



Innovation, Science and
Economic Development Canada
Canadian Intellectual Property Office

Innovation, Sciences et
Développement économique Canada
Office de la propriété intellectuelle du Canada

Canada

The Madrid Protocol in Canada

A Summary of the General Principles



Overview of the presentation

- Introduction
- The *Madrid Protocol*
 - Declarations to be made by Canada
 - Summary of the International Procedure
 - Application for International Registration
 - Territorial Extension to Canada
 - Managing an International Registration
- Next Steps
- Questions

Introduction



Introduction

Amendments to the *Trademarks Act and Regulations*

- Practice Notices
- Guides
- Web Content

Preparation in view of the Accession to the *Madrid Protocol*

- IT
- Training
- Communications
- Stakeholder Engagement

The *Madrid Protocol*



The *Madrid Protocol*

- What is it?
- Office of Origin vs Designated contracting Party
- Communication with the International Bureau of WIPO



Declarations made by Canada



Four (4) Accession Declarations

Article 5(2)(b) of the *Madrid Protocol*

Extension of the deadline from 12 to 18 months to send a total provisional refusal to the IB

Article 5(2)(c) of the *Madrid Protocol*

Allows Canada to send a provisional refusal based on opposition after the 18 month time limit



Four (4) Accession Declarations

Article 8(7)(a) of the *Madrid Protocol*

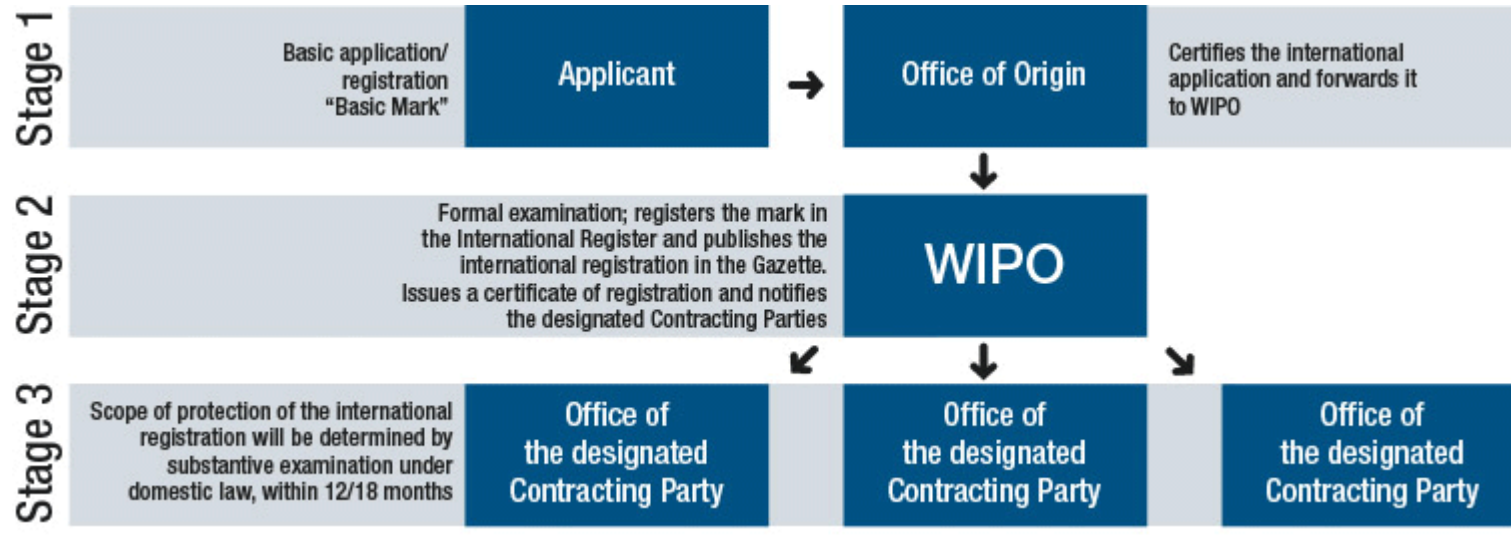
Allows Canada to charge individual fees when designated

