

**SUBMISSION BY THE  
INTERNATIONAL TRADEMARK ASSOCIATION  
IN RESPONSE TO THE  
CANADIAN INTELLECTUAL PROPERTY OFFICE  
CONSULTATION PAPER:  
*PROPOSED AMENDMENTS TO THE TRADE-MARKS  
REGULATIONS 2014***

**November 29, 2014**

## **Acknowledgements**

This submission was prepared with the assistance of the following INTA committees:

Trademark Office Practices Committee – Canadian Intellectual Property Office Subcommittee

Trademark Office Practices Committee – Madrid System Subcommittee

Famous & Well-Known Marks Committee – Canada Subcommittee

Non-Traditional Marks Committee – Canada Subcommittee

Related Rights Committee – Geographical Indications Subcommittee

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## 1.0 INTRODUCTION

### 1.1 *About This Submission*

Further to the letter from Sylvain Laporte to Etienne Sanz de Acedo dated October 2, 2014, this submission constitutes the response of the International Trademark Association (“INTA”) to the request for comment concerning the Canadian Intellectual Property Office (“CIPO”) discussion document entitled *Proposed Amendments to the Trade-marks Regulations 2014* the “Discussion Document”). INTA appreciates this opportunity to provide our input on this document and welcomes the opportunity to work with CIPO regarding this and any future initiatives concerning amendments to the Canadian trademark laws and regulations and the trademark registration process in Canada.

Our comments regarding the proposed amendments are divided into three parts:

- a. Section 2.0 highlights broad issues of concern arising from the changes to the *Trade-marks Act* as a result of the amendments contained in the *Budget Implementation Act* (Bill C-31). In particular, this part will address how the *Trade-marks Regulations* can and should be amended to address our continued concerns about the changes to *Trade-marks Act* resulting from Bill C-31.
- b. Section 3.0 addresses the CIPO proposals regarding amendments to the *Trade-marks Regulations* as set out in the discussion document. This section tracks the four parts of that discussion document and uses the same numbering.
- c. Section 4.0 addresses other issues relating to the trademark registration process in Canada.

Throughout this paper, reference to the Canadian *Trade-marks Act* is abbreviated to “TMA” and the TMA as recently amended by Bill C-31 is referred to as the “amended TMA”. Reference to the Canadian *Trade-marks Regulations* is abbreviated to “TMR.” In keeping with common Canadian practice sections, subsections, paragraphs and subparagraphs of the TMR are sometimes referred to herein as “Rules.”

### 1.2 *About INTA*

INTA is a not-for-profit membership association of more than 6,800 trademark owners and professional firms from more than 190 countries. The association was founded in 1878 and is dedicated to the support and advancement of trademarks and related intellectual property as elements of fair and effective national and international commerce. INTA members share common interests in the protection of trademarks and the development of trademark law, and they rely on INTA to represent and advocate for those interests with national governments and

international organizations. INTA's diverse membership includes multinational corporations and other business enterprises of all sizes, intellectual property and general practice law firms, trademark agent firms, service firms, trademark consultants, and academic institutions.

INTA currently has 303 member firms and corporations in Canada.

INTA works closely with national trademark offices around the world evaluating their practices, procedures, operations and regulations, and analyzing proposed legislative and regulatory developments relating to trademark registration and enforcement. Reflecting the importance of trademark issues in Canada, in 2012 INTA established within several of its standing committees subcommittees whose mandates are to specifically focus on Canada.

For many years, INTA has also worked closely with the World Intellectual Property Organization (“WIPO”) to move closer to harmonization of trademark law and practices and, in particular, the harmonization of formalities of national offices, resulting in the Trademark Law Treaty 1994 (“TLT”), as well as increasingly widespread adoption of the Madrid System for registration of international trademarks, among other initiatives. INTA has advised national trademark offices around the world on issues regarding adherence to the Madrid Protocol, the Nice Agreement, and the TLT, and, more recently, the revisions to the TLT adopted in 2006 as the Singapore Treaty on the Law of Trademarks. INTA has been pleased to previously provide comments to CIPO regarding the Madrid Protocol and the Singapore Treaty in response to earlier consultation documents.

Further information about INTA can be found at [www.inta.org](http://www.inta.org).

Any questions relating to these comments should be sent to Bruce J. MacPherson, Director, External Relations, at [bmacpherson@inta.org](mailto:bmacpherson@inta.org).

## 2.0 GENERAL COMMENTS

Many of the proposals contained in the Discussion Document are general statements rather than the draft language one might expect to see in the *Canada Gazette*. Consequently, our submissions are based on the information before us, and our position may change once we have had an opportunity to review the actual language that is proposed by CIPO and the Department of Justice. For example Part 2 regarding the implementation of the Madrid Protocol is particularly vague and our interpretation will be subject to the precise language proposed to be used in the Regulations.

### 2.1 *General Comments Regarding Changes to the Trademarks Act Introduced through Bill C-31*

#### **Comments Relating to “Use” as a Requirement for Registration**

“Use” has historically been the foundation of Canadian trademark law, including the registration process. The removal of “use” as a prerequisite to registration, coupled with the absence of any regular, predictable post-registration checks on trademark use, will compromise the currently robust Canadian trademark registration system, and will predictably result in increased costs and uncertainty to stakeholders, and in particular Canadian businesses. These views are shared by many trademark owners, experts, practitioners, and industry organizations, including INTA, representing the interests of stakeholders in the context of the Canadian trademark registration system. Those views were communicated to CIPO and Industry Canada prior to the passage of Bill C-31. INTA saw the release of the Discussion Document as an opportunity for CIPO to propose amendments to the regulations that would serve to ameliorate some of the effects of Bill C-31 and is disappointed that the Discussion Document neither addresses the issues nor attempts to take any step via regulation to assure that the Canadian registration system will retain its robust and informative nature while maintaining compliance with *Madrid*, *Singapore* and *Nice*.

In INTA’s view, two amendments to the proposed regulations are necessary to address the “use” issue:

#### **1. Permitting the voluntary filing of statements of use**

Given the widespread support for maintaining the provision of “use” information as part of the procedure associated with registration of trademarks, INTA recommends CIPO adopt regulatory changes that incentivize applicants (rather than requiring applicants) to provide such information. Recognizing both the usefulness of information about “use,” and the importance of having the Register reflect genuine, reliable rights, applicants and registrants could be rewarded for providing a statement of use in Canada.

Neither the *Madrid Protocol* nor the *Singapore Treaty* prohibits applicants/registrants from *voluntarily* filing statements of use at any time during the lifecycle of the registration: with the application, before advertisement, after registration or upon

requesting renewal. INTA recommends that the TMR, pursuant to s.65(i) TMA, be amended to encourage the filing of voluntary statements of use by providing that applicants/registrants who do file will attain a rebuttable presumption that the trademark has been used in association with the goods/services in Canada from the date(s) stated in the statement(s) for the purposes of opposition and s.45 proceedings.

The form of the statement of use can be prescribed by the Registrar (pursuant to s.65(k) of the TMA) and a fee (pursuant to s.65(j) of the TMA) may be attached. CIPO need not examine the statement. However, the information in the statement of use should be reflected on the Register (accordingly, Rule 52 should be further amended to provide that the Register shall indicate the particulars of any use information filed by the applicant/registrant) and, if filed prior to advertisement, should be reflected in the advertisement particulars (accordingly, Rule 16 should be amended).

This proposal maintains the robust nature of both Canadian trademark law and the Canadian register which benefits both stakeholders and CIPO. Applicants/registrants voluntarily provide the same type of use information that is provided in the current registration system either in the application itself or in a declaration of use submitted prior to registration, while eliminating the delay, uncertainty and strain on CIPO resources that results from the high volume of extension requests endemic in the current declaration of use environment.

## **2. Registrar-initiated s.45 proceedings**

The Government has suggested that it would use s. 45 proceedings as a means to control “abuse.” It is most certainly an abuse of the privileges of registration to allow any registrant to maintain rights beyond the third anniversary of registration without any use in Canada, particularly in light of the predictable rise in the number of conflicts between paper registrations and common law rights that will be a consequence of Bill C-31.

INTA recommends that the TMR, via s.65(i) TMA, be amended to provide that the Registrar shall, after the third anniversary of registration, issue a notice to a registered owner under s. 45 TMA, except in cases where the registered owner has filed a statement of use in the prescribed form (see discussion above regarding “Permitting the voluntary filing of statements of use”) within the preceding three-year period.

INTA also recommends that the TMR be amended to additionally provide that the Registrar shall issue notices under s.45 TMA to all registered owners within the one-year period immediately preceding the expiration of ten years following the date of registration, and each successive ten-year period following the date of registration (thus tracking section 8(2) of the U.S. legislation), except in cases where (a) the registered owner has filed a statement of use in the prescribed form within the preceding three-year period, or (b) the notice would be within three years of the date of issuance of a previous

section 45 notice in cases in which the proceedings led to a final decision under s.45 TMA.

We understand from our discussions with CIPO that administrative resources will not be an issue and that CIPO's position is that it will be able to hire and train additional staff as required to keep up with any increased file load that may be experienced by the Trademarks Branch and the Opposition Board. However, if CIPO should determine that it will have insufficient administrative resources to handle the volume of automatic proceedings, the foregoing could be modified so that the s.45 proceedings could be instituted randomly against the pool of registrations that have no declaration or statement of use on file. If and when the declaration or statement of use is filed, the registration is withdrawn from the pool until the date for the next voluntary declaration of use. The percentage of proceedings initiated would vary with the size of the pool at any given time.

The ability to solicit information on proposed or actual use in Canada is not prohibited by any of the treaties. Rule 7(2) of the *Common Regulations of the Madrid Protocol* permits Contracting Parties to require a declaration of intention to use a mark, including a declaration filed by the applicant, if notification to this effect is made to WIPO. Article 3 of the *Singapore Treaty* permits any Contracting Party to require an application contain some of all of a defined list, including (at (1) (a) (xvi)) "a declaration of intention to use the mark, as required by the law of the Contracting Party," or instead, in Article 3 (1)(b) "[t]he applicant may file, instead of or in addition to the declaration of intention to use the mark referred to in (a) (xvi) a declaration of actual use of the mark and evidence to that effect, as required by the law of the Contracting Party." It is worth noting that Article 3 (3) also permits a Contracting Party to require, where a declaration of intention to use has been filed under (1)(a)(xvi), evidence of actual use. Further, Article 5 provides for a filing date to be given when specific information is filed, including, at (1)(a)(vi) "a declaration referred to in Article (3)(a)(xvi) or the declaration of evidence referred to in Article (3)(1)(b)."

A requirement to provide a statement of use upon renewal also is not prohibited by the *Singapore Treaty*. Article 13(2)(iii) merely prohibits contracting parties from *requiring* that proof of use be provided at the time of a *request* for renewal. It should be noted, specifically, that Canada's largest trading partner, the United States, is a member of the *Singapore Treaty* and does require evidence of use both in the 6th year of registration and upon renewal (or, more precisely, within the one-year period immediately preceding the expiration of ten years following the date of registration, and each successive ten-year period following the date of registration). Specifically, if there will be a renewal fee, Article 13(1)(b) provides that "[f]ees associated with the furnishing of a declaration and/or evidence of use shall not be regarded, for the purposes of this subparagraph, as payments required for the maintenance of the registration, and shall not be affected by this subparagraph." This provision clearly contemplates that declarations or evidence of use are permissible.

Accordingly, “use” information is permitted under the treaties as part of the application process, and the amended TMA is worded in such a way to permit such information to be provided or required in the regulations.

### **Comments Relating to Proposed Changes to the Trademark Register**

It is important to INTA that the usefulness of the Canadian Register as a search tool be protected. INTA is concerned that developments such as destruction of documents will compromise the usefulness of the Register. Even more importantly, the Register currently contains very important information about use, dates of declarations of use, consents, claims under s. 12(2) and s. 14 (related to evidence of distinctiveness before filing) and disclaimers. Trademark owners and IP advisors use that information to make critical decisions about use, marketing and expansion of rights. It is important that this information be protected. Proposals to limit the information provided on the Register contribute to stakeholder costs associated with the responsible use of trademarks in Canada. Further to our recommendation concerning voluntary statements of use, Rule 52 should be amended to provide that the register shall indicate the particulars of any use information filed by the applicant/registrant.

### **Comments Relating to the Implementation of the Madrid Protocol**

INTA has fully supported Canada’s accession to the *Madrid Protocol*, the *Singapore Treaty* and the *Nice Agreement* for more than a decade. However, INTA believes that in-depth consultation by the Government with Canadian trademark owners, experts and other stakeholders is absolutely necessary with respect to the draft implementing regulations. Our comments below, which are related to the treaties and specifically to the Madrid Protocol, should be viewed as just the starting points for further detailed discussions with CIPO on a myriad of issues.

We also would like to note that in joining the Madrid Protocol, other countries and particularly use-based jurisdictions like the United States, took almost two years to consult with the trademark community on drafting implementing regulations, to prepare their systems and procedures for accepting Madrid applications, and to educate the user community. We are pleased that CIPO already has engaged trademark owners and practitioners on this historic milestone for Canada’s trademark system and would encourage the Government to continue its due diligence in preparing Canada to become a leading example as a cutting edge and internationally integrated trademark system.

### **3.0 COMMENTS CONCERNING SPECIFIC PROPOSALS TO AMEND THE TRADE-MARKS REGULATIONS**

Throughout this part of our submission, the proposed amendments to the TMR contained in the discussion paper are reproduced, followed by INTA's comments.

#### ***3.1 Part 1 – Proposed Amendments to the Trade-marks Regulations – Examination and General Provisions***

In the following, we provide general comments as well as comments to many of the proposed amendments in Part 1 in turn.

##### ***Correspondence***

**General Comments:** INTA welcomes confirmation of acceptance of electronic filing for all documents and acceptance of commonly used addresses that may not have street numbers.

On a more general note, INTA believes that electronic correspondence should be permitted more broadly. The Trademarks Office (“TMO”) itself should be encouraged to communicate electronically with users – applicants, registrants and parties in opposition/non-use proceedings. There should be a mechanism whereby such parties could indicate their desire for all correspondence to be received from the TMO electronically, and that the TMO will in turn accept their electronic communications. In addition, the TMO should adopt the practice widely followed in advanced trademark offices around the globe such as in the United States Patent and Trademark Office (“USPTO”) of telephone communications by examiners regarding minor examination issues, with confirmation that necessary amendments will be dealt with as a priority if responses are made promptly. This will resolve many delays in prosecution.

- 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.***
- 2. Amend subsection 3(6) of the Regulations to replace the reference to the Trademarks Journal to reference the web site of the Canadian Intellectual Property Office. Correspondence addressed to the Registrar may be sent at any time by electronic or other means of transmission specified on the web site of the Canadian Intellectual Property Office.***

**Comments:** The proposed changes are generally supported given that the CIPO website is more readily accessible than the Journal. However, to eliminate concerns surrounding the specific location of the information on the CIPO website INTA recommends that a specific website location be included in the proposed amended language and that the link to the “means of transmission” be more prominently displayed on the CIPO website homepage. As a general principle, wherever a provision within the TMR prescribes that

the necessary information is to be located on the CIPO website, that information should be easily navigable from the website homepage.

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.***

**Comments:** INTA would like clarification regarding the impact *dies non* has on the deemed date of receipt of a communication. CIPO has consulted on this concept in the past, and responses have raised concerns about the impact of timing and *dies non* on receipt of documents. Furthermore, s. 66 (2) of the TMA has not been amended, and continues to state that the Office of the Registrar of Trade-marks shall be closed for business on Saturdays and holidays and on such other days as the Minister by order declares that it shall be closed for business.

INTA recommends that each of subsections 3(7) and 3(8) of the TMR be amended to provide that the date on which the Office receives the communication shall constitute the date of receipt of the communication, if such communication was received before midnight local time at CIPO on a date that the Office was open for business. For communications sent on a date that the Office is not open for business, the date of receipt should be deemed to be the following business day.

Notably, the USPTO's *Trademark Manual of Examining Procedure* distinguishes between electronic filing (using the USPTO's TEAS system) and other forms of electronic correspondence such as facsimile and electronic mail. The former is considered to have been filed on the date the USPTO receives the transmission in Eastern time, regardless of whether that date is a day on which the USPTO is closed for business (§303.1 TMEP). However, the USPTO treats the filing date of an e-mail communication (see TMEP §§304 et seq.) or fax transmission (see TMEP §§306 et seq.) as the date the complete transmission is received in the USPTO, unless that date is a date on which the USPTO is closed for business (i.e., a Saturday, Sunday, or Federal holiday within the District of Columbia), in which case the filing date is the next succeeding day that is not a Saturday, Sunday, or Federal holiday within the District of Columbia.

