

**SUBMISSION BY
GOWLING WLG
IN RESPONSE TO THE
CANADIAN INTELLECTUAL PROPERTY OFFICE
PUBLIC CONSULTATIONS
ON THE PROPOSED AMENDMENTS TO THE TRADEMARK REGULATIONS**

July 21, 2017

INTRODUCTION

Gowling WLG is recognized as one of the leading trademark practices in Canada. We have been prosecuting and enforcing trademarks for more than 100 years which gives us a depth of experience and knowledge that few firms can match. We file more trademark applications than any other firm in the Canadian market and we manage more than 90,000 active trademark records. Many of the world's largest companies use Gowling WLG to manage their Canadian trademark portfolio. Our experience as one of the most active users of the current trademark system gives us a unique perspective on the regulatory changes needed to implement the amendments to the Canadian Trademarks Act.

Gowling WLG wishes to recognize the momentous and welcome efforts of CIPO to provide educational support, policy information and explanation to the trademark community to assist in their consideration of the proposed Regulations. We look forward to continuing to work collaboratively with CIPO throughout the Regulatory process as well as in the development of Practice Notices and policies to support these changes.

Our response is comprised of two sections, the first section consists of our general comments on broad issues. Our specific technical considerations are set throughout the draft Regulations in the applicable sections.

General Comments

Gowling WLG welcomes the modernization of Canadian trademark practice recognized in these Regulations. We strongly support Canada's accession to the Madrid Protocol, The Singapore Treaty, and the Nice Agreement. We recognize and applaud the efficiency and benefits that Canadian business will enjoy by these changes when seeking international protection of their valuable brand assets.

1) Simplification of Filing Requirements

We applaud the simplification of filing requirements for Canada.

2) Alignment of Process for Challenge Proceedings

We support the alignment of procedure and process for Opposition, Section 45, and Objector Proceedings.

3) Drafting Convention and Comprehension of Draft Regulations

We understand that modern drafting conventions must be used for the Regulations in accordance with current legislative drafting requirements observed in Canada which follow a particular set of organizational and language rules. These are intended to bring clarity for our Courts and also comprehension and understanding by users including the trademark profession and the Canadian business community. We have concern that several sections in the Regulations are quite difficult to understand including sections which do not make changes to existing regulatory practice but, as stated, are still difficult to comprehend including by seasoned practitioners. It is important that the drafting be comprehensible by Canadian business and users generally to ensure an entity's ability to comply with requirements. We have set out in the Regulations those sections which we identify as confusing or awkward.

4) Restrictions on Ability to Amend Applications

The restriction on the ability to amend applications after filing to add or remove descriptions of the mark represents a significant departure from current practice and will require education to warn users about this important change. We urge the Office to include transition provisions that are lenient while the trademark practice and business communities become familiar with the new process. Under current practice, we often work with examiners during their review to identify the appropriate descriptions. The inability to add the proper description will risk a potentially significant loss of rights for the unwary.

5) Madrid Protocol

The Madrid Protocol system is new to the majority of Canadian practitioners and Canadian business community. There are several very complicated sections in the Madrid portion of the Regulations in terms of process and obligations for which there are severe penalties for non-compliance, including obligation for advancement of conflicting rights, loss of rights to applicants, and a corresponding loss of fees. The potential loss of fees is magnified by the fact that there may be multiple contracting countries connected to the base application. We recommend that CIPO develop educational programming to inform and familiarize Canadian practitioners and other potential users of this system regarding process and risks, including via Practice Notices in clear and understandable terms. We have indicated where we consider clarity and/or clarification may be required in the Regulations and welcome the opportunity to collaborate with you in the development of informative and directive Practice Notices.

6) Calculation of Time Limits

We understand from your helpful workshops and discussions that the indication of deadlines in the draft Regulations, the language for which is a departure from the current Regulations, is based on a unified approach to referencing deadlines throughout Canadian legislation and regulations according to the Interpretation Act. We appreciate there may be no flexibility for amending this language, but we also

appreciate that there is no change in practice for the calculation of deadlines. We recommend education on this point as the stipulated deadlines in the draft are somewhat confusing.

7) Registrar-Initiated Section 45 Proceedings

We understand there may be an intention by CIPO to increase Registrar-initiated Section 45 proceedings to help declutter the register. We welcome the opportunity to help develop that practice with you and consider appropriate criteria that might trigger the issuance of this notice against a registration following the three year protection period set out in the Act. It is our hope that Registrar-initiated proceedings would be expeditious, as there will be no written submission by the Registrar, and that the criteria to trigger such a proceeding be predictable and objective. There should not be any subjective criteria in the selection process to avoid a conflict of interest for the Registrar who will then render a decision in the cancellation.

A potential approach might be as follows:

- 1) Establish a pool of registrations against which the following criteria would be considered:
 - a. The registration is at least six years old;
 - b. There has been no activity on the Trademarks Office file in the preceding five years;
 - c. The registration covers more than a certain number of classes.
- 2) Against that pool of registrations, the Registrar would randomly select 100 for initiation of this proceeding.

We offer this as a suggestion only and welcome the opportunity to collaborate in the development of a policy. We envision criteria for these Registrar-initiated proceedings that would enable us to inform and/or warn registrants of their potential vulnerability in certain circumstances.

Proposed Trademarks Regulations draft

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PART 1 Rules of General Application

Interpretation

Definitions

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

Act means the Trademarks Act. (Loi)

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

International Bureau means the International Bureau of the World Intellectual Property Organization. (Bureau international)

International Register means the official collection of data concerning international registrations maintained by the International Bureau. (Registre international)

international registration means a registration of a trademark on the International Register. (enregistrement international)

trademark agent means a person or firm whose name is entered on the list of trademark agents kept under section 28 of the Act. (agent de marques de commerce)

Reference to a period

(2) Except to the extent otherwise indicated, a reference to a period in these Regulations that is extended under sections 47 or 47.1 or subsection 66(1) of the Act is to be read as a reference to the period "as extended".

GWLG: We understand the definition for 'Reference to a Period' is to provide legal certainty that an extended deadline under Section 47 is the new deadline and to provide contrast for the non-extendable deadlines that exist. We appreciate this language is the same in the Patent Rules.

Should add definition for 'Office of Origin'

General

Written communications intended for Registrar

2 Written communications intended for the Registrar must be addressed to the "Registrar of Trademarks".

GWLG: We understand that current and modernized drafting conventions replace previous references to “shall” with “must” but that they mean the same thing and that there is no policy intent by this change. Otherwise, the penalty for non-compliance should be noted.

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.

GWLG: We recommend that “mergers” and “changes in status” (conversions to LLPs, etc.) for owners be included in the exception as they are treated the same in current practice.

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.

GWLG: We recommend that this be amended to include the mark or application number, as it does in 4(2), to avoid significant confusion by CIPO examiners and practitioners. The Office will not always know which case is being referred to particularly where a party owns a significant portfolio. We understand CIPO is somewhat restricted on this issue by the Singapore Treaty, but could the amendment to either mark “or” serial number be entered?

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.

GWLG: We support this.

Address

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

GWLG: We understand this serves to acknowledge the ability to file in the name of joint parties but also that one address must be provided and you have clarified that in the event two addresses are provided, you will work with the first.

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.

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.

GWLG: We understand that this section would not prohibit other forms of communication such as phone calls to examiners, but reads as a narrowing of s. 4(2) in existing registrations which provide that the Registrar ‘may consider oral communication’. This section should acknowledge oral communications and other efficient forms of appropriate communication that may come about over the years.

Intelligibility of documents

7 Documents provided to the Registrar must be clear, legible and capable of being reproduced.

GWLG: We support this.

Document provided in non-official language

8 If a person 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.

GWLG: We understand that this section would not preclude the filing of evidence or exhibits in another language, such as those which feature the mark, provided the relevance of the evidence in the document is explained in English or French.

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.

Date of receipt — physical delivery to designated establishment

(3) Documents, information or fees that are provided to the Registrar by physical delivery to a designated establishment are deemed to have been received by the Registrar,

(a) in the case that they are delivered during the establishment's ordinary business hours,

(i) on the day on which they are delivered, if the Office of the Registrar of Trademarks is open that day, or

(ii) on the day on which the Office of the Registrar of Trademarks is next open, if the Office is closed that day; or

(b) in any other case, on the day on which the Office of the Registrar of Trademarks is next open that falls on or after the day on which the establishment is next open.

GWLG: We understand that this does not change the current practice and that physical delivery to CIPO, or one of its designated local offices, remains subject to these same rules.

Date of receipt — provided by electronic means

(4) Documents, information or fees that are provided to the Registrar by electronic means in accordance with subsection 64(1) of the Act are deemed to have been received on the day, according to the local time of the place where the Office of the Registrar of Trademarks is located, on which the Office receives them.

GWLG: We strongly support the ability to transmit documents, information or fees electronically. We also understand this to mean that all electronic documents including applications will be accepted on receipt by CIPO and granted that filing date including on weekends and holidays. You have clarified that this does not impact priority deadlines in any adverse manner. The ability to obtain a non-business day filing date is cause for some concern for agency practices and law firms which are closed on holidays and weekends as they may be expected to process these requests on non-business days.

