

Proposed Amendments to the Trade-marks Regulations 2014

***Consultation Comments Provided By Ridout & Maybee LLP
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Part 1 - Proposed Amendments to the *Trade-marks Regulations* -

Examination and General Provisions

Correspondence

...

The proposed amendments include:

1. Amend subsection 3(4) of the Regulations to replace the reference to the *Trademarks Journal* to reference the website of the Canadian Intellectual Property Office.

Will the advertisement information be easily accessible? Does this mean that publication can or will occur at any time and not necessarily every (or nearly every) Wednesday?

2. ...
3. Amend subsections 3(7) and 3(8) to comply with Rule 6(8) of the *Singapore Regulations* which, for electronic communications, provides that the date on which an Office receives the communication, shall constitute the date of receipt of the communication.

Does this mean that if a due date falls on a weekend, it must be met by the due date (in other words the "next business day" no longer is applicable and if yes, will CIPO provide IT support 24/7?

4. ...
5. ...
6. ...
7. ...
8. ...
9. ...
10. ...
11. ...

12. ...

13. ...

14. ...

TM Agents

Amendments are being proposed to reflect the amendment to s.28 of the Act, which provides that trademark agents may now be appointed to act on behalf of registered owners and parties to opposition proceedings and section 45 proceedings as well as others in all business before the Office of the Registrar of Trademarks. These amendments are permitted in accordance with Article 4 of the *Singapore Treaty*.

Presumably "trademark agents" still must be "registered" trademark agents. Consider adding the word "registered." Rule 3 of the Common Regulations under the Madrid Protocol also contemplate the appointment of a representative by the applicant or holder.

The proposed amendments include:

15. ...

16. ...

17. ...

18. ...

19. ...

20. ...

21. Add a new provision to provide that despite the above provisions with respect to the appointment of a trademark agent, that any person may pay a registration or renewal fee.

What about possible fraud? What are the consequences if someone not authorized by the owner underpays a required amount?

Third Party Correspondence – TM Examination

...

The proposed amendment is as follows:

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

pertinence pertaining to the registrability of the applied for trademark. The acceptance of such correspondence will not result in the commencement of *inter partes* 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 *Patent Act*). The Registrar will forward a copy of any such correspondence which it determines to be pertinent to the applicant.

Can the applicant file comments in reply and if yes, will the applicant's comments be provided to the third party?

Address for Service

...

The proposed amendments include:

23. ...

24. ...

25. The Registrar ~~may require~~ [shall require that] 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:
- a. does not have an agent with a Canadian address; and
 - b. 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 *Singapore Treaty*)

Consider making paragraph 25 mandatory as suggested above rather than permissive.

26. Where the applicant, registered owner or others including parties to the proceedings under sections 38 and 45 ~~does do~~ not provide the Registrar with an address for service upon request, or where such person fails to keep such address up to date, they ~~will~~ *may* no longer be served with documents in relation to their application, registration or ongoing proceeding under section 38 or 45 of the Act.

It is possible that a "mail forwarding" type of arrangement still could result in service in the case where a party has moved. So perhaps this should be more permissive.

General

...

The proposed amendments include:

27. ...

28. ...

29. Amend section 14 to provide that:

- a. The Registrar will refuse to take cognizance of any document submitted to the Registrar that is not in the English or French language unless a translation of the document into one of those languages is submitted to the Registrar.
- b. An application for the registration of a trademark must, with the exception of the trademark, be entirely either in English or in French.

Applicant should not have to supply its name and address in English or French.

- 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.

Is there any consequence contemplated for not submitting the original upon request by the Registrar?

Advertisement of Applications

...

The proposed amendments include:

30. ...

31. ...

32. ...

Application for Registration

33. ...

34. ...

Application Requirements

...

35. Create a new provision that, for the purposes of section 30(2) [(d)] of the Act, the following information is required for a complete application for registration
- a. The name and address of the applicant or in the case of joint applicants, the name and address of each applicant.
 - b. An address for correspondence, if any
 - c. Where the applicant has a trademark agent, the name and address of that agent.
36. ...

Representation or Description of the Trademark

...

The proposed amendments include:

37. ...
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 Trademarks Journal, the Registrar may require an applicant to submit a new representation.

In light of paragraph 1 above, should not the reference to the "Trademarks Journal" be replaced with reference to the website for consistency?

39. ...
40. ...
41. Create a new provision to provide that the representation or description of the trademark must relate to only one trademark.

How is this meant to differ from Rule 24 of the current Regulations?

Standard Characters

42. For the purposes of subparagraph 31(a) of the Act the list of standard characters adopted by the Registrar will appear, as amended from time to time, on the web site of the Canadian Intellectual Property Office.
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.

3D, Scent, Taste, Texture, Colour, Sound, Hologram, Moving Image, Mode of Packaging, Position

Consider requiring a description of the trademark in cases where the representation and view(s) are not clear.

44. ...

