

# Consultation on the Amendments to the *Trade-marks Regulations* 2014

Submission to the Canadian Intellectual Property Office  
Part 2 of 2: Comments on Specific Amendments

November 28, 2014

	<b>Part 1 – Proposed Amendments to the Trade-marks Regulations – Examination and General Provisions</b>	
3	Amend subsections 3(7) and 3(8) to comply with Rule 6(8) of the <i>Singapore Regulations</i> which, for electronic communications, provides that the date on which an Office receives the communication, shall constitute the date of receipt of the communication.	The proposed changes to Rule 3(7) and 3(8) should specify that the Office which receives the electronic communications is deemed to be CIPO's office in Gatineau given the time differences between the various CIPO office locations.
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.	All communications to the Registrar should also include the trademark itself or a description of the trademark to provide a check against a clerical error in the application/registration number.
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.	All communications to the Registrar should also include the trademark itself or a description of the trademark to provide a check against a clerical error in the application/registration number.
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	Without the benefit of a practice notice, it is difficult to comment on this proposed new provision.  Considering CIPO's broad discretion to assess the inherent distinctiveness of trademarks (see Sections 32(1)(b) and 37(1)(b) of the amended TMA), the type of information/ materials/ documents that could be considered by CIPO under this new provision is quite broad and could potentially take away from a much more suited mechanism for addressing many of those issues, i.e. opposition proceedings.  In our view, this provision should only allow the filing by third parties of information/ materials/ documents relevant to Sections 12(1)(a), (b),

	<p>pertinence pertaining to the registrability of the applied for trademark. The acceptance of such correspondence will not result in the commencement of <i>inter partes</i> 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 <i>Patent Act</i>). The Registrar will forward a copy of any such correspondence which it determines to be pertinent to the applicant.</p>	<p>(c) and (d), which are typically within the purview of Examiners during the examination of TM applications.</p> <p>There is concern that by allowing third parties to submit correspondence and documents, this will conceivably encourage submissions seeking to delay a competitor's entry into the market.</p> <p>This proposed amendment may frustrate the TMO's efforts to meet the strict Madrid timelines.</p>
25	<p>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:</p> <ol style="list-style-type: none"> <li>does not have an agent with a Canadian address; and</li> <li>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 <i>Singapore Treaty</i>)</li> </ol>	<p>The word "may" should be replaced with "shall". We believe that it is necessary that every application and registration have an address for service in Canada. It would not be appropriate to require third parties to serve applicants or registrants abroad.</p>
26	<p>Where the applicant, registered owner or others including parties to the proceedings under sections 38 and 45 does not provide the Registrar with an</p>	<p>The wording gives rise to the spectre of a party punishing another party for failing to keep its address up to date in the Trade-marks Office.</p> <p>We recommend that the test should not be that an address be "kept up to date", but instead that mail properly served is returned, and that the Registrar has made at least some attempt to contact the party using other means. CIPO should also clarify whether this section is restricted to</p>

	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.	service by the Registrar on parties to a proceeding, or whether it includes service by any party on any other party to a proceeding.
29	Amend section 14 to provide that:	
	b. An application for the registration of a trademark must, with the exception of the trademark, be entirely either in English or in French.	It is submitted that the use of both official languages, English and French, should be permitted.
	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.	It should be made clear that the other party has the right to request the Registrar to request the original affidavit. The proposal should also set the consequences for failing to retain the original affidavit within the prescribed period, such as a negative inference.
30	Repeal paragraphs 15(b) and (c) as the particulars of registrations will no longer be published. Paragraphs 15(a), (d) and (e) of the Regulations do not require amendment.	The Registrar's rulings should still be published as per Rule 15(c), which should not be repealed.
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 <i>Trademarks Journal</i> , the Registrar may require	It is unclear how this prohibition will impact the common practice of showing the position of a trademark on an object, for instance, the dotted outline of a bottle, with a comment that the bottle does not form part of the trademark.

