

**Submissions on**  
**Proposed Amendments to the**  
**Trade-marks Regulations 2014**

**Bereskin & Parr LLP**

- November 28, 2014 -

CONTACT: Cynthia Rowden, B.A., LL.B.  
PHONE: 416.957.1617  
FAX: 416.361.1398  
EMAIL: crowden@bereskinparr.com

Bereskin & Parr LLP  
Scotia Plaza, 40 King Street West, 40th Floor, Toronto, Ontario, Canada M5H 3Y2  
Tel: 416.364.7311 Fax: 416.361.1398 [www.bereskinparr.com](http://www.bereskinparr.com)

**TORONTO MISSISSAUGA WATERLOO MONTRÉAL**

## TABLE OF CONTENTS

Preliminary Remarks Regarding “Use” .....	5
Specific Recommendations .....	7
Voluntary Statements of Use .....	7
Proactive Use of Section 45 Proceedings to Address Abuse .....	7
PART 1 — EXAMINATION AND GENERAL PROVISIONS .....	9
Correspondence (points 1–14) .....	9
General comments .....	9
Specific comments .....	9
Trademark Agents (points 15–21) .....	12
Third Party Correspondence—TM Examination (point 22) .....	12
Address for Service (points 23–26) .....	13
General (points 27–29) .....	14
Advertisement of Applications (points 30–32) .....	15
Application for Registration/Application Requirements (points 33–36) .....	16
Representation or Description of the Trademark (points 37–41) .....	17
Standard Characters (points 42–43) .....	18
Single Colour or a Combination of Colours Without Delineated Contours (point 46) ..	18
Position (points 50–51) .....	18
Goods and Services (points 52–53) .....	19
Processing of Trademark Applications (point 54) .....	19
Nice – Registered Trademarks (point 55) .....	19
Divided Applications (points 56–57) .....	20
Merger of Divided Applications (points 58–59) .....	20
Amendments (points 60–63) .....	21
Renewal (points 68–69) .....	22
The Register (points 70–71) .....	23
PART 2 – IMPLEMENTATION OF THE MADRID PROTOCOL .....	25
General Comments .....	25
Application for International Registration (Rule 9(1) and (2) of the Common Regulations) (points 7–9) .....	26
Functions of the Registrar (points 10–17) .....	26
Irregularities – Rule 12 & 13 Common Regulations (point 18) .....	29

International Registrations Designating Canada (IRDC) (points 19–44).....	30
Examination of International Registrations Designating Canada (points 19–21) .....	30
Priority Claim of an IRDC (points 22–25).....	31
Grounds for Refusal (Rules 17(1), (2) and (3) Common Regulations) (point 26).....	32
Refusals (points 27–29).....	33
Notice to International Bureau (points 30–33) .....	33
Opposition (points 34–35).....	34
Extension of Time to Oppose (points 36–38).....	35
Counterstatement (point 39) .....	35
Evidence (points 40–41) .....	36
Transformation (points 49–53).....	36
General Comments .....	36
Specific Comments .....	37
Replacement (points 54–59).....	38
General Comments .....	38
Specific Comments .....	38
Change in Ownership of the International Registration (points 60–64).....	39
Divisionals (point 65) .....	40
<b>PART 3 – PROPOSED AMENDMENTS TO OPPOSITION AND SECTION 45</b>	
<b>SUMMARY CANCELLATION PROCEEDINGS</b> .....	41
General Comments.....	41
Correspondence – Opposition and Summary Cancellation Proceedings (points 1–2)	
.....	41
Service – Opposition and Summary Cancellation Proceedings (points 3–9) .....	42
Case Management – Opposition and Summary Cancellation Proceedings (points 10–	
11) .....	44
Opposition Proceedings (points 12–30).....	45
Evidence – Opposition Proceedings (points 12–14).....	45
Leave Provisions (points 15–16).....	46
Cross-Examination (points 17–21).....	47
General Comments .....	47
Specific Comments.....	47
Written Representations (points 22–24).....	48
Oral Hearings (points 25–29) .....	48
Geographical Indications (point 30).....	49

Section 45 Summary Cancellation Proceedings (points 31–37) .....	49
Written Representations (points 31–33).....	50
Hearings – Summary Cancellation Cases (points 34–37).....	50

*NOTE: Comments use the numbering in the Discussion Document. Comments on this Discussion Document ought not to be taken for approval of specific drafting language reflecting the matters discussed in the Document. That applies very specifically to the sections regarding implementation of the Madrid Protocol, where general ideas have been expressed, but interpretation will be subject to the exact language in the Regulations.*

## **PRELIMINARY REMARKS REGARDING “USE”**

In both the introductory remarks, and in the Background to the Discussion Document, the paper suggests that the amendments to the *Trademarks Act* (the “Act”) are “required” to permit Canada to accede to the *Singapore Treaty on the Law of Trademarks* (the “Singapore Treaty”), the *Protocol relating to the Madrid Agreement concerning the International Registration of Marks* (the “Madrid Protocol”), and the *Nice Agreement concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks* (the “Nice Agreement”) (collectively the “Treaties”). While this applies to some provisions, we note that this does not apply to *all* of the proposed provisions.

For example, Rule 7(2) of the Common Regulations of the Madrid Protocol *expressly permits* Contracting Parties to require a declaration of intention to use a mark, including a declaration filed by the applicant, if notification to this effect is made to WIPO. Article 3 of the Singapore Treaty *expressly permits* Contracting Parties to require that applications contain “a declaration of intention to use the mark, as required by the law of the Contracting Party” (Article 3(1)(a)(xvi)), or “a declaration of actual use of the mark and evidence to that effect, as required by the law of the Contracting Party” (Article 3(1)(b)) in addition to or instead of the declaration of intent to use. It is worth noting that Article 3(3) of the Singapore Treaty also *expressly permits* Contracting Parties to require evidence of actual use, where a declaration of intention to use has been filed under Article (1)(a)(xvi). Further, Article 5(1) allows Contracting Parties to require such declarations or declarations and evidence as a precondition to obtaining a filing date (Article 5(1)(a)(vi)), or to require such statements/documents at some point during the application process (Article 5(1)(b)).

Moreover, the Singapore Treaty clearly contemplates that a demonstration of use could be required as part of trademark registration renewals. Specifically, Article 13(b) provides that if there will be a renewal fee, the “Fees associated with the furnishing of a declaration and/or evidence of use shall not be regarded, for the purposes of this subparagraph, as payments required for the maintenance of the registration, and shall not be affected by this subparagraph.” This provision therefore implicitly permits Contracting Parties to require declarations/evidence of use as a matter of renewal. It should be noted that our major trading partner, the United States, is a member of the Singapore Treaty, and does require evidence of use both in the 6<sup>th</sup> year of registration, and upon renewal.

Many countries who are parties of the Madrid Protocol, such as the UK and other commonwealth countries—India, Ireland, New Zealand, and Singapore—require the applicant have an “intent to use” the trademark for both domestic applications and international registrations designating that country. Requiring an “intent to use” does not impose any particular hardship on a prospective international applicant: the form for International Applications available on the WIPO website already includes notification of what countries require applicants have an “intent to use” the mark as part of the “check the box” section where the applicant designates in what countries it seeks protection for the mark.

Accordingly, “use” information is permitted as part of the application process under the Treaties.

Although the amended *Trademarks Act* does remove the current “use” requirements, the wording of amended section 30(2)(d) provides that an application must include “any prescribed information or statement”. This wording therefore clearly permits the Regulations to establish additional requirements for applications not provided for in the Act. Accordingly, in our opinion, **the Regulations should be amended to permit information on proposed or actual use of a mark to be filed by applicants**, given the usefulness of “use” information to those who access the Register.

There are many ways the Government could incorporate the provision of “use” information into the Regulations. For example, applicants may elect to provide either a statement of use in Canada along with a date of first use, for any class or goods/services, or a statement of proposed use in Canada, at filing. If no statement of use is filed, then applicants could be deemed to have filed based on proposed use in Canada. If a statement of use is not filed originally, then applicants and registrants could file the statement of use at any time thereafter.

Moreover, recognizing both the usefulness of information about “use”, and the importance of having the Register reflect genuine, and not paper, rights, applicants and registrants could be “rewarded” for providing a statement of use in Canada. The Government has suggested that it would use section 45 cancellation proceedings as a means to control “abuse”. We submit that it is an abuse of the privileges of registration to allow any registrant to maintain rights beyond the 3<sup>rd</sup> anniversary of registration without any use in Canada. Actively using section 45 to require any registrant who has not filed a statement of use before the 3<sup>rd</sup> anniversary of the registration to demonstrate use of their mark would go a long way to ameliorating many of the problems identified by those who commented on the amendments to the Act.

Amendments permitting use information to be filed as part of the procedure associated with registration of trademarks, like those discussed above, would remedy the many problems posed by deleting use, as identified and set out in comments from trademark owners, experts, practitioners, industry groups and professional lawyer/practitioner organizations. Moreover, such amendments would preserve the status of Canadian

trademark applications and registrations as an international standard bearer for assessing genuine trademark rights.

## **SPECIFIC RECOMMENDATIONS**

### **Voluntary Statements of Use**

Any applicant or registrant may file a statement, in a form to be prescribed by the Registrar, of the date of first use in Canada for any specific goods and/or services set out in the application or the registration, as the case may be. Only one statement may be filed for any specific goods and/or services although additional statements may be filed for other goods and/or services set out in the application or registration. Under no circumstances can multiple statements be filed for the same goods and/or services. Such statement may be filed with the application, before advertisement, after registration and/or on renewal. The Registrar may, in the Registrar's discretion, in a form to be prescribed, require that each such statement be accompanied by a fee, but it is not expected that such statement would be subject to any examination by the Registrar. Once filed, the Register and the certificate of registration/renewal, if applicable, shall reflect the details of each such statement of use.

The regulations enacted under section 65(i) governing opposition proceedings would provide that any applicant or registrant who files one or more voluntary statement(s) of use in Canada of a trademark for any goods and/or services would be presumed to have used such trademark in Canada in association with such goods and/or services from the date(s) stated in any such statement for the purposes of determining entitlement under s.16 (1) of the *Act*, unless rebutted by any opposition evidence.

### **Proactive Use of Section 45 Proceedings to Address Abuse**

The Registrar shall, following the third anniversary of any registration, issue a notice to a registrant requiring it to file evidence of use of the registered trademark in Canada in association with the goods and/or services listed in such registration. In determining whether, and when, to issue such notice, the Registrar shall not send any such notice in respect of the goods and/or services for which any statement(s) of use has (have) been filed by the registrant within the preceding three year period.

To clarify, the intent of this proposed voluntary statement regime is to improve the usefulness of the Register for Canadian businesses and all others who search the Register by providing helpful information about trademark use in Canada. There is no intent to make *any* substantive change to s. 45 proceedings, except to forestall the commencement of Registrar-initiated proceedings in respect of particular goods and/or services for which a statement of use had been filed in the preceding three year period. The rebuttable presumption would only apply in opposition proceedings, and would not impact any proceedings relating to abandonment, expungement or enforcement.