3D

45. An application for the registration of a trademark that contains or consists of a three-dimensional shape, must contain a graphic representation. Where the Registrar considers that the different views and/or description do not sufficiently show the particulars of the three-dimensional trademark, the Registrar may invite the applicant to furnish specimens of the trademark (Rule 3(4) of the *Singapore Regulations*).

Does "graphic" still have the same meaning here as under paragraph 39 above (i.e. "visual, pictorial or graphic")? Will a photograph satisfy either or both of the graphic representation requirement and specimen request?

Single colour or a combination of colours without delineated contours

46. ...

Sound

47. ...

Hologram

48. ...

Moving Image

49. ...

Position

50. ...

51. ...

Goods and Services

...

The proposed amendments include:

52. Add a new provision to provide that the goods and/or services must, as far as practicable, be specified in terms appearing in any listing of goods and services that is published by the Registrar via the Canadian Intellectual Property Office web site.

Consider replacing "practicable" with "available and applicable."

53.

Processing of Trademark Applications

...

The proposed amendment is as follows:

54. ...

Nice – Registered Trademarks

...

The proposed amendment is as follows:

55. ...

Division and Merger of Applications

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The proposed amendments are as follows:

Divided Applications

56. ...

57. ...

Merger of Divided Applications

58. ...

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
- c. are classified according to the same edition of the Nice Classification.

Can an older registration be re-classified to effect the merger of two registrations?

Amendments

...

The proposed amendments include:

60. ...

61. Amend section 31 of the Regulations to provide that no application for the registration of a trademark may be amended where the amendment would change,

- a. the identity of the applicant, except after recognition of a transfer by the Registrar or to correct an error in the naming of the applicant;
- b. the trademark, unless the trademark remains substantially the same;

- c. the statement of goods or services so as to be broader than the statement of goods or services contained in the application at the time the application was filed.
62. Amend section 32 of the *Regulations* to provide that no application for the registration of a trademark may be amended, after it has been advertised to change:
- a. the identity of the applicant, except after recognition of a transfer by the Registrar or to correct an error in the naming of the applicant;
 - b. the trademark, unless the trademark remains substantially the same;
 - c. the statement of goods or services so as to be broader than the statement of goods or services contained in the application at the time of advertisement.

Query whether two separate sections are required since the above changes can be made before or after advertisement. What about after registration? It would be helpful to be able to make such changes after registration too.

63. ...

Advertisement of Application for Registration

64. ...

Transfers

65. ...

66. Amend section 49(1) of the *Regulations* to provide that where the Registrar receives a request to record a partial transfer of a trademark application from either the applicant or the transferee, the request must indicate the list of goods and/or services associated with the trademark that are to be transferred to the transferee. Ensure subsection 49(2) specifies that the application owned by the transferee is a continuation of the original application for the purpose of preserving the benefit of the date of filing of the application, but shall otherwise be treated in subsequent proceedings as a separate application.

Will s. 49(1) be amended to delete the reference to "for use"?

67. ...

Renewal

...

The proposed amendments include:

68. ...

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.

Will IT support be available 24/7? What if CIPO's website is down the last day for renewing a registration?

The Register

...

The proposed amendments include:

70. ...

71. ...

Part 2 - Implementation of the Madrid Protocol

...

General

...

The proposed new regulations include the following:

Purpose

1. The purpose of this part of the *Trade-marks Regulations* is to carry into effect in Canada the Madrid Protocol.

Application

2. For the purpose of this part, the *Trade-marks Act* and *Trade-marks Regulations* apply, to the extent applicable and with all necessary modifications to

any applicant for an international registration for which Canada is the Office of Origin, holder of an international registration designating Canada and any holder of a protected international trademark, unless and to the extent that:

- a. this part provide[s] otherwise; or
- b. any provision of the *Trade-marks Act* or *Trade-marks Regulations* is inconsistent with the Madrid Protocol or the Common Regulations.

Definitions

3. Create the following definitions:

Basic application means the application for the registration of a trademark that has been filed with the Office of a Contracting Party and that constitutes the basis for an application for the international registration of that trademark.

Basic registration means the registration of a trademark that has been registered by an Office of a Contracting Party and that constitutes the basis for an application for the international registration of that trademark.

Common Regulations means the regulations adopted under Article 10 of the Madrid Protocol, with effect from 1 April 1996, as replaced, revised, or amended from time to time.

Contracting Party of the holder has the meaning given by Rule 1 (xxvibis) of the Common Regulations.

Date of request means, in relation to an international registration designating Canada, the date the notification of the request for extension of protection to Canada is sent to Canada from the International Bureau.

Date of International Registration means the date recorded in the International Register as the international registration date for a trademark in respect of which a request was made under Article 3^{ter}(1) of the Protocol for extension of protection to Canada.

Date of Recording means the date recorded in the International Register as the recordal date for a request made under Article 3^{ter}(2) of the Protocol for extension of protection to Canada.

Holder means the person in whose name the international registration is recorded in the International Register.

