



Intellectual Property Institute of Canada  
Institut de la propriété intellectuelle du Canada

# Intellectual Property Institute of Canada (IPIC) Trademark Committee: Comments on Official Mark Consultation

Submission to the  
Canadian Intellectual Property Office

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## INTRODUCTION

The Intellectual Property Institute of Canada (IPIC) is the professional association of patent agents, trademark agents and lawyers practicing in all areas of intellectual property law. Our membership totals over 1700 individuals, consisting of practitioners in law firms and agencies of all sizes, sole practitioners, in-house corporate intellectual property professionals, government personnel, and academics. Our members' clients include virtually all Canadian businesses, universities and other institutions that have an interest in intellectual property (e.g., patents, trademarks, copyrights, and industrial designs) in Canada or elsewhere, as well as foreign companies that hold intellectual property rights in Canada.

IPIC is pleased to respond to the request by the Canadian Intellectual Property Office (CIPO) for comments on a draft Practice Notice relating to the public notice which may be given under subsection 9(4) of the Trademarks Act (the "Act").

When in force, section 215 of Bill C-86 (2018) will amend the Act to add subsections 9(3) and 9(4) allowing the Registrar to give public notice that [pursuant to subsection 9(4)] subparagraph 9(1)(n)(iii) of that Act does not apply with respect to a badge, crest, emblem or mark that was the subject of a public notice of adoption and use as an official mark if the entity that made the request for the public notice is not a public authority or no longer exists. (*italics added*)

## SUMMARY OF RECOMMENDATIONS

**Purpose:** We understand that the Registrar is seeking a "simple and efficient mechanism" to reach its determination about public notice. As requested, we are seeking clarification of certain points and also making suggestions, but we are keeping in mind the Registrar's goal in this process. To the extent possible, we are following the same format as set out in the draft Practice Notice. Our questions or comments are noted in italics.

## OVERVIEW

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The Registrar on his or her own initiative or at the request of a person ("requesting party") who pays a prescribed fee may .....

*Who can be a requesting party, for example, an agent for a third party, as is currently sometimes the practice in s45 proceedings – will the third party have to be named?*

Upon receipt of a request and a payment, the .... file will be reviewed.....

*But it is also the information or evidence which must be received and considered. Should this be mentioned at this stage as the section is called “Overview”. Also, while we note it appears under “Required Information and fee”, would it be useful to stress in the “Overview” that this is not an inter-partes proceeding?*

This request relates to one official mark only.

*If the result is that the relevant entity (“holder”) is not a public authority or no longer exists, how does this impact the other official marks in the name of the holder. Does one have to file a request, pay a fee, and produce evidence or information for each mark? We do note the section dealing with ex officio notices (see below), but are unclear if this is a mandatory undertaking by the Registrar or permissive.*

## COMMUNICATION PROCEDURES

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We note that 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....

*Could requests also be made electronically, through the CIPO portal?*

The action history page for the relevant mark on the CIPO database is updated with details of the request.

*If the Registrar decides not to issue the notice, is the action page updated to indicate “closed”, similar to oppositions or s45 proceedings?*

*We understand that the action page will be updated to show “inactivated” if the final assessment determines that the holder is not a public authority or no longer exists. Will the decisions (final assessment) be made public, similar to Opposition Board decisions, or available only through obtaining file histories?*

## REQUIRED INFORMATION AND FEE

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The requesting party should provide information or evidence demonstrating that the official mark holder is not a public authority or no longer exists...

*What is the difference between “information” and “evidence” – what form does this information or evidence take – evidence suggests sworn statement. Is this necessary? Would photocopies of corporate records be acceptable, for example?*

*Perhaps it would be useful to emphasize that the evidence does not relate to current use or absence of use of the official mark. A similar statement is made in the last paragraph under the “Evidence of public authority status” section, but it may help to underline this as well here.*

Any additional evidence submitted by the requesting party will be put on the relevant file but will not be considered by the Registrar.

*The requesting party has only one opportunity to submit information or evidence, so this should be highlighted.*

The requesting party can obtain a copy of the response from the holder by ordering the file history. The Registrar only advises the requesting party in circumstances where a request is not warranted or where a final assessment issues.

A request must be accompanied by a prescribed fee of **\$XXX**.

*To discourage frivolous requests, we suggest that the prescribed fee for a request under subsection 9(4) should be the same as the prescribed fee to request public notice under paragraph 9(1)(n) or (n.1) of the Act (i.e. fee set out in item 6 of the Schedule to the Trademarks Regulations).*

## REASONS WHY THE REGISTRAR MAY NOT SEND A NOTICE TO THE OFFICIAL MARK HOLDER

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There are various instances where the Registrar may decline to send a notice, some of which are similar to those under section 45, such as when a request was made within the last 12 months.

Of those listed, one is where the holder is listed as a municipal government entity.

*What is a municipal government entity? In a different context, s. 9(1)(e) refers to a municipal corporation. Would “municipal government entity” cover an aboriginal band council or a “municipalité régionale de comté” (MRC or Regional County Municipality).*

Another listed instance is where 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.