Exception — certain applications and requests

(5) Subsections (1) to (3) do not apply in respect of

(a) an application for international registration referred to in sections 97 to 99;

(b) a request for the recording of a change in ownership referred to in sections 100 and 101;

(c) a request for division referred to in section 122; and

(d) a transformation application referred to in section 146.

Exception — International Bureau

(6) Subsections (1) to (4) do not apply in respect of a document, information or a fee provided to the Registrar by the International Bureau.

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.

GWLG: We strongly support the changes to the Regulations which provide for a Letters of Protest Practice in Canada. However, the title and language in this section are confusing as to the scope and non-adversarial intention of the “letters of protest” practice is not clear. The words “appear to be against its registration” are ambiguous. It is our understanding that the “letters of protest” will deal only with issues of registrability under Section 12 and they will be non-adversarial. We recommend that at least the ‘registrability’ restriction should be referenced to decrease other types of communications and avoid adversarial behaviors. This section should be titled “Third Party Written Communications”?

Exception

(2) Subsection (1) does not apply in respect of written communications made in a proceeding referred to in section 38 of the Act.

Waiver of fees

11 The Registrar may waive the payment of a fee if the Registrar is satisfied that the circumstances justify it.

GWLG: We understand this is to apply to situations where the Office determines, based on a circumstance, that a party should not be subject to fees. The section is drafted broadly to suggest it may apply to many

situations ie., that an applicant might try to make a case that its charitable service application should not be subject to fees. We understand this will be clarified in a Practice Notice.

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.

GWLG: We support this.

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.

GWLG: We strongly support the ability to file affidavits and statutory declarations electronically.

Provision of original

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

GWLG: We recommend adding the specified time period to 13.2.

Extension of time — fee

14 A person who applies for an extension of time under section 47 of the Act must pay the fee set out in item 1 of the schedule to these Regulations.

GWLG: It is our understanding that “prescribed fees” will now be set out specifically in the Regulations, such as in this example, as they are not so referenced in the current Regulations. We further understand there is no policy change intended by the fee references for prescribed fees. We support this.

Prescribed days for extension of periods

15 The following days are prescribed for the purpose of subsection 66(1) of the Act:

- (a) every Saturday;
- (b) every Sunday;
- (c) January 1 or, if January 1 falls on a Saturday or Sunday, the following Monday;
- (d) Good Friday;
- (e) Easter Monday;
- (f) the Monday before May 25;
- (g) June 24 or, if June 24 falls on a Saturday or Sunday, the following Monday;
- (h) July 1 or, if July 1 falls on a Saturday or Sunday, the following Monday;
- (i) the first Monday in August;
- (j) the first Monday in September;
- (k) the second Monday in October;
- (l) November 11 or, if November 11 falls on a Saturday or Sunday, the following Monday;
- (m) December 25 and 26 or, if December 25 falls on a
 - (i) Friday, that Friday and the following Monday, and
 - (ii) Saturday or Sunday, the following Monday and Tuesday; and
- (n) any day on which the Office of the Registrar of Trademarks is closed to the public.

GWLG: We understand this to represent our current practice and the standard days on which time limits are extended automatically to the next working day. We also understand that this does not apply to matters before the IB, which does recognize some different holidays. This exclusion should be clarified “but not in respect of business before the IB”.

Trademark Agents

List of Trademark Agents

Eligibility for examination

16 A person is eligible to sit for a qualifying examination for trademark agents if the person meets the following requirements:

- (a) on the first day of the examination, resides in Canada and
 - (i) has been employed for at least 24 months in the Office of the Registrar of Trademarks either on the examining staff or as a person to whom any of the Registrar's powers, duties and functions under section 38 or 45 of the Act have been delegated,
 - (ii) has worked in Canada in the area of Canadian trademark law and practice, including the preparation and prosecution of applications for the registration of trademarks, for at least 24 months, or
 - (iii) has worked in the area of trademark law and practice, including the preparation and prosecution of applications for the registration of trademarks, for at least 24 months, at least 12 of which were worked in Canada and the rest of which were worked in another country where the person was authorized to act as a trademark agent under the law of that country; and
- (b) within two months after the day on which the notice referred to in subsection 18(2) was published,
 - (i) notifies the Registrar in writing of their intention to sit for the examination,
 - (ii) pays the fee set out in item 2 of the schedule, and
 - (iii) furnishes the Registrar with a statement indicating that they will meet the requirements set out in paragraph (a), along with supporting justifications.

GWLG: We understand there is no change from the current Regulations. We support this.

Establishment of examining board

17 (1) An examining board is hereby established for the purpose of preparing, administering and marking a qualifying examination for trademark agents.

GWLG: We understand there is no change from the current Regulations. We support this.

Membership

(2) The Registrar must appoint the members of the board. At least two members of the board must be trademark agents nominated by the Intellectual Property Institute of Canada.

GWLG: We understand there is no change from the current Regulations. We support this.

Frequency of qualifying examination

18 (1) The examining board must administer a qualifying examination for trademark agents at least once a year.

GWLG: We understand there is no change from the current Regulations. We support this.

Notice of date of examination

(2) The Registrar must publish on the website of the Canadian Intellectual Property Office a notice that specifies the date of the next qualifying examination and indicates that a person who intends to sit for the examination must meet the requirements set out in section 16.

GWLG: We understand there is no change from the current Regulations. We support this.

Designation of place of examination

(3) The Registrar must designate the place or places where the qualifying examination is to be held and must, at least two weeks before the first day of the examination, notify every person who has met the requirements set out in paragraph 16(b) of the designated place or places.

GWLG: We understand there is no change from the current Regulations. We support this.

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

GWLG: Use of ‘trademark agent’ in 19(b) does not work here as it is defined in section 1(1)

- (c) a firm at least one member of which has their name entered on the list as a trademark agent.

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
- (c) a firm whose name is on the list of trademark agents must, to maintain its name on the list, file a statement signed by one of its members whose name is on the list, indicating all of its members whose names are on the list.

GWLG: We understand there is no change from the current Regulations. We support this.

Removal from list

(2) The Registrar must remove from the list of trademark agents the name of any trademark agent who

(a) fails to comply with subsection (1); or

(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).

GWLG: We understand 2(b) to mean that a lawyer who has not written the TM Agents examination would be required to pass it in order to qualify for reinstatement. We also understand that in practice, CIPO's intention is to use its discretion, in appropriate circumstances, to work with individuals that face this issue.

Reinstatement

21 If the name of a trademark agent has been removed from the list of trademark agents under subsection 20(2), it may be reinstated on the list if the trademark agent

(a) applies to the Registrar, in writing, for reinstatement within one year after the day on which their name was removed from the list; and

(b) as the case may be

(i) is a person referred to in paragraph 19(a) and pays the fees set out in items 4 and 5 of the schedule,

(ii) is a person referred to in paragraph 19(b) and files the statement referred to in paragraph 20(1)(b), or

(iii) is a firm referred to in paragraph 19(c) and files the statement referred to in paragraph 20(1)(c).

GWLG: We support this.

Representation

Power to appoint trademark agent

22 (1) An applicant, registered owner or other person may appoint a trademark agent to represent them in any business before the Office of the Registrar of Trademarks.

GWLG: Please see our comment at 22(3)

Requirement to appoint associate trademark agent

(2) A trademark agent who does not reside in Canada must appoint a trademark agent who resides in Canada to represent the person who appointed them in any business before the Office of the Registrar of Trademarks.

GWLG: Please see our comment at 22(3)

Power to appoint associate trademark agent

(3) A trademark agent who resides in Canada, other than an associate trademark agent, may appoint another trademark agent who resides in Canada to represent the person who appointed them in any business before the Office of the Registrar of Trademarks.

GWLG: We recommend that this include “and with the permission of the Canadian resident agent” or “with their consent” or language to that effect to ensure the agent is given notice that they have been entered. We are now receiving confirmation that we have been, without permission or connection, noted as an agent on an incoming filings. This creates liability for an agency practice and law firm and it would be helpful to have a rule to address and control this. We expect an increase in appointments after filing, during examination and in opposition because of the Regulatory changes.

Notice of appointment or revocation

23 The appointment of a trademark agent or the revocation of such an appointment is effective starting on the day on which the Registrar receives notice of the appointment or revocation, including, in the case of an appointment, the postal address of the trademark agent.

GWLG: Please see our comment at 22(3)

Acts by or in relation to trademark agent

24 (1) In any business before the Office of the Registrar of Trademarks, any act by or in relation to a trademark agent who resides in Canada, other than an associate trademark agent, has the same effect as an act by or in relation to the person who appointed them in respect of that business.

Acts by or in relation to associate trademark agent

(2) In any business before the Office of the Registrar of Trademarks, any act by or in relation to an associate trademark agent has the same effect as an act by or in relation to the person who appointed, in respect of that business, the trademark agent that appointed the associate trademark agent.

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.