International Application means an application to the International Bureau for registration of a trademark in the International Register.

International Bureau means the International Bureau of the World Intellectual Property Organisation.

International Register means the register of trademarks maintained by the International Bureau for the purposes of the Madrid Protocol.

International Registration means the registration of a trademark in the International Register.

International Registration designating Canada (IRDC) means an international registration requesting extension of protection to Canada under Article 3^{ter} (1) or (2) of the Madrid Protocol.

Office of Origin has the meaning given by Article 2(2) of the Protocol.

Protected International Trademark means a trademark to which protection resulting from the international registration of the mark is extended in Canada in accordance with this part of the Regulations.

Madrid Protocol means the Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks, adopted at Madrid on 27 June 1989, as amended from time to time.

Register means the register of trademarks kept under section 26 of the Act.

Application of International Registration (Canada as Office of Origin)

...

The proposed new regulations include:

Eligibility to Apply for International Registration (*Article 2(1)(i) of the Protocol*)

4. ...
5. ...
6.

Application for International Registration (Rule 9(1) and (2) of the Common Regulations)

7. An application for international registration shall:
- Comply with the requirements of the Madrid Protocol (the applicant shall use the official form issued by the International Bureau (MM2) or another form that requires the same information and uses the same format);
 - The international application shall be in English or French;
 - Be filed with the International Bureau through the intermediary of the Office of the Registrar of Trademarks; and
 - Be accompanied by the certification fee (if any) set out in the Tariff of Fees.

Will there be any other consultation regarding the fees which CIPO is entitled to fix at its own discretion and collect for its own benefit pursuant to Article 8(1) of the Protocol? No information has been provided regarding what CIPO is contemplating regarding the possible certification fee nor whether it will vary depending on the number of classes of goods and services involved.

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).

What if the website is not available? Will IT support be available 24/7 or will an alternative method of filing (such as fax or paper) be possible?

9. ...

Functions of the Registrar

10. ...
11. ...
12. 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,—
- within 5 years after the date of the international registration; or
 - 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.

It should be clarified that the Registrar's obligation to notify the IB applies to any applicable Court orders. Also, what will be the implications for this provision if the "dependency" on the IR or basic application eventually is eliminated? Discussions about such possibility have occurred internationally. Perhaps contingency language should be considered.

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 specified in the Registrar's notice in order to ensure the application is sent to WIPO within 2 months.
- a. the international application is not filed on the proper form, and does not contain all the indications and information required by that form;
 - 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;
 - 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;
 - 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;
 - 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;
 - 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;
 - g. the applicant is not eligible to file an international application through the intermediary of the Registrar in accordance with Article 2(1)(i) of the Madrid Protocol; or
 - h. the prescribed fee is missing or insufficient.

How quickly will IAs be reviewed? Paragraph 13 suggests that the review will be mostly a "formalities" type of review (as contemplated by Article 3 of the Protocol) but perhaps this should be clarified.

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).

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.

If, subsequent to the "deeming," an applicant is not precluded from starting the IR process over again, consider stating that this is the case.

16. The date of the international application is the date on which the Registrar receives the request (and the certification fee, if any) so long as it is received by the International Bureau within two months from the date the Registrar receives the request. Otherwise, it is the date received by the International Bureau.
17. Any fees payable to the International Bureau under the Madrid Protocol shall be paid directly by the applicant to the International Bureau.

Given the potential complexity of fees payable for IAs/IRs, it would simplify the process for applicants if they could pay CIPO directly for all fees (as contemplated by Rule 34(2) of the Common Regulations under the Protocol). Otherwise, applicants nonetheless could be responsible for a certification fee to CIPO and other fees payable to the IB. Also, what happens to fees paid to the IB in cases where CIPO is unable to certify and forward the IA to the IB within two months or if the missing or insufficient fees mentioned in paragraph 13 h are not remedied within the 6-month period mentioned in paragraph 15?

Irregularities – Rule 12 & 13 Common Regulations

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 Bureau by the Registrar.

What about irregularities under Rule 11(4) of the Common Regulations under the Protocol? These are issues over which CIPO, as the Office of Origin, has control and should remedy.

International Registrations Designating Canada (IRDC)

...

The proposed new regulations include:

Examination of International Registrations designating Canada.

19. An IRDC that the International Bureau transmits to the Registrar is deemed to be filed in accordance with section 30 of the *Trade-marks Act* (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:
- a. The international registration date, if the request for extension of protection was filed with the international application;
 - 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
 - c. The date of priority claimed pursuant to paragraph 25 below.

Query whether the deeming language underlined above puts Canadian applicants at a disadvantage since their applications could be subject to opposition for non-compliance with new s. 30(2) of the Act. Potentially, paragraph 19 removes a ground of opposition that otherwise should be available in connection with IRDCs under new s. 38(2)(a) of the Act and is inconsistent with paragraph 21 below.

20. ...

