

Intellectual Property Institute of Canada (IPIC) Submission on the Proposed Amendments to the *Trade-marks Regulations*

Submission to the
Canadian Intellectual Property Office

July 21, 2017

INTRODUCTION

The Intellectual Property Institute of Canada (IPIC) is a professional association of patent agents, trademark agents and lawyers practising in all areas of intellectual property law. Our membership totals over 1700 individuals, consisting of practitioners in law firms and agencies of all sizes, sole practitioners, in-house corporate intellectual property professionals, government personnel, and academics. Our members' clients include virtually all Canadian businesses, universities and other institutions that have an interest in intellectual property (e.g. patents, trademarks, copyrights and industrial designs) in Canada and elsewhere, and also foreign companies that hold intellectual property rights in Canada.

Thank you for the opportunity to participate in the Public Consultation on the Proposed *Trade-marks Regulations*.

This document is a compilation of material received from members of the Trademark Legislation Committee and the Trademark Practice Committee. We can advise that these members are substantially in agreement with these viewpoints.

The general viewpoint of the members is that the draft *Trade-marks Regulations* document is well drafted and covers the necessary points. There are some points of clarification and comments noted below along with some points of recommendations. Particularly where clarification is requested, it is acknowledged that some points may become better understood with more familiarity with the changes, particularly as they apply to the Madrid Protocol section. However, the difficulty with comprehension suggests that in many cases, simpler language would be preferred.

The format of the following is to embed comments, requests for clarification and recommendations for change underneath the specific section in the Draft Regulations.

IPIC welcomes the opportunity for further dialogue on these comments and would be pleased to answer any questions.

PART 1 Rules of General Application

Interpretation

Definitions

1 (1) The following definitions apply in these Regulations.

...

associate trademark agent means a trademark agent appointed by another trademark agent under subsection 22(2) or (3). (agent de marques de commerce associé)

RECOMMEND: Amending this to read as “... subsection 22(2) or 22(3).”

...

Limit on written communications

3 (1) A written communication to the Registrar must not relate to more than one application for the registration of a trademark or more than one registered trademark.

Exceptions

(2) Subsection (1) does not apply in respect of

- (a) a change in a name or address;
- (b) a payment of a fee for the renewal of a registration;
- (c) a cancellation of a registration;
- (d) a transfer of a registered trademark or of an application for the registration of a trademark;
- (e) an appointment or revocation of an appointment of a trademark agent;
- (f) a correction of an error; and
- (g) evidence, written representations or requests for a hearing provided in a proceeding referred to in section 11.13, 38 or 45 of the Act.

CLARIFICATION: The words “or other document affecting the rights to” an application/registration (found in current 5(2)(d)) have been removed; how will this impact requests for recordal of security agreements?

Written communications regarding applications for registration

4 (1) A written communication to the Registrar in respect of an application for the registration of a trademark must include the name of the applicant and, if known, the application number.

RECOMMEND: Amending this to read as “... must include the name of the applicant, the trademark and, if known, the application number.”

Written communications regarding registered trademarks

(2) A written communication to the Registrar in respect of a registered trademark must include the name of the registered owner and either the registration number or the number of the application that resulted in the registration.

RECOMMEND: Amending this to read as “... must include the name of the registered owner, the trademark and either the registration number or the number of the application that resulted in the registration.”

Address

5 (1) Joint applicants, opponents and objectors must provide a single address for correspondence.

RECOMMEND: Joint applicants should be permitted to provide multiple addresses, and should they do so, CIPO should correspond with all applicants.

Notice of change of address

(2) A person doing business before the Office of the Registrar of Trademarks must notify the Registrar of any change to their address.

CLARIFICATION: Is an applicant/registrant/opponent a “person doing business before the Office”, or is this wording intended also cover agents? What is the implication of failing to do so?

Form of communication

6 The Registrar is not required to have regard to any communication that is not submitted in writing other than a communication made during a hearing held in a proceeding referred to in section 11.13, 38 or 45 of the Act.

COMMENT: The current Regulations state that the Registrar “may also consider oral communications”. This statement sets a positive tone for encouraging telephone conversations with Examiners. The change in wording seems to

discourage telephone or other oral communications and may negatively impact efficiency of prosecution.

RECOMMEND: Issuing a Practice Notice to clarify that oral communication is encouraged.

Document provided in non-official language

8. If a party provides to the Registrar a document, all or part of which is in a language other than English or French, and does not provide to the Registrar a translation of the document or part into English or French, the Registrar is not required to have regard to it.

RECOMMEND: That this section not apply to exhibits to affidavits filed in opposition and s. 45 proceedings, where non-English/French evidence may be filed to address issues such as distinctiveness or use in Canada.

...

Manner of providing documents, information or fees

9 (1) Unless it is provided by an electronic means in accordance with subsection 64(1) of the Act, a document, information or fee for provision to the Registrar must be provided by physical delivery to the Office of the Registrar of Trademarks or to an establishment that is designated by the Registrar on the website of the Canadian Intellectual Property Office.

Date of receipt — physical delivery to Office

(2) Documents, information or fees that are provided to the Registrar by physical delivery to the Office of the Registrar of Trademarks are deemed to have been received by the Registrar

(a) on the day on which they are delivered to the Office, in the case that they are delivered during the Office's ordinary business hours; or

(b) on the day on which the Office is next open, in any other case.

COMMENT: Different dates of deemed receipt may result in much confusion, especially for applicants acting on their own.

RECOMMEND: Incorporating the Federal Court Rules provisions on deemed delivery/receipt.

...

Acknowledgement of written communications

10 (1) Written communications made before a trademark is registered that are addressed to the Registrar and that are or appear to be against its registration must be acknowledged. However, subject to section 29 of the Act, no information may be given as to any action taken.

RECOMMEND: Amending this to read as “Written communications made by a party other than the applicant or its agents before a trademark is registered ...”

Refund

12 The Registrar must refund any amount paid by a person in excess of the fee that is to be paid by them if the person requests reimbursement no later than three years after the day on which the payment is made.

RECOMMEND: Amending this to read as “The Registrar must refund any amount paid by a person in excess of the fee that was is to be paid by them if the person requests reimbursement no later than three years after the date on which the payment was is made.”

Affidavit or statutory declaration

13 (1) A person who provides the Registrar with a copy of an affidavit or statutory declaration in a matter in respect of which an appeal lies under subsection 56(1) of the Act must retain the original for one year after the day on which the applicable appeal period expires but, if an appeal is taken, until the day on which the final judgment is given in the appeal.

COMMENT: What are the consequences for failure to comply? The Registrar should have discretion to deem that the affidavit/declaration not form part of the record and to return the copy to the person who filed it (such as when an affiant fails to attend for cross examination) if the original is not provided upon request. This gives the Registrar leeway to disregard evidence in a serious case of fidelity/sufficiency of the copy.

Provision of original

(2) On request by the Registrar, the person must provide the original to the Registrar.

COMMENT: The wording does not provide an explicit mechanism for the opposite party to inspect the original.

...

Listing of trademark agents

19 The Registrar must, on written request and payment of the fee set out in item 3 of the schedule, enter on the list of trademark agents kept under section 28 of the Act the name of

- (a) a resident of Canada who has passed the qualifying examination for trademark agents;
- (b) a resident of another country who is authorized to act as a trademark agent under the law of that country; and
- (c) a firm at least one member of which has their name entered on the list as a trademark agent.

COMMENT: Use of the term “trademark agent” is not appropriate under 19(b) as it has been defined under Section 1(1) of the Trademark Regulations.

