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

**July 21, 2017**

## **Acknowledgments**

This submission was prepared with the assistance of the following INTA committee:

Trademark Office Practice Committee – Canadian Intellectual Property Office Subcommittee

Trademark Office Practices Committee – Madrid System Subcommittee

Legislation Committee – Canada Subcommittee

## INTRODUCTION

### *About This Submission*

This submission constitutes the response of the International Trademark Association (“INTA”) to the request for comments concerning Canada’s proposed Trademark Regulations. INTA gratefully appreciates the opportunity to provide our input on this document and welcomes the opportunity to work with CIPO regarding this and any future initiatives concerning amendments to the Canadian trademark laws and Regulations and the trademark registration process in Canada.

INTA wishes to acknowledge and thank CIPO for its unprecedented reach out to the profession and Canadian business community to provide explanatory materials, webinars and workshops, to help understand these changes in preparation for submission of this response. Our comments regarding these amendments are divided into two parts. Our general comments concerning the Regulations are set out in Section 1. These address the broad issues arising from the changes. Our specific technical comments on each section are set out throughout the draft of the document highlighted in bold.

### *About INTA*

INTA is a not-for-profit membership association of more than 6,800 trademark owners and professional firms from more than 190 countries. The association was founded in 1878 and is dedicated to the support and advancement of trademarks and related intellectual property as elements of fair and effective national and international commerce. INTA members share common interests in the protection of trademarks and the development of trademark law, and they rely on INTA to represent an advocate for those interests with national governments and international organizations. INTA’s diverse membership includes multinational corporations and other business enterprises of all sizes, intellectual property and general practice law firms, trademark agent firms, service firms, trademark consultants, and academic institutions.

INTA currently has more than 300 member firms and corporations in Canada.

INTA works closely with national trademark offices around the world evaluating their practices, procedures, operations and regulations, and analyzing proposed legislative and regulatory developments relating to trademark registration and enforcement. Reflecting the importance of trademark issues in Canada, in 2012 INTA established within several of its committees, subcommittees whose mandates are specifically focused on Canada. This submission is compiled by the members of these Canadian subcommittees.

For many years, INTA has also worked closely with the World Intellectual Property Organization (“WIPO”) to move closer to harmonization of trademark law and practices and, in particular, the harmonization of formalities of national offices resulting in the Trademark Law Treaty 1994 (“TLT”), as well as increasingly widespread adoption of the Madrid System for registration of international trademarks, among other initiatives. INTA has advised national trademark offices around the world on issues regarding adherence to the Madrid Protocol, the Nice Agreement, and the TLT, and, more recently, the revisions to the TLT adopted in 2008 as the Singapore Treaty on the Law of Trademarks. INTA has been pleased to previously provide comments to CIPO regarding the Madrid Protocol and the Singapore Treaty in response to earlier consultation documents.

Further information about INTA can be found at [www.inta.org](http://www.inta.org).

Any questions relating to these comments may be sent to Deborah Cohn, Senior Director, Government Relations, at [dcohn@inta.org](mailto:dcohn@inta.org).

## Introduction

### GENERAL COMMENTS

INTA applauds Canada's accession to the Madrid Protocol, the Singapore Treaty, and the Nice Agreement and has actively supported this potential for over a decade.

INTA acknowledges that the draft Regulations are a “blend” of the Common Regulations of the Madrid Protocol with Canada's domestic regulations with the intent to treat domestic applications and international applications coming into Canada the same, except where highlighted in the Regulations. INTA supports the decision to treat all applications the same, with the limited exceptions set out in the Regulations.

#### *Part 1 - Comprehension*

It is acknowledged that the Regulations have been drafted using modern drafting conventions that call for specific language and organization of content consistent with all new Canadian Acts and Regulations. This is so users can find provisions which are relevant to them and those provisions can then be precisely identified and clearly understood. These conventions are intended to respond to the need for clarity and certainty. It is acknowledged that the drafters may be less involved in developing the underlying policy, as their expertise is to strike a balance in drafting that will provide clarity and certainty for the Courts, but comprehension by the public.

There are several sections in the Regulations that are difficult to comprehend, particularly in relation to divisional applications and transition rules. These have been identified throughout the draft. There is concern that practitioners with many years of experience have difficulty comprehending certain sections so it may be reasonable to assume their purpose may not be understood by others including Canadian business and those from abroad who may seek protection in Canada. It is important that the Regulations be understandable to ensure compliance for domestic brand owners as well as users of the Madrid Protocol wishing to protect brand assets in Canada.

