



THE CANADIAN
BAR ASSOCIATION

L'ASSOCIATION DU
BARREAU CANADIEN

Proposed Amendments to the *Trade-marks Regulations 2014*

**NATIONAL INTELLECTUAL PROPERTY LAW SECTION
CANADIAN BAR ASSOCIATION**

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PREFACE

The Canadian Bar Association is a National Association representing 36,000 jurists, including lawyers, notaries, law teachers and students across Canada. The Association's primary objectives include improvement in the law and in the administration of justice.

This submission was prepared by the National Intellectual Property Law Section of the Canadian Bar Association, with assistance from the Legislation and Law Reform Directorate at the National Office. The submission has been reviewed by the Legislation and Law Reform Committee and approved as a public statement of the National Intellectual Property Law Section of the Canadian Bar Association.

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Proposed Amendments to the *Trade-marks Regulations* 2014

I. INTRODUCTION AND EXECUTIVE SUMMARY

The National Intellectual Property Section of the Canadian Bar Association (the CBA Section) is pleased to comment on the proposed amendments to the Trade-marks Regulations, published in the October 2014 discussion document. Our comments are aimed at:

1. Ensuring the Canadian trade-marks regime operates as efficiently as possible, and safeguarding the regime against the real and substantial likelihood of abuse that could occur under the system;
2. Ensuring implementation of the Madrid Protocol is given appropriate consideration;
3. Reducing unnecessary complexities that may arise from implementation of the proposed regulations that would be burdensome on businesses and other stakeholders; and,
4. Reducing the overall costs associated with engaging the trade-marks regime in an effort to make the system as user-friendly as possible.

The CBA Section's comments are preliminary because we have not seen the wording of the proposed amendments, but only statements of what the Canadian Intellectual Property Office (CIPO) intends to do. This is particularly so for sections on implementation of the Madrid Protocol, where general ideas are expressed but implementation will be subject to the specific language in the regulations. Our comments should not be taken for approval of specific drafting language reflecting the matters discussed in it. We welcome the opportunity for further consultation with CIPO on the specific language.

The time for consultation has been limited in view of the complexity of the Madrid Protocol. When the United States implemented the Madrid Protocol, more than four years passed from the original ratification of the Protocol until its implementation, to ensure that all interests were appropriately considered. Similarly, the CBA Section requests that CIPO afford appropriate time and consideration before implementing the Madrid Protocol in Canada. While

the CBA Section is pleased to have this opportunity to consult, the two month consultation is not enough time to fully consider the Madrid Protocol provisions.

The specific comments track the numbering of the discussion document.

II. BACKGROUND

The amendments to the *Trade-marks Act* on trademark use, to which we have taken issue, are not required by any of the treaties. Some of these concerns can be partially addressed by further amendments to the regulations. Subsection 30(2)(d) of the amended *Trade-marks Act* provides that an application shall contain, among other things, any prescribed information or statement. We suggest that the amended regulations provide that an applicant include in the application a statement on whether the applicant bases its claim to entitlement on proposed use or the date it first used the trademark in Canada. This will help address the concerns raised by many practitioners, industry groups and lawyer/practitioner organizations.

Requesting 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 that an application contain some or all of a defined list of items, 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) “The 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.” 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. 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(1)(a)(xvi) or the declaration of evidence referred to in Article 3(1)(b)”.

In addition, a requirement to provide a statement of use on renewal is not prohibited by the Singapore Treaty. If there will be a renewal fee, Article 13(b) provides that “Fees 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.” The Article contemplates that declarations or evidence of use are permissible. The United States is a member of the Singapore Treaty, and they require evidence of use both in the sixth year of registration and on renewal.

“Use” information is permitted as part of the application process and on a post-registration basis, and the *Trade-marks Act* as amended permits this information to be provided or required in the regulations. This was also considered in the paper published on the CIPO website, *Legal and Technical Implications of Canadian Adherence to the Madrid Protocol*, at page 67.

Based on widespread support for use information as part of the procedure for registration of trade-marks, we suggest that the Government incorporate use information in the regulatory changes. For example, applicants may elect to provide either a statement of use in Canada along with a date of first use, for any class of goods or services, or a statement of proposed use in Canada, at filing. If no statement of use is filed, applicants should be deemed to have filed based on proposed use in Canada. If a statement of use is not filed originally, applicants