

Response to Review of Draft Regulations to Implement Amendments to the Trademarks Act

Submitted July 20, 2017 by Bereskin & Parr, Toronto

Comments are divided into general comments that apply to many sections of the Draft Regulations (“the Draft”), and specific comments on certain sections.

Part I – General Comments

1. Comprehension

There are numerous paragraphs (particularly regarding Divisional Applications and Transition Rules) that defy comprehension. When those with years of experience cannot easily understand the impact or specifics of these sections, it is certain that those with less experience will be unable to do so. It is particularly important that the Regulations be understandable to filers at Canadian small and medium enterprises (SMEs), or those from abroad who will be reading the Regulations both to ensure compliance with regular applications, as well as those impacting the Madrid Protocol.

2. Calculation of Time Limits

The wording of time limits generally (although not consistently in the Draft) uses language such as “four months after the day on which ...”. This is a change from current language, which uses “within four months”. To many readers, this would involve calculating a deadline by adding 4 months to the “day after” an event occurred – so the deadline would be 4 months, plus a day, from the event that triggered the deadline.

Not only is there some uncertainty about the actual deadline, but as a general rule of statutory interpretation, a change in wording is understood to connote a change in meaning. While the past method of deadline calculation was “within 4 months”, understood to mean 4 months from the actual date of an event, the new wording seems to suggest a different method of calculation. Even a review of ss. 27 and 28 of the *Interpretation Act* do not unambiguously confirm that the new language does not mean “4 months plus a day”. Accordingly, it is recommended that the current, and well-understood language, be maintained. These comments apply to dates and deadlines throughout the Regulations.

3. Unnecessary Restrictions on Amendments to Applications

The Draft unnecessarily restricts changes to non-traditional marks. Particularly if such changes are made before advertisement and do not broaden the scope of protection of a mark, there does not appear to be any reason for this restriction, which seem likely to particularly impact SMEs and others not generally familiar with the application process.

4. While the intent seems to be to totally enact all provisions relating to the Madrid Protocol in the Draft, the Regulations are not a complete guide to Madrid Protocol applications.

There are several sections in the Draft that deal with Madrid Protocol filing procedures that may mislead many applicants, who may otherwise believe that the Draft is a complete guide to Madrid Protocol

filings. For example, fee information is missing from the Madrid Protocol sections. It is understood that the intent is for applicants to pay all fees directly to the International Bureau. However, by not mentioning fees anywhere in the Madrid Protocol section (with the exception of divisional applications in s. 122), and not including any fees in the Schedule, not only is it not apparent that there are fees for Madrid Protocol filings, but there is no indication of how fees will be paid. Some indication that “all fees payable in respect of any Protocol application or Protocol registration shall be paid directly on or on behalf of the applicant to the International Bureau” should be added so as not to mislead Canadian applicants for international registrations or holders of international registrations (“IRs”) that there are fee implications related to the Madrid Protocol system.

5. Calculation of Effective Dates for service of documents

Having different dates, depending on the method of service, is complicated and will likely lead to errors in calculation of deadlines. It would be simpler to provide that deadlines are always calculated from the date of delivery. Even if the method of delivery might differ, resulting in a day or two more or less to receive any document, this would avoid miscalculation of dates. Should actual delivery be much longer than expected, relief, particularly for any short deadlines, should be available upon request. Further, with more acceptance of electronic delivery of correspondence and documents, or mutual agreement on the method of delivery, there would seem to be less need for specific rules depending on the type of mail or delivery service.

6. Impact of use of “must”

There are many new sections, eg. dealing with necessary information in communications (**s. 4**), providing single address for joint applicants (**s. 5(1)**), notice of change of address (**s. 5(2)**), notification of hearing details (**s. 58(3)**) etc., where the wording of the Regulation states “must”. The consequences for failure to comply should be clear. It is hoped that use of “must” would not be used to result in inadvertent abandonment or other loss of rights, but without clarity on the impact of failure to fully comply, there is a concern that rights could be compromised. This also could especially prejudice SMEs and others not fully experienced in trademark practice.

7. Review Opposition Practice

There have been repeated suggestions for changes to opposition practice – eg. to implement mediation, and to remedy the impact of a party appearing at a hearing without having filed evidence/written submissions. Now is a chance to review these procedures, and recommendations are set out below.