RECOMMEND: Amending subsection (b) to read as “a resident of another country who is authorized to practice before the Trademarks Office of that country; and”

Maintenance of name on list

20 (1) During the period beginning on January 1 and ending on March 31 of each year,

- (a) a resident of Canada whose name is on the list of trademark agents must, to maintain their name on the list, pay the fee set out in item 4 of the schedule;
- (b) a resident of another country whose name is on the list of trademark agents must, to maintain their name on the list, file a statement signed by them, setting out their country of residence and declaring that they are authorized to act as a trademark agent under the law of that country; and

COMMENT: Use of the term “trademark agent” is not appropriate under 20(b) as it has been defined under Section 1(1) of the Trademark Regulations.

RECOMMEND: Amending subsection (b) to read as “...setting out their country of residence and declaring that they are authorized to practice before the Trademarks Office of that country; and”

Removal from list

s. 20 The Registrar must remove from the list of trademark agents the name of any trademark agent who

- (a) fails to comply with subsection (1)

COMMENT: This refers to payment of the annual fee. It should be confirmed that failure to pay the fee on the date required, for reasons of clerical mistake or inadvertence and especially if rectified within a short period following the deadline, should not impact trademark agent status in Canada.

...

(b) no longer meets the requirements under which their name was entered on the list unless the trademark agent is a person referred to in paragraph 19(a) or (b) or a firm referred to in paragraph 19(c).

RECOMMEND: That this paragraph be reworded to clarify what type of situation will result in the Registrar's removal of an agent or firm who is a registered agent under ss. 19.

Persons authorized to act

25 (1) Subject to subsection (2), in any business before the Office of the Registrar of Trademarks in respect of which a person has appointed a trademark agent,

(a) the person must not represent themselves; and

(b) no one other than the trademark agent, if that agent resides in Canada, or an associate trademark agent appointed by that trademark agent, is permitted to represent that person.

Exceptions

(2) A person who has appointed a trademark agent may represent themselves or be represented by another person authorized by them for the purpose of

(a) filing an application for the registration of a trademark, an application for international registration referred to in sections 97 to 99 or a transformation application referred to in section 146;

(b) paying a fee;

(c) giving notice under section 23;

(d) renewing the registration of a trademark under section 46 of the Act; or

(e) making a request or providing evidence for the purpose of section 48 of the Act.

COMMENT: Section 25(2) would permit an applicant/registrant to authorize a layman to act on their behalf before the Trademarks Office. This is a very wide

scope for non-qualified persons to be practicing before the Office, particularly in respect of filing applications, and a potential source of deception and abuse to unrepresented parties.

RECOMMEND: Amending the wording to read as “A person who has appointed a trademark agent may represent themselves for the purpose of” or alternatively, keeping in mind the goal of the Trademark Office was to allow for registrants to hire companies to pay their multiple registration fees, delete subsection 22(2)(a).

Prohibited Marks

Fee

26 Any person or entity that requests the giving of public notice under paragraph 9(1)(n) or (n.1) of the Act must pay the fee set out in item 6 of the schedule to these Regulations.

COMMENT: With respect to the underlined words above: The language when referring to the schedule is inconsistent. For example, in Section 21(b)(i) it states “...set out in items 4 and 5 of the schedule” but here it says “...set out in item 6 of the schedule to these regulations”.

RECOMMEND: Amending to refer to the schedule consistently throughout.

...

Manner of describing goods or services

29 The statement of the goods or services referred to in paragraph 30(2)(a) of the Act must clearly describe each of those goods or services in a manner that identifies a specific good or service.

CLARIFICATION: It would be useful to know how the Office will interpret this new requirement.

...

Representation or description

Contents

31 The following information or statements are prescribed for the purpose of paragraph 30(2)(d) of the Act:

(a) the applicant's name and postal address;

- (b) if the trademark consists in whole or in part of characters other than Latin characters, a transliteration of those characters into Latin characters following the phonetics of the language of the application;
- (c) if the trademark consists in whole or in part of numerals other than Arabic or Roman numerals, a transliteration of those numerals into Arabic numerals;
- (d) a translation into English or French of any words in any other language that are contained in the trademark;
- (e) if the trademark consists in whole or in part of a three-dimensional shape, a hologram, a moving image, a mode of packaging goods, a sound, a scent, a taste, a texture or the positioning of a sign, a statement to that effect;
- (f) if colour is claimed as a feature of the trademark, a statement to that effect, the name of each colour claimed and an identification of the principal parts of the trademark that are in that colour;
- (g) if the trademark consists exclusively of a single colour or a combination of colours without delineated contours, a statement to that effect and the name of each colour; and
- (h) if the trademark is a certification mark, a statement to that effect.

RECOMMEND: Including a requirement to identify an agent where one is appointed.

...

Request for priority

s. 33(1) For the purpose of paragraph 34(1)(b) of the Act, a request for priority must be filed within six months after the filing date of the application on which the request is based.

COMMENT: This comment pertains to all “timing” clauses. There is confusion with the wording “Within [number] month after the day on which ...”

RECOMMEND: The timing of service throughout the regulations be amended to read as “Within [number] month after service of ...”.

Amendment of Application for Registration of a Trademark

Before registration

35 (1) Subject to subsection (2), an application for the registration of a trademark may be amended before the trademark is registered.

Exceptions

(2) An application for the registration of a trademark may not be amended, other than in accordance with sections 106, 109, 110, 113 and 116,

(a) to change the identity of the applicant, except as a result of the recording of a transfer of the application by the Registrar or, in the case of an application other than a Protocol application as defined in section 95, to correct an error in the applicant's identification;

(b) to change the representation or description of the trademark, unless the application has not been advertised under subsection 37(1) of the Act and the trademark remains substantially the same;

(c) to broaden the scope of the statement of goods or services contained in the application beyond the scope of

(i) the statement of the goods or services contained in the application on its filing date, not taking into account section 34 of the Act or subsection 105(2) of these Regulations,

(ii) the statement of the goods or services contained in the application as advertised under subsection 37(1) of the Act as amended after that advertisement, whichever is narrower, and

ERROR: The term “Actor” should be “Act or”.

(iii) in the case of a Protocol application as defined in section 95, the list of goods or services contained, in respect of Canada, in the international registration on which the application is based at the time of the amendment;

(d) to add an indication that it is a divisional application;

(e) to add or delete a statement referred to in paragraph 31(b) of the Act or paragraph 31(e), (f) or (g) of these Regulations; or

RECOMMEND: That the restrictions on amending to add/delete colour claims be restricted to amendments made after advertisement. Such changes should not adversely impact the rights of third parties if made before advertisement, and inclusion, or not, of colour claims will likely be errors especially made by unrepresented applicants. Also, since the elimination of filing grounds makes it important to file as quickly as possible, delay in sorting out colour claim details may adversely impact priority rights.

(f) after the application is advertised under subsection 37(1) of the Act, to add or delete a statement referred to in paragraph 31(h).

...

Effect of transfer — separate applications

38 If an application for the registration of a trademark becomes, as a result of its transfer as recorded under subsection 48(3) of the Act or section 145 of these Regulations, the property of one person in respect of one or more of the goods or services specified in the application and of another person in respect of any other of those goods or services,

(a) each person is deemed to be the applicant of a separate application in respect of the goods or services for which they own the trademark;

(b) each such separate application is deemed to have the same filing date as the original application; and

(c) any steps taken in relation to the original application before the day on which the transfer is recorded are deemed to have been taken in relation to each of the separate applications.

CLARIFICATION: It remains unclear how the separate applications/registrations will be designated.