21. Subject to the provisions relating to opposition below, an IRDC shall be subject to opposition under section 38 of the Act.

Priority claim of an IRDC

22. ...

23. For the purposes of section 16(1)(a) of the Act, "filing date" in that section means the earlier of:
- a. The international registration date, if the request for extension of protection was filed with the international application;
 - 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

- c. The date of priority claimed pursuant to paragraph 25 below.

Since paragraph 24 mentions an IRDC, while paragraph 25 mentions a request for extension of protection to Canada, similarly for consistency paragraph 23 should clarify that the request for extension of protection relates to Canada.

- 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.
- 25. The holder of an international registration with a request for extension of protection to Canada is entitled to claim priority within the meaning of Article 4 of the Paris Convention for the Protection of Industrial Property if:
 - a. the request for extension of protection contains a claim of priority; and
 - b. the date of international registration or the date of the recordal of the request for extension of protection to Canada is not later than 6 months after the date of the first regular national filing (within the meaning of Article 4(A)(3) of the Paris Convention for the Protection of Industrial Property) or a subsequent application (within the meaning of Article 4(C)(4) of the Paris Convention for the Protection of Industrial Property).

Grounds for Refusal (Rules 17(1), (2) and (3) Common Regulations)

- 26. ...

Refusals

- 27. ...
- 28. ...
- 29. ...

Notice to International Bureau

- 30. 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:
 - a. A notification of refusal based on an examination of the IRDC.
 - b. A notification of refusal based on the filing of an opposition to the IRDC.
 - c. A notification of the possibility that an opposition to the IRDC may be filed after the end of that 18-month period.

Query whether paragraph 30 is subject to continued pendency of the basic application. Regarding paragraph 30 b, presumably once an opposition has been filed, it is subject to all applicable procedural delays which, if the opposition is not settled, will take it well past the 18 months mentioned above until a decision is rendered. What about the possibility of a retroactive request for extension of time oppose the application (but see paragraph 37 below) or a request to withdraw allowance because of a timely filed but overlooked extension request? Will CIPO wait one month after the expiry of the opposition deadline before taking another step? If the 18-month period expires during that one month, does that mean that CIPO will transmit a notification to the IB pursuant to paragraph 30 c?

31. ...

32. ...

33. ...

Opposition

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.
35. The statement of opposition shall be filed with the Registrar of Trade-marks by using the online service that may be accessed through the Canadian Intellectual Property Office's website (if available).

What if the online service is not available? Unless IT support will be available 24/7, an alternative method of filing (fax or paper) should be provided. Consider changing "shall be" to "may be." What about addresses in Canada for correspondence and service? A Canadian opponent should not be required to effect international service.

Extension of Time to Oppose

36. The Registrar may, if requested, extend the deadline for filing a statement of opposition:
- a. By up to 2 months, without the consent of the holder of the international registration; or
 - b. Up to 3 months, with the holder's consent.

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.

37. The Registrar shall not grant a retroactive extension of time to file a statement of opposition if the request is received more than 1 month after the deadline for filing a statement of opposition.
38. ...

Counterstatement

39. ...

Evidence

40. 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.
41. 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.

Paragraphs 40 and 41 should be reversed. Will all other opposition procedures and timelines (such as cross-examination, representations, extensions of time, etc.) apply?

Decision

42. In addition to the notification of the parties to an opposition of the Registrar's decision pursuant to section 38(12) of the *Act*, the Registrar will simultaneously to the International Bureau, confirm refusal for protection of the mark or send a statement to the effect that protection is granted in Canada for the opposed goods and services. If the Registrar's decision is appealed pursuant to section 56 of the *Act* and a further decision or decisions issue, the Registrar will make any

necessary changes to the Register and notify the International Bureau pursuant to Rule 18ter3 (4) of the Common Regulations.

Will the initial confirmation of refusal sent to the IB indicate that the refusal is subject to possible appeal within two months of the Registrar's decision?

Cancellation and Expungement

43. ...

44. ...

Protected International Trademarks – Rights and Protection

...

The proposed amendments include:

45. ...

46. ...

Specifically, the following terms need to be substituted into sections 19, 20, 21, 51.01-53.1 and 55 for application to international registrations:

...

Protections

47. ...

Renewals

48.

Transformation

...

49.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:

- 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:
 1. the international registration number;
 2. the date of cancellation of the international registration;
 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
 4. address for service, if any.
- 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.

The underlined language seems to be too narrow when one considers Article 6(3); it could be an appeal, action or opposition or a withdrawal of the IA prior to the expiry of the 5-year period with the decision or result occurring after the expiry of the 5-year period. This should be taken into account in the provision to be drafted.

50.If the trademark is the subject of an IRDC, the *Trade-marks Act* and *Trade-marks Regulations* apply for the purposes of the application as if it were an application for registration.

- 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
- b. If the IRDC in respect of the trademark included a priority claim, the priority date allowed under the claim; and
- 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.