With this in mind, the comments below, regarding proposals in the Discussion Document, have incorporated recommendations to permit information on use to be obtained, encouraged and maintained on the Register.



## **PART 1 — EXAMINATION AND GENERAL PROVISIONS**

---

### **CORRESPONDENCE (POINTS 1–14)**

#### **General Comments**

Confirmation of acceptance of electronic filing for all documents is welcome. Similarly, acceptance of commonly used addresses that may not have street numbers is also welcome.

#### **Specific Comments**

2. *Amend subsection 3(6) of the Regulations to replace the reference to the Trademarks Journal to reference the web site of the Canadian Intellectual Property Office. Correspondence addressed to the Registrar may be sent at any time by electronic or other means of transmission specified on the web site of the Canadian Intellectual Property Office*

**Clarify:** Whether CIPO will prominently display or provide guidance as to where on the CIPO website information formerly published in the Trademarks Journal will be available. Similarly, whether CIPO will prominently display or explain where the “other means of transmission” are located on the website. The CIPO website has recently changed, and concerns have been raised that it is difficult to locate specific information on the current website.

3. *Amend subsections 3(7) and 3(8) to comply with Rule 6(8) of the Singapore Regulations which, for electronic communications, provides that the date on which an Office receives the communication, shall constitute the date of receipt of the communication.*

**Clarify (I):** What impact will *dies non* have on the deemed date of receipt of a communication?

CIPO has consulted on this concept in the past, and responses have raised concerns about the impact of timing and *dies non* on receipt of documents. Furthermore, the provisions of current s. 66(2) of the *Trademarks Act* have not been amended, and continue to state that “*The Office of the Registrar of Trade-marks shall be closed for business on Saturdays and holidays and on such other days as the Minister by order declares that it shall be closed for business*”.

**Recommend (I):** That each of subsections 3(7) and 3(8) of the Regulations provide that the date on which an Office receives the communication shall constitute the date of receipt of the communication, if such communication was received on a date that the Office was open for business. If the Office was not open for business, such

correspondence shall be deemed to be received on the next day the Office is open for business.

**Clarify (II):** What impact will *dies non* have on the calculation of deadlines?

**Recommend (II):** The calculation of deadlines should not be impacted, and that, if the date of the deadline falls on a weekend or any other day that the Trademarks Office is closed for business, the deadline will continue to be the first day the Trademarks Office is open for business following such closure.

8. *Replace the current requirement in subsection 6(1) of the Regulations by providing that any address required to be furnished pursuant to the Act or these Regulations shall be sufficiently detailed to enable the Registrar to contact the addressee at that address and, in any case, consist of all the relevant administrative units up to, and including, the house or building number, if any. This amendment corresponds to Rule 2(2)(a) of the Singapore Regulations that permits an Office to regulate the form an address should take.*
9. *The information provided under paragraph 8 above relating to the applicant's address may, in accordance with Rule 2(2)(c) of the Singapore Regulations also contain any or all of the following:*
  - a. *A telephone number.*
  - b. *A fax number.*
  - c. *An email address.*

**Clarify:** Whether point 9 has been included to explain point 8, or whether it will form its own provision in the amended *Trademarks Regulations*.

10. *Delete paragraph 5(2)(e) because "representative for service" has been removed from the Act. Articles 3(1) and (4) of the Singapore Treaty do not permit Canada to maintain the representative for service requirements found in s.30(g) of the Act.*

**Clarify:** What impact removal of "representative for service" from the exception for the requirement for single correspondence will have on applicants who have appointed representative agents.

**Recommend:** Replace paragraph 5(2)(e) to allow the exception from the requirement for single correspondence to extend to changes to agent and agent addresses, since agents are still permitted to be appointed under the amended *Trademarks Act*.

12. *Amend subsection 6(2) to provide that as soon as practicable, applicants and other persons doing business before the Office of the Registrar of Trademarks, including registered owners and parties to proceedings under section 38 and 45, and any appointed trademark agent must notify the Registrar of all changes of address. If the Registrar has not been notified of a change of address, the Registrar is not responsible for any correspondence not received. Remove the reference to "representative for service".*

**Clarify:** The impact of stating that the parties “must” notify the Registrar of all changes of address is not clear.

**Recommend:** After “any appointed trademark agent”, add “who is notified of any change of address”.

13. *Amend subsection 7(1) to provide that communications to the Registrar in respect of an application for the registration of a trademark shall include:*
- a. the name of the applicant; and*
  - b. the application number, if one has been assigned and is known.*

AND

14. *Amend subsection 7(2) to provide that communications to the Registrar in respect of a registered trademark shall include:*
- a. the name of the registered owner; and*
  - b. the registration number.*

**Recommend:** The requirement to identify the trademark should be maintained. Omitting the trademark will add inconvenience and time to trademark owners and their agents when attempting to connect correspondence with the right file. In addition, it is easy to make clerical errors when typing numbers, and errors in numbers lead to inconvenience and time in trying to identify a file, when the combination of a trademark, application number/registration number will simplify quick identification of correct files. We assume this issue of time and convenience would apply to the Trademarks Office as well.

### **What Could be Added**

The Trademarks Office itself should be encouraged to communicate electronically with users— applicants, registrants and parties in opposition/non-use proceedings. Such parties should have a mechanism for indicating their desire for all correspondence to be received from the Office electronically, and that the Office will in turn accept their electronic communications. In addition, the Office should adopt the practice widely followed in the United States of telephone communications by examiners regarding minor examination issues, with confirmation, by email, that necessary amendments will be dealt with as a priority if responses are made promptly. This will resolve many

delays in prosecution.

## **TRADEMARK AGENTS (POINTS 15–21)**

16. *Amend section 8(2) to provide that the Registrar must receive notice in writing that an applicant, opponent, registered owner, requesting party or any other person who is doing business before the Office of the Registrar of Trade-marks has appointed a trademark agent. This notice may come from the agent itself and does not require a signed power of attorney from the applicant, opponent, registered owner, requesting party or any other person who is doing business before the Office of the Registrar of Trade-marks. Subject to the scope of the trademark agent's authority, an agent may act for the agent's principal in any proceeding or take any step on that principal's behalf.*

**Clarify (I):** Whether a separate letter to the Registrar is required per mark for any mark of such applicant, opponent, registered owner, requesting party, or other person.

**Clarify (II):** Whether such notice may be in any correspondence relating to an application, opposition, or s. 45 proceeding, or whether a separate communication is required.

21. *Add a new provision to provide that despite the above provisions with respect to the appointment of a trademark agent, that any person may pay a registration or renewal fee.*

### **General Comment**

This change will most certainly result in increased opportunities for fraud. Canadian registrants are already subject to “scams” by companies in Canada and around the world who offer to take unnecessary steps, often for considerable sums of money. Such companies are not easy to locate, and it is difficult for any party seeking recourse for improper conduct to succeed.

**Recommend:** To reduce this risk, we recommend that any entity wishing to renew a mark, apart from the registrant or its appointed agent, must first register with CIPO and provide their name, full contact information, and an address for service in Canada.

## **THIRD PARTY CORRESPONDENCE—TM EXAMINATION (POINT 22)**

22. *Add a new provision to allow the Registrar to receive correspondence from a third party other than the applicant any time before advertisement. A person who files such correspondence must explain the pertinence of the document – such pertinence pertaining to the registrability of the*

*applied for trademark. The acceptance of such correspondence will not result in the commencement of inter partes proceedings, and will only be accepted after an application has received a filing date but before it is advertised (see section 34.1 of the Patent Act). The Registrar will forward a copy of any such correspondence which it determines to be pertinent to the applicant.*

**Clarify:** This concept is welcome, but further clarification is sought in respect of the following:

- (1) What will “pertinent” mean?;
- (2) Confirm that this is not a substitute for examination by the Trademarks Office;
- (3) What is the impact of both the third party correspondence and the step of forwarding a copy of such correspondence to the applicant? Is the intent merely to permit owners of other marks to be ensured that the TMO will have considered the impact of registrability and entitlement issues? Applicants should not have to respond to both the Registrar’s correspondence and that of third parties; and
- (4) That the Trademarks Office will forward all third party correspondence to the applicant.

**Recommend (I):** That the “pertinence” of the correspondence relate to any ground for refusing registration of the applied-for trademark under section 37 of the *Trademarks Act*.

**Recommend (II):** That if the Registrar determines the correspondence is pertinent, the Registrar will, in accordance with section 37, notify the applicant of the Registrar’s objections and reasons for those objections by way of an Examiner’s Report or cause the application to be advertised.

## **ADDRESS FOR SERVICE (POINTS 23–26)**

25. *The Registrar **may** require an address for service in Canada be provided for the purposes of any procedure before the Office of the Registrar of Trade-marks, of an applicant and others including the registered owner of a trademark and parties to the proceedings under sections 38 and 45, in all business before the Office of the Registrar of Trademarks who:*
- a. *does not have an agent with a Canadian address; and*
  - b. *the applicant, registered owner or others including parties to the proceedings under sections 38 and 45, has not provided the Registrar with the address of its principal office or place of business in Canada (Paragraph 4(2)(b) of the Singapore Treaty)*

**Recommend:** Given the importance of service rules in Canada, it is recommended that “may” above be replaced with “shall”. Attempting to contact and serve documents on

persons outside of Canada can be time-consuming, expensive, and the results uncertain. Requiring a Canadian contact address, most ideally that of a Canadian agent who can be easily identified, found, and contacted, is preferred.

26. *Where the applicant, registered owner or others including parties to the proceedings under sections 38 and 45 does not provide the Registrar with an address for service upon request, or where such person fails to keep such address up to date, they will no longer be served with documents in relation to their application, registration or ongoing proceeding under section 38 or 45 of the Act.*

#### **General Comment (I)**

Is it permissible, in accordance with administrative law, for any tribunal to simply decide to no longer “serve” documents upon a party, for any reason?

**Recommend (I):** To make a decision that documents will no longer be “served” on a party, the test should be that mail properly served is returned, and that the Registrar has made at least some attempt to contact the party by using other mail resources, not that an address has not been “kept up to date”.

#### **General Comment (II)**

The comment that “*they will no longer be served*” would appear to include service not only by the Registrar, but also by other parties to the proceeding. At which point could a party decide that an applicant, registered owner or other has not kept an address up to date? What if the party in question knew the actual address of the opposite party, but despite that, the opposite party had not kept its recorded address in the Trademarks Office up to date.

**Recommend (II):** This proposal be reviewed to address the specter of parties deciding to punish each other for failure to keep addresses up to date, and the consequences in additional time, appeals, judicial reviews etc.