Steps deemed to have been taken

40 (1) If an original application for the registration of a trademark is divided, any steps taken in relation to the original application on or before the following day are deemed to have been taken in relation to the resulting divisional application:

(a) if all of the goods or services specified in the divisional application on its division day ceases to be within the scope of the original application after the end of the two-month period referred to in subsection 38(1) of the Act, read without reference to any extension to that period under section 47 of the Act, that division day;

ERROR: “ceases” should be “cease”.

...

Division day

(3) For the purpose of subsection (1), the division day is

(a) in respect of a divisional application referred to in section 123, the day on which the International Bureau notifies the Registrar of the creation of the corresponding divisional international registration; and

(b) in respect of any other divisional application, the day on which the divisional application is filed, not taking into account subsection 34(1) or 39(4) of the Act.

RECOMMEND: Moving the definition of “Division day” up to the top of Section 40 of the Regulations. That is - renumber 40(3) to 40(1), 40(1) to 40(2) and 40(2) to 40(3). Even with this change, this paragraph remains difficult to comprehend.

RECOMMEND: That the intent of the section be made clearer.

Advertisement

Manner

41 For the purpose of subsection 37(1) of the Act, an application is advertised by publishing on the website of the Canadian Intellectual Property Office:

COMMENT: Previously, advertisement was made in the Journal, and the date of the Journal publication was clear. Referencing the application as advertised by publishing the listed particulars on the website of the Canadian Intellectual Property Office may be confusing. The particulars set out in Section 41(a) to (j) would also be contained in the database record for the application, which is available on the website of the Canadian Intellectual Property Office.

CLARIFICATION: How is advertisement different from making the database record accessible to the public? Will the Office give Applicants notice of the advertisement date in the Approval Notice?

...

Manner of service

46 (1) Service of a document in respect of an opposition proceeding must be effected

(a) by personal service in Canada;

(b) by registered mail to an address in Canada;

(c) by courier to an address in Canada;

(d) by the sending of a notice to the other party advising that the document to be served has been filed with or provided to the Registrar, if the party seeking to effect service does not have the information necessary to permit them to serve the other party in accordance with any of paragraphs (a) to (c); or

(e) in any manner that is agreed to by the parties.

Effective date of service

(2) Subject to subsections (3) to (6) and (9), service is effective on the day on which the document is delivered.

Exception — service by registered mail

(3) Service by registered mail is effective on the day on which the document is mailed.

ERROR: Should read as “Service by registered mail is effective on the day on which the document is mailed.”

COMMENT: See comments above regarding deemed dates of receipt. A single deemed receipt date would offer more certainty and less risk of mistake or inadvertent miscalculation of deadlines.

...

Proof of service

(8) A party that serves a document must, on request of the Registrar, provide proof of service within one month after the date of the request. If proof of service is not provided within that month, the document is deemed not to have been served.

CLARIFICATION: What will trigger the Registrar to make a request under section 46(8)?

Manner of submitting evidence

s.49. Evidence in respect of an opposition proceeding, other than evidence referred to in subsection 56(3) of these Regulations, is to be submitted to the Registrar by way of affidavit or statutory declaration. However, if the evidence consists of a document or extract from a document in the official custody of the Registrar, it is to be submitted by way of a certified copy referred to in section 54 of the Act.

RECOMMEND: That it be clarified that this does not require “state of the Register evidence” to consist of certified copies of applications and registrations.

...

Circumstances — deemed withdrawal of opposition

51 For the purpose of subsection 38(10) of the Act, the circumstances under which the opponent's not submitting and serving evidence referred to in subsection 38(8) of the Act or a statement that the opponent does not wish to submit evidence results in their opposition being deemed to have been withdrawn are that neither that evidence nor that statement has been submitted and served by the opponent by the end of the four-month period referred to in section 50 of these Regulations.

COMMENT: This wording seems cumbersome.

RECOMMEND: This be amended to read as “For the purpose of subsection 38(10) of the Act, the failure of the opponent to submit and serve evidence referred to in subsection 38(8) of the Act or a statement that the opponent does not wish to submit evidence by the end of the four-month period referred to in section 50 of these Regulations results in the opposition being deemed to have been withdrawn.”

Timing — evidence of the opponent

52 (1) The time within which the applicant may, under subsection 38(8) of the Act, submit evidence and must, under subsection 38(9) of the Act, serve any such evidence on the opponent is four months after the day on which the opponent's service under section 50 of these Regulations is effective. ...

ERROR: “evidence of the opponent” in the title should read “evidence of the applicant”.

Circumstances — deemed abandonment of application

53 For the purpose of subsection 38(11) of the Act, the circumstances under which the applicant's not submitting and serving evidence referred to in subsection 38(8) of the Act or a statement that the applicant does not wish to submit evidence results in their application being deemed to have been abandoned are that neither that evidence nor that statement has been submitted and served by the applicant by the end of the four-month period referred to in section 52 of these Regulations.

COMMENT: This wording seems cumbersome.

RECOMMEND: That similar changes to those mentioned in section 51 be made, namely: be amended to read as “For the purpose of subsection 38(11) of the Act, the circumstances under which the failure of the applicant to submit and serve

evidence referred to in subsection 38(8) of the Act or a statement that the applicant does not wish to submit evidence by the end of the four-month period referred to in section 52 of these Regulations results in their application being deemed to have been abandoned.

Reply evidence — timing

54 Within one month after the day on which the applicant's service on the opponent under section 52 is effective, the opponent may submit to the Registrar reply evidence and, if so, must serve it on the applicant.

COMMENT: The one-month time limit is not long enough to permit the applicant's evidence to be reviewed, reported to the client, for instructions to be received and for any reply evidence to be prepared and filed.

RECOMMEND: That a longer time limitation for filing reply evidence be specified in section 54 or, at the very least, that it be made clear that this deadline may be extended without any requirement for consent

...

Ordering of cross-examination

56 (1) On the application of a party made before the Registrar gives notice in accordance with subsection 57(1), the Registrar must order the cross-examination under oath or solemn affirmation, within the period specified by the Registrar, of any affiant or declarant on an affidavit or statutory declaration that has been submitted to the Registrar and is being relied on as evidence in the opposition proceeding.

CLARIFICATION: This assumes that cross-examination may be requested at any time before written representations are requested by the Registrar. Clarification on the impact on evidence, and evidence deadlines, as well as requests for leave to file additional evidence or re-examine should be clarified. Does it still leave room to “split a case” as under the current practice, where the applicant can request cross on the opponent's evidence before filing their own evidence?

Holding of cross-examination

(2) The cross-examination is to be conducted as agreed to by the parties or, in the absence of an agreement, as specified by the Registrar

Transcript and undertakings

(3) Within the period specified by the Registrar for the holding of the cross-examination,

(a) the party that applied for the cross-examination must submit to the Registrar and serve on the other party the transcript of the cross-examination and exhibits to the cross-examination; and

(b) the party that was cross-examined must submit to the Registrar and serve on the other party any information, document or material that they undertook to provide in the course of the cross-examination.

Inadmissibility in absence of cross-examination

(4) An affidavit or statutory declaration is not to be part of the evidence if the affiant or declarant declines or fails to attend for cross-examination.

RECOMMEND: Section 56(4) also give the Registrar discretion to strike out all or part of the evidence for failure to answer undertakings.

Written representations

57 (1) After all evidence has been filed, the Registrar must give the parties notice that they may submit written representations to the Registrar.

COMMENT: The proposed wording is problematic because there is always the prospect of additional evidence being filed pursuant to new Rule 55 and thus, not all of the evidence will have yet been filed, as is required by the regulations.

RECOMMEND: The regulations should specify something along the lines of: “No less than * after the time for the expiry of submitting and serving the applicant’s evidence or a statement under section 52, or where reply evidence is submitted under section 54, after the time for expiry of serving the reply evidence, the Registrar must give the parties notice that they may submit written representations to the Registrar.”