## ***Part 2 - Calculation of Time Limits***

The wording of time limits generally, although not consistently throughout the draft, uses language such as “four months after the day on which ...” This is a change from current language which uses “within four months”, and our current practice generally understood. The suggestion by the new language is that the method for calculation of deadlines is now different.

We understand from explanation that the indication of deadlines in the Regulations is to be treated consistently in new Canadian legislation and Regulation and based on the Interpretation Act. We recommend continued education on this issue for all concerned including in Practice Notices so that deadline calculation in the new Regulations is understood and specifically, that it accords with current calculation of deadlines and there is no intended policy change by the use of this different but mandatory language.

## ***Part 3 - Restrictions on Ability to Amend Applications***

The inability to amend the description of a trade mark after filing to add or delete the applicable statement represents a significant change of practice. It is understood that these changes are a result of the Common Regulations on the same issue, but the departure from standard practice for Canadian applicants is significant and carries potential for a loss of rights for the unwary and for those who simply make a mistake. It is recommended that there be significant education including Practice Notice guidance around this important change and that the transition provisions and Office practice consider providing a reasonable period during which Canadian business and practitioners can learn about and adapt to the new practice to reduce the loss of rights.

## ***Part 4 – Fee Information for Madrid Protocol Section***

The requirement to pay fees directly to the International Bureau for Madrid Protocol filings is not mentioned in the Regulations. There are sections related to fees for domestic applications which specifically exclude Madrid Protocol applications. The suggestion by the exclusionary reference is that there may be no fees for Protocol Applications. We recommend below that there be an exclusionary statement entered in the fee section

to ensure Canadian applicants are aware that Madrid Protocol applications are subject to fees payable to the International Bureau.

### ***Part 5 – Calculation of Effective Dates for Service of Documents***

The principal change in the forms of accepted service of documents under the new Regulations is the ability to serve electronically. The Regulations set out different methods of service and their corresponding effective dates. The suggestion by this section is that there may be different dates for each manner of service while close inspection indicates that it is for ‘personal service’ that the date of delivery appears and others remain the date of issue when using a form of service easy to prove. We recommend significant education on this issue, including in Practice Notices, to ensure users of the system clearly understand the effective date of service for the particular delivery method they choose.

### ***Part 6 – Impact of Use of “Must” in Sections***

Many new sections, particularly those dealing with information required in communications for compliance, include the word ... “must”. The consequence for failure to comply with the requirement is not indicated. We expect that the use of “must” would not be used to result in inadvertent abandonment or loss of rights, but without clarity on the impact of the failure to fully comply, there is a concern that rights might be compromised. Clarity on this issue is welcome.

### ***Part 7 – Opposition Practice***

The draft Regulations contain some changes to opposition practice, but do not address two significant issues that have been mentioned in submissions over the years: mandatory mediation and the impact of Parties filing little or no evidence and/or no written argument, and leaving their submissions to the hearing stage, when neither the other Party nor the Registrar has had the opportunity to consider their position in advance, and thus may not be able to effectively prepare for the hearing. This is an opportunity to address both these issues.

On the subject of mediation, the experience from court proceedings is that requiring the Parties to attend for mediation sessions either helps to resolve the issue, outright, or focuses the Party’s submissions on the most

contentious issues. Either way, proceedings may be resolved faster and at less cost to everyone – including the Opposition Board and the public.

As currently drafted, a Party to an opposition may elect to file no evidence, but file a statement that it does not intend to do so, and also file no written submissions, but instead, a statement that it does not intend to do so. However, either Party may still request a hearing and make submissions. This is more often a tactic of opponents than applicants. It is difficult to prepare for a hearing in the absence of a written submission as the applicant is essentially “ambushed” by the oral submissions. It is recommended that other options be considered, including:

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

## ***Part 8 – Registrar-Initiated Section 45 Proceedings***

It has been previously suggested by CIPO that there may be more use of Registrar-initiated Section 45 non-use proceedings to control perceived over-claiming or other registrations not in use to assist in decluttering of the register. We make the following recommendations for the steps in that proceeding and possible criteria that might trigger a notice:

### **1. Relevant Regulation and Distinction From Other Section 45 Non-Use Proceedings**

As now contemplated under Section 45 of the Act, the Registrar “at his or her own initiative” may give notice to the registered owner, requiring evidence of use to be filed. New s.45(2) suggests that representations may be received – as set out in the Regulations. The normal procedure in s. 45 is for the registrant to file evidence, following which the requesting Party, and then the registrant, may file representations, and lastly participate in a



possible hearing. It would not seem appropriate for the “requesting Party” to file written representations in a Registrar-initiated proceeding, nor does there seem to be much need for a hearing. However, the Draft does not distinguish between the steps of an ordinary s.45 proceeding and those initiated by the Registrar. For example, at s. 72(1) of the Draft, it is assumed the Registrar will not give notice to “the Registrar” that it may submit written representations. Similarly, having filed evidence, it does not seem to make sense, as contemplated by s. 72(2), for the registrant to wait two months, and then file representations. It is recommended that should the Registrar initiate a section 45 proceeding, the registrant should submit both its evidence and any representations simultaneously. The most efficient way to handle such proceedings would be to require the registrant to file evidence, as there will not be any submissions by the registrant but only a Registrar decision.

## **2. Suggested Guidance for CIPO to Consider for the Initiation of a Registrar-Initiated Section 45 Proceeding**

In a previous INTA submission in 2014 in response to the Draft Discussion Paper on the Amendments to the Regulations, several threshold criteria were suggested for the Registrar’s consideration of ‘Registrar-Initiated’ proceedings to help develop a general practice on this issue, including some of the following:

- a. The registration contains more than a threshold number of classes.
- b. A registrant owns multiple registrations for similar marks that issued more than a threshold number of years ago.
- c. There has been inconsistent treatment of the registrant portfolio (ie., changes have been recorded only against certain registrations).
- d. There is a history of overreaching or inability to support use by the registrant in related cases (brands featuring the same distinctive element).
- e. Registrations are owned by a company who is known to have ceased operations entirely, or ceased operations in Canada.

To balance consideration of the criteria, CIPO may wish to consider allowing a registrant to file a voluntary letter, declaration, or statement which confirms its active use of a brand in Canada as one measure for the Board to distinguish active versus inactive rights in Canada and reduce cluttering.

It is appreciated that the Registrar may not be able to investigate to identify vulnerable registrations and then decide those cancellation proceedings as this may create conflict issues. Perhaps a random pool of registrations based on age might first be collected annually and against that pool criteria considered to identify candidates for Registrar-initiated proceedings.

These are suggested considerations only. INTA would be grateful to continue to assist CIPO in its development of this internal policy.

## **Madrid Protocol - General Comments**

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

# 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".

**INTA: Consider adding a definition for Office of Origin – since that term is used in the Madrid Protocol section.**

## General

### Written communications intended for Registrar

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

**INTA: We understand that current 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;

**INTA: Current practice recognizes merger and/or a change in the jurisdiction of incorporation to be similar to a change of name, in that no fee is payable, but does require documentary proof. These changes should be included, either by amending s. 3(2)(a), or by adding a new subsection.**

(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.

**INTA: This section appears to exclude recordal of security interests.**

#### **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.

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

#### **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.

**INTA: No comment**

#### **Address**

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

**INTA: This serves to acknowledge the ability to file in the name of joint parties but also that one address must be provided. We understand that if 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.

**INTA: The current Regulations state that the Registrar “may also consider oral communications”. While the language seems to indicate some discretion by the Registrar, the tone of this section seems to discourage telephone or other oral communications, particularly when they may increase efficiency of prosecution.**

### **Intelligibility of documents**

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

**INTA: No comment**

### **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.

**INTA: It is recommended that this be amended to exclude exhibits filed in evidence as required by steps taken to prove distinctiveness, or in oppositions or non-use cancellation proceedings. For example, as part of proof of reputation of a mark, it may be useful to file non-English/French documents, both to show use/reputation in Canada amongst Canadian residents who speak other languages, or to show international reputation and use that may impact a Canadian trademark proceeding.**



### **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.

**INTA: It could be possible to effect “delivery”, even if the Office/designated establishment is not “open”. Recommend instead that the wording provide that “in the event the Office is open, on the day they are delivered to the Office during ordinary business hours.”**

### **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.

**INTA: We understand that this reflects current practice and that physical delivery to CIPO or one of its designated local offices will remain subject to these traditional 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.