### **GENERAL (POINTS 27–29)**

29. *Amend section 14 to provide that:*

*(a) The Registrar will refuse to take cognizance of any document submitted to the Registrar that is not in the English or French language unless a translation of the document into one of those languages is submitted to the Registrar*

**Clarify:** Whether CIPO would accept any translation of a document into English or French, or whether a certified translation will be required.

*(b) An application for the registration of a trademark must, with the exception of the trademark, be entirely either in English or in French.*

**Clarify (I):** Presumably an address need not be in English or French. For example, presumably Via Roma for an address in Italy need not be translated. Similarly, it is common for applicant names to include some local indication of corporate status.

**Recommend (I):** The provision should provide that this requirement does not apply to local addresses, to the extent that such addresses refers to locally used street or other geographic names, nor to any part of the applicant name.

**Clarify (II):** The requirement that the application be “*entirely either in English or in French*” suggests that an application for registration cannot be submitted in English and French, but rather must be entirely in one language or the other. This may create a problem where an application is filed by an entity that corresponds with CIPO in English, but transferred to an entity doing business in French. Further, should an application to extend a statement of goods/services be filed, this provision would appear to preclude such an application from being filed in the other official language.

**Recommend (II):** The provision be amended to allow the application to be “in English or French”.

*(c) If an affidavit or statutory declaration submitted to the Registrar is not an original affidavit or statutory declaration, the original shall be retained by the person who submitted the affidavit or statutory declaration for one year after the expiry of all appeal periods and the original shall be submitted to the Registrar upon request.*

**Clarify (I):** How will CIPO ensure that an original of an affidavit of statutory declaration submitted to the Registrar be retained by the party for the requisite amount of time.

**Clarify (II):** What enforcement action can CIPO take to ensure the documents are retained, and what penalties would be imposed if the documents are not retained according to this provision.

**Clarify (III):** Whether any enforcement action with respect to this provision would take into account uncontrollable circumstances leading to the loss of the original document, such as fire, flood, natural disaster, etc.

## **ADVERTISEMENT OF APPLICATIONS (POINTS 30–32)**

31. *Amend section 16 to provide that the advertisement of an application must contain:*

1. *The representation, description or both of the trademark;*

2. *The name and address of the applicant and the applicant's trademark agent, if any;*
3. *The application number;*
4. *The filing date of the application and priority date, if any;*
5. *The names of the goods or services, 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;*
6. *In the case of an application for a certification trademark or a trademark consisting of standard characters, a note to that effect;*
7. *The particulars of any translation or transliteration; and*
8. *In the case of evidence of acquired distinctiveness and/or the particulars of the territorial restriction, a note to that effect.*

**Recommend (I):** That “2. *The name and addresses of the applicant and the applicant's trademark agent, if any*”, refer to the applicant's current name, address, and trademark agent, as set out above in our previous comments.

**Recommend (II):** That this section should be amended to add:

*“5. Such information regarding the date of first use in Canada for any Class of goods or services, or any specific goods or services, or any statement of proposed use that the applicant, pursuant to these Regulation, elects to provide.”*

The remaining items should be renumbered accordingly.

## **APPLICATION FOR REGISTRATION/APPLICATION REQUIREMENTS (POINTS 33–36)**

### **General Comments**

Amended s. 30 of the Act permits, “(d) any prescribed information or statement”. As described above in our comments, we recommend adding a new provision to this section that any applicant may provide a statement that its mark has been used in Canada, with the date of first use, with any Class of goods and services, or any goods and services within any Class, or that the applicant proposes to use its mark in Canada.

25. *Repeal section 25 because the filing date requirements are now in section 33 of the Act.*

**Clarify:** Removal of section 25 of the *Regulations*, in light of changes to section 33 of the *Trademarks Act*, results in the potential for a filing date problem, which arises from



the language in section 33(1)(f) (“any prescribed fees”). If the fees consultation to come yields any type of “per class” filing fee arrangement, which would be aligned with “international norms”, then any underpayment of class fees could be seen to result in no filing date. This has ramifications for priority and section 16 entitlement assessments. Further, an Office practice of accepting the initial fee remitted at the time of filing, and then a later “top up”, might well be seen as contrary to the *Trademarks Act*, similar to what occurred in respect of patents in *Dutch Industries Ltd* (2003 FCA 121).

## REPRESENTATION OR DESCRIPTION OF THE TRADEMARK (POINTS 37–41)

38. *Create a new provision to provide that the representation or description of the trademark must be capable of being legibly reproduced for the purposes of advertisement (section 37 of the Act) and shall not include any matter that is not part of the trademark. Where the representation of the trademark is not suitable for reproduction in the Trademarks Journal, the Registrar may require an applicant to submit a new representation.*

**Clarify:** How will this impact the common practice of showing the placement of a trademark on an object—e.g., a dotted outline of a bottle, with a comment that the “bottle does not form part of the trademark”? Being able to show how the mark is displayed is helpful to the examiner, and also to others who review the Register.

**Recommend:** This should not apply to matter that is included in a representation or description for the purpose of explaining the features of the mark, including the placement of a mark on any goods where the description of the mark includes a statement that “the portion of the drawing shown in dotted outline does not form part of the mark” or a similar statement.

### What Could be Added

No directions are given, either as to possible requirements, or to possible specimens, or to future requirements on the website for marks that consist of taste, scent or texture.

39. *Create a new provision to provide that any or all (up to 6) visual, pictorial or graphic (hereinafter referred to as “graphic”) representation of the trademark must be no larger than 8cm X 8cm.*

**Clarify (I):** Whether the 8cm x 8cm limit will apply to graphic representations of non-traditional marks, such as sound marks, given that at that size, musical notations depicting the sound mark would be difficult to read.

**Recommend (I):** Provide that graphic representations of sound marks consisting of musical notation may exceed the 8cm x 8cm limit.

**Clarify (II):** Whether the 8cm x 8cm limit will apply to each individual representation, or

to all of the representations together.

## **STANDARD CHARACTERS (POINTS 42–43)**

42. *For the purposes of subparagraph 31(a) of the Act the list of standard characters adopted by the Registrar will appear, as amended from time to time, on the web site of the Canadian Intellectual Property Office.*

**Clarify:** What will the “list of standard characters” include? For example, will Latin letters, Latin letters with French accents, and French or English punctuation marks be included?

43. *Where a graphic representation is required, an application for a trademark that is not in standard characters may contain a representation that consists of more than one (1) view of the trademark, where that is required to clearly define the sign, but in no case more than six (6) views.*

**Clarify (I):** This comment is found under “standard characters”, but actually applies to marks that are not in standard characters.

**Clarify (II):** What is a “view”, and how will it apply to non-traditional marks such as moving images or holograms?

## **SINGLE COLOUR OR A COMBINATION OF COLOURS WITHOUT DELINEATED CONTOURS (POINT 46)**

46. *An application for the registration of a trademark that consists exclusively of a single colour or a combination of colours without delineated contours must indicate the name of the colour or colours and contain a graphic representation showing the colour or colours. The applicant may include a reference to an internationally recognized colour system for each colour. (Rule 3(2) of the Singapore Regulations).*

**Clarify:** What is a “graphic representation” of a colour?

**Recommend:** If colours, *per se*, are now permissible, it should be confirmed that the “graphic representation” is merely a sample of the colour, and not a representation of the colour applied to any particular object.

## **POSITION (POINTS 50–51)**

50. *An application for the registration of a trademark consisting of a position*

*must contain a graphic representation clearly showing the placement of the trademark.*

**Clarify:** This point appears to be in conflict with point 38, above, which prohibits matter that is not part of the trademark from inclusion in the representation of that mark.

## **GOODS AND SERVICES (POINTS 52–53)**

52. *Add a new provision to provide that the goods and/or services must, as far as practicable, be specified in terms appearing in any listing of goods and services that is published by the Registrar via the Canadian Intellectual Property Office web site.*

**Clarify:** What is the meaning of “as far as practicable”.

53. *Add a new provision to provide that goods and/or services not appearing in any listing of goods and services that are published by the Registrar must be defined in a manner that is clear, accurate and precise.*

**Clarify:** What is the meaning of “clear, accurate and precise”, and how is it to be reconciled with the need for the description to be in “ordinary commercial terms”?

## **PROCESSING OF TRADEMARK APPLICATIONS (POINT 54)**

54. *Create a new provision to provide that the prescribed period under section 36 of the Act, where the applicant is in default of the prosecution of an application, will be 2 months. (Rule 9 of the Singapore Regulations)*

**Clarify (I):** Whether this section will apply to all applications, including those processed pursuant to the Madrid Protocol. If so, 2 months may prove to be too short a term.

**Clarify (II):** Whether for applications noted in default, the prescribed 2 month period will run from the issuance of a default notice, or whether it will run from the date of default itself, unbeknownst to the applicant.

## **NICE – REGISTERED TRADEMARKS (POINT 55)**

55. *Create a new provision to provide that the prescribed time for the purposes of subsection 44.1(1) of the Act, the prescribed time in which the Registered Owner will be required to submit its statement of goods or services grouped and classed will be within one year of the date of the notice.*

**Clarify:** What will be the consequence of a failure to comply with point 55 within the one year period from the date of notice, and what impact an objection to a Registered Owner's classification of the goods/services will have on the one year period.

### **DIVIDED APPLICATIONS (POINTS 56–57)**

56. ....if a request for an extension of time to oppose or a statement of opposition has been filed, a statement from any opponent that the opposition will be withdrawn for the classes, goods or services divided out;

**Recommend:** The suggested “statement from any opponent” should be removed. A statement from an opponent that the opposition will be withdrawn for the classes, goods and/or services should not be a precondition for acceptance of a divisional application. For example, an applicant may wish to delete classes, goods and/or services through unilateral action, regardless of whether an opponent will withdraw the opposition—which, in some instances, might encourage later resolutions. Moreover, a prospective opponent may not be prepared to withdraw the oppositions simply because a divisional application is filed.

### **MERGER OF DIVIDED APPLICATIONS (POINTS 58–59)**

**General Comments:** The provisions address merger of registrations issuing from divided applications. The title for points 58 and 59 appear to be a misnomer. The title of this section should be amended to “Merger of Registrations Issuing from Divided Applications”.

58. Create a new provision to provide that a request to merge a registration should be in writing and contain the following information ...
59. Create a new provision to provide that the Registrar may merge the registrations only if
- (a) the trademarks are the same;
  - (b) stand in the name of the same Registered Owner; and
  - (c) are classified according to the same edition of the Nice Classification

**Clarify:** Whether CIPO will make available the different editions of the Nice Classifications on the CIPO website.

#### **What Could be Added (I)**

The mark itself should be included in the list of information to be provided in a request to merge a registration. This would address the possibility of clerical errors in writing the registration numbers, and would also help CIPO verify that the marks are, in fact, the same.

### **What Could be Added (II)**

Which edition of the Nice Classification has been used to classify the goods and services should also be included in the list of information to be provided in a request to merge a registration. This would allow CIPO to easily verify whether the requirements at point 59 are met.