GWLG: In 25(2) “or be represented by another person authorized by them” is vague. Without additional clarification, this may give rise to unofficial agencies and persons without skills or training as to process before the Office taking advantage of brand owners and causing a loss of rights, and delays in CIPO in view of their unfamiliarity with practice. This makes Canadian business vulnerable to unprofessional business practices. We recommend the words ‘or be represented by another person’ be removed.

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.

Application for Registration of Trademark

Scope

27 A separate application must be filed for the registration of each trademark.

Language

28 An application for the registration of a trademark, with the exception of the trademark itself, must be in English or French.

GWLG: We understand this to mean the applicant cannot feature both of Canada’s official languages in one application. It must appear in one or the other and the reason for this is tied to the Common Regulations. We also understand that the goods/services in the application may appear in the other language but the application itself must be in one. Should this rule be limited to applications that form the basis of an IA to not appear in two languages? We appreciate that Canada presents a unique issue for WIPO in that it has two official languages. Should this be amended to recognize Canada’s both of Canada’s official languages to permit Canadian applicants the ability to use both in an application?

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.

GWLG: The purpose for including this new section in the Regulations remains unclear. The language “clearly describe” each of those ... in a manner that identifies a specific good or services seems to defeat the amendment in Section 30 of the new legislation which removes “specific”. This criteria, to specifically describe goods and services, counters one of the primary goals of our new legislation which is harmonization of Canadian practice to accord with similar treatment of applications in other countries.

Applicants in Canada currently face some of the strictest requirements for identification of goods and services anywhere which causes multiple office actions, creates backlog, and importantly, delay in examination.

This section maintains our already burdensome process in Canada. We understand the policy intent by removal of “specific” from Section 30 of the Act was to be less restrictive. By inserting the word “specific” back into the Regulations, we arrive at the same place. If the intention is to harmonize our process to the extent possible and increase filings in Canada, we need to avoid being uniquely strict. We should consider alternate language to realize the intended policy change. Please consider the following:

The statement of the goods or services referred to in paragraph 30(2)(a) of the Act must describe each of those goods or services in a manner that is clear.

Canadians who take advantage of Madrid for international applications will be disadvantaged by our strict requirements, which will result in a narrowing of their rights in all contracting countries.

Representation or description

30 The following requirements are prescribed for the purpose of paragraph 30(2)(c) of the Act:

- (a) any representation may contain more than one view of the trademark only if the multiple views are necessary to permit the trademark to be clearly defined;
- (b) any two-dimensional representation must not exceed 8 cm by 8 cm;
- (c) if the trademark consists in whole or in part of a three-dimensional shape, any representation must be a two-dimensional graphic or photographic representation;
- (d) if colour is claimed as a feature of the trademark or if the trademark consists exclusively of a single colour or a combination of colours without delineated contours, any visual representation must be in colour;
- (e) if colour is not claimed as a feature of the trademark or if the trademark does not consist exclusively of a single colour or a combination of colours without delineated contours, any visual representation must be in black and white;

- (f) if the trademark consists in whole or in part of a sound, any representation must include a recording of the sound in a format specified by the Registrar on the website of the Canadian Intellectual Property Office; and
- (g) any description must be clear and concise.

GWLG: We understand an accurate description must be included at the time of filing and may not be added or deleted after filing. We are hopeful CIPO will allow amendments to correct an existing statement and/or provide a transition phase policy to permit changes while Canadian practitioners and SME's become familiar with the new stricter practice.

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.

Fee

32 (1) A person who files an application for the registration of a trademark, other than a Protocol application as defined in section 95 or a divisional application, must pay the applicable fee set out in item 7 of the schedule.

GWLG: We understand that this section excludes protocol applications because CIPO itself does not collect these fees. We believe this should clarify that protocol applications are subject to fees paid to the IB simply to clarify that they also require payment of fees generally. As worded, it sounds like they are not subject to fees.

Filing date

(2) For the purpose of paragraph 33(1)(f) of the Act, the prescribed fees are those fees set out in subparagraphs 7(a)(i) and (b)(i) of the schedule to these Regulations.

Request for Priority

Time and manner of filing

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.

GWLG: We support this.

The new language “after the filing date” is intended to have the same meaning as “from the filing date” and there is no policy intent by this change of language which appears throughout the Regulations. Dates will continue to be calculated as they currently are calculated. We understand this wording represents a new modernized drafting convention, and is in accordance with the Interpretation Act, used for all Canadian legislative and regulatory drafting. It will not, however, be easily understood by practitioners and businesses required to calculate deadlines. If amendment for further clarity is not possible, we recommend that the “no policy change” be addressed in guidelines, Practice Notices and public education leading to the new Act and Regulations.

Time and manner of withdrawal

(2) For the purpose of subsection 34(4) of the Act, a request for priority may be withdrawn by filing a request to do so before the application is advertised under subsection 37(1) of the Act.

GWLG: We are concerned by the ability to withdraw priority claims prior to advertisement or at all. This may encourage deception before our examiners as our practice in Canada requires no proof of priority entitlement and as proposed the practice may allow for advancement of cases which are deemed to have priority when they do not. Instead of encountering an examination citation based on a third party filing, that third party will then be required to oppose. There should be an additional restriction or condition that where a priority claim is removed, a second confusion search will be undertaken before Examination.

Default in Prosecution of Application

Time for remedying default

34 For the purpose of section 36 of the Act, the time within which a default in the prosecution of an application may be remedied is two months after the date of the notice of the default.

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, **merger or conversion** 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;

GWLG: We understand this represents a more flexible approach by CIPO for correcting typographical errors such as legal status, entity or corporate legal endings, etc and that affidavits will no longer be required. We strongly support this. Recommend adding 'merger' and 'conversion' to the exceptions.

(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;

GWLG: We understand that the policy intention is to introduce a lighter burden on an applicant requesting this change than under our current practice which limits to "in a manner that does not alter the distinctive character". We support this change.

(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

(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;

GWLG: The Rules for Amendment of goods and services are confusing and are a departure from current practice as they appear to suggest the ability to remove goods and services and then reinsert them at a later point in examination. We recommend significant education around the Rules for Amendment of goods and services so the impact on practice is clearly understood.

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

GWLG: We understand this amendment is not permitted since the divisional application would be the “child application”. The parent will not be so indicated but there should be some provision for noting the register on the parent application that there are divided or related cases.

(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

GWLG: The Rules for Amendment under 35(2)(c) to add or delete descriptions of marks, colour claims and nontraditional mark claims are particularly strict and a significant departure from our current procedure. This section is likely to cause significant loss of rights, and consequently fees for applicants in Canada familiar with the current more lenient system. We understand it is the common regulations that require these restrictions. We need to find a means to reduce the impact of this change to protect SME's and Canadian filers who are familiar with the current system. We expect there is no ability to isolate this restriction to those filings which will form the basis of an IA as this is contrary to the goal of the unified approach in the Regulations to treat all filings the same – but we need to remember that these restrictions are a dramatic departure from current practice where we can typically work with an examiner to arrive at an appropriate description of the mark or appropriate colour claim. We recommend a transition phase be developed to allow for education around this regulation and enable changes to or amendments to the descriptions.

(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).

Transfer of Application for Registration of Trademark

Fee

36 A person who requests the recording under subsection 48(3) of the Act of the transfer of an application for the registration of a trademark must pay the fee set out in item 8 of the schedule to these Regulations.

GWLG: We support this.

Required information

37 The Registrar may not record the transfer of an application for the registration of a trademark under subsection 48(3) of the Act unless they have been provided with the name and postal address of the transferee.

GWLG: We support this and the reduction of documentation for recordal of a transfer when initiated by the assignor.

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.

GWLG: We understand that the new Regulations use different language to refer to the assignment of applications versus registrations because they are separated accordingly in the Act. We will record the transfer of an application and we will register the transfer of a registration (see Rule 64). We understand these new sections acknowledge the ability for partial assignments and in return, the removal of the associated mark concept. We support this.

Divisional Application

Manner of identifying corresponding original application

39 For the purpose of subsection 39(2) of the Act, the manner in which a divisional application must identify the corresponding original application is by providing its application number, if known.

GWLG: We support this but strongly recommend that applications and their divisional applications be referenced on the CIPO database or that there be some form of notice to allow for the linking or tracking of divisionals to their 'parent' application.

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;

(b) in any other case, the earlier of

(i) its division day, and

(ii) the day before the day on which the original application is advertised.

GWLG: Section 40 is confusing and the lack of clarity is troubling because the practice of dividing a case is new. We understand that an applicant will have the ability to divide an application into multiple applications at any time. It will be able to divide during an opposition proceeding to move certain goods and services forward and retain others in opposition (and this will require consent of the other party). We understand this section to clarify that when different rules will apply depending on the timing when the goods and services are moved into a divisional. When an application is divided during the two month

opposition period (ie., during advertisement), the original application will continue on its course and the divisional will be re-advertised. Where an application is divided after the two-month opposition period, and an opposition has been filed, opposition proceedings against the original will apply to the divisional. Clarification in a Practice Notice would be tremendously helpful.

Exception

(2) Subsection (1) does not apply in respect of any of the following steps taken in relation to the original application:

- (a) an amendment of the statement of the goods or services contained in the original application;
- (b) a withdrawal of an opposition; and
- (c) a rejection of an opposition.