**INTA: What is the impact of a failure of electronic communications, such that documents were “provided”, but not “received”? This could result in a loss of rights. Similarly, there may be a difference in the “local time” of the place where the Office is located, and the physical place of the person making the electronic submission.**

**This section also implies that all electronic documents including applications will be accepted on receipt by CIPO and granted that filing date including on weekends and holidays. We also understand that this does not impact priority deadlines in any adverse manner. The ability to obtain a non-business day filing date is a significant change and could be cause for concern for agency practices and law firms which are traditionally closed on holidays and weekends.**

#### **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.

**INTA: The title and language in this section are confusing as the scope and non-adversarial intention of the intended “letters of protest” practice is not clear. The words “appear to be against its registration” are ambiguous. We recommend this section be limited to raising issues of registrability under Section 12 and clarify they will be non-adversarial. Should this section be titled “Third Party Written Communications Before Registration”?**

#### **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.

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

It is understood that when this might occur could be clarified in a Practice Notice. The words “circumstances justify it” are used, vs. a term such as “interest of justice to do so”. Some clarification prior to finalization of the Draft would be appreciated.

#### **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.

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

#### **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.

**INTA: We support the ability to file affidavits and statutory declarations electronically and recommend that you clarify the penalty for the inability to provide the original on request ie., will the evidence be removed?**

#### **Provision of original**

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

**INTA: Add “during the time specified in subsection (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.

**INTA: No comment**

## **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.

**INTA: We understand that this does not apply to matters before the IB, which may recognize different holidays. This exclusion should be clarified that it relates to CIPO or “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,

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

(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.

### **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.

**INTA: No comment**

### **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.

**INTA: No comment**

### **Frequency of qualifying examination**

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

**INTA: No comment**

### **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.

**INTA: No comment**

### **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.

**INTA: No comment**

## **Listing of trademark agents**

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

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

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

## **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.

**INTA: No comment**



## **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).

**INTA: The language of s. 20(2) (b) is confusing (admittedly, this language appears in the current Regulations) but it should be clarified.**

**We understand this section refers to a lawyer who has not written the TM Agents examination who would be required to pass it in order to qualify for reinstatement.**

## **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).

**INTA: No comment**

## **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.

**INTA: 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.

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

**INTA: 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.

**INTA: We recommend that this include “and with the permission of the Canadian resident agent” or language to that effect to ensure that the appointed party is given notice of their appointment.**

### **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.

**INTA: 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.

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

### **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.

**INTA: Section 25 will permit a person to be represented by “another person authorized by them”. Such other person does not need to be a trademark agent. Currently, many applicants/registrants are solicited**

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

### 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.

## **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.

**INTA: 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 may be found in the Common Regulations. We further understand that the goods/services in the application may appear in the other language, but the application itself must be in one language. Canada is unique in that it has two official languages. Should this be amended to recognize both of Canada’s official languages and 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.

**INTA: There are a number of criteria for correctly specifying goods and services. Section 30(a) of the Act (as amended) requires “ordinary commercial terms”. Section 29 of the Draft adds a requirement that the goods/services must be “clearly” described “in a manner that identifies a specific good or service”. The last words starting with “in a manner” seem to be unnecessary, and should be deleted.**

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 service” seems to defeat the corresponding amendment in Section 30 of the new legislation which removes “specific”. Applicants in

Canada currently face some of the strictest requirements for identification of goods and services of any country and these requirements result in multiple office actions and creates backlog and delay before the examiners.

This section appears to maintain a complex and 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 laws and practice, we recommend this section be removed. The requirement to specifically describe goods and services descriptions will place Canadian applicants using the Madrid Protocol at a disadvantage in terms of the scope of the consequent rights which issue via Madrid around the world.

### **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;

#### **INTA: Is the reference to “necessary” “in the opinion of the Registrar”?**

(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;

#### **INTA: Will gray be permissible, to show shading or shadows, when colour is not claimed?**

(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.

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

## **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.

**INTA: The suggestion is that there are no fees for a Protocol application, which may mislead. Perhaps clarification is required that Protocol fees are paid to the International Bureau. We also understand there are no fees payable to CIPO for divisional applications or mergers of registrations.**



## 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.

**INTA: No comment**

### **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.

**INTA: We see some concern over the ability to withdraw priority claims prior to advertisement, or at all. Canada requires no proof of priority entitlement and this section may permit deceptive practices and advancement of cases which are deemed to have priority when they do not. We recommend some additional restriction or measure that where a priority claim is removed, a second confusion test will be undertaken.**

## 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 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;

**INTA: This represents a welcome and more flexible approach by CIPO for correcting typographical errors such as name, entity, or corporate legal endings. We understand that affidavits will no longer be required. We recommend “merger” and “conversion” be added to the exclusion “transfer” in this section.**

(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;

