLS® Marks must only be used to identify the professional services provided by Members of CREA to effect the purchase and sale of real estate as part of a “plural system arrangement”, also known as a co-operative selling system. The MLS® Marks must never be used as a synonym for a “database of real estate listings.”
- 9.5.5.2: When referring to the co-operative selling systems operated by Boards and Associations, the proper terminology is “the MLS® System of the Board.”
- 9.5.5.3: The MLS® Marks must never be used as part of a business name, trade name, or corporate branding except as may be permitted by CREA in writing.
- 9.5.5.4: A REALTOR® member who does not have access to the MLS® System of a Board/Association may not use, reproduce or display the MLS® Marks.

9.6: Use of Marks by Boards and Associations

- 9.6.1: A Board may only use, reproduce or display the MLS® Marks if it operates, or otherwise provides its REALTOR® members with access to an MLS® System.
- 9.6.2: A Board or Association may use REALTOR® or REALTORS® as part of its corporate name and trade name, provided that:
 - 9.6.2.1: the proposed name is approved in accordance with CREA’s Rules; and
 - 9.6.2.2: the Board or Association executes a written license agreement with CREA prior to using the name.
- 9.6.3: Each Board and Association is licensed to use REALTOR® or REALTORS® in the name of its building and in the titles of its publications, provided that each use is first approved by CREA in writing.



9.7: Use of the Marks in Domain Names and on the Internet

9.7.1: Licensees shall not use the Marks or any of them or any other CREA trademarks in domain names, e-mail addresses, meta-tags or other Internet search fields unless specifically authorized to do so by CREA's Policies.

9.8: Enforcement

9.8.1: Boards and Associations are responsible for monitoring and enforcing the proper use, reproduction and display of the Marks in their own jurisdiction. This includes ensuring that real estate firm names, websites and other advertising materials (print and electronic) are compliant, and that Boards and Associations respond to complaints regarding improper uses of the Marks, and conduct discipline hearings in a prompt manner, as required.



APPENDIX E

CREA Policy for Use of REALTOR® in Domain Names and E-mail Addresses

1. Real estate Boards, provincial/territorial Associations, member firms and individuals may all use the REALTOR® mark in domain names and e-mail addresses in accordance with this policy.
2. Real estate Boards and provincial/territorial Associations may use a domain name or e-mail address which includes the term REALTOR® and a geographically descriptive term which is related to their corporate jurisdiction and consistent with their assigned name. **For example**, the Alberta Real Estate Association may use “[albertarealtor.ca](#)” or “[altarealtor.ca](#)” or some other variation.
3. Individual REALTORS® are permitted to use REALTOR® in their domain name or e-mail address only if the term refers to the member or the member’s firm. Punctuation, while preferred, is not mandatory. **For example**, “[johndoe-realtor.ca](#)” and “[johndoerealtor.ca](#)” are both correct, as are “[johndoe-realtor@sympatico.ca](#)” and “[johndoerealtor@sympatico.ca](#)”.
4. The REALTOR® term can never be used with descriptive words or phrases. **For example**, “[professionalrealtor.ca](#)” or “[realtorlistings.ca](#)” are all improper uses of the term.
5. As a limited exception to CREA’s Rules regarding the use of the REALTOR® mark, the term can appear in lower case letters in domain names and e-mail addresses.
6. The REALTOR® logo is never to be used as a hypertext link.
7. Except as set out in this policy, all rules governing the proper use of the REALTOR® mark must be adhered to by all members.

The CREA Policy for use of REALTOR® Trademark in domain names was set out in Dispatch 99-07 issued on March 5th, 1999.



