

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

AS PUBLISHED IN GAZETTE I ON FEBRUARY 10, 2018

March 6, 2018

Acknowledgments

This submission was prepared with the assistance of the following International Trademark Association (INTA) committees:

Trademark Office Practices Committee – Canadian Intellectual Property Office Subcommittee

Legislation & Regulation Committee – Canada Subcommittee

Introduction

The International Trademark Association (INTA) is grateful for the opportunity to provide comments on this new draft of the proposed Trademarks Regulations as published in Gazette I on February 10, 2018.

We commend CIPO once again for its collaborative approach and unprecedented reach out for the fine tuning of these Regulations. In particular, we thank CIPO for listening and responding to many of the comments and concerns raised by INTA'S Trademark Office Practices Committee (TOPC) and Legislation & Regulation Committee Canada Subcommittees, as well as other organizations and stakeholders. These Regulations will serve as the guiding framework for Canada's new legislation representing the most significant practice changes for Canadian brand owners in several decades. Your continued efforts to improve clarity and policy in response to our requests is gratefully acknowledged.

About INTA

INTA is a not-for-profit membership association of more than 7,200 organizations from more than 190 countries. The Association's member organizations represent some 31,000 trademark professionals, including 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. The association was founded in 1878 and is dedicated to supporting trademarks and related intellectual property to foster consumer trust, economic growth, and innovation. 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 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 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.

The Changes Made

INTA first wishes to acknowledge the important policy changes to the first draft you have made at our request which will significantly benefit Canadian brand owners and foreign trade mark applicants into Canada, in particular:

- a) The ability to amend an application prior to publication to enter the description of the mark provided the trade mark remains substantially the same;
- b) The removal of ‘clearly’ from Section 29 “Manner of Describing Goods or Services”; and
- c) The minor rewording of Section 48(2) ‘Interests of Justice’ which now appears to appropriately reflect the current test and is easily understood.

INTA also commends CIPO on the extensive clarifications now entered for many sections that enable stakeholders and practitioners a better understanding and clarity of the intended policy in those sections, including:

- a) Timing of Service – specifically the clarifications in Sections 50(2), 52(2) and 54(Reply Evidence), which appear throughout the Opposition, Objector and Section 45 regulations; and
- b) Process clarifications - such as those which appear in Section 65 ‘Required Information for Transfer of Registered Trademark’ and ‘Effect of Transfer’ in Section 66.

Clarifications We Urge You to Make Now

INTA acknowledges the importance of the timeline ahead to implementation and further, that policy changes at this stage are highly unlikely. It wishes to focus its recommendations in light of this on clarification of certain important sections of the Regulations. We are concerned that certain provisions remain unclear such that they still cannot be understood by experts in the practice. The law and regulations must be accessible to those involved in the practice of Trademark law and to all Canadians.

INTA fully supports CIPO’s general outreach to Canadians and stakeholders to increase their IP awareness and understanding of the value of trade marks to Canadians and those investing in Canada and the importance of, and process for, their registered protection. Your efforts to provide education and support to SME’s and other Canadian business directly is commendable and in keeping with one of the pillars of the INTA organization. Consistent with this communication effort, we strongly recommend that you clarify the wording of the sections we highlight in red in the attached copy of the Regulations to ensure the policy intent is understood by brand owners and/or those who represent them.

“If there is an overriding principle to readability [in legislative drafting], it is that you must write in order to communicate clearly with the intended reader”. This quote is taken from www.justice.gc.ca, the Guide to Foster the Readability of Legislative Texts. To maintain certain sections of these Regulations which cannot be understood by the intended readers defeats their purpose. Those who have drafted this report appreciate the constraints of the legislative drafting requirements that you work under, but implore you to simplify and clarify those sections we identify which cannot be understood by practitioners with

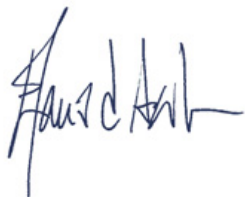
many years of experience reading and working with the Canadian Trademark Regulations, let alone by the Canadian business community.

We have identified one apparent typographical error in Section 92(3).

We thank CIPO once again for allowing us the opportunity to present our submissions to you for your further discussion and consideration and look forward to continuing to collaborate with you on this new law and practice in Canada.

Any questions relating to these comments may be sent to Deborah Cohn, Senior Director, Government Relations, at dcohn@inta.org.

Sincerely,

A handwritten signature in blue ink, appearing to read "Etienne Sanz de Acedo". The signature is stylized with a large initial "E" and a long horizontal stroke at the end.

Etienne Sanz de Acedo
Chief Executive Officer

PROPOSED REGULATORY TEXT

Notice is given that the Governor in Council, pursuant to sections 65 ([see footnote a](#)), 65.1 ([see footnote b](#)) and 65.2 ([see footnote c](#)) of the *Trade-marks Act* ([see footnote d](#)), proposes to make the annexed *Trademarks Regulations*.

Interested persons may make representations concerning the proposed Regulations within 30 days after the date of publication of this notice. All such representations must cite the *Canada Gazette*, Part I, and the date of publication of this notice, and be addressed to Mesmin Pierre, Director General, Trademarks Branch, Department of Industry, Place du Portage Phase 1, 50 Victoria Street, Room C236-10, Gatineau, Quebec K1A 0C9 (tel.: 819-994-4600; email: ic.cipo-consultations-opic.ic@canada.ca).

Ottawa, February 1, 2018

Jurica Čapkun
Assistant Clerk of the Privy Council

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Trademarks Regulations

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 that is 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 that is maintained by the International Bureau. (*Registre international*)
- **international registration** means a registration of a trademark that is on the International Register. (*enregistrement international*)
- **trademark agent** means, other than in subparagraph 16(a)(iii) and paragraphs 19(b) and 20(1)(b), a person or firm whose name is on the list of trademark agents that is kept under section 28 of the Act. (*agent de marques de commerce*)

Reference to a period

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

General

Written communications intended for Registrar

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

Limit on written communications

3 (1) A written communication intended for 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 to a written communication in respect of

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

INTA acknowledges and supports the change to add 'e' to account for security interests and other documents.

Written communications regarding applications for registration

4 (1) A written communication intended for 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.

Written communications regarding registered trademarks

(2) A written communication intended for 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.

Address

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

Notice of change of address

(2) A person that is doing business before the Office of the Registrar of Trademarks must notify the Registrar of any change of their postal address for correspondence.

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 under section 11.13, 38 or 45 of the Act.

Intelligibility of documents

7 A document that is provided to the Registrar must be clear, legible and capable of being reproduced.

Document provided in non-official language

8 The Registrar is not required to have regard to the whole or any part of a document that is provided in a language other than English or French unless a translation into English or French is also provided.

Manner of providing documents, information or fees

9 (1) Unless provided by an electronic means in accordance with subsection 64(1) of the Act, a document, information or fee must be provided to the Registrar 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) A document, information or fee that is provided to the Registrar by physical delivery to the Office of the Registrar of Trademarks is deemed to have been received by the Registrar

- (a) on the day on which it is delivered to the office, if it is delivered during the office's ordinary business hours; or
- (b) on the first day after the delivery on which the office is open, in any other case.

Date of receipt — physical delivery to designated establishment

(3) A document, information or fee that is provided to the Registrar by physical delivery to a designated establishment is deemed to have been received by the Registrar

- (a) in the case that it is delivered during the establishment's ordinary business hours,
 - (i) on the day on which it is 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 on the day of delivery; or
- (b) in any other case, on the first day after the delivery on which the Office of the Registrar of Trademarks is open that falls on or after the first day on which the establishment is open after the delivery.

Date of receipt — provision by electronic means

(4) A document, information or fee that is provided to the Registrar by an electronic means in accordance with subsection 64(1) of the Act is 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 it.