8. Change Procedure for Registrar-initiated s. 45 proceedings

Particularly in the event of increased use of Registrar-initiated s. 45 proceedings, as predicted by CIPO during consultations on Bill C-31, a clarification of that procedure is recommended, and specific comments are set out below.

9. Require information on entitlement (proposed use or actual use in Canada).

As proposed in the amended *Trademarks Act*, a person may file an application if they are using or propose to use, and are entitled to use, the trademark in Canada (s. 30(1)). Section 30(2) requires that the application shall contain a statement of goods/services in association with the trademark is used or proposed to be used, or similar information, relating to a certification mark (ss. 30(2)(a) and (b)). Section 30(d) permits “any prescribed information or statement” to be included in the application.

Given the usefulness of use/proposed use information to applicants and registrants in searching, prosecution and oppositions, the widespread support for maintaining that information both as part of the application process and on the Register (refer to comments made in submissions to Bill C-31) and that collecting such information is not contrary to any of the intellectual property treaties, Sections 30, 31 and 59 of the Draft should be amended to include information provided by the applicant regarding which goods and services the applicant proposes to use, and which are used, with date information on such use, and that such information be maintained on the Register.

Specific Comments

Interpretation – consider adding:

s. 95 – add a definition of Office of Origin – since that term is used in the Madrid Protocol section.

Written communications

s. 3(2)(a) refers to a change in a name or address. The TMO now considers a merger and/or a change in the jurisdiction of incorporation to be similar to a change of name, in that no fee is payable, but does require documentary proof. Such changes should be clearly included, either by amending s. 3(2)(a), or by adding a new subsection.

s. 4 lists only the name of the applicant/registrant and the application/registration number. Traditionally, files are identified by the trademark, eg., when opening files, when connecting mail with files, when addressing mail to other parties, etc. At the least, an “and/or” approach should be followed, so that use of 2 out of 3 of the applicant/registrant name, application/registration number and/or mark be accepted. NOTE, rules such as this will impact SMEs, who may not use the right combination of identifying details.

Form of Communication

Section 6 states that the Registrar is “not required” to have regard to non-written communications. The current Regulations state that the Registrar “may also consider oral communications”. While the language seems to indicate some discretion by the Registrar, the tone of this section seems to discourage telephone or other oral communications, particularly when they may increase efficiency of prosecution. It is recommended that the current wording of “may also consider” be used.

Document in non-official language

Section 8 states that the Registrar need not have regard to any documents not in English or French. It is recommended that this be amended to exclude exhibits filed in evidence as required by steps taken to prove distinctiveness, or in oppositions or non-use cancellation proceedings. For example, as part of proof of use in Canada or reputation of a mark, it may be useful to file non-English/French documents.

Date of Receipt

Section 9(2) and 9(3) deems a specific date of delivery in the case where documents are “delivered” to the Office or a designated establishment. It could be possible to effect “delivery”, even if the Office/designated establishment is not “open”. For example a local building designated as an establishment for delivery may be open, but the specific government office may not be . Recommend instead that the wording provide that “in the event the Office is open, on the day they are delivered to the Office during ordinary business hours.”

Section 9(4) assumes that documents “provided” by electronic means are deemed to have been “received...”. What is the impact of a failure of electronic communications, such that documents were “provided”, but not “received”? This could result in a loss of rights. Similarly, there may be a difference in the “local time” of the place where the Office is located, and the physical place of the person making the electronic submission.

Waiver

Section 11 – waiver of fees. It is understood that when this might occur could be clarified in a Practice Notice. The words “circumstances justify it” are used, vs. a term such as “interest of justice to do so”. Clarification is required.

Refund

Section 12 – Similar comments to Section 11 above. Also, the refund applies to any amount “in excess of the fee that is to be paid by them”. If an applicant miscalculates the fee requirements, drops classes after filing, or abandons its application, it could take the position that it paid an excess fee. Clarify this section to apply only to fees paid that are the result of an original miscalculation.

Affidavit of statutory declaration

Section 13(2) – add “during the time specified in subsection (1).”

Eligibility for examination

Section 16 (a)(i) does not include working on Geographic Indications. Was this omitted intentionally?