GWLG: The wording of this section is difficult to understand and will require significant education to ensure understanding by SME's and practitioners.

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.

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

- (a) the application number;
- (b) the name and postal address of the applicant and of the applicant's trademark agent, if any;
- (c) any representation or description of the trademark contained in the application;

GWLG: Does this include colour?

- (d) if the trademark is in standard characters, a note to that effect;
- (e) if the trademark is a certification mark, a note to that effect;
- (f) the filing date of the application;
- (g) if the applicant filed a request for priority in accordance with paragraph 34(1)(b) of the Act, the filing date and country or office of filing of the application on which the request for priority is based;
- (h) the statement of the goods or services in association with which the trademark is used or proposed to be used, grouped according to the classes of the Nice Classification, each group being preceded by the number of the class of the Nice Classification to which that group of goods or services belongs and presented in the order of the classes of the Nice Classification;
- (i) any disclaimer made under section 35 of the Act; and
- (j) if the Registrar has restricted the registration to a defined territorial area in Canada under subsection 32(2) of the Act, a note to that effect.

GWLG: This information should include colour claims, transliterations, translations and reference to distinctiveness claims.

Opposition Proceedings Under Section 38 of the Act

Fee

42 For the purpose of subsection 38(1) of the Act, the prescribed fee for filing a statement of opposition is that set out in item 9 of the schedule to these Regulations.

Correspondence

43 A person who corresponds with the Registrar in respect of an opposition proceeding under section 38 of the Act must clearly state that the correspondence relates to that proceeding.

Forwarding copies of documents

44 A party to an opposition proceeding who on a given day, after the Registrar has forwarded a copy of the statement of opposition to the applicant under subsection 38(5) 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 opposition must, on that day, forward a copy of it to the other party.

GWLG: We support this, in particular the requirement to forward a document to the other side on the same day that it is submitted to the registrar (apart from those documents which you are required to serve).

Service on representative of applicant

45 An applicant may set out in their counter statement under subsection 38(7) of the Act, or may file with the Registrar and serve on the opponent a separate notice setting out, the name and address in Canada of a person or firm on whom service of any document in respect of the opposition may be made with the same effect as if it had been served on the applicant.

GWLG: We understand a counter statement may now include the appointment of an agent in the same document, which is referred to as “a person”. Should we substitute “a person” for “trade mark agent” or “agent” and, include a provision for that party to be made aware of or consent to the appointment? We refer to our comments in s. 22(3).

Manner of service

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

(a) by personal service in Canada;

GWLG: As per both 46(2) and 46(8), some form of proof of delivery must be obtained.

(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.

GWLG: We understand “d” to aid in the situation where the other party is outside Canada without a representative in Canada. There is no requirement to serve outside Canada and the forwarding of a notice to confirm the filing of evidence with CIPO will be sufficient. We support this.

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 the day on which the document is mailed.

Exception — service by courier

(4) Service by courier is effective on the day on which the document is provided to the courier.

Exception — service by electronic means

(5) Service by electronic means is effective on the day on which the document is transmitted.

Exception — service by sending of notice

(6) Service by the sending of a notice under paragraph (1)(d) is effective on the day on which the notice is sent.

GWLG: We understand this section to follow current practice on effective dates for delivery by registered mail, courier, electronic transmission and forwarding of the new notice under 1(d) and highlights “personal service” as carrying a distinct effective date, namely the date of delivery. This would accord with the requirement to obtain a signed receipt on that delivery day as proof of service under 46(8).

Notice of manner and date of service

(7) The party effecting service must notify the Registrar of the manner of service and the effective date of service.

GWLG: We understand this to mean our service communications must state the manner of service and also the effective date for that manner of service as set out in 46(2) through (6).

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.

Non-conforming service

(9) Service of a document other than in accordance with subsection (1) is nonetheless valid if the Registrar determines that the document came to the notice of the party being served, with the service being effective on the day on which the document came to their notice.

GWLG: It would be helpful to understand what type of service CIPO would envision under this section.

Counter statement — timing

47 For the purpose of subsection 38(7) of the Act, the prescribed time is two months after a copy of the statement of opposition is forwarded to the applicant.

Amendment

48 (1) No amendment to a statement of opposition or counter statement may be made except with leave of the Registrar on terms that the Registrar determines to be appropriate.

Interests of justice

(2) The Registrar must grant leave under subsection (1) unless it is not in the interests of justice to do so.

GWLG: There is concern that this revised wording (revised from an earlier technical draft) implies the default is yes you are entitled to leave unless the other party can convince the Registrar why it should not be granted. This represents a shift of the onus or burden to the other party to make the case as to why leave should not be granted. The Board has stated that there is no policy change intended by the inclusion of this section in the Regulations. As such, the section should be redrafted to reflect the current practice or deleted and the practice set out in a Practice Notice.

Alternate wording, which reflects the current test, might be “The Registrar has the discretion to grant leave under subsection (1) and on such terms as the Registrar considers appropriate, when satisfied that it is in the interests of justice to do so”. This would at least balance the issues and require that the party requesting leave must justify why it is appropriate to do so outside of the normally available time.

Manner of submitting evidence

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.

GWLG: We strongly support this. We understand this to reference certified copies of registered and pending rights and to exclude lists of marks, such as state of the register evidence. We understand this will be the same as current practice and there is no policy intent by this change.

Timing — evidence of the opponent

50 (1) The time within which the opponent 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 applicant is four months after the day on which the applicant's service on the opponent of a copy of the counter statement is effective.

GWLG: Although the wording is somewhat awkward, and the deadline presented differently, there is no intended policy change by this wording and the deadline will continue to be calculated as four months from service of the counter statement.

Opponent's statement

(2) If the opponent does not wish to submit evidence under subsection 38(8) of the Act, they may rather submit a statement to that effect within the four-month period set out in subsection (1) and serve it on the applicant within that period.

GWLG: The word ‘rather’ could be removed to bring clarity.

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.

GWLG: A deemed withdraw should occur “after the end” of the four month period.

Timing — evidence of the ~~opponent~~ applicant (correction)

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.

Applicant's statement

(2) If the applicant does not wish to submit evidence under subsection 38(8) of the Act, they may rather submit a statement to that effect within the four-month period set out in subsection (1) and serve it on the opponent within that period.

GWLG: The word ‘rather’ could be removed to bring clarity.

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.

GWLG: A deemed abandonment should not occur until after the end of the four month period.

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.

GWLG: This accords with current practice.

Additional evidence

55 (1) A party may submit additional evidence with leave of the Registrar on terms that the Registrar determines to be appropriate.

GWLG: This accords with current practice.

Interests of justice

(2) The Registrar must grant leave under subsection (1) unless it is not in the interests of justice to do so.

GWLG: We reiterate our comments under section 48(2).

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.

GWLG: We understand this to mean that there is no deadline for filing a request for cross-examination provided it issues before the call for written arguments. We recommend that a deadline be clearly set out in a Practice Notice. We also acknowledge that the Registrar must order a cross-examination and appears to lose discretion to deny. We understand this is because the Registrar’s authority may not go beyond what is set out in the Act and the word “may” is now “must”. We recommend that the Registrar have the discretion to refuse the Order in appropriate circumstances. For instance, “.. must order the cross-examination under oath or solemn affirmation unless they are satisfied the circumstances makes it inappropriate to do so” or something to this effect.

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.

GWLG: We strongly support this shared responsibility in 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.

GWLG: We support this but request that the evidence be eliminated from the file.

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.

GWLG: It may be difficult for the Board to ascertain when all evidence is filed given the lower bar on leave requests to file additional evidence and the ability to examine on that evidence. We recommend firm deadlines be established in a Practice Notice.

Opponent's written representations and statements — timing

(2) The time within which the opponent may, under subsection 38(8) of the Act, submit to the Registrar written representations and must, under subsection 38(9) of the Act, serve them on the applicant is two months after the date of that notice.

GWLG: We strongly support this longer term for the filing of Written Arguments.

Opponent's statement

(3) If the opponent does not wish to submit written representations, they may rather submit a statement to that effect within the two-month period set out in subsection (2) and serve it on the applicant within that period.

GWLG: Recommend removal of 'rather' to bring clarity.

Applicant's written representations — timing

(4) The time within which the applicant may, under subsection 38(8) of the Act, submit to the Registrar written representations and must, under subsection 38(9) of the Act, serve them on the opponent is,

(a) if service referred to in subsection (2) or (3), as the case may be, is effective within the two-month period mentioned in that subsection, within two months after the day on which that service is effective; and

(b) in any other case, within two months after the expiry of the two-month period mentioned in subsection (2).

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

GWLG: This is confusing wording. This requires clarification in a Practice Notice.

(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

GWLG: This detail is typically provided when the hearing is set so the representatives can identify the attending party and organize these details. This is difficult timing to provide accurate details and will result in many changes. We recommend that these details be provided later.

(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.

GWLG: Same comment as 58(a) above.