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 98 to 100;
- (b) a request for the recording of a change in ownership referred to in sections 101 and 102;
- (c) a request for division referred to in section 123; and
- (d) a transformation application referred to in section 147.

Exception — International Bureau

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

Acknowledgement of written communications

10 (1) The Registrar must acknowledge a written communication received by the Registrar before a trademark is registered and that is, or appears to be, against that registration. However, subject to section 29 of the Act, no information may be given as to any action taken as a result of that communication.

COMMENT: This provision should include some indication of the permissible timing of the written communication, or an indication that a written communication should not be viewed as an alternative to an opposition. For example, wording should confirm that written communications can be sent at any time up to the date of advertisement.

Exception

(2) Subsection (1) does not apply in respect of a written communication made in a proceeding under 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.

Refund

12 On request made no later than three years after the day on which a fee is paid, the Registrar must refund any overpayment of the fee.

INTA acknowledges this helpful language clarification.

Affidavit or statutory declaration

13 (1) A person that 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 a retention period that ends one year after the day on which the applicable appeal period expires but, if an appeal is taken, ends on the day on which the final judgment is given in the appeal.

Provision of original

(2) On request by the Registrar made before the end of the retention period, the person must provide the original to the Registrar.

Extension of time — fee

14 A person that 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.

Prescribed days — extension of time 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
 - (i) if December 25 falls on a Friday, that Friday and the following Monday, and
 - (ii) if December 25 falls on a 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.

Trademark Agents

List of Trademark Agents

Eligibility for examination

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

- (a) on the first day of the examination, resides in Canada and
 - (i) has been employed for at least 24 months in the Office of the Registrar of Trademarks either on the examining staff or as a person to whom any of the Registrar's powers, duties and functions under section 38 or 45 of the Act have been delegated,
 - (ii) has worked in Canada in the area of Canadian trademark law and practice, including in 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 in the preparation and prosecution of applications for the registration of trademarks, for at least 24 months of which at least 12 were worked in Canada with the rest being 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.

See our [INTA comments below Section 20\(1\)](#).

Establishment of examining board

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

Membership

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

Frequency of qualifying examinations

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

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 that intends to sit for the examination must meet the requirements set out in section 16.

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 that has met the requirements set out in paragraph 16(b) of the designated place or places.

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 that is kept under section 28 of the Act the name of

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

Maintenance of name on list

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

- (a) a resident of Canada whose name is on the list of trademark agents must, to maintain their name on the list, pay the fee set out in item 4 of the schedule;
- (b) a resident of another country whose name is on that list must, to maintain their name on the list, file a declaration, signed by them, indicating their country of residence and that they are authorized to act as a trademark agent under the law of that country; and
- (c) a firm whose name is on that list must, to maintain its name on the list, file a declaration, signed by one of its members whose name is on the list, indicating all of its members whose names are on the list.

Re. ss. 16, 19 and 20: COMMENT: Most countries do not use the term “trademark agent” (trademark attorney is far more common), and the term “agent” is uncertain – for example, does it mean merely a person appointed to act in lieu of an applicant

directly, without any specific training or experience, or does it mean a person who has some special status or qualifications to appear before the registrar of any specific country? Since use of “act as a trademark agent under the law of that country” will result in confusion and uncertainty as to the qualifications for becoming a trademark agent and remaining on the list of Canadian trademark agents, we recommend a change to language that focuses upon the status of a “regulated professional”, or other qualifications to lawfully represent applicants before a local trademark office.

Removal from list

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

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 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 declaration referred to in paragraph 20(1)(b), or
 - (iii) is a firm referred to in paragraph 19(c) and files the declaration referred to in paragraph 20(1)(c).

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.

Requirement to appoint associate trademark agent

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

Power to appoint associate trademark agent

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

COMMENT: S. 22 uses “associate”, whereas the headings use “associate trademark agent”. The headings should correspond with the section wording, otherwise there will be ambiguity to the meaning of “associate”. We recommend that all references to merely “associate” be replaced with “associate trademark agent”. (We note that s. 25 uses “associate trademark agent”).

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.

Acts done by or in relation to trademark agent

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

Acts done by or in relation to associate trademark agent

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

Persons authorized to act

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

- **(a)** the person must not represent themselves; and
- **(b)** no one other than the trademark agent, if that agent resides in Canada, or an associate trademark agent appointed by that trademark agent, is permitted to represent that person.

Exceptions

(2) A person that 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 98 to 100 or a transformation application referred to in section 147;
- **(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 under 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.

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 describe each of those goods or services in a manner that identifies a specific good or service.

INTA is extremely grateful for the removal of ‘clearly’ in this section.

Representation or description

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

- **(a)** a representation may contain more than one view of the trademark only if the multiple views are necessary for the trademark to be clearly defined;
- **(b)** a 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, a 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, a 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, a visual representation must be in black and white;
- **(f)** if the trademark consists in whole or in part of a sound, a 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)** a description must be clear and concise.

Contents

31 The following information and 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 other 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 other 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, along with the name of each colour claimed and an indication 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, along with the name of each colour; and
- (h) if the trademark is a certification mark, a statement to that effect.

Fee

32 (1) A person that files an application for the registration of a trademark, other than a *Protocol application* as defined in section 96 or a divisional application, must pay the applicable fee set out in item 7 of the schedule.

Fee for divisional application

(2) A person that files a divisional application that does not stem from a *Protocol application* as defined in section 96 must pay the applicable fee set out in item 7 of the schedule for

- (a) in the case that the corresponding original application is itself a divisional application,
 - (i) if the filed divisional application stems from a series of divisional applications, the original application from which the series stems, and
 - (ii) if the filed divisional application does not stem from a series of divisional applications, the original application from which the corresponding original application stems; and
- (b) in any other case, the corresponding original application.

Deemed payment of fees

(3) If all or part of the applicable fee set out in item 7 of the schedule is paid in respect of an application, the applicable fee referred to in that item, or part of it, as the case may be, is deemed to have been paid for

- (a) when that application is itself a divisional application
 - (i) in the case that it stems from a series of divisional applications, the original application from which stems the series and every divisional application that stems from that original application, and

- (ii) in the case that it does not stem from a series of divisional applications, its corresponding original application and every divisional application that stems from it; and
- (b) when that application is not itself a divisional application, every divisional application that stems from it.

COMMENT: The wording of ss. 32(2) and 32(3) are exceptionally difficult to clearly understand. Various terms are used, including “divisional application”, “corresponding original application” – which, it appears, may also be a “divisional application”, “filed divisional application”, “series of divisional applications”, “original application”, including “an original application from which the corresponding original application stems”, “divisional application that stems from it”, and “an application”. We understand the intent is to ensure that fees are not avoided by applying to divide an application. It would appear that if an application covers multiple classes, and all class fees are paid, then a fee “per divisional application” would be justified. Similarly, if a “divisional” application” is further divided, then a fee “per further divisional application” could be applied (but additional fees per class should not be necessary). However, the wording above is very problematic – it is exceptionally difficult to determine when a fee is to be paid, or will, under s. 32(3), be deemed to have been paid, and since payment of fees is essential to the validity of any application, and also to its filing “date”, clarity on fee payment is necessary.

Fees for filing date

(4) 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 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.

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 that effect before the application is advertised under subsection 37(1) of the Act.

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) An application for the registration of a trademark may be amended before the trademark is registered.