CLARIFICATION: Are there intended to be consequence for failure to serve written representations on the other party? There does not seem to be any explicit discretionary remedy available to the Registrar.

...

Request for hearing

58 (1) Within one month after the day on which the applicant's service on the opponent of written representations or of a statement that the applicant does not wish to make written representations is effective — but, if no such service is effective within the two-month period described in subsection 57(3), within one month after that period's expiry — a party who wishes

to make representations to the Registrar at a hearing must file with the Registrar a request that indicates

(a) whether they intend to make representations in English or French and whether they will require simultaneous translation if the other party makes representations in the other official language; and

(b) whether they wish to make representations in person, by telephone, by video conference or by other means of communication offered by the Registrar and sets out any information necessary to permit the use of the chosen means of communication.

RECOMMEND: Amending to require the filing of substantive written submissions addressing the evidence and relevant case law as a prerequisite to the filing of a request for a hearing.

RECOMMEND: Including a subsection that no person shall make oral representations at a hearing that are not referred to in their written submissions, without prior written leave of the Opposition Board and notice to the other party.

s. 58(2) If a party does not file a request in accordance with subsection (1), they may not make representations at the hearing.

COMMENT: It is in the interest of justice and the parties that should a hearing be held, all parties be permitted to participate. In many case, whether or not a hearing is requested will depend on the response of the other party. If a hearing is requested on the last day for doing so, a party may be deprived of the right to make representations, when it would have done so if it had known a hearing would be requested. This ruling will disadvantage parties, and may have the unintended effect of forcing parties to an opposition to always request a hearing, to ensure that they have the right to be heard.

RECOMMEND: That this provision be deleted and should a hearing be requested by any party, all parties have the right to appear and make representations. However, each party wishing to be heard should notify the Registrar in advance, to ensure that all necessary hearing and translation requirements can be made.

The same comments apply to hearings requested as part of an objection to a geographical indication and in section 45 proceedings.

...

Requested statement of goods or services — timing

63 For the purpose of subsection 44.1(1) of the Act, the time within which a registered owner must furnish the Registrar with a statement of goods and services grouped in the manner described in subsection 30(3) of the Act is six months after the date of the notice given to them.

CLARIFICATION: What will trigger the timing of the issuance of the notice by the Registrar? Is there a particular time during the life-cycle of a registration when that the notice will be issued?

CLARIFICATION: Will the Registrar, if requested, issue a single notice requiring a response under both section 44.(1) and section 45 (assuming that the prescribed fee is paid)?

CLARIFICATION: Will the Registrar, in a notice to a registrant sent under section 44(1), identify the person who requested that the notice be sent and paid the prescribed fee?

Effect of transfer — separate registration

65 If a registered trademark becomes, as a result of its transfer as registered under subsection 48(4) of the Act or section 145 of these Regulations, the property of one person in respect of one or more of the goods or services specified in the registration and of another person in respect of any other of those goods or services, each person is deemed to be the owner of a separate registration in respect of the goods or services for which they own the trademark and each such separate registration is deemed to have the same registration date as the original registration.

CLARIFICATION: Will separate registration numbers be assigned?

...

Proceedings Under Section 45 of Act

CLARIFICATION: Should there be any restrictions on making requests for notice under section 45 where a requestor has recently (but not simultaneously) made a request for notice under section 44(1)?

COMMENT: Steps under Section 45 do not make sense if it is the Registrar initiating the proceeding. That is, the Registrar is not likely file written submissions in response to evidence of use being filed. Nor may a hearing be required.

RECOMMEND: Having two different requirements for Section 45 proceedings – one for the Registrar and one for third parties.

Forwarding copies of documents

68 A party to a proceeding under section 45 of the Act who on a given day, after the Registrar has given notice under subsection 45(1) of the Act, provides a document, other than a document that they are otherwise required to serve on another party, to the Registrar that relates to the proceeding must, on that day, forward a copy of it to the other party.

CLARIFICATION: What is the practical consequence for failure to comply with the requirement to forward a copy under Rule 68?

Service on representative of party

69 A party to a proceeding under section 45 of the Act may file with the Registrar and serve on any other party to the proceeding a notice setting out the name and address in Canada of a person or firm on whom service of any document in respect of the proceeding may be made with the same effect as if it had been served on them.

RECOMMEND: If an agent has been appointed, there should be a requirement to identify that agent in a document submitted to Registrar and served on the other party.

...

Written representations

72 (1) After the registered owner has furnished an affidavit or statutory declaration to the Registrar in response to a notice given under subsection 45(1) of the Act, the Registrar must give the parties notice that they may submit written representations to the Registrar.

CLARIFICATION: What is the expected timing of issuance of the notice by the Registrar?

...

Request for hearing

73 (1) Every party wishing to make representations to the Registrar at a hearing must, within the period set out in subsection (2), file with the Registrar a request that

(a) indicates whether the party intends to make representations in English or French and whether they will require simultaneous translation if another party makes representations in the other official language; and

(b) indicates whether the party wishes to make representations in person, by telephone, by video conference or by other means of communication offered by the Registrar and sets out any information necessary to permit the use of the chosen means of communication.

Period

(2) For the purpose of subsection (1), the period is

(a) if the notice referred to in subsection 45(1) of the Act was given on the Registrar's own initiative, one month after the day on which the registered owner submits to the Registrar written representations or a statement that they do not wish to make written representations or, if no such submission is made within the period referred to in subsection 72(2) of these Regulations, one month after that period's expiry; or

(b) if the notice referred to in subsection 45(1) of the Act was given at the request of a person, one month after the day on which the registered owner's service of written representations or of a statement that they do not wish to make written representations is effective or, if no such service is effective within the period referred to in paragraph 72(3)(b) of these Regulations, one month after that period's expiry.

Prohibition

(3) If a party does not file a request in accordance with subsection (1), they may not make representations at the hearing.

RECOMMEND: Amending to require the filing of substantive written submissions addressing the evidence and relevant case law as a prerequisite to the filing of a request for a hearing.

RECOMMEND: Including a subsection that states something to the effect that, no person shall make oral representations at a hearing that are not referred to in their written submissions, without leave of the Opposition Board.

RECOMMEND: That s. 73(3) be deleted (see comments above in the Opposition section).

Renewal of Registration

Prescribed period

75 For the purpose of section 46 of the Act, the period within which the renewal fee is to be paid begins on the day that is six months before the expiry of the initial period or the renewal period, as the case may be, and ends at the later of the end of the six-month period beginning after that

expiry and the end of the two-month period beginning after the date of the notice referred to in subsection 46(2) of the Act.

COMMENT: The provision is more confusing and uncertain than the current practice. It is felt that there is no need for a 2-month period and requiring a registrant to figure out which late renewal deadline applies. In addition, the 2-month term would appear to change the grace period that applies under the Madrid Protocol, raising the possibility of differing grace periods.

RECOMMEND: If the Registrar sends a renewal notice, it state that the late renewal deadline is six-months after the expiry of the initial or renewed term.

...

Forwarding copies of documents

79 A party to an objection proceeding who on a given day, after a statement of objection has been filed with the Registrar under subsection 11.13(1) of the Act, provides a document, other than a document that they are otherwise required to serve on another party, to the Registrar that relates to the objection must, on that day, forward a copy of it to the other party.

CLARIFICATION: What are the consequences for failure to forward copies of documents?

...

Ordering of cross-examination

90 (1) On the application of a party made before the Registrar gives notice in accordance with subsection 91(1), the Registrar must order the cross-examination under oath or solemn affirmation, within the period specified by the Registrar, of any affiant or declarant on an affidavit or statutory declaration that has been submitted to the Registrar and is being relied on as evidence in the objection proceeding.