**INTA: S. 35(b) uses new language, namely “remains substantially the same”. The current wording is “in respects that do not alter its distinctive character or affect its identity”. We understand that the policy intention is to introduce a lighter burden on an applicant requesting this change than under current practice and we welcome 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,

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

(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;

**INTA: The Rules for Amendment of goods and services are confusing and seemingly different than current practice. They appear to suggest the ability to remove goods and services and then reinsert them at a later point in examination. We welcome clarification.**

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

**INTA: Regarding s. 35(d) – one may not amend to add a statement that the application is a divisional application. We understand this amendment is not permitted since it is the created divisional application that would be so indicated, but clarification is requested. We recommend the addition of some notice on the Register that the original application has been divided.**

(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

**INTA: The restrictions in s. 35(e) seem unnecessary, if such changes are made before advertisement. For example, the Trademarks Office now permits an applicant to “add” a colour claim, presumably on the basis that the change does not broaden rights, and there is no adverse impact on third parties to permit applicants to do so. Many applicants, particularly in the early years of the new Act and Regulations, might inadvertently include a claim about a colour, design or other representation features, due to unfamiliarity with the Act or their rights. Such limitations have the potential to adversely impact SMEs especially. It is recommended that more leeway be permitted to change the mark description, until advertisement.**

**The Rules for Amendment under 35(2)(e) prohibit one to add or delete descriptions of marks, colour claims and nontraditional mark claims are particularly onerous and very different from current procedure. This may result in a significant loss of rights and fees to filers in Canada familiar with the current system.**

(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.

**INTA: No comment**

### **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.

**INTA: No comment**

### **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;

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

(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.

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

**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. One will “record” the transfer of an application and 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.**



## **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.

**INTA: We recommend that applications, and their divisional applications, be somehow referenced on the CIPO database or that there be some form of notice to allow for tracking.**

### **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.

**INTA: The provisions of s. 40 are confusing. We recommend the inclusion of a definition for “division day” that appears as s. 40(3). The reference to “ceases” should be “cease”. It appears that the last words of s. 40)(1) ought to be “its division day”. Referring to “steps taken on or before the following day” is confusing – why not “on or before the day”? The language appears to have an impact on advertisement and re-advertisement, but even if read in conjunction with the document entitled “Public Consultations on the Proposed Trade-marks Regulations”, and in particular, page 27 of that document, the treatment of divisional applications remains very unclear. For example, the “consultation” document describes a situation where goods/services may be deleted, then an opposition is withdrawn, and then an application**

might be filed in respect of some/all of the deleted goods/services. This seems to contemplate goods/services being deleted, and that at some future date, being the subject of a divisional application. The uncertainty of the future of such goods/services is a matter of concern, and even if an opponent has a chance to continue its opposition against the previously deleted goods/services, having to file a second opposition, and deal at an uncertain date in the future with deleted goods/services is not a welcome change. At the least, if an applicant wishes to divide out certain goods and services, it should have to do so at the time it files the divisional application – the goods and services should not remain in limbo at the whim of the applicant.

**S. 40 requires some revision to clarify what will happen, and when.**

### **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.

### **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;

#### **INTA: 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.

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

**How will the “advertisement” be different from the database information?**

## **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.

**INTA: Until an opposition is commenced, there is no “opposition proceeding”, so the wording of this section should be amended to refer to “an opposition or possible opposition”.**

### **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.

**INTA: It might be clearer to state that once the Registrar has forwarded a copy of the statement of opposition to the applicant, apart from any document required to be served on a party, all other documents sent to the Registrar must also be sent on the same day to the other party.**

**INTA supports this, in particular the requirement to forward a document to the other side on the same day that it is submitted to the registrar.**

## **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.

**INTA: We recommend adding trademark agent (to person or firm) in Canada who can receive service of opposition documents.**

**We also understand a counterstatement may now include an appointment of agent and recommend you include some provision for that party to be made aware of or consent to the appointment.**

## **Manner of service**

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

(a) by personal service in Canada;

**INTA: There does not appear to be any definition of “personal service”. Also, it is not clear that service on an agent has the same effect as service on the applicant/opponent. The provisions of s. 46 appear to suggest different dates for calculation of deadlines depending on the method of service. These differences may be confusing, and may lead to uncertainty and disagreement on deadlines. During the course of an opposition, documents may be served in different ways, depending on the type of document or size of the delivery. We recommend significant education around effective dates of service including in Practice Notices.**

(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.

**INTA: 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 their mailing address to confirm the filing of evidence with CIPO will be sufficient.**

**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.

**INTA: We understand this to mean that letters of service must state the manner of service and also the effective date 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.