Exceptions

(2) Despite subsection (1), the application must not be amended

- (a) to change the identity of the applicant, unless the change results from 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 96, to correct an error in the applicant's identification;
- (b) to change the representation or description of the trademark, unless the application has not been advertised under subsection 37(1) of the Act and the trademark remains substantially the same;
- (c) to broaden the scope of the statement of the goods or services contained in the application beyond the scope of
 - (i) that statement on the filing date of the application without regard to section 34 of the Act or subsection 106(2) of these Regulations,
 - (ii) the narrower of that statement as advertised under subsection 37(1) of the Act and that statement as amended after that advertisement, and
 - (iii) in the case of a *Protocol application* as defined in section 96, the list of goods or services, in respect of Canada, contained — at the time of the amendment, if it were made — in the international registration on which the application is based;
- (d) to add an indication that it is a divisional application;
- (e) to add or delete a statement referred to in paragraph 31(b) of the Act or paragraph 31(e), (f) or (g) of these Regulations, unless the application has not been advertised under subsection 37(1) of the Act and the trademark remains substantially the same; or
- (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) of these Regulations.

INTA is grateful for the amendment to (e) to permit the addition or deletion of a statement before publication provided the trade mark remains substantially the same.

Exceptions to exceptions

(3) Despite subsection (2), an amendment referred to in that subsection may be made in accordance with sections 107, 111, 114 or 117.

Should the subheading here read “Protocol exceptions”

Transfer of Application for Registration of a Trademark

Fee

36 A person that 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.

Required information

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

Effect of transfer — separate applications

38 If the transfer to a person of an application for the registration of a trademark is, under subsection 48(3) of the Act or section 146 of these Regulations, recorded in respect of at least one but not all of the goods or services specified in the initial application,

- (a) that person is deemed to be the applicant in respect of a separate application;
- (b) the separate application is deemed to have the same filing date as that initial application; and
- (c) any action taken, before the day on which the transfer is recorded, in relation to the initial application is deemed to have been taken in relation to that separate application.

Divisional Application

Manner of identifying corresponding original application

39 For the purpose of subsection 39(2) of the Act, the corresponding original application must be identified in a divisional application by means of its application number, if known.

COMMENT: In s. 32 of the Regulations, above, a “corresponding original application” can itself be a divisional application. It is noted that s. 39 of the Act (as amended), uses “corresponding original application”, but in the context, it appears to refer to the “original application”. Since s. 32 of the Regulations complicates this by suggesting a corresponding original application can be a divisional, it is not clear which application number must be used. The impact of confusion over application numbers is exacerbated by the new provisions in the Regulations that only the owner and an application number need be used to identify an application (s. 4(1)) above. Since potential errors in application numbers can impact the status of any application, the Regulations should be clear about which application number, or possibly which series of application numbers, must be used.

Steps deemed to have been taken

40 (1) Any action taken in respect of the corresponding original application, on or before the day on which the divisional application is filed, is deemed to be an action taken in respect of the divisional application.

COMMENT: This section is not clear. As above, since a “corresponding original application” can itself be a divisional application, as suggested by Regulations s. 32, which steps, is it intended that all actions regarding a divisional application, as well as an original application, are deemed to have been taken on the divisional application? To clarify, is there a chain, starting with the first-filed application, which is then divided multiple time – and all actions on any would be deemed to have occurred on all divisionals (which would include divisional applications that are based on divisional applications)? Since knowing the status of all applications is critical, this section should be clarified.

Exceptions

(2) Subsection (1) does not apply in respect of the following actions:

- (a) an amendment of the statement of the goods or services contained in the original application;
- (b) a withdrawal or rejection of an opposition in respect of the original application;
- (c) the advertisement of the original application, except if all of the goods or services specified in the divisional application, on the day referred to in subsection (1), cease 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 regard to any extension to that period under section 47 of the Act; and
- (d) the payment of the applicable fee set out in item 7 of the schedule to these Regulations.

Clarification

(3) For greater certainty, a statement of opposition filed under subsection 38(1) of the Act in respect of an original application, on or before the day on which the divisional application is filed, is deemed to have been filed in respect of the divisional application within two months after the advertisement of the divisional application.

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;
- (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.

COMMENT: This list does not specifically mention "the trademark" – and it is not clear that a word or design mark is included in the words "a representation or description of a mark. Recommend that s. 41(c) be amended to add the words "the trademark, including any representation or description of the trademark contained in the application";".

Opposition Proceeding Under Section 38 of the Act

Fee

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

Correspondence

43 A person that corresponds with the Registrar in respect of an opposition proceeding must clearly indicate that the correspondence relates to that proceeding.

Forwarding copies of documents

44 A party to an opposition proceeding that, 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 to the Registrar a document, other than a document that they are otherwise required to serve, that relates to that proceeding must, on that day, forward a copy of it to the other party.

Service on representative of applicant

45 Unless they have appointed a trademark agent, an applicant may in their counter statement under subsection 38(7) of the Act set out, 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 on whom or a firm on which 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.

Manner of service

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

- (a) by personal service in Canada;
- (b) by registered mail to an address in Canada;
- (c) by courier to an address in Canada;
- (d) by the sending of a notice to the other party advising that the document to be served has been filed with or provided to the Registrar, if the party seeking to effect service does not have the information necessary to 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.

Service on trademark agent

(2) If a party to be served appoints a trademark agent that resides in Canada in respect of an opposition proceeding,

- (a) that agent is deemed to replace any person or firm set out in a statement of opposition, counter statement or notice as a person on whom or a firm on which service of any document in respect of the opposition may be made with the same effect as if it had been served on the party directly; and
- (b) service must be effected on that agent unless the parties agree otherwise.

Effective date of service

(3) Subject to subsections (4) to (7) and (10), service is effective on the day on which the document is delivered.

Exception — service by registered mail

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

Exception — service by courier

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

Exception — service by electronic means

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

Exception — service by sending of notice

(7) 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

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

Proof of service

(9) 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.

Validity of irregular service

(10) Service of a document other than in accordance with subsection (1) is nonetheless valid if the Registrar determines that the document has been provided to the party being served and informs the parties of that determination. The service is effective on the day on which the document was provided to the party being served.

COMMENT: We appreciate that imperfect service should not, in all cases, impact the status of oppositions, and that permitting the Registrar to have discretion to determine that a document has been provided is beneficial. However, whether service has taken place and the effective date of service is key to all steps in oppositions (as well as s. 45 proceedings and objections to protection of geographic indications), since it impacts not only the setting of deadlines, but whether the opposition remains active. It is not clear “when” the Registrar will make a determination that the document has been provided to the party being served. Further, if the Registrar makes a determination that the document was not served, as required, then presumably relevant steps and deadlines in the opposition will be impacted, and uncertainty about the determination may result in whether opposition steps should, or need not, be taken. To permit parties to calculate steps while issues of imperfect service are

resolved, this section should clarify that all deadlines in the proceeding are deemed to remain in place unless determined otherwise by the Registrar.

. Counter statement — timing

47 For the purpose of subsection 38(7) of the Act, the time is two months.

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 considers to be appropriate.

Interests of justice

(2) The Registrar must grant leave under subsection (1) if it is in the interests of justice to do so.

INTA supports this drafting change. We understand this to reflect our current test for a leave request and thank CIPO for this amendment.

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 that is 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 of opponent's evidence

50 (1) The opponent may submit evidence referred to in subsection 38(8) of the Act to the Registrar in the period of four months that begins after the day on which the applicant's service on the opponent of a copy of the counter statement is effective.

Timing of service

(2) For the purpose of subsection 38(9) of the Act, the time within which the opponent must serve that evidence on the applicant is during that four-month period.

INTA is grateful for this timing clarification.

Opponent's statement

(3) If the opponent does not wish to submit evidence referred to in subsection 38(8) of the Act, they may submit a statement to that effect to the Registrar within the four-month period set out in subsection (1) of this section and, if so, they must serve it on the applicant within that four-month period.

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.

Timing of applicant's evidence

52 (1) The applicant may submit evidence referred to in subsection 38(8) of the Act to the Registrar in the period of four months that begins after the day on which the opponent's service under section 50 of these Regulations is effective.

