



November 30, 2014

Darlene Carreau  
Chair, Trade-marks Opposition Board  
Canadian Intellectual Property Office (CIPO)  
50 Victoria Street, Room C232-35B  
Gatineau, Quebec K1A 0C9

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

Dear Ms. Carreau,

The following is the submission of Cassels Brock & Blackwell LLP in response to the consultation notice entitled *Proposed Amendments to the Trade-marks Regulations 2014* issued by the Canadian Intellectual Property Office (the "Office"). Cassels Brock thanks the Office for the opportunity to provide comments and suggestions on the *Proposed Amendments*.

**Part 1 - Proposed Amendments to the Trade-marks Regulations- Examination and General Provisions**

- Amendment 22
  - Amendment 22 indicates that correspondence from a third party will be pertinent if it pertains to "registrability" of the applied for trademark. "Registrability" is both a technical trademark term and common law term, and its use in the context of this proposed amendment to the Regulations might be equivocal and confusing. If the intention of the Office was not to limit pertinent third party submissions to those addressing "registrability" issues under section 12 of the *Trade-marks Act*, but was instead to allow third parties to make submissions on other issues such as distinctiveness, entitlement under section 16 and technical compliance, it is suggested that a word other than "registrability" be used here.
  - In our view, the word "pertinent" in amendment 22 is unclear. We recommend that the Office provide further guidance as to the meaning of this term to help Examiner's apply the new provision consistently.
  - The amendment states that the Registrar will forward a copy of any third party correspondence which it determines to be pertinent to the applicant. It would seem reasonable to require the Registrar to forward all third party correspondence to the applicant, not only correspondence deemed pertinent.



- Moreover, the draft Regulations are unclear as to the effect or consequence of sending pertinent third party correspondence to the applicant. We submit that the proper procedure, and the Regulations or implementing Practice Direction should so state, should be for the Examiner, if he or she feels the third party submission is pertinent to the issue of “registrability”, to issue an Examination report or requisition with the pertinent third party correspondence/submission being included as support for that Examination report or requisition.
  - Similarly, the Regulations or implementing Practice Direction should provide a mechanism by which the Examiner confirms or denies the pertinence of the submission to the third party; if anything so that the loop is closed and the third party can take some comfort in the knowledge that its submission has in fact been received and considered by the Office.
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- Amendment 25 states that “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...”. Is the intention of the Office that the Registrar will have the discretion not to require a Canadian address for service? If so, in the event of a proceeding against an applicant or registrant for which no Canadian address has been provided, how does the Office propose that service of documents on such persons be effected?
  - With respect to applications filed on behalf of joint applicants, we suggest that it be made clear whether: (i) each joint applicant can correspond with CIPO if one or neither appoint a Trademark Agent; and (ii) each joint applicant may have a separate Trademark Agent.
  - In the case of a discrepancy between the description and the colour representation (as required by amendment 44) in an application where colour is claimed as a distinctive feature, which takes precedence?
  - Amendments 44 through 50 fail to address signs that comprise a scent, taste or texture. As noted in proposed amendment 38, outdated provisions requiring “drawings” and lines for colours will be replaced with proposed new provisions that include the use of modern technologies for both the creation and the reproduction of representations. Moreover, we understand that a new provision in the Regulations is to provide that the representation or description of the trademark must be capable of being legibly reproduced for the purposes of advertisement. The recognition of more modern technological presentations and representations of trademarks is laudable, but care must be taken in the case of scents, taste or texture marks to avoid mandatory disclosure of what may, in many cases, be trade secrets underlying the very scent, taste or texture for which trademark protection is sought. Having to legibly reproduce for advertisement a chemical formulation for a scent, or the components and their concentrations for a flavour profile, may very well destroy the value of the trademark for which protection is sought.



- With respect to amendment 52 regarding goods and services descriptions, we recommend that the Office provide direction on its interpretation of “as far as practicable” or use more precise language in the amended regulations.
- Does “clear, accurate and precise” in amendment 53 change the way the Act sets out descriptions as being in ordinary commercial terms?
- Amendments 61 and 62 provide that no application for the registration of a trademark may be amended where the amendment would change the trademark unless the trademark remains “substantially the same”. How will this be different from the language of “except in respects that do not alter its distinctive character or affect its identity” in the current Regulations? Does the Office intend to implement a new standard that deviates from the case law interpretation of the former language “except in respects that do not alter its distinctive character or affect its identity”

### **Part 3 - Proposed Amendments to Opposition and Section 45 Summary cancellation Proceedings**

- With respect to Amendment 4, it would be helpful if the Office would clarify what will constitute “proof of service” by electronic means.
- We welcome the introduction of case management, which could facilitate complex or multiple case oppositions and Section 45 proceedings.
- Electronic filing of documents with the Opposition Board appears to be contemplated by the proposed Regulations. However, the precise mechanism for electronic filing is not clear nor is the protocol for cross-referencing and hypertext linking exhibit and relevant affidavit material. Given the volume of some opposition and summary cancellation proceeding evidence and exhibit material, the profession requires guidance by way of regulation or Practice Direction in this regard, and perhaps the Office might consider the approach to electronic documents (especially as it applies to motion, application and appeal records) adopted by the Federal Court and Federal Court of Appeal.
- As well, while electronic filing is a laudable goal, and in line with the technical realities of the day, it would appear that the Office still contemplates evidence in the traditional sense of narrative affidavit supported by visually legible two dimensional affidavit exhibits. Some thought must be given to the ability of both applicants and opponents, as well as registrants in summary cancellation proceeding, to submit and identify by way of affidavit, video and audio evidence and streamed or dynamic content from websites and other sources that does not reproduce legibly or effectively in screen capture shots or transcribed dictation, and for three dimensional demonstrative evidence (especially in the assessment of marks falling within the newly expanded mark categories such as the sound, scent, taste and texture genres).



#### **Other Issues - Fees**

- We understand that the Office will be conducting a separate consultation on changes to trademark fees. We suggest that any fee increases be minimal to minimize the burden on businesses and that any changes in the fee structure, including the introduction of class fees, be introduced in a manner that allows existing trademark owners to spread any transition costs over a reasonable period of time.

Yours truly,

A handwritten signature in cursive script that reads "Cassels Brock &amp; Blackwell LLP".

Cassels Brock & Blackwell LLP