Rule 20bis(6)(b) of the *Common Regulations*

Licenses recorded in the International Register have no effect in Canada

Summary of the International Procedure

The International Procedure



Source: WIPO

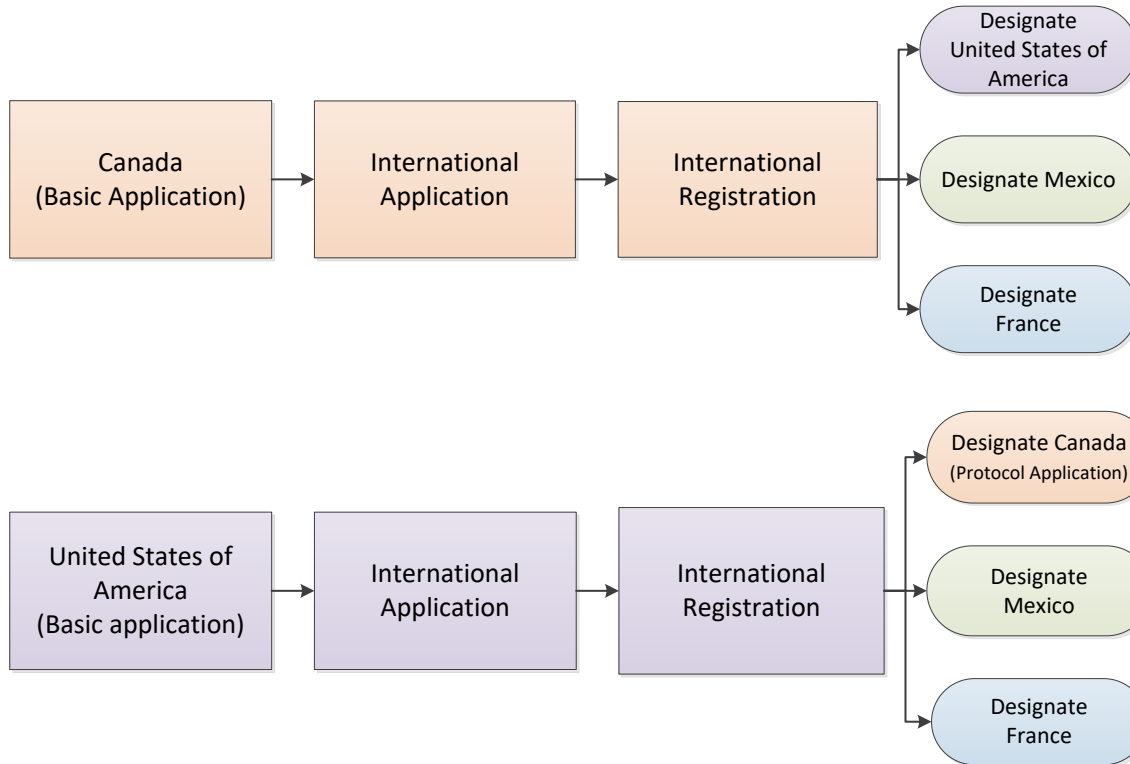


The Canadian Procedure

- New Definitions:
 - Basic Application
 - Basic Registration
 - Protocol Application
 - Protocol Registration



The Canadian Procedure



Application for International Registration

Applications for International Registration

The Office of the Registrar as Office of Origin

- MM2 Form - WIPO (Madrid eFiling)
- Fees
- Certification by the Registrar
 - Application for International Registration
 - Change in Ownership of the International Registration
- Five (5) Year Dependency Period



The International Procedure



Source: WIPO



Irregularities

- Notifications sent to the Applicant and CIPO
- Some Irregularities are remedied by CIPO
- Other Irregularities are remedied by the applicant
 - Directly with the International Bureau (i.e. missing \$\$)
 - Via CIPO (i.e. incorrect Nice Classification)

The International Procedure



Source: WIPO

Territorial Extension to Canada



Territorial Extension to Canada

Protocol Applications

- Initial Designation (*3ter(1)*)
- Subsequent Designation (*3ter(2)*)
- Filing fee per class applies (*Declaration under Article 8(7)(a) of the Madrid Protocol*)