What is intended to be covered by paragraph 50 c? Examination? Advertisement? Does it mean that any procedural steps taken in connection with the IRDC which are the same as any steps which would have been taken in respect of a national application are considered to have been taken in connection with the transformation application? This should be clarified.

51.If the transformation application is in respect of a protected international trademark, the *Trade-marks Act* and *Trade-marks Regulations* apply as if it were a

registration and the date of registration is deemed to be the date of the certificate of grant of protection.

- 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.

If the whole of an international registration is cancelled and no application for transformation is filed, should there no longer be a "protected international trademark" in Canada? This should be clarified.

- 53.Notification of any such application for transformation will appear on the Canadian Intellectual Property Office's website.

Replacement

...

- 54.Upon written request from the holder, the Registrar shall record the replacement of the Canadian registration with the international registration in the Register and publish a notice thereof.

Will this apply to a Canadian basic registration once it is more than 5 years old? Article 4bis of the Protocol does not appear to preclude this (but we note that Rule 21(1) of the Common Regulations refers to the Office of a designated Contracting Party, while Article 4bis refers simply to the Office of a Contracting Party). If yes but if it cannot occur until the basic registration is more than 5 years old, perhaps the provision could address this. For example, any request by the holder prior to the fifth anniversary should not be processed until after 5 years.

Can an IR replace a Canadian registration which is limited geographically? By analogy, paragraph 65 indicates that the divisional provisions in new s.39 of the Act will not apply to an IRDC.

- 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 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.

Similar comments as above under paragraph 54 regarding possible application to basic registration more than 5 years old.

56. 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:
- both registrations are owned by the same person and identify the same trademark;
 - all the goods and/or services listed in the registration are also listed in the international registration; and
 - the international registration takes effect after the date of the registration.

Will any of the Claims, Action Information and/or Footnotes currently appearing in the database in respect of Canadian registrations be maintained? This information often is useful for assessing rights and considering strategies. As well, this is to be contrasted with the more limited information found on the official register or Intrepid database.

57. The holder of an international registration that meets the requirements of subsection 21(1) of the Common Regulations may file a request to note replacement of the registration with the international registration. If the request contains all of the following, the Registrar will make a notation on the Register of the replacement and publish the notation **on** in the Journal and **on** the Canadian Intellectual Property Office's website:
- The number of the international registration; and
 - the registration number of the replaced registration.

Should the reference to the Journal be deleted altogether in light of paragraph 1 in Part 1?

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.

This appears to mimic the language in Rule 21(1)(iii) of the Common Regulations but it's not clear what this means, particularly in respect of any registrations which have issued or will issue in Canada prior to the coming into force of the

changes to the Trade-marks Act passed on June 19, 2014.

59. 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:

- a. the number of the international registration in question,
- b. the filing date and number of the application for registration of the trademark
- c. the registration date and number of the registration
- d. the priority date, if any, of the registration and
- e. information relating to other rights acquired by virtue of the registration in Canada.

Regarding paragraph 59 e, see comments above under paragraph 56.

Change in Ownership of International Registration

...

The proposed amendments include:

60. An IRDC or protected international trademark is transferable subject to paragraph 64(a) below, and deemed always to have been transferable, either in connection with or separately from the goodwill of the business and in respect of either all or some of the goods or services in association with which it has been used.

Rule 27(4)(b)(ii) of the Common Regulations contemplates that a Contracting Party might refuse to recognize a transfer (or declare that a change in ownership has no effect) because it is not lawful or does not comply with applicable laws. Consider whether paragraphs 63 and 64 a should be expanded to include address this issue.

61. The assignee must be a national of, is domiciled in, or has a bona fide and effective industrial or commercial establishment either in a country that is a Contracting Party or in a country that is a member of an intergovernmental organization that is a Contracting Party.

62. Nothing in paragraph 60 prevents an IRDC or protected international trademark from being held not to be distinctive if as a result of a transfer thereof there subsisted rights in two or more persons to the use of confusing trademarks and the rights were exercised by those persons.

63. On transmittal of change of ownership received from the International Bureau, the Register shall update the Register.

As mentioned under paragraph 60 above, this provision should be made subject to the Registrar's discretion to declare that the change of ownership has no effect pursuant to Rule 27(4) of the Common Regulations.

64. 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:

- a. the assignee cannot obtain the assignor's signature on the request to record the change;
- b. the assignee is a national of, is domiciled in, or has a real and effective industrial or commercial establishment in Canada;
- c. the assigned goods/services apply to the designation in Canada; and
- d. the Registrar has received evidence satisfactory to the Registrar of the change of ownership.

As mentioned under paragraph 60 above, consider whether paragraph 64 a should be amended to include a reference to possible unlawfulness of the change of ownership.

Divisionals

65. Section 39 of the *Trade-marks Act* does not apply with respect to an IRDC.

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

General Opposition and Section 45

...