4. ***Repeal subsection 3(9) of the Regulations since electronic submissions will now be accepted for affidavits or statutory declarations.***

**Comments:** None

5. ***Section 4 does not require amendment.***

**Comments:** See General Comments under Part 1 above.

6. *Amend subsection 5(2) to provide that subsection (1) does not apply in respect of a request for the correction of a clerical error under section 33 of the Regulations, provided that the mistake and the requested correction are the same for each application or registration, and that the application numbers or registration numbers of all applications and registrations concerned are indicated in the request. This amendment is required to comply with Articles 12(1)(d) and (2) of the Singapore Treaty.*

**Comments:** None

7. *Amend subsection 5(2) to provide that subsection(1) does not apply in respect of an appointment of agent, which may relate to one or more applications and/or registrations identified in the appointment of agent or, subject to any exception indicated by the appointing person, to all existing and future applications and/or registrations of that person. This amendment is required to comply with Article 4(3)(b) of the Singapore Treaty.*

**Comments:** None

8. *Replace the current requirement in subsection 6(1) of the Regulations by providing that any address required to be furnished pursuant to the Act or these Regulations shall be sufficiently detailed to enable the Registrar to contact the addressee at that address and, in any case, consist of all the relevant administrative units up to, and including, the house or building number, if any. This amendment corresponds to Rule 2(2)(a) of the Singapore Regulations that permits an Office to regulate the form an address should take.*

**Comments:** None

9. *The information provided under paragraph 8 above relating to the applicant's address may, in accordance with Rule 2(2)(c) of the Singapore Regulations also contain any or all of the following:*
  - a. *A telephone number.*
  - b. *A fax number.*
  - c. *An email address.*

**Comments:** INTA would like clarification as to whether this is simply meant to be a further comment pertaining to paragraph 8 above or whether CIPO intends to include this in the TMR.

10. *Delete paragraph 5(2)(e) because "representative for service" has been removed from the Act. Articles 3(1) and (4) of the Singapore Treaty do not permit Canada to maintain the representative for service requirements found in s.30(g) of the Act.*

**Comments:** INTA notes that, while “representative for service” may be omitted, “agent” should not be. Accordingly, the exception from the requirement for single correspondence should extend to changes to agent and agent addresses. INTA recognizes that this exception is set up paragraph 7 above.

- 11. Add a new provision to provide that for the purpose of any communication with the Registrar in the name of 2 or more persons with different addresses, the persons must provide the Registrar with a single address as the address for correspondence. (Rule 2(2) of Singapore). Also provide that where the persons fail to provide a single address, the Registrar will send correspondence to the first listed address.**

**Comments:** None

- 12. Amend subsection 6(2) to provide that as soon as practicable, applicants and other persons doing business before the Office of the Registrar of Trademarks, including registered owners and parties to proceedings under section 38 and 45, and any appointed trademark agent must notify the Registrar of all changes of address. If the Registrar has not been notified of a change of address, the Registrar is not responsible for any correspondence not received. Remove the reference to "representative for service".**

**Comments:** INTA would like clarification on the impact of stating that the parties “must” notify the Registrar of all changes of address. If a party may obtain relief from the consequences of failure to respond to any correspondence by noting that such correspondence was not received due to a change in address, then this should not unduly impact parties or their representatives.

The obligation to notify the Registrar of all changes of address should also apply to all changes of trademark agents’ name and address.

- 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.**
- 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.**

**Comments:** The proposed changes in paragraphs 13 and 14 would eliminate the requirement that the trademark be identified in correspondence with CIPO concerning applications and registrations. While INTA recognizes and appreciates that CIPO desires to streamline correspondence procedures to reduce administrative burden for

correspondents, Committee members studying this proposal were strongly of the view that, to the extent that it would not be contrary to Singapore, the TMR retain the requirement that the trade-mark should be identified in order to safeguard against possible adverse consequences resulting from clerical errors when writing application/registration numbers.

In respect of correspondence pertaining to opposition proceedings, INTA notes that additional identification is required in any event: Rule 35 (for which no amendment is proposed by CIPO) requires that the correspondence clearly state that it relates to the opposition proceeding. Thus, CIPO recognizes that opposition correspondence in particular should require more than the applicant name and number. To the extent that it would not be contrary to Singapore, INTA supports an amendment to the TMR which would require that correspondence to CIPO relating to opposition/s.45 proceedings identify: (1) that it is intended for the Opposition Board; (2) the name of the applicant/registrant; (3) the application/registration number; (4) the trade-mark (where practicable – see comment below regarding non-traditional marks); and (5) the name of the proposed opponent(s)/opponent(s) or requesting party. INTA considers that requiring this information on opposition/s.45 correspondence will be beneficial both to the parties in to the proceeding, and to CIPO and will help to eliminate issues which we foresee may result if the changes in proposed Rules 7(1) and 7(2) are adopted. A clerical error in an application number, particularly where the application opposed is one of several applications filed by the applicant at the same time (and which will be likely to bear sequential or near sequential serial numbers), or the non-identification of an opponent where there are multiple opposition proceedings pending against the same application, can be expected to lead to confusion and delay. This can be forestalled by adopting the additional correspondence identification requirements proposed by INTA.

INTA acknowledges that the trademark cannot appear on all correspondence where the trademark is a non-traditional mark. However, where the mark is capable of easy representation, the Committee members are of the view that requiring its inclusion may provide a check against any clerical error in the application/registration number and allow for quick identification of correct files.

### ***TM Agents***

- 15. Amend section 8(1) to provide that except as otherwise provided by the Act or these Regulations, the Registrar shall only have regard to communications from, as applicable, applicants 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 Trade-marks. Repeal 8(4).***

**Comments:** None

**16. Amend section 8(2) to provide that the Registrar must receive notice in writing that an applicant, opponent, registered owner, requesting party or any other person who is doing business before the Office of the Registrar of Trade-marks has appointed a trademark agent. This notice may come from the agent itself and does not require a signed power of attorney from the applicant, opponent, registered owner, requesting party or any other person who is doing business before the Office of the Registrar of Trade-marks. Subject to the scope of the trademark agent's authority, an agent may act for the agent's principal in any proceeding or take any step on that principal's behalf.**

**Comments:** There is some ambiguity as to whether or not a notice in writing informing the Registrar of the appointment of a trademark agent may be provided as part of any correspondence relating to an opposition or s. 45 proceeding. INTA recommends that a notice in writing to the Registrar separate from any correspondence relating to opposition or s. 45 proceeding should not be required.

**17. If a trademark agent has been appointed and is authorized to act on behalf of a person who is doing business before the Office of the Registrar of Trade-marks, the Registrar shall only have regard to communications from that appointed trademark agent. Repeal section 11.**

**Comments:** None

**18. The Registrar satisfies any requirement under the Act and Regulations for the issuance to, notice on, correspondence with or service on, a person who is doing business before the Office by issuing to, serving on, giving notice to or corresponding with that person's trademark agent.**

**Comments:** None

**19. No amendment is required to section 8(3) or section 9.**

**Comments:** None

**20. Repeal section 10.**

**Comments:** None

**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.**

**Comments:** INTA Committee members are concerned that this change will likely result in increased opportunities for fraud. Canadian registrants are already subject to “scams” by companies around the world who offer to take unnecessary steps, often for

considerable sums of money. Such companies are not easy to locate, and it is difficult for any party seeking recourse for improper conduct to succeed.

INTA recommends that any entity wishing to renew a mark, apart from the registrant or its appointed agent, should be required to first register with CIPO and provide their name, full contact information and an address for service in Canada.

INTA would also like to know whether CIPO intends to continue to issue renewal notices advising that a renewal has been paid and identifying the party that paid the renewal.

With respect to the reference to “registration fee”, some Committee members indicated that they had previously understood from CIPO that the concept of a registration fee was to be eliminated. If registration fees are to remain, does not that necessarily infer a status interval between the conclusion of the opposition period and the issuance of the registration which we understood to have been removed in Bill C-31 through the elimination of the allowance status category?

### ***Third Party Correspondence – TM Examination***

- 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.***

**Comments:** It appears that this proposed change is meant to introduce a procedure similar to the Letter of Protest procedure in the USPTO. The INTA Famous & Well-Known Marks Committee Canada Task Force has prepared detailed submissions for CIPO relating to this proposal and the Letter of Protest procedure. Those submissions are attached as Appendix 1 to this document.

While INTA generally welcomes the proposal, we would like more detailed information as to how CIPO intends that this procedure will work in practice. In particular, INTA would like clarification on following issues:

- (1) How many opportunities will third parties have to send correspondence? How will CIPO ensure that this process will not lead to undue delay in prosecution of a trademark application?
- (2) What will be the test for “pertinence” of a third-party document? What will be the test

to decide whether or not the correspondence will be forwarded to the applicant? Will the Registrar be required to provide reasons for accepting or rejecting the third party correspondence?

(3) What is the impact of both the third party correspondence and the step of forwarding a copy of such correspondence on the applicant? How will third party correspondence affect the examination by the Registrar? Is the intent merely to permit owners of other marks to be assured that the Trademarks Office will have considered the impact of registrability and entitlement issues?

(4) Will applicants be required to respond to both the Registrar's correspondence and that of third parties?

(5) To what extent, if any, will the Registrar's decision to accept or reject third party correspondence relating to the registrability of the trademark, have on an opposition proceeding? Will correspondence deemed not to be pertinent remain part of the record?

(6) Will there be any consequence for the third party in providing correspondence?

(7) Can evidence of prior common law use be used to pre-empt the Office's practice of approving applications based solely on an assessment of filing date?

(8) The CIPO proposal narrowly speaks only to "registrability" (which, under the amended TMA deals only with s.12 and 15 of the TMA). Why should this procedure not also deal with compliance with s.30(2) TMA, entitlement, and distinctiveness issues, all of which are issues for examination under s.37(1) TMA?

INTA recommends that the language in s.22 be amended 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 correspondence – such pertinence pertaining to the registrability of the applied for trademark any ground for refusing registration of the applied-for trademark under section 37 of the Trademarks Act. 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 determine whether such correspondence is pertinent and will then, in accordance with section 37, notify the applicant of his/her objections and reasons for those objections by way of an Examiner's Report, and forward a copy of any such correspondence which it he/she determines to be pertinent to the applicant, or cause the application to be advertised.

*Address for Service*

23. *Where a trademark agent is appointed by an applicant, registered owner or others including parties to the proceedings under sections 38 and 45, that trademark agent's address is considered to be the address for service, provided that it is a Canadian address.*

**Comments:** None

24. *Where no agent is appointed by an applicant, registered owner or others including parties to the proceedings under sections 38 and 45 and they have a Canadian address, that address will be considered to be the address for service.*

**Comments:** None

25. *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:*
- 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)*

**Comments:** Given the importance of service rules in Canada, INTA recommends that “may” above be replaced with “shall” insofar as it is not inconsistent with a treaty obligation. Attempting to contact and serve documents on persons outside of Canada can be time-consuming, expensive and the results uncertain. Requiring a Canadian contact address, most ideally that of a Canadian agent who can be easily identified and contacted, is preferred.

26. *Where the applicant, registered owner or others including parties to the proceedings under sections 38 and 45 does 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 no longer be served with documents in relation to their application, registration or ongoing proceeding under section 38 or 45 of the Act.*

**Comments:** INTA committee members studying this proposal expressed three concerns in respect of this proposed change. First, is it permissible, in accordance with principles of fairness in administrative law, for any tribunal to simply decide to no longer “serve” documents upon a party, for any reason.

Second, assuming it is permissible for the Registrar to decide that a party is no longer to be served with documents, INTA suggests that the triggering test should not be failure to keep an “up to date” address. Instead, the test should be that mail properly served is returned, and that the Registrar has made at least some attempt to contact the party by other appropriate means of communication.

Third, the language “they will no longer be served” would appear to include service not only by the Registrar, but other parties to the proceeding. At what point may a party decide that an applicant, registered owner or other has not kept an address up to date? Suppose a situation where a party knew the actual address of the opposite party, but despite that, the opposite party had not kept its recorded address up to date with the Registrar. The current language allows for the possibility for parties to punish each other for failure to keep addresses up to date, which will inevitably lead to additional time, appeals, judicial reviews and so on. We assume that this is not CIPO’s intention.

INTA recommends that this proposal be reviewed further.

### *General*

#### ***27. Section 12 of the Regulations does not require amendment.***

**Comments:** None

#### ***28. Amend section 13 to provide that documents shall be clear, legible and capable of being reproduced.***

**Comments:** None

#### ***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.***

**Comments:** INTA agrees with this proposed change. To avoid inaccurate machine translations provided by websites such as Google Translate, INTA recommends that any translated documents should be certified translations or be accompanied by a certification that they have been translated by a professional translator to the extent it is not prohibited under Singapore.

- b. An application for the registration of a trademark must, with the exception of the trademark, be entirely either in English or in French.***

**Comments:** There is some concern that the proposed amendment as currently worded may create problems in particular situations. For example, where a foreign applicant in a French-speaking country wishes to file an application in Canada in English, the proposed amendment would appear to prohibit the ability to include in the application the applicant's name and address as it would be written in the French language. Such a result is not desirable, and we assume cannot be what CIPO intends. INTA recommends that it be clarified that this requirement does not apply to local addresses, to the extent that such addresses refers to locally used street or other geographic names, nor to any part of the applicant name.

Also, an application that is filed by an applicant in English and which has received objections to certain of the specifications under s.30(a) may be assigned (e.g. during examination) to a French speaking applicant who then wishes to amend the impugned wares specifications by reference to her own language; the CIPO proposal would seem to preclude the assignee from so doing. Would CIPO object to such an assignee making a discrete amendment using her own language resulting in some of the discrete wares being written in English and some of the discrete wares being listed in French? Can an applicant elect to receive correspondence in English if the application is filed in French (or vice versa)? Would CIPO permit the entirety of the application to be amended via translation from English to French? Additionally, query whether this proposed revision would require an application to extend a statement of wares/services to be filed in the same language as the original application?

- 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.*

**Comments:** This proposed new provision confirms that CIPO will accept for filing copies (whether electronic or paper) of affidavits or statutory declarations and provides that the original must be retained by the person that filed the documents. INTA generally supports the proposed Rule, but recommends that CIPO issue a practice notice that would deal with requests by a party opposite to view the original affidavit or statutory declaration. Also, the proposed regulations do not appear to provide for any consequences for a failure to comply with the retention requirement. INTA suggests that CIPO consider whether an appropriate consequence for a failure to retain is that the Registrar be given explicit discretion to deem the affidavit/statutory not to form part of the evidence submitted and to return the filed copy to the party who filed it. This would give the Registrar the ability to disregard the evidence (such as is presently mandated in a case where an affiant fails to attend for cross-examination) in circumstances where a real issue arises concerning the fidelity or sufficiency of the copy filed with CIPO, but would

not mandate such a severe sanction where any issue concerning the filed copy is relatively minor and the failure to retain can be evidenced as having resulted from uncontrollable circumstances such as fire, natural disaster, war, acts of terror, etc.

### *Advertisement of Applications*

**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.**

**Comments:** The *Journal* will no longer include the particulars of every registration of a trademark made or extended pursuant to the TMA, nor will it include the particulars of the Registrar’s rulings required to be published pursuant to section 64 TMA.

Rule 15(b) reads “the particulars of every registration of a trademark made or extended pursuant to the Act.” INTA would like confirmation that CIPO does not intend to stop publishing extension applications for opposition.

We recommend that Rule 15(b) be amended to delete the words “made or” and retain the “extended” portion of it.

**31. Amend section 16 to provide that the advertisement of an application must contain:**

- a. The representation, description or both of the trademark;*
- b. The name and address of the applicant and the applicant's trademark agent, if any;*
- c. The application number;*
- d. The filing date of the application and priority date, if any;*
- e. 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;*
- f. In the case of an application for a certification trademark or a trademark consisting of standard characters, a note to that effect;*
- g. The particulars of any translation or transliteration; and*
- h. In the case of evidence of acquired distinctiveness and/or the particulars of the territorial restriction, a note to that effect.*

**Comments:** Under this amendment, Rule 16 would no longer require that an advertisement of an application include a note of disclaimer or a summary of the information filed by the applicant pursuant to sections 30(a) to (d) and (g) of the Act. Instead, section 16(e) would require that the application provide the names of the goods or services, grouped in the classes of the Nice Classification. Further, while section 16(g) currently requires a note to be made of an application for a proposed trademark, certification mark or a distinguishing guise, the proposed amendment would require it to

be noted if the application relates to an application for a certification trademark or a trademark consisting of standard characters. Also, the proposed amendment would no longer require the application to note when the applicant has claimed the benefit of subsection 12(2) or section 14 of the Act. Finally, the amendment would require the application to note evidence of acquired distinctiveness and/or the particulars of the territorial restriction.