**INTA: We understand that proof of personal service would require evidence of signed receipt. There is no definition of personal service. There is some concern that these different effective dates of service will cause confusion in opposition proceedings. We recommend significant guidance via Practice Notices on the effective dates of the various service methods.**

## **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.

**INTA: Clarification as to what this section is to accommodate or account for is requested.**

## **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.

**INTA: There is no requirement in the regulations that a Statement of Opposition be filed. In the current regulations, it specifically states that “a statement of opposition shall be filed with the Registrar”.**

## **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.

**INTA: There is concern that this revised wording means the default position is yes you are entitled to leave unless the other party can convince the registrar why it should not be granted. It is a shift in the onus or burden to the other party to make the case for why leave should not be granted.**

**We consider, instead, the language should read “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 balance the issues and require that the party requesting leave must justify why it is appropriate to do so outside of the normally prescribed time period. The Board has indicated there is no policy change intended by the inclusion of this new section and as such the proposed language needs to change to reflect the current test.**

## **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.

**INTA: We understand this to apply to certified copies of registered and pending rights and to exclude lists of marks such as state of the register evidence. We understand the current practice is the same 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.



**INTA: This is awkward wording. We understand that there is no policy intent by this change in language and the date remains to be calculated as it is under current practice as four months from service of the counterstatement. We recommend the language be clarified or clarification and education of this deadline be clearly set out in a Practice Notice.**

#### **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.

**INTA: This is awkward wording and suggest “instead” as opposed to “rather”, or delete “rather” entirely 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.

**INTA: This is awkward wording. A “deemed withdrawal” should not occur until “after the end” of the 4 month period, and not “by the end”. We recommend this be clearly set out in a Practice Notice.**

#### **Timing — evidence of the ~~opponent~~applicant (Note 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.

**INTA: We suggest revised wording with “instead” as opposed to “rather”, or delete “rather” entirely.**

## **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.

**INTA: A “deemed abandonment” should not occur until “after the end” of the 4 month period, and not “by the end”.**

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

## **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.

**INTA: The one month time limit is exceedingly short and does not permit review, reporting and instructions on reply evidence. A longer term, in line with other deadlines, should be set.**

#### **Additional evidence**

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

**INTA: This appears to accord 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.

**INTA: There is concern that this revised wording means the default position is yes you are entitled to leave unless the other party can convince the registrar why it should not be granted. It is a shift in the onus or burden to the other party to make the case for why leave should not be granted.**

**We consider, instead, the language should read “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 balance the issues and require that the party requesting leave must justify why it is appropriate to do so outside of the normally prescribed time period. The Board has indicated there is no policy change intended by the inclusion of this new section and as such the proposed language needs to change to reflect the current test.**

#### **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.

**INTA: We recommend that Registrar be given discretion to refuse an order for cross-examination when the circumstances justify it. The Registrar currently has that discretion.**

**We also understand this to mean that there is no deadline to request cross-examination provided the request is made before the call for written arguments. We recommend that there be a deadline for this clearly set out in a Practice Notice.**

#### **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.

**INTA: We 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.

**INTA: Refusal to file undertakings should lead to the same consequence – namely that the affidavit/statutory declaration is deemed not to be part of the evidence. The evidence should be removed completely from the file before the Officer.**

#### **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.

**INTA: How will the Registrar know that all evidence has been filed? If parties can request leave to file additional evidence, and may do so with leave, to be granted unless not in interest of justice to do so, when will Registrar normally send notice that written arguments are due? What if leave to file additional evidence is granted – how does that impact the deadline to file written argument?**

#### **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.

**INTA: Many parties to an opposition currently ask for an extension of time to file written submissions. A term longer than 2 months is recommended – eg. 4 months.**

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

#### **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.

**INTA: This is awkward wording. Suggest “instead” as opposed to “rather”, or delete “rather” entirely. If the opponent does not file written representations or a statement that it is choosing not to do so, what is the consequence?**

#### **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

**INTA: This is awkward and confusing wording. Why not simply state that a request for a hearing is to be made once the application has filed its written submissions or a statement that it does not wish to do so? This would be less awkward if you remove the option of a party not responding at all. Each party should have to either file written arguments or a notice that they do not want to do so. Leaving it open to having no response from the parties makes this confusing.**

(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

**INTA: Since requests relating to the type of hearing and language may depend on the position taken by the other party, there should be some leeway to initially request a hearing, and then when the parties know a hearing is being held, to provide details at a later date as to the language of submission and translation as works successfully in current practice before the Board.**

(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.