*The reference to “the official mark file” suggests that the requesting party has not been able to file information or evidence to dispute the status of the holder as originally set out – is that what was indicated by this wording?*

*But, more importantly, what is the **threshold** for the information or evidence – is it to “raise a doubt” as mentioned in this last bullet point, or must it be convincing proof that the holder is not in existence or is no longer a public authority?*

## NOTICE TO THE OFFICIAL MARK HOLDER

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If... the Registrar will generally send a notice...

*What does the word “generally” mean? What are examples of instances where the Registrar will NOT send the notice, despite an initial assessment that the holder does not exist or is no longer a public authority?*

*We would ask that the first paragraph be revised to read that the Registrar will send a notice to the official mark holder **and** the appointed agent, if any....*

*Similarly, we would ask that the second paragraph be revised to read “The Registrar will send the notice to the address of record of the holder ~~or~~ and to the address of record of the appointed trademark agent, if any.”*

*Will the requesting party be informed of this notice?*

## **TIMING AND EXTENSION OF TIME**

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We understand that CIPPO’s goal to be as simple and efficient as possible, and to not further delay prosecution of applications held up by official marks which may be invalidated. The time frame seems reasonable, especially in light of certain exceptional circumstances for additional time. This underlines the importance for official mark holders to ensure their address information is updated.

*We wonder if the first paragraph should include the wording “There is no fee for this extension.”*

*In the case of a retroactive extension, we assume a fee is required.*

*We suggest one slight change to the last paragraph, last sentence, being “The Registrar considers that there is no authority to grant a retroactive extension of time after the Registrar has given public notice pursuant to subsection 9(4) of the Act, that subparagraph 9(1)(n)(iii) of the Act does not apply with respect to the badge, crest, emblem or mark.”*

## **EVIDENCE OF PUBLIC AUTHORITY STATUS**

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The holder is referred to the two-part test to establish public authority status, the Practice Notice, and the Examination Manual, and is reminded that this does not relate to establishing adoption and use of the official mark.

What is the form of the evidence that the holder must file? Is it by sworn affidavit or similar to the information originally required? We do not see any provision for copying the requesting party. Again, this is not inter partes, so does the requesting party have to order the public file, to obtain this information? ;

## CONSEQUENCES FOR HOLDER'S FAILURE TO FURNISH EVIDENCE

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If no evidence or no response is made, the Registrar will generally give public notice..."

*What does the word "generally" mean? What are examples of instances where the Registrar will NOT send the notice, despite the failure of the holder to respond. If "generally" is to remain, please provide an explanation for this wording.*

*As with other similar references, we would also revise the second sentence as follows:  
"Confirmation of the Registrar's final assessment of the request to give such public notice will be sent to the holder ~~or~~ and their appointed ~~trademark~~ agent, if any.*

## CONSEQUENCES OF INSUFFICIENT EVIDENCE OF PUBLIC AUTHORITY STATUS FROM THE HOLDER

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If, after review of the holder's evidence, the Registrar remains of the view that the holder no longer exists or is not a public authority, the Registrar will give notice that the mark is inactivated.

Does the Registrar inform the holder about the deficiencies in its evidence, similar to an office action, giving the holder an opportunity to file further evidence? Or is this similar to s45 proceedings where the Registrar decides on the evidence presented to him or her? If the latter is the case, should a sentence be added to say something similar to "The Registrar will assess the evidence as received and will not allow for the submission of additional evidence by the holder.".

We also suggest the same revision to the language about sending the notice to the holder and their appointed agent, if any.

## EX OFFICIO ISSUANCE OF A NOTICE BY THE REGISTRAR TO SAME HOLDER

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*Is it intended that in all cases where the Registrar believes that a holder no longer exists or is not a public authority, that the Registrar will give notice for all the other marks in the name of the same holder, thereby relieving requesting parties of the expense of having to do so? Or is this a case where the Registrar may do so? The use of “will” in the notice suggests it is mandatory.*

## FINAL ASSESSMENT OF THE REQUEST

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*As with other similar references, we would also revise the second sentence as follows: “The final assessment of the request will be communicated to the holder and the requesting party, ~~or~~ and their appointed ~~trademark~~ agents, if any.*

*Perhaps a word or punctuation is missing from the second paragraph, such as “The Registrar will act in accordance with the final assessment as soon as administratively possible if no appeal or judicial review is taken, otherwise, the Registrar will act in accordance with the final judgment, as the case may be.”*

*Can either party appeal the decision of the Registrar? Or, given this is not inter partes, only the holder and the Registrar can be parties to an appeal?*

We are available to discuss any of these points in more detail with CIPO, if this would be helpful.

## CONCLUSION

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Thank you again for the opportunity to comment on a draft Practice Notice relating to the public notice which may be given under subsection 9(4) of the Trademarks Act (the "Act"). We would be pleased to review any of these points in more detail with CIPO and look forward to future discussions on this initiative.

If we may be of further assistance, please do not hesitate to contact our CEO Adam Kingsley ([akingsley@ipic.ca](mailto:akingsley@ipic.ca)) at your convenience.