In accordance with our general comments about the importance of retaining “use” as a requirement of registration, INTA recommends that Rule 16 be amended to add:

“Such information regarding the date of first use in Canada for any Class of goods or services, or any specific goods or services, or any statement of proposed use that the applicant, pursuant to these Regulations, elects to provide.”

***32. Repeal section 17 of the Regulations as the particulars of every registration will no longer be published.***

**Comments:** See comments at no. 30 above pertaining to applications to extend.

***Application for Registration***

**General Comments:** The new s. 30(2) of TMA permits, “(d) any prescribed information or statement.” In accordance with our general comments about the importance of “use” as a requirement for registration, we recommend adding a new provision that any applicant may provide a statement that its mark has been used in Canada, with the date of first use, on any Class of goods and services, or any goods and services within any Class, or that the applicant proposes to use its mark in Canada.

INTA notes that the Discussion Document provides no directions, either as to possible requirements, or to possible specimens, or to future requirements on the website for marks that consist of taste, scent or texture.

***33. Amend section 24 of the Regulations to only indicate that a separate application must be filed for the registration of each trademark.***

**Comments:** None

***34. Repeal section 25 because the filing date requirements are now in section 33 of the Act.***

**Comments:** None

### *Application Requirements*

35. *Create a new provision that, for the purposes of section 30(2) 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.*

**Comments:** None

36. *Amend section 26 to provide that a Registered Owner of a trademark may file an application to extend under s.41(2) of the Act that must comply with the requirements of the Act and Regulations for filing a trademark application and must also contain the registration number.*

**Comments:** None

### *Representation or Description of the Trademark*

37. *Repeal section 27 of the Regulations. The provision of a "drawing" in accordance with subparagraph 30(h) of the Act has been replaced with the broader concept of "representation" or "description" or both.*

**Comments:** INTA welcomes this change.

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.*

**Comments:** INTA would like clarification as to how this change will impact the common practice of showing the placement of a trademark on an object, for example, a dotted outline of a bottle with a comment that the “bottle does not form part of the trademark.” Being able to show how the mark is displayed is helpful to the examiner and to others who review the Register. We recognize that the proposed change in paragraph 50 below permits a graphic representation showing the placement of the trademark.

We recommend that this proposed change not apply to matter that is included in a representation or description for the purpose of explaining the features of the mark, including the placement of a mark on any goods where the description of the mark

includes a statement that “the portion of the drawing shown in dotted outline does not form part of the mark” or such similar statements.

- 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.**

**Comments:** INTA would like clarification as whether the 8cm x 8cm size limit applies to each individual graphic or the total area for up to as many as 6 graphics.

We also note that representations of sound marks, i.e. the musical staff, could potentially be larger than 8cm x 8cm in order to be legible. Perhaps CIPO could restrict the size by megabytes as with images filed online.

- 40. Repeal section 28 of the Regulations.**

**Comments:** None

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

**Comments:** Concern has been expressed that some trademarks may unwittingly violate the “one trademark” requirement (for example, the application is to register the representation of a mascot bearing a team logo). With this concern in mind, how will unwarranted challenges to applications and registrations on this basis be prevented?

#### **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.**

**Comments:** INTA would like to see the list of standard characters so it may be assessed. The current practice notice titled *Compliance with Paragraph 30(h) – Marks in a Special Form* (Publication date: 1999-03-10) is insufficient.

- 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.**

**Comments:** INTA would like clarification as to what a “view” means and how it will apply to non-traditional marks such as moving images or holograms. For moving images

or objects with more than 6 faces, a limit of six views may be insufficient. Concern has been expressed regarding a need for certainty as to how the Registrar will determine if more than one view is required.

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

**General Comments:** No directions are given, either as to possible requirements, or to possible specimens, or to future requirements on the website for marks that consist of taste, scent or texture.

- 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 Singapore Regulations)***

**Comments:** If colors, per se, are now permissible, it should be confirmed that the “graphic representation” is merely a sample of the color, and not a representation of the color applied to any particular object.

### ***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).***

**Comments:** It is unclear from the description in the Discussion Document whether an applicant can voluntarily submit a specimen as opposed to awaiting invitation from the Registrar.

### ***Single colour or a combination of colours without delineated contours***

- 46. An application for the registration of a trademark that consists exclusively of a single colour or a combination of colours without delineated contours must indicate the name of the colour or colours and contain a graphic representation showing the colour or colours. The applicant may include a reference to an internationally recognized colour system for each colour. (Rule 3(2) of the Singapore Regulations).***

**Comments:** If colors, per se, are now permissible as registrable trademarks, INTA would like a confirmation from CIPO that the “graphic representation” of such a mark is merely

a sample of the color, and not a representation of the color applied to any particular object.

### ***Sound***

- 47. An application for the registration of a trademark that contains or consists of a sound, must contain an electronic recording of the sound in a format specified by the Registrar on the web site of the Canadian Intellectual Property Office.***

**Comments:** None

### ***Hologram***

- 48. An application for the registration of a trademark that contains or consists of a hologram must contain a graphic representation capturing the holographic effect or an electronic recording of the hologram in a format specified by the Registrar on the web site of the Canadian Intellectual Property Office.***

**Comments:** None

### ***Moving Image***

- 49. An application for the registration of a trademark that contains or consists of a moving image must contain a graphic representation depicting the movement or an electronic recording of the moving image in a format specified by the Registrar on the web site of the Canadian Intellectual Property Office.***

**Comments:** The trademark application for a moving image should contain a graphical depiction and word description of each movement in a sequence of still pictures forming the entire motion of the moving mark. The number of frames possible should be limited to ten (10) or less. The purpose of the word description is for the application to be reproduced in the *Trademark Journal*.

### ***Position***

- 50. An application for the registration of a trademark consisting of a position must contain a graphic representation clearly showing the placement of the trademark.***

**Comments:** INTA supports this proposal. However, as noted in our comments to paragraph 38 above, that proposal appears to preclude the inclusion of any matter that shows the placement of the mark but is not a part of the mark. INTA would like clarification on this contradiction. A requirement that the object on which the trademark is placed be depicted in dotted outlines would be helpful; the object is not considered a feature of the mark but merely shows the placement of the mark.

51. *Repeal section 29 of the Regulations (Rule 29(a) and (b) moved to application requirements above and specimens may be required for three-dimensional trademarks).*

**Comments:** None

#### *Goods and Services*

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.*

**Comments:** INTA would like clarification on how CIPO intends to implement the notion of “as far as practicable.”

53. *Add a new provision to provide that goods and/or service 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.*

**Comments:** The amendments to the TMA removed the current requirement that the goods/services be defined specifically. INTA welcomed that change on the basis that the specificity requirement appeared to result in an inordinate number of office actions. However, Rule 53 will introduce three new requirements in place of the deleted specificity requirement. INTA wonders whether the problems which resulted from the specificity requirement will simply be carried over into the new regime.

How is “precise” intended to be different than “accurate?”

#### *Processing of Trademark Applications*

54. *Create a new provision to provide that the prescribed period under section 36 of the Act, where the applicant is in default of the prosecution of an application, will be 2 months. (Rule 9 of the Singapore Regulations)*

**Comments:** INTA would like clarification as to whether this proposal will apply to all applications, including those processed pursuant to the Madrid Protocol. If so, a period of 2 months may be too short. INTA would also like clarification as to when the 2-month period begins to be calculated.

#### *Nice – Registered Trademarks*

55. *Create a new provision to provide that the prescribed time for the purposes of subsection 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.*

**Comments:** We note that neither the amended TMA nor the proposed TMR provide a definition for “Registered Owner.”

INTA would also like clarification on the consequence of failure to comply within one year. Will the Registrar expunge the registration or make the amendments? Could the one-year deadline be extended? Is there any opportunity to argue/challenge the examiner regarding the classification?

### ***Division and Merger of Applications***

#### ***Divided Applications***

**General Comments:** It appears that CIPO is exercising discretion under Singapore Article 7(2) to exclude possibility of dividing registrations. INTA would like confirmation from CIPO on this point.

- 56. Create a new provision to provide that an application for division must be in writing and contain the following information:**
- a. the original application number of the application for registration;***
  - b. in the case of division of classes, a list of the classes to be divided out;***
  - c. in the case of division of goods or services, a list of the goods or services to be divided out;***
  - 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; and***
  - e. the prescribed fee.***

**Comments:** There was some concern expressed about item d of this proposal. This does not appear to be a requirement of the Singapore Treaty. Moreover, a statement from an opponent that the opposition will be withdrawn for the classes, goods and/or services should not be a precondition for acceptance of a divisional application. An applicant may wish to delete classes, goods and/or services regardless of whether an opponent will withdraw the opposition, and a prospective opponent may not be prepared to withdraw the oppositions simply because a divisional application is filed. We recommend that the requirement for a statement from an opponent be removed from item d.

Furthermore, item d also needs to be re-phrased so that oppositions that have been concluded do not interfere with a request for division.

INTA also recommends that the mark itself be included in the list of information to be provided in an application for division.

57. *Create a new provision to provide that where an application has been divided, the part of the application that was divided out will be treated as independent from the application from which it was divided. However, it will retain:*
- a. the filing date or convention priority filing date if any;*
  - b. any documents filed with the Registrar since the filing of the application;*
  - c. any time period for action by the applicant which is outstanding in the original application at the time of the division will apply to each separate new application created by the division.*

**Comments:** None

### *Merger of Divided Applications*

**General Comments:** The title of this section, “Merger of Divided Applications”, is a misnomer. It should be more accurately titled “Merger of Registrations Issuing from Divided Applications”.

58. *Create a new provision to provide that a request to merge a registration should be in writing and contain the following information:*
- a. the registration number that the subject registration will be merged to;*
  - b. in the case of merging only certain classes in the registration, a list of the classes to be merged; and*
  - c. in the case of merging only certain goods or services in the registration, a list of the goods or services to be merged.*

**Comments:** INTA recommends that the mark itself be included in the list of information to be provided in a request to merge a registration.

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.*

**Comments:** Regarding item c, INTA suggests that the different editions of the Nice Classification should be published on the CIPO website.

### *Amendments*

60. *Section 30 does not require amendment.*

**Comments:** None

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.*

**Comments:** None

- 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.*

**Comments:** While flexibility in amending marks is desirable, INTA is concerned that permitting marks to be amended after advertisement has the potential to frustrate agreements reached by parties during opposition. An opponent or prospective opponent may be prejudiced by an amendment to a mark, even one that results in the mark remaining “substantially the same.” It is critical that the opponent’s decision to oppose or not be based on an accurate understanding of the trademark. What the Registrar considers to be “substantially the same” may be viewed quite differently by a prospective opponent.

Note, the interaction between these provisions and the Madrid Protocol must be considered. Once a Canadian applicant files an international application (under the Madrid Protocol), and that international application results in an international registration, the mark cannot be amended in any way (see *Guide to the International Registration of Marks Under the Madrid Agreement* and the Madrid Protocol, BII 72.02). Similarly, a change in the goods and services will impact not only the IR but all applications to extend.

Further, since proposed changes to Rule 31 in paragraph 61 above contains no timing limitation, items a and b appear superfluous in Rule 32, as they are already captured under Rule 31.

- 63. Section 33 does not require amendment.**

**Comments:** None

*Advertisement of Application for Registration*

**64. Repeal section 34 of the Regulations since it is redundant in view of s.37 of the Act and paragraph 30 above.**

**Comments:** None

*Transfers*

**65. Repeal section 48 of the Regulations.**

**Comments:** None

**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.**

**Comments:** None

**67. Amend section 50 to provide that in cases where the Registrar has registered a partial transfer of a trademark registration, each person is deemed to be a separate registered owner of the trademark with a separate trademark registration.**

**Comments:** INTA would like clarification as to whether separate registration numbers will be assigned to the separate trademark registrations.

*Renewal*

**General Comments:** The amended TMA provides that prescribed renewal fees shall be paid. It would be possible, under Article 13 of the *Singapore Treaty* to set a base fee payable for renewal (adjusted, presumably for class fees), and adjust that fee upwards or downwards based on whether, or not, a voluntary declaration of use or evidence of use has been filed. The *Singapore Treaty* seems to suggest that making a declaration of use or evidence of use voluntary, upon renewal, is not prohibited.

In accordance with our general comments about the importance of “use” as a requirement of registration within the Canadian context, INTA recommends that the Regulations be amended to permit filing a voluntary declaration of use upon renewal. This, added to a voluntary declaration of use/proof of use on application, will go a long way to address the many problems identified by

trademark owners, experts and practitioners arising from the elimination of the “use” information requirement from the TMA.

***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 Singapore Regulations).***

**Comments:** Subsection 46(1) of the TMA states:

Subject to any other provision of this Act, the registration of a trademark is on the register for an initial period of 10 years beginning on the day of the registration and for subsequent renewal periods of 10 years if, for each renewal, the prescribed renewal fee is paid within the prescribed period.

The proposed language appears to suggest that renewals can be done only 6 months in advance of the expiry of the ten-year term and for 6 months following the expiry of the ten-year term. Many companies plan for and budget their renewals well in advance of the renewal term.

Therefore, we consider restricting renewals to only 6 months in advance is too short. Instead, we recommend that renewal be permitted up to a year in advance, and with 6 month grace period.

The impact of the proposed change will be to shorten the currently applied grace period. Presumably, the notice of non-renewal will now advise of the 6 month term, now calculated from the actual renewal deadline, rather than the date of the letter from the Registrar.

We recommend that the Registrar send the notice of non-renewal as soon as possible, given the shorter term from the date of the notice.

***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.***

**Comments:** INTA is concerned that requiring only electronic renewal may pose an inconvenience for some trademark owners including small self-represented registrants. Further, in any event, such a requirement should be subject to availability of CIPO's website (contrast this proposal with Part 2 paragraph 8). Subsection 46(5) of the TMA only permits an extension of seven days. In the event that CIPO's website is offline for more than seven days, registrants should not be penalized for the unavailability of CIPO's website.

## *The Register*

### **70. Repeal section 51 of the Regulations as "summary of an application" has been removed from paragraph 26(2)(b).**

**Comments:** Further to our submission to CIPO that neither Bill C-31 nor Bill C-8 had the effect of removing the words “summary of the application for registration” from paragraph 26(2) of the Act, we understand from CIPO that the policy statement in this proposal does not match the amendment proposed in the Discussion Document. CIPO confirmed for INTA that Section 26(2)(b) of the Act has not changed, but that Rule 51 of the Regulations is proposed to be repealed since it contained information no longer required. In addition, CIPO stated that Rule 52 will be amended to include some of the information previously contained under Rule 51, and that in doing so, CIPO considers that it has captured all of the relevant information that should be displayed on the register. INTA has no further comment.

### **71. Amend section 52 of the Regulations to indicate, in respect of each registered trademark, the following particulars:**

- a. The representation or description of the trademark;**
- b. The name and address of the applicant and the applicant's trademark agent, if any;**
- c. The registration number;**
- d. The filing date of the application and priority date, if any;**
- e. 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;**
- f. In the case of a registration for a certification trademark or a trademark consisting of standard characters, a note to the effect;**
- g. The particulars of any translation or transliteration; and**
- h. In the case of evidence of acquired distinctiveness and/or territorial restriction, a note to that effect.**

**Comments:** In respect of item b, in relation to registered trademarks, we believe reference should be made to “registered owner” or “registrant,” rather than “applicant.”

In item c., we believe that the application number should also be displayed on the register so that information concerning partial assignments and divided applications can be readily ascertained.

In respect of item f, we would like clarification as to whether all details of certification will be available on the Register.

In respect of item h, we would like clarification as to whether all details filed during prosecution relating to acquired distinctiveness will remain available on the Register.

Further, since, as noted above, information on use or evidence of use is permitted under the *Singapore Treaty*, the Register should be mandated to display “use” information where such information is voluntarily provided by an applicant or registrant. In particular, we recommend that the provision be amended to add the following item:

- (i) Any information provided by the applicant or registrant with respect to the date of first use or use in Canada, for any Class of goods and services or any goods or services.

Additionally, INTA would like to see information pertaining to licenses, liens, security interests and transfers appear on the register.

### **3.2 Part 2 – Implementation of the Madrid Protocol**

**General Comments:** The Madrid Protocol contemplates the use of declarations of intention to use the mark by Contracting Parties (see Rule 7 of the Common Regulations for the specifics). The Rules state that the Contracting Party should notify the Director General of the declaration of use requirement, and also indicates if a signature of the applicant is required (which, for Canada, should not be necessary).