Holding of cross-examination

(2) The cross-examination is to be conducted as agreed to by the parties or, in the absence of an agreement, as specified by the Registrar.

Transcript and undertakings

(3) Within the period specified by the Registrar for the holding of the cross-examination,

(a) the party that applied for the cross-examination must submit to the Registrar and serve on the other party the transcript of the cross-examination and exhibits to the cross-examination; and

(b) the party that was cross-examined must submit to the Registrar and serve on the other party any information, document or material that they undertook to provide in the course of the cross-examination.

RECOMMEND: Section 90(3) also give the Registrar discretion to strike out all or part of the evidence for failure to answer undertakings.

...

Request for hearing

92 (1) Within one month after the day on which the responsible authority's service on the objector of written representations or of a statement that the responsible authority does not wish to make written representations is effective — but, if no such service is effective within the two-month period described in subsection 91(3), within one month after that period's expiry — a party who wishes to make representations to the Registrar at a hearing must file with the Registrar a request that indicates

(a) whether they intend to make representations in English or French and whether they will require simultaneous translation if the other party makes representations in the other official language; and

(b) whether they party wish to make representations in person, by telephone, by video conference or by other means of communication offered by the Registrar and sets out any information necessary to permit the use of the chosen means of communication.

Prohibition

(2) If a party does not file a request in accordance with subsection (1), they may not make representations at the hearing.

RECOMMEND: Amending to require the filing of substantive written submissions addressing the evidence and relevant case law as a prerequisite to the filing of a request for a hearing.

RECOMMEND: Including a subsection that states something to the effect that, no person shall make oral representations at a hearing that are not referred to in their written submissions, without leave of the Opposition Board.

PART 2 Implementation of Madrid Protocol

COMMENT: The Regulations will be viewed by many as the complete guide to the Madrid Protocol. However, a full understanding of the procedure is only possible by also reading and incorporating provisions from the Common Regulations. For any section that is modified or impacted by the Common Regulations, there should be a specific mention of that provision in the Canadian regulations.

General

Interpretation

95 The following definitions apply in this Part.

...

date of notification of territorial extension means the day on which the International Bureau sends to the Registrar a notification of a request made under Article 3ter(1) or (2) of the Protocol. (date de notification d'extension territoriale)

CLARIFICATION: Not clear on the meaning of “sends” and the manner of transmission. Is this the mailing date or the date on which the notification is received by the Office? What if this is received on a day the Office is closed for business?

Non-application of section 66 of Act

96 (1) Section 66 of the Act does not apply in respect of periods fixed by this Part, except

- (a)** the two-month period fixed by subsections 116(2) and (3) of these Regulations;
- (b)** the maximum four-month extension fixed by section 124 of these Regulations; and
- (c)** the three-month period fixed by section 146 of these Regulations.

COMMENT: Which closure days are the same for CIPO and the International Bureau, and which are different will have to be well publicized.

Application of Rule 4(4) of Common Regulations

(2) Rule 4(4) of the Common Regulations applies to all periods fixed by this Part other than those referred to in paragraphs (1)(a) to (c) of this section.

CLARIFICATION: Rule 4(4) of the Common Regulations contains ambiguous language regarding closings of the International Bureau (“IB”) “or” the Office of

Origin. What is the implication if one is open and the other is not. This issue should be clarified.

...

Requirements

97 A person may file with the Registrar an application for international registration of a trademark for presentation to the International Bureau if they meet the following requirements:

(a) the person is a national of or domiciled in Canada or has a real and effective industrial or commercial establishment in Canada; and

CLARIFICATION: No reference to “citizen”. Is there a legal distinction between a national and a citizen in Canada?

...

Contents

98 (1) Every application for international registration filed with the Registrar must include

(a) the applicant's name and postal address;

(b) the number and filing date of the basic application or the number and date of registration of the basic registration;

(c) a statement that

(i) the applicant is a national of Canada,

CLARIFICATION: See above. No reference to “citizen”. Is there a legal distinction between a national and a citizen in Canada?

(ii) the applicant is domiciled in Canada, accompanied by the address of the applicant's domicile in Canada if the address filed under paragraph (a) is not in Canada, or

(iii) the applicant has a real and effective industrial or commercial establishment in Canada, accompanied by the address of the applicant's industrial or commercial establishment in Canada if the address filed under paragraph (a) is not in Canada;

RECOMMEND: Including a definition for “real and effective industrial or commercial establishment” under Section 95.

COMMENT: Requirement to provide address is more onerous than that necessary for the purposes of a priority claim in a basic application.

(d) if colour is claimed as a feature of the trademark in the basic application or the basic registration, the same claim;

COMMENT: Should provision not be made for more specific colour claims if the applicant wishes? The requirement should not be that the colour claim is “the same” but rather that it simply be no broader than the original claim. An agreement specific to a particular jurisdiction might for example require an Applicant to claim not just green, but light green or use a Pantone shade. The regulations should not preclude this.

(e) a reproduction of the trademark, which must be in colour if the trademark is in colour in the basic application or basic registration or if colour is claimed as a feature of the trademark in the basic application or the basic registration;

CLARIFICATION: 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?

(f) if the trademark in the basic application or basic registration is a certification mark or consists in whole or in part of a three-dimensional shape or a sound or consists exclusively of a single colour or a combination of colours without delineated contours, an indication to that effect;

(g) a list of the goods or services for which international registration is sought, which

(i) is limited to goods or services within the scope of the basic application or basic registration; and

RECOMMEND: Amending to “is limited to goods or services within the scope of the basic application as at the filing date of the basic application or basic registration”.

RECOMMEND: Adding “the amount of the fee being paid to the International Bureau and the method of payment, or instructions to debit the required amount to an account opened with the International Bureau, and the name of the person effecting the payment or giving the instructions.”

CLARIFICATION: How will any inconsistency or disagreement regarding Nice Classification between the Canadian Registrar and the International Bureau be handled?

Functions of Registrar

Office of origin

99 On receipt of an application for international registration filed in accordance with section 98 by a person who meets the requirements set out in section 97, the Registrar must, in respect of that application, act as the Office of origin in accordance with the Protocol and the Common Regulations, including by

RECOMMEND: Amending this to read as “...with section 98 by a person or on behalf of a person who meets the requirements.”

Change in Ownership of International Registration

Request for recording

100 (1) A transferee of an international registration may file with the Registrar a request for the recording of a change in ownership of the international registration for presentation to the International Bureau if the following requirements are met:

(a) they are a national of or domiciled in Canada or have a real and effective industrial or commercial establishment in Canada; and

(b) they have been unable to obtain on the request the signature of the holder of the international registration or that of their representative recorded in accordance with Rule 3(4)(a) of the Common Regulations.

CLARIFICATION: Is any proof of a request made to the holder needed?

RECOMMEND: In respect of s. 100 to avoid any doubt, wording regarding 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.

RECOMMEND: Requiring transferee to indicate and therefore have on record, the efforts of the transferee to obtain a signature. This approach would be more consistent with s. 101 wording involving evidence of a transfer.

...

Manner of filing

(3) The application for international registration must be filed

(a) by using the online service that is accessible through the website of the Canadian Intellectual Property Office; or

(b) by completing the form issued by the International Bureau and providing it to the Registrar by an electronic means specified by the Registrar.

CLARIFICATION: What electronic means will be specified by the Registrar?

...

Accompanying documents

(3) The request must be accompanied by

(a) evidence of the transfer; and

(b) a statement to the effect that the transferee made efforts to obtain the signature of the holder of the international registration or that of their representative recorded in accordance with Rule 3(4)(a) of the Common Regulations and that their efforts were not successful.