Timing of service

(2) For the purpose of subsection 38(9) of the Act, the time within which the applicant must serve that evidence on the opponent is during that four-month period.

INTA is grateful for this timing clarification.

Statement of applicant

(3) If the applicant does not wish to submit evidence referred to in subsection 38(8) of the Act, they may submit a statement to that effect to the Registrar within the four-month period set out in subsection (1) of this section and, if so, they must serve it on the opponent within that four-month period.

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.

Reply evidence — timing

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

Additional evidence

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

Interests of justice

(2) The Registrar must grant leave under subsection (1) if it is in the interests of justice to do so.

INTA supports this – same as 48(2) above.

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 as evidence in the opposition proceeding.

Conduct 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 conducting the cross-examination,

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

Inadmissibility in absence of cross-examination

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

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.

Timing of opponent's written representations

(2) The opponent may submit written representations to the Registrar in the period of two months that begins after the date of that notice.

Timing of service

(3) For the purpose of subsection 38(9) of the Act, the time within which the opponent must serve their written representations on the applicant is during that two-month period.

INTA is grateful for this timing clarification.

Statement of opponent

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

Timing of applicant's written representations

(5) The applicant may submit written representations to the Registrar in the following period:

- (a) if service referred to in subsection (3) or (4), as the case may be, is effective within the two-month period set out in subsection (2), the period of two months that begins after the day on which that service is effective; and
- (b) in any other case, the period of two months that begins after the end of the two-month period set out in subsection (2).

Timing of service

(6) For the purpose of subsection 38(9) of the Act, the time within which the applicant must serve their written representations on the opponent is during the applicable two-month period referred to in subsection (5) of this section for their submission of written representations.

INTA is grateful for this timing clarification.

Statement of applicant

(7) If the applicant does not wish to submit written representations, they may submit a statement to that effect to the Registrar within the applicable two-month period referred to in subsection (5) for their submission of written representations and, if so, they must serve it on the opponent within that period.

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 — or, if no such service is effective within the applicable two-month period referred to in subsection 57(5) for their submission of written representations, within one month after the end of that period — a party that wishes to make representations to the Registrar at a hearing must file with the Registrar a request that indicates

- (a) whether they intend to make representations in English or French and whether they will require simultaneous translation if the other party makes representations in the other official language; and
- (b) whether they wish to make representations in person, by telephone, by video conference or by another means of communication offered by the Registrar, and that sets out any information necessary to permit the use of the chosen means of communication.

COMMENT: This section, read in conjunction with ss. 57(4) and 57(7) appears to suggest that it is not until after the expiry of the applicant's deadline to file written representations that the opponent and the applicant may request a hearing. Practically, many parties advise the Registrar that they do not intend to file evidence and/or written representations, and at the same time advise that they intend to make representations at a hearing. It is more convenient for the parties, and we submit, the Registrar, to permit parties to advise of the wish to make representations at a hearing at any stage after the opposition and the counter statement to opposition have been filed. We therefore recommend that this section be amended by adding, at the beginning "At any time following the filing of a counter statement, and no later than one month after"

When representations may be made

(2) A party may make representations at the hearing only if they file a request in accordance with subsection (1).

COMMENT: it bears repeating that this section will most certainly result in parties consistently requesting a hearing, to avoid losing the opportunity to make submissions. This will add a step to all oppositions, adding to the cost of opposition proceedings, and also to the scheduling efforts of the Registrar. It is recommended that this section be revised to provide that in the event a request for a hearing is made by any party, the other party must advise the Registrar within a designated time that they intend to attend and make submissions. Should that party fail to do so, many parties may elect not to proceed with the hearing.

Changes

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

COMMENT: What is the effect of notification of a change less than a month before the date of a hearing? Given the realities of daily practice, there could be many changes to the details of a hearing, including, for example, how representations will be made (by telephone, video, etc.). While we appreciate the disruptive impact of last-minute changes, the section suggests unnecessary inflexibility.

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 that is 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.

Fee for extending statement of goods or services

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

Merger of registrations

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

Fee for the giving of notice

62 For the purpose of subsection 44(1) of the Act, the fee to be paid by a person that requests that a notice be given 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 that was given to them.

Transfer of Registered Trademark

Fee

64 A person that requests the registration of the 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.

Required information

65 The Registrar must not register the transfer of a registered trademark under subsection 48(4) of the Act unless the Registrar has been provided with the transferee's name and postal address.

Effect of transfer — separate registrations

66 If the transfer to a person of a registered trademark is, under subsection 48(4) of the Act or section 146 of these Regulations, registered in respect of at least one but not all of the goods or services that are

specified in the initial registration, that person is deemed to be the registered owner of a separate registration that is deemed to have the same registration date as that initial registration.

INTA gratefully acknowledges this language clarification.

Proceeding Under Section 45 of Act

COMMENT: Please see above for comments on service and hearings. These apply to section 45 proceedings as well.

Fee

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

Correspondence

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

Forwarding copies of documents

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

Service on representative of party

70 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 on whom or a firm on which 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

71 (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 filed with or submitted to the Registrar, if the party seeking to effect service does not have the information necessary 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.

Service on trademark agent

(2) Despite section 70, if a party to be served appoints a trademark agent that resides in Canada in respect of a proceeding under section 45 of the Act, service must be effected on that agent unless the parties agree otherwise.

Effective date of service

(3) Subject to subsections (4) to (7) and (10), service is effective on the day on which the document is delivered.

Exception — service by registered mail

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

Exception — service by courier

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

Exception — service by electronic means

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

Exception — service by sending of notice

(7) 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

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

Proof of service

(9) 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.

Validity of irregular service

(10) Service of a document other than in accordance with subsection (1) is nonetheless valid if the Registrar determines that the document has been provided to the party being served and informs the parties of that determination. The service is effective on the day on which the document was provided to the party being served.

Evidence — timing

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

Written representations

73 (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 the period of two months after the date of the notice given under subsection (1) of this section.

Statement of registered owner

(3) If the registered owner does not wish to submit written representations in respect of a notice referred to in subsection 45(1) of the Act that was given on the Registrar’s own initiative, they may submit a statement to that effect to the Registrar within the two-month period referred to in subsection (2) of this section.

Timing if notice given on request

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

Statement of person requesting notice

(5) If that person does not wish to submit written representations, they may submit a statement to that effect to the Registrar within the two-month period set out in subsection (4) and, if so, they must serve it on the registered owner within that period.

Timing of registered owner’s written representations

(6) 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, the time within which the registered owner may submit written representations to the Registrar and must serve those representations on that person is

- (a) in the case that a service referred to in subsection (4) or (5) of this section, as the case may be, is effective within the two-month period set out in that subsection (4), the period of two months that begins after the day on which that service is effective; and
- (b) in any other case, the period of two months that begins after the end of that two-month period set out in that subsection (4).

Statement of registered owner

(7) If the registered owner does not wish to submit written representations in respect of a notice referred to in subsection (6), they may submit a statement to that effect to the Registrar within the applicable two-month period referred to in subsection (6) for their submission of written representations and, if so, they must serve it on the person requesting the notice within that period.

Request for hearing

74 (1) Every party that wishes to make representations to the Registrar at a hearing must file with the Registrar a request that indicates

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

Period

(2) The request must be filed within the following period:

- (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 two-month period referred to in subsection 73(2) of these Regulations, one month after the end of that period; and
- (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 applicable two-month period referred to in subsection 73(6) of these Regulations for their submission of written representations, one month after the end of that period.

When representations may be made

(3) A party may make representations at the hearing only if they file a request in accordance with this section.