Section 18(3): Recommend more than two weeks’ notice provided to persons who have signed up to write the exam, so they can address both work and travel plans.

Listing of trademark agents

The term “trademark agent” is a defined term – referring to a person whose name is on the list maintained by the Canadian Intellectual Property Office (“CIPO”). Such persons generally will have written the trademark agents exam, unless they meet other requirements. **Section 19(b)** uses “trademark agent” inappropriately. The person described there will not be a trademark agent, as defined. Further, the use of the word “trademark agent” is not one universally used as an equivalent for someone qualified to practice before a national trademark office. The current provision is a person “qualified to practice before the trademarks office of that country”. That language seems to be better suited to s. 19(b). Similar comments apply to **s. 20(1)(b)**.

Section 20(2)(a) would permit the Registrar to remove a person from the list of trademark agents for failure to pay the annual fee. That failure could be as a result of an inadvertent or clerical error. Removal from the Register, and worse, the possible necessity of having to requalify as an agent is an unnecessarily harsh response to such an error. By analogy, failure to renew a driver’s license in Ontario does not result in the inability to be fully reinstated, unless the failure lasts for more than a year, at which point the driver may be forced to requalify. Similar discretion should apply to trademark agents. Recommend that this section be amended to provide for suitable notice of non-payment of fees and a grace period.

The language of **s. 20(2)(b)** is confusing (admittedly, this language appears in the current Regulations). What circumstances would apply here? If the person is an agent who no longer meets the requirements of s. 19(a), how can they be a person referred to in s. 19(a)?

Representation

The language of **s. 22** and **s. 24** is very awkward – particularly regarding the reference to “the person who appointed them”. Recommend that all foreign applicants appoint a trademark agent.

Section 25 will permit a person to be represented by “another person authorized by them”. Such other person does not need to be a trademark agent. Currently, many applicants/registrants are solicited by companies for a variety of trademark tasks that are either unnecessary, are not what they purport to be, or for fees well in excess of what regular trademark agent practitioners would charge. Allowing “another person” to act, particularly regarding payment of fees, opens up applicants, and particularly SMEs, to the potential for abuse and unlawful conduct. While applicants/registrants should be permitted to do any act, abuse will be avoided if other acts must be done by trademark agents, as defined in the Draft.

Language

Section 28 – requires application to be in English or French. A combination should be accepted, so recommend addition of “or any combination of both”.

Manner of describing goods or services

There are a number of criteria for correctly specifying goods and services. Section 30(a) of the Act (as amended) requires “ordinary commercial terms”. **Section 29** of the Draft adds a requirement that the

goods/services must be “clearly” described “in a manner that identifies a specific good or service”. The last words starting with “in a manner” seem to be unnecessary, and should be deleted.

Representation or description

Section 30(a) requires more than one view of a mark “only if the multiple views are necessary”. Is the reference to “necessary” “in the opinion of the Registrar”? Under what circumstances will multiple views be “necessary”. Since the preparation of trademark drawings can be costly, more guidance on this requirement is requested.

Section 30(e) refers to a representation in “black and white” if colour is not claimed. Will gray be permissible, to show shading or shadows, when colour is not claimed? If so, then recommend that the language of this paragraph be amended to “black and white, and shades thereof”.

Section 30(g) adds a requirement for the mark description to be “clear and concise” – in addition to all the other requirements in s.30. How will this be interpreted?

Add to **ss. 30 and 31** the requirement that the applicant indicate whether its right to register is based on proposed use, or use in Canada, and if the latter, the date of first use in Canada, with specific information on dates of use for the general class of goods/services.

Fee

Section 32 - see comments above re Protocol applications and fees – the suggestion (by using “other than”) is that there are no fees for a Protocol application, which is misleading. Also, why is there no fee for a divisional application, merger or transformation?

Amendment of application

Confirm that **s. 35(2)** permits a change of identify arising from a merger or change in jurisdiction, as well as a transfer.

S. 35(b) uses new language, namely “remains substantially the same”. The current wording is “in respects that do not alter its distinctive character or affect its identity”. That wording has been the subject of interpretation by the Registrar, such that there is some expectation of what can, or cannot, be changed. This change in wording suggests a different test, but how will it compare?