### **AMENDMENTS (POINTS 60–63)**

61. *Amend section 31 of the Regulations to provide that no application for the registration of a trademark may be amended where the amendment would change,*
- a. *the identity of the applicant, except after recognition of a transfer by the Registrar or to correct an error in the naming of the applicant;*
  - b. *the trademark, unless the trademark remains substantially the same;*
  - c. *the statement of goods or services so as to be broader than the statement of goods or services contained in the application at the time the application was filed.*

**Clarify:** How does the “*substantially the same*” test relate to the “*alter its distinctive character*” test with respect to changes to a trademark.

62. *Amend section 32 of the Regulations to provide that no application for the registration of a trademark may be amended, after it has been advertised to change:*
- a. *the identity of the applicant, except after recognition of a transfer by the Registrar or to correct an error in the naming of the applicant;*
  - b. *the trademark, unless the trademark remains substantially the same;*
  - c. *the statement of goods or services so as to be broader than the statement of goods or services contained in the application at the time of advertisement.*

**Clarify:** While flexibility in amending marks is desirable, permitting marks to be amended after advertisement has the potential to frustrate agreements reached by parties during opposition. Further, an opponent or prospective opponent may be prejudiced by an amendment to a mark, even one that results in the mark remaining “substantially the same”.

**Recommend:** More information is required on what will be viewed as “substantially the same”. If an opposition has been filed, prior notice to the opponent of any amendment

to the opposed trademark should be a precondition for amendment until the trademark has issued to registration.

### **What Could be Added**

The interaction between these provisions and the Madrid Protocol must be considered. Once a Canadian applicant files an International Application (under the Madrid Protocol), and that International Application results in an International Registration, the mark cannot be amended in any way (see Guide to the International Registration of Marks Under the Madrid Agreement and the Madrid Protocol, BII 72.02). Similarly, a change in the goods and services will impact not only the IR but all applications to extend.

### **RENEWAL (POINTS 68-69)**

68. *Create a provision to provide that the prescribed period referred to in subsection 46(1) of the Act, will be 12 months beginning 6 months before the initial renewal period expires. (Rule 8 of the Singapore Regulations).*

The amended *Act* states:

*46. (1) Subject to any other provision of this Act, the registration of a trademark is on the register for an initial period of 10 years beginning on the day of the registration and for subsequent renewal periods of 10 years if, for each renewal, the prescribed renewal fee is paid within the prescribed period.*

**Clarify:** The reference to “12 months beginning 6 months before” appears to convey the idea that renewals can be done only 6 months in advance, and for 6 months following the expiry of the 10 year term. Restricting renewal to only six months before the expiry of the term is unnecessarily restrictive. Many companies plan for and budget their renewals well in advance of the renewal term, and to restrict renewals to only 6 months in advance is too short.

**Recommend (I):** Amend the provision to allow renewal up to a year in advance, and with 6 month grace period. Rule 8 of the *Singapore Regulations* only requires that the Contracting Party allow the renewal fee to be paid “*at least 6 months before*” the renewal is due and at least up to 6 months after that date. As such, the *Singapore Regulations* would permit a longer renewal period that begins 12 months before the renewal date. The impact of this will be to shorten the currently applied-grace period, but to still comply with the *Singapore Regulations*. Presumably, the notice of non-renewal will now advise of the 6 month term, now calculated from the actual renewal deadline versus the date of the Trademarks Office letter.

**Recommend (II):** The Trademarks Office should send the notice of non-renewal as soon as possible, given the shorter term from the date of the notice.

69. *Create a provision to provide that all trademark registrations must be renewed electronically through the online services available on CIPO's web site.*

**Clarify:** Will this pose an inconvenience for small self-represented registrants?

### **What Could be Added**

As discussed above, the Singapore Treaty clearly suggests that making a declaration of use or evidence of use voluntary, upon renewal, is not prohibited. This, added to a voluntary declaration of use/proof of use on application, goes a long way to address the many problems identified by trademark owners, experts and practitioners arising from a “useless” Act.

## **THE REGISTER (POINTS 70–71)**

### **GENERAL COMMENTS**

As discussed in our comments above, information respecting “use” on the register is an invaluable source of information for prospective applicants. We recommend that provisions be added to this section to ensure that all current information regarding use or the declaration of use filing date be preserved on the Register.

Similarly, we recommend that provisions be added to ensure current information regarding any limitations relating to disclaimers or s. 12(2)/14 claims, geographic limitations, and consents also be maintained on the Register.

### **SPECIFIC COMMENTS**

70. *Repeal section 51 of the Regulations as “summary of an application” has been removed from paragraph 26(2)(b).*

**Clarify:** The amended Act only changes section 26 to the extent that a provision is added after subsection 26(2)(e) to provide for a listing of the goods and services grouped according to the Nice Classification. Section 26(2)(b) remains intact. Consequently, it appears a “summary of the application” is still required and section 51 does not need to be repealed.

71. *Amend s. 52 of the Regulations to indicate, in respect of each registered trademark....*
- (b) The name and address of the applicant and of the applicant's trademark agent, if any; ...*
  - (f) In the case of a registration for a certification trademark or a trademark consisting of standard characters, a note to that*

*effect; ...*

- (h) *In the case of evidence of acquired distinctiveness and/or territorial restriction, a note to that effect.*

**Clarify (I):** Respecting point 71(b) — given that trademark registrations can be assigned, there is a risk that only including the name of the “applicant” and the “applicant’s trademark agent” would mean the Register would not reflect the true ownership status of the registration.

**Recommend (I):** Respecting point 71(b)—the Register should also include the name and address of the registrant, and its trademark agent.

**Clarify (II):** Respecting point 71(f)—will all details of the certification also be available?

**Clarify (III):** Respecting point 71(h)—as above, will all details filed during prosecution relating to acquired distinctiveness remain available?

**What Could be Added**

Since, as noted above, information on use/evidence of use is permitted under the Singapore Treaty, this provision should also be amended to add “(i) Any information provided by the applicant or registrant with respect to the date of first use or use in Canada, for any Class of goods and services or any goods or services.”



## **PART 2 – IMPLEMENTATION OF THE MADRID PROTOCOL**

The *Madrid Protocol* prescribes what Contracting Parties must, may, and cannot do when participating in the international trademark registration system. The following comments focus on the interaction between current Canadian procedures and any steps that appear to be voluntary, or for which a choice is given under the *Madrid Protocol*.

### **GENERAL COMMENTS**

One point of some national discretion permitted by the *Madrid Protocol* is fees per class, and since this consultation does not address fees, the impact and usefulness of the Madrid Protocol to Canadian and other trademark owners cannot be fully addressed.

### **Use**

The *Madrid Protocol* contemplates that Contracting Parties can require declarations of intention to use (see Rule 7 of the Common Regulations for the specifics). In such instances, the Rules require the Contracting Party notify the Director General of the declaration of use requirement and the language in which the declaration must be made, if required to be in English, French, or Spanish. The Director General must also be notified where the Contracting Party requires the declaration be made on a separate form annexed to the international application and signed by the applicant (which, for Canada, should not be necessary).

As discussed above, “use” is central to the current Canadian trademark regime, and implementation of the treaties, including *Madrid Protocol*, do not require removal of such requirements. Rule 7 of the *Madrid Protocol* Common Regulations demonstrates that retaining some form of use requirement for applicants using the *Madrid Protocol*—i.e., requiring a declaration of intention to use at filing—is not overly burdensome: what is required under the Common Regulations is that notification be given to the Director General.

Clearly requiring a declaration of intention to use a mark at filing will also protect applicants using the *Madrid Protocol* from the impact of opposition. The amendments to the *Act* include a ground of opposition that “at the filing date of the application ... the applicant was not using and did not propose to use the trademark”. Without knowledge of that ground of opposition, many applicants for an International Registration Designating Canada (IRDC) could be vulnerable to challenge on that basis. It would be preferable to clearly require applicants to state at the time of filing that they intend to use their marks in Canada, rather than to be surprised by an opposition challenging the application on that basis later on.

**Recommend:** Given the historic importance of use as a basis for trademark rights in Canada, the strong views of trademark owners, experts, and practitioners already expressed regarding the importance of use, and to ensure that all applicants for IRDCs

are aware, on making the request to extend rights to Canada, of the requirement that all applicants have used or propose to use the trademark, that Canada maintain a requirement for a declaration of intent to use or a statement of use in commerce, where appropriate, for all applicants using the Madrid Protocol to acquire rights in Canada.

## **APPLICATION FOR INTERNATIONAL REGISTRATION (RULE 9(1) AND (2) OF THE COMMON REGULATIONS) (POINTS 7–9)**

7. *An application for international registration shall: ...*  
d. *Be accompanied by the certification fee (if any) set out in the Tariff of Fees*

**Background:** The certification fee is the fee charged by the Originating Office (OO) to ensure that the International Application (IA) both reflects the national application and meets the requirements of the *Protocol*. It is a fee that will be kept by the OO, and not submitted to the International Bureau (IB). Article 8, permits the OO to fix and collect “for its own benefit, a fee which it may require from the applicant for international registration or from the holder of the international registration in connection with the filing of the international application or the renewal of the international registration.”

**Recommend:** Obviously, since Fees are not part of the current consultation, it is difficult to comment effectively on this. However, it is **recommended** that the “certification fee” be in line with amounts collected in other jurisdictions. For example, the United States certification fee is \$100 per class, if the IA is based on a single United States application or registration, and \$150 per class if the IA is based on multiple US applications.

8. *For the purposes of paragraph 7(a) above, the application shall be filed with the Registrar of Trademarks by using the online application service that may be accessed through the Canadian Intellectual Property Office’s website (if available).*

**Recommend:** While electronic filing is likely to be more convenient for both applicants and the Registrar, recommend that paper filing be permitted, as is the case in the United States.

## **FUNCTIONS OF THE REGISTRAR (POINTS 10–17)**

11. *The Registrar shall:*  
a. *review the international application; and*  
b. *certify that the information in the international application corresponds with the information held by the Registrar in respect of the basic application or the basic registration, as the case requires.*

**Clarify:** What information in the international application must correspond with the information in respect of the basic application/registration. There may be instances where the information in the basic application does not correspond with information in the international application, but may not impact the validity of the international application, for example, a priority date.

12. *If the international application results in an international registration, the Registrar shall notify the International Bureau if the basic application or the basic registration is withdrawn, limited, cancelled, abandoned, expunged, rejected, expires or otherwise ceases to have effect in respect of some or all of the goods or services listed in the international registration, ...*  
*a. within 5 years after the date of the international registration;...*

**Background:** This provision relates to the “dependency” of the international registration (IR) on the basic application or registration of the applicant in the applicant’s home country.

**Clarify:** Whether the obligation to notify the IB will occur upon the expiry of any appeal period relating to the decision or impact of withdrawal, limitation, cancellation abandonment, expungement, rejection, expiry, or otherwise, and that the 5 year period refers to the period after the date of the IR.