	an applicant to submit a new representation.	
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.	This proposal limits the representation of a mark to no more than six views. However, in the case of moving images or objects with more than six faces, six views might not be sufficient.
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.	This proposal limits the representation of a mark to no more than six views. However, in the case of moving images or objects with more than six faces, six views might not be sufficient.
44	Where an applicant wishes to claim colour as a distinctive feature of the trademark, the application must contain a colour representation of the trademark, must provide the name of the colour or colours claimed and, in respect of each colour, the principal parts of the trademark which are in that colour. The applicant may include a reference to an internationally recognized colour system for each colour. (Rule 3(2) of the <i>Singapore Regulations</i> )	In Canadian TM law, colour or colours claimed as a feature or features of a TM do not have to be distinctive. The word “distinctive” should be deleted as leaving such language in the Regulations may limit the ability of applicants to include colour claims in their applications and/or make their applications subject to opposition on that basis.
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.	Is there a reason that the terms “clear”, “accurate” and “precise” were chosen rather than “ordinary commercial terms” and, if so, how will the examiners determine descriptions using these words?
55	Create a new provision to provide that the prescribed time for the purposes of subsection	If the Registrar disagrees with the classification provided by the registered owner, it should be clarified that any disagreement in that regard

	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.	between the registered owner and the Registrar can be resolved subsequent to the expiry of the one year deadline.
56	Create a new provision to provide that an application for division must be in writing and contain the following information:  d. 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	This provision should be clarified to ensure that consent to divide an application is not required where an opposition has been concluded.
58	<i>“Merger of Divided Applications”</i>	This heading is misleading. It should read “Merger of Registrations Issuing from Divided Applications”.
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  are classified according to the same edition of the Nice Classification.	To be merged, is it necessary for the registrations to share a common filing date?
62	Amend section 32 of the <i>Regulations</i> to provide that no application for the registration of a trademark may be amended, after it has been advertised to change:  b. the trademark, unless the trademark remains substantially the same	If a trademark can be amended after advertisement, the application should be re-advertised to allow third parties who, with the amendments, would have opposed the application in the first place. Otherwise, such parties’ only option would be to seek cancellation of the registration to issue, where possible, which is a much more engaging and costly process. Amendment of trademarks after advertisement, no matter how insignificant the changes are, should not be allowed.

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 <i>Singapore Regulations</i> ).	For clarity, the term “initial” should be deleted, as the proposed timeline will also apply after the first renewal.
69	Create a provision to provide that all trademark registrations must be renewed electronically through the on-line services available on CIPO's web site.	In the case where the on-line service is not available for more than seven days, another option for payment should be made available to avoid loss of rights.
71	<p>Amend section 52 of the Regulations to indicate, in respect of each registered trademark, the following particulars:</p> <ol style="list-style-type: none"> <li>The representation or description of the trademark;</li> <li>The name and address of the applicant and the applicant's trademark agent, if any;</li> <li>The registration number;</li> <li>The filing date of the application and priority date, if any;</li> <li>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;</li> <li>In the case of a registration for a certification</li> </ol>	<p>It is unclear if this will affect current online records.</p> <p>Reclassifying according to Nice the goods or services of existing registrations containing valuable information on the use of marks in Canada or abroad, no matter how challenging it may be, should not prevent CIPO from making this information available online going forward. Such information is regularly relied upon by third parties.</p> <p>IPIC recommends that all current information be maintained on the register</p>

	<p>trademark or a trademark consisting of standard characters, a note to the effect;</p> <p>g. The particulars of any translation or transliteration; and</p> <p>h. In the case of evidence of acquired distinctiveness and/or territorial restriction, a note to that effect.</p>	
	<b>Part 2 – Implementation of the Madrid Protocol</b>	
Gen'l	<p>The <i>Trade-marks Act</i> and <i>Trade-marks Regulations</i> will apply to international registrations unless the <i>Trade-marks Act</i> and <i>Trade-marks Regulations</i> are inconsistent with the Madrid Protocol. This part of the <i>Regulations</i> governs these inconsistencies and sets out how the processing of international registrations will occur. One of the key goals of this section is to minimize the differences between a domestic trademark application and one done through the Madrid system. A definitions section will be included in this part to supplement those definitions already found in the <i>Trade-marks Regulations</i>. The new definitions have specific meaning in the international context and are consistent with the definitions used in other jurisdictions.</p>	<p>Since this consultation does not address fees, the impact of the Madrid Protocol to Canadian and foreign trademark owners cannot be fully addressed.</p> <p>The Madrid Protocol or Singapore Treaty or both contemplate the use of declarations of intention to use the mark by Contracting Parties (see Rule 7 of the Common Regulations).</p> <p>Requiring a declaration of intention to use a mark at filing would protect applicants using the Madrid Protocol to seek registration in Canada from the impact of opposition based on lack of proposed use in Canada at the date of filing. 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 that they intend to use their marks in Canada at the time of filing, rather than face an opposition later on, and only then become aware of the requirement. This is what IPIC recommends.</p>
7	An application for international registration shall:	
	a. Comply with the requirements of the Madrid Protocol (the applicant shall use the official form issued by the International Bureau (MM2) or	The “requirements of the Madrid Protocol” in paragraph 7(a) need to be specifically listed in the regulations.