It is not clear how the exception in **s. 35 (c) (i)** (“not taking into account section 34”) will be interpreted. Is the intent to assess a broadening of goods/services only from the “actual” filing date in Canada, regardless of what the goods/services in a priority filing might have been? This should be clarified.

Regarding **s. 35(d)** – adding a statement that the application is a divisional application. It is not clear why this is required. (Will the divisional application is treated as a different application?)

The restrictions in **s. 35(e)** seem unnecessary, if such changes are made before advertisement. For example, the Trademarks Office now permits an applicant to “add” a colour claim, presumably on the

basis that the change does not broaden rights, and there is no adverse impact on third parties to permit applicants to do so. Many applicants, particularly in the early years of the new Act and Regulations, might inadvertently include a claim about a colour, design or other representation features, due to unfamiliarity with the Act or their rights. Further, since it is important not to delay the filing of new applications, when the filing date may impact priority, having to sort out colour claims before filing may lead to unnecessary delay. Such limitations have the potential to adversely impact SMEs especially, who may “cut and paste” colour, or black and white drawings into an application without understanding the implications of their choice. It is recommended that more leeway be permitted to change the mark description, until advertisement.

Effect of transfer

Section 38(a) – each “part” of the application or registration should be designated a different application or registration number to clearly identify future rights.

Section 38(c) “any steps” presumably only applies to the steps taken with respect to specific goods/services, and not all of them. If the mark for all goods is assigned, then steps taken with respect to services will not apply.

Also, in terms of overall comprehension, it would be preferred if the transfer provisions for applications and registrations were found in the same section.

Divisional Application

The provisions of **s. 40** are simply not understandable. It would be preferable to start the paragraph with the definition of “division day” that now appears as s. 40(3). The reference to “ceases” should be “cease”. It also appears that the last words of s. 40(1) ought to be “its division day”. However, even with such changes, the section is unintelligible. Referring to “steps taken on or before the following day” is confusing – why not “on or before the day”? The language appears to have an impact on advertisement and re-advertisement, but even if read in conjunction with the document entitled “Public Consultations on the Proposed Trade-marks Regulations”, and in particular, page 27 of that document, the treatment of divisional applications remains very unclear. For example, the “consultation” document describes a situation where goods/services may be deleted, then an opposition is withdrawn, and then an application might be filed in respect of some/all of the deleted goods/services. This seems to contemplate goods/services being deleted, and that at some future date, being the subject of a divisional application. The uncertainty of the future of such goods/services is a matter of concern, and even if an opponent has a chance to continue its opposition against the previously deleted goods/services, having to file a second opposition, and deal at an uncertain date in the future with deleted goods/services is not a welcome change. At the least, if an applicant wishes to divide out certain goods and services, it should have to do so at the time it files the divisional application – the goods and services should not remain in limbo at the whim of the applicant.

s. 40 requires a re-write to clarify what will happen, and when.

Advertisement

The list of information that must appear in an advertisement (s. 41) is not the same as the information that must appear in an application, and it is recommended that the advertisement also include details of translations, transliterations, any information regarding a s. 12(2) claim or evidence of distinctiveness, plus colour claims.

How will the “advertisement” be different from the database information? How frequently will “advertisement” take place?

Opposition Proceedings

General Comment: The Draft contains some changes to opposition practice, including the welcome change to file written arguments *in seriatum*, but does not deal with 2 significant issues that have been mentioned in many submissions over the years: mandatory mediation and the impact of parties filing little or no evidence and/or no written argument, and leaving their submissions to the hearing stage, when neither the other party nor the Registrar has had the opportunity to consider their position in advance, and thus may not be able to effectively prepare for the hearing. This is an opportunity to address both these issues.

On the subject of mediation, the experience from court proceedings is that requiring the parties to attend for mediation sessions either helps to resolve the issues, outright, or focuses the party’s submissions on the most contentious issues. Either way, proceedings may be resolved faster and at less cost to everyone – including the Opposition Board and the public.

As currently drafted, parties to an opposition may elect to file no evidence, but file a statement that it does not intend to do so, and also file no written submissions, but instead, a statement that it does not intend to do so. However, either party may still request a hearing and make submissions. It is very difficult to prepare for a hearing in the absence of a written submission – the applicant is essentially “ambushed” by the oral submissions.