Prohibition

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

GWLG: Once a hearing is requested, both parties should have the ability to appear and the party who did not request the Hearing should face a deadline to confirm their attendance. This prohibition will increase hearing requests as the parties will always default to request one to preserve their option even when they

did not wish to in the first place. We understand that in practice you will continue to accept a conditional hearing request, conditional on the other party requesting the hearing.

Changes

(3) If a party notifies the Registrar of changes to any of the information provided under subsection (1) at least one month before the date of the hearing, the Registrar must modify the administrative arrangements for the hearing accordingly.

GWLG: These changes may happen often because of the inability to provide accurate details set out in 58(1)(a) and (b) at the time of the hearing request. We recommend this information be submitted later.

Register

Particulars

59 For the purpose of paragraph 26(2)(f) of the Act, the following are other particulars that are required to be entered on the register:

- (a) the registration number;
- (b) the name and postal address of the registered owner on the date of registration;
- (c) any representation or description of the trademark contained in the application for the registration of the trademark;
- (d) if the trademark is in standard characters, a note to that effect;
- (e) if the trademark is a certification mark, a note to that effect; and
- (f) if the Registrar has restricted the registration to a defined territorial area in Canada under subsection 32(2) of the Act, a note to that effect.

GWLG: These details should include translations, transliterations, colour claims, distinctiveness claims and territorial restrictions.

Fee for extending statement of goods or services

60 For the purpose of subsection 41(1) of the Act, the prescribed fee to be paid by a registered owner of a trademark who makes an application to extend the statement of goods or services in respect of which a trademark is registered is that set out in item 10 of the schedule to these Regulations.

Merger of registrations

61 The Registrar may merge registrations under paragraph 41(1)(f) of the Act only if the trademarks to which the registrations apply are the same and have the same registered owner.

GWLG: We understand there is no fee for merging.

Fee for sending of notice

62 For the purpose of subsection 44(1) of the Act, the prescribed fee to be paid by a person who requests the giving of notice under that subsection is that set out in item 11 of the schedule to these Regulations.

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.

GWLG: We recommend that registrants have the ability to extend this deadline.

Transfer of Registered Trademark

Fee

64 A person who requests the registration of a transfer of a registered trademark under subsection 48(4) of the Act must pay the fee set out in item 12 of the schedule to these Regulations.

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.

GWLG: We support this.

Proceeding Under Section 45 of Act

Fee

66 For the purpose of subsection 45(1) of the Act, the prescribed fee to be paid by a person who requests the giving of notice under that subsection is that set out in item 13 of the schedule to these Regulations.

Correspondence

67 A person who corresponds with the Registrar in respect of a proceeding under section 45 of the Act must clearly state that the correspondence relates to that proceeding.

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.

GWLG: We strongly support the new requirement to forward a copy of all submissions to the Registrar to the other party.

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.

GWLG: Our comments regarding effective dates, and procedure regarding opposition also apply to Section 45 proceedings. See comments in 46.

Manner of service

70 (1) Service of a document in respect of a proceeding under section 45 of the Act 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 submitted 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 the day on which the document is mailed.

Exception — service by courier

(4) Service by courier is effective on the day on which the document is provided to the courier.

Exception — service by electronic means

(5) Service by electronic means is effective on the day on which the document is transmitted.

GWLG: Our comments regarding effective dates, and procedure regarding opposition also apply to Section 45 proceedings. See comments in 46.

Exception — service by sending of notice

(6) Service by the sending of a notice under paragraph (1)(d) is effective on the day on which the notice is sent.

Notice of manner and date of service

(7) The party effecting service must notify the Registrar of the manner of service and the effective date of service.

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.

Non-conforming service

(9) Service of a document other than in accordance with subsection (1) is nonetheless valid if the Registrar determines that the document came to the notice of the party being served, with the service being effective on the day on which the document came to their notice.

Evidence — timing

71 For the purpose of subsection 45(2.1) of the Act, the time within which the registered owner of the trademark must serve their evidence on the person at whose request the notice was given is the three-month period referred to in subsection 45(1) of the Act.

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.

Timing if notice given at Registrar's initiative

(2) For the purpose of subsection 45(2) of the Act, if the notice referred to in subsection 45(1) of the Act was given on the Registrar's own initiative, the time within which the registered owner may submit written representations to the Registrar is two months after the date of the notice given under subsection (1) of this section.

GWLG: We predict in this “Registrar-initiated’ proceeding, the Registrar will not make representations and will instead simply issue a decision subject to a Hearing Request by the registrant. Would it make sense to then combine the requirement for the registrant’s evidence and submissions to expedite the proceedings? We also welcome the opportunity to recommend guidelines or criteria for the Office to consider for the identity of registrations that should be subject to these Registrar-initiated proceedings. Rather than proceeding by random selection, we submit that the Office consider situations where a case meets one or two criteria following the three year protection term:

- **The registration covers a significant number of classes or a suspect variety of classes unusually broad**
- **The registration is several years old and there is no sign of recorded activity of any sort**
- **The registrant is known to be bankrupt or not operating in Canada**
- **The registrant has failed to defend or did not attempt to defend a registration with the same distinctive element**

Timing if notice given at request of person

(3) For the purpose of subsections 45(2) and (2.1) of the Act, if the notice referred to in subsection 45(1) of the Act was given at the request of a person,

(a) the time within which that person may submit written representations to the Registrar and must serve those representations on the registered owner is two months after the date of the notice given under subsection (1) of this section; and

(b) the time within which the registered owner may submit written representations to the Registrar and must serve those representations on that person is two months after the day on which that person's service of written representations or of a statement provided to the Registrar that the person does not wish to make written representations is effective or, if no such service is effective within the period referred to in paragraph (a), two months after that period's expiry.

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.

Changes

(4) If a party notifies the Registrar of changes to any of the information provided under subsection (1) at least one month before the date of the hearing, the Registrar must modify the administrative arrangements for the hearing accordingly.

GWLG: Our comments regarding effective dates, deadlines and procedure also apply here. See section 8.

Renewal of Registration

Fee

74 For the purpose of section 46 of the Act, the prescribed renewal fee is that set out in item 14 of the schedule to these Regulations.

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.

GWLG: We recommend that these dates be clarified in a Practice Notice. We anticipate this to indicate that a renewal notice, if issued late, may extend the grace period.

Deemed date — merged registrations

76 For the purpose of a renewal under section 46 of the Act, the deemed day of registration in respect of a registration of a trademark that results from the merger of registrations under paragraph 41(1)(f) of the Act is the day that is 10 years before the earliest day, after the day of merger, on which the initial period or renewal period, as the case may be, in respect of any of the registrations being merged would have expired, had the merger not occurred.

GWLG: We understand this to mean 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. Clarity would be helpful.

Objection Proceeding Under Section 11.13 of Act

GWLG: Our comments under opposition apply equally for Objector Proceedings.

Fee

77 For the purpose of subsection 11.13(1) of the Act, the prescribed fee for filing a statement of objection is that set out in item 15 of the schedule to these Regulations.

Correspondence

78 A person who corresponds with the Registrar in respect of an objection proceeding under section 11.13 of the Act must clearly state that the correspondence relates to that proceeding.

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 Register that relates to the objection must, on that day, forward a copy of it to the other party.

Manner of service

80 (1) Service of a document in respect of an objection 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;

GWLG: Our comments under opposition apply equally for Objector Proceedings.

(d) by the sending of a notice to the other party advising that the document to be served has been filed with or submitted 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); and

(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 the day on which the document is mailed.

Exception — service by courier

(4) Service by courier is effective on the day on which the document is provided to the courier.

Exception — service by electronic means

(5) Service by electronic means is effective on the day on which the document is transmitted.

Exception — service by sending of notice

(6) Service by the sending of a notice under paragraph (1)(d) is effective on the day on which the notice is sent.

Notice of manner and date of service

(7) The party effecting service must notify the Registrar of the manner of service and the effective date of service.

GWLG: Our comments under opposition apply equally for Objector Proceedings.

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.

Non-conforming service

(9) Service of a document other than in accordance with subsection (1) is nonetheless valid if the Registrar determines that the document came to the notice of the party being served, with the service being effective on the day on which the document came to their notice.

Amendment

81 (1) No amendment to a statement of objection or counter statement may be made except with leave of the Registrar on terms that the Registrar determines to be appropriate.

Interests of justice

(2) The Registrar must grant leave under subsection (1) unless it is not in the interests of justice to do so.

Manner of submitting evidence

82 Evidence in respect of an objection proceeding, other than evidence referred to in subsection 90(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.

GWLG: Our comments under opposition apply equally for Objector Proceedings.

Timing — evidence of the objector

83 (1) The time within which the objector may, under subsection 11.13(5) of the Act, submit evidence and must, under subsection 11.13(5.1) of the Act, serve any such evidence on the responsible authority is four months after the day on which the responsible authority's service on the objector of a copy of the counter statement is effective.

Objector's statement

(2) If the objector does not wish to submit evidence, they may rather submit a statement to that effect within the four-month period set out in subsection (1) and serve it on the responsible authority within that period.

