

Dear Darlene,

I have reviewed the consultation documents available here:

<http://www.cipo.ic.gc.ca/eic/site/cipointernet-internetopic.nsf/eng/wr03853.html>

While I believe I have the support of at least some of my colleagues copied above, I may not be characterizing their sentiments accurately in this email and therefore ask that you please treat this proposal as mine alone and that I am not representing the views of my firm.

I propose that a provision be added to the Regulations to require a "prescribed statement" in trademark applications filed with CIPO. As you know, prescribed statements are authorized by new 30(2) of the Trademarks Act. Here is just one example of a prescribed statement, though I can see many variations to this (including variations to account for multiple applicants, etc.):

Applicant is using or proposing to use in good faith the trademark in Canada in association with the goods and/or services recited herein. Furthermore, Applicant believes s/he / it is entitled to use the trademark as aforesaid.

I derived this wording from the wording of new subsection 30(1) of the Act.

Requiring an applicant to make this statement in the original application may help to avoid frivolous, bad faith, or innocently erroneous filings. In my experience, the meaning of "use," the purpose and function of a trademark, and requirements for valid trademark rights are not well understood by the general public. Therefore, anything that the government can do to educate the public on the meaning of "use," including prescribing mandatory statements about use to be included in the application will, I think, be in the public interest. On a related note, I think it would be helpful to provide explanations regarding "use", etc. to applicants/agents using the electronic system for applying to register a trademark online. This may help people (agents and unrepresented applicants alike) to complete a trademark application correctly and accurately.

I see a low administrative burden associated with requiring applicants to make a statement such as the one above. There is no need to determine date(s) of first use. There is no need to confirm whether the mark is used on some goods and proposed to be used on others, etc. So I see this as a middle ground between a totally "useless" registration regime and the regime we currently have. Here, when I say "useless" registration regime," I mean a regime wherein applicants can register a trademark without having to put on record any indication

whatsoever that the mark has or will be used before grant of a registration. I fully understand that use is required to avoid expungement under section 45, court invalidity proceedings, etc.

If there is a way to make “wilful false statements” punishable by fine, I would support that too, in the interest of creating a greater incentive to avoid wilful over-reaching applications. Here is another example statement to consider. I realize that there will need to be legal authority to impose a fine and that such legal authority currently does not exist.

Applicant is using or proposing to use in good faith the trademark in Canada in association with the goods and/or services recited herein. Furthermore, Applicant believes s/he / it is entitled to use the trademark as aforesaid. Applicant confirms that the statements made herein are true; and further that these statements are made with the knowledge that willful false statements and the like so made are punishable by a fine and that such willful false statements may jeopardize the validity of any registration issued on the basis of this application.

I kindly ask that you confirm receipt of this proposal and thank you for your consideration.

Kind regards,

Dolly Kao

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