	another form that requires the same information and uses the same format)	
	d. Be accompanied by the certification fee (if any) set out in the Tariff of Fees.	Since Fees are not part of the current consultation, it is difficult to comment effectively on this.
8	For the purpose 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).	While online filing is likely to be more convenient for both applicants and the Registrar, it is recommended that facsimile or paper filing be permitted as well, especially if online filing is not available.
12	<p>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,—</p> <p>a. within 5 years after the date of the international registration; or</p> <p>after that time, if the action that resulted in the basic application or the basic registration being so affected began before the end of that 5-year period.</p>	This provision relates to the “dependency” of the international registration (IR) on the basic application or registration of the applicant in its home country. Clarify that 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, including any of the following specific irregularities, the Registrar shall notify the applicant and require that the applicant submit the outstanding items within the date	<p>Given current delays to first examination, there will have to be a speedier turnaround by the TMO, or else applicants will lose the benefit of the IA filing date.</p> <p>The TMO will need to dedicate resources to processing IAs; 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.</p>

	<p>specified in the Registrar's notice in order to ensure the application is sent to WIPO within 2 months.</p> <ul style="list-style-type: none"> <li>a. the international application is not filed on the proper form, and does not contain all the indications and information required by that form;</li> <li>b. the list of goods and services contained in the international application is not covered by the list of goods and services appearing in the basic application or basic registration;</li> <li>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;</li> <li>d. any indication in the international application as to the trademark, other than a disclaimer or a colour claim, does not also appear in the basic application or basic registration;</li> <li>e. if colour is claimed in the international application as a distinctive feature of the trademark, and the basic application or basic registration is not in the same colour or colours;</li> <li>f. if no colour is claimed in the international application and the basic application or basic registration claims colour or colours as a distinctive feature of the mark;</li> <li>g. the applicant is not eligible to file an international application through the</li> </ul>	<p>The Registrar will need to ensure that regular applicants will enjoy the same speedy service.</p> <p>13(d): We do not understand why “or a colour claim” appears in this provision.</p> <p>13 (e) and (f): We believe that the term “distinctive” should be deleted for the reasons noted above with respect to part 1, item 44.</p>
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	intermediary of the Registrar in accordance with Article 2(1)(i) of the Madrid Protocol; or h. the prescribed fee is missing or insufficient.	
14	If there are no irregularities or if the irregularities are remedied within the time specified by the Registrar, which period shall not be extended, 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).	See above comments.
15	If the irregularities referred to in paragraph 13 are not remedied within a 6 month period, which period shall not be extended, the Registrar shall refuse to forward the international application to the International Bureau and the international application is deemed never to have been filed.	See above comments.
17	Any fees payable to the International Bureau under the Madrid Protocol shall be paid directly by the applicant to the International Bureau.	This proposal requires applicants to pay fees directly to the IB. Paying the IB directly involves some complication, and must be carried out in foreign currency. It is suggested that payment be allowed to the Registrar instead, who will then pay the fees to the IB.
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	<p>This paragraph purports to deal with objections from WIPO as to the classification and/or description of goods and services. It is understood that both the applicant and CIPO receive notice from WIPO of these objections. The text of this paragraph seems to suggest that CIPO expects any response prepared by the Applicant to be submitted to CIPO and that CIPO “shall approve” the response and forward it to WIPO on behalf of the Applicant. We note that there is only a 3 month period in which to respond to such an objection from WIPO.</p> <p>It is recommended that a specific procedure be established and that both CIPO and the Applicant be compelled to comply with strict deadlines to ensure that a response is delivered to WIPO in a timely fashion. At present, there is no procedural detail as to how such proposed responses will be processed by CIPO.</p>