It is recommended that other options be considered, such as:

1. a fee be required to support any request for a hearing;
2. a hearing may not be requested unless a written submission is first filed; or
3. if no written submissions are filed, then any request for a hearing must clearly set out the arguments intended to be advanced with sufficient particulars to permit all parties (including the Hearing Officer) to effectively prepare for the hearing, and that no additional arguments may be advanced at the hearing. In addition, it should be clear that no documents may be filed at the hearing (eg. a hearing brief, cases), unless permission is granted in advance of the hearing, with copies supplied to the other party.

Specific Comments:

s. 42 - consider if opposition fees might be split, and payable at different stages of the opposition. That might permit SMEs, especially, to more easily oppose an application, and avoid fees if the opposition is subsequently settled.

s. 43 – until an opposition is commenced, there is no “opposition proceeding”, so the wording of this section should require a statement that the correspondence refers to “an opposition or possible opposition”.

s. 44 – very awkward wording. It would be clearer to state that once the Registrar has forwarded a copy of the statement of opposition to the applicant, apart from any document required to be served on a party, all other documents sent to the Registrar must also be sent on the same day to the other party.

s. 45 – recommend adding the name of a trademark agent (person or firm) in Canada who can receive service of opposition documents.

s. 46. There does not appear to be any definition of “personal service”. Also, it is not clear that service on an agent has the same effect as service on the applicant/opponent. The provisions of **s. 46** result in different dates for calculation of deadlines depending on the method of service. See General Comments above – such differences are confusing, and will most certainly result in uncertainty and disagreement on actual deadlines. For example, it is not always easy to determine when a document is “provided” to a courier – whereas the date of delivery by a courier is easy to confirm. During the course of an opposition, documents may be served in different ways, depending on the type of document or size of the delivery. It is not clear how one is to send a notice under s. 46(1) (d) and what “delivered” means under s. 46(2). There would be more certainty if dates were calculated from the date of correspondence or delivery, in all cases. The Federal Court rules have more certain deemed dates of delivery.

s. 48(2) – why must an applicant obtain leave to amend a counterstatement? Recommend instead that once a statement of opposition is amended, the applicant may, in its own discretion, amend its counterstatement.

s. 49 – as read, if a party to an opposition wishes to file state of the Register evidence, it would be necessary to order and attach certified copies of any application/registration pages relied upon. That could mean a very significant expense if there are many marks upon which any party wishes to rely. Possibly, this requirement only applies if Register evidence is filed without an affidavit or statutory declaration, but the section is not clear. Recommend that the section be worded to exclude affidavits to which are attached copies of applications and registrations copied from the CIPO database. If any party wishes to challenge the currency of the information on those pages, they can do so.

s. 50(2)/s. 52(2)/s. 57(3) – awkward wording. Suggest “instead” as opposed to “rather”, or delete “rather” entirely.

s. 51 /s.52(2), s. 53. – very awkward wording. Deemed withdrawal should not occur until “after the end” of the 4 month period, and not “by the end”.

Also, it should be certain when an applicant or opponent is deemed to abandon/withdraw its application/opposition. Provisions such as **s. 57(3)**, which states that should the opponent not wish to submit written representations, it “may rather” submit a statement to that effect – leave uncertainty about actual withdrawal of an opposition. Instead, the language should state that if an opponent does not file evidence/written representations, or a statement that they do not intend to do so but otherwise wish for the opposition to proceed, then the opposition is deemed to be abandoned on the date of any specific deadline for taking such act.

s. 54 – the one month time limit is exceedingly short and does not permit review, reporting and instructions on reply evidence. Recommend that a longer term be set, in line with other opposition deadlines.

s. 55(2) – The change in wording to granting leave, unless “it is not in the interest of justice to do so” suggests that a different standard will be applied than is the case now. While it is probably in the interest of justice, the parties and the public for all opposition grounds and evidence to be before the Opposition Board, there is a concern that there will be unwarranted leaves/granting of leave to amend/file new evidence. The latter, particularly, raises the possibility of many rounds of evidence, and uncertainty about deadlines. However, it is assumed the Registrar will set easy-to-follow and predict guidelines on leave requests. If so, no change is required to this wording.