INTA believes that, in the Canadian context, clearly requiring a declaration of intention to use a mark at filing will 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 application, 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 a subsequent opposition, and only then become aware of the requirement.

Given the historic importance of “use” as a basis for trademark rights in Canada, and the strong views of trademark owners, experts and practitioners already expressed regarding the importance of use, INTA recommends that Canada maintain a requirement for all applicants using the Madrid Protocol to acquire rights in Canada to provide a declaration of intent to use on making the request to extend rights to Canada. This will ensure that all applicants for IRDCs will be protected against the risk of opposition on the basis of a lack of proposed use in Canada at the date of filing.

## *General*

### *Purpose*

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

**Comments:** None

### *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 otherwise; or*
  - b. *any provision of the Trade-marks Act or Trade-marks Regulations is inconsistent with the Madrid Protocol or the Common Regulations.*

**Comments:** None

### *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<sup>ter</sup>(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<sup>ter</sup>(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<sup>ter</sup>(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.*

**Comments:** INTA notes that the definition for “Contracting Party of the holder” is unclear.

Also, INTA recommends a definition for “Date of Protection” be added.

*Application of International Registration (Canada as Office of Origin)*

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

4. *A person who is the registered owner of a registered trademark or an applicant for registration of a trademark may apply for international registration of the trademark.*

**Comments:** None

5. *The person shall:*
- a. *be a Canadian citizen (or a national of Canada);*
  - b. *be domiciled in Canada; or*
  - c. *have a real and effective industrial or commercial establishment in Canada.*

**Comments:** The INTA TOPC Madrid System Subcommittee suggested that the word “or” should appear at the end of part (a), i.e. “*be a Canadian citizen (or a national of Canada); or*”

6. *Two or more persons may jointly apply for international registration of a trademark as allowed by Rule 8 of the Common Regulations.*

**Comments:** INTA seeks clarification on this proposal. Trademark applications and registrations may only be owned by one entity (which includes two or more persons who, by agreement, do not have the right to use the trademark in Canada except on behalf of both or all of them), although splitting via transfer is contemplated by the TMR. Does this proposed rule suggest that two or more parties can join together to apply for a single international registration, as opposed to each filing their own international applications?

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

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 another form that requires the same information and uses the same format);*
  - b. *The international application shall be in English or French;*
  - c. *Be filed with the International Bureau through the intermediary of the Office of the Registrar of Trademarks; and*
  - d. *Be accompanied by the certification fee (if any) set out in the Tariff of Fees.*

**Comments:** With respect to item d, the certification fee is the fee charged by the Originating Office (OO) to ensure that the International Application (IA) both reflects the national application and meets the requirements of the Protocol. It is a fee that will be kept by the OO, and not submitted to the International Bureau (IB). Article 8, permits the

OO to fix and collect “for its own benefit, a fee which it may require from the applicant for international registration or from the holder of the international registration in connection with the filing of the international application or the renewal of the international registration.” Since fees are not part of the current consultation, it is difficult to comment effectively on this proposal.

Nonetheless, INTA recommends that the “certification fee” be in line with amounts collected in other jurisdictions. For example, the United States certification fee is \$100 per class, if the IA is based on a single U.S. application or registration, and \$150 per class if the IA is based on multiple U.S. applications.

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).***

**Comments:** INTA is generally in support of this proposal, as electronic filing is likely to be more convenient for both applicants and the Registrar. However, we recommend that paper filing should remain an option, to guard against the event that the CIPO website may be offline for an extended period of time, and to accommodate situations where an applicant does not have easy access to the Internet. To deter applicants from filing by paper generally, a higher fee could be charged for using this option.

9. ***Any communication for transmittal to the International Bureau through the intermediary of the Registrar shall be in English or French.***

**Comments:** None

#### ***Functions of the Registrar***

10. ***The Registrar shall perform the functions, under the Madrid Protocol, of the Office of origin in relation to:***
  - a. ***the international application; and***
  - b. ***if the international application results in an international registration, the international registration.***

**Comments:** None

11. ***The Registrar shall:***
  - a. ***review the international application; and***
  - b. ***certify that the information in the international application corresponds with the information held by the Registrar in respect of the basic application or the basic registration, as the case requires.***

**Comments:** INTA believes that it would be preferable if this provision specified the "information in the international application" that has to correspond to the information held by the Registrar, as this is not the case for all the possible contents in the international application. For example, a priority claim could apply to the international registration but not to the basic mark. See the language in rule 9(5)(d) of the Common Regulations:

*The international application shall contain a declaration by the Office of origin certifying*

*(i) the date on which the Office of origin received or, as provided for in Rule 11(1), is deemed to have received the request by the applicant to present the international application to the International Bureau,*

*(ii) that the applicant named in the international application is the same as the applicant named in the basic application or the holder named in the basic registration, as the case may be,*

*(iii) that any indication referred to in paragraph (4)(a)(viibis) to (xi) and appearing in the international application appears also in the basic application or the basic registration, as the case may be,*

*(iv) that the mark that is the subject matter of the international application is the same as in the basic application or the basic registration, as the case may be,*

*(v) that, if color is claimed as a distinctive feature of the mark in the basic application or the basic registration, the same claim is included in the international application or that, if color is claimed as a distinctive feature of the mark in the international application without having been claimed in the basic application or basic registration, the mark in the basic application or basic registration is in fact in the color or combination of colors claimed, and*

*(vi) that the goods and services indicated in the international application are covered by the list of goods and services appearing in the basic application or basic registration, as the case may be.*

**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,—**

**a. within 5 years after the date of the international registration; or**

**b. 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.**

**Comments:** This proposal illustrates the dependency of the international registration on the basic application or registration of the applicant in its home country. INTA would like

clarification that the obligation to notify the International Bureau 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 international registration.

Also, the INTA TOPC Madrid System Subcommittee suggested the following change in language:

12. If the international application results in an international registration, the Registrar shall notify the International Bureau if the basic application, the registration resulting therefrom 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,—
  - a. within 5 years after the date of the international registration; or
  - b. after that time, if the action that resulted in the basic application, the registration resulting therefrom or the basic registration being so affected began before the end of that 5-year period.
  
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.*

**Comments:** INTA is concerned that a 2 month deadline in these proposals will inevitably create a “two-speed system”, in which Madrid applications would necessarily have to take precedence over national applications.

The 2 month term originates with Article 3(4) of the Madrid Protocol, which assigns a date to the international registration that is the date the Office of Origin received the international application, if the International Bureau receives it within 2 months. Otherwise, the international registration will be the date the international application was received by the International Bureau. Practically, this will require examination by the Registrar, with a notice of irregularities to the applicant/agent, a response/amendment to the form, approval of any changes by the Registrar and then submission to the International Bureau within 2 months.

Given that current examination of Canadian applications takes 8 to 10 months, INTA would like more detailed information with respect to how CIPO intends to implement the 2 month timeline. With incoming mail, faxes and electronic submissions being misplaced, misfiled, lost and generally guaranteed not to be reviewed for 3 to 4 months after submission, how will the Registrar ensure an application is sent to the International Bureau within 2 months or within other set deadlines for processing of international application and international registration?

Furthermore, the 2 month deadline puts extra pressure on applicants and agents outside of Quebec and Ontario, since it often takes a week for mail to arrive from CIPO to, say, Vancouver. When there is only a two month time period, a one-week difference matters much more. To alleviate this concern, does the Registrar intend to require all correspondence with international application applicants or their agents be sent electronically?

INTA recommends that it should be mandatory that the Registrar raise all irregularities in one single correspondence in order for the remedies to be filed and submission of the international applications to the International Bureau to occur within 2 months. If the Registrar is permitted to raise irregularities in multiple correspondences, submission of the international application to International Bureau within 2 months becomes very unlikely. Applicants or their agents must be given reasonable time to remedy any irregularities, while aiming to meet the 2 month deadline. INTA would like clarification as to how much time the Registrar intends to give applicants or agents to remedy irregularities to meet the 2 month deadline. Will there be a specific cut off or will it be at the discretion of the Registrar?

The suggestion that the Registrar will use “all reasonable efforts” to ensure receipt within the 2 month term by the International Bureau will be cold comfort to an applicant in any case where the Registrar suggests that despite its best efforts, the 2 month date was not met. Given current delays to first examination, the Registrar will have to process international applications at a much speedier rate, or else applicants will lose the benefit of the international application filing date. The Registrar will have to dedicate additional resources to processing international applications.

INTA believes that these proposals will inevitably lead to a “two-speed system” where national applications will not receive the same immediate attention as international applications. INTA would like confirmation from the Registrar that regular applicants, who have the same need for speedy service, should not suffer any delays as a result redirected resources to process international applications and IRDCs, particularly since IRDCs may be a small percentage of the overall filings in Canada.

Comments on specific irregularities listed in paragraph 13:

With respect to item c: does “identical” mean identical in all respects? Currently, an applicant relying on s.14 can rely on a registration abroad for a mark that differs from the applied for mark “only by elements that do not alter its distinctive character or affect its identity.” Also, when claiming priority, this can be done with respect to the “same or substantially the same trade-mark.” Does a Madrid application allow for any leeway in this respect?

Further, suppose an application is filed, then an international application is prepared and certified, and subsequently, the mark is amended as permitted by the proposed amendment to TMR in Part 1 paragraph 62 above, such that the mark is no longer identical to the mark shown in the international application. Given that a mark in an international application or international registration may not be amended, what will happen to the international application in such a situation? Presumably if the basic application is amended to change the mark, the Protocol provisions must result in the loss of rights to protect that amended mark pursuant to the Madrid Protocol. INTA would like clarification on this point.

With respect to items e and f, item e deals with the situation where basic application or registration and international application claim different colors. Item f deals with the situation where no color is claimed in the international application while a color is claimed in the basic application. There is no provision dealing with the situation where no color is claimed in the basic application or registration and a color is claimed in the international application.

With respect to item h, INTA would like clarification that the “prescribed fee” applies to the CIPO Registrar’s filing fees, and not the fees payable to the International Bureau as proposed in paragraph 17 below.

INTA also notes that missing from the list of irregularities in paragraph 13 is the naming of the applicant's representative, the appointment of which can be made in the IA (Rule 3(2)(a) of the Madrid Protocol Common Regulations). We recommend that, since the Rules also provide for communication to be to the representative, and that such communication has the same effect as one addressed to the applicant or holder of an international application or international registration, the Regulations should be amended to include "the name and address of the applicant's representative, if any."

The INTA TOPC Madrid Subcommittee suggested changes in language in items a and c as follows:

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~~ or does not contain all the indications and information required by that form;  
...

c. the representation of the trademark which is the subject ~~to~~ of the international application is not identical to the trademark as appearing in the basic application or basic registration;

***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).***

**Comments:** None

***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.***

**Comments:** As noted in our comments with respect to paragraph 13 above, INTA believes it should be mandatory for the Registrar to raise all irregularities in one single correspondence in order for the remedies to be filed and submission of the international applications to the International Bureau to occur within 2 months. INTA would like

clarification as to whether the 6 month deadline contemplated in this proposal suggest that CIPO intends to permit the Registrar to raise irregularities over multiple correspondences.

- 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.***

**Comments:** None

- 17. Any fees payable to the International Bureau under the Madrid Protocol shall be paid directly by the applicant to the International Bureau.***

**Comments:** Fee calculation and payment will be complicated. In addition to a certification fee payable to the Registrar (mentioned in paragraph 7(d) above), there will be a series of fees payable to the International Bureau, including a “basic fee” and a “supplementary fees” payable per class, both payable to the International Bureau, and the complementary fee and/or individual fee for extensions to other countries. There could be fees set and collected by the Registrar (under Article 8 of the Protocol) payable to it for submitting the international application to the International Bureau. For those payable to the International Bureau, the Protocol Rules assume that an account will be set up with the International Bureau, and fees will be payable in Swiss francs.

INTA recommends that the Registrar make it as easy as possible to pay all fees. The Registrar is permitted to pay all fees itself under Rule 34(2) of the Protocol, rather than requiring an applicant to make those fees directly to the International Bureau, and since the Registrar is also submitting the international application, it would be easier for applicants to request the Registrar to submit the fee with the international application. At least until all involved parties (CIPO, applicants and their agents) become familiar with the procedure, the Registrar should assist both with the calculation of fees and the payment of fees.

#### ***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.***

**Comments:** INTA recommends that any reference to “applicant” as in this proposal should be amended to include to its representative, if any.

INTA also notes that under Rule 12 of the Common Regulations, any issues regarding classification must be dealt with within 3 months, and any implication on fee payment is also time-limited. We recommend that the applicant be fully informed of the implications of the amendments to classification and/or specification on goods or services, so it may ensure that appropriate fees are paid in a timely manner.

### ***International Registrations Designating Canada (IRDC)***

**General Comments:** The basic premise of the Madrid Protocol is that once the application to extend the protection of the international registration is communicated to the national office members, the application will be treated as a national application. No special examination of such applications is required. In keeping with the desire to maintain a robust Canadian registration system informed by information as to actual use as espoused throughout these submissions, INTA recommends that a declaration of intent to use be required, to ensure that IRDC applicants are apprised of the minimum requirement of having at least an intent to use their trademark in Canada.

We understand that CIPO has taken the position that it would not seek to add Canada to the list of Madrid countries for which a designation carries with it a statement of intention to use pursuant to Rule 7(2) of the Madrid Common Regulation. We further understand that CIPO's rationale is based on a desire to treat applications uniformly irrespective of whether they are international registrations or filed directly with CIPO (notwithstanding that it appears that IRDCs will receive preferential treatment in respect of processing and examination times). We also appreciate that applicants of all types will be presumed to know the applicable laws of the Contracting Parties. However, the reality is that applicants filing directly with CIPO are far more likely to have actual knowledge of the requirements of s.30(1) TMA than are applicants who file an IRDC because they are far more likely to be benefitting from the advice of a Canadian trademark agent. Thus, without the benefit of any check concerning intention to use at the time Canada is designated, it appears that IRDC applicants will be more likely to be blindsided during opposition because they are far less likely to have actual knowledge at the time of designating Canada of the requirements under s.30(1) and of the grounds of opposition provided under s.38(2)(e) and (f).

In any event, irrespective of whether Canada chooses to make the declaration provided for under Rule 7(2) of the Madrid Common Regulations, under which by designating Canada the applicant would automatically be declaring it has a genuine intent to use the trademark, INTA recommends that CIPO provide for the voluntary filing of statements of use by all applicants, whether the filings have been done nationally or via Madrid.

### ***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.*

**Comments:** Query whether the proposal was intended to refer to “deemed to be filed in accordance with section 30(2)” as opposed to “deemed to be filed in accordance with section 30.” An application can be opposed for non-compliance with s. 30(2) TMA, and can also be opposed on the additional grounds that the applicant did not propose to use the trademark and did not use in Canada (s.38(2)(e) TMA) and is not entitled to use the trademark in Canada (s. 38(2)(f) TMA). If the scope of the proposed deeming provision is limited to section 30(2), it would appear that an opponent can still oppose via s. 38(2)(e) and (f). However, if the scope of the deeming provision extends to all of s. 30, i.e. (s.30(1) –(4)), deemed compliance with s.30(1) appears to also remove opposition grounds 38(2)(e) and (f) from IRDCs. If this is the case, IRDCs could only be opposed on the grounds of registrability, entitlement and distinctiveness. Perhaps, instead of deeming provisions, the proposal should be amended to create a presumption of compliance, which would be rebuttable. [Note: subsequent to the preparation of this portion of the paper, we learned from a top CIPO official that CIPO’s intent with Item 19 was to consider the application to have been filed in Canada (and not deem that it otherwise complies with all of the new s.30), and that the policy intent is that Madrid applications be examined and subject to opposition in the same way as a domestic application, and that all grounds of opposition will be available against an IRDC. We understand that the language that appears in the draft regulations will be revised to reflect the policy intent.]

Moreover, INTA believes that the deeming should be dependent on the IRDC meeting the Madrid requirements as opposed to the mere fact of the International Bureau’s transmittal. This will be a check against the possibility that the International Bureau transmission of the IRDC is in error.

**20. An IRDC shall be examined as an application for registration, and if on such examination there is no basis on which to refuse protection, the Registrar shall cause the trademark to be published in accordance with section 37 of the Act.**

**Comments:** None

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

**Comments:** None

*Priority claim of an IRDC*

22. *Provide that section 34 of the Act does not apply to an IRDC.*

Comments: None

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.*

Comments: INTA would like confirmation that, in each case above, the “request for extension” will only apply to a request for extension 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.*

Comments: None

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).*

Comments: INTA is unclear as to the possible ramifications flowing from the “subsequent application.”

