

From: [Morton, Jennifer \(Ext.\)](#)
To: [Goyette, Iyana \(ISED/ISDE\)](#); [Pierre, Mesmin \(ISED/ISDE\)](#)
Cc: [Carnegie, Shelagh](#); [Savoy, Martha](#); [Ciancone, Denise](#)
Subject: GowlingWLG Canada Response in the Consultation on the Draft - Request to Give Public Notice Under Section 9(4)
Date: August 29, 2022 12:12:35 PM

Attention:

Mme Iyana Goyette
Deputy Director Policy and Legislation
Trademarks and Industrial Design Branch
Canadian Intellectual Property Office

Re: The Response of GowlingWLG Canada to the Draft – Request to give public notice under subsection 9(4) of the *Trademarks Act*

Dear Madame Goyette,

Thank you for this opportunity to provide our comments on the Draft New Practice Notice under Section 9(4).

Gowling WLG is recognized as one of the leading trademark practices in Canada. We have been prosecuting and enforcing trademarks for more than 100 years which gives us a depth of experience and knowledge that few firms can match. We file more trademark applications than any other firm in the Canadian market and we manage in excess of 90,000 active trademark records including more than 1300 Section 9 mark entries. We represent multiple Public Authorities and have significant experience obtaining Section 9 mark rights and defending Public Authority status and [Section 9](#) rights in the Courts and in opposition proceedings. Conversely, we have significant experience dealing with the challenges Section 9 presents for third party applicants who encounter Section 9 rights as a block to advancement of their applications. Our experience as one of the most active users of the current trademark system gives us a unique perspective on the proposed practice changes.

We support this draft Practice Notice and the provision of a means to deal with Section 9 ‘deadwood’ to remove the blocks to advancement of stakeholder rights in appropriate circumstances and in an efficient manner. In particular, this practice notice answers the difficult circumstance where one cannot locate the Public Authority to obtain their consent because they no longer exist.

We have entered general comments under the paragraphs of the new Practice Notice. We also highlight directly below the key issues we identify for this new practice. The first issue is one that we appreciate will affect a small percentage of cases but for which the implications for the Public Authority are severe.

- 1) We understand that the Registrar’s notice to challenge Public Authority status is only likely to issue in circumstances where there is a strong belief based on the evidence and/or reasons filed by the requesting party that the public authority no longer exists or there is

doubt as to their current qualification as a public authority. For the sake of argument, if in 80% or more cases there is no response, in perhaps 20% or fewer cases the public authority may exist and the challenge to their status has significant implications for their entire portfolio of rights. A negative determination by CIPO on one Section 9 entry would have the theoretical impact of invalidating the entire portfolio of Section 9 rights of this owner, whether that initiative is through the Registrar's own actions in the "ex officio" paragraph in this draft or by implication. In our experience there are often fine issues to consider in the assessment as to Public Authority status, details to be gathered by and provided by the public authority to counsel and substantive explanations required to convey the issues to the Registrar. For this smaller percentage of cases where the public authority will be fighting to maintain their status, we wish to consider the following issues with you:

- In the scenario where the public authority exists but the particular Section 9 mark is of no interest to them, could there be a voluntary withdrawal option to save the public authority the potentially significant expense of a legal defence of their status simply because of the implications for the remainder of their rights? This would also save the Registrar the time involved in review of this assessment. The draft Practice Notice currently requires a response from the Public Authority even where the mark in issue may be of no interest. Should there be an option to voluntarily rescind or withdraw the particular Section 9 mark as a means to quickly and efficiently dispose of the proceeding.
 - The three month response period, followed by a possible three month extension based on exceptional circumstance is, we appreciate, purposeful and intended to expedite this consideration and not cause additional delay for trademark applicants seeking to remove these rights. This limited response time will be challenging for the 20% or fewer cases where the Public Authority seeks to defend its status. We support the addition of another Exceptional Circumstance in the Practice Notice for "The Public Authority intends to defend its status and requires the additional time to prepare a full response to the issued Notice" – similar in practice to the "substantive issue" reason in the Practice Notice on Extensions of Time in Examination.
 - We consider it appropriate that agents will have an opportunity for a second submission if, as a result of the first submission, the registrar remains unsatisfied that public authority status applies, perhaps with the restriction that any subsequent submission would need to introduce new arguments and evidence.
- 2) For decades, the only ability to challenge a Section 9 mark has been through the courts, which Public Authorities are accustomed to and which represents one of the significant benefits of Public Authority status. While we welcome this new change resulting from Bill C-86 and support this draft new practice notice, we believe it is reasonable to assume that public authorities will continue to operate on the now mistaken assumption that maintenance of these rights through changes of name and address updates is optional. Given the magnitude of the change, we consider that the registrar should issue notice of this intended practice change to all Section 9 mark owners to alert them to the difference in practice and to provide a period of time for these owners to:

- Update their address
- Appoint agents of record
- Record changes of name
- File a fresh Section 9 mark application if their circumstances may require it

In the interests of fairness, after decades of acquiescence, we believe Section 9 owners should be given a notice period before this practice takes effect

Through our firm and through the trademark associations in which we participate, we will assist in educating public authorities of the coming changes to assist the registrar in preparing this community for the significant implications of this new practice and the required maintenance of their rights.

We thank CIPO for the opportunity to provide our comments and your collaborative approach to new practices such as this one.

This submission has been made on behalf of **the National Practice Group for Trademarks of Gowling WLG (Canada) LLP.**

Draft – Request to give public notice under subsection 9(4) of the *Trademarks Act*

From: [Canadian Intellectual Property Office](#)

Publication Date: 202X-XX-XX

This notice is intended to clarify the practice of the Trademarks Office and the Registrar of Trademarks with respect to requesting that the Registrar give public notice under subsection 9(4) of the *Trademarks Act* ("the Act").

Overview

Subsection 9(4) of the *Act* provides that the Registrar may, on his or her own initiative or at the request of a person who pays the prescribed fee (the "requesting party"), give public notice that subparagraph 9(1)(n)(iii) of the *Act* does not apply with respect to a particular official mark. This notice may be given if the relevant entity (the "holder") that made the request under subparagraph 9(1)

(n)(iii) of the *Act* for the public notice is not a public authority or no longer exists.

We wish to confirm that “a person” may include the name of a firm of Agents and the disclosure of the client instigator is not required.

On receipt of a request and payment of the prescribed fee, the request and the relevant file will be reviewed. If the Registrar is satisfied that it is necessary to do so, a notice will be sent to the holder of the official mark requesting evidence of the holder's public authority status. See the practice notice entitled "[Official marks pursuant to subparagraph 9\(1\)\(n\)\(iii\)](#)" with respect to the evaluation of public authority status. If the Registrar is not so satisfied, a notice will not be sent to the holder of the official mark.

Communication procedures

Requests must be submitted in writing, by mail or fax, addressed as follows:

Request under subsection 9(4) of the *Trademarks Act*
c/o Deputy Director, Examination Division
Trademarks Office
Canadian Intellectual Property Office
50 Victoria Street
Gatineau, Quebec K1A 0C9

Fax: 819-953-2476

It would be beneficial at some future point have a link for these requests and the submission of evidence in reply from the Public Authority through CIPO's e-services portal.

Requests under subsection 9(4) of the *Act* will be placed on the relevant file. Receipt of requests will be indicated by a note "Request under subsection 9(4) of the Trademarks Act received on [YYYY/MM/DD]" on the action history page of the relevant official

mark on the Canadian Trademarks Database. If the Registrar determines that sending a notice to the holder of the official mark is not warranted, the Registrar will inform the requesting party by way of letter. If the Registrar sends a notice to the holder, the Registrar will inform both parties of the final assessment.