	Bureau by the Registrar.	
19	<p>An IRDC that the International Bureau transmits to the Registrar is deemed to be filed in accordance with section 30 of the <i>Trade-marks Act</i> (the "Act") and is deemed to be an application for registration in Canada for the purposes of the Act and Regulations. The filing date of an IRDC for the purposes of the Act and Regulations is the earlier of:</p> <ul style="list-style-type: none"> <li>a. The international registration date, if the request for extension of protection was filed with the international application;</li> <li>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</li> <li>c. The date of priority claimed pursuant to paragraph 25 below.</li> </ul>	<p>We note that (a) and (b) are mutually exclusive. They should be combined and separated by the word "or".</p> <p>What if the IB transmission of the IRDC is in error? Should not the deeming be dependent on the IRDC meeting the Madrid requirements as opposed to merely the fact of the IB's transmittal?</p>
23	<p>For the purposes of section 16(1)(a) of the Act, "filing date" in that section means the earlier of:</p> <ul style="list-style-type: none"> <li>a. The international registration date, if the request for extension of protection was filed with the international application;</li> <li>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</li> <li>c. The date of priority claimed pursuant to</li> </ul>	<p>We note that (a) and (b) are mutually exclusive. They should be combined and separated by the word "or".</p> <p>The reference should be to 16(1) and item 24 deleted.</p>

	paragraph 25 below.	
24	Further, for the purposes of section 16(1)(b) of the Act a trademark in respect of which an application for registration has been previously filed includes an IRDC and the relevant date is determined as in a-c above.	Should be deleted as indicated above.
30	<p>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:</p> <p>a. A notification of refusal based on an examination of the IRDC.</p> <p>b. A notification of refusal based on the filing of an opposition to the IRDC.</p> <p>A notification of the possibility that an opposition to the IRDC may be filed after the end of that 18-month period.</p>	Clarify that (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.	<p>The timing limitations in this section appear to prevent the use of the maximum 9 month cooling off extension before filing of a statement of opposition. This may result in more oppositions being filed.</p> <p>Opponents appear to be prevented from amending the grounds of opposition after 7 months from the beginning of the opposition period. This may result in opponents raising any and all possible grounds of opposition at the outset (shotgun approach) resulting in more protracted and expensive opposition proceedings.</p>

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.	As soon as an opposition is filed, the applicant should be required to either appoint a Canadian agent, or indicate a Canadian address for service, to ensure that the opponent does not have to serve any documents internationally.
36	<p>The Registrar may, if requested, extend the deadline for filing a statement of opposition:</p> <ul style="list-style-type: none"> <li>a. By up to 2 months, without the consent of the holder of the international registration; or</li> <li>b. Up to 3 months, with the holder's consent.</li> </ul> <p><i>The notification of the provisional refusal (the grounds of opposition) shall be communicated to the International Bureau no later than 7 months from the date on which the opposition period begins. This timing will eliminate the ability for a cooling off period to be requested before the filing of a statement of opposition.</i></p>	Will it be possible to request a two-month extension of time without consent and then obtain a third month with consent?
38	If a statement of opposition is filed, the Registrar shall give notification to the International Bureau of a refusal based on opposition and state in the notification the grounds of the opposition.	Given that CIPO must provide the grounds of opposition to WIPO within 7 months, this seems to preclude the opponent from amending the Statement of Opposition with leave after 7 months. This should be clarified.
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 <i>Trade-marks Regulations</i> . If the holder fails to comply with this requirement in relation to any	<p>Can this proposal be clarified to indicate that it is possible to obtain a two-month extension of time or whatever extension of time is permitted to Canadian applications?</p> <p>Similarly, clarification is requested to confirm whether or not IRDCs are subject to the same opposition procedures as Canadian applications. It is recommended that the same procedures should apply to all applications.</p>

	<p>goods or services in respect of which protection is opposed:</p> <p>a. The Registrar will treat the holder's request for protection in Canada in respect of those goods or services as withdrawn; and</p> <p>The Registrar's refusal will be confirmed to the International Bureau in respect of those goods or services.</p>	
40	<p>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.</p>	<p>It appears that paragraphs 40 and 41 ought to be reversed.</p> <p>It should be clarified whether extensions of time will be permitted.</p>
41	<p>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.</p>	
43	<p>The Registrar shall notify the International Bureau if a protected international trademark is cancelled or the goods and services are amended to any extent.</p>	<p>We do not believe that the wording “to any extent” is necessary and recommend that the wording be deleted.</p>

