

November 28, 2014

BY FAX: (819) 953-2476
BY E-MAIL: darlene.carreau@ic.gc.ca

Canadian Intellectual Property Office
Trade-marks Branch
50 Victoria Street
Room C232-35B
Place du Portage II
Gatineau, QC
K1A 0C9

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

Re: Discussion Document regarding amendments to the
Regulations of the *Trade-marks Act*

Dear Ms. Carreau:

We are writing in response to the request for comments in respect of the above Discussion Document.

Obtaining Information relating to “Use” of a Trade-mark

A primary shift under the new system is the change in registration requirements as it relates to the “use” status of a trade-mark, in that “use” of a mark in Canada will no longer be required to obtain registration.

While we understand that requiring an applicant to have “used” a mark prior to registration is not permitted under the Madrid Protocol, we believe there would be tremendous benefit for trade-mark owners to provide use information at the outset of filing, indicating whether they have used the trade-mark or not. While no legal status would attach to the provision of the “use” information, in our view, obtaining this information up front, and having it published in the on-line CIPO records, would provide valuable notice to others. This could assist in limiting or avoiding oppositions and disputes that would otherwise occur. This proposal could be easily accomplished. It is a requirement under the Madrid Protocol and the Singapore Treaty that an Applicant has an intention to use a mark. Therefore, on an application form there could be two boxes – one to signify that the mark has not been used and the Applicant has an intention to use the mark; another to signify that the mark has been used and the Applicant has an intention to continue to use the mark.

We note that the proposal would accord with practices in other countries. For example, under the Madrid Protocol, if India, Ireland, New Zealand, Singapore or the United Kingdom are designated in an international application, the applicant must declare that he has the intention to use the mark by himself or by another with his consent in that country in connection with the

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goods and services identified in this application. If the United States is designated in an international application of another country, it is compulsory to annex to the application a form containing a declaration of intention to use the mark.

Coupled with the requirement to provide this information on the initial application form, a trade-mark owner would also be permitted to voluntarily file a declaration of use at any time after filing its trade-mark, even after registration. While this statement need not be policed by the Office, as it would simply be filed at the Office, to serve as an effective notice of use to others, it should be reflected on the Trade-marks Register, similarly to the manner in which security interests are currently filed with the Office and reflected on the Register.

Other issues

We also note that the proposal identifies the means by which certain non-traditional marks may apply for registration, including color, sound, hologram, moving image, and position marks, but does not indicate the manner in which applications are to identify scent, texture, mode of packaging and taste marks. We believe it would be useful to provide guidance on this point.

We thank you for the opportunity to provide our input on these issues. Should you have any questions, please do not hesitate to contact:

Sébastien Gardère
(514) 847-4486
sebastien.gardere@nortonrosefulbright.com

or

Adrienne Blanchard
(514) 847-4750
adrienne.blanchard@nortonrosefulbright.com

Yours truly,

NORTON ROSE FULBRIGHT CANADA LLP/S.E.N.C.R.L., s.r.l.

Norton Rose Fulbright Canada LLP/S.E.N.C.R.L., s.r.l.

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