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Mr. Mesmin Pierre
Director General
Trademarks Branch
Canadian Intellectual Property Office
50 Victoria Street, Room C236-10
Gatineau, QC K1A 0C9

Dear Mr. Pierre:

Re: Smart & Biggar Comments Regarding Trademarks Regulations
Published in the Canada Gazette, Part I

On behalf of Smart & Biggar/Fetherstonhaugh, I am writing to you about the proposed Trademarks Regulations published in the Canada Gazette, Part I.

As you are likely aware, we are the largest IP boutique in Canada. Every year, we file and prosecute thousands of trademark applications on behalf of our clients. It is imperative to both us and our clients that we understand the Trademarks Regulations to ensure that we do not risk jeopardizing our clients' rights.

As noted below, some of the proposed regulations are virtually impossible to understand. With some others, while we believe we understand them, they are so complicated as to create a considerable risk of inadvertent errors. These concerns are echoed by most of the other Canadian trademark lawyers and trademark agents with whom we have discussed these issues.

If experts within the field cannot comprehend certain provisions, then it would best for those provisions to be clarified. Failure to amend those provisions will seriously risk the rights of all applicants, clearly contrary to their interests and the reputation of the Canadian trademark profession and the Canadian Trademarks Office.

While we have heard that the Canadian Trademarks Office intends to provide Practice Notices to clarify some of the provisions, the publication of Practice Notices will not resolve the lack of clarity. Practice Notices are not legally binding. If experts within the trademark field cannot understand certain provisions, then it is even less likely that a Canadian judge, who has less experience interpreting trademark legislation, will understand the provisions. There is no guarantee that a judge will agree with interpretations provided within Practice Notices. In our

view, the purpose of Practice Notice should be to fill gaps within the Trademarks Act and Regulations, such as, for example, to explain certain requirements for filing non-traditional marks or to describe the types of evidence that could be useful to prove distinctiveness. The purpose of Practice Notices should not, in our view, be for the purpose of interpreting legislation.

As explained in greater detail below, the following provisions are the most problematic: 32(2), 32(3), 39, 40, 77, 155, 159 and 160.

With respect to sub-sections 32(2) and (3) and subsequent sections, a number of terms are used, including “divisional application” and “corresponding original application.” It is not clear if these terms refer to the same or different applications as compared to “filed divisional application”, “series of divisional applications”, “original application”, “an original application from which the corresponding original application stems”, “divisional application that stems from it”, and “an application”. It is difficult to determine when a fee is required. Since failure to pay the required fees could result in invalidity, this lack of clarity is of serious concern.

With respect to section 39, the term “corresponding original application” is ambiguous. It appears that a “corresponding original application” can itself be a divisional application. In this regard, it is noted that s. 39 of the Act refers to “corresponding original application.” However, in that context, this term appears to refer to the original application in the case of a series of divisional applications. Since s. 32 of the Regulations suggests that a corresponding original application can be a divisional application, it is not clear which application number must be provided.

A similar ambiguity exists for section 40. It is not clear if the “corresponding original application” is the immediate parent application or the original application in the case of a series of divisional applications.

Section 77 is almost impossible to understand and seems to be unnecessarily complicated.

Section 155 is very challenging to understand and appears to be unnecessarily complicated.

Section 159 is very challenging to understand and appears to be unnecessarily complicated.

Section 160 is very challenging to understand and appears to be unnecessarily complicated.

In view of the above, we request that these draft provision be amended so that they are free of ambiguity and understandable to a typical Canadian trademark agent.

Best regards,

SMART & BIGGAR


Philip Lapin