We note that the requesting party might not be made aware of the initiation of the proceeding until the “final assessment”. While the ‘Request’ is to be placed on the relevant file, will a copy of the notice issued by CIPO to the Public Authority be stored on the relevant Section 9 file?

Required information and fee

Requests under subsection 9(4) of the *Act* must identify the relevant official mark, including the file number and the name of the holder of the official mark. In addition, the requesting party should provide information or evidence demonstrating that the official mark holder is not a public authority or no longer exists.

Will it be sufficient to include relevant information and/or evidence by letter? We understand there is no stated format for the evidence or submission.

As the request does not create a proceeding between the holder of the official mark and the requesting party, any information provided by the holder will not be provided to the requesting party. Any additional information submitted by the requesting party after the request is submitted will be placed on the relevant file but will not be considered by the Registrar.

Will any response of the Public Authority be placed on the file history?

A request may not relate to more than one official mark.

In the circumstance that the request under subsection 9(4) is successful on the basis that the Public Authority no longer qualifies, the remaining rights of the Section 9 owner are implicated and at risk, either by virtue of the “ex officio” paragraph below or by inference.

Consider the circumstance where the Public Authority exists and still qualifies as a Public Authority but may not be interested in incurring the expense or effort to defend a particular Section 9 mark. In this case, could the Public authority withdraw the challenged Section 9 mark upfront to avoid the requirement to participate and/or the implications for all their other Section 9 rights. Rather than be forced to defend their status for brands of no importance to them, could there be a fast resolution option such as voluntary withdrawal so there are not compelled to defend their status.

A request under subsection 9(4) of the *Act* must be accompanied by the prescribed fee of \$XXX as set out in section XX of the *Trademarks Regulations* and Item XX of the Schedule to the *Regulations*.

The prescribed fee is for the request itself and is not dependent on the final outcome of the request.

We submit that this fee should be sufficient enough to prevent abuse of process. It is our view that this fee should be \$500, consistent with the fee to request Section 9 protection.

Reasons why the Registrar may not send a notice to the official mark holder

The Registrar determines on a case-by-case basis whether a notice to the official mark holder is necessary. Generally, a notice is not necessary in the following cases:

- the official mark holder has previously been requested to provide evidence as a result of a request that remains pending before the Registrar;
- the official mark was previously the subject of a request and the Registrar determined that the holder is a public authority in the one year period preceding the receipt date of the current request;
- the request is received within one year of the date of the Registrar giving public notice of adoption and use of the official mark under paragraph 9(1)(n)(iii) of the *Act*;
- the holder of the official mark is listed as Her Majesty the Queen in right of Canada or a province, including as represented by any current or previous department, agency, crown corporation or special operating agency;
- the holder of the official mark is listed as a municipal government entity; or
- the content of the request and the official mark file does not raise any doubt respecting the holder's public authority status or

its existence.

We support all of these circumstances for non-issuance of the Notice.

Notice to the official mark holder

If, after reviewing the request and the relevant file, the Registrar's initial assessment is that the holder is not a public authority or no longer exists, the Registrar will generally send a notice to the official mark holder requesting evidence of the holder's public authority status.

The Registrar will send the notice to the address of record of the holder or of the appointed trademark agent, if any.

The Registrar is not responsible for any correspondence not received by the holder or its appointed trademark agent in cases where the Registrar has not been notified of a change of address [see subsection 6(2) of the *Regulations*].

Timing

If a notice is sent to the official mark holder, they must reply **within three months** from the date of the notice with evidence of their status as a public authority.

Evidence of public authority status

The Registrar will apply the two-part test, adopted by the Federal Court of Appeal in *Ontario Association of Architects v. Association of Architectural Technologists of Ontario*, (2002), 19 C.P.R. (4th) 417 (F.C.A.); reversing (2000), 19 C.P.R. (4th) 417 (F.C.T.D.), to evaluate public authority status. The two-part test is made up of the following elements:

- a significant degree of control must be exercised by the appropriate government over the activities of the body; and
- the activities of the body must benefit the public.