**INTA: This detail is typically provided when the hearing is set so the representatives can identify the attending party and these details. This is difficult timing for the provision of accurate details and will result in many changes.**

### **Prohibition**

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

**INTA: This provision will likely result in every party requesting a hearing, even if they would otherwise choose to not have one, in order to not miss the chance to make submissions in the event that the other party requests a hearing.**

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

### **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.

**INTA: Oral hearings are usually set some months away. There can be changes within an applicant or agent's firm (e.g. personnel changes or other unexpected intervening events) that could require a change in the hearing. This should be taken into account when setting a time line of what will be accommodated by the Office.**

## **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.

**INTA: As with advertisement, all information required to be included in an application when filed, or after examination should be included on the Register (eg. translation, transliteration, colour claims, claims re distinctiveness or s. 12(2)), and full details of any territorial restrictions.**

### **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.

**INTA: No comment**



### **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.

**INTA: We understand there is no fee payable for this.**

### **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.

**INTA: We recommend that this deadline be extendable.**

## **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.

**INTA: No comment**

## **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.

**INTA: No comment**

## **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.

**INTA: We support the requirement to forward a copy of all submissions to the Registrar on the other party.**

**INTA: Many of the comments regarding wording, deadlines and procedure made regarding oppositions also apply to s. 45 proceedings. For example, see comments under s. 44.**

## **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.

## **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.

**INTA: Many of the comments regarding wording, deadlines and procedure made regarding oppositions also apply to s. 45 proceedings. For example, see general comments and comments under s. 46.**

## **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.

### **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.

**INTA: Many of the comments regarding wording, deadlines and procedure made regarding oppositions also apply to s. 45 proceedings. For example, see general comments and comments under s. 46.**

### **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.

### **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.

**INTA: Many of the comments regarding wording, deadlines and procedure made regarding oppositions also apply to s. 45 proceedings. For example, see comments under s. 58.**

### **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.

**INTA: Many of the comments regarding wording, deadlines and procedure made regarding oppositions also apply to s. 45 proceedings. For example, see general comments and comments under s. 58.**

## 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.

**INTA: There are now 3 relevant dates: the actual renewal date, 6 months following the renewal deadline (“the grace period”), and 2 months following the Registrar’s notice, if longer than the grace period. This will complicate the calculation of deadlines and adds uncertainty about when a mark will actually expire for non-renewal. It is recommended that the Draft provide that the Registrar will send a notice following the renewal date, should any registration not be renewed, but that the notice will not impact the 6 month grace period.**

### 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.



**INTA: This is confusing language. It may be easier to state 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.**

### **Objection Proceeding Under Section 11.13 of Act**

#### **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.

**INTA: While this is not a new fee, what is the justification for a higher fee than the opposition fee?**

**All comments included under Opposition Proceedings apply equally throughout this section.**

#### **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;

(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.

**INTA: The list in (1) (a) to (d) should be followed by “or” rather than “and”.**

#### **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.

#### **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.

**INTA: All comments included under Opposition Proceedings apply equally throughout this section.**

### **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.

### **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.

**INTA: All comments included under Opposition Proceedings apply equally throughout this section.**

#### **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.

#### **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.

**INTA: All comments included under Opposition Proceedings apply equally throughout this section.**

#### **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.

#### **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.

**INTA: All comments included under Opposition Proceedings apply equally throughout this section.**

### **Holding of cross-examination**

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

### **Transcript and undertakings**

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

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

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

### **Inadmissibility in absence of cross-examination**

(4) An affidavit or statutory declaration is not to be part of the evidence if 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.

**INTA: All comments included under Opposition Proceedings apply equally throughout this section.**

#### **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

(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.

**INTA: All comments included under Opposition Proceedings apply equally throughout this section.**

### **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.

**INTA: All comments included under Opposition Proceedings apply equally throughout this section.**



## **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

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

### 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)

**INTA: How will that date be known? What means of notice/effective date?**

**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.

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

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

## **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.

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

### **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;

**INTA: How will applications/registrations filed/issued before the coming into force date, that have drawings that are not in colour be treated? Will the applicant need to supply new colour drawings of the mark?**

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

(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

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

(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.