13. *Where the review of the international application reveals any irregularities, .... the Registrar shall notify the applicant and require that the applicant submit the outstanding items within the date specified in the Registrar’s notice in order to ensure the application is sent to WIPO within 2 months.*
14. *If there are no irregularities or if any irregularities are remedied ...., the Registrar shall take all reasonable steps to ensure that the application is received by the International Bureau within two months from the date the Registrar received the request (pursuant to paragraph 7.)*
15. *If the irregularities are not remedied within a six month period, the Registrar shall refuse to forward the international application to the International Bureau and the international application is deemed never to have been filed.*

**Background:** The 2 month term appears to originate with Article 3(4) of the *Madrid Protocol*, which assigns a date to the IR that is the date the Office of Origin (OO) received the international application (IA). To take advantage of this, however, the Article requires the International Bureau (IB) receive the IA within 2 months. Otherwise, the IR will be the date the IA was received by the IB.

**Clarify:** In combination, points 13–15 appear to impose on the Trademarks Office a two (2) month timeline in which to examine the application, issue a notice of irregularities to the applicant/agent, receive and consider a response/amendment to the form, approve any changes, and submit the approved application to the IB. While it has been suggested that the Registrar will use “all reasonable efforts” to ensure the two (2) month timeline is honoured, that is no comfort to an applicant whose application is submitted to the IB after the two (2) month deadline expired, despite the Registrar’s based efforts.

**Confirm:** Points 13–15 suggest:

- (1) The TMO will need to dedicate resources to processing IAs;
- (2) All correspondence between IA applicants/agents will need to be sent electronically, and with very clear notations of deadlines and the impact of missed deadlines;
- (3) Care will need to be taken to clearly indicate the difference between the 2 month term to file with the IB and the 6 month term to respond to an office action; and
- (4) This may lead to a 2 track system, with all other applications not receiving the same immediate attention.

**Recommend:** The Registrar should confirm that regular applicants, who have the same need for speedy service, will not suffer any delays as a result of redirected resources to process IAs and IRDCs, particularly since IRDCs may be a small percentage of the overall filings in Canada.

13. *Where the review of the international application reveals any irregularities, including ....*

- c. *the representation of the trademark which is subject to the international application is not identical to the trademark as appearing in the basic application or basic registration ...*

**Clarify:** As described above, proposed amendments to sections 31 and 32 of the *Trademarks Regulations* will allow changes to be made to a trademark after application and after advertisement, provided the mark remains substantially the same; however, point 13(c) of the proposed amendments relating to implementation of the *Madrid Protocol* requires the trademark in the IA be *identical* to the mark appearing in the basic application/registration. Presumably if an IA is prepared and certified, and subsequently, the mark in the basic application is amended in any way, the Protocol provisions will result in the loss of rights to protect that amended mark pursuant to the *Madrid Protocol*.

**Recommend:** Include in the General Provisions of the *Trademarks Regulations* provisions specifying that an application for which there is a corresponding IA or IR may not be amended.

13. *Where the review of the international application reveals any irregularities,*

*including ....*

*h. the prescribed fee is missing or insufficient...*

**Clarify (I):** That point 13(h) applies to the Registrar's "certification fee" described in point 7(d) of the Discussion Document and/or a fee payable to the Registrar for submitting the IA to the IB (pursuant to Article 8(1) of the *Madrid Protocol*), and not the fees payable to the IB. (Article 8 of the *Madrid Protocol*).

**Recommend (I):** Clarify that the "prescribed fee" means the Registrar's "certification fee", and not any other fee payable to CIPO.

**Clarify (II):** The list in point 13 does not currently include the name of the applicant's representative as a potential "irregularity". The appointment of such representatives can be made in the International Application (IA) (Rule 3(2)(a) of the Common Regulations). The *Madrid Protocol* Common Regulations provide for communication regarding the IA or IR to also be to the representative, and deems such communication as having the same effect as one addressed to the applicant or holder of an IA or IR.

**Recommend (II):** The proposed Regulations should be amended to include "the name and address of the applicant's representative, if any".

*17. Any fees payable to the International Bureau under the Madrid Protocol shall be paid directly by the applicant to the International Bureau.*

**Clarify:** There are a series of fees payable to the IB, including a "basic fee", the "supplementary fees" payable per class, and the complementary fee and/or individual fee for extensions to other countries. Rule 35 of the Common Regulations requires all payments due to the IB be made in Swiss currency (francs). The Rules further presume an account will be set up with the IB to facilitate such payment.

**Recommend:** The Registrar should make it as easy as possible for applicants to pay all fees and should at least assist both with the calculation of fees and the payment of fees. The *Madrid Protocol* and Common Regulations specifically permit the Office of a Contracting Party to pay all fees on behalf of an applicant (Rule 34(2)). Since it is the Registrar who submits the IA to the IB, it would certainly be easier for applicants, especially for self-represented applicants, to request the Registrar to submit the required IB fees with the IA, and for the Registrar to forward such fees, at the very least until all involved parties (the Trademarks Office, and applicants and their agents) become familiar with the procedure.

## **IRREGULARITIES – RULE 12 & 13 COMMON REGULATIONS (POINT 18)**

*18. Any response to the International Bureau with respect to irregularities is to be provided directly by the applicant to the International Bureau, except*

*that, a response to an International Bureau irregularity notice relating to the classification or specification of goods or services is to be developed by the applicant but shall be approved by the Registrar and sent to the International Bureau by the Registrar.*

**Clarify:** Rule 12 of the Common Regulations states that any issues regarding classification must be dealt with within 3 months, and any implication on fee payment is also time-limited.

**Recommend (I):** The applicant must be fully informed of the implications of the amendments to classification and/or specification on goods or services so the applicant may ensure that appropriate fees are paid in a timely manner.

**Recommend (II):** Any reference to “applicant” as in the above provision should be amended to also refer to the applicant’s representative, if any.

## **INTERNATIONAL REGISTRATIONS DESIGNATING CANADA (IRDC) (POINTS 19–44)**

### **GENERAL COMMENTS**

The basic premise of the *Madrid Protocol* is that once the application to extend the protection of the International Registration (IR) is communicated to the national office members, the application will be treated as a national application. No special examination of such applications is required.

**Recommend:** To ensure that all registrants seeking the benefits of registration in Canada meet the same minimum requirements in respect of having actually used or actually intended to use the trademark in Canada, and in keeping with the desire to maintain a use-based registration system, requiring the previously mentioned declaration of intent to use is recommended.

## **EXAMINATION OF INTERNATIONAL REGISTRATIONS DESIGNATING CANADA (POINTS 19–21)**

19. *An IRDC that the International Bureau transmits to the Registrar is deemed to be filed in accordance with section 30 of the Trademarks Act*  
...

**Clarify (I):** Section 30 of the *Act* as amended requires persons filing trademark applications be “using or propose to use” and be “entitled to use” the applied-for trademark in Canada, that the application contain a statement of the goods and services to which the application pertains “in ordinary commercial terms”, that the representation of the applied-for mark permits the mark to be clearly defined and comply with the prescribed requirements, and classify the applied-for goods and services according to

the Nice Classification. The amended grounds of opposition listed in section 38 of the *Act* make compliance with the above section 30 filing requirements challengeable. Deeming IRDCs to automatically comply with section 30 effectively removes these very important grounds of opposition.

**Clarify (II):** Whether because IRDCs are deemed to automatically comply with section 30, such applications will not be subject to examination for technical adherence to the *Trademarks Act* including proper specification/classification of goods and services, which will result in inconsistencies and discriminate against all regularly filed trademark applications that would be subject to opposition on grounds relating to section 30 of the *Trademarks Act*.

**Recommend:** Remove the provision deeming all IRDCs to comply with section 30. Removing such a deeming provision is not inconsistent with the *Madrid Protocol*, since nothing in the *Madrid Protocol* or Common Regulations requires such treatment of IRDCs. Furthermore, examining IRDCs for compliance with section 30, including whether the goods/services are stated in ordinary commercial terms, will ensure consistency on the Canadian Trademarks Register as to acceptable descriptions of goods and services, and will ensure registrations issuing from IRDCs truly reflect to what goods and/or services the trademark pertains.

20. *An IRDC shall be examined as an application for registration, and if on such examination there is no basis on which to refuse protection, the Registrar shall cause the trademark to be published in accordance with section 37 of the Act*

**Clarify:** Applications for registration are examined both for substantive compliance with the *Trademarks Act* (i.e., sections 12 and 16) and for technical compliance with the filing requirements established in section 30. Point 19 of the Discussion Document, however, provides that IRDCs will not be subject to examination under section 30, with which they will be deemed in automatic compliance. Points 19 and 20 thus appear to be in conflict.

**Recommend:** Confirm that IRDCs will be subject to the same scrutiny and examination process as domestic applications, including examination for compliance with the section 30 requirements.

## **PRIORITY CLAIM OF AN IRDC (POINTS 22–25)**

23. *For the purposes of section 16(1)(a) of the Act, "filing date" in that section means the earlier of:*

- a. *The international registration date, if the request for extension of protection was filed with the international application;*

- b. *The date of recording of the request for extension of protection, if the request for extension of protection was made after the international registration date; and*
- c. *The date of priority claimed pursuant to paragraph 25 below.*

**Clarify:** It is assumed in each case above that the “request for extension” will only apply to a request for extension to Canada. Please confirm in the Regulations that this is the case.

25. *The holder of an international registration with a request for extension of protection to Canada is entitled to claim priority within the meaning of Article 4 of the Paris Convention for the Protection of Industrial Property if*  
...

*(b) the date of international registration or the date of the recordal of the request for extension of protection to Canada is not later than 6 months after the date of the first regular national filing (within the meaning of Article 4(A)(3) of the Paris Convention for the Protection of Industrial Property) or a subsequent application (within the meaning of Article 4(C)(4) of the Paris Convention for the Protection of Industrial Property).*

**Clarify:** What would be considered a “subsequent application” and what would be the ramifications flowing from such an application.

## **GROUND FOR REFUSAL (RULES 17(1), (2) AND (3) COMMON REGULATIONS) (POINT 26)**

26. *If the Registrar considers that the (requirements for registration – ensure all of section 37 of the Act applies) are not met, or are met only in relation to some of the goods or services in respect of which protection in Canada has been requested, the Registrar shall,*
- a. *Give notification of a provisional refusal of the international registration to the International Bureau; and*
  - b. *Specify in the notification a period within which the holder may respond.*

**Clarify:** Given the time limits applicable to an IRDC, whether the “period within which the holder may respond” will be standardized, and if so, what would be the length of such a period.



## REFUSALS (POINTS 27–29)

27. *If, an IRDC is refused, the Registrar shall declare in a notification of refusal that the extension of protection cannot be granted, together with a statement of all grounds on which the refusal is based.*

**Clarify:** Whether the decision of the Registrar to refuse an IRDC would be appealable to the Federal Court, since IRDCs are “deemed to be an application for registration in Canada” under point 19, above, and refusal of an IRDC is a decision of the Registrar.