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

26. *If the Registrar considers that the (requirements for registration – ensure all of section 37 of the Act applies) are not met, or are met only in relation to some of the goods or*

*services in respect of which protection in Canada has been requested, the Registrar shall,*

- a. Give notification of a provisional refusal of the international registration to the International Bureau; and*
- b. Specify in the notification a period within which the holder may respond.*

**Comments:** INTA would like clarification as to whether any deadline or period applies to this proposal.

INTA's TOPC Madrid System Subcommittee also recommends that item b. be revised as follows:

- b. Specify in the notification a period within which the holder may respond, whether the provisional refusal applies to all or only to some of the goods and services for which protection in Canada has been requested, and in the latter specify the goods and services for which protection is provisionally refused.*

### *Refusals*

- 27. If an IRDC is refused, the Registrar shall declare in a notification of refusal that the extension of protection cannot be granted, together with a statement of all grounds on which the refusal is based.*

**Comments:** Given that the decision to refuse an IRDC is a decision of the Registrar under the TMA, presumably a refusal could be appealed to the Federal Court. INTA would like confirmation on this point.

- 28. If an IRDC is abandoned under section 36 of the Act, the Registrar will confirm refusal for protection of the trademark which is the subject of that IRDC.*

**Comments:** None

- 29. Where all procedures before the Registrar have been completed and there is no possible ground for the Registrar to refuse protection, (no office action and no opposition; i.e. no provisional refusal was issued) the Registrar shall, before the expiry of the 18 month period (calculated from the date that WIPO notifies the Registrar of an IRDC), send to the International Bureau, a statement to the effect that protection is granted to the trademark in Canada and issue a certificate of grant of protection.*

**Comments:** Given the current Canadian practice, is the 18 month period realistic?

*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.*

**Comments:** INTA would like confirmation that item 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.*

**Comments:** INTA would like general clarification as to how the time periods contemplated in this proposal will apply. In particular, in what cases will “if applicable” apply? Does “within 7 months after the beginning of the opposition period” mean 7 months after advertisement?

This provision applies to notification of “grounds” of opposition, and not that the opposition decision ought to be made within the time limits herein.

Note, the timing limitations in this proposal appear, as noted in the Discussion Document under “Opposition”, to prevent the use of the maximum 9 month cooling off extension before filing of a statement of opposition. That should encourage parties to proceed with a statement of opposition, as opposed to use all available time to pursue settlement. Practically, this may result in more filed oppositions (as is, for example, the case in Europe). This also would appear to prevent parties from amending the grounds of opposition at any time after the described term of the earliest of “7 months after the beginning of the opposition period or within 1 month after the end of the opposition period.” There are a few other limitations which were noted by Alan Troicuk who advised the Government a few years ago in his paper *Legal and Technical Implications of Canada’s Adherence to the Madrid Protocol*, namely:

S.39(3) CTMA might also need modification since it would not be possible to withdraw an application from allowance to consider a missed request for an extension of time to file a statement of opposition more than seven months after the date of advertisement; as well, a withdrawal from allowance would probably not be possible once the IB has been notified

that the opposition period expired without an opposition having been filed. In addition, some restrictions would need to apply in respect of the grant under subsection 47(2) CTMA of retroactive extensions of time to file a statement of opposition.

INTA also recommends that the TMR be amended to include language to the effect of “statement of all the grounds for the opposition at the time” so as to permit amendments to be made to the grounds of opposition.

**32. *If a notification specified in paragraph 30(a) or (b) is not sent to the International Bureau within the time period with respect to a request for extension of protection, the IRDC shall not be refused and the Registrar shall issue a certificate of grant of protection.***

**Comments:** In the event that the Registrar makes an administrative error and fails to send the notification within the time period even though it ought to have, will the IRDC not be refused? Will the Registrar have the authority to “correct” its error? Would an opponent have to bring a proceeding before the Federal Court to correct the error?

**33. *If the holder is successful at overcoming a refusal with respect to all the goods or services or some of the goods and services and no opposition is filed, the Registrar shall confirm protection in Canada with the International Bureau for all or some of the goods or services and issue a certificate of grant of protection.***

**Comments:** None

### ***Opposition***

**General Comments:** As soon as an opposition is filed, presumably the Registrar will transmit the notification of the opposition to the applicant or its designated representative. At that time, as in other Madrid member countries, the applicant, if it has not done so already, 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.

**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.***

**Comments:** INTA would like to know if there is any possibility to request an extension of time to file a statement of opposition.

**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)***

**Comments:** As noted earlier above, INTA believes that paper filing has to remain an option, for several reasons, and in particular to accommodate circumstances in which the CIPO website is offline. INTA recommends charging a higher fee for filing by paper, to deter applicants from using that option generally.

*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.*

**Comments:** INTA is concerned that this proposal may result in more oppositions being filed in order to preserve the opponent's rights even in the event of ongoing settlement discussions.

INTA would like clarification as to whether an extension of 2 months can be given and then a further third month on consent.

To clarify the timeline set out in these proposal, is it correct that CIPO has given itself a minimum 2 month period to transmit notices of opposition to the International Bureau, with a possible 3 month extension on consent, which results in a maximum of 5 months to file Statement of Opposition post advertisement? And CIPO has 7 months to notify the International Bureau?

Given the deadlines contemplated in these proposals, will the Practice Notice "Practice in Trademark Opposition Proceedings of March 31, 2009" continue to apply or not?

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.*

**Comments:** INTA would like to know whether the opponent has to provide any justification for the retroactive extension of time, or is a request for a retroactive extension of time sufficient.

**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.***

**Comments:** None

***Counterstatement***

**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 Trade-marks Regulations. If the holder fails to comply with this requirement in relation to any goods or services in respect of which protection is opposed:***

- a. The Registrar will treat the holder's request for protection in Canada in respect of those goods or services as withdrawn; and***
- b. The Registrar's refusal will be confirmed to the International Bureau in respect of those goods or services.***

**Comments:** INTA assumes that the provisions relating to a “counterstatement” in the amended s. 38 of TMA will apply to opposition proceedings to IRDCs. We would like confirmation on this point.

INTA would also like to know if any extension of time to file a counterstatement will be permitted.

***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.***

**Comments:** Based on the sequence of steps in an opposition proceeding (i.e. opponent files first) it appears that paragraphs 40 and 41 ought to be reversed.

In paragraph 40, the reference to “application” should be changed to “applicant.”

There are no proposals for written arguments or hearings. INTA would like to know whether the regular provisions for oppositions at this stage will apply. Further, will requests for extension of time be permitted?

The language suggests that an opponent may oppose only in respect of some goods/services. If so, does the application automatically mature to registration in respect of the goods/services not opposed?

### ***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.***

**Comments:** The first sentence of this paragraph should be rephrased. The reference to Rule “18ter3 (4)” is incorrect and should be “18ter(4).”

### ***Cancellation and Expungement***

- 43. The Registrar shall notify the International Bureau if a protected international trademark is cancelled or the goods and services are amended to any extent.***

**Comments:** None

- 44. For the purposes of applying sections 11.14-11.15, 17, 18, 18.1, 45 and 57 of the Act:***
- a. The reference in sections 11.19, 17(2), 18 and 45 of the Act to the date of registration shall be treated as a reference to the date of the certificate of protection;***
  - b. The references to person in section 11.19 and 17 are taken to mean holder.***
  - c. The references to registered owner in section 45 of the Act are taken to mean holder;***
  - d. References in section 45 to the goods or services specified in the registration shall be treated as references to those in respect of which it is protected;***
  - e. References in section 45 of the Act to the registration of a trademark being expunged shall be treated as references to the protection of a protected international trademark (Canada) being revoked; and***
  - f. References in sections 18 and 57 to the registration of a trademark being declared invalid shall be treated as references to the protection of a protected international trademark (Canada) being declared invalid.***

**Comments:** None

***Protected International Trademarks – Rights and Protection***

45. ***From the date of the certificate of grant of protection***
- a. ***such grant of protection shall have the same effect and validity as a registered trademark; and***
  - b. ***the holder of the international registration shall have the same rights and remedies as the owner of a registered trademark.***

**Comments:** None

46. ***Sections 19, 20, 21, 51.01-53.1, 53.3, 54(2) and 55 apply in relation to a protected international trademark. For these sections references to:***
- a. ***A registered trademark correspond to a protected international trademark;***
  - b. ***Goods and services refer to the goods and/or services for which protection has been granted; and***
  - c. ***The owner refers to the holder.***

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

- ***protected international trademark (Canada)***
  - ***registration of a trademark (sections 19, 20(1.1), 20(1.2), 20(2))***
  - ***registered trademark (sections 20, 21, 51.01, 51.02-51.05, 51.08-51.09, 53.1 and 53.3)***
  - ***trademark registered (sections 22 and 51.01(a))***
- ***goods and/or services for which protection has been granted***
  - ***in respect of those goods and services (section 19)***
  - ***registered trademark for such goods (section 51.03)***
  - ***trademark registered for such goods; trademark registered for such services (section 51.01)***
  - ***trademark registered for goods (section 51.02)***
  - ***goods for which the trademark is registered (section 51.04)***
- ***holder***
  - ***owner of a registered trademark (sections 20, 51.04(1), 53.1)***
  - ***registered owner of the trademark (section 21)***
  - ***owner of the trademark (sections 19 and 51.03(2))***
  - ***owner of that registered trademark (section 51.01)***
  - ***trademark owner (sections 51.04, 51.09)***
  - ***owner of a relevant registered trademark (section 51.06, 51.08, 51.09, 51.11(5), 51.12)***
  - ***owner of a trademark (section 51(1))***
  - ***owner of the registered trademark (section 53.3)***

**Comments:** None

### *Protections*

47. *The trademark that is the subject of the request for protection shall be protected as a protected international trademark and in the case where a refusal applies in respect of some of the goods or services in respect of which protection in Canada has been requested, protection shall apply, only in relation to the remaining goods or services.*

**Comments:** None

### *Renewals*

48. *Section 46 of the Trade-marks Act with respect to renewals of trademarks does not apply. The international registration is effective for ten years from the date of international registration. It may be renewed for ten year periods as set forth in the Madrid Protocol. When the Registrar receives notification from the International Bureau of the renewal of an international registration, this shall be recorded in the Canadian register.*

**Comments:** None

### *Transformation*

**General Comments:** This section requires a review of both Article 6 of the Protocol (relating to “dependence” of the international registration and all related rights granted following the extension of the international registration on the originating national rights for a period of 5 years from the date of the international registration) and Article 9quinquies, permitting “transformation” to national rights.

The Discussion Document does not provide any explanation for the concept of dependence (as found in Article 6 of the Protocol). Canada, if acting as an Office of Origin, must notify the International Bureau of any decision within 5 years of the date of the international registration 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 international registration, and by implication, all extended rights in countries to which the international registration has been extended, “may no longer be invoked” (Art. 6(3)), and the Office of Origin is obliged to notify the International Bureau.

It is worth pointing out that the wording in Art. 6 provides for the protection of the international registration to be lost if there is a decision “in respect of all or some of the goods and services listed in the international registration.” One interpretation is that all rights in the international registration are lost if the decision impacts all or some of the goods/services. However, in

practice, this is not how Art. 6 works. Instead, the international registration seems to remain in place for any goods/services not impacted by a decision.

Article 9quinquies provides a mechanism to preserve rights, by requesting transformation. The Discussion Document provides the example of an American applicant making a request for transformation. In Canada there are two aspects to this situation: 1) the impact on any international registration and related extended rights to any Canadian international registration owner; and 2) the impact on the owner of an IRDC should its national rights be impacted. INTA recommends that the TMR provides more certainty on the impact on Canadian international registration holders in this scenario.

The Discussion Document does not provide any proposal as to how a transformation application is to be filed. Will applications be filed online through the CIPO website (if available)? If so, INTA recommends that paper filing should remain an option.

The Discussion Document also does not explain whether there will be a new examination and a new opposition period, even for transformation applications based on a protected international trademark. INTA would appreciate clarification on this point.

- 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:***
    - i. the international registration number;***
    - ii. the date of cancellation of the international registration;***
    - iii. 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***
    - iv. 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.***

**Comments:** INTA would appreciate clarification as to what is intended by the phrase “transform... a protected international trademark into a registered trademark.” Does this mean that the former international registration rights are now only “national” trademark rights? In addition, with respect to a “transformation” application in Canada, will it be subject to regular examination?

**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.**

**Comments:** INTA would like clarification concerning what is intended by this provision.

Does 50(c) mean that an application that has advanced to advertisement in Canada immediately prior to the cancellation of the IR can transform into a national Canadian application and does not have to go through examination again?

**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.**

**Comments:** None

**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.**

**Comments:** None

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

**Comments:** Will this publication be a special part of the Trade-marks Journal? Or will there be a separate publication for transformation applications?

Further, INTA would like to know whether the publication of transformation applications is intended to permit some means of opposition, whether by conventional opposition or otherwise.

## **Replacement**

**General Comment:** Under Article 4bis of the Protocol, existing “national” registrations that subsequently become the subject of an international registration are deemed to be replaced if such national rights are for the same mark, goods and services. Such replacement is “without

prejudice to any rights” in the national registration. Art. 4bis (2) states that any Office “shall, upon request, be required to take note in its register of the international registration,”

According to the Alan Troicuk paper cited above, there are “important divergences of practices and of interpretation amongst the Contracting Parties” relating to Article 4bis. Therefore, it will be important to review the actual language of the regulations pertaining to 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.***

**Comments:** None

***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.***

**Comments:** None

***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:***

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

**Comments:** A registration now includes useful information, including the filing date, the date of first use or the date of the declaration of use, geographic limitations, disclaimers, any consents from other parties and so on.

INTA would like clarification 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

With respect to item b, is it necessary that all the goods and services be listed? Or is listing only some of them sufficient?

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 the Canadian Intellectual Property Office's website:*
- a. *The number of the international registration; and*
  - b. *the registration number of the replaced registration.*

**Comments:** None

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.*
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.*

**Comments:** The Common Regulations provide that if a holder of an international registration makes a request to the national office, the notification shall include the filing date and registration date, relevant application and registration numbers and the priority date. It may also include “information relating to any other rights acquired by virtue of that national or regional registration.”

INTA would like clarification as to what is intended by the references to “priority date” and “information” in paragraphs 58 and 59. Does this mean that the date of registration of the Canadian registration being replaced becomes the relevant date when considering rights? What would happen if there is a date of first use claimed in the Canadian registration being replaced? A “registration” does not have a priority date; and for registrations based on “use” the registrant’s rights will date from the use claim, and not the registration date.

Further, what is the impact of an international registration on geographically limited Canadian registrations? If a registrant owns a registration in Canada that is limited to certain areas, and that registrant subsequently obtains an international registration, what is the impact of “replacement” on those limited rights? Presumably, that registrant will not be able to obtain any broader rights by virtue of replacement.

INTA recommends that all relevant use claims, any limitations relating to disclaimers or s. 12(2) and 14 claims, geographic limitations and consents are maintained on the Register.

INTA's TOPC-Madrid subcommittee suggests revising item e. as follows:

- e. as applicable, information relating to other rights acquired by virtue of the registration in Canada.

### ***Change in Ownership of International Registration***

- 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.***

**Comments:** None

- 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.***

**Comments:** None

- 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.***

**Comments:** INTA would like clarification as to how a holding of non-distinctiveness will be made. Will the Registrar make that declaration? Does a proceeding for invalidity pursuant to s.18 have to be brought?

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

**Comments:** Alan Troicuk's paper raises numerous issues relating to the recordal of assignments. One point that is made (at p. 72) is that while the International Bureau is required to notify Contracting Parties of an assignment, such Contracting Parties may declare the assignment has no effect in their country. Rule 27(4) of the Common Regulations specifically confirms this. While the amended TMA has eliminated "associated marks", presumably it would not be in the public interest to have confusing

marks owned by different parties. While the proposed regulation in paragraph 62 above addresses the possible validity of co-existing confusing marks, the impact of confusing marks being owned by multiple parties is not merely the potential non-distinctiveness of specific marks, it is the lack of usefulness of the Register as an indicator of rights, and also as a tool to predict the registrability of new applications.

INTA recommends that this proposal confirm that the Register may reserve the right to declare that the change in ownership shall have no effect in Canada.

- 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.**

**Comments:** INTA would like clarification as to what is intended by this proposal. Is this meant to suggest that only the Registrar may submit a request to change ownership? Rule 25 of the Common Regulations suggests that the request may be submitted by the holder or the Office of the Contracting Party. There does not seem to be any equivalent to item a in Rule 25.