Changes

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

Renewal of Registration

Fee

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

Period

76 For the purpose of section 46 of the Act, the period within which the renewal fee is to be paid

- (a) begins on the day that is six months before the end of the initial period or the renewal period, as the case may be, and
- (b) ends at the later of
 - (i) the end of the six-month period that begins after the end of that initial or renewal period, and
 - (ii) the end of the two-month period that begins after the date of the notice referred to in subsection 46(2) of the Act.

Deemed date — merged registrations

77 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 the merger, on which the initial period or the renewal period, as the case may be, in respect of any of the registrations being merged would have expired, had the merger not occurred.

COMMENT: This provision is exceedingly difficult to decipher, and uncertainty may result in errors in calculation of renewal dates, which in turn can result in lost rights. It would be simpler to confirm that the initial period, and all subsequent renewal periods for any registration that results from a merger of registrations is determined by the registration date of the earliest registration.

Objection Proceeding Under Section 11.13 of Act

COMMENT: Please see above under Oppositions for comments on service of documents and hearings.

Fee

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

Correspondence

79 A person that corresponds with the Registrar in respect of an objection proceeding must clearly indicate that the correspondence relates to that proceeding.

Forwarding copies of documents

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

Manner of service

81 (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 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.

Service on trademark agent

(2) If a party to be served appoints a trademark agent that resides in Canada in respect of an objection proceeding,

- (a) that agent is deemed, in respect of any party that has been served with notice of the appointment, to replace any person or firm set out in a statement by the Minister or a statement of objection as a person on whom or a firm on which service of any document may be made with the same effect as if it had been served on the party directly; and
- (b) service must be effected on that agent unless the parties agree otherwise.

Effective date of service

(3) Subject to subsections (4) to (7) and (10), service is effective on the day on which the document is delivered.

Exception — service by registered mail

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

Exception — service by courier

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

Exception — service by electronic means

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

Exception — service by sending of notice

(7) 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

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

Proof of service

(9) 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.

Validity of irregular service

(10) Service of a document other than in accordance with subsection (1) is nonetheless valid if the Registrar determines that the document has been provided to the party being served and informs the parties of that determination. The service is effective on the day on which the document was provided to the party being served.

Amendment

82 (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 considers to be appropriate.

Interests of justice

(2) The Registrar must grant leave under subsection (1) if it is in the interests of justice to do so.

Manner of submitting evidence

83 Evidence in respect of an objection proceeding, other than evidence referred to in subsection 91(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 that is 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 of objector's evidence

84 (1) The objector may submit evidence referred to in subsection 11.13(5) of the Act to the Registrar in the period of four months that begins after the day on which the responsible authority's service on the objector of a copy of the counter statement is effective.

Timing of service

(2) For the purpose of subsection 11.13(5.1) of the Act, the time within which the objector must serve that evidence on the responsible authority is during that four-month period.

Objector's statement

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

Circumstances — deemed withdrawal of objection

85 For the purpose of subsection 11.13(6) of the Act, the circumstances under which the objector's not submitting and serving evidence or a 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 84 of these Regulations.

Timing of responsible authority's evidence

86 (1) The responsible authority may submit evidence referred to in subsection 11.13(5) of the Act to the Registrar in the period of four months that begins after the day on which the objector's service under section 84 of these Regulations is effective.

Timing of service

(2) For the purpose of subsection 11.13(5.1) of the Act, the time within which the responsible authority must serve that evidence on the objector is during that four-month period.

Statement of responsible authority

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

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

87 For the purpose of paragraph 11.13(5)(a) of the Act, the circumstances under which the responsible authority's not submitting evidence or a statement that they do not wish to submit evidence results in the loss of the opportunity to submit evidence and to make representations to the Registrar 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 86 of these Regulations.

Circumstances — indication or translation not entered on list

88 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 86 of these Regulations.

Reply evidence — timing

89 Within one month after the day on which the service on the objector under section 86 is effective, the objector may submit to the Registrar reply evidence and, if so, they must serve it on the responsible authority within that one-month period.

Additional evidence

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

Interests of justice

(2) The Registrar must grant leave under subsection (1) if it is in the interests of justice to do so.

Ordering of cross-examination

91 (1) On the application of a party made before the Registrar gives notice in accordance with subsection 92(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 as evidence in the objection proceeding.

Conduct 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 conducting the cross-examination,

- (a) the party that conducted 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

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

Timing of objector’s written representations

(2) The objector may submit written representations to the Registrar in the period of two months that begins after the date of that notice.

Timing of service

(3) For the purpose of subsection 11.13(5.1) of the Act, the time within which the objector must serve their written representations on the responsible authority is during that two-month period.

INTA believes there may be a typo in this section. Specifically the reference to s 11.13(5.1) appears incorrect (non-existent) and we believe you intended this to refer to s. 11.13 (6).

Statement of objector

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

Timing of responsible authority’s written representations

(5) The responsible authority may submit written representations to the Registrar in the following period:

- (a) if service referred to in subsection (3) or (4), as the case may be, is effective within the two-month period set out in that subsection, the period of two months that begins after the day on which that service is effective; and
- (b) in any other case, the period of two months that begins after the end of the two-month period set out in subsection (2).

Timing of service

(6) For the purpose of subsection 11.13(5.1) of the Act, the time within which the responsible authority must serve their written representations on the objector is during the applicable two-month period referred to in subsection (5) of this section for their submission of written representations.

Statement of responsible authority

(7) If the responsible authority does not wish to submit written representations, they may submit a statement to that effect to the Registrar within the applicable two-month period referred to in subsection (5) for their submission of written representations and, if so, they must serve it on the objector within that period.

Request for hearing

93 (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 — or, if no such service is effective within the applicable two-month period referred to in subsection 92(5) for their submission of written representations, within one month after the end of that period — a party that wishes to make representations to the Registrar at a hearing must file with the Registrar a request that indicates

- (a) whether they intend to make representations in English or French and whether they will require simultaneous translation if the other party makes representations in the other official language; and
- (b) whether they wish to make representations in person, by telephone, by video conference or by another means of communication offered by the Registrar, and that sets out any information necessary to permit the use of the chosen means of communication.

When representations may be made

(2) A party may make representations at the hearing only if they file a request in accordance with subsection (1).

Changes

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

Copies of Documents

Fee for certified copies

94 (1) A person that requests a certified copy of a document that is 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 that is 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

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

PART 2

Implementation of Madrid Protocol

General

Interpretation

96 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 an 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 notifies the Registrar of a request made under Article 3^{ter}(1) or (2) of the Protocol. (*date de la notification d’extension territoriale*)

COMMENT: Is the date the date of the “notification” by the International Bureau, the date it is sent, or the date it is received by the Registrar? More clarity is needed, since this date impacts other provisions in the Regulations.

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. (*délai d’opposition*)

COMMENT: Recommend that this be qualified by “subject to any permissible extension” – otherwise there will be confusion about the permitted period within which to oppose, particularly given the language of s. 125.

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 103(1) or (2) or a divisional application referred to in subsection 124(1). (*demande prévue au Protocole*)

Protocol registration means the registration of a trademark under subsection 132(1). (*enregistrement prévu au Protocole*)

Non-application of section 66 of Act

97 (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 117(2) and (3) of these Regulations;
- (b) the maximum four-month extension fixed by section 125 of these Regulations; and
- (c) the three-month period fixed by section 147 of these Regulations.

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)

Qualification

Conditions

98 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 conditions:

- (a) the person is a national of or is 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.

Contents and Form

Contents

99 (1) Every application for international registration filed with the Registrar must include the following information:

- (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 basic registration, the same claim;
- (e) a reproduction of the trademark, which must be in colour if the trademark is in colour in the basic application or basic registration or if colour is claimed as a feature of the trademark in the basic application or the basic registration;
- (f) if the trademark in the basic application or basic registration is a certification mark, it consists in whole or in part of a three-dimensional shape or a sound or it 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 that must
 - (i) include only goods or services that are within the scope of the basic application or basic registration, and
 - (ii) group 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 3^{ter}(1) of the Protocol.