CLARIFICATION: Statement required is not a sworn statement – what is consequence of a false statement?

Transmission to International Bureau

101 The Registrar must transmit to the International Bureau a request for the recording of a change in ownership that is filed in accordance with section 100 if the Registrar considers the evidence of the transfer to be satisfactory.

CLARIFICATION: What is timeline for transmitting a request to IB? Must the Registrar notify requesting party if evidence of transfer is not satisfactory?

...

Non-Registrable Trademarks

Goods or services outside scope of international registration

103 A trademark that is the subject of a Protocol application is not registrable if the goods or services specified in the Protocol application are not within the scope of the international registration.

CLARIFICATION: The concept of “registrability” does not deal with goods/services descriptions. A specific amendment would appear to be

necessary to the Act to permit this to be treated as a “registrability” issue. How will the fact that Protocol application is not within the scope of the IR be raised as a ground of Opposition? How will the validity of any such registration be challenged? The provisions in the Act regarding grounds of opposition are clear, and registrability does not apply to any provision in the Regulations such as this.

...

Date of international registration

105 (1) The filing date of a Protocol application is

(a) if the Protocol application results from a request made under Article 3ter(1) of the Protocol, the date of international registration of the corresponding international registration; and

(b) if the Protocol application results from a request made under Article 3ter(2) of the Protocol, the date borne by the subsequent designation under Rule 24(6) of the Common Regulations.

CLARIFICATION: What is the rationale behind use of the term “date borne by”? Use of the more archaic “borne” could bring ambiguity that the plain language would avoid.

RECOMMEND: Use the plain wording “date of the subsequent designation”.

Amendment or Withdrawal of Protocol Application

Recording resulting in deletion

106 (1) Subject to subsection (3), if, in respect of an international registration on which a Protocol application is based, the International Bureau notifies the Registrar of the recording in the International Register under Rule 27(1)(a) of the Common Regulations of a limitation of the list of goods or services in respect of Canada that results in a deletion of a good or service from that list, the Protocol application is deemed to be amended or withdrawn accordingly.

CLARIFICATION: What “from that list” means. Is it the list specific to Canada or the entire IR listing?

Recording resulting in new list

(2) If a notification referred to in subsection (1) by the International Bureau of a recording of a limitation is made and that recording results in a new list of goods or services, the Registrar must determine, with respect to each good or service in the new list, whether the following requirements are met:

(a) the good or service is within the scope of the Protocol application on its filing date, not taking into account subsection 105(2), and on the date of the recording in the International Register;

(b) the good or service is within the scope of the Protocol application as advertised, if the date of the recording in the International Register is on or after the day on which the application is advertised under subsection 37(1) of the Act; and

(c) the good or service is clearly described in ordinary commercial terms and in a manner that identifies a specific good or service.

Consequences of new list

(3) The Protocol application is deemed to be amended to include any good or service in the new list that meets the requirements set out in subsection (2).

CLARIFICATION: What public notice will be given of the deemed amendment?

Declaration to International Bureau

(4) The Registrar must, in accordance with Rule 27(5) of the Common Regulations, send to the International Bureau a declaration that the limitation has no effect in Canada in respect of any good or service in the new list that does not meet the requirements set out in paragraph (1)(b).

COMMENT: This provision authorizes the Office to issue a declaration that an “amendment” of the international registration will have no effect in Canada because the goods and services are not in “ordinary commercial terms”, etc. However, there seems to be no obligation to notify the applicant or give them an opportunity to argue the issue. This seems inconsistent with principles of fairness and another similar provision of the regulations, namely section 139(2) which provides a period to respond to such objections arising from a “correction” of the international register.

RECOMMEND: A subsection similar to 139(2) be added here.

...

Complete renunciation

107 If, in respect of an international registration on which a Protocol application is based, the International Bureau notifies the Registrar of the recording in the International Register of a renunciation in respect of Canada for all of the goods or services, the Protocol application is deemed to be withdrawn.

Complete cancellation

108 If, in respect of an international registration on which a Protocol application is based, the International Bureau notifies the Registrar of the recording in the International Register of a cancellation of the international registration for all of the goods or services, the Protocol application is deemed to be withdrawn.

Partial cancellation

109 If, in respect of an international registration on which a Protocol application is based, the International Bureau notifies the Registrar of the recording in the International Register of a cancellation of the international registration for at least one but not all of the goods or services, the Protocol application is deemed to be amended or withdrawn accordingly.

COMMENT: For sections 107, 108 and 109, when will deemed renunciation or changes be apparent to interested third parties? Will a specific notice be given to the applicant, and will the Register show that there has been an amendment or withdrawal for the reasons specified in this section?

CLARIFICATION: How a partial cancellation will be handled. If there is only a partial cancellation, there should not be any “withdrawal”.

Change of name or address

110 If, in respect of an international registration on which a Protocol application is based, the International Bureau notifies the Registrar of the recording in the International Register of a change in the name or address of the holder, the Protocol application is deemed to be amended accordingly.

COMMENT: In respect of s. 110, what is the date on which the change will be deemed to have been made? As 110 is one of the sections exempt from new s. 35(2) setting out what amendments are possible this preclude an Opponent arguing that the application was brought in the name of the wrong entity? If so this is problematic. Will an applicant be able to provide the exact date of the change and have that recorded? Will third parties be able to see this and if so how quickly?

Non-renewal of international registration

112 If the international registration on which a Protocol application is based is not renewed in respect of Canada and the International Bureau notifies the Registrar accordingly, the Protocol application is deemed to have been withdrawn at the expiry of the international registration in respect of Canada.

COMMENT: In respect of section 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? Concern was expressed that this section could facilitate a Madrid application advancing to registration and sit on the register for 10 years even if the day after filing in Canada the international registration came due for renewal and not renewed? It is not clear whether “in respect of Canada” refers to the IR – in which case why say Canada, or the Canadian designation. Do the proposed regulations permit this situation from developing? Is there a procedure to revive registration at least in instances wherein the International Bureau fails to notify the owner that renewal is due?

Deemed amendment to application

113 If the International Bureau notifies the Registrar of a correction of an international registration in the International Register affecting a Protocol application, the Protocol application is deemed to be amended accordingly.

COMMENT: Under s.113, what if the correction to the IR was beyond that which would be permitted in respect of a Canadian application? If we assume that the intention is for Canada to, at least in respect of Madrid applications, accept all corrections WIPO deems acceptable – then how can correction be challenged in Opposition or post registration? Since s. 113 is one of the sections exempt from the restrictions on amendments this seems to be a valid concern. The word “correction” is vague and ambiguous. We recommend that the scope of what constitutes a correction to an international registration be clarified.

Amendment to non-advertised application

114 If the Protocol application has not been advertised under subsection 37(1) of the Act before the date of notification of a correction and if the Registrar determines that the amendment is substantive in respect of at least one of the goods or services specified in the amended Protocol application and is not limited to narrowing the scope of the statement of goods or services, then a reference in sections 119 and 128, paragraph 131(1)(c) and subparagraph 131(1)(d)(i) of these Regulations to “the date of notification of territorial extension” is to be read as “the day on which the International Bureau sent to the Registrar the notification of a correction of an international registration on which the Protocol application is based” in respect of that Protocol application.

COMMENT: The heading preceding Section 114 should ideally refer to amendments relating to goods and services. Any other amendments presumably fall under the regulations that cover all applications, i.e. s 35 and referenced to goods and services only would make this clear. A related point involves s. 35 and what “substantially the same” means. It would be beneficial to retain the wording in the old Act, “except in respects that do not alter its distinctive character or affect its identity” instead of creating a test that does not have existing jurisprudence available for guidance and predictability.