Territorial Extension to Canada

Examination of the Protocol Application

- Filing Date
- Domestic/National Process Applies
- Canada's Official Languages Offer (if applicable)
- Courtesy letter to WIPO Representative (if applicable)
- Collective, Certification or Guarantee Marks
- At the tenth (10th) month from the notification of designation, a notification of possible opposition after 18 months will be sent to the IB if the application is not advertised (*Declaration under Article 5(2)(c) of the Protocol*)

Territorial Extension to Canada

Total Provisional Refusal

- Will be issued if the trademark is not registrable in Canada;
- Will be issued if certain requirements under the Trademarks Act or Regulations are not met; and
- Must be issued before eighteen (18) months from notification of designation from the IB. (*Declaration under Article 5(2)(b) of the Protocol*)





Territorial Extension to Canada

Divisional applications and Mergers

- As of February 1st 2019, the IB allows for the division/merger of an International Registration
- The divisional application or request for merger is sent to the Registrar who reviews the contents and forwards it to the IB
- The registrar updates the Canadian Trademarks Database/Register to reflect the division/merger of the IR only once confirmation is received from the IB

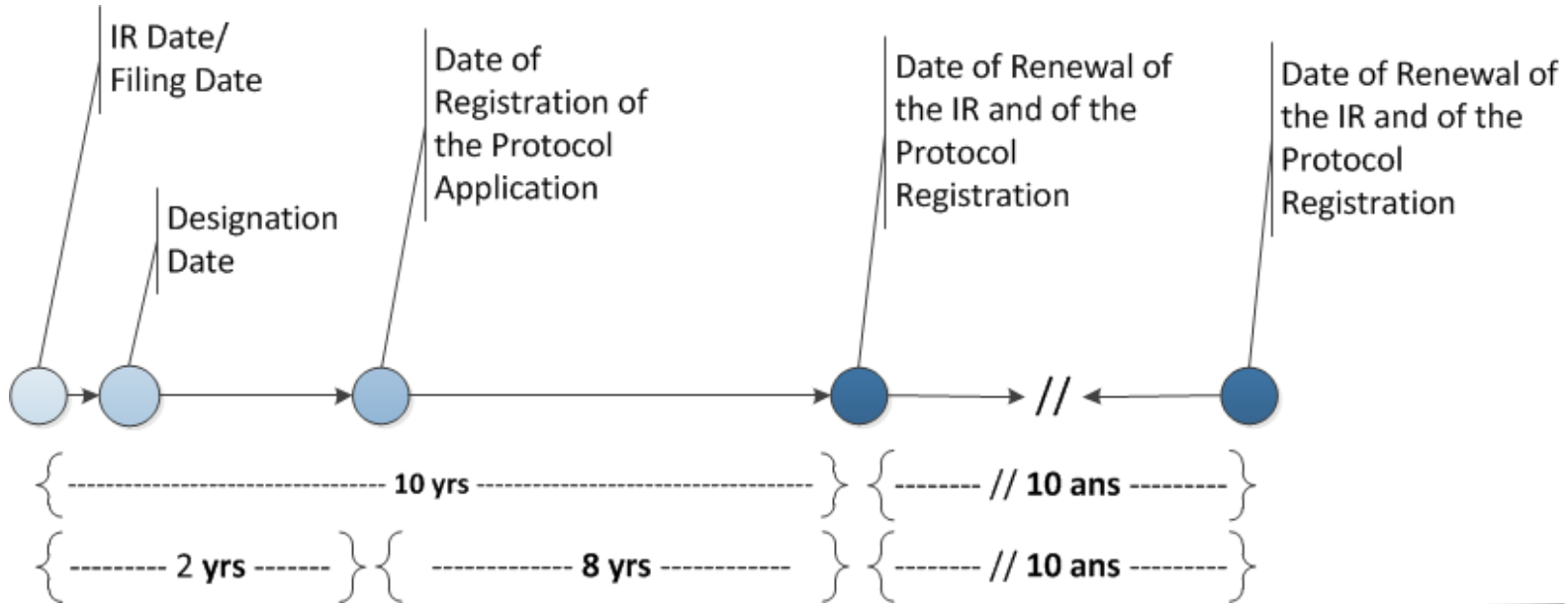


Territorial Extension to Canada

Registration

- Certificate
- Statement of Grant of Protection
- Protection period is ten (10) years from the date of the International Registration

