

---

**From:** Cynthia Rowden <crowden@bereskinparr.com>  
**Sent:** July-20-17 6:12 PM  
**To:** CIPO Consultations / OPIC consultations (IC)  
**Cc:** Pierre, Mesmin (IC); Goyette, Iyana (IC)  
**Subject:** COMMENTS ON DRAFT TRADEMARK REGULATIONS  
**Attachments:** Draft TM Regs Comments by B&PJuly20.docx

TO: Canadian Intellectual Property Office

On behalf of Bereskin & Parr, we enclose comments on the draft Regulations to implement the amended *Trademarks Act*.

By way of introduction, the firm of Bereskin & Parr was formed in 1965, and is now one of Canada's largest intellectual property law firms. The firm has one of Canada's biggest trademark practices and some of the best-known trademark professionals. We represent clients across the country, and around the world. Not only do we act for some of Canada's most successful innovators, with both national and global trademark rights, we also are privileged to act for some of the biggest trademark owners in the world. Our clients range from sole proprietors and small partnerships across Canada, to multinationals with far-ranging business activities. More than 40 of the firm's professionals, including trademark agents and lawyers, and more than 45 staff members are involved specifically with trademark matters.

We especially appreciate the steps taken by CIPO to inform and educate stakeholders about the new regulations, and the spirit of collaboration that has been shown in many meetings. We are excited to learn as much as possible about both the upcoming changes and the rationale for new procedures and rules. Many of our professionals have not only attended CIPO sessions, but have also spent hours analyzing the Regulations. We have held several inhouse sessions to ensure that we are well-informed about changes and how they will impact all aspects of our practice, from administrative file handling and deadline recordal, to evidence and hearings in oppositions and s.45 proceedings. We appreciate the opportunity to offer our comments and hope that they will be received in the spirit in which they have been prepared, namely to bring more clarity and certainty to the interpretation of the regulations and the system by which trademark rights are acquired and protected in Canada. These comments reflect the impressions of administrative staff, junior lawyers and those with decades of experience.

We believe that clear and simple guidance on the acquisition of trademark rights will be key to increasing Canadian participation in the trademark system, and we look forward to the growth of Canadian global trademark rights that should follow Canadian membership in treaties such as the Madrid Protocol.

As a general comment, we are pleased to note many changes that should bring more convenience to users of CIPO's systems, and also may streamline and shorten opposition proceedings. However, even for members of our firm with decades of experience, we have struggled with the interpretation of some provisions, and are certain that those with less familiarity with trademark prosecution will be even more confused. In addition, and particularly with respect to the Madrid Protocol sections, the detail of many steps are difficult to follow. While we appreciate that with more use and familiarity with the system, many of the provisions may be better understood, we recommend that two points be addressed: clarity of language, and the fact that for a full understanding of the workings of the Madrid Protocol, recourse will also have to be made to the

*Common Regulations under the Madrid Agreement Concerning the International Registration of Marks and the Protocol Relating to that Agreement.* The new Draft Regulations, once finalized, will not be a complete guide to the Madrid Protocol, and where additional information is necessary, it should be specifically noted.

We have started our attached comments with a number of general points, and then addressed sections of the Draft Regulations individually.

We would be pleased to respond to any questions and also to offer comments and suggestions on points we have raised. Please do not hesitate to contact the undersigned.

Regards,

Cynthia Rowden

Head, Trademarks Group

**Cynthia Rowden, Partner | Bereskin & Parr LLP**

Direct: 416.957.1617 | Fax: 416.361.1398 | [crowden@bereskinparr.com](mailto:crowden@bereskinparr.com)

This e-mail and any attachments may contain information that is privileged and/or confidential. If you are not the intended recipient and appear to have received this e-mail in error, please notify us immediately and then delete all copies from your computer system. Any unauthorized use, copying or further distribution is prohibited. Please also note that if you send us e-mails containing time-sensitive or important instructions, you should ensure that receipt has been timely acknowledged in view of the potential for misdirection or inadvertent interception. Thank you.