Amendment to advertised application — all goods or services

115 If the Protocol application has been advertised under subsection 37(1) of the Act before the date of notification of a correction and if the Registrar determines that the amendment is substantive in respect of all of the goods or services specified in the amended Protocol application and is not limited to narrowing the scope of the statement of goods or services,

(a) the application is deemed to never have been advertised; and

COMMENT: We suggest terminology be added to this section, 116(b) and 116(2) to make it clear that the Protocol application then reverts to examination, as in the CIPO Overview document. While it is indirectly stated in section 119 that the Registrar cannot refuse a Protocol application without first issuing a notification of provisional refusal, it would be useful to make it clear that there is examination involved.

Amendment of advertised application — some goods or services

116 (1) If the Protocol application has been advertised under subsection 37(1) of the Act before the date of notification of a correction and if the Registrar determines that the amendment is substantive in respect of at least one but not all of the goods or services specified in the amended Protocol application and is not limited to narrowing the scope of the statement of goods or services, then the Registrar must by notice invite the applicant to select one of the following options:

(a) that the Protocol application be amended to delete those goods or services; or

(b) that the Protocol application be deemed to never have been advertised.

Deletion of goods or services

(2) If the applicant selects the option referred to in paragraph (1)(a) or does not make an election within two months after the date of the notice, the Protocol application is deemed to be amended to delete those goods or services.

Deemed non-advertisement of application

(3) If the applicant selects the option referred to in paragraph (1)(b) within two months after the date of the notice

(a) the Protocol application is deemed to never have been advertised; and

(b) a reference in sections 119 and 128, paragraph 131(1)(c) and subparagraph 131(1)(d)(i) to "the date of notification of territorial extension" is to be read as "the day on which the

International Bureau sent to the Registrar the notification of a correction of an international registration on which the Protocol application is based" in respect of that Protocol application.

COMMENT: Timing of amendment appears to conflict with opposition proceedings. Might a prospective opponent be required to file a statement of opposition pending the selection of the options offered in 116(1)? Would filing a statement of opposition for an application ultimately deemed to never have been advertised result in a refund of the opposition filing fee?

Under 116(2) what recourse exists if the Applicant misses the 2-month deadline? Also, if something is “deemed to have never been advertised” what deadlines apply generally- i.e. on what date is the application officially abandoned?

Effective date of amendment

117 An amendment to a Protocol application under section 113 or subsection 116(2) is deemed to take effect on the filing date of the Protocol application.

COMMENT: Under section 117, what is the deemed date of amendment for non-113 and 116(2) amendments?

Statement of confirmation of total provisional refusal

118 If the Registrar treats a Protocol application as abandoned under section 36 of the Act, the Registrar must send a statement of confirmation of total provisional refusal to the International Bureau.

COMMENT: Under s. 118, is the applicant notified by the IB? If not will CIPO notify the owner/agent? Is advanced warning given of pending abandonment and is there any opportunity to remedy a missed deadline?

Notification of provisional refusal

119 The Registrar must not refuse a Protocol application under subsection 37(1) of the Act without first sending to the International Bureau, before the end of 18 months after the date of notification of territorial extension, a notification of provisional refusal stating the Registrar's objections.

Statement of confirmation of total provisional refusal

120 If the Registrar refuses a Protocol application under subsection 37(1) of the Act, the Registrar must send a statement of confirmation of total provisional refusal to the International Bureau.

COMMENT: For sections 119 and 120, how long after sending of the notification of provisional refusal is the application deemed refused? Does whatever period envisioned allow sufficient time for applicants to remedy any deficiency? Who notifies the Applicant? Is there recourse if notification is not received by the owner and the application is formally refused?

Should add a reference that Registrar is obliged to send a notification of provisional refusal to the applicant, in addition to the International Bureau. There is no mention of notification of the applicant in this sub-section although there is in the CIPO Overview document. Also, recommend adding “to the Protocol application” to the end of the sub-section.

Divisional Application

Non-application of subsections 39(1), (2) and (5) of Act

121 Subsections 39(1), (2) and (5) of the Act do not apply in respect of a Protocol application.

RECOMMEND: Adding a statement that s. 39(4) does not apply and the filing date of the Protocol divisional application would be calculated based on all Protocol filing dates.

Opposition

Extension limitation

124 In respect of a Protocol application, the Registrar is not permitted, on application made to the Registrar, to extend, under section 47 of the Act, the two-month period referred to in subsection 38(1) of the Act by more than four months.

CLARIFICATION: Once a notice of provisional refusal has been made, will a “cooling off” extension be available? Is four months sufficient to conclude settlement? What period is allowed for retroactive extensions of time?

Filing of statement of opposition

125 A statement of opposition under section 38 of the Act in respect of a Protocol application must be in English or French and be filed by using the online service that is accessible through the website of the Canadian Intellectual Property Office.

CLARIFICATION: No paper filing of statement of opposition – will service be limited to checkbox grounds of opposition?

RECOMMEND: That any form include wide leeway in grounds of opposition.

Notification of provisional refusal

126 If, in respect of a Protocol application, a statement of opposition is filed, the Registrar must send to the International Bureau a notification of provisional refusal.

COMMENT: Under s. 126, when will the notification be sent? As it limits amendment to the Statement of Opposition this should be done as late as possible thereby allowing the Opponent time to add grounds. Should this read notification of provisional refusal based on an opposition? See below for comments. It seems as though it might be possible to have some flexibility in when to send this notification. 7 months after the date the opposition began (see 131(1)(d)(ii))?

No new ground of opposition

127 If the Registrar sends to the International Bureau a notification of provisional refusal based on an opposition, the statement of opposition may not be amended to add a new ground of opposition.

CLARIFICATION: This will encourage statements of opposition with all conceivable grounds of opposition and will make it difficult for applicants to understand the focus of any opposition. This may lead to an increase in requests for interlocutory rulings.

RECOMMEND: We suggest that to the extent possible an Opponent should be permitted to add grounds for as long as possible and that time frames not be cut short, for example by sending notification to WIPO earlier than needed. Could a general notification of provisional refusal be first given, for example, by providing for a notice of intent to oppose, before notification of Opposition, to extend the time period during which the Opponent is able to add grounds? Ideally an Opponent should at least be able to add grounds up to the point it has received and reviewed the Applicant's evidence.

Statement of confirmation of total provisional refusal

129 The Registrar must send a statement of confirmation of total provisional refusal to the International Bureau if

(a) the Protocol application is deemed to have been abandoned under subsection 38(11) of the Act; or

(b) the Registrar refuses the Protocol application under subsection 38(12) of the Act with respect to all of the goods or services specified in it and either the period for filing an appeal has ended and no appeal has been filed or, if an appeal has been filed, the final judgment has been decided in favour of the opponent.

COMMENT: Section 129 does not appear to encompass the rather common split decisions issued by the Board. If a Protocol application is refused with respect to only some of the goods and/or 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.

Under s. 129 (b) use of the term “the period of appeal” would make it clear that the provision covered not just a first appeal but subsequent appeals as well. Otherwise it might be arguable that “an appeal” means one appeal for example an appeal of the Federal Court to the Court of Appeal.

Obligations of Registrar

131 (1) In respect of a trademark that is the subject of a Protocol application, the Registrar must register the trademark in the name of the applicant, issue a certificate of its registration and send a statement of grant of protection to the International Bureau if the following requirements are met:

- (a) the Protocol application has not been opposed and the opposition period has ended;
- (b) the Protocol application has been opposed and the opposition has been decided in favour of the applicant and either the period for filing an appeal has ended and no appeal has been filed or, if an appeal has been filed, the final judgment has been decided in favour of the applicant;

COMMENT: Section 131(1)(b) does not appear to contemplate a situation where an appeal is withdrawn. As drafted now, the options are the appeal term has ended with no appeal, or an appeal has been filed and final judgement issued.