## NOTICE TO INTERNATIONAL BUREAU (POINTS 30–33)

30. *Within 18 months after the date on which the International Bureau transmits to the Registrar an IRDC, the Registrar shall transmit to the International Bureau any of the following that applies to such request:*
- a. A notification of refusal based on an examination of the IRDC.*
  - b. A notification of refusal based on the filing of an opposition to the IRDC.*
  - c. A notification of the possibility that an opposition to the IRDC may be filed after the end of that 18-month period.*

**Clarify:** That point 30(a) includes a refusal based on abandonment of the application.

31. *If the Registrar has sent a notification of the possibility of opposition under paragraph 30(c), the Registrar shall, if applicable, transmit to the International Bureau a notification of refusal on the basis of the opposition, together with a statement of all the grounds for the opposition, within 7 months after the beginning of the opposition period or within 1 month after the end of the opposition period, whichever is earlier.*

**Clarify (I):** This provision applies only to notification of “grounds” of opposition.

**Clarify (II):** In what cases, will “if applicable” apply?

**Anticipated Effect (I):** The timing limitations in this section appear, as noted in the Discussion Document under “Opposition”, to prevent the use of the maximum 9 month cooling off extension before filing of a statement of opposition. That should encourage parties to actually proceed with a statement of opposition, as opposed to using all available time to pursue settlement. Practically, this may result in more filed oppositions (as is, for example, the case in Europe).

**Anticipated Effect (II):** The shortened time limits also would appear to prevent parties from amending the grounds of opposition at any time after the described term of the

earliest of “7 months after the beginning of the opposition period or within 1 month after the end of the opposition period”. Since opposition grounds are often amended after evidence or cross-examination, such a limitation would seem to unfairly prejudice IRDC applicants.

**Anticipated Effect (III):** A few other limitations are noted in a January 2012 paper on the *Madrid Protocol* on the CIPO website, written by Alan Troicuk (“*Legal and Technical Implications of Canadian Adherence to the Madrid Protocol*”), namely:

S.39(3) CTMA might also need modification since it would not be possible to withdraw an application from allowance to consider a missed request for an extension of time to file a statement of opposition more than seven months after the date of advertisement; as well, a withdrawal from allowance would probably not be possible once the IB has been notified that the opposition period expired without an opposition having been filed. In addition, some restrictions would need to apply in respect of the grant under subsection 47(2) CTMA of retroactive extensions of time to file a statement of opposition.

32. *If a notification specified in paragraph 30(a) or (b) is not sent to the International Bureau within the time period with respect to a request for extension of protection, the IRDC shall not be refused and the Registrar shall issue a certificate of grant of protection*

**Clarify (I):** Section 41(3) and (4) of the amended *Trademarks Act* provide the Registrar with the power to correct errors on the Register within a certain period of time following registration, including removal of a registration. Presumably, these provisions should also provide the Registrar with the power to correct an administrative error resulting in notification not being sent to the International Bureau.

**Recommend (I):** That the Registrar retain the power provided by Sections 41(3) and (4) of the amended *Trademarks Act* in respect of IRDCs.

**Clarify (II):** Whether a proceeding commenced in Federal Court would be required to correct that error, should the Registrar not retain that power.

## **OPPOSITION (POINTS 34–35)**

### **GENERAL COMMENTS**

**Clarify:** As soon as an opposition is filed, presumably the Registrar will transmit the notification of the opposition to the applicant or its designated representative.

**Recommend:** To ensure that the opponent does not have to serve any documents internationally, the applicant should be required to either appoint a Canadian agent, or indicate a Canadian address for service, once the notice of opposition is transmitted to the applicant, if the applicant has not done so already.

#### **SPECIFIC COMMENTS**

34. *A person who opposes (the Opponent) an IRDC, may file with the Registrar of Trade-marks a statement of opposition within 2 months after the advertisement of the IRDC.*

**Clarify:** Whether an opponent may request an extension of time to file a statement of opposition, given the restricted timelines for IRDCs.

35. *The statement of opposition shall be filed with the Registrar of Trade-marks by using the online service that may be accessed through the Canadian Intellectual Property Office's website (if available)*

**Clarify:** Whether paper or other means of filing statements of opposition will be allowed as a general matter or only when CIPO's website is unavailable, as the wording of the provision suggests that the electronic filing will be required "if available".

**Recommend:** Specify the means of filing statement of opposition allowed should the online service not be available.

#### **EXTENSION OF TIME TO OPPOSE (POINTS 36–38)**

**Clarify:** With respect to the comments at part 3, point 1, below, it is unclear when the opponent must begin to copy the applicant on all correspondence with CIPO (i.e., only after the statement of opposition has been filed and forwarded by CIPO, or if the applicant must be copied beginning after a request for an extension of time to oppose has been filed, in such cases).

#### **COUNTERSTATEMENT (POINT 39)**

39. *For greater certainty, a holder of an international registration to whom a statement of opposition has been sent shall file and serve a counterstatement within 2 months of the date of the refusal based on opposition and in the manner prescribed in the Trade-marks Regulations. If the holder fails to comply with this requirement in relation to any goods or services in respect of which protection is opposed:*

- a. *The Registrar will treat the holder's request for protection in Canada in respect of those goods or services as withdrawn; and*
- b. *The Registrar's refusal will be confirmed to the International Bureau in respect of those goods or services.*

**Clarify (I):** Will extensions to file a counterstatement be permitted?

**Clarify (II):** It is assumed that the provisions relating to a “counterstatement” in amended s. 38 of the Trademarks Act will apply to opposition proceedings to IRDCs. Is this assumption correct?

### **EVIDENCE (POINTS 40–41)**

- 40. *If the applicant does not file evidence or a statement that the application does not wish to file evidence within four months after the expiry of the time for submitting opponent's evidence or statement, the Registrar will confirm the refusal for the opposed goods and services to the International Bureau.*
- 41. *If the opponent does not file evidence or a statement that the opponent does not wish to file evidence within four months after the expiry of the time for filing the counter statement, the Registrar will send a statement to the International Bureau to the effect that protection is granted in Canada for the opposed goods and services and issue a certificate of protection.*

**Note:** It appears that paragraphs 40 and 41 ought to be reversed, as the Opponent submits evidence or a statement that no evidence will be filed first.

**Clarify (I):** Will extensions of time be permitted?

#### **What Could be Added**

There are no provisions in the Discussion Document for written arguments or hearings. Will the regular provisions for oppositions at this stage apply?

### **TRANSFORMATION (POINTS 49–53)**

#### **GENERAL COMMENTS**

This section requires a review of both Article 6 of the *Madrid Protocol* (relating to “dependence” of the International Registration (IR) and all related rights on the basic application for that mark for a period of 5 years following the date of the IR), and Article 9*quinquies* (permitting “transformation” to national rights).

## SPECIFIC COMMENTS

49. *If an international registration is cancelled, in whole or in part, by the International Bureau at the request of the Office of Origin, within the five year period from the date of the international registration or based on an action commencing during the five year period, the Registrar shall transform an IRDC into an application for registration or a protected international trademark into a registered trademark, if:*
- a. Within three months after the date on which the international registration is cancelled, the holder files with the Registrar a transformation application, including the following details:
    - i. the international registration number;*
    - ii. the date of cancellation of the international registration;*
    - iii. whether the transformation application relates to all the goods and services or the specific goods and services to which the IRDC or protected international trademark relates and their respective Class numbers; and*
    - iv. address for service, if any.**
  - b. the transformation application is in relation to any of the goods and services to which the cancellation applies that were listed in the IRDC or international registration, immediately before the cancellation.*

**Clarify (I):** That the phrase “transform... a protected international trademark into a registered trademark” means that the former IR rights are now only “national” trademark rights.

**Clarify (II):** With respect to a “transformation” application in Canada, whether such applications will be subject to regular examination, or if the deeming provisions in point 19 would apply.

50. *If the trademark is the subject of an IRDC, the Trade-marks Act and Trade-marks Regulations apply for the purposes of the application as if it were an application for registration...*
- (c) Anything already done for the purposes of the IRDC is to be treated as having been done for the purposes of the transformation application.*

**Clarify:** What is intended by this provision?

53. *Notification of any such application for transformation will appear on the Canadian Intellectual Property Office's website.*

**Clarify (I):** Whether notification will appear in a special publication or section of the website.

**Clarify (II):** Whether publication of transformed applications or registrations will open such applications or registrations to opposition.

## **REPLACEMENT (POINTS 54–59)**

### **GENERAL COMMENTS**

According to the January 2012 Alan Troicuk paper ("*Legal and Technical Implications of Canadian Adherence to the Madrid Protocol*"), prepared for CIPO and available on the CIPO website, there are "important divergences of practices and of interpretation amongst the Contracting Parties" relating to the implementation of Article 4*bis*(2).

### **SPECIFIC COMMENTS**

56. *An international registration shall be treated as being registered under the Act as of the date of registration of a registered trademark in relation to all the goods or services in respect of which the registered trademark was registered if:*
- a. both registrations are owned by the same person and identify the same trademark;*
  - b. all the goods and/or services listed in the registration are also listed in the international registration; and*
  - c. the international registration takes effect after the date of the registration.*

**Clarify:** That all information currently in the Canadian registration, including any information regarding a use in Canada claim, or other filing grounds, information relating to registration under s. 12(2) or s. 14, plus any disclaimer and consent, will continue to be shown on the Register following any replacement.

58. *The international registration has the priority date of the registered trademark in respect of all the relevant goods and services covered by the registered trademark.*
59. *Where the Registrar has taken note of an international registration in accordance with subsection 21(2) of the Common Regulations he shall notify the International Bureau accordingly. Such notification shall indicate the following ...*
- (d) the priority date, if any, of the registration and*

*(e) information relating to other rights acquired by virtue of the registration in Canada.*

**Background:** The Common Regulations provide that if a holder of an IR makes a request to the national office, the notification shall include the filing date and registration date, relevant application and registration numbers and the priority date. It may also include “information relating to any other rights acquired by virtue of that national or regional registration”.

**Clarify (I):** What is the meaning of the terms “*priority date*” and “*information*” in points 58 and 59, above. A “registration” does not have a priority date—and for registrations based on “use”, the registrant’s rights will date from the use claim, and not the registration date.

**Clarify (II):** What is the impact of an IR on geographically limited Canadian registrations? If a registrant owns a registration in Canada that is limited to certain areas, and that registrant subsequently obtains an IR, what is the impact of “replacement” on those limited rights? Presumably, that registrant will not be able to obtain any broader rights by virtue of replacement.