Circumstances — deemed withdrawal of objection

84 For the purpose of subsection 11.13(6) of the Act, the circumstances under which the objector's not submitting and serving evidence or statement referred to in that subsection results in their objection being deemed to have been withdrawn are that neither that evidence nor that statement has been submitted and served by the objector by the end of the four-month period referred to in section 83 of these Regulations.

Timing — evidence of the responsible authority

85 (1) The time within which the responsible authority may, under subsection 11.13(5) of the Act, submit evidence and must, under subsection 11.13(5.1) of the Act, serve any such evidence on the objector is four months after the day on which the objector's service under section 83 of these Regulations is effective.

Responsible authority's statement

(2) If the responsible authority does not wish to submit evidence, they may rather submit a statement to that effect within the four-month period set out in subsection (1) and serve it on the objector within that period.

GWLG: Our comments under opposition apply equally for Objector Proceedings.

Non-application of subsection 11.13(5) of Act — circumstances

86 For the purpose of paragraph 11.13(5)(a) of the Act, the circumstances under which the responsible authority's not submitting and serving evidence or a statement that they do not wish to submit evidence results in the loss of the opportunity to submit evidence are that neither that evidence nor that statement has been submitted and served by the responsible authority by the end of the four-month period referred to in section 85 of these Regulations.

Indication or translation not entered on list — circumstances

87 For the purpose of subsection 11.13(6.1) of the Act, the circumstances under which the responsible authority's not submitting and serving evidence or a statement that they do not wish to submit evidence results in the indication or the translation not being entered on the list are that neither that evidence nor that statement has been submitted and served by the responsible authority by the end of the four-month period referred to in section 85 of these Regulations.

Reply evidence — timing

88 Within one month after the day on which the responsible authority's service on the objector under section 85 is effective, the objector may submit to the Registrar reply evidence and, if so, must serve it on the responsible authority.

Additional evidence

89 (1) A party may submit additional evidence with leave of the Registrar on terms that the Registrar determines to be appropriate.

GWLG: Our comments under opposition apply equally for Objector Proceedings.

Interests of justice

(2) The Registrar must grant leave under subsection (1) unless it is not in the interests of justice to do so.

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.

GWLG: Our comments under opposition apply equally for Object Proceedings.

Inadmissibility in absence of cross-examination

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

Written representations

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

Opponent's written representations and statements — timing

(2) The time within which the objector may, under subsection 11.13(5) of the Act, submit to the Registrar written representations and must, under subsection 11.13(5.1) of the Act, serve them on the responsible authority is two months after the date of that notice.

Objector's statement

(3) If the objector does not wish to submit written representations, they may rather submit a statement to that effect within the two-month period set out in subsection (2) and serve it on the responsible authority within that period.

Responsible authority's written representations — timing

(4) The time within which the responsible authority may, under subsection 11.13(5) of the Act, submit to the Registrar written representations and must, under subsection 11.13(5.1) of the Act, serve them on the objector is,

(a) if service referred to in subsection (2) or (3), as the case may be, is effective within the two-month period mentioned in that subsection, within two months after the day on which that service is effective; and

GWLG: Our comments under opposition apply equally for Object Proceedings.

(b) in any other case, within two months after the expiry of the two-month period mentioned in subsection (2).

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.

Changes

(3) If a party notifies the Registrar of changes to any of the information provided under subsection (1) at least one month before the date of the hearing, the Registrar must modify the administrative arrangements for the hearing accordingly.

GWLG: Our comments under opposition apply equally for Object Proceedings.

Copies of Documents**Fee for certified copies**

93 (1) A person who requests a certified copy of a document in the Registrar's possession must pay the fee set out in item 16 or 17 of the schedule, as applicable.

Exception

(2) Subsection (1) does not apply in respect of a certified copy transmitted under section 60 of the Act or rule 318 of the Federal Courts Rules, including as modified by rule 350 of those Rules.

Fee for non-certified copies

94 A person who requests a certified copy of a non-certified copy of a document in the Registrar's possession must pay the fee set out in item 18 or 19 of the schedule, as applicable.

PART 2 Implementation of Madrid Protocol

General

Interpretation

95 The following definitions apply in this Part.

basic application means an application for the registration of a trademark that has been filed under subsection 30(1) of the Act and that constitutes the basis for an application for international registration, but does not include a Protocol application. (demande de base)

basic registration means a registration of a trademark that is on the register and that constitutes the basis for an application for international registration, but does not include a Protocol registration. (enregistrement de base)

Common Regulations means the Common Regulations under the Madrid Agreement Concerning the International Registration of Marks and the Protocol Relating to that Agreement, as modified from time to time. (Règlement d'exécution commun)

contracting party means any state or intergovernmental organization that is a party to the Protocol. (partie contractante)

date of international registration means the date borne by the international registration under Rule 15 of the Common Regulations. (date de l'enregistrement international)

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)

holder means the person in whose name an international registration is recorded in the International Register.
(titulaire)

opposition period means the two-month period referred to in subsection 38(1) of the Act or, if the Registrar has extended that period under section 47 of the Act, the extended period. (délai d'opposition)

Protocol means the Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks, adopted at Madrid on June 27, 1989, including any amendments, modifications and revisions made from time to time to which Canada is a party. (Protocole)

Protocol application means an application referred to in subsection 102(1) or (2) or a divisional application referred to in subsection 123(1). (demande prévue au Protocole)

Protocol registration means the registration of a trademark under subsection 131(1). (enregistrement prévu au Protocole)

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.

GWLG: We understand that certain dies non days for CIPO will not apply to Protocol deadlines. The Common Regulations provide for dies non dates for the IB. In practice, this will mean that certain Protocol deadlines which fall due on CIPO dies non days are still active deadlines. We recommend this be clarified in the Regulations and Practice Notices.

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.

Application for International Registration (Office of Registrar as Office of Origin)

Entitlement

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

(b) the person is the applicant in respect of a basic application for the trademark or, if there is a basic registration in respect of the trademark, the registered owner of the trademark.

GWLG: “citizen” is removed from the entitlement provision. Clarification is requested.

Contents and Form

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,

(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;
- (d) if colour is claimed as a feature of the trademark in the basic application or the basic registration, the same claim;
- (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;
- (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
 - (ii) groups the goods or services according to the classes of the Nice Classification, each group being preceded by the number of the class of the Nice Classification to which that group of goods or services belongs and presented in the order of the classes of the Nice Classification; and
- (h) the names of the contracting parties for which the extension of protection is requested under Article 3ter(1) of the Protocol.

Language

- (2) The application for international registration, with the exception of the trademark itself, must be in English or French

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.

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

- (a) certifying that the particulars appearing in the application for international registration correspond to the particulars appearing in the basic application or basic registration;
- (b) presenting the application for international registration to the International Bureau; and
- (c) if the application for international registration results in an international registration, notifying the International Bureau if, in respect of all or any of the goods or services listed in the international registration, the basic application is withdrawn, abandoned or refused or the basic registration is cancelled or expunged before the end of five years after its date of international registration or if a proceeding that began before the end of that five-year period produces such a result after that period.

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.

Manner of filing

- (2) The request must be in English or French and 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.

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.

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.

Territorial Extension to Canada

Protocol Application

Request under Article 3ter(1) of the Protocol

102 (1) On the registration of a trademark in the international registrar on the basis of an application that contains a request made under Article 3ter(1) of the Protocol for the extension to Canada of the protection of a trademark resulting from its international registration, an application is deemed to have been filed under subsection 30(1) of the Act by the holder of the international registration for the registration of the trademark and in respect of the same goods or services that are listed in that request .

Request under Article 3ter(2) of the Protocol

(2) On the recording in the International Register of a request made under Article 3ter(2) of the Protocol for the extension to Canada of the protection of a trademark resulting from its international registration, an application is deemed to have been filed under subsection 30(1) of the Act by the holder of the international registration for the registration of the trademark and in respect of the same goods or services that are listed in that request.

Deemed application for certification mark

(3) An application referred to in subsection (1) or (2) is deemed to be an application for the registration of a certification mark if the international registration relates to a collective mark, a certification mark or a guarantee mark.

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.

GWLG: We identify a concern in this section which raises a new ground of opposition related to registrability not found in Section 12. Will Section 12 need to be amended?

Filing Date

Non-application of sections 33 and 34 of Act

104 Sections 33 and 34 of the Act do not apply in respect of a Protocol application.

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.

Exception — priority

(2) Despite subsection (1), if, before the filing date of a Protocol application as determined under that subsection, the applicant of the Protocol application or the applicant's predecessor in title had applied, in or for any country of the Union other than Canada, for the registration of the same or substantially the same trademark in association

with the same kind of goods or services, the filing date of the application in or for the other country is deemed to be the filing date of the Protocol application and the applicant is entitled to priority in Canada accordingly despite any intervening use in Canada or making known in Canada or any intervening application or registration, if

(a) the international registration on which the Protocol application is based contains a declaration claiming the priority of the application in or for the other country together with an indication of the name of the country or office where the filing was made and of the filing date;

(b) the filing date of the Protocol application as determined under subsection (1) is within a period of six months after the date on which the earliest application was filed in or for any country of the Union for the registration of the same or substantially the same trademark in association with the same kind of goods or services; and

(c) the applicant of the Protocol application, at the filing date of the Protocol application as determined under subsection (1), is a citizen or national of or domiciled in a country of the Union or has a real and effective industrial or commercial establishment in a country of the Union.

