



Bereskin & Parr

Submissions in Response to Public Consultations on Amendments to the *Trademarks Regulations*

March 10, 2018

We very much appreciate the opportunity to consult with CIPO in connection with the new draft *Trademarks Regulations*, published in the Official Gazette on February 10, 2018. We also appreciate CIPO's efforts in bringing about a number of amendments and clarifications following collaboration with stakeholders during the first round of consultations in July 2017.

We have spent many hours studying the amended draft Regulations, both through in-house sessions and in collaboration with other esteemed members of the Canadian trademark bar, through participation on committees of the International Trademark Association (INTA) and the Intellectual Property Institute of Canada (IPIC).

We are pleased to see that some positive steps have been taken to address issues raised in our previous submissions, a copy of which is attached. However, we remain concerned, particularly with respect to the incomprehensibility of certain sections of the Regulations and with respect to confusion or ambiguity over deadlines that could result in loss of rights.

As mentioned in our previous submissions, even members of our firm with decades of experience have struggled with the interpretation of some provisions, and we are certain that those with less familiarity with trademark prosecution will be even more confused. Clear and unambiguous language, particularly with respect to the calculation of deadlines, is absolutely critical so that there is no inadvertent loss of rights.

We look forward to continuing the dialogue with CIPO in order to ensure that the *Trademarks Regulations*, and Canada's trademark system in general, are accessible to all.

About Bereskin & Parr LLP

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.

PART 1

Rules of General Application

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.

Section 4(1) requires only the name of the applicant and the application number. Traditionally, files are identified by the trademark, e.g., when opening files, when connecting mail with files, when addressing mail to other parties, etc. We had previously commented that rules such as this will impact SMEs, who may not use the right combination of identifying details. This requirement also exacerbates the confusion over application numbers created by the plethora of different terms used in the Regulations (and particularly in Sections 32 and 39, below) to refer to applications and divisional applications.

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.

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, and specifically state that such written communications will not be considered by the Registrar to be an opposition.

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.

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.

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.

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.

Section 22 uses the term “associate”, whereas the headings use the term “associate trademark agent”. The headings should correspond with the terminology in the sub-sections, otherwise there will be ambiguity as to the meaning of “associate”. We recommend that all references to “associate” per se be replaced with “associate trademark agent”. We note that s. 25 uses “associate trademark agent”.

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.

The wording of ss. 32(2) and 32(3) is exceptionally difficult to 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 to avoid inadvertent

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.

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 applicant 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.

This section is not clear. As noted above, since a “corresponding original application” can itself be a divisional application, as suggested by s. 32 of the Regulations, is it intended that all actions regarding a divisional application, as well as an original application, are deemed to have been taken in respect of the divisional application? To clarify, if there is a chain, beginning with the first-filed application, which is then divided multiple times, would all actions on any application in the chain be deemed to have been taken in respect of 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.

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.

This list does not specifically mention “the trademark” – and it is not clear that a word, vs. a design, mark is included in the words “a representation or description of a mark”. We recommend that ss. 41(c) be amended to add the words “the trademark, including any representation or description of the trademark contained in the application”.

The meaning of “publishing on the website of the Canadian Intellectual Property Office” is unclear, since the specific information listed in ss. 41(a)-(j) would also be contained in the application particulars on the Trademarks Database, which is available online on the website of the Canadian Intellectual Property Office. The wording in s. 34 of the current Regulations is much clearer, namely “the Registrar shall advertise the particulars of the application in the Journal” (with “Journal” being defined as the Trade-marks Journal referred to in subsection 66(3) of the Act).

Opposition Proceeding Under Section 38 of the Act

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.

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 as to whether steps in the opposition should, or need not, be taken. To permit parties to calculate the deadlines for next 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.

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.

As noted in our previous submission, as drafted, if a party to an opposition wishes to file state of the Register evidence, it would be necessary to order and attach certified copies of any application/registration pages relied upon. That could mean a very significant expense if there are many marks upon which any party wishes to rely. Possibly, this requirement only applies if Register evidence is filed without an affidavit or statutory declaration, but the section is not clear. We reiterate our recommendation that the section be worded to exclude affidavits to which are attached copies of applications and registrations copied from the CIPO database. If any party wishes to challenge the currency of the information on those pages, they can do so.