Territorial Extension to Canada





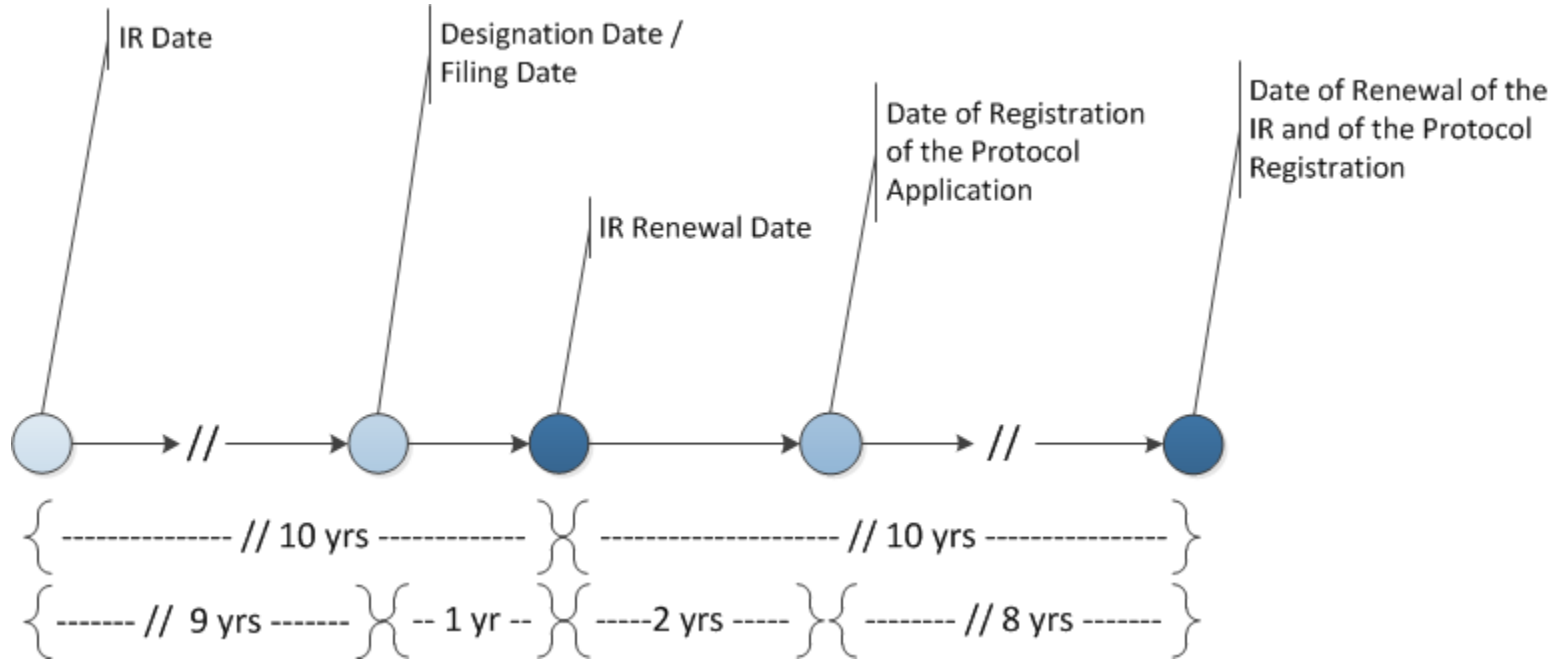
Territorial Extension to Canada

Renewal of the International Registration

- The International Bureau notifies the Registrar of the renewal of the International Registration
- For Protocol Applications - Notice of Renewal of the International Registration
- For Protocol Registrations - Certificate of Renewal



Territorial Extension to Canada





Territorial Extension to Canada

Amendments

- Limitations

A limitation consists of the removal of goods or services from the International Registration

- Effect on a Protocol Application
- Effect on a Protocol Registration





Territorial Extension to Canada

Amendments

- Renunciation

A renunciation is the equivalent of a domestic voluntary abandonment or voluntary cancellation. It concerns all of the goods or services but only for some (not all) of the designated Contracting Parties.