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.

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).

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).

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.

GWLG: A partial cancellation should not result in a 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.

Effective date of amendment or withdrawal

111 An amendment or withdrawal of a Protocol application under any of sections 106 to 110 is deemed to take effect on the date of the limitation, renunciation, cancellation or change recorded in the International Register.

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.

Effect of Correction of International Registration on Protocol Application

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.

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.

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
- (b) 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.

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.

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.

Abandonment**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.

Examination**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.

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.

Filing of request for division

122 (1) The applicant in respect of a Protocol application may limit the original Protocol application to one or more of the goods or services that were within its scope and file with the Registrar for presentation to the International Bureau a request for the division, in respect of Canada, of the international registration on which the original Protocol application is based for any other goods or services that were within the scope of

- (a) the original Protocol application on its filing date;
- (b) the original Protocol application as advertised, if the request is filed on or after the day on which the Protocol application is advertised under subsection 37(1) of the Act; and
- (c) the international registration in respect of Canada on the day on which the request is filed.

Manner of filing

(2) The request must be in English or French and 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.

Contents

(3) The request must indicate

- (a) the number of the international registration on which the original Protocol application is based;
 - (b) the name of the holder of that international registration;
 - (c) the name of the goods or services to be set apart, grouped according to the classes of the Nice Classification;
- and

(d) 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.

Forwarding of request to International Bureau

(4) The Registrar must forward to the International Bureau any request that is filed in accordance with subsections (1) to (3).

Deemed divisional application

123 (1) If, following receipt of a request under section 122, the International Bureau notifies the Registrar of the creation of a divisional international registration in respect of Canada, the applicant is deemed to have filed a divisional application for the registration of the same trademark as in the divisional international registration and in respect of the same goods or services that are listed in the divisional international registration in respect of Canada.

Division of divisional application

(2) The divisional application may itself be divided under subsection (1) and section 122, in which case those provisions apply as if that divisional application were an original Protocol application.

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.

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.

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.

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.

GWLG: We understand Statements of Opposition must include all possible grounds of opposition at filing as they may not be amended to add a new ground. We understand this to mean one can amend existing grounds, with leave, and delete existing grounds.

Notice of opposition period

128 If, in respect of a Protocol application, it is likely that the opposition period will extend beyond the end of 18 months after the date of notification of territorial extension, the Registrar must so inform the International Bureau.

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.

Registration of Trademarks

Non-application of section 40 of Act

130 Section 40 of the Act does not apply in respect of a Protocol application.

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;
- (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
- (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.

GWLG: Should Section (b) include “... decided in favour of the applicant for some or all of the goods and services” to address a case where an opposition is only partially successful. Section d(ii), in particular, is very complicated and difficult to comprehend.

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.

Amendment of Register

Non-application of statutory provisions

132 Paragraphs 41(1)(a) to (c) and (f), subsections 41(2) and (4) and section 44.1 of the Act do not apply in respect of a Protocol registration.

Filing of request for merger

133 (1) The holder of a divisional international registration in respect of Canada may file with the Registrar for presentation to the International Bureau a request for the divisional international registration to be merged into the international registration from which it was divided if there is at least one Protocol registration based on each of those international registrations and

(a) those Protocol registrations stem from the same original Protocol application;

- (b) they relate to the same trademark; and
- (c) their registered owner is the holder of the international registrations.

Manner of filing

- (2) The request must be in English or French and 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.

Contents

- (3) The request must indicate
 - (a) the numbers of the international registrations to be merged; and
 - (b) the name of the holder of the international registrations to be merged.

Forwarding of request to International Bureau

- (4) The Registrar must forward to the International Bureau any request that is filed in accordance with subsections (1) to (3).

Merger of Protocol registrations

- (5) If, following receipt of the request, the International Bureau notifies the Registrar of the merger of a divisional international registration in respect of Canada into the international registration from which it was divided, the Registrar must amend the register to merge the Protocol registrations that are based on those international registrations and that stem from the same original Protocol application.

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.

GWLG: Same comments re: 2(b) “specific” goods or services as made in Section 29.

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).

GWLG: Where the limitation is refused under (4), what is the consequence for the resulting protection in Canada? Is the limitation only refused when it is broader so the Canadian right is an acceptable subset of the goods and services in the IR?

Complete renunciation

135 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 of a renunciation in respect of Canada for all of the goods or services, the Registrar must cancel the Protocol registration.

Complete cancellation

136 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 of a cancellation of the international registration for all of the goods or services, the Registrar must cancel the Protocol registration.

Partial cancellation

137 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 of a cancellation of the international registration for at least one but not all of the goods or services, the Registrar must cancel the Protocol registration or amend the register accordingly.

GWLG: The words ‘but not all’ suggest there would still be an existing right in the Protocol registration so cancellation should not be an option.

Change of name or address

138 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 of a change in the name or address of the holder, the Registrar must amend the register accordingly.

Correction of international registration

139 (1) If the International Bureau notifies the Registrar of a correction of an international registration in the International Register affecting a Protocol registration and

(a) if the Registrar considers that protection can still be granted to the international registration as corrected, the Registrar must amend the register accordingly; or

(b) if the Registrar considers that protection cannot, or can no longer, be granted to the international registration as corrected, the Registrar must so declare and state their grounds in a notification of provisional refusal sent to the International Bureau within 18 months after the date on which the notification of the correction was sent.

GWLG: Where the correction is refused under (b), where does this leave the Canadian protocol registration that no longer “matches” the IR? We also understand that ‘correction’ is very broadly construed and recommend significant education on this point.

Period to respond

(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.

Protection granted

(3) 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 can be granted to the international registration as corrected, the Registrar must notify the International Bureau and amend the register accordingly.

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.

Effective date of cancellation or amendment

140 A cancellation of a Protocol registration or an amendment of the register under any of sections 134 to 139 is deemed to take effect on the date of the limitation, renunciation, cancellation, change or correction recorded in the International Register.

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.

Notification

(2) If the Registrar removes a Protocol registration from the register under subsection (1), the Registrar must notify the International Bureau accordingly.

Renewal**Non-application of section 46 of Act**

142 Section 46 of the Act does not apply in respect of a Protocol registration.

Period of registration

143 (1) Subject to the Act and any other provision of these Regulations, a Protocol registration is on the register for the period beginning on the day of the registration and ending at the moment of its cancellation or expungement.

Expungement

(2) If the international registration on which a Protocol registration is based is not renewed in respect of Canada and the International Bureau notifies the Registrar accordingly, the Registrar must expunge the Protocol registration. The Protocol registration is deemed to have been expunged at the expiry of the international registration in respect of Canada.

Transfer

Non-application of subsections 48(3) to (5) of Act

144 Subsections 48(3) to (5) of the Act do not apply in respect of a Protocol application or a Protocol registration.

Recording or registration

145 If the International Bureau notifies the Registrar of the recording in the International Register of a change in ownership in respect of Canada of an international registration on which a Protocol application or a Protocol registration is based, the Registrar must record the transfer of the Protocol application or register the transfer of the Protocol registration accordingly.

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.

GWLG: Transformation creates a 'grey area' of 3 months following cancellation of the IR when a Protocol application or registration in Canada that "appears" to be cancelled, can be revived. How will the Office treat this 3 month potential reinstatement term in its consideration of third party rights previously blocked by this entry? Will it advance those rights and pull them back after reinstatement?

Single application or registration

(2) The transformation application may only be filed in respect of a single Protocol application or Protocol registration.

List of goods or services — scope

(3) The statement of the goods or services in the transformation application may only include goods or services that are within the scope of

(a) goods or services that were cancelled from the international registration in respect of Canada; and

(b) goods or services in the Protocol application or Protocol registration on the date of cancellation recorded in the International Register.

Contents of application

(4) The transformation application must include the following

(a) a statement to the effect that the application is for transformation of an international registration;

(b) a statement of the goods or services in respect of which the registration of the trademark is sought;

(c) the international registration number of the cancelled international registration;

(d) information that permits the Registrar to identify the Protocol application or Protocol registration that was based on the cancelled international registration.

Manner of filing

(5) The transformation application must be filed by an electronic means specified by the Registrar.

No extension

(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.

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;

(c) the application referred to in paragraph (a) is deemed to have the same filing date as the Protocol application;
and

(d) any steps taken in relation to the Protocol application before the day on which the International Bureau notifies the Registrar of the recording of the cancellation of the international registration are deemed to have been taken in relation to the application referred to in paragraph (a).