Regarding cancellation proceedings, the elimination of the requirement to declare "use" prior to registration, coupled with an inability to cross-examine on evidence filed by a registered owner in response to a s. 45 Notice, could put an undue burden on businesses wishing to adopt and commercialize trademarks (or "confusing" trademarks) which essentially are "deadwood" on the register.

Correspondence – Opposition and Summary Cancellation Proceedings

1. Amend section 36 of the *Trade-marks Regulations* 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.

Should "filed" read "granted?" Will it be necessary to copy an applicant or its agent on the first request for extension of time to oppose? This should be clarified since, technically, at that stage there is no "opposition proceeding." Also, to be consistent with the next point, paragraph 2 immediately below, there should be no requirement to copy the other party until the initial extension of time to oppose has been granted. This is to be contrasted with any requirement to "serve" the Statement of Opposition but it is noted that neither current nor amended s. 38(1) of the Trade-marks Act imposes a requirement to "serve" the Statement of Opposition; rather it provides merely that any person may file the Statement of Opposition on payment of the prescribed fee. This also is to be contrasted with the evidentiary provisions under s. 38 which mention both filing and service.

2. A party corresponding with the Registrar in respect of a summary cancellation proceeding after a notice has been issued shall forward to the other party a copy of that correspondence.

Service – Opposition and Summary Cancellation Proceedings

...

The proposed amendments include:

3. Amend subsections 37(1) – (2) to provide for service in relation to opposition and summary cancellation proceedings as follows:

In light of the comments above, it should be clarified that service does not apply to the initial request for an extension of time to oppose, the Statement of Opposition and the request for issuance of a s. 45 Notice.

Service in respect of any opposition or summary cancellation proceeding before the Registrar may be effected:

- a. in person;
- b. by courier;
- c. by facsimile up to a maximum of 20 pages; or
- d. in any other manner with the consent of the party being served or their trademark agent.

Unless the parties have agreed otherwise, service on a party that has appointed a trademark agent shall be effected on that agent.

Regarding paragraphs 3 a and b, would service of a CD or DVD containing the party's evidence in person or by courier (as opposed to originals) constitute service of that evidence or would that be considered service "in any other manner" requiring consent?

Regarding paragraph 3 c, does the maximum number of pages include the letter to the Trademarks Opposition Board and the fax cover? What is the consequence of 21 or 22 pages being served by fax without consent having been obtained? Would the provision contemplated by paragraph 4 below apply and if yes, what if the Registrar does not require proof and the other party does not object until late in the proceedings, such as at the oral hearing stage? Would the provision contemplated by paragraph 6 below apply instead?

4. Create a new provision regarding proof of service:

If the Registrar has reasonable grounds to believe that any material in respect of an opposition or summary cancellation proceeding has not been served within the prescribed time, the Registrar shall request that proof of service be submitted to the Registrar within a time specified by the Registrar. If proof of service is not submitted within the specified time, the material shall be considered not to have been validly served and the Registrar shall not have regard to it unless the Registrar deems the material to be validly served pursuant to paragraph 5 below.

5. Create a new provision which sets out effective dates for the various methods of service, as follows:
- a. "in person" – service is effected when delivered to the party, or left at the party's address of record
 - b. "by courier" – service is effected on the date indicated on the receipt received from the courier service

- c. “by facsimile” – service is effected on the date appearing on the transmission record as indicating successful transmission

There is no mechanism provided for ascertaining the effective date of service in any other manner such as email or other electronic communication. Could the parties agree to the effective date?

- 6. Create a new provision which provides that the Registrar may consider a document to have been validly served, and deem it to have been served within the time for doing so, if the Registrar is satisfied that the document came to the notice of or was received by the person to be served within a reasonable time after the deadline for doing so.
- 7. Replace section 38 of the *Trade-marks Regulations* with a provision that provides that if filed in paper form, a statement of opposition shall be filed with the Registrar in duplicate.

Would a Statement of Opposition filed by fax need to be filed in duplicate? Either way, the provision should clarify this.

- 8. ...
- 9. If a person files a copy (including an electronic copy) of an affidavit or statutory declaration with the Registrar, the person shall retain the original version for at least one year after the expiry of the appeal period set out in section 56 of the Act and file it with the Registrar upon request.

It is noted that a similar type of provision does not apply to assignments which affect title. Query the need to retain original affidavits or statutory declarations for so long.

Case Management – Opposition and Summary Cancellation Proceedings

...

These proposed amendments include:

- 10. 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:
 - a. Fixing the time by which a step in the proceeding shall be taken;

- b. Specifying the steps that shall be taken to prepare the case for a hearing;
and
- c. Directing how the hearing of the case will be conducted.

Will the parties have an opportunity to request case management? For example, consider the following additional language: Provide that the Registrar may, on the Registrar's own initiative or at the request of any party, ... Is the hearing mentioned in paragraphs 10 b and c the "oral hearing" in the proceedings (and if yes, does this include by videoconference, teleconference, etc., as well as hearing related matters together) or a "case management hearing" (such as a teleconference)?