- Effect on a Protocol Application
- Effect on a Protocol Registration



Territorial Extension to Canada

Amendments

- Cancellation

A cancellation consists of the withdrawal of some (Partial Cancellation) or all (Total Cancellation) of the goods or services from the International Registration and concerns all of the designated Contracting Parties.

- Effect on a Protocol Application
- Effect on a Protocol Registration



Territorial Extension to Canada

Amendments

- Change in Ownership

When the IB notifies the Registrar of a change in ownership of an International Registration, the new owner information will be recorded in the Canadian Trademarks Database/Register

- Effect on a Protocol Application
- Effect on a Protocol Registration





Territorial Extension to Canada

Amendments

- Change in the owner's name and/or address

When the IB notifies CIPO of a change in the owner's name or address for a particular International Registration, CIPO will record the new owner's name/address in the Trademarks Database/Register

- Effect on a Protocol Application
- Effect on a Protocol Registration



Territorial Extension to Canada

- Recording of license agreements
 - Will be recorded in the Trademarks Database/Register
 - Licences recorded in the International Register have no legal effect in Canada (*Declaration under Rule 20bis(6)(b) of the Common Regulations*)



Corrections on Protocol Applications

Notification of Correction

- If not substantive → Registrar makes the correction
- If substantive and not advertised → Registrar will issue a Total Provisional Refusal
- If advertised + is substantive + affects **all** g/s:
 - Deemed never advertised + Total Provisional Refusal
- If advertised + is substantive + affects **some** g/s:
 - Option to delete g/s *or* deem never advertised
 - 2 months to respond or g/s deleted



Corrections on Protocol Registrations

Notification of Correction

- If protection can still be granted → Registrar makes the correction
- If protection can no longer be granted → Total/Partial Provisional Refusal depending if correction affects some or all g/s
 - Following response:
 - If protection can still be granted → Registrar makes the correction and Notifies IB
 - If protection can no longer be granted → Registrar amends register/cancels the Protocol Registration and notifies IB
 - 6 months to respond or Registrar amends register/cancels the Protocol Registration and notifies IB
 - Default provisions do not apply



Correction Request

- To request that a correction be made to the information recorded in the International Register:
 - Before nine (9) month deadline
 - IB has no deadline (*ex officio* corrections)





Irregularities

- As a Designated Contracting Party, an Irregularity Notification can be sent from the IB if the information sent to them is not considered acceptable.
- For example:
 - Incorrect form was used
 - Correct form was used but information is missing or not in the correct field
 - Deadline has expired for particular transaction



Transformation

- The International Registration was cancelled at the Office of Origin's request (Ceasing of Effect during five (5) year dependency period)
- The owner of the Protocol application or registration can request to transform into a domestic/national application/registration
 - Effect on Cancelled Protocol Application
 - Effect on Cancelled Protocol Registration



Replacement

- Request to take note of replacement of the national registration by the Protocol registration
 - Same owner
 - Same trademark
 - Some or all of the goods or services
- Remain on the Canadian Trademark Register
- Independent Registrations: Different renewal dates

Managing an International Registration



Managing an International Registration

- After registration - Independent of the Basic Application or Registration
- MM Forms (WIPO)
 - Sent directly to the IB (WIPO)
 - Not certified by the Registrar (except MM5)
- WIPO e-services
 - e-Subsequent Designation
 - e-Renewal

Managing an International Registration

- Fees (WIPO)
- Potential effect on protection obtained in some or all of the Designated Contracting Parties



Next Steps

Next Steps for the Trademarks Branch

- Finalize IT Solutions
 - Madrid eFiling
 - Administrative System (Intrepid)
 - Online Services
 - Amendment to Application e-service will be available for Protocol Applications
 - All other online services not available for Protocol Applications or Registrations





Next Steps for the Trademarks Branch

- Training
- Webinars
- Communications
- Stakeholder Engagement
- Website Content
 - Practice Notices
 - Guides
 - Other





Questions?



Thank you!

For more information, visit
www.cipo.gc.ca/tm and/or www.wipo.int



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Questions or Comments? Send us an email:
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