49	<p>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:</p> <p>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:</p> <ol style="list-style-type: none"> <li>1. the international registration number;</li> <li>2. the date of cancellation of the international registration;</li> <li>3. 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</li> <li>4. address for service, if any.</li> </ol> <p>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.</p>	<p>We suggest that the wording “in Canada” be added after “address for service”.</p> <p>What is missing in the Discussion Document are provisions explaining the concept of dependence (as found in Article 6 of the Protocol). Canada, if acting as an OO, must notify the IB of any decision within 5 years of the date of the IR affecting the originating rights, namely, should either the application, if still pending, be limited, withdrawn, abandoned or refused, or the registration limited, cancelled or otherwise invalidated. Note, Art. 6(3)(iii) extends the 5 year term if there was a proceeding (such as a s. 45 proceeding) or an opposition or opposition appeal, that had started within the 5 year term. Under Article 6, the protection of the IR, and by implication, all extended rights in countries to which the IR has been extended, “may no longer be invoked” (Art. 6(3), and the OO is obliged to notify the IB.</p>
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50	<p>If the trademark is the subject of an IRDC, the <i>Trade-marks Act</i> and <i>Trade-marks Regulations</i> apply for the purposes of the application as if it were an application for registration.</p> <p>a. The filing date for the transformation application is taken to be the date of international registration or the date of recording, as applicable; or</p> <p>b. If the IRDC in respect of the trademark included a priority claim, the priority date allowed under the claim; and</p> <p>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.</p>	Clarify what is intended by this provision.
52	If no application for transformation is filed as prescribed above, the goods and services will be deleted if there is a partial cancellation or the IRDC is cancelled.	As presently drafted, this paragraph appears to suggest that if the basic application is cancelled entirely and no transformation application is filed, then the goods and services will simply be deleted from the corresponding CDN registration. In effect, this would leave a CDN registration on the registry with no goods or services. It does not explicitly state that in such circumstances the CDN registration would in fact be cancelled in its entirety as we would expect.
54-59		We request clarification that a Canadian registration that is replaced with an international registration will retain the information currently on the register such as filing date, date of first use, geographical limitations, disclaimers, etc
55	An international registration is deemed to replace a Canadian registration for the same mark and the same goods and services recorded in the name of the same person. The effect of replacement is that, if the national registration is not renewed, the holder of the international registration may	<p>This paragraph provides that replacement takes place automatically and the holder may notify CIPO that its national registration should be replaced by the IR (Article 4bis (2) of the Madrid Protocol). It should be clarified in the regulations how this will be implemented administratively. What happens if an owner fails to notify CIPO (not required) and then also fails to renew its national registration? What happens to the replaced national registration if the IR is cancelled during the 5 year dependency period?</p> <p>How will a registration that is geographically limited be dealt with?</p>

	continue to benefit from the earlier rights acquired by reason of that national registration. Although replacement takes place automatically, the holder of the international registration may request the Contracting Party take note in its register of the international registration.	
56	<p>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:</p> <ul style="list-style-type: none"> <li>a. both registrations are owned by the same person and identify the same trademark;</li> <li>b. all the goods and/or services listed in the registration are also listed in the international registration; and</li> <li>c. the international registration takes effect after the date of the registration.</li> </ul>	It should be clarified that all information 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 trademark registration has the priority date of the registered trademark in respect of all the relevant goods and services covered by the registered trademark.	A different term than “priority date” should be used here.
59	<p>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:</p> <ul style="list-style-type: none"> <li>a. the number of the international registration</li> </ul>	It should be clarified that all information 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.

	<p>in question,</p> <p>b. the filing date and number of the application for registration of the trademark</p> <p>c. the registration date and number of the registration</p> <p>d. the priority date, if any, of the registration and</p> <p>information relating to other rights acquired by virtue of the registration in Canada.</p>	
63	On transmittal of change of ownership received from the International Bureau, the Register shall update the Register.	Recommend that the proposed regulation confirm that the Register may reserve the right to declare that the change in ownership shall have no effect in Canada in accordance with Rule 27 of the Common Regulations.
64	<p>Requests to record a change of ownership must be forwarded to the International Bureau. The Registrar will only accept for submission and forward to the International Bureau a request to record a change of ownership if all of the following conditions have been met:</p> <p>a. the assignee cannot obtain the assignor's signature on the request to record the change;</p> <p>b. the assignee is a national of, is domiciled in, or has a real and effective industrial or commercial establishment in Canada;</p> <p>c. the assigned goods/services apply to the designation in Canada; and</p> <p>d. the Registrar has received evidence</p>	<p>We recognize that this provision may not be the ultimate wording to appear in the Regulations. In any event, the second sentence appears to be incomplete. We suggest that an amendment along the following lines be entered:</p> <p><u>In a case where a request to record a change of ownership does not include the assignor's signature</u>, the Registrar will only accept for submission and forward to the International Bureau a request to record a change of ownership if all of the following conditions have been met.</p>