- 11. The Registrar must inform the parties of the proposed directions in writing and seek their comments before issuing such a ruling. In making such a ruling, the Registrar must consider all the surrounding circumstances of the case and must balance the procedural interest of the parties and the public interest.

How will the Registrar inform the parties of proposed directions? Will directions be proposed only after consultation with the parties or will the Registrar act entirely on the Registrar's own initiative until the parties are invited to comment on the draft ruling? The former would be preferred over the latter.

Opposition Proceedings

Evidence – Opposition Proceedings

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Proposed amendments

Opponent's Evidence

- 12. The portion of subsection 41(1) of the *Trade-marks Regulations* before paragraph (a) is replaced by the following:

***41.(1)** Except if the application is abandoned or deemed under subsection 38(11) of the Act to be abandoned, within four months after the expiry of the time for filing the counter statement, the opponent shall,*

If the applicant's due date is December 1, 2014, will the language "within four months after the expiry of the time for filing..." mean that the opponent's initial due date for filing and serving its evidence or the requisite statement will be April 1, 2015, regardless of the date when the applicant actually files and serves its Counter Statement? This point should be clarified, perhaps by way of practice notice or by adding language along the lines of the underlined wording.

Applicant's Evidence

13. The portion of subsection 42(1) of the *Trade-marks Regulations* before paragraph (a) is replaced by the following:

***42.** (1) Except if the opposition is withdrawn or deemed under subsection 38(10) of the Act to have been withdrawn, within four months after the expiry of the time for submitting the opponent's evidence or statement referred to in subparagraph 41(1)(a), the applicant shall*

Same comments as above under paragraph 12.

Reply Evidence

14. The portion of section 43 of the *Trade-marks Regulations* before paragraph (a) is replaced by the following:

***43.** Except if the application is abandoned or deemed under subsection 38(11) of the Act to be abandoned, within one month after the expiry of the time for submitting the applicant's evidence referred to in subparagraph 42(1)(a), the opponent*

Similar comments as above under paragraph 12. Also, consider increasing "one month" to two months.

Leave Provisions

....

15. Amend section 40 of the *Trade-marks Regulations* to provide that leave will be granted if the Registrar is satisfied that it is in the interests of justice to do so having regard to all the surrounding circumstances, including
- a. the stage the opposition proceeding has reached;
 - b. the reasons for not amending the statement of opposition or counter statement sooner;
 - c. the importance of the amendment; and
 - d. the prejudice that will be suffered by the other party if the amendment is accepted.

Consider changing "will" in paragraph 15 d to "may be" since "will" assumes that the other party will suffer prejudice regardless. Consider adding a provision that the request for leave shall be accompanied by the amended Statement of Opposition or Counter Statement that the party proposes to submit.

16. Amend section 44 of the *Trade-marks Regulations* to provide:

44. (1) No further evidence shall be submitted by any party except with leave of the Registrar, on such terms as the Registrar determines to be appropriate.

44. (2) A request for leave under subsection (1) shall be accompanied by the evidence that the party proposes to submit.

44. (3) Leave shall be granted under subsection (1) if the Registrar is satisfied that it is in the interests of justice to do so having regard to all the surrounding circumstances, including

- a. the stage the opposition proceeding has reached;*
- b. the reasons for not submitting the evidence sooner;*
- c. the importance of the evidence; and*
- d. the prejudice that will be suffered by the other party if the evidence is admitted.*

44. (4) The Registrar's grant of leave to file an affidavit or statutory declaration under section 44(1) of the Regulations will be made conditional on the affiant or declarant being made available for cross-examination. Unless indicated otherwise, a grant of leave under section 44(1) of the Regulations will have no effect on any outstanding deadlines.

Consider changing "will" in s. 44(3)d. to "may be" since "will" assumes that the other party will suffer prejudice regardless.

Cross-Examination

...

The proposed amendments include:

- 17.A party in an opposition proceeding may, at any time up until four months after the expiry of the time for submitting the opponent's reply evidence under section 43, cross-examine under oath or solemn affirmation the affiant or declarant of any affidavit or statutory declaration.

Similar comments as above under paragraph 12.

- 18.Cross-examinations shall be held on a date, at a time and place and in a manner before a person agreed to by the parties or their agents.
- 19.In the absence of an agreement, any of the parties may request that those matters be designated by the Registrar. The Registrar shall grant the request if the party seeking to conduct the cross-examination establishes that they have been unable to reach an agreement with the other party despite having made reasonable and timely efforts to do so, and that there has been no undue delay in making the request.

Would two requests by one party to the other party to schedule cross-examination(s) constitute sufficiently "reasonable" efforts? What would be considered "timely"? If the other party "stalls for time" would that lead to a finding of "timely" if the request is not made of the Registrar until close to the end of the 4-month period?

