



March 8, 2018

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

Email: ic.cipo-consultations-opic.ic@canada.ca

Dear Mr. Pierre,

Re: Canada Gazette Part I, Trademark Regulations published February 11, 2018

I am pleased to provide the following submissions on behalf of the Canadian Generic Pharmaceutical Association with respect to the draft amendments to the *Trademark Regulations* published February 11, 2018 in the Canada Gazette Part I (the “TM Regulations”).

As set out below, our concerns are specific to section 132 of the TM Regulations. As a preliminary matter, section 132(1)(d) is almost incomprehensible. Subsection 132(d)(ii) is particularly unclear and confusing. Rather than referring to various time periods, it would be helpful to refer to specific dates and provide for the earlier of the two dates.

The ability of parties to oppose a pending trademark application has been a key tenant under Canada’s *Trademark Act* for many years. The Canadian Generic Pharmaceutical Association has been engaged in a number of successful proceedings before the Trade-Mark Opposition Board (TMOB) over the years, and these oppositions have confirmed that the size, shape or color of a medicine is not distinctive to a specific company but instead readily identifies a type of medicine, which is not unique to a particular company.

The CGPA is concerned that the ability to effectively challenge a pending trademark application will be significantly reduced or eliminated altogether as a result of the current wording of section 132(1)(c) of the proposed regulations, unless significant corresponding changes are made to the processes and procedures of the Canadian Intellectual Property Office (CIPO). This is due to the timing of registrations for Madrid Protocol applications, and the time for opposing these registrations in Canada.

Currently, CIPO does not always advertise trademark applications within an 18-month period. Some applications have taken far longer to be advertised. Under proposed section 132(1)(c) the Registrar is obliged to register a trademark if 18 months have passed from the date of notification of territorial extension (i.e. the effective filing date in Canada) unless it sends a notification of the provision refusal (i.e. commencement of opposition proceedings) to the International Bureau within the 18-month period.

The CGPA is concerned that the 18-month period provided for in section 132(1)(c) of the TM Regulations may well pass before an application is advertised for opposition. In such a case the application as required under the Madrid Protocol must be registered, but the rights of another party to oppose the application would be removed, which is not a requirement under the Madrid Protocol.

To address this issue, CIPO will have to review and advertise applications under the Madrid Protocol within 15 months to allow time for oppositions. The CGPA is not confident that CIPO has the proper resources and procedures in place to meet this objective, and certainly not for all applications. An alternative or complementary approach would be for CIPO to have standing instructions to advise the International Bureau that it is likely that the domestic opposition period would extend beyond the 18-month period for all applications filed under the Madrid Protocol.

In addition, given the obligations of CIPO to advise the International Bureau regarding oppositions and the severe consequences if they do not, it is essential that the CIPO website is fully transparent in posting the dates of letters sent to the International Bureau with clear and easily apparent information relating to the trademark involved, the trademark application number and a commitment from CIPO that it will respond to reminder correspondence from third parties when the appropriate letters have not been sent.

In the interest of transparency, it would also be helpful to the public to post on the CIPO website a list of Madrid Protocol applications which have not been advertised within 15 months from the deemed filing date that may be easily reviewed by any concerned member of the public.

The ability to oppose is an important right granted under the *Trademarks Act* and should not be pre-empted or curtailed due to administrative delays at CIPO. Without having the ability to oppose due to the expiration of the 18-month period, parties would have to bring expungement proceedings in the Federal Court, which are significantly more expensive than opposition proceedings. In addition, the challenger bears the onus of invalidating the mark in an expungement proceeding, while under the opposition proceedings where the applicant bears the onus of proving the application complies with the *Trademarks Act*.

Thank-you for taking the time to review these important submissions of the Canadian Generic Pharmaceutical Association. We trust that CIPO will fully consider these submissions and take the necessary steps to address our concerns. The CGPA would

also welcome the opportunity to meet with you to discuss these important issues with you in greater detail

Sincerely,

A handwritten signature in cursive script that reads "Jody Cox".

Jody Cox
Vice President, Federal and International Affairs
Canadian Generic Pharmaceutical Association

Cc: Mark Schaan, Director General, Marketplace Policy Framework Branch, ISED
Martin Simard, Director of Copyright and Trade-mark Policy Directorate, ISED