

Comments Regarding Proposed Amendments to the Trade-marks Regulations

Submission to Canadian Intellectual Property Office

From: Andrea L. Ruty

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In general, I agree with the comments and suggestions submitted by the Intellectual Property Institute of Canada (IPIC) with respect to the Proposed Amendments to the Trade-marks Regulations and I wish to add my further comments and support as given below. Some of my comments may be addressed through further amendment of the regulations and some may be addressed through a related practice notice.

Rules of General Application

I am in favour of the addition of the option for a Canadian trade-mark agent to appoint an associate agent and I am in favour of joint applicants, opponents and objectors.

Section 5(2) seems ambiguous. Who are considered “As a person doing business before the Office of the Registrar of Trademarks” for this section?

I am in favour of Section 11 which allows the Registrar to waive the payment of a fee if the Registrar is satisfied that the circumstances justify it.

I am also in favour of the prescribed days for extension of periods, and especially Section 15(n) “any day on which the Office of the Registrar of Trademarks is closed to the public”. The deletion of the requirement of a Minister’s order declaring a closure is a useful improvement.

With respect to the listing of trademark agents on the list of trademark agents at the Canadian Intellectual Property Office (CIPO), I am pleased to see that an agent can be reinstated within one year of the date of their removal from the list without the necessity of writing an examination.

I am pleased to see that agents not residing in Canada must still appoint a resident Canadian trademark agent and I am in favour of allowing a Canadian agent the option of appointing an associate agent.

I am in agreement with IPIC’s concerns regarding Section 25(2) as I am concerned with the quality of applications which have appeared in the Canadian Trade-marks Journal from unrepresented applicants and I am concerned with untrained third parties representing applicants before the Registrar of Trademarks.

With respect to the representation of the trade-mark, I am pleased to see the ability to file a representation in colour and a sound recording for sound marks. With respect to the representation of the mark, I would like to see the ability to file in formats other than TIFF, including JPEG and PDF formats.

I am concerned about the interpretation of “clear and concise” in Section 30(g). How will the Office determine what is sufficiently “concise”? Perhaps the term “concise” could be replaced with the term “specific” or something similar.

I am concerned with Section 32(1) and Section 32(2) with respect to payment of fees and a filing date. What if the incorrect amount of fees is paid? What if it is later determined that there should be more classes? It should be made clear that the payment of the fee for one class of goods and/or services is sufficient to obtain a filing date and additional fees may be paid upon request by the Registrar.

With respect to advertisement of the trademark, pursuant to Section 41, I would also like to see clarification of what constitutes advertisement. How will trademarks be advertised for the public to review? Why not maintain a form of *official* Journal, even if in a different electronic format than currently exists. The U.S. currently has an official Gazette, the United Kingdom has a Trade Mark Journal, and IP Australia also has a Journal, to name just a few.

Opposition Proceedings, Section 45 Proceedings, and Objection Proceedings

I am in favour of submission of evidence by electronic means. It is my understanding that this would be through electronic filing at CIPO’s website. Would there also be an option of submission on some form of stored media (e.g. CD-ROM, DVD, USB stick)? This may be preferable when there may be difficulties with CIPO’s website and it may also be less time consuming than uploading a significant amount of data, particularly in time to meet a specific due date. Can copies of this evidence then be served on the other party in electronic format, for example on CD-ROM, DVD, USB stick as well?

I agree with IPIC’s concerns regarding Section 49 and “state of the register evidence”. This evidence should not require certified copies from CIPO and, instead, a sworn affidavit from a searcher should be sufficient.

With respect to extensions of time, I am in favour of maintaining the current exceptional circumstances. However, I would like to see the “Finalizing Settlement” extension of time available to both parties and I would like it to be clarified that a party may request the remainder of the “cooling-off” extension of time period if the full nine months was not requested on the first request.

I am in complete agreement with IPIC’s comments regarding Section 54, one month is not enough time for an Opponent to file Reply Evidence, especially if the deadline must be first reported to a client and time allowed for the client to review the Applicant’s Evidence, give instructions, and gather evidence. I request that this deadline be extended and/or allow for an extension of time without consent of the other party.

With respect to timing following the filing of the Opponent’s Reply Evidence, I would like to see a defined due date for filing a request for a cross-examination order on the Opponent’s Reply Evidence, and once that due date has passed, the Opposition will move into the Written Arguments stage. This would give more certainty to the Opponent regarding deadlines and timing and would assist agents with entering related due dates in their docketing systems.

With respect to Oral Hearings, I am in favour of the option for either party to elect to not file Written Argument but still request an Oral Hearing.

Renewal

I agree with IPIC's comments that Section 75 is confusing. The period to pay the Renewal Fee beginning six months before the expiry of the registration is acceptable and the period to pay the Renewal Fee should end at the end of a six month grace period. The Registrar could issue a Renewal Notice advising the Registrant of the six month grace period deadline.

Madrid Protocol Applications

I am in agreement with IPIC regarding Section 96, the closure dates of CIPO and the International Bureau (IB), and the interplay between the two, will need to be made clear to everyone, including through the use of practice notices and other public notifications.

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