- 20.Before the expiry of the time limit for completing the cross-examination:
 - a. the party who conducted the cross-examination shall file with the Registrar and serve on the other party a transcript of the cross-examination and exhibits to the cross-examination; and

Consider adding "any" before "exhibits" since there may not be exhibits in every case. This would be consistent with reference to "any documents or materials" in paragraph 20 b below.

- b. the party whose affiant or declarant was cross-examined shall file with the Registrar and serve on the other party any documents or materials undertaken to be submitted by the party.

21. An affidavit or statutory declaration shall not form part of the evidence on record if the affiant or declarant declines or fails to attend for cross-examination.

Written Representations

...

Section 46 of the *Regulations* is proposed to be replaced by the following with respect to written representations and hearings in opposition proceedings:

22. 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.

Similar comments as above under paragraph 12. Also, will any extensions of time be possible?

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.

Similar comments as above under paragraph 12. Also, consider a one-month period for possible "reply" submissions by the opponent. Otherwise, would reply submissions be possible with leave?

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.

Oral Hearings

...

These amendments include the following:

25. Within one month after the expiry of the time for the applicant to file written representations, any party wishing to make representations to the Registrar at a

hearing shall file with the Registrar and serve on the other party a request for hearing that:

- a. Specifies whether the party intends to make representations in English or French
- b. Specifies whether the party will require simultaneous translation if the other party makes representations in the other official language; and
- c. Indicates whether the party wishes to make representations in person, by phone or by other means of communication offered by the Registrar and sets out any information necessary to effect the chosen means of communication.

Similar comments as above under paragraph 12. What about any request for an oral hearing submitted prior to the one month period, such as contemporaneously with the written submissions? Also, paragraph 25 c presupposes that the parties will know what information the Registrar requires to arrange, for example, representations by videoconference. Typically, a test run by the IT people at both (or more) locations is helpful to ensure smooth functioning on the day of the actual event (oral hearing in this case). Greater details/guidance about the "information necessary" would be helpful.

26. Following receipt of a request from at least one party who wishes to make representations to the Registrar at a hearing, the Registrar shall send the parties a written notice setting out the time, date and place of, and other details concerning, the hearing.
27. If only one of the parties files a request to make representations, and if, after a notice is sent pursuant to paragraph 26 above, that party withdraws its request, the Registrar shall notify both parties that the hearing is cancelled.

What are the implications for the other party if one party requests a hearing, the Registrar sends the notice contemplated by paragraph 26 above and then the other party confirms, belatedly, a desire to be heard?

28. ...
29. ...

Geographical Indications

30. ...

Section 45 Summary cancellation Proceedings

...

Written Representations

...

These amendments include:

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.

What about service of the registered owner's evidence? Why not two months from the expiry of the period for the filing and service of the registered owner's evidence?

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.

Similar comments as above under paragraph 12. Also, consider a one-month period for possible "reply" submissions by the requesting party. Otherwise, would reply submissions be possible with leave?

33. No written argument shall be filed after the expiry of the time for the registered owner to file written representations, except with leave of the Registrar.

Hearings – Summary Cancellation Cases

The proposed amendments aim to establish clear, prescribed date for parties to request a hearing in summary cancellation proceedings and align with the proposed amendment for requests for hearings in opposition cases detailed above.

These amendments include the following:

34. Within one month after the expiry of the time for the registered owner to file written representations, any party wishing to make representations to the

Registrar at a hearing shall file with the Registrar and serve on the other party a request for hearing that:

- a. Specifies whether the party intends to make representations in English or French
- b. Specifies whether the party will require simultaneous translation if the other party makes representations in the other official language; and
- c. Indicates whether the party wishes to make representations in person, by phone or by other means of communication offered by the Registrar and sets out any information necessary to effect the chosen means of communication.

Similar comments as above under paragraph 12. What about any request for an oral hearing submitted prior to the one month period, such as contemporaneously with the written submissions? Also, paragraph 34 c presupposes that the parties will know what information the Registrar requires to arrange, for example, representations by videoconference. Typically, a test run by the IT people at both (or more) locations is helpful to ensure smooth functioning on the day of the actual event (oral hearing in this case). Greater details/guidance about the "information necessary" would be helpful.

35. Following receipt of a request from at least one party who wishes to make representations to the Registrar at a hearing, the Registrar shall send the parties a written notice setting out the time, date and place of, and other details concerning, the hearing.
36. If only one of the parties files a request to make representations, and if, after a notice is sent under paragraph 35 above, that party withdraws its request, the Registrar shall notify all the parties that the hearing is cancelled.

What are the implications for the other party if one party requests a hearing, the Registrar sends the notice contemplated by paragraph 35 above and then the other party confirms, belatedly, a desire to be heard?

37. ...

Part 4 - Coming Into Force

It is the intention of the Registrar that the new regulations will come into force 30 days after the day on which they are registered.

In light of the number and complexity of changes, which will require internal training for many firms/practitioners as well as unrepresented persons, consider a period of 60 days for the changes to the Regulations to come into force.