s. 56 (1) – Consider the impact of timing of cross-examination on additional evidence of both parties. It is recommended that timing not lead to any party “splitting” its case – and that following cross-examination, the party conducting the cross-examination be permitted to file evidence to address new issues arising due to cross-examination. Also, recommend that Registrar be given discretion to refuse order for cross-examination. The Registrar has occasionally exercised such discretion where the evidence is factual and non-controversial, and particularly if the cost and inconvenience of attendance of a witness is significant.

s. 56(4) Recommend that refusal to file undertakings should lead to the same consequence – namely that the affidavit/statutory declaration is deemed not to be part of the evidence.

s. 57(1) - how will the Registrar know that all evidence has been filed? If parties can request leave to file additional evidence, and may do so with leave, to be granted unless not in interest of justice to do so, when will Registrar normally send notice that written representations are due? What if leave to file additional evidence is granted – how does that impact the deadline to file written representations?

s. 57 (2) – since most parties now ask for an extension of time to file written representations, a term longer than 2 months is recommended – eg. 4 months.

The Draft does not provide for any **rebuttal by the opponent**. In many cases, a hearing is requested because a party feels it has not had a chance to respond to an argument in written representations. Providing not only for arguments *in seriatum*, but also a rebuttal by the opponent, may reduce the number of hearing requests.

s. 58(1) – very awkward and confusing wording. Why not simply state that a request for a hearing is to be made once the application has filed its written submissions or a statement that it does not wish to do so?

s. 58(1)(a) – since any requests relating to the type of hearing and language may depend on the position taken by the other party, there should be some leeway to request a hearing, and then when the parties know a hearing is being held, provide details at a later date of the language of submission and translation.

s.58(2) – This provision is a significant departure from practice, and will likely result in every party requesting a hearing, even if they do not wish to have one themselves, in order not to miss the chance to make submissions in the event that the other party requests a hearing.

Practically, a decision on whether to hold a hearing often depends on the position taken by the other party. If a party waits to request a hearing until the last day, and the other party does not have a chance to request a hearing on that day, (e.g. since it was not possible to get client instructions that quickly) that party should not be denied the ability to make representations at a hearing. Instead, once a hearing is requested, both parties should have the ability to participate. It would be appropriate, however, for any party that did not request a hearing to have a specific deadline to advise if and how it will be participating.

More important, as noted above, the Registrar should have the discretion to limit the argument of any party who did not file written submissions.

Register

s. 59 - As with advertisement, all information required to be included in an application when filed, or after examination should be included on the Register (eg. translation, transliteration, colour claims, claims re distinctiveness or s. 12(2)), and full details of any territorial restrictions (not just that there is one).

As noted in the introductory comments, amend s. 59 to include on the Register information provided on filing regarding goods/services proposed to be used, and those in use.

Merger

s. 61 – will there be any fee?

Section 45

General Comments

CIPO personnel have suggested that there may be more use of Registrar-initiated section 45 non-use proceedings to control perceived over-claiming or other registrations that do not represent Canadian marketplace use. If that is the case, and there will be more such Registrar-initiated proceedings, it is

recommended that there be a specific procedure for s. 45 cancellation proceedings initiated by the Registrar.

As now contemplated, in Section 45 of the Act, the Registrar “at his or her own initiative” may give notice to the registered owner, requiring evidence of use to be filed. New s.45(2) suggests that representations may be received – as set out in the Regulations. The normal procedure in s. 45 is for the registrant to file evidence, following which first the requesting party, and then the registrant may make representations, and both may request a hearing. It does not make sense for the “requesting party” to file written representations in a Registrar-initiated proceeding, nor does there seem to be much need for a hearing. However, the Draft does not in any way distinguish between the steps of an ordinary s.45 proceedings and those initiated by the Registrar. Looking, for example at s. 72(1) of the Draft, presumably the Registrar will not give notice to “the Registrar” that it may submit written representations. Similarly, having filed evidence, it does not seem to make sense, as contemplated by s. 72(2), for the registrant to wait 2 months, and then file representations. Instead, it is recommended that should the Registrar initiate a section 45 proceeding, the registrant should submit both its evidence and any written representations simultaneously. Likewise, while s. 73 contemplates that “every party” may make representations to the Registrar at a hearing, presumably, having initiated the proceeding, the Registrar will not appear at a hearing, before itself, to make representations, and thereafter issue its decision. There would seem to be no need for a hearing in such a case, and the Regulations should be adjusted specifically to take this into account. The most efficient way to handle such proceedings would be to require the registrant to file evidence, as that there will not be any Registrar representations – only a Registrar decision.