Language

(2) The application, with the exception of the trademark itself, must be in English or French.

Manner of filing

(3) The application must be filed by

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

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

- (a) certifying that the information included in the application for international registration corresponds to the information included in the basic application or basic registration;
- (b) presenting the application for international registration to the International Bureau; and
- (c) in the case that the application for international registration results in an international registration, notifying the International Bureau to the following effect:
 - (i) 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, and
 - (ii) if a proceeding that began before the end of that five-year period leads to the withdrawal, abandonment or refusal of the basic application or to the cancellation or expungement of the basic registration after that period.

COMMENT: The words “if in respect to all or any of the goods or services” are in s. 100(c)(i), but not in s. 100(c) (ii). There does not appear to be any reason for this omission.

Change in Ownership of International Registration

Request for recording

101 (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 they meet the following requirements:

- (a) the transferee is a national of or is domiciled in Canada or has a real and effective industrial or commercial establishment in Canada; and
- (b) the transferee has been unable to obtain, on a request for the recording of a change in ownership of the international registration, the signature of the holder of the international registration or of the holder’s representative recorded in accordance with Rule 3(4)(a) of the Common Regulations.

Manner of filing

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

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

102 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 101 if the Registrar considers the evidence of the transfer to be satisfactory.

COMMENT: s. 100 states that “on receipt of an application”, the Registrar “must” do certain acts, including presenting the application to the International Bureau. Section 102 should similarly include the wording that the “Upon receipt of a request for the recording of a change in ownership...”

Territorial Extension to Canada

Protocol Application

Request under Article 3ter(1) of the Protocol

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

Request under Article 3ter(2) of the Protocol

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

Deemed application for certification mark

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

Non-Registrable Trademarks

Goods or services outside scope of international registration

104 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.

COMMENT: It bears repeating that s. 104 uses the words “not registrable”, but that the qualifications for registrability are set out in s. 12 of the Act, and do not include whether or not goods/services are within the scope of an international registration. This will cause uncertainty as to the impact of such “registrability”, and also whether this raises, or not, a ground of opposition. It is recommended that the language of this section use alternate language, such as “A trademark that is the subject of a Protocol application may not be registered if the goods or services specified in the Protocol application are not within the scope of the international registration.”

Filing Date

Non-application of sections 33 and 34 of Act

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

Date of international registration

106 (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), in the case that, 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, along 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 is 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

107 (1) If 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, of an international registration on which a Protocol application is based,

- (a) in the case that the recording results in a deletion of all goods or services from that list without giving rise to a resulting new list, the Protocol application is deemed to be withdrawn;
- (b) subject to paragraph (a), in the case that the recording results in a deletion of all goods or services from that list of a particular class of the Nice Classification without giving rise to a resulting new list for that particular class of the Nice Classification, the Protocol application is deemed to be amended accordingly; and
- (c) in the case that the recording results in a deletion of one or more of the goods or services from a list of a particular class of the Nice Classification and gives rise to a resulting new list for that particular class of the Nice Classification, the Registrar must determine, with respect to each good or service in that resulting new list for that particular class, whether the following requirements are met:
 - (i) the good or service is within the scope of the Protocol application on its filing date, not taking into account subsection 106(2), and on the date of the recording in the International Register,
 - (ii) 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,
 - (iii) the good or service is within the scope of the Protocol application as amended, if the Protocol application is amended on or after the day on which the application is advertised under subsection 37(1) of the Act and if the date of the recording in the International Register is on or after the day of the amendment, and
 - (iv) the good or service is described in ordinary commercial terms and in a manner that identifies a specific good or service.

INTA is grateful for the language clarification in this section.

Recording resulting in new list

(2) In the case that the recording results in a deletion of one or more of the goods or services from a list of a particular class of the Nice Classification and gives rise to a resulting new list for that particular class of the Nice Classification,

- (a) if the Registrar determines that the requirements set out in paragraph (1)(c) are not met for any good or service in that resulting list for that particular class, the Registrar must, in accordance with Rule 27(5) of the Common Regulations, send to the International Bureau a declaration to the effect that the limitation has no effect in Canada in respect of all of the goods and services in that class; and
- (b) if the Registrar determines that the requirements set out in paragraph (1)(c) are met for all of the goods or services in that resulting list for that particular class, the Protocol application is deemed to be amended accordingly.

INTA is grateful for the language clarification in this section.

Complete renunciation

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 renunciation in respect of Canada for all of the goods or services that are listed in the international registration, the Protocol application is deemed to be withdrawn.

INTA is grateful for the language clarification in this section.

Complete 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 all of the goods or services that are listed in the international registration, the Protocol application is deemed to be withdrawn.

INTA is grateful for the language clarification in this section.

Partial cancellation

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 cancellation of the international registration for at least one but not all of the goods or services that are listed in the international registration, the Protocol application is deemed to be amended or withdrawn accordingly.

INTA is grateful for the language clarification in this section.

Change of name or address

111 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 of name or address of the holder, the Protocol application is deemed to be amended accordingly.

INTA is grateful for the language clarification in this section.

Effective date of amendment or withdrawal

112 An amendment or withdrawal of a Protocol application under any of sections 107 to 111 is deemed to have taken effect on the date of the limitation, renunciation, cancellation or change, as the case may be, as recorded in the International Register.

Non-renewal of international registration

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

Effect of Correction of International Registration on Protocol Application

Deemed amendment to application

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

Amendment to non-advertised application

115 If a Protocol application has not been advertised under subsection 37(1) of the Act before the date of notification of a correction of an international registration on which the Protocol application is based and if the Registrar determines that the deemed amendment to the Protocol application 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 120 and 129, paragraph 132(1)(c) and subparagraph 132(1)(d)(i) of these Regulations to “date of notification of territorial extension” is to be read as “day on which the International Bureau sent to the Registrar the notification of a correction of an international registration on which the Protocol application is based” in respect of that Protocol application.

COMMENT: This section, which has been reworded, continues to be very difficult to comprehend, especially since the sections referred follow, and not precede, this section. It would be preferable, and easier to understand, if reworded to refer to the impact of any particular section, vs. merely the section numbers.

Amendment to advertised application — all goods or services

116 If a Protocol application has been advertised under subsection 37(1) of the Act before the date of notification of a correction of an international registration on which the Protocol application is based and if the Registrar determines that the deemed amendment to the Protocol application 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 120 and 129, paragraph 132(1)(c) and subparagraph 132(1)(d)(i) of these Regulations to “date of notification of territorial extension” is to be read as “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 — some goods or services

117 (1) If a Protocol application has been advertised under subsection 37(1) of the Act before the date of notification of a correction of an international registration on which the Protocol application is based and if the Registrar determines that the deemed amendment to the Protocol application 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 elect one of the following options:

- (a) that the Protocol application be amended to delete those goods or services; or
- (b) that the Protocol application be deemed to never have been advertised.

Deletion of goods or services

(2) If the applicant elects 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 never to have been advertised; and
- (b) a reference in sections 120 and 129, paragraph 132(1)(c) and subparagraph 132(1)(d)(i) to “date of notification of territorial extension” is to be read as “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

118 An amendment to a Protocol application under section 114 or subsection 117(2) is deemed to have taken effect on the later of the filing date of the Protocol application and the day on which the error was made that gave rise to the correction of the international registration.

COMMENT: It seems possible that the date that any error was made may not be easily, or ever, determined, and so having a date run from when the error occurred will always result in uncertainty about the effective date of an amendment to the Protocol application. In addition, it is not certain that every “correction” will result from an “error”. Since both s. 114 and ss 117(2) refer to corrections, it would be preferable if the amendment is deemed to have taken place on the later of the filing date of the Protocol application, and the date on which the international registration was corrected.

