

November 28, 2014

Canadian Intellectual Property Office
Trade-marks Branch
50 Victoria Street
Place du Portage II
Gatineau, QC K1A 0C9

Attention: Darlene Carreau, Chair, Trade-marks Opposition Board,
Canadian Intellectual Property Office (CIPO)

Dear Ms. Carreau:

**Re: Discussion Document regarding amendments to the
Regulations of the *Trademarks Act***

In response to the request for comments on the above Discussion Document, the undersigned, all of whom are involved in the practice and/or study of trademark law in Canada, request that the Regulations be amended to address concerns that were consistently raised in submissions made before enactment of the amendments to the *Trademarks Act* in Bill C-31. These proposed changes will benefit businesses and trademark owners in Canada, and will reduce, we believe, the many costs, risks and uncertainties that result from the elimination of "use" as a requirement for registration in Canada.

Specifically, the following amendments are requested:

1. 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 a 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 rebuttable by any opposition evidence 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*.

2. Proactive use of s. 45 to address abuse:

The Register 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 any previous three year period. The rebuttable presumption would only apply in opposition proceedings, and would not impact any proceedings relating to abandonment, expungement or enforcement.

Respectfully submitted,

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