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Ms. Darlene Carreau
Chair, Trade-marks Opposition Board
Canadian Intellectual Property Office (CIPO)
50 Victoria Street, Room C232-35B
Gatineau, Québec K1A 0C9

Dear Ms. Carreau:

Re: Smart & Biggar/Fetherstonhaugh Comments Concerning
Proposed Amendments to the Trademark Regulations 2014

These submissions are being filed on behalf of Smart & Biggar / Fetherstonhaugh, in response to the request for comments from CIPO to the proposed amendments to the Trademark Regulations 2014.

We would first like to thank CIPO for the opportunity to provide comments.

We have reviewed the proposed amendments and have prepared comments below using the same numbering as set out in the proposal.

Part 1

Item 22

This provision would allow third party correspondence to be filed and considered during prosecution.

While we are not necessarily opposed to this provision, we do have some serious concerns. As well, we would appreciate having an opportunity to comment more thoroughly once proposed wording has been prepared. We would like to have a better sense, for example, as to whether or not the third party correspondence can relate to any issue (descriptiveness, confusion, distinctiveness, whether or not the applicant actually

has an intention to use the mark in Canada, etc.) or whether the third party correspondence would have to be limited to certain specific issues (such as confusion).

We have some concerns about Examiner training. If third parties are permitted to submit correspondence on any and all issues, Examiners will be required to be trained in a significantly broader range of areas, such as the laws of evidence and must be able to assess the reliability and relevance of any and all documents and correspondence filed. We are concerned that it is simply not practical to provide the requisite training to all Examiners who will have to consider such third party correspondence.

As well, given the strict time constraints imposed under the Madrid Protocol, we are concerned that this practice could unnecessarily extend prosecution time.

Given that oppositions already provide a robust forum for third parties to raise concerns, we wonder if such a practice is necessary or beneficial.

It is our understanding that the Trademarks Office intends to only consider submissions of information related to documents that Examiners can now consider, namely trademark applications and registrations as well as dictionary definitions. If that is the case, we recommend that the regulations make this clear.

Item 25

We believe that 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.

Item 29(c)

We recommend that this sub-section be amended to allow the opposing party to request that the original affidavit be submitted to the Registrar. There are many cases where the copy provided to the opposing party is simply not sufficiently clear to see all relevant details.

We suggest that there should be consequences for failing to retain the original. For example, if the original is not retained and a portion of the exhibits is not clear, a negative inference should be drawn.

Item 31

We suggest that 31(f) be amended, in the case of a certification mark, to include the standard.

Item 44

This provision refers to a case where “an applicant wishes to claim colour as a distinctive feature of the trademark...”

This provision should apply to any case where colour is claimed as a feature of the mark. There does not appear to be any need to include the word “distinctive”. We recommend that the word “distinctive” be removed.

Item 62(b)

Under current Section 32 of the Regulations, it is not possible to amend the trademark after advertisement. We are opposed to the current proposal which would allow the trademark to be amended after advertisement, unless the proposal is changed to require that the amended application be re-advertised. Otherwise, it would be unfair to third parties who might have opposed the amended mark but not the original mark.

Item 68

This provision only contemplates the initial renewal of the registration but not subsequent renewals. To be consistent with Section 46(2) of the *Act*, we suggest that the proposal be amended as follows:

...will be 12 months beginning 6 months before the initial renewal period or renewal period expires.

Item 69

We are concerned about this provision in the case where the on-line service is not available. Section 46(5) of the *Act* only permits an extension of time of seven days to renew a registration. If CIPO’s on-line service is not available for seven days, the registrant would lose its rights.

The wording of Item 69 is to be contrasted with, for example, Items 8 and 35 of Part 2, which specify “if available”. We therefore suggest that wording such as “if available” be added to this provision and that another option for payment be made available whenever the online system is not in service.

Part 2

Item 13(d)

We do not understand why “or a colour claim” appears in this provision. It appears inconsistent with 13(e).

Item 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.

Item 18

This item refers to the requirement that the classification or specification of goods and services is to be developed by the applicant in response to an irregularity notice. We believe that it would be helpful to have an option for the Registrar to provide a proposed classification for consideration by the applicant. This would be especially helpful to unsophisticated Canadian applicants and self-represented Canadian applicants.

Item 19

We note that (a) and (b) are mutually-exclusive. We therefore suggest that they be combined, and separated by the word “or”.

Item 23

We have the same comment as with respect to Item 19 above.

If the suggested amendment to Item 23 is entered, Item 24 can be deleted.

This item specifies that it is “For the Purposes of Section 16(1)(a) of the *Act*...” We believe that the reference to “16(1)(a) should be amended to read “16(1)”.

Item 42

We suggest that this provision be clarified to specify that any statements to the International Bureau concerning the status of the application will be delayed until all appeals have been exhausted.

Item 43

We do not believe that the wording “to any extent” is necessary and recommend that the wording be deleted.

Item 49(a)(iv)

We suggest that the wording “in Canada” be added after “address for service”.

Item 52

We believe that the wording “the goods and services” should be amended as “the relevant goods and services”.

Item 57

There is a typographical error. "...on in the Journal" should be "in the Journal".

Item 58

We assume that "priority date" does not mean "convention priority date". If "priority date" does not mean "convention priority date", then we wonder if a term different from "priority date" could be used to avoid confusion.

Item 64

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:

In a case where a request to record a change of ownership does not include the assignor's signature, 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:

Part 3

Item 3

To be consistent with the other amendments, it appears that Sections 37(3)-(6) of the Regulations should be repealed.

Items 22 and 23

These proposals specify that each party has two months to prepare and file written representations. Given that each party must review the file, provide recommendations to the client, seek recommendations from the client, prepare draft written representations for the client's review and make any changes suggested by the client prior to filing, the two month period appears to be short. We suggest that each party be given three months, instead of two, to prepare their written representations.

Items 31 and 32

Our comments are the same as with respect to Items 22 and 23. We suggest that each party be given three months to prepare their written representations, rather than two.

Items 26 and 35

Under the proposal, and consistent with current practice, either party may attend an Oral Hearing, regardless of whether or not they filed written representations. There is significant unfairness and prejudice where a party who did not file written representations appears at the Hearing. First, it is unfair to the party who filed written representations, since their case will be known by the other party but not *vice versa*. Second, the situation is undesirable both to the party who filed written representations and the Opposition Board, since both may be taken by surprise and may not have had an opportunity to properly consider all of the relevant issues and case law prior to the hearing.

Accordingly, we recommend that if a party has not filed substantive written representations, then they may only appear at the hearing with leave of the Opposition Board. As well, if leave is granted, the party would be required to provide a list of all case law upon which it is relying at least one month prior to the hearing.

One other issue

We wish to raise one further issue. Under the new regime, it will be possible to obtain a registration without use anywhere in the world. The widespread concern in the Canadian trademark community is that this could have a negative impact upon trademark owners since this is likely to lead to a more crowded register, more difficulty clearing marks and less certainty as to who may have entitlement in view of prior use. To partly counteract this concern, we recommend that the requirement for a registration fee be maintained. The requirement for a registration fee at the end of the trademark application process will be helpful to dissuade applicants who do not actually intend to use their marks in Canada. This should help lead to a less cluttered register for searching purposes, provide for a register which more closely reflects marks in use in the Canadian marketplace and will provide greater commercial certainty to businesses when adopting a mark.

We would be pleased to discuss any of these items or any other issues relating to the proposed amendments to the Regulations. Please do not hesitate to contact us if we can be of assistance.

Yours very truly,

SMART & BIGGAR


Philip Lapin

PDL:tjt