CREA Policy for Use of MLS® in Domain Names

CREA Internet Domain Name Policy

Rules for use of MLS® and S.I.A® in Board domain names/e-mail addresses

(Revised May 2, 2005)

1. Only member Boards and Associations may apply to use MLS® in domain names/e-mail addresses. No individuals or firm members may use the marks in their domain names or e-mail addresses.
2. Boards/Associations wishing to incorporate MLS® into their domain names may do so only in conjunction with a geographical modifier within their jurisdictional area.
3. Any Board/Association wishing to use MLS® in domain names or e-mail addresses must sign a special license agreement in the form provided by CREA.
4. Any display of the domain name/e-mail address on any business or promotional material and in all advertising must show the MLS® initials in capital letters.
5. The MLS® initials must never be preceded or followed by any other letters or numbers. The initials must always be separated from any other text by a dot or an @.
6. All domain names/e-mail addresses incorporating MLS® must be pre-approved by CREA before they are registered.
7. Any local Board or Association entering into a contract with a supplier for Internet services must ensure that the contract specifically provides that:
 - (a) the initials MLS® cannot be used in the name of any website computer directory;
 - (b) all uses of MLS® on website pages must be approved by the local board/association before the pages are released to the Internet.
8. In all print advertising where the domain name is displayed, there must be an acknowledgment that MLS® and related logos are trademarks of The Canadian Real Estate Association.
9. All Boards/Associations currently using domain names/e-mail addresses which incorporate MLS® must modify them to conform with this policy and sign a license agreement.

The CREA policy for use of MLS® in Board/Association internet domain names and e-mail addresses as was set out in Dispatch 2005-03 issued on May 18th, 2005.



APPENDIX F

Examples of Proper and Improper use of MLS® in Domain Names, E-mail Addresses and Advertising

Improper Use of MLS® in Domain Names

www.mlsottawa.ca
www.mls.ottawa.ca
www.mlssystem.ca

Proper Use of MLS® In Domain Names

www.MLS.ottawa.ca
www.ottawa.MLS.ca
www.MLS.ottawarealestateboard.ca

Improper Use of MLS® in E-mail Address

ottawamls@ottawa.ca
mls@ottawa.ca

Proper Use of MLS® in in E-mail Address

MLS@ottawa.ca
MLS@ottawa.MLS.ca



Domain Name Transfer Procedure

This procedure is triggered when an infringing domain name refers to a major city or town.

For example, “www.torontorealtor.com” or “www.princerupertmls.ca”.

There are two ways to transfer the domain name. The most efficient way is likely to be where the Board carries out the transfer.

1. The Board Carries Out the Transfer

- Request the domain name owner receiving the letter to change the e-mail contact address to an address owned or used by your board.

When the formal domain name transfer request is sent to the owner, the board can immediately approve the transfer on behalf of the owner.

- A domain name registrar approved by the Canadian Internet Registration Authority (CIRA)—likely working with your board’s IT staff—must generate the domain name transfer request.
- Your domain name registrar must ensure that the domain name has an “unlocked status” before the transfer request can be generated.

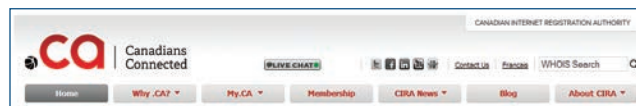
2. The Domain Name Owner Carries Out the Transfer

If the domain name owner cannot or does not want to change the e-mail contact address for their domain then your board should take the following steps.

- Your board should confirm with the domain owner that they can access the registered e-mail contact address for the domain name.
- If they cannot, advise them to contact their domain name host and/or CIRA in order to restore e-mail access. Ask them to let you know when their access has been restored.
- If they can access the e-mail address, a formal transfer request should be sent to them. The formal transfer is generated by a CIRA-approved domain name registrar and will contain authorization codes and the option for the owner to approve the transfer.
- The owner needs to click on <Accept> in the transfer request within a specified period of time. Presently, this is within seven (7) days of their having received the request.

If they fail to <Accept> within this time then the process may have to be repeated from scratch.

- If the owner is required to take any other steps (**for example**, such as logging in to the CIRA website) then those instructions will be contained in the transfer request that the domain name owner receives.





NOTES

Any questions or comments about the service or products CREA provides?
You can contact us on-line at info@crea.ca.

CREA THE CANADIAN
REAL ESTATE ASSOCIATION

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