Abandonment

Statement of confirmation of total provisional refusal

119 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

120 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

121 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

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

Filing of request for division

123 (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.

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(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.

Sending of request to International Bureau

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

Deemed divisional application

124 (1) If, following receipt of a request under section 123, 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 123, in which case those provisions apply as if that divisional application were an original Protocol application.

Opposition

Limitation of extension

125 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.

COMMENT: As noted above, this section appears to set an internal inconsistency about the term of the “opposition period”, which under s. 96 is 2 months, but can, under s. 1(2) and s. 125, be extended, (subject to s. 97(1)).

Filing of statement of opposition

126 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

127 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

128 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.

Notice of opposition period

129 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

130 The Registrar must send a statement of confirmation of total provisional refusal in respect of a Protocol application 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 taken, the final judgment has been decided in favour of the opponent.

Registration of Trademarks

Non-application of section 40 of Act

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

Obligations of Registrar

132 (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 to the International Bureau that protection is granted to the trademark if

- (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 taken, the final judgment has been decided in favour of the applicant;

COMMENT: Since an application may be decided in favour of the applicant for only some goods/services, but not all, this section should so clarify, by adding, after the phrase “in favour of the applicant” the words “for all or some of the goods and services”, and it should be confirmed that the onus of the Registrar to register is for such goods/services. If this change is not made, it will be uncertain what will happen in the case of an opposition that is only partially in favour of an 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 end 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 that begins after the day on which the opposition period began and the end of the one-month period that begins after the day on which the opposition period ended.

COMMENT: The calculation of dates in s. 132(2), and in particular s 132(2)(d)(ii) is exceedingly complicated. Further, the language in the section uses a number of terms such as “after the date”, “after the day”, and “from the date”. Setting a deadline “from” a specific date provides clarity. Two months “from” March 11 is May 11. Two months after March 11 is not clearly May 11 - it could be May 12. Since calculation of deadlines is critical and certainty is important, and the impact of any error in the calculation of deadline can have very adverse consequences, the way in which deadlines are expressed needs more clarity. This comment applies to numerous sections of the Regulations.

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

133 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

134 (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 to merge the divisional international registration with 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) all of the 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.

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(3) The request must indicate the number of each of the international registrations to be merged and the name of the holder of those international registrations.

Sending of request to International Bureau

(4) The Registrar must send 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

135 (1) If 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, of an international registration on which a Protocol registration is based,

- (a) in the case that the recording results in a deletion of all goods or services from that list without giving rise to a resulting new list, the Registrar must cancel the Protocol registration; and
- (b) subject to paragraph (a), in the case that the recording results in a deletion of all goods or services from that list of a particular class of the Nice Classification without giving rise to a resulting new list for that particular class of the Nice Classification, the Registrar must amend the register accordingly; and
- (c) in the case that the recording results in a deletion of one or more of the goods or services from a list of a particular class of the Nice Classification and gives rise to a resulting new list for that particular class of the Nice Classification, the Registrar must determine, with respect to each good or service in that resulting new list for that particular class, whether the following requirements are met:
 - (i) the good or service is within the scope of the Protocol registration on the date of the recording in the International Register, and
 - (ii) the good or service is described in ordinary commercial terms and in a manner that identifies a specific good or service.

Recording resulting in new list

(2) In the case that the recording results in a deletion of one or more of the goods or services from a list of a particular class of the Nice Classification and gives rise to a resulting new list for that particular class of the Nice Classification,

- (a) if the Registrar determines that the requirements set out in paragraph (1)(c) are not met for any good or service in that resulting list for that particular class, the Registrar must, in accordance with Rule 27(5) of the Common Regulations, send to the International Bureau a declaration to the effect that the limitation has no effect in Canada in respect of all of the goods and services in that class; and
- (b) if the Registrar determines that the requirements set out in paragraph 1(c) are met for all of the goods or services in that resulting list for that particular class, the Registrar must amend the register accordingly.

Complete renunciation

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 renunciation in respect of Canada for all of the goods or services that are listed in the international registration, the Registrar must cancel the Protocol registration.

Complete 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 all of the goods or services that are listed in the international registration, the Registrar must cancel the Protocol registration.

Partial cancellation

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

Change of name or address

139 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 of name or address of the holder, the Registrar must amend the register accordingly.

Correction of international registration

140 (1) If the International Bureau notifies the Registrar of a correction of an international registration 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 is 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 still considers that protection cannot, or can no longer, be granted to the international registration as corrected, the Registrar must so notify the International Bureau and amend the register or cancel the Protocol registration accordingly.

Effective date of cancellation or amendment

141 A cancellation of a Protocol registration or an amendment of the register under any of sections 135 to 140 is deemed to take effect on the date of the limitation, renunciation, cancellation, change or correction, as the case may be, as recorded in the International Register.

Failure to consider request for extension of time

142 (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 so notify the International Bureau.

Renewal

Non-application of section 46 of Act

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

Period of registration

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

COMMENT: What is the impact of “moment” in this section? All other periods or terms are expressed by “on the day”, or “one the date”, whereas this section uses “at the moment”. Since the “moment” on which a cancellation or expungement is not recorded, anywhere, this term is confusing, and leads to a suggestion that the time of day could make a difference. It is recommended that “on the day” be used for both the beginning, and ending terms.

Expungement

(2) If the international registration on which a Protocol registration is based is not renewed in respect of Canada and the International Bureau so notifies the Registrar, 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

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

Recording or registration

146 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

147 (1) If an international registration on which a Protocol application or Protocol registration is based is cancelled under Article 6(4) of the Protocol for all or any of the goods or services listed in the international registration, the person that 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.

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; and
- (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 in English or French and 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 three-month period referred to in subsection (1) of this section.

Consequences — trademark subject of cancelled Protocol application

148 If a transformation application is filed in accordance with section 147 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 that, on the date of cancellation recorded in the International Register, was the holder of the same trademark as in the cancelled international registration and in respect of the goods or services specified in the transformation application;
- (b) the deemed application is deemed to include any document or information contained in the Protocol application, other than the statement of goods or services;
- (c) the deemed application 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 deemed application.

Consequences — trademark subject of cancelled Protocol registration

149 If a transformation application is filed in accordance with section 147 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 76 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 76; 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 Protocol

150 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

Definitions

151 The following definitions apply in this Part.

former Regulations means the *Trade-marks Regulations* as they read immediately before coming-into-force day. (*ancien règlement*)

coming-into-force day means the day of coming-into-force determined in accordance with subsection 162(1) (*date d'entrée en vigueur*)

Filing date already determined

152 If, before coming-into-force day, 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

153 If, before coming-into-force day, 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 coming-into-force day.

Exception to subsections 32(1) and (2)

154 (1) If the filing date, without regard to section 34 of the Act, of an application for the registration of a trademark, other than a *Protocol application* as defined in section 96, precedes the coming-into-force day and the trademark has not yet been registered on that day, subsections 32(1) and (2) of these Regulations do not apply and the person that 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.

Deemed payment of fees

(2) If the fee set out in item 15 of the schedule to the former Regulations is paid in respect of an application referred to in subsection (1), the fee referred to in that item is deemed to have been paid for

- **(a)** when that application is itself a divisional application
 - **(i)** in the case that it stems from a series of divisional applications, the original application from which stems the series and every divisional application that stems from that original application, and
 - **(ii)** in the case that it does not stem from a series of divisional applications, its corresponding original application and every divisional application that stems from it; and
- **(b)** when that application is not itself a divisional application, every divisional application that stems from it.