Consequences — trademark subject of cancelled Protocol registration

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

- (a) the Registrar must, in respect of the goods or services specified in the transformation application, register the trademark in the name of the applicant and issue a certificate of its registration;
- (b) the registration of the trademark is deemed to have resulted from the Protocol application that resulted in the Protocol registration;
- (c) the day of registration of the trademark is deemed to be the day of registration of the Protocol registration;
- (d) despite subsection 46(1) of the Act and subject to any other provision of the Act, the registration of the trademark is or is deemed to be on the register for
 - (i) an initial period that begins on the day of registration of the trademark and ends when the international registration's term of protection would have expired had the international registration not been cancelled, and
 - (ii) subsequent renewal periods of 10 years if the fee set out in item 14 of the schedule is paid
- (A) for the first renewal period, within the period referred to in section 75 or within six months after the day on which the trademark is registered under paragraph (a), not taking into account paragraph (c), whichever ends later, and
- (B) for each subsequent renewal period, within the period referred to in section 75; and
- (e) any steps taken in relation to the Protocol registration before the day on which the International Bureau notifies the Registrar of the recording of the cancellation of the international registration are deemed to have been taken in relation to the registration made under paragraph (a).

Denunciation

Application of Article 15(5) of the Protocol

149 Article 15(5) of the Protocol applies to a holder of an international registration on which a Protocol application or a Protocol registration is based if that holder is no longer entitled to file international applications under Article 2(1) of the Protocol because of the denunciation of the Protocol by a contracting party.

PART 3 Transitional Provisions, Repeal and Coming into Force

Transitional Provisions

GWLG: These provisions are difficult to understand, particularly sections 153 to 159. Clarity is recommended or guidelines that specifically set out the transitional provisions.

Meaning of former Regulations

150 For the purpose of sections 151 to 154 and 157, former Regulations means the Trade-marks Regulations as they read immediately before the day referred to in subsection 161(1).

Filing date already determined

151 If, before the day referred to in subsection 161(1), the date of filing of an application for the registration of a trademark has been determined in accordance with section 25 of the former Regulations, the filing date of the application is that date of filing.

Filing date — coming into force

152 If, before the day on which these Regulations come into force, in respect of an application for the registration of a trademark, all of the items set out in subsection 33(1) of the Act have been received by the Registrar but not all of the items set out in section 25 of the former Regulations have been delivered to the Registrar, the filing date of the application is the day referred to in subsection 161(1) of these Regulations.

GWLG: These provisions are difficult to understand, particularly sections 153 to 159. Clarity is recommended or guidelines that specifically set out the transitional provisions.

Exception to subsection 32(1)

153 If the filing date of an application for the registration of a trademark precedes the day referred to in subsection 161(1) and the trademark has not yet been registered, subsection 32(1) does not apply and the person who filed the application must pay the fee set out in item 15 of the schedule to the former Regulations, in addition to the fee set out in item 1 of that schedule that they have already paid.

Exception to subsection 32(2)

154 If the filing date of an application for the registration of a trademark precedes the day referred to in subsection 161(1) of these Regulations, the prescribed fee for the purpose of paragraph 33(1)(f) of the Act as referred to in section 69.1 of the Act, is, despite subsection 32(2) of these Regulations, the fee set out in item 1 of the schedule to the former Regulations.

Exception to section 34

155 Despite section 34, if the date of a notice of a default in the prosecution of an application precedes day referred to in subsection 161(1), the time within which the default may be remedied is that specified in the notice.

Exception to paragraph 35(2)(e)

156 Despite paragraph 35(2)(e) of these Regulations, an application for registration referred to in section 69.1 of the Act may, if the trademark remains substantially the same, be amended to add a statement referred to in paragraph 31(b) of the Act or any of paragraphs 31(e) to (g) of these Regulations.

GWLG: These provisions are difficult to understand, particularly sections 153 to 159. Clarity is recommended or guidelines that specifically set out the transitional provisions.

Exception to section 74

157 Despite section 74 of these Regulations, for the purpose of section 46 of the Act, the prescribed renewal fee for a registration in respect of which the day of the last renewal — or, if the registration has never been renewed, the day of the registration — is more than 15 years before day referred to in subsection 161(1) of these Regulations is the fee set out in item 7 of the schedule to the former Regulations.

Exception to section 75 — first renewal

158 Despite section 75 of these Regulations and subject to section 159 of these Regulations, for the purpose of subsections 46(2) to (5) of the Act, in respect of the first renewal, on or after the day referred to in subsection 161(1) of these Regulations, of a registration that is on the register on the day before that day, the period within which the renewal fee must be paid begins on the later of the day of registration and the day of last renewal and ends on the later of the end of the period of 15 years and six months beginning after that day and the end of the two-month period beginning after the date of the notice referred to in subsection 46(2) of the Act.

Exception to section 75 — goods or services not grouped

159 Despite section 75 of these Regulations, if the goods or services in respect of which a trademark is registered are not, at the expiry of the period that would otherwise apply, grouped on the register in accordance with paragraph 26(2)(e.1) of the Act, the period within which the fees set out in subparagraphs 14(a)(ii) and (b)(ii) of the schedule to these Regulations must be paid ends, if later than the end of the period established by section 75 or 158, the end of the two-month period beginning after the day on which the Registrar sends to the registered owner a notice stating that the register has been amended to so group the goods or services and that the registration will be expunged if the fees are not paid within the prescribed period.

GWLG: These provisions are difficult to understand, particularly sections 153 to 159. Clarity is recommended or guidelines that specifically set out the transitional provisions.

Repeal

160 The Trade-marks Regulations Footnote 1 are repealed.

Coming into Force

S.C. 2015, c. 36, s. 67 and S.C. 2017, c. 6, s. 75

161 (1) Subject to subsection (2), these Regulations come into force on the first day on which both section 67 of the Economic Action Plan 2015 Act, No. 1, chapter 36 of the Statutes of Canada, 2015 and section 75 of the Canada–European Union Comprehensive Economic and Trade Agreement Implementation Act, chapter 6 of the Statutes of Canada, 2017, are in force but, if they are registered after that day, they come into force on the day on which they are registered.

February 1, 2019

(2) If that section 67 comes into force before February 1, 2019, sections 122, 123 and 133 of these Regulations come into force on February 1, 2019.

SCHEDULE

(Section 14, subparagraph 16(b)(ii), section 19, paragraph 20(1)(a), subparagraph 21(b)(i), sections 26, 32, 36, 42, 60, 62, 64, 66, 74 and 77, subsection 93(1), section 94 and subparagraph 149(d)(ii))

Tariff of Fees		
Item	Description	Fee (\$)
1	Application for an extension of time under section 47 of the Act, for each act for which the extension is sought	125.00
2	Trademark agent qualifying examination	400.00
3	Request for name to be entered on the list of trademark agents	
	(a) if the request and fee are submitted online through the Canadian Intellectual Property Office website	300.00
	(b) in any other case	350.00
4	Maintenance of name on list of trademark agents	
	(a) if the fee is submitted online through the Canadian Intellectual Property Office website	300.00
	(b) in any other case	350.00
5	Reinstatement of name on list of trademark agents	200.00

6	Request for the giving of public notice under paragraph 9(1)(n) or (n.1) of the Act, for each badge, crest, emblem, mark or armorial bearing	500.00
7	Application for the registration of a trademark	
	(a) if the application and fee are submitted online through the Canadian Intellectual Property Office website	
	(i) for the first class of goods or services to which the application relates	330.00
	(ii) for each additional class of goods or services to which the application relates as of the filing date	100.00
	(b) in any other case	
	(i) for the first class of goods or services to which the application relates	430.00
	(ii) for each additional class of goods or services to which the application relates as of the filing date	100.00
8	Request for the recording of the transfer of one or more applications for the registration of a trademark under subsection 48(3) of the Act, for each application	100.00
9	Statement of opposition under subsection 38(1) of the Act	750.00
10	Application to amend the register under subsection 41(1) of the Act to extend the statement of goods or services in respect of which a trademark is registered	
	(a) for the first class of goods or services to which the application relates	430.00
	(b) for each additional class of goods or services to which the application relates	100.00
11	Request for the giving of one or more notices under subsection 44(1) of the Act, for each notice requested	400.00

12	Request for the registration of the transfer of one or more registered trademarks under subsection 48(4) of the Act, for each trademark	100.00
13	Request for the giving of one or more notices under subsection 45(1) of the Act, for each notice requested	400.00
14	Renewal of the registration of a trademark under section 46 of the Act	
	(a) if the renewal is requested and the fee submitted online through the Canadian Intellectual Property Office website	
	(i) for the first class of goods or services to which the request for renewal relates	400.00
	(ii) for each additional class of goods or services to which the request for renewal relates	125.00
	(b) in any other case	
	(i) for the first class of goods or services to which the request for renewal relates	500.00
	(ii) for each additional class of goods or services to which the request for renewal relates	125.00
15	Statement of objection under subsection 11.13(1) of the Act	1,000.00
16	Certified copy in paper form	
	(a) for each certification	35.00
	(b) for each page	1.00
17	Certified copy in electronic form	
	(a) for each certification	35.00

	(b) for each trademark to which the request relates	10.00
18	Non-certified copy in paper form, for each page	
	(a) if the requesting person makes the copy using equipment of the Office of the Registrar of Trademarks	0.50
	(b) if the Office makes the copy	1.00
19	Non-certified copy in electronic form	
	(a) for each request	10.00
	(b) for each trademark to which the request relates	10.00
	(c) if the copy is requested on a physical medium, for each physical medium requested in addition to the first	10.00