INTA would like clarification as to the interaction between items a and d. How can the Registrar be satisfied under item d if the assignee cannot obtain the signature under item a? Would an assignee be able to obtain the assignor's signature to satisfy the requirements of item d, but not item a?

Further, a change in ownership might not necessarily be the result of an assignment. Accordingly, INTA also recommends to replace all reference to "assignee" with "new owner" and replace all reference to "assignor" with "the registered holder."

Moreover, INTA's Trademark Office Practices Committee – Madrid System Subcommittee has cautioned that item c should be further reviewed as it may not comply with the Common Regulations Rules 25(1)(b) and 25(2)(a)(iv), which allow the new owner of an international registration to record the change of ownership through the Office of the Contracting Party with which he can justify an entitlement, regardless of whether the concerned international registration designates the territory of that Contracting Party.

## Divisionals

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

**Comments:** INTA would like clarification as to the intent and consequence of this proposal. Why will the provisions regarding division of applications, for example, to deal with examination or opposition issues, not apply to IRDCs?

### *3.3 Part 3 – Proposed Amendments to Opposition and Section 45 Summary Cancellation Proceedings*

**General Comments:** Many of the proposed changes in this part have been discussed in earlier consultations.

The Discussion Document notes that both oppositions and s. 45 proceedings are “mechanisms that help maintain ...balance in the marketplace by providing reasonably swift and cost-effective administrative decisions.” Particularly with respect to the latter, there is a chance for the Registrar to take control of the Register, and address the abuses that will most certainly arise from permitting registration without use, both in terms of crowding the Register with marks that are not in use, and having the Register filled with marks covering goods and services not in use.

In consultations, the government has suggested that it would use s. 45 summary non-use proceedings to address potential abuse. INTA recommends that the TMR specifically address this issue by having the commencement of a s. 45 proceeding by the Registrar occur on the third anniversary of all registrations, unless the registrant has (e.g. before or after the registration date) filed a statement of use pertaining to all goods and/or services. If any statement of use covers only some of the registered goods and/or services, the proceedings commenced by the Registrar shall apply to only the remaining goods/services. This Registrar-initiated proceeding shall not impact the ability of any other person to commence s. 45 proceedings after the third anniversary of the registration for any or all goods/services.

If CIPO lacks the resources to handle the volume of automatic proceedings, the foregoing could be modified so that the s.45 proceedings could be instituted randomly against the pool of registrations that have no declaration or statement of use on file. If and when the declaration or statement of use is filed, the registration is withdrawn from the pool until the date for the next voluntary declaration of use. The percentage of proceedings initiated would vary with the size of the pool at any given time.

We understand that CIPO may consider developing guidelines with respect to evidence that would be acceptable to satisfy a ground of opposition under s.38(2)(e) TMA. INTA would welcome further discussion with CIPO concerning the development of such guidelines.

## *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.*

**Comments:** The phrase “that is the subject of an opposition proceeding” implies that the formal opposition proceeding has commenced. Under the current legislation, an opposition proceeding does not commence until the statement of opposition has been vetted by the Board and forwarded to the applicant. By including the words “including if an extension of time has been filed to oppose the application,” CIPO appears to intend that the requirement to forward a copy of the correspondence extend also to correspondence relating to proposed opposition proceedings. Therefore, we recommend that the specific wording that will actually appear in the regulations on this point be expansive enough to cover all intended situations rather than the narrow phrase “that is the subject of an opposition proceeding.”

We note that in the 2012 consultation document the proposal specifically excluded a requirement that the proposed opponent forward a copy of the statement of opposition filed with the Opposition Board. Under that 2012 proposal the applicant would not get a preview of the grounds pleaded by the opponent before the review conducted by the Opposition Board. As that exclusion is not present in the current Discussion Document, INTA requests that CIPO confirm that the intention in the current proposal is that the proposed opponent will be required to forward a copy of the statement of opposition to the applicant at the same time that it is initially filed with the Board.

We note that proposed new Rule 36 is silent concerning *when* the party corresponding with the registrar is required to forward a copy of the correspondence to the other party. INTA suggests that the proposed provision be amended to include words sufficient to clarify that the copy is required to be forwarded to the other party reasonably contemporaneously with the sending of the correspondence to the Registrar. It is crucial to the fair and efficient conduct of an opposition proceeding that parties to be provided with copies of correspondence to the Registrar in a timely manner.

The proposed changes to Rule 36 lack any consequence of non-compliance. INTA suggests that CIPO consider revising the proposed new Rules to provide for an appropriate consequence, such as giving the Registrar discretion to not have regard or give effect to correspondence which has not been forwarded to the other side. The opposition process can only work fairly and efficiently where the parties are assured that they will timely receive all correspondence submitted to the Opposition Board by the other party.

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.*

**Comments:** It appears that the specific wording of this proposal is intended to exclude from the forwarding requirement the initial correspondence to the Registrar requesting the initiation of a s. 45 proceeding. INTA considers that it is appropriate that CIPO not require that the registered owner be copied on a request to the Registrar to issue a notice under s. 45.

As in our comments concerning opposition proceedings, INTA also recommends that the required forwarding needs to be contemporaneous with filing and there should be consequences for failure to comply.

### *Service – Opposition and Summary Cancellation Proceedings*

**General Comments:** It is noted that the commentary speaks to electronic transmission of documents, and yet items 3 and 5 do not specifically refer to that mode of transmission

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

*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.*

**Comments:** Generally, maximum flexibility in the delivery and service of documents in all proceedings is welcomed as long as parties are well aware of and expect to receive documents by a specific means. Further, references to “in any other manner” presumably are meant to include electronic correspondence and that should be specifically mentioned.

### Facsimile

As a general observation the use of facsimile machines has decreased significantly in recent years. Many fax machines are not equipped to handle long faxes (and a 20 page fax would be considered a long fax), and for some documents, e.g. evidence, the quality of reproduction is poor. It may be appropriate that fax be utilized only if consent has been given. At the very least, INTA recommends that CIPO consider requiring that the serving party provide notice to the other agent by some other means, either immediately before or after transmission, that a facsimile communication has been sent unless a fax number has

specifically been communicated to the server for the purposes of receiving served documents.

INTA supports an amendment to the wording that would clarify that the service by facsimile may only be effected without consent or notice where the fax has been sent to the fax address(es) that are specifically designated in written correspondence (or set out in a statement of opposition or counterstatement) as being the address for service for the purpose of opposition proceedings. The clarification is sought to avoid situations in which a party or its agent/representative for service has multiple fax addresses associated with it, and the party seeking to effect service sends a fax to any of those multiple addresses rather than to an address which the recipient will know to be checking regularly.

#### Registered Mail (and Canada Post equivalent service for heavier documents)

Some concern was raised concerning the benefit of CIPO deleting registered mail as a means by which service may be effected without the consent of the other party. INTA recognizes that there are issues that have arisen concerning Canada Post's decision (some time ago now) to limit its service known as "registered mail" to a maximum weight restriction (and thus rendering it a non-viable means for service of weighty documents). However, we also understand that Canada Post has for some time offered a materially equivalent service to its registered mail service that does not have the same weight restrictions, and we note that under the present TMR registered mail continues to be a viable method to serve documents that are not particularly weighty. Thus, rather than delete registered mail as a means of service that can be effected without consent, INTA requests that CIPO consider extending registered mail to "registered mail or an equivalent postal service which requires a signature from the recipient upon delivery." This would provide parties with more, rather than fewer, options for service.

Given that personal service and service by courier will still be permitted under the new Rules (and thus it is still contemplated that paper copies will continue to be served, notwithstanding that the new Rules will facilitate the service and filing of electronic copies), we do not see what is to be gained by removing registered mail (and, as we suggest, the additional equivalent postal services) as a means of service, but there may be something to lose. Canada is a very large country, the population of which is dispersed throughout communities of various sizes from the very large to the very small, and the ability of persons to access means of service permitted by the Rules will sometimes vary considerably depending on the size of the community. There may be some communities in Canada in which Canada Post, as a Crown corporation having a universal service obligation, presents the most viable means of effecting service for its citizens. INTA urges CIPO to consider the potential impact on rural and outlying communities if it proceeds with the elimination of registered mail (and fails to add the equivalent service for heavier items) as a service option.

Other

CIPO should consider enacting a regulation that requires a trademark agent to provide an email address and/or fax number in addition to a courier/post office mailing address for the purposes of facilitating service and forwarding requirements in opposition and s.45 proceedings. Agents opposite would then be able to rely on these default particulars for complying with service/forwarding requirements unless provided with alternative particulars for that purpose.

Consent vs Notice

Another consideration is that obtaining the “consent” of the other party may not be necessary in part d if sufficient meaningful “notice” has been provided that the service has been made by another manner.

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.*

Comments: None

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*

Comments: INTA recommends that the effective date of service for electronically served documents also be included. It should be the “on the date appearing on the transmission record as the date of communication.”

With respect to item b, INTA would like clarification whether the date contemplated is the date of pickup or the date of delivery.

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.***

**Comments:** INTA generally supports this proposal. However, INTA would like clarification as to how will “a reasonable time after the deadline” be interpreted. Since the timing for any act is limited, this “reasonable time” should be interpreted to mean only “days” and not any longer. Perhaps it is better to specify, for example, “within seven days” as a way or providing some degree of certainty. As deadlines will be flowing from when documents are due to be filed, it would be unfair to the other party if a significant delay between filing and service was forgiven.

INTA further recommends that if this section will be applied for the calculation of any date, the Registrar notify the parties and give parties an opportunity to comment on the “deemed” date. This will ensure that any special factors that could impact the actual receipt of communications are considered.

INTA would also like clarification to how the deemed date will affect the proceedings moving forward. For example, if Opponent’s evidence, due on January 1, is actually received on January 6 and is deemed to be served on January 1, is Applicant’s evidence now due May 1 or May 6? Presumably, it would be May 1, since Opponent’s evidence is deemed to be served on time.

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.***

**Comments:** What are the consequences for failing to file in duplicate?

Is a facsimile considered a “paper form” and thus subject to this requirement?

Is this requirement for paper duplicates still necessary given that the applicant will already have received a copy of the statement of opposition from the proposed opponent pursuant to new Rule 36.

8. ***Subsection 3(9) of the Trade-marks Regulations is repealed.***

**Comments:** None

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.***

**Comments:** INTA would like clarification concerning whose request will trigger the filing requirement. Would it be the Registrar who makes the request? Will the other party have the right to request the filing of the original if the copies provided are unclear?

### *Case Management – Opposition and Summary Cancellation Proceedings*

#### **General Comments:**

Without specific proposed language to consider, it is difficult for INTA to fully comment on these proposals. Further, how does CIPO envision an opposition or summary cancellation proceeding become case managed? Does an application have to be brought by a party, or is a decision made by the Registrar?

It may be useful for CIPO to know that in our discussions there was some uncertainty as to the usefulness of case management in opposition and summary cancellation proceedings. To this camp, the delivery and exchange of evidence is already governed by deadlines that are clear, other than the possibility of exceptional circumstances extensions of time, and case management does not seem necessary to manage these deadlines. It was also observed that in many cases, oppositions are dragged out due to extensions of time, and that most extensions now require consent of the other side. It was observed that case management is not very useful when the parties are willing to consent to extensions.

Others thought that case management would be quite helpful as a means of obtaining interlocutory orders, for example, concerning the scheduling of cross-examinations, or for obtaining further extensions of time in appropriate circumstances in situations where the current opposition practice may not permit be sufficiently flexible, or for synchronizing multiple related proceedings. This camp welcomed the ability of parties to request case management in appropriate circumstances.

There was consensus, however, that it would be dangerous for the case management process to permit grounds of opposition to be removed or narrowed, as the rights of the opponent may be prejudiced. In particular, in any appeal to the Federal Court the ground would no longer be in issue.

- 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.***

**Comments:** INTA would like clarification as to how case management will be initiated. Will parties have to make an application, or will the Registrar insert himself into the process.

- 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.***

**Comments:** Given the many deadlines in opposition and summary cancellation proceedings, it is not clear why case management would be used, and what situations are felt by the Registrar to be “appropriate” for case management. In addition, permitting the Registrar to “determine timetables” that are different from those that would apply to other cases creates a high likelihood that the parties will object to such deadlines. The idea that the Registrar might “narrow issues” in an opposition could be seen by parties to remove from consideration valid grounds of opposition or defenses to such opposition grounds, to the detriment to the parties. While the provisions notes that the Registrar must “inform parties” of proposed directions and seek their comments, it is not clear what the impact of such comments would be. If, for example, both parties object to any changes in proceedings, issues, timetables, etc. will the Registrar not proceed?

INTA would like clarification why case management would be necessary, when it might be used, and how deadlines might be applied. Specifically, INTA would like confirmation that in no case would deadlines ever be set to be less than those set out in the TMR.

### ***Opposition Proceedings***

#### ***Evidence - Opposition Proceedings***

**General Comments:** In our discussions support was expressed for the proposed changes for the purpose of providing certainty to the deadlines in an opposition proceeding.

However, others have questioned whether the proposed changes will substantially improve certainty, clarity and transparency noting that the proposed changes must be considered carefully to take into account of the possibility of extensions of time. Query whether extensions of time should be codified in the regulations rather than being contained in a Practice Notice?

### ***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,***

***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***

***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***

**Comments:**

The proposed changes to the TMR alter the manner in which the deadlines for the submission of evidence are calculated. Under the current TMR, the evidentiary deadlines are calculated from the service of the pertinent document/materials in the preceding stage. In the proposed amended TMR, the evidentiary deadlines are calculated from “after the expiry of the time for” filing/submitting the pertinent document/materials in the preceding stage. It appears that the change is to be interpreted in a manner such that the deadlines for each evidentiary stage of the proceeding will be ascertainable to the Opposition Board and to the parties (subject to any extensions that may be requested and granted) from the very outset, i.e. once the parties know the date that the statement of opposition has been forwarded to an applicant under subsection 38(5) TMA. However, if CIPO considers that the time for filing/submitting the evidence at each stage actually expires upon the filing/submitting of the evidence if that filing/submitting occurs earlier than the latest permissible date for the filing/submitting of same, CIPO should clarify what is meant by the phrase “expiry of the time for.”

INTA supports CIPO’s decision that the TMR retain the opponent’s right to file reply evidence.

INTA generally supports the new subsections 38(10) and (11) TMA and the introduction of a substantive repercussion for parties who fail to serve evidence on the other party. However, we believe that some clarification is required in the regulations with respect to

the timing of the deemed withdrawal under TMA 38(10) and the deemed abandonment under TMA 38(11). A point of continuing concern has been the manner in which CIPO handles deemed abandonments and withdrawals under current TMA s. 38(7.1) and 38(7.2), and how this may be continued under new TMA s.38(1) and 39(11). What is missing from the proposals is a better and more certain description of the stepwise process and timing concerning how an application/opposition in default proceeds to deemed abandonment/withdrawal. In current practice, the parties are left uncertain as to the timing of the deeming, and the circumstances which might transpire that could result in the deeming not occurring. INTA considers it appropriate that the regulations should be amended to clarify this situation.

Also, new TMA s.38(1) and 39(11) reads “The [opposition/application] *is deemed* to have been [withdrawn/abandoned] if ...” (italics added). Contrast this to the current wording of subsections TMA 38(7.1) and (7.2) which reads “...*shall be deemed* to have been [withdrawn/abandoned] if ...” (italics added). Query whether the new language is functionally equivalent to the old language, or whether the new language “is deemed” provides for the deeming to occur immediately upon the happening of the default, as opposed to the present opposition practice in which the defaulting party is put on notice and provided an opportunity to remedy the default before any withdrawal or abandonment is deemed to have occurred. In any event, section 36 of the TMA requires that the Registrar give notice to an applicant of a default in the prosecution of an application. However, there is no parallel legislative provision for an opponent who is in default of the prosecution of his opposition. Given the change in language to TMA 38(10), and given that there is no statutory requirement that the Registrar give notice to an opponent of his default, this could set up an unintended difference in the Registrar’s application of the deeming provisions between subsections 38(10) (immediate effect) and 38(11) (only after notice). Consequently, INTA considers it appropriate that the regulations clarify these provisions of the TMA.

### ***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.*

**Comments:** None

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.*

**Comments:** There is some concern regarding how a grant of leave to submit additional evidence under proposed new Rule 44 (and any cross-examinations that may take place in respect of same) will impact the parties' deadlines to file written arguments under proposed new Rule 46. The current TMR provide that a notice inviting the parties to file written arguments is not sent out until at least two weeks after "completion of the evidence." Presently, it is left in the hands of the Opposition Board to determine when the evidence has been completed. Under the new proposed regulations, because the deadline for the filing of the parties' written arguments will have been set once the statement of opposition is forwarded by the Registrar to the applicant, additional evidence for which leave is granted late in the proceeding may negatively impact a party's ability to effectively prepare written arguments. INTA suggests that CIPO consider whether it would be appropriate for the new TMR to set an outer time limit for the filing of additional evidence and the completion of any cross-examinations thereunder.