## **CHANGE IN OWNERSHIP OF THE INTERNATIONAL REGISTRATION (POINTS 60–64)**

60. *An IRDC or protected international trademark is transferable subject to paragraph 64(a) below, and deemed always to have been transferable, either in connection with or separately from the goodwill of the business and in respect of either all or some of the goods or services in association with which it has been used.*

62. *Nothing in paragraph 60 prevents an IRDC or protected international trademark from being held not to be distinctive if as a result of a transfer thereof there subsisted rights in two or more persons to the use of confusing trademarks and the rights were exercised by those persons.*

**Clarify:** Whether the Registrar would be responsible for making a finding of “non-distinctiveness” as the result of a transfer, or whether an application would need to be made to the Federal Court to invalidate the IRDC or protected international trademark on the non-distinctiveness basis, and if so, on what statutory basis?

63. *Upon transmittal of change of ownership received from the International Bureau, the Register **shall** update the Register.*

**Clarify:** The paper on the *Madrid Protocol* on the CIPO website, written by Alan Troicuk, raises numerous issues relating to the recordal of assignments. One point that is made (at p. 72) is that while the IB is required to notify Contracting Parties of an

assignment, such Contracting Parties may declare the assignment has no effect in their country. Rule 27(4) of the Common Regulations specifically confirms this. While the amendments to the *Trademarks Act* have eliminated “associated marks”, presumably it would not be in the public interest to have confusing marks owned by different parties. While the proposed regulation in point 62 (marks may be held non-distinctive if a transfer results in confusing marks being held by two or more parties) addresses the possible validity of co-existing confusing marks, the impact of confusing marks being owned by multiple parties is not merely the potential non-distinctiveness of specific marks, but also negatively impacts the usefulness of the Register as an indicator of rights. Further, it negatively impacts the ability to predict the registrability of new applications.

**Recommend:** The proposed regulation in point 63 above confirm that the Registrar may reserve the right to declare that the change in ownership shall have no effect in Canada, as permitted by Rule 27(4) of the Common Regulations to the *Madrid Protocol*.

64. *Requests to record a change in ownership must be forwarded to the International Bureau. The Register will only accept for submission and forward to the International Bureau a request to record a change of ownership if all the following conditions have been met:*

*a. the assignee cannot obtain the assignor's signature on the request to record the change:*

**Clarify (I):** Does point 64 mean that only the Registrar may submit a request to change ownership? Rule 25 of the Common Regulations suggests that the request may be submitted by the holder or the Office of the Contracting Party (1)(b).

**Clarify (II):** What is intended by point 64(a)? There does not appear to be any equivalent in Rule 25.

## **DIVISIONALS (POINT 65)**

65. *Section 39 of the Trade-marks Act does not apply with respect to an IRDC.*

**Clarify:** Why will the provisions regarding division of applications, for example, to deal with examination or opposition issues, not apply to IRDCs?



## **PART 3 – PROPOSED AMENDMENTS TO OPPOSITION AND SECTION 45 SUMMARY CANCELLATION PROCEEDINGS**

---

### **GENERAL COMMENTS**

The Discussion Document notes that both oppositions and s. 45 proceedings are “mechanisms that help maintain ... balance in the marketplace by providing reasonably swift and cost-effective administrative decisions”. Particularly with respect to the latter, there is the opportunity for the Registrar to take control of the Register and prevent crowding or cluttering caused by marks that are not in use or that are only in use with a small number of goods and services identified in the registration. Under the amended *Trademarks Act*, s. 45 proceedings will thus become a crucial mechanism for addressing the abuses and “deadwood” that will most certainly arise from permitting registration without any use.

In consultations, the government has suggested that it would use s. 45 summary non-use proceedings to address potential abuse.

**Recommend:** The Regulations should specifically address this issue of potential abuse. As discussed above, a solution would be to have the Registrar to commence a s. 45 proceeding on the 3<sup>rd</sup> anniversary of all registrations, unless the registrant has previously filed a statement of use pertaining to all goods and/or services (this would not mean, however, that the statement of use would foreclose the possibility of any Registrar-initiated s. 45 proceeding). Further, if a statement of use covers only some of the registered goods and/or services, the proceedings commenced by the Registrar would only apply to the remaining goods/services for which no use was declared. This Registrar-initiated proceeding would not impact the ability of any other person to commence s. 45 proceedings after the third anniversary of the registration for any or all goods/services.

### **CORRESPONDENCE – OPPOSITION AND SUMMARY CANCELLATION PROCEEDINGS (POINTS 1–2)**

1. *Amend section 36 of the Trade-marks Regulations to provide that a party corresponding with the Registrar in respect of a trademark application that is the subject of an opposition proceeding (including if an extension of time has been filed to oppose the application) shall forward a copy to the other party of that correspondence.*

**Clarify:** At what point is a trademark application considered “subject” to an opposition proceeding. The current wording of point 1 (underlined above) makes it unclear whether an opponent must begin copying the applicant on all correspondence with CIPO only after the Statement of Opposition has been filed with CIPO and forwarded to the

applicant, or whether, when an extension of time to file an opposition has been requested, the opponent must begin copying an applicant on all CIPO correspondence at some point before the Statement of Opposition is filed and forwarded.

2. *A party corresponding with the Registrar in response of a summary cancellation proceeding after a notice has been issued shall forward to the party a copy of that correspondence.*

**Clarify:** Whether point 2 also applies to the initial request to commence a section 45 proceeding. The words “after a notice has been issued” suggests that the requesting party is not required to forward the registrant a copy of the request.

### **SERVICE – OPPOSITION AND SUMMARY CANCELLATION PROCEEDINGS (POINTS 3–9)**

3. *Amend subsections 37(1) – (2) to provide for service in relation to opposition and summary cancellation proceedings as follows:*

*Service in respect of any opposition or summary cancellation proceeding before the Registrar may be effected:*

- a. in person;*
- b. by courier;*
- c. by facsimile up to a maximum of 20 pages; or*
- d. in any other manner with the consent of the party being served or their trademark agent.*

*Unless the parties have agreed otherwise, service on a party that has appointed a trademark agent shall be effected on that agent.*

**General Comments:** Maximum flexibility in the delivery/service of documents in all proceedings is welcomed as long as parties are well aware of, and/or expect to receive documents by a specific means.

**Clarify (I):** In point 3(c), the use of facsimile machines has virtually ceased. Further, many fax machines are not equipped to handle long faxes (and a 20 page fax would be considered a long fax), and for some documents, such as evidence, the quality of reproduction by facsimile is poor.

**Recommend (I):** Consider adding “by facsimile, provided that the other party notifies, either immediately before or after transmission, that a facsimile communication has been sent”.

**Clarify (II):** Reference to “in any other manner” in point 3(d) is presumably meant to include electronic correspondence.

**Recommend (II):** Specifically mention whether electronic correspondence is included by “in any other manner”.

**Clarify (III):** Requiring “consent” of the other party may not be necessary if actual “notice” has been provided.

**Recommend (III):** that the term “consent”, in point 3(d), be replaced with “notice”.

5. *Create a new provision which sets out effective dates for the various methods of service, as follows:*

- a. *"in person" – service is effected when delivered to the party, or left at the party's address of record*
- b. *"by courier" – service is effected on the date indicated on the receipt received from the courier service*
- c. *"by facsimile" – service is effected on the date appearing on the transmission record as indicating successful transmission*

**Clarify:** Point 3(d), above, allow for the possibility of electronic service; however, point 5 is silent on the effective date of electronic service.

**Recommend:** The effective date of service for electronically served documents should be the “on the date appearing on the transmission record as the date of communication”.

6. *Create a new provision which provides that the Registrar may consider a document to have been validly served, and deem it to have been served within the time for doing so, if the Registrar is satisfied that the document came to the notice of or was received by the person to be served within a reasonable time after the deadline for doing so.*

**Clarify (I):** Whether this section will be applied to the calculation of any date.

**Recommend (I):** The Registrar notify the parties and give parties an opportunity to comment on the “deemed” date. This will ensure that any special factors that could impact the actual receipt of communications are considered.

**Clarify (II):** What is intended by “a reasonable time after the deadline”.

**Recommend (II):** Since the timing for any act is limited, this “reasonable time” should be interpreted to mean only “days” and not longer.

7. *Replace section 38 of the Trade-marks Regulations with a provision that provides that if filed in paper form, a statement of opposition shall be filed with the Registrar in duplicate.*

**Clarify:** Whether facsimile is considered “paper form”.

9. *If a person files a copy (including an electronic copy) of an affidavit or statutory declaration with the Registrar, the person shall retain the original version for at least one year after the expiry of the appeal period set out in section 56 of the Act and file it with the Registrar upon request.*

**Clarify (I):** How will CIPO ensure that an original of an affidavit of statutory declaration submitted to the Registrar be retained by the party for the relevant amount of time.

**Clarify (II):** What penalties would be imposed if the documents are not retained according to this provision.

**Clarify (III):** Whether any enforcement action with respect to this provision would take into account uncontrollable circumstances leading to the loss of the original document, such as fire, flood, natural disaster, etc.

**Clarify (IV):** Who may request the original copy be filed with the Registrar (e.g., the Registrar only, the opponent in an opposition or requesting party in a summary cancellation proceeding, or some other third party).

## **CASE MANAGEMENT – OPPOSITION AND SUMMARY CANCELLATION PROCEEDINGS (POINTS 10–11)**

10. *Provide that the Registrar may, for the purpose of securing the just, speedy and most cost-effective determination of a proceeding, review proceedings and the steps that have been or must still be taken and to give directions to the parties that are consistent with the Act and these Regulations, including:*
  - a. *Fixing the time by which a step in the proceeding shall be taken;*
  - b. *Specifying the steps that shall be taken to prepare the case for a hearing; and*
  - c. *Directing how the hearing of the case will be conducted.*
11. *The Registrar must inform the parties of the proposed directions in writing and seek their comments before issuing such a ruling. In making such a ruling, the Registrar must consider all the surrounding circumstances of the case and must balance the procedural interest of the parties and the public interest.*

**Clarify (I):** When case management would be necessary and how deadlines might be applied. Given the many deadlines in opposition and summary non-use proceedings, it is not clear why case management would be used, and what situations are felt by the Registrar to be “appropriate” for case management.

**Clarify (II):** Whether deadlines would ever be set that are less than those set out in the Regulations. Permitting the Registrar to “determine timetables” that are different from those that would apply to other cases creates a high likelihood that the parties will object to such deadlines. As well, shorter deadlines would be problematic vis-a-vis due date systems.

**Clarify (III):** The idea that the Registrar might “narrow issues” in an opposition could be seen by parties to remove valid grounds of opposition or defenses to such opposition grounds from consideration by the Registrar, to the detriment to the parties. While the provisions note that the Registrar must “inform parties” of proposed directions and seek their comments, it is not clear what the impact of such comments would be; for example, would the Registrar not proceed if both parties object to any changes in proceedings, issues, timetables, etc. ?

**Clarify (IV):** That any narrowing of the issues, once pleaded, would not affect a party’s right to appeal on any issue related to the original grounds of opposition.