For further information regarding the information required to assess public authority status, please refer to the practice notice entitled

"Official marks pursuant to subparagraph 9(1)(n)(iii)" as well as section 5 of the Trademarks Examination Manual.

Note that the Registrar will not require evidence of adoption and use of the official mark.

Extension of time

The Registrar may grant an extension of time to provide evidence of public authority status if the Registrar is satisfied that the facts justify the need for an extension of time.

As the intent is to provide an efficient and summary procedure for removing official mark protection, an extension of time for providing evidence will be granted only in exceptional circumstances and the Registrar will grant only **one** request for an extension of time up to a maximum period of three months. The following are examples of what the Registrar may consider exceptional circumstances justifying an extension of time.

Recent change in appointed trademark agent

If there has been a very recent change in appointed trademark agent and the agent requires more time to become familiar with the file.

Circumstances beyond the control of the person concerned

Examples include illness, accident, death, or other serious and unforeseen circumstances.

If the deadline has already passed, the Registrar may consider a request for a retroactive extension of time. Requests for a retroactive extension of time must include sufficient facts for the Registrar to determine that the failure of the holder to meet its deadline or apply for an extension within the time limit was not reasonably avoidable. The Registrar considers that there is no authority to grant a retroactive extension of time after the Registrar has given public notice that subparagraph 9(1)(n)(iii) of the *Act* does not apply with respect to the badge, crest, emblem or mark.

We support the addition of an Exceptional Circumstance relating to the Public authorities intention to prepare a full response to the challenge, similar in practice to the “substantive issue” circumstance in the Extensions of Time in Examination Practice Notice. For the small percentage of Public Authorities who will respond to this challenge, it is our experience that the more than the initial three months may be needed for the entity and its agent to prepare and file a full response.

Consequences for holder's failure to furnish evidence

If the holder does not respond or does not provide any evidence in response to the notice within the allotted time, the Registrar will generally give public notice that subparagraph 9(1)(n)(iii) of the *Act* does not apply with respect to the badge, crest, emblem or mark. Confirmation of the Registrar's final assessment of the request to give such public notice will be sent to the holder or their appointed trademark agent, if any. If such public notice is given by the Registrar, the status of the official mark on the Canadian Trademarks Database will be amended to read "inactivated".

Consequences of insufficient evidence of public authority status from the holder

If, after the holder provides evidence in response to the notice, the Registrar is still of the view that the holder is not a public authority or no longer exists, the Registrar will give public notice that subparagraph 9(1)(n)(iii) of the *Act* does not apply with respect to the badge, crest, emblem or mark. Confirmation of the Registrar's final assessment of the request to give such public notice will be sent to the holder or their appointed trademark agent, if any. If such public notice is given by the Registrar, the status of the official mark on the Canadian Trademarks Database will be amended to read "inactivated".

***Ex officio* Issuance of a notice by the Registrar to same holder**

If the holder does not respond to the notice, does not provide any evidence in response to the notice, or provides evidence in response to the notice and the Registrar is still of the view that the holder is not a public authority or no longer exists, the Registrar will send on his or her own initiative a notice to the holder requesting evidence of the holder's public authority status with respect to all official marks listing the same holder.

Final assessment of the request

The final assessment of the request will be communicated to the holder and the requesting party, or their appointed trademark agents, if any.

The Registrar will act in accordance with the final assessment as soon as administratively possible if no appeal or judicial review is taken, the Registrar will act in accordance with the final judgment, as the case may be

Jennifer Morton

Partner

T +1 416 862 5798

jennifer.morton@gowlingwlg.com

Gowling WLG (Canada) LLP
Suite 1600, 1 First Canadian Place
100 King Street West
Toronto ON M5X 1G5
Canada

gowlingwlg.com

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