COMMENT: The provisions of s. 154(2) are very difficult to understand. Since payment terms should be clear and unequivocal, clarifications are required. For example, s 154(2) could begin with the words “in the case of any divisional application”, since this provision only applies to divisional applications. Similarly, use of wording such as “from which stems the series”, and “that stems from the original” is complicated. The intent of the section is not clear.

Exception to subsection 32(4)

155 If, before coming-into-force day, in respect of an application for the registration of a trademark, the items set out in paragraphs 33(1)(a) to (e) of the Act have been received by the Registrar, the fee for the purpose of paragraph 33(1)(f) of the Act, referred to in section 69.1 of the Act, in respect of that application is, despite subsection 32(4) of these Regulations, the fee set out in item 1 of the schedule to the former Regulations.

COMMENT: Repeating the concern above, payment of fees is key to registration, and any doubt as to what, or when a fee applies should be clear. It should not be necessary to first read a number of paragraphs in both the Act and the Regulations to understand the impact of any single section. It would have been easier to say, for example, that for any application filed before the coming-into-force date that includes the information set out in s. 33(1)(a) to (e) of the Act is set out in item 1 of the schedule to the former Regulations. Even a simple reference to “information set out in s. 33 (1) (a) to (e) would simplify the interpretation of this provision.

COMMENT: The Regulations are inconsistent in how provisions of the Act and Regulations are identified. For example, above, the terms “paragraphs” are used to refer to subsections of sections in the Act, whereas “subsection” is used to refer to subsections of the Regulations. However, for example, in s. 159 of the Regulations, the words “for the purpose of subsections 46(2) to (5) of the Act...” is used. There should be more consistency in the use of paragraph and subsection.

Exception to section 34

156 Despite section 34, if the date of a notice of a default in the prosecution of an application precedes the coming-into-force day, the time within which the default may be remedied is that specified in the notice.

Exception to paragraph 35(2)(e)

157 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 31 (e), (f) or (g) of these Regulations.

Exception to section 75

158 Despite section 75 of these Regulations, for the purpose of section 46 of the Act, the 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 the coming-into-force day is the fee set out in item 7 of the schedule to the former Regulations.

Exception to section 76 — first renewal

159 Despite section 76 of these Regulations and subject to section 160 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 coming-into-force day, of a registration that is on the register on the day before the coming-into-force day, the period within which the renewal fee must be paid

- (a) begins on the later of the day of registration and the day of last renewal, and
- (b) ends on the later of
 - (i) the end of the period of 15 years and six months that begins after the later day described in paragraph (a), and
 - (ii) the end of the two-month period that begins after the date of the notice referred to in subsection 46(2) of the Act.

COMMENT: Since calculation of renewal dates is critical, and uncertainty and errors may lead to loss of rights, wording of any provisions on term should be clear. This section is not. Use of phrases that depend upon calculating dates that are based

on later and beginning days, and incorporate calculations from both the Regulations and the Act are too complex for many applicants, particularly self-represented applicants. The exact date when expressed in terms of “x months after a date” as opposed to “x months from the date” is not certain. Simplification is required. For example, even adding a clue such as “notice of renewal referred to in subsection 46(2) of the Act” might assist in determination of the deadline date.

Exception to section 76 — goods or services not grouped

160 Despite section 76 of these Regulations, if the goods or services in respect of which a trademark is registered are not, at the end of the period established by section 76 or 159 of these Regulations, as the case may be, 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 on the expiry of the two-month period that begins 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 in the event that the fees are not paid within the prescribed period, in the case that two-month period ends later than that period established by section 76 or 159 of these Regulations.

COMMENT: As above, absent some reference to the content of sections referred to (eg. ss. 76 and 159), the impact of this section is very difficult to comprehend. Terms that are calculated from the “expiry” of a period and beginning “after a day” are not only very complex to clearly determine, but it is expected that there will be many errors in the calculation of these dates, particularly by self-represented applicants. Since there will be many registrations that will require grouping of goods and services by class, and the impact of failure to respond to the notice period is severe (loss of registration), the wording in the section needs to be both simple and clear.

Repeal

161 The *Trade-marks Regulations* ([see footnote 1](#)) are repealed.

Coming into Force

S.C. 2015, c. 36 and S.C. 2017, c. 6

162 (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 section 67 of the *Economic Action Plan 2015 Act, No. 1* comes into force before February 1, 2019, sections 123, 124 and 134 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, paragraph 40(2)(d), sections 42, 60, 62, 64, 67, 75 and 78, subsection 94(1), section 95, subparagraph 149(d)(ii) and section 160)

Tariff of Fees

Item	Column 1 Description	Column 2 Fee (\$)
1	Application for an extension of time under section 47 of the Act, for each act for which the extension is sought	• 125.00
2	Trademark agent qualifying examination	• 400.00
	Request for name to be entered on the list of trademark agents	
3	<ul style="list-style-type: none"> • (a) if the request and fee are submitted online through the Canadian Intellectual Property Office website • (b) in any other case 	<ul style="list-style-type: none"> • 300.00 • 350.00
	Maintenance of name on list of trademark agents	
4	<ul style="list-style-type: none"> • (a) if the fee is submitted online through the Canadian Intellectual Property Office website • (b) in any other case 	<ul style="list-style-type: none"> • 300.00 • 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
	Application for the registration of a trademark	
7	<ul style="list-style-type: none"> • (a) if the application and fee are submitted online through the Canadian Intellectual Property Office website <ul style="list-style-type: none"> ○ (i) for the first class of goods or services to which the application relates ○ (ii) for each additional class of goods or services to which the application relates as of the filing date • (b) in any other case <ul style="list-style-type: none"> ○ (i) for the first class of goods or services to which the application relates ○ (ii) for each additional class of goods or services to which the application relates as of the filing date 	<ul style="list-style-type: none"> • 330.00 • 100.00 • 430.00 • 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
	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	
10	<ul style="list-style-type: none"> • (a) for the first class of goods or services to which the application relates • (b) for each additional class of goods or services to which the application relates 	<ul style="list-style-type: none"> • 430.00 • 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
	Renewal of the registration of a trademark under section 46 of the Act	
14	<ul style="list-style-type: none"> • (a) if the renewal is requested and the fee submitted online through the Canadian Intellectual Property Office website <ul style="list-style-type: none"> ○ (i) for the first class of goods or services to which the request for renewal relates ○ (ii) for each additional class of goods or services to which the request for renewal relates • (b) in any other case <ul style="list-style-type: none"> ○ (i) for the first class of goods or services to which the request for renewal relates ○ (ii) for each additional class of goods or services to which the request for renewal relates 	<ul style="list-style-type: none"> • 400.00 • 125.00 • 500.00 • 125.00
15	Statement of objection under subsection 11.13(1) of the Act	• 1,000.00
	Certified copy in paper form	
16	<ul style="list-style-type: none"> • (a) for each certification • (b) for each page 	<ul style="list-style-type: none"> • 35.00 • 1.00
	Certified copy in electronic form	
17	<ul style="list-style-type: none"> • (a) for each certification • (b) for each trademark to which the request relates 	<ul style="list-style-type: none"> • 35.00 • 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

Non-certified copy in electronic form

- | | | |
|----|--|---|
| 19 | <ul style="list-style-type: none"> • (a) for each request • (b) for each trademark to which the request relates • (c) if the copy is requested on a physical medium, for each physical medium provided other than the first | <ul style="list-style-type: none"> • 10.00 • 10.00 • 10.00 |
|----|--|---|

[6-1-o]

- [Footnote 1](#)
SOR/96-195; SOR/2007-91, s. 1
- [Footnote a](#)
S.C. 2015, c. 36, s. 67
- [Footnote b](#)
S.C. 2014, c. 20, s. 358
- [Footnote c](#)
S.C. 2017, c. 6, s. 75
- [Footnote d](#)
R.S., c. T-13