	satisfactory to the Registrar of the change of ownership.	
65	Section 39 of the <i>Trade-marks Act</i> does not apply with respect to an IRDC.	It should be clarified why the provisions regarding division of applications, for example, to deal with examination or opposition issues, not apply to IRDCs.
	<b>Part 3 – Proposed Amendments to Opposition and Section 45 Summary Cancellation Proceedings</b>	
	<b><i>Correspondence – Opposition and Summary Cancellation Proceedings</i></b>	
1	Amend section 36 of the <i>Trade-marks Regulations</i> 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 to the other party a copy of that correspondence.	It is suggested that these provisions be amended to require a party to forward a copy of any correspondence to the other party <u>contemporaneously</u> with the filing and the consequences for non-compliance should be mentioned.
3	<p>Amend subsections 37(1) – (2) to provide for service in relation to opposition and summary cancellation proceedings as follows:</p> <p>Service in respect of any opposition or summary cancellation proceeding before the Registrar may be effected:</p> <ul style="list-style-type: none"> <li>a. in person;</li> <li>b. by courier;</li> <li>c. by facsimile up to a maximum of 20 pages; or</li> <li>d. in any other manner with the</li> </ul>	<p>It is recommended that both fax and e-mail should be treated the same.</p> <p>We question why it is necessary to obtain consent from the other party for the use of registered mail.</p> <p>For consistency with the other amendments, it seems that Section 37(3)-(6) of the Regulations should be repealed.</p>

	<p>consent of the party being served or their trademark agent.</p> <p>Unless the parties have agreed otherwise, service on a party that has appointed a trademark agent shall be effected on that agent.</p>	
10	<p>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:</p> <ul style="list-style-type: none"> <li>a. Fixing the time by which a step in the proceeding shall be taken;</li> <li>b. Specifying the steps that shall be taken to prepare the case for a hearing; and</li> </ul> <p>Directing how the hearing of the case will be conducted.</p>	<p>Will a party be able to apply for case management?</p> <p>IPIC welcomes the opportunity to review the issue of case management in more detail with CIPO. As commented earlier to CIPO, the use of case management at the Federal Court was necessary as many actions were taking a number of years to get to a hearing. In contrast, trademark oppositions and cancellation proceedings already have strict, numerous, prescribed deadlines. There may not be the same need for case management for oppositions. Other issues include the adding of another administrative layer and increasing costs and decreasing flexibility. IPIC is interested in engaging in further dialogue with CIPO before finalizing its position on case management.</p>
17-21		<p>There is some concern that the proposals will not necessarily permit a party to submit relevant evidence after cross-examination. It is suggested that the regulations provide a reasonable opportunity for parties to obtain an extension of time to file additional evidence following cross-examination, and not be refused such an extension without a strong reason.</p>
22	<p>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.</p>	<p>The reference to “41(1)” [in 22] appears to be incorrect.</p> <p>The time limit of two months is too short and a minimum of three months would appear to be much more appropriate given the size of the task.</p> <p>In addition, the opponent should be given the right to file a rebuttal, to address any issues raised in the applicant’s written arguments. This might reduce te number of requests for oral hearings.</p>

23	Within two months after the expiry of the time for the opponent to file written representations, the applicant may file written representations with the Registrar and shall serve a copy on the opponent.	
24	No written representations shall be filed after the expiry of the periods referred to in sections (1) and (2), except with leave of the Registrar.	
25-29		<p>The time limit of one month is too short, and should be extended to at least 2 months.</p> <p>In addition, given that the Opposition Board, in its current form of notice to the parties confirming the hearing date, obliges the parties to file and serve a list of cases upon which they intend to rely, together with copies of any unreported decisions, within a certain time period of time prior to the hearing date, this requirement should be included in the Regulations.</p>
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.	Our comments are the same as with respect to Items 22 and 23. We suggest that each party have three months to prepare their written representations, rather than two.
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.	Our comments are the same as with respect to Items 22 and 23. We suggest that each party have three months to prepare their written representations, rather than two.