(c) 18 months have passed from the date of notification of territorial extension and, within that 18-month period, the Registrar did not inform the International Bureau that it was likely that the opposition period would extend beyond that 18-month period and

- (i) did not send to the International Bureau a notification of provisional refusal, or
- (ii) did send to the International Bureau a notification of provisional refusal, but not one based on an opposition, and is not satisfied that any of paragraphs 37(1)(a) to (d) of the Act apply; or

CLARIFICATION: Would Registrar’s failure to inform that IB of an extension of the opposition period beyond 18 months result in registration of a Protocol Application despite opposition by a third party?

(d) the Protocol application has been opposed, the following periods have ended, the Registrar informed the International Bureau, in the period referred to in subparagraph (i), that it was likely that the opposition period would extend beyond that period and the Registrar did not send to the International Bureau, before the expiry of the period referred to in subparagraph (ii), a notification of provisional refusal based on an opposition:

(i) the 18-month period after the date of notification of territorial extension, and

(ii) the period that ends at the earlier of the end of the seven-month period beginning after the day on which the opposition period began and the end of the one-month period beginning after the day on which the opposition period ended.

CLARIFICATION: This provision is extremely confusing. Was the phrase “the following periods have ended” misplaced in this draft.

In respect of section 131(1)(d) what happens when an opposition commences after the 18 months contemplated? At 18 months will CIPO advise for all applications that the opposition is likely to extend beyond 18 months? If not, can the Registrar do anything but register the mark?

Is it possible to define the “day on which the opposition period began”? Is it simply the date of advertisement?

Section 131 does not appear to contemplate a situation where a decision issues covering some of the goods or services. Section 131, like section 129 could be revised to make it clear that appeal beyond the trial division is possible. Using “period of appeal” instead of “period for filing an appeal” is suggested. See comments for s. 126 and 127 involving preserving the ability to add grounds to an opposition for as long as possible.

Non-advertisement

(2) Despite subsection 37(1) of the Act, the Registrar must not cause the Protocol application to be advertised if the trademark was registered under subsection (1) of this section without the Protocol application having been advertised.

CLARIFICATION: Is this section intended to state that despite subsection 131(1), the Registrar must not cause the Protocol Application to be registered without the Protocol Application having been advertised?

Is there a mechanism for correcting such an error elsewhere in the regulations?

Recording resulting in deletion

134 (1) Subject to subsection (3), if, in respect of an international registration on which a Protocol registration is based, the International Bureau notifies the Registrar of the recording in the International Register under Rule 27(1)(a) of the Common Regulations of a limitation of the list of goods or services in respect of Canada that results in a deletion of a good or service from that list, the Registrar must cancel the Protocol registration or amend the register accordingly.

Recording resulting in new list

(2) If a notification referred to in subsection (1) of a recording of a limitation is made and that recording results in a new list of goods or services, the Registrar must determine, with respect to each good or service in the new list, whether the following requirements are met:

(a) the good or service is within the scope of the Protocol registration on the date of the recording in the International Register; and

(b) the good or service is clearly described in ordinary commercial terms and in a manner that identifies a specific good or service.

Consequences of new list

(3) The Registrar must amend the register to include any good or service in the new list that meets the requirements set out in subsection (2).

Declaration to International Bureau

(4) The Registrar must, in accordance with Rule 27(5) of the Common Regulations, send to the International Bureau a declaration that the limitation has no effect in Canada in respect of any good or service in the new list that does not meet the requirements set out in subsection (2).

COMMENT: This provision authorizes the Office to issue a declaration that a new “limitation” recorded against the international registration will have no effect in Canada because the goods and services are not in “ordinary commercial terms”, etc. However, there seems to be no obligation to notify the applicant or give them an opportunity to argue the issue. Further, 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.

This seems inconsistent with principles of fairness and another similar provision of the regulations, namely section 139(2) which provides a period to respond to such objections arising from a “correction” of the international register.

RECOMMEND: Adding a similar provision here.

Correction of international registration

139 (1)...

Period to respond

139 (2) The Registrar must by notice invite the registered owner to respond to a declaration made under paragraph (1)(b) within the period specified in the notice.

COMMENT: Under s. 139(2) what period of time is contemplated and what recourse is possible if the deadline lapses and for example the registrant has not receive the notice?

Protection not granted

(4) If — after considering any response received within the specified period or, if there are none, at the end of that period — the Registrar considers that protection cannot, or can no longer, be granted to the international registration as corrected, the Registrar must notify the International Bureau and amend the register or cancel the Protocol registration accordingly.

COMMENT: Under section 139(4) there appears to be no contemplation of a response back to the registrant – just “consideration” and notification. Registrar is “satisfied” would be language that entrenches a dialogue prior to final notification.

Failure to consider request for extension of time

141 (1) The Registrar may remove a Protocol registration from the register if the Registrar registered the trademark without considering a previously filed request for an extension of time to file a statement of opposition, unless the time limit under Article 5(2) of the Protocol to make a notification of provisional refusal based on an opposition has ended.

COMMENT: This ought to apply to both a request for an extension, and any opposition. Does “previously filed” have to be there at all? Also, the wording should be “previous request” instead of “previously filed request” to catch transmissions sent but not received by CIPO?

Recording or registration

145

COMMENT: The title for s. 145 should be “Recording of registration”, not “or”.

Transformation

Application

146 (1) If an international registration on which a Protocol application or Protocol registration is based is cancelled under Article 6(4) of the Protocol in respect of all or any of the goods or services listed in the international registration, the person who was the holder of the international registration on the date of cancellation recorded in the International Register, or their successor in title, may, within three months after that date, file with the Registrar an application (referred to in these Regulations as a "transformation application") to revive the former Protocol application as an application for the registration of the trademark or the former Protocol registration as a registration of the trademark.

COMMENT: Under s. 146 there does not appear to be fees set for “transformation”. Also, while the holder of the IR rights may request transformation within 3 months, if it does not do so until the end of the 3 months term, it could appear to third parties 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 owing to 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?

No extension

146 (6) The applicant may not apply under section 47 of the Act for an extension of the 3-month period referred to in subsection (1) of this section.

COMMENT: Under s. 146(6) should retroactive extensions be specifically precluded as well?

Consequences — trademark subject of cancelled Protocol application

147 If a transformation application is filed in accordance with section 146 for the revival of a Protocol application,

(a) an application is deemed to have been filed under subsection 30(1) of the Act by the person who was the holder, on the date of cancellation recorded in the International Register, of the

same trademark as in the international registration and in respect of the goods or services specified in the transformation application;

(b) the application referred to in paragraph (a) is deemed to include any document or information contained in the Protocol application, other than the statement of goods or services;

COMMENT: Under, s. 147(b) does “document or information contained in the Protocol application” include evidence submitted in support of the registration?

Typos:

s. 98(1)(c)(i) should have “or” at end of line (following “the applicant is a national of Canada”)

s. 100 (b) – the words “on the request” should either be deleted or “by the transferee” should be added

s. 102(1) should be “International Register”, NOT international registrar

s. 106(1) – the reference in the first line should be to subsection (4), and not subsection (3)

s. 106(4) – paragraph 1(b) on the last line should be subsection (2)

s. 111 – needs rewording – “on” left out, and then “on of” added. Should read “.... deemed to take effect on the date of the limitation...”.

Part III – Comments on Transitional Provisions, Repeal and Coming into Force

COMMENT: these are extremely complex and difficult to understand. Recommend rewording.