Specific comments

Many of the comments regarding wording, deadlines and procedure made regarding oppositions also apply to s. 45 proceedings. For example, see the following:

s. 68 – see comments under s. 44

s. 70 – see general comments and comments under s. 46

s. 73 - re hearing, see comments under s. 58

Renewal

s. 75 – there are now 3 relevant dates: the actual renewal date, 6 months following the renewal deadline (“the grace period”), and 2 months following the Registrar’s notice, if longer than the grace period. This will complicate the calculation of deadlines and adds uncertainty about when a mark will actually expire for non-renewal. In addition, it appears that Canada may have a longer effective grace period than is the case under the Madrid Protocol. It is recommended that the Draft provide that the Registrar will send a notice following the renewal date, should any registration not be renewed, but that the notice will not impact the 6 month grace period.

s. 76 – very awkward and confusing language. Recommend instead that the section provide that any registration resulting from a merger will have a term for renewal that is calculated from the earliest registration date of the merged registrations.

Objections

Fees

s. 77 – while this is not a new fee, what is the justification for a higher fee than the opposition fee?

See comments above regarding calculation of deadlines, service, amendment of a counterstatement, impact of failure to file evidence/submissions, and clarity of wording.

There appear to be a number of clerical errors under this heading, relating to s. 11.13 – and the subsections that apply.

s. 80 – the list in (1) (a) to (d) should be followed by “or” rather than “and”.

Madrid Protocol

General comments

There is little information about fees or the handling of correspondence relating to both applications for international registration submitted by the Registrar, acting as Office of Origin, or Protocol Applications and Registrations. An exception is the divisionals provision (s. 122), and there does not appear to be any reason for that specific exception. At the least, the Regulations should include a provision that fees for any steps set out in these sections will be paid in accordance with the Madrid Protocol and the Common Regulations. In addition, some indication should be made regarding correspondence – for example, how the Registrar will handle any correspondence from the International Bureau that impacts a Canadian party (applicant, registrant, opponent).

Consider adding to s. 95 definitions of “Office of Origin” “provisional refusal” and “total provisional refusal”.

There is concern about the impact of any failure of the Registrar to take a required step in a timely matter. What remedy is there for an applicant/registrant or opponent? Could new s. 41(3) apply in such a case, permitting the Registrar to “correct” any mistake or omission? Clarification of any remedy, eg. an appealable decision under s. 56, invalidity under s. 18, or any other recommendation is required.

Finally, can the Common Regulations be incorporated or applied without specific legislation to that effect?

Specific comments

s. 95 – date of notification of territorial extension – how will that date be known? What means of notice/effective date?

s. 96 – As read, this section initially suggests that certain *dies non* will not apply to Protocol applications. However, the Common Regulations, Rule 4, provide for *dies non*. Since the Regulations may be viewed as the “entire” legislative scheme for Madrid Protocol applications unless otherwise noted, any section that is modified in any way by the Madrid Protocol or the Common Regulations should specifically state so. This section should thus begin by stating that for the purpose of specific sections, Rule 4(4) of the Common Regulations will apply, as opposed to that being a secondary comment in s. 96(2).

NOTE, that Rule 4(4) of the Common Regulations contains ambiguous language regarding closings of the International Bureau (“IB”) “or” the Office of Origin. This issue should be clarified.

s. 97- while “country of origin” in the Act includes “citizen”, that word is omitted from the “entitlement” provision. A person need be a national or domiciled. Was “citizen” omitted intentionally? Applies also in **s. 98 (c) and 100(1)(a)**.

s. 98(e) – how will applications/registrations filed/issued before the coming into force date, that have drawings that are not in colour be treated? Will the applicant need to supply new colour drawings of the mark?