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

### **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.

**INTA: What is the timeline of the transmission?**

## **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.

**INTA: It does not seem possible to simply “deem” a territorial extension originating from a collective mark or a guarantee mark to be a “certification mark”, which has a defined and jurisprudential meaning. A “collective” mark is normally a very different type of mark, and should be protected by specific provisions.**

### **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.

**INTA: This section uses the term “not registrable”. Normally, the concept of non-registrability is focused upon factors specifically named in s. 12 of the Act, which is not drafted to include the situation described in this section. How will non-compliance with this provision impact opposition or other challenges to validity? Does Section 12 of the Act need to be amended to provide this ground of opposition?**

## **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.

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

(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.

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

## **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.

**INTA: What would be the impact on the date of deemed withdrawal of a failure of the IB to notify the Registrar of the failure to renew an international registration?**

## **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.

**INTA: What is the effect on any opposition of the options given to an applicant under this provision?**

### **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.

**INTA: As an observation, the inability to amend a statement of opposition will result in all opposition grounds being relied upon, making it sometimes difficult for an applicant to actually understand the true basis of the opposition.**

### **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.

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

## 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.

**INTA: This provision is awkwardly worded. It should address any decision that is in favour of applicant for all or some of goods/services. Section 131(1)(b) should include among the events, a withdrawal of an appeal. As drafted now, the options are the appeal term has ended with no appeal, or appeal filed and final judgement issued. In Section 131(1)(d)(ii) – the calculation of dates is extremely complicated. For example, “the day on which the opposition period began” – is this the date of advertisement of the application?**

#### **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.

### **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).

**INTA: Section 134(4) permits the Registrar to declare that a limitation of goods/services has no effect in Canada for any goods/services that do not meet the requirements of s. 134(2). However, if the Canadian registration is, in essence, dependent on an IR that has now been changed to a different list of**



goods/services, what rights will the owner of a Protocol Registration in Canada that no longer reflects the IR actually have? Also, there does not appear to be any recourse for the owner of a Protocol Registration should the Registrar take this step. Section 139, for example, states that the Registrar must send a notification of provisional refusal in the event of a comparable “correction”, and provides for a possible response by the registrant.

#### **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.

**INTA: Why would we need to cancel a Canadian registration if at least one but not all the goods and services are cancelled? Cancellation of the protocol registration should only be an option if all of the goods/services are cancelled, which is already contemplated in s. 136.**

### **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.

### **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.

**INTA: There are no fees set for "transformation".**

While the holder of the IR rights may request transformation within 3 months, if it does not do until the end of the 3 months term, to all 3rd parties, it will appear as if the holder of the IR has lost its rights in Canada. Presumably, any entitlement rights acquired by a 3rd party during those 3 months will be extinguished by the wording of s. 147, which deems the holder's rights in the "transformed" application/registration to be reinstated as of the date of cancellation. Given the impact on potential loss of rights by a 3rd party, what notice will be given of the "cancellation" on the Register, and what description will be given relating to the transformation on the Register?

### **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**

**INTA: These provisions are extremely difficult to understand, and make sense only with reference to the Public Consultation document. This applies particularly to s. 153 to 159. Rewording is strongly recommended.**

### **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.

### **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.

**INTA: As a general comment, these are extremely difficult to understand, and make sense only with reference to the Public Consultation document. This applies particularly to s. 153 to 159. Rewording is strongly recommended.**

#### **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.

**INTA: As a general comment, these are extremely difficult to understand, and make sense only with reference to the Public Consultation document. This applies particularly to s. 153 to 159. Rewording is strongly recommended.**

#### **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.

**INTA: As a general comment, these are extremely difficult to understand, and make sense only with reference to the Public Consultation document. This applies particularly to s. 153 to 159. Rewording is strongly recommended.**

#### **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.

**INTA: As a general comment, these are extremely difficult to understand, and make sense only with reference to the Public Consultation document. This applies particularly to s. 153 to 159. Rewording is strongly recommended.**

#### **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.

**INTA: As a general comment, these are extremely difficult to understand, and make sense only with reference to the Public Consultation document. This applies particularly to s. 153 to 159. Rewording is strongly recommended.**

#### **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.

**INTA: As a general comment, these are extremely difficult to understand, and make sense only with reference to the Public Consultation document. This applies particularly to s. 153 to 159. Rewording is strongly recommended.**

#### **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.

**INTA: As a general comment, these are extremely difficult to understand, and make sense only with reference to the Public Consultation document. This applies particularly to s. 153 to 159. Rewording is strongly recommended.**

### **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))

<b>Tariff of Fees</b>		
<b>Item</b>	<b>Description</b>	<b>Fee (\$)</b>
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