Concerning Rule 44(2), the proposed revision will require a leave to file evidence outside of normal rules to be accompanied "by the evidence that the party proposes to submit." If that evidence is costly to prepare, that puts a potentially enormous burden on a client to accept the cost of preparing evidence merely on a chance that it will be accepted. Currently, the Practice Notice merely recommends that the evidence be submitted, and many parties attach a draft of the affidavit rather than the actual evidence. There does not appear to be a need to move away from that current practice. INTA would prefer proposed Rule 44(2) provide that the request be accompanied by a clear description of the

evidence proposed to be filed rather than require that it be accompanied by the actual evidence itself.

### ***Cross-Examination***

**General Comments:** The main concern has been, and continues to be, that parties may not have an opportunity to file evidence in response to issues arising from cross-examination, except with leave, and since the results of a request for leave is uncertain, and parties may risk such leave request being denied, there is a potential inequity in the procedure. Cross-examination frequently leads to one or both parties wanting to address an issue in their own evidence. Since proposed paragraph 17 suggests that the actual deadline for completion of cross-examination is 4 months from the expiry of the time for filing reply evidence, it is likely that both the applicant and the opponent will postpone any cross-examinations until that step. If the parties seek leave to file additional evidence in response to those cross-examinations, and it is granted, then presumably the other party may want an opportunity to cross-examine any witness regarding the “new” evidence. In terms of timing and efficiency, this does not seem preferable to the current system. At the very least, it is recommended that the parties may, following any cross-examination, seek leave to file additional evidence in response to issues arising in such cross-examinations, and that such leave will be granted unless there is a strong reason not to.

***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.***

**Comments:** INTA is concerned about some aspects of the proposed new provisions regarding cross-examinations. Under the current TMR, an applicant can arrange matters such that its Rule 42 evidence need not be prepared until after the completion of the cross-examination on the opponent’s Rule 41 evidence. Similarly, an opponent can presently arrange matters such that it need not prepare its Rule 43 evidence until after the completion of the cross-examination on the applicant’s Rule 42 evidence. In many instances, the Rule 42 and Rule 43 evidence is informed by what is learned during cross-examination. In particular, at present the decision concerning whether or not an opponent prepares and files Rule 43 evidence is often determined by answers given during the cross-examination on the applicant’s Rule 42 evidence. (Presumably this is one of the reasons that CIPO has not maintained a previous proposal, *i.e.* that cross-examinations not take place until all the evidence is filed, as is the case with applications in the Federal Court.)

It is foreseeable that a scenario will arise where one party will wish to conduct a cross-examination before it prepares its next evidentiary submission and the party opposite will wish to resist scheduling the cross-examination until after all the Rule 41-43 evidence is submitted. INTA would like to have a better understanding of how CIPO intends that

these regulations concerning cross-examination would operate, particularly in the scenario set out above.

This proposal appears to suggest that, even if the opponent files no reply evidence, there is a four month “holding period” in which the opposition will not move forward pending cross-examinations. This would cause possibly undue delay in oppositions. This proposal as drafted would likely lead parties to put forth their affidants for cross-examination as late as possible, which could lead to more requests for leave to file additional evidence. There should be a framework applicable to cross-examinations rather than just a time frame in which cross-examinations may be conducted.

INTA agrees that the current system is unduly complicated but believe that a clear, step by step process can be put in place that is fair to both opponents and applicants.

INTA also believes that there should be the option of filing evidence in response to issues raised in cross examination. Perhaps this can adequately be dealt with in a request for leave to file additional evidence in limited appropriate circumstances.

***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.***

**Comments:** None

***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.***

**Comments:** INTA urges CIPO to provide some guidelines concerning what the Registrar would consider to be “undue delay.” INTA is concerned that the procedure as set out in the proposed regulations will lead to more, as opposed to fewer, requests for leave to file additional evidence outside of normal time limits.

***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***  
***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.***

**Comments:** None

**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.***

**Comments:** None

***Written Representations***

**General Comments:** INTA supports the proposal for the sequential filing of written arguments, and there is support for additionally giving the opponent a right of written reply based on the theory that it may result in fewer requests for oral hearings. However, there is some concern both with the timelines, and with the concept that the triggering event for the written argument stage should be the expiry of the time for completion of cross-examinations of the Rule 41(1) evidence. As for the timelines, we support increasing to three months the time that each party has to prepare written arguments (with a suggested right of reply of the opponent set at two months).

INTA recommends that there be a provision for filing a “rebuttal” argument by the opponent, without requiring leave to do so, restricted only to issues raised in the applicant’s written submissions.

**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.***

**Comments:** Should the reference to 41(1) not instead be a reference to sections 41-43 so that all of the affidavits/declarations that may be filed in the proceeding (apart from those that require special leave) are included in the timing formula?

**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.***

**Comments:** None

**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.***

**Comments:** None

## *Oral Hearings*

**General Comments:** While the proposal to set a deadline to request the oral hearing that is “fixed” can be helpful, INTA believes that the parties should be able to request a hearing at an earlier date.

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.*

**Comments:** INTA recommends that any party may request an oral hearing at any time.

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.*

**Comments:** None

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.*

**Comments:** INTA recommends that, should the party withdraw, the cancellation of the hearing not be automatic unless this impact has first been clearly noted in earlier correspondence from the Opposition Board. There should be clear notice, for example, when setting the hearing date, to ensure that parties clearly understand that unless both parties wish to attend, the hearing will not proceed.

28. *A party may notify the Registrar of changes to any of the information provided under paragraph 25 above and the Registrar shall modify the administrative arrangements for the hearing accordingly if the request is received by the Registrar at least one month before the date of the hearing or, if the Registrar is reasonably able to modify the administrative arrangements that have been made for the hearing, at any time before the hearing.*

**Comments:** None

**29. Repeal section 47 of the Trade-marks Regulations as extensions of time in opposition proceedings may be obtained pursuant to section 47(1) and 47(2) of the Act.**

**Comments:** None

### ***Geographical Indications***

**30. Make any consequential amendments necessary to bring the procedure for geographical indication objection proceedings in line with the procedure for oppositions as set out in the new Regulations.**

**Comments:** INTA's Related Rights Committee – Geographical Indications Subcommittee expressed concern that this proposal is essentially a placeholder provision with no details about how the GI objection proceedings will actually work. It was also observed that the preamble of Part 3 of the Discussion Document states that “[s]ome of the amendments are proposed to align opposition and s. 45 proceedings with the changes brought about by the treaties while others are meant to improve market certainty by enabling faster resolution of disputes brought before the Trade-mark Opposition Board.” INTA's Related Rights Committee – Geographical Indications Subcommittee interprets this as a strong indication that CIPO may be prepared to recognize the geographical indication rights in the opposition proceedings and to comply with the Canadian obligations under current and future anticipated treaties regarding GIs.

### ***Section 45 Summary Cancellation Proceedings***

**General Comments:** To repeat our general comments to Part 3, since the Registrar has the right to initiate s. 45 proceedings, and since the potential for “abuse” resulting from eliminating use as a registration requirement is both obvious and long lasting, the Registrar should use s. 45 proceedings to actively police against abuses by clearing deadwood and reducing register clutter.

We recommend that the TMR be amended to provide that on the third [or fifth] anniversary of any registration, if a statement of actual use in Canada has not yet been filed regarding any mark, or any registered goods or services, the Registrar may exercise his discretion to send a notice, pursuant to s. 45, to the registered owner of such mark or its recorded agent and initiate s. 45 proceedings.

In the event that CIPO is not prepared to institute Registrar-initiated s.45 proceedings against all registrations for which no statement of use has been voluntarily filed as recommended by INTA, INTA would welcome meeting with CIPO to discuss a set of criteria that could be used to assess when Registrar-initiated s.45 proceedings would be appropriate. A list of indicia that would favor the issuance of a s. 45 notice by the Registrar might include: (1) registration contains more than a threshold number of classes; (2) registration has been on register for more than a threshold number of years; (3) inconsistency on the record (e.g. addresses, etc. changed for all marks in a

portfolio but a few); (4) has a voluntary statement of use been filed; (5) is there a Canadian presence ascertainable from the registration record; (6) has credible information of non-use been received from third parties through a “letter of protest”-like procedure; (7) prior evidence of overclaiming (e.g. s.45 and opposition proceedings in which registrant/applicant was not able to evidence use). Not all criteria would have to be manifest to trigger a Registrar-initiated notice, i.e. the presence of only some of the criteria would suffice.

### ***Written Representations***

- 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.***
- 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.***
- 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.***

**Comments:** These comments to relate to paragraphs 31, 32, and 33. We recommend that, regarding the timing of filing of written representations, as noted above under “Oppositions” the filing of a “rebuttal” by the requesting party, should be specifically allowed, under the same conditions as set out above in the Opposition section.

### ***Hearings – Summary Cancellation Cases***

- 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.***

**Comments:** None

*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.*

**Comments:** None

*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.*

*37. A party may notify the Registrar of changes to any of the information provided under paragraph 34 above and the Registrar shall modify the administrative arrangements for the hearing accordingly if the request is received by the Registrar at least one month before the date of the hearing or, if the Registrar is reasonably able to modify the administrative arrangements that have been made for the hearing, at any time before the hearing.*

**Comments:** Similar to as in Oppositions, above, we recommend that steps be taken to ensure that a party is not surprised and disadvantaged by the cancellation of a hearing. There should be clear notice, for example, when setting the hearing date, to ensure that parties clearly understand that unless both parties wish to attend, the hearing will not proceed

### **3.4 *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.*

**Comments:** None

## **4.0 COMMENTS CONCERNING OTHER ISSUES RELATING TO TRADE-MARK REGISTRATION PROCESS**

### **4.1 *Process and Technology Improvements***

One of the biggest factors that will determine whether CIPO can successfully transition to a post-Madrid/Singapore/Nice registration system under the amended TMA and amended TMR will be the ability of CIPO to implement technology and process improvements. INTA has considered the types of process and technology improvements which it believes will have the greatest positive impact on turn-around times and/or on service quality with respect to CIPO's trademark services.

INTA's recommendations are divided into two categories: electronic filing improvements and non-electronic filing improvements. The recommendations in each category are listed below. In terms of priority, INTA members most frequently request access to Trade-marks Office documents online, but the following list also includes many requests that would greatly improve the efficiency of the filing system for all applicants.

### **Electronic Filing Improvements**

1. Electronic availability of all Trademark Office documents (i.e. file histories, assignments, opposition files).
2. Ability to file routine changes online, namely:
  - addresses of applicants and registrants,
  - change in agent/representative for service
  - assignments, mergers and changes of name of applicants, registrants and agents/representatives for service.
3. Online filing of declarations of use for partial list of wares/services.
4. Online filing of extension applications
5. Ability to file online responses to Office Actions without having to submit a revised application;
6. Ability to open an existing electronic application without having to re-attach design image file;
7. Ability to enter file identifying information on payment transaction form (i.e. internal file no., trademark)
8. Online filing of requests for recordal of a security interest.

### **Other (i.e. Non-Electronic Filing) Improvements**

1. Ability for agents to elect to send and receive official letters by email
2. Improved Examiner responsiveness to emails (i.e. increasing the capacity of Examiner's email inbox)
3. Ability to make amendments by telephone with Examiner (i.e. minor changes to statement of wares/services)
4. Ability to use formats other than TIFF for design applications (i.e. PDF, JPEG)

5. Different terminology for official marks so more easily recognized (i.e. use of the terms “published” or public notice” in place of “advertised”)
6. The elimination of commas in applications numbers and registration numbers
7. Publication of marks in color on the CIPO database and in *Trade-marks Journal*
8. Hypertext linking of associated marks in the trademarks database

INTA respectfully requests that CIPO consider these recommendations when considering which process and technology improvements to implement.

We would welcome the opportunity to these recommendations with CIPO at your convenience.

#### ***4.2 Effect of Consents in Overcoming Office Objections Based on Confusion***

INTA supports the view that the provision of consent from the owner of the registered trademark should be considered by the court or the Registrar, as the case may be, as one of the surrounding circumstances in assessing the likelihood of confusion between trademarks. INTA has identified some factors which may be included in such a consent (See Section 10.1.3 of INTA’s Examination Guidelines which are attached).

Although consent from the owner of the cited mark is indeed considered by examiners as one of the surrounding circumstances when assessing the likelihood of confusion, it is INTA’s view that where the trademark owner and the applicant have come to an agreement, an examiner should be prepared to give deference to the parties’ wishes in all but the most extreme situations, given that it is the parties who are best placed to know the marketplace and their customers. Nevertheless, the Registrar must exercise discretion in making the assessment of confusion.

Reconsideration of CIPO’s position concerning the weight to be afforded letters of consent is ripe in light of the TMA amendments which will eliminate the concept of associated marks and with them the restrictions on their transfer. It would appear absurd that the Registrar would reject a co-existence agreement between sophisticated parties, when the applicant can overcome the same confusion citation by temporarily transferring title to the owner of the cited mark and then reacquiring title post-registration.

#### ***4.3 Newfoundland Registration Reform***

Trademarks registered pursuant to the laws of Newfoundland that existed prior to April 1, 1949 should be subject to the same provisions respecting renewal and expungement as are other trademarks.

#### ***4.4 Statutory Definition of Making Known***

The statutory definition of when a trademark is deemed to have been made known should be updated to include modern means of communication by which the advertisements for wares and services will come to the attention of potential dealers in, purchasers or users of the wares or services. INTA

believes that the “making known” provision does not reflect Canadian modern commercial communication realities as there are several options by which wares and services are advertised and become well known in Canada other than printed publications and radio broadcasts. Therefore, INTA suggests that the TMA should be revised to include some additional options in which wares and services are advertised in Canada.

#### ***4.5 Increased Protection for Well-Known Trademarks in Canada***

INTA notes Canada’s lack of specific legislative provisions for protecting well-known marks and takes this opportunity to recommend that Canada adopt provisions:

- (1) acknowledging that if a mark is well-known, there is a greater risk of confusion; and
- (2) protecting against dilution.

Because of their attributes, well-known marks are especially vulnerable to being copied or emulated.

The “Joint Recommendation Concerning Provisions on the Protection of Well-Known Marks” adopted by the Assembly of the Paris Union for the Protection of Intellectual Property and the General Assembly of the World Intellectual Property Organization provides member states, such as Canada, with guidelines for implementing the well-known mark provisions of international agreements. INTA supports the Joint Recommendation and recommends to the government of Canada that well-known marks be protected in accordance with its provisions.

Well-known marks often fall victim to unauthorized use by third parties, who frequently adopt such marks for their own goods and services, not necessarily to confuse, but rather for the positive associations that such marks carry. Unfortunately, there does not appear to be a useful mechanism in the TMA to address this type of activity. In view of the above, INTA recommends the adoption of the following two types of provisions:

- (1) A provision acknowledging that, when assessing the likelihood of confusion with a well-known mark, there is an increased risk of confusion, whether or not the goods and services of the parties are identical or similar. This acknowledgment should apply to marks that are well known by the public at large as well as marks that are only well known in relevant sectors of the public.
- (2) A narrow, clear, and focused dilution provision.

The dilution provision should:

- provide a clear definition for what constitutes a well-known mark, namely a mark that is “widely recognized by the general consuming public of Canada.”
- protect well-known marks regardless of the presence or absence of a likelihood of confusion between the well-known mark and the junior use.
- specifically protect well-known marks from junior uses that are likely to dilute the well-known mark.

INTA further recommends that dilution of a well-known mark should be a ground for opposing a trademark application or canceling a trademark registration.

For both infringement and dilution cases, there should be an acknowledgement that well-known marks need not be registered to benefit from the provisions. INTA would be pleased to work with the government of Canada on specific language for these provisions.

#### **4.6 Section 9 Reform**

INTA supports the reform of the provisions of Section 9 of the TMA, and in particular those provisions which deal with Her Majesty's Forces, universities and, especially, public authorities (paragraphs 9(1)(n))

INTA has previously proposed that the TMA be amended by wholly deleting sub-paragraphs 9(1)(n)(ii) and (iii), and introducing a sunset clause, as follows:

9. (1) No person shall adopt in connection with a business, as a trade-mark or otherwise, any mark consisting of, or so nearly resembling as to be likely to be mistaken for,

(n) any badge, crest, emblem or mark adopted or used by any of Her Majesty's Forces as defined in the National Defence Act in respect of which the Registrar has, at the request of Her Majesty, given public notice of its adoption and use.