It is recommended that the list of information needed for an application also specify that it “may” include the **name and contact details of a trademark agent**. It is expected that Madrid Protocol filings will be complex enough to require the assistance of a trademark professional, and that person’s name should be identified for any subsequent communications.

s. 99 – Add “or on behalf of a person” in front of the words “a person” on line 2. The language in (c) is confusing, and it is recommended that the subsection be broken into further segments.

s. 100 – to avoid any doubt, the normal way of securing a transfer of rights, namely, through a registrant-initiated request to the International Bureau, should precede the option of having the Canadian transferee file the request.

s. 101 - what is the timeline of the transmission?

s. 102(3) – it does not seem possible to simply “deem” a territorial extension originating from a collective mark or a guarantee mark to be a “certification mark”, which has a defined and jurisprudential meaning. A “collective” mark is normally a very different type of mark, and should be protected by specific provisions.

s. 103 – uses the term “not registrable”. The concept of non-registrability is focused upon factors specifically named in s. 12 of the Act, which is not drafted to include the situation described in this section. Accordance, an opposition could not be made on non-registrability grounds even if the goods are not within the scope of the international registration. It is recommended that this provision instead state that should the goods or services not be within the scope of the international registration, the application shall be deemed not to comply with s. 30 of the Act.

s. 106 – what notice will be given of any “deemed amendment” of goods/services under this section, or others that result in changes to the list of goods/services in any application or registration? While a notice might not be required for any application that has not yet been advertised, what about applications that have been advertised (eg. if amended during the course of an opposition), or following registration? What chance will an applicant have to respond to a notice under s. 106(4)?

s. 109 – refers to partial cancellation. However, the impact is to deem the Protocol application to be “amended or withdrawn accordingly”. If there is only a partial cancellation, there should not be any “withdrawal”, so that reference should be removed.

s. 112 – what would be the impact on the date of deemed withdrawal of a failure of the IB to notify the Registrar of the failure to renew an international registration?

s.116 – what is the effect on any opposition of the options given to an applicant under this provision?

s. 127 – as an observation, the inability to amend a statement of opposition will result in all opposition grounds being relied upon, making it very difficult for the applicant to actually understand the basis of the opposition.

s. 129 – if a Protocol application is refused with respect to “some” of the goods/services, what notice will the Registrar send to the IB? **Section 129(b)** contemplates a notice of total provisional refusal being given when there is a decision regarding “all” of the goods/services, but there is nothing regarding a partial refusal.

s. 131 – this provision is very awkwardly worded and unclear. It should address any decision that is in favour of applicant for all or some of goods/services. **Section 131(1)(b)** should include as events a withdrawal of an appeal. As drafted now, the options are the appeal term has ended with no appeal, or appeal filed and final judgement issued. **Section 131(1)(d)(ii)** – calculation of dates is extremely complicated. For example, “the day on which the opposition period began” – isn’t that the date of advertisement of the application? If so, it should state so in those words, which use a well-known event to set a deadline.

s. 134(4) – permits the Registrar to declare that a limitation of goods/services has no effect in Canada for any goods/services that do not meet the requirements of s. 134(2). However, if the Canadian registration is, in essence, dependent on an IR that has now been changed to a different list of goods/services, what rights will the owner of a Protocol Registration in Canada that no longer reflects the IR actually have? Also, there does not appear to be any recourse for the owner of a Protocol Registration should the Registrar take this step. Section 139, for example, states that the Registrar must send a notification of provisional refusal in the event of a comparable “correction”, and provides for a possible response by the registrant.

s. 146 – there are no fees set for “transformation”.

While the holder of the IR rights may request transformation within 3 months, if it does not do until the end of the 3 months term, to all 3rd parties, it will appear as if the holder of the IR has lost its rights in

Canada. Presumably, any entitlement rights acquired by a 3rd party during those 3 months will be extinguished by the wording of s. 147, which deems the holder's rights in the "transformed" application/registration to be reinstated as of the date of cancellation. Given the impact on potential loss of rights by a 3rd party, what notice will be given of the "cancellation" on the Register, and what description will be given relating to the transformation on the Register?

Transitional Provisions

As a general comment, these are **extremely difficult** to understand, and make sense only with reference to the Public Consultation document. Comprehension will be particularly difficult for self-represented trademark owners. There are also wording inconsistencies – such as "have been received by the Registrar" and "have been delivered to the Registrar (s. 152). Sections **157-159** particularly would benefit from simplification.