## **OPPOSITION PROCEEDINGS (POINTS 12–30)**

### **EVIDENCE – OPPOSITION PROCEEDINGS (POINTS 12–14)**

#### **General Comments**

The Discussion Document proposes that deadlines be calculated by setting specific terms for the doing of any act, and the next step starting from that term, versus from the date of the actual act. Given the length of time that the current deadlines have been in place, it is not clear that changing calculation will add more certainty, clarity, or transparency. It is likely, however, that setting deadlines in the proposed fashion will not result in opposition proceedings being handled any more quickly than is now the case.

**Clarify:** What is meant by “is deemed to be abandoned” or “deemed to be withdrawn”. The Opposition Board generally treats this provision to mean that the application/opposition is in default, and that notice of deemed abandonment/withdrawal will, if not responded to, result in abandonment of the application or withdrawal of the opposition in due course. The parties are thus left uncertain as to when “formal” abandonment or withdrawal of the opposition will occur, and the circumstances under which it might not.

**Recommend (I):** A better and more certain description of “deemed to be abandoned” and “deemed to be withdrawn”, as well as provisions explaining what acts might

overturn that decision (e.g., inadvertent missed deadlines, exceptional circumstances) should be added to the Regulations.

**Recommend (II):** Consideration should be given to reversing the order of evidence at least with respect to evidence concerning an opposition ground that the applicant, at the time of filing the application, did not propose to use the trademark in Canada with the applied-for goods and/or services. Moreover, given that an opponent cannot know what the applicant is contemplating or doing at the application date with respect to its “proposal” to use, consideration should be given to the evolving USTTAB case law with respect to the applicant’s burden to show plans or other steps (or to providing in the Regulations at least a limited form of documentary discovery as between the parties before evidence is to be filed by the opponent with respect to this ground).

#### **LEAVE PROVISIONS (POINTS 15–16)**

16. *Amend section 44 of the Trade-marks Regulations to provide:*

*44. (1) No further evidence shall be submitted by any party except with leave of the Registrar, on such terms as the Registrar determines to be appropriate.*

*44. (2) A request for leave under subsection (1) shall be accompanied by the evidence that the party proposes to submit.*

*44. (3) Leave shall be granted under subsection (1) if the Registrar is satisfied that it is in the interests of justice to do so having regard to all the surrounding circumstances, including*

- a. the stage the opposition proceeding has reached;*
- b. the reasons for not submitting the evidence sooner;*
- c. the importance of the evidence; and*
- d. the prejudice that will be suffered by the other party if the evidence is admitted.*

*44. (4) The Registrar's grant of leave to file an affidavit or statutory declaration under section 44(1) of the Regulations will be made conditional on the affiant or declarant being made available for cross-examination. Unless indicated otherwise, a grant of leave under section 44(1) of the Regulations will have no effect on any outstanding deadlines.*

**Clarify:** Whether a grant of leave under revised section 44 to file new evidence will result in changed deadlines to file written arguments under revised section 46. Under the proposed revisions, deadlines to file evidence, conduct cross-examination, and written submissions, will all be set by the Registrar by way of regulation; however, granting leave to file additional evidence will require a change in deadline for all of the

steps following submission of the additional evidence (i.e., cross examination and written representations).

**Recommend:** Amend the relevant regulations for cross-examination and written representations to specify that a different prescribed time period will apply or will be set by the Registrar on a case-by-case basis where leave to file additional evidence has been granted.

## **CROSS-EXAMINATION (POINTS 17–21)**

### **General Comments**

The proposals regarding timing of cross-examination have been discussed in previous consultations, and responses from many organizations have already been received. It should be noted, however, that the prior consultations are only of limited usefulness, as they contemplated a very different regime—this limited usefulness does not apply, however, to the observations that follow about cross-examination and additional evidence.

The **main concern** has been, and continues to be, that parties may not have an opportunity to file evidence in response to issues arising from cross-examination, except with leave, and since the results of a request for leave is uncertain, and parties may risk such leave request being denied, there is a potential inequity in the procedure. Cross-examination frequently leads to one or both parties wanting to address an issue in their own evidence.

### **Specific Comments**

17. *A party in an opposition proceeding may, at any time up until four months after the expiry of the time for submitting the opponent's reply evidence under section 43, cross-examine under oath or solemn affirmation the affiant or declarant of any affidavit or statutory declaration.*

**Clarify:** This proposal suggests that the actual deadline for completion of cross-examination is four (4) months from the expiry of the time for filing reply evidence. Based on current practice, it is likely that both the applicant and the opponent will postpone any cross-examinations until that step. If the parties seek leave to file additional evidence in response to those cross-examinations, and such leave is granted, then presumably the other party may want an opportunity to cross-examine any witness regarding the “new” evidence. In terms of timing and efficiency, this does not seem preferable to the current system.

**Recommend:** At the very least, the parties should be permitted to file additional evidence following cross-examination in response to issues arising in such cross-

examinations, and that such filing of additional evidence will be permitted unless there is a strong reason not to.

19. *In the absence of an agreement, any of the parties may request that those matters be designated by the Registrar. The Registrar shall grant the request if the party seeking to conduct the cross-examination establishes that they have been unable to reach an agreement with the other party despite having made reasonable and timely efforts to do so, and that there has been no undue delay in making the request.*

**Clarify:** How will “undue delay” be assessed.

#### **WRITTEN REPRESENTATIONS (POINTS 22–24)**

**Clarify:** While the proposal to have arguments filed *seriatim* versus together is welcomed, the opponent should be given the right to file a “rebuttal” within a short term, clearly restricted to the issues raised in the applicant’s written representations. To do so may reduce the circumstances in which an oral hearing is requested, which is beneficial for all parties.

**Recommend:** That there be a provision for filing a “rebuttal” argument by the opponent, without requiring leave to do so, restricted only to issues raised in the applicant’s written submissions.

22. *Within two months after the expiry of the time for the completion of all cross-examinations on affidavits or statutory declarations referred to in subsection 41(1), the opponent may file written representations with the Registrar and shall serve a copy on the applicant.*

**Clarify:** Whether reference to section 41(1) should, in fact, be reference to section 46(1), given that section 41(1) of the *Trademarks Regulations* pertains to the filing of the opponent’s evidence, while section 46(1) establishes when written arguments are due.

#### **ORAL HEARINGS (POINTS 25–29)**

**Recommend:** While the proposal to set a deadline to request the oral hearing that is “fixed” can be helpful, the parties should be able to request a hearing at an earlier date.

25. *Within one month after the expiry of the time for the applicant to file written representations ...*

**Recommendation:** Any party may request an oral hearing at any time.



27. *If only one of the parties files a request to make representations, and if, after a notice is sent pursuant to paragraph 26 above, that party withdraws its request, the Registrar shall notify both parties that the hearing is cancelled.*

**Clarify:** There is a high risk that the other party may be surprised and suffer a disadvantage by the automatic cancellation of a hearing if one of the parties withdraws.

**Recommend:** The cancellation of the hearing, if the party withdraws, should not be automatic unless this impact has first been clearly noted in earlier correspondence from the Opposition Board. There should therefore be clear notice in correspondence from the Opposition Board that withdrawing a request for a hearing will cancel the hearing. Such notice could be provided, for example, when setting the hearing date, and would ensure that parties clearly understand that unless both parties wish to attend, the hearing will not proceed.

#### **GEOGRAPHICAL INDICATIONS (POINT 30)**

30. *Make any consequential amendments necessary to bring the procedure for geographical indication objection proceedings in line with the procedure for oppositions as set out in the new Regulations.*

**Clarify:** As the definition of “mark” will be expanded in the amended *Trademarks Act*, and could include geographical indications, whether CIPO will make additional amendments to the *Regulations* to permit opposition based on geographical indications.

#### **SECTION 45 SUMMARY CANCELLATION PROCEEDINGS (POINTS 31–37)**

##### **GENERAL COMMENTS**

As discussed above, s. 45 proceedings should become a means to protect against the potential abuse of the trademarks registration system that will certainly arise from eliminating the “use” requirement as a condition to registration. Specifically, since the Registrar has the right to initiate s. 45 proceedings, and since the potential for abuse resulting from eliminating use as a registration requirement is both obvious and long-lasting, the Registrar should use s. 45 proceedings to actively police the Register against abuse.

**Recommend (I):** As discussed above, the Regulations should be amended to provide that on the third anniversary of any registration, if a declaration of actual use in Canada has not yet been filed regarding any of the goods/service with which the mark is

registered, the Registrar shall send a notice, pursuant to s. 45, to the registered owner of such mark or its recorded agent requiring proof of use.

**Recommend (II):** Consideration should be given to allowing the requesting party to cross-examine the Registrant's affidavits and to allowing the requesting party to itself file evidence, thereby creating a more robust cancellation regime, such as exists in certain other common law countries. This recommendation may require amendment to s. 45 of the *Trademarks Act*.

#### **WRITTEN REPRESENTATIONS (POINTS 31–33)**

31. *Provide that in a summary cancellation proceeding where the registered owner has filed evidence that, within two months from the filing of the registered owner's evidence, the requesting party may file written representations with the Registrar and shall serve a copy on the registered owner.*
32. *Within 2 months after the expiry of the time for the requesting party to file written representations, the registered owner may file written representations with the Registrar and shall serve a copy on the requesting party.*
33. *No written argument shall be filed after the expiry of the time for the registered owner to file written representations, except with leave of the Registrar.*

**Clarify:** While the proposal to have arguments filed *seriatim* versus together is welcomed, the requesting party should be given the right to file a “rebuttal” within a short term, clearly restricted to the issues raised in the registrant's written representations. To do so may reduce the circumstances in which an oral hearing is requested, which is beneficial for all parties.

**Recommend:** That there be a provision for filing a “rebuttal” argument by the requesting party, without requiring leave to do so, restricted only to issues raised in the registrant's written submissions.

#### **HEARINGS – SUMMARY CANCELLATION CASES (POINTS 34–37)**

36. *If only one of the parties files a request to make representations, and if, after a notice is sent under paragraph 35 above, that party withdraws its request, the Registrar shall notify all the parties that the hearing is cancelled.*

37. *A party may notify the Registrar of changes to any of the information provided under paragraph 34 above and the Registrar shall modify the administrative arrangements for the hearing accordingly if the request is received by the Registrar at least one month before the date of the hearing or, if the Registrar is reasonably able to modify the administrative arrangements that have been made for the hearing, at any time before the hearing.*

**Clarify:** There is a high risk that the other party may be surprised and suffer a disadvantage by the automatic cancellation of a hearing if one of the parties withdraws.

**Recommend:** The cancellation of the hearing, if the party withdraws, should not be automatic unless this impact has first been clearly noted in earlier correspondence from the Opposition Board. There should therefore be clear notice in correspondence from the Opposition Board that withdrawing a request for a hearing will cancel the hearing. Such notice could be provided, for example, when setting the hearing date, and would ensure that parties clearly understand that unless both parties wish to attend, the hearing will not proceed.