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.

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.

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.

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.

In each of ss. 51(2) and 52(2), for clarity and consistency, the language "set out in subsection (1) of this section" should be added following "four-month period" in order to clarify when the four-month period begins. We note that this language is specifically included in ss. 51(3) and 52(3).

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.

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).

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, increasing the cost of opposition proceedings, and also impacting 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, any parties who had initially requested a hearing 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.

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 conference, etc.). While we appreciate the disruptive impact of last-minute changes, the section suggests unnecessary inflexibility.

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.

In s. 65 and 66, for clarity and to avoid confusion, we recommend replacing the word “register” / “registered” with respect to a transfer to “record” / “recorded”.

Proceeding Under Section 45 of Act

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

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.

This provision is exceedingly difficult to understand, 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

Please see above under Oppositions for comments on service of documents and hearings. These comments apply equally to objection proceedings.

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.

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.

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.

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.

Reference to subsection 11.13(5.1) of the Act in ss. 84(2), 86(2), 92(3) and 92(6) appears to be a typo, since this section does not exist.

PART 2

Implementation of Madrid Protocol

General

Interpretation

96 The following definitions apply in this Part.

date of notification of territorial extension means the day on which the International Bureau notifies the Registrar of a request made under Article 3ter(1) or (2) of the Protocol. (*date de la notification d'extension territoriale*)

Is the date of "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.

opposition period means the two-month period referred to in subsection 38(1) of the Act. (*délai d'opposition*)

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.

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.

We appreciate that the heading for this section has been changed from “Entitlement” to “Qualification”. This change ensures that there will be no confusion between this provision and Section 16 of the Act, dealing with entitlement.

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.

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

Change in Ownership of International Registration

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.

Section 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 “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.

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

Non-Registrable Trademarks

Goods or services outside scope of international registration

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.

It bears repeating that s. 104 uses the words “non-registrable” in the heading and “not registrable” in the section itself, but 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 or not this raises a ground of opposition. It is recommended that 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.”

As noted above, the heading for s. 98 has been changed from “Entitlement” to “Qualification”, which ensures that there will be no confusion between this provision and Section 16 of the Act, dealing with entitlement. We recommend that comparable amendments be made to the heading and text of s. 104.

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.

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

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.

It seems 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.

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.

As noted above, this section appears to set an internal inconsistency about the term of the “opposition period”, which under s. 96 is defined as “the two-month period referred to in subsection 38(1) of the Act”, but can, under s. 1(2) and s. 125, be extended, (subject to s. 97(1)). We understand that the defined 2-month “opposition period” is used elsewhere in the Regulations (e.g. at s. 129) for the purposes of calculating timelines, but it is difficult to know how one would refer to the up to four month period referred to in s. 125 – perhaps there could be an additional defined term in s. 96, such as “extended opposition period”.

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.

This section is somewhat confusing with the reference to “opposition period”. Just so there is no confusion as to timing (in other words that “opposition period” here is not interpreted to include the up to four month extension of time available under s. 125, above), we recommend that “opposition period” be replaced with the wording “the two-month period referred to in subsection 38(1) of the Act”.

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;

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.

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 a deadline can have adverse consequences, the way in which deadlines are expressed needs more clarity. This comment applies to numerous sections of the Regulations.

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.

What is the impact of “moment” in this section? All other periods or terms are expressed by “on the day”, or “on the date”, whereas this section uses “at the moment”. Since the “moment” on which a cancellation or expungement occurs 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.

PART 3

Transitional Provisions, Repeal and Coming into Force

Transitional Provisions

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.

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 that 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.

Payment of fees is key to registration, and there should be no doubt as to what, or when a fee applies. 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. Just by way of example, it would be more straightforward to say that for any application filed before the coming-into-force date that includes the information set out in ss. 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 this provision.

The Regulations are inconsistent in the terminology used to identify provisions of the Act and Regulations. For example, above, the term “paragraphs” is used to refer to subsections of sections in the Act, whereas “subsections” 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...” are used. There should be more consistency in the use of paragraph and subsection.

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.

Since calculation of renewal dates is critical, and uncertainty and errors may lead to loss of rights, wording of any provisions relating to 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.

Absent some reference to the content of sections referred to (e.g. s. 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.