(n.1) Any public notice of adoption and use of any badge, crest, emblem or mark made in favour of a "public authority" as an official mark or in favour of a "university" before \_\_\_\_\_ has the same force and effect as it had before \_\_\_\_\_ and all rights and privileges acquired under or by virtue of the provision then existing in this regard may continue to be exercised or enjoyed in Canada until \_\_\_\_\_. On \_\_\_\_\_, these rights and privileges will cease to have effect.

However, if CIPO is not prepared at this time to entertain the deletion of ss. 9(1)(n)(ii) and (iii) from the TMA, INTA submits that - in view of the foregoing concerns - reform of Section 9 is nonetheless required. Because paras. 9(1)(e) and 9(1)(n.1) also provide for the Registrar to give public notice of various prohibited marks it is logical that at least some of the reforms extend to those paragraphs as well. INTA therefore submits that the following proposals relating to the reform of Section 9 should be seriously considered:

##### *a. Use and Adoption of Official Marks and Statement of Wares and Services*

In INTA's view, there is some overreaching by public authorities with respect to statements that official marks have been "adopted and used" on "wares and services." This problem may be curtailed if the requesting party had to show that by the relevant date it had "used and adopted"

the official mark (something akin to a Section 45 test). At a minimum, a list of wares and services in association with which the official mark is said to have been used and adopted should be required to be set out in the request for public notice, in the same manner as required in a trade-mark application (Section 30(a)).

*b. Inspection Prior to Public Notice*

We see no rationale in not permitting requests for a public notice under paragraph 9(1)(n) to be open for public inspection prior to public notice being given in the Trade-marks Journal. INTA submits that Section 28(1) of the TMA should be amended to mandate that the Registrar keep an index of arms, flags, badges, crests, emblems, marks and armorial bearings for which requests for protection under paragraphs 9(1)(e), s.9(1)(n) and s.9(1)(n.1) are received as well as an index of arms, flags, badges, crests, emblems, marks and armorial bearings for which the Registrar has given public notice of adoption and use under paragraphs 9(1)(e) and s.9(1)(n) or public notice of the grant, recording or approval under paragraphs 9(1)(n.1). Section 29(1) would then operate to permit the public inspection and searching of paragraph 9(1)(e), 9(1)(n) and 9(1)(n.1) requests prior to the advertisement of the public notice of their adoption and use/grant, recording or approval, as the case may be. This would permit searchers to provide a more complete registrability report and allow trade-mark owners to make more informed decisions.

*c. Renewal, Abandonment, Cancellation and Opposition*

For ease of reference in the following discussion, the owners of arms, flags, badges, crests, emblems, marks and armorial bearings (collectively referred to hereafter as “Section 9 Marks”) subject to protection under s.9 will be referred to as Section 9 Owners. INTA supports the view that the TMA should be amended to include specific provisions:

- providing for a term of protection, extendable by renewal terms of equal length, of not longer than 10 years for Section 9 Marks
- permitting Section 9 Owners to abandon their Section 9 Marks and requiring the Registrar to give public notice of that abandonment. Further in respect of Section 9 Marks arising from paragraph 9(1)(n.1) the Registrar should be required to give public notice in any change in status of the grant, recording or approval in respect of a recipient’s right to use such Section 9 Marks.
- providing for a section 45-type proceeding obliging Section 9 Owners (at the very least those claiming under paragraphs 9(1)(e) and 9(1)(n)) to prove continued use of their Section 9 Marks. Surely, the same rationale that applies to deadwood trade-mark registrations applies equally well to Section 9 Marks.
- providing for an opposition-type procedure in order that the entitlement of the Section 9 Owner to the protection afforded by the relevant provisions of the TMA

may be challenged by interested persons in an administrative framework rather than through the process of judicial review in the courts.

*d. Uniformity in Entitlement to Rights*

The words “adoption and use” appear in the last line of paragraph 9(1)(n). This is consistent with the words “adopted and used” appearing in sub-paragraph 9(1)(n)(iii), however, it is inconsistent with the words “adopted or used” appearing in 9(1)(n)(i). Moreover, none of these words appear in 9(1)(n)(ii). There does not appear to be any justifiable reason for the discrepancy and it is submitted that badges, crests, emblems and marks of Her Majesty’s forces, universities, and public authorities be treated in the same manner, i.e., the words “adopted and used by” should replace the words “adopted or used by” in 9(1)(n)(i) and the word “of” in 9(1)(n)(ii). This is also consistent with the wording appearing in paragraph 9(1)(e).

**Appendix 1**  
**Letters of Protest in Canada and Section 22 of the Proposed Amendments to the Trademarks Regulations**

*Letters of Protest in Canada and Section 22 of the Proposed Amendments to the Trademarks Regulations*, by INTA Famous & Well-Known Marks Committee, Canada Task Force, October 2014

**LETTERS OF PROTEST IN CANADA**

**and**

**SECTION 22 OF THE PROPOSED AMENDMENTS TO THE  
TRADEMARKS REGULATIONS**

**INTA Famous & Well-Known Marks Committee**

**Canada Task Force**

**November 2014**

## 1. **Introduction – Famous and Well-Known Marks**

A famous or well-known mark is a trademark that may be entitled to a broader protection by reason of its widespread reputation or recognition. INTA's position is that it supports the effective protection and enforcement of famous and well-known marks worldwide, and is committed in assisting countries in meeting their international treaty obligations to protect such marks.

## 2. **Famous and Well-Known Marks in Canada – Marcon**

From 2001 to 2003, an individual named Robert Marcon ("Marcon") filed a series of applications to register some of the world's most famous or well-known trademarks. His typical mode of operation was to seek registration of these marks in association with goods that somewhat differed from those commonly associated with the famous or well-known trademarks. For example, he sought to register DOM PERIGNON, HEINEKEN and CORONA for coffee-based beverages and other non-alcoholic beverages, and EVIAN for distilled spirits.

The Examination Section of the Canadian Intellectual Property Office (CIPO) refused some of Marcon's applications on the basis of confusion. However, in the majority of cases, the applications proceeded to advertisement, thus necessitating the commencement of opposition proceedings by the famous or well-known mark owners. In all opposed cases, the application was ultimately refused.

The Marcon applications and their refusal, whether it be at the examination stage or following opposition, does illustrate CIPO's willingness and ability to protect famous and well-known marks. However, the current statutory and regulatory regime requires the famous and well-known trademark owner to resort to the commencement of opposition proceedings in the majority of cases.

INTA believes that the introduction of Letters of Protest in Canada would not only be in line with CIPO's willingness to protect famous and well-known marks, but would also serve to provide famous or well-known mark owners with an informal mechanism by which to prevent a third party, such as Marcon, from registering trademarks that are confusing with their famous or well-known marks, without having to resort to the institution of opposition proceedings, which can take years to reach a conclusion at great expense to the famous or well-known mark owner.

### **3. Passing of Bill C-31**

The *Economic Action Plan 2014 Act*, No. 1, which includes significant amendments to the Canadian *Trademarks Act* (the "*Act*"), received Royal Assent on June 19, 2014. Accordingly, the Bill is now law and the amendments to the *Act* will come into force on a date to be set by order in council.

These amendments to the *Act* will necessitate a review of the existing statutory and regulatory regime in order to ensure that it is in line with the amendments and permits for their proper implementation. This is therefore an opportune time for INTA to make this submission for the introduction of Letters of Protest in Canada, as they exist in the United States.

### **4. Letters of Protest in the U.S.**

The Letters of Protest procedure in the United States is straightforward and explained in detail in Section 1715 of the United States Patent and Trademark Office (USPTO) *Trademark Manual of Examining Procedure* (7<sup>th</sup> ed. 2010) (TMEP). It is an informal procedure created by and existing at the discretion of the USPTO that allows third parties to bring factual and objective evidence to the attention of the USPTO bearing on the registrability of a trademark, without causing undue disruption or delay to the examination process. Section 1715 of the TMEP and the USPTO Letters of Protest Practice Tip (the "Practice Tip") are attached as Schedule A and B, respectively. Attached as Schedule C is an article entitled *Letters of Protest: An Attractive Alternative to a U.S. Opposition* that appeared in Vol. 66 No. 4 of the INTA Bulletin.

#### **(i) When Appropriate**

The following is stated in the Practice Tip:

- a. A letter of protest is an informal procedure that allows third parties to bring to the attention of the USPTO evidence bearing on the registrability of a mark. However, “the issues (and related evidence) that are appropriate for letters of protest are those which are relevant to ex parte examination and support a reasonable ground for refusal.”
- b. The most common grounds for accepting a letter of protest include:
  - likelihood of confusion with a U.S. trademark registration or prior pending application;
  - descriptiveness/genericness of the mark;
  - use of a registered mark in the identification of goods/services, or false association with the protestor.
- c. A letter of protest is not meant for, nor will it be accepted, if the issue presented relates to common law prior use, an ownership dispute, fraud or mere disagreement with the examination conducted by the examining attorney.

## **(ii) Procedure**

The Practice Tip also provides the following pertaining to the procedure for filing letters of protest and the appropriate evidence:

- a. The letter of protest should be filed with the Office of the Deputy Commissioner for Trademark Examination Policy as soon as possible after the subject application is filed and preferably before publication. Pre-publication letters of protest are accepted if the evidence is relevant and supports a reasonable ground for refusal. After publication, a letter of protest is only accepted if the evidence supports a clear error on the part of the USPTO in approving the mark for publication. A letter of protest filed after the thirty-day opposition period is denied as untimely. As per the article attached as Schedule C, in fiscal year 2010, approximately 1,060 Letters of Protest were filed with the USPTO. The grant rate for letters filed pre-publication was 69 percent. The grant rate for letters filed post-publication was 29 percent.

b. The evidence to submit should be factual and objective evidence that is relevant to examination of the mark. Only evidence relevant to the grounds for protest will be forwarded to the examining attorney if the letter of protest is accepted by the Deputy Commissioner. The letter of protest itself, and any arguments included therein, is not forwarded to the examining attorney for consideration.

c. Evidence submitted should be succinct in nature and consist of quality submissions that are relevant to the grounds being considered and support a reasonable ground for making the refusal or issuing the requested requirement.

d. If the issue is a likelihood of confusion with federally registered marks or prior pending applications and the goods/services are identical, all that is required is the relevant registration or application serial number or numbers. Copies of registration certificates or printouts from the USPTO database are not needed.

e. If the issue is a likelihood of confusion and the goods and services are not identical, then objective third party evidence showing the relatedness of the goods/services should be provided.

f. If the issue is descriptiveness/genericness of the mark, evidence showing use by others of the mark or portions of the mark in a descriptive or generic manner, or excerpts from the dictionary showing the meaning of the mark, is appropriate. However, merely submitting a list of web sites is not sufficient and a letter of protest merely including such a list will be denied. With respect to the latter point, reference is made to §710.01(b) of the TMEP for guidance on the transitory nature of Internet postings.

g. If the issue is descriptiveness/genericness and the evidence includes third-party registrations, a mere list of the registrations or a copy of a search report is not proper evidence of such registrations. Copies of the registration certificates should be included.

## **5. Applicability Not Limited to Famous or Well-Known Marks**

In view of the foregoing, it is clear that Letters of Protest need not be restricted to issues relating to likelihood of confusion, and do not constitute a vehicle that is solely applicable to famous or well-known mark owners. It is important to note that a letter of protest in the U.S. may be filed with respect to any ground upon which the USPTO could refuse registration.

## **6. Implementation in Canada**

As noted above, the Letters of Protest procedure in the United States was created by and exists at the discretion of the USPTO. INTA submits that a similar procedure can and should be created and exist at the discretion of CIPO.

In addition to raising the common grounds of descriptiveness and likelihood of confusion pursuant to ss. 12(1)(b) and (d) of the *Act*, and related disentanglement pursuant to s. 16 of the *Act* (previously filed application), Letters of Protest in the Canadian context may also be useful to side-step opposition proceedings by raising other grounds of non-registrability, such as:

- the mark is primarily merely the name or surname of an individual pursuant to s. 12(1)(a) of the *Act*;
- the mark is the name in any language of any of the goods and services pursuant to s. 12(1)(c);
- the mark is prohibited pursuant to ss. 12(1)(e), and 9 and 10 of the *Act*;
- the mark is in whole or in part a protected geographical indication pursuant to ss. 12(1)(g) and (h); and
- the mark is not distinctive pursuant to s. 2, and new ss. 12(3) and 32(1).

In addition, Letters of Protest could be utilized to deal with section 30 non-compliance issues, such as the goods and services are not described in ordinary commercial terms.

However, it is noted that section 8 of the *Trademarks Regulations* stipulates that correspondence relating to the prosecution of an application for the registration of a trade-mark shall be with the applicant (emphasis added). This section may be interpreted as limiting correspondence with

only the applicant (or its agent) and thus disallowing consideration of correspondence from a third party. An amendment to this section may therefore be required in order to ensure that this section does not run afoul of a Letters of Protest procedure. By way of example, an exception could be introduced that expressly permits third parties to bring evidence to the attention of CIPO bearing on the registrability of a trademark. In the alternative, CIPO could issue a Practice Notice pertaining to Letters of Protest in which it is expressly stipulated that section 8 of the *Trademarks Regulations* is not interpreted by CIPO as disallowing the consideration of relevant third party correspondence that brings evidence to its attention bearing on the registrability of a trademark.

## 7. Amendments to the Trademarks Regulations 2014

Following the initial preparation of this submission, CIPO issued a consultation document on proposed amendments to the *Trademarks Regulations*. The consultation period began on October 1, 2014, and ends on November 30, 2014.

Section 22 of these proposed amendments provides for the acceptance of third party correspondence during the examination process. According to the consultation document, the third party correspondence is not intended to commence an *inter partes* proceeding but will provide examiners with information that could potentially help in the assessment of an application.

More specifically, section 22 provides 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.

The above obviously deals with the issue raised concerning section 8 of the *Trademarks Regulations*. The above also raises two separate issues when compared to the Letters of Protest procedure in the U.S.

First, the U.S. procedure contemplates the issuance of an Office Action in response to the filing of a Letter of Protest, in circumstances where the letter provides evidence that is relevant and supports a ground for refusal. It is submitted that given that the proposed amended *Regulations* are not intended to commence *inter partes* proceedings, the possibly better avenue of communication to the applicant is by way of an Examiner's Report rather than by way of the forwarding of the third party correspondence. In any event, the acceptance of third party correspondence is welcomed and is viewed as being a positive amendment that will serve the interests of trademark owners.

Second, a Letter of Protest will not be accepted in the U.S. if the issue presented relates to common law prior use, an ownership dispute, fraud or mere disagreement with the examination conducted by the examining attorney. Section 22 speaks to the registrability of the applied for trademark. Is this limited to section 12 registrability or does it extend to section 16 entitlement and for that matter, to technical compliance under Section 30 or non-distinctiveness? Under the U.S. procedure, it would be limited to section 12 grounds, section 16 non-entitlement (previously filed application), descriptions of wares and services, and distinctiveness/descriptiveness/genericness and, presumably, the proposed section 22 amendment would be equally limited. In any event, and as stated above, the acceptance of third party correspondence is welcomed and is viewed as being a positive amendment that will serve the interests of trademark owners, irrespective of the approach taken by CIPO.

In view of the foregoing, the following revised wording for section 22 is proposed:

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 correspondence – such pertinence pertaining to any ground for refusing registration of the applied-for trademark under section 37 of the *Trademarks Act*. 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 determine whether such correspondence is pertinent and will then, in accordance with section 37, notify the applicant of his/her objections and reasons for those objections by way of an Examiner's Report, and forward a copy of any such correspondence he/she determines to be pertinent to the applicant, or cause the application to be advertised.

A track changes version of revised section 22 is provided below for ease of reference:

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~~ correspondence – such pertinence pertaining to ~~the registrability of the applied-for trademark~~ any ground for refusing registration of the applied-for trademark under section 37 of the *Trademarks Act*. 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 determine whether such correspondence is pertinent and will then, in accordance with section 37, notify the applicant of his/her objections and reasons for those objections by way of an Examiner's Report, and forward a copy of any such correspondence which it he/she determines to be pertinent to the applicant, or cause the application to be advertised.

## 8. Conclusions

It is reiterated that the Letters of Protest procedure in the United States was created by and exists at the discretion of the USPTO. A similar procedure can equally be created in Canada and exist at the discretion of CIPO. The proposed amendments to the *Regulations* are a clear indication that CIPO is receptive and shares that view. It is submitted that given the high cost of opposition proceedings, both from the perspective of the parties involved and CIPO, and their lengthy duration, the introduction of Letters of Protest in Canada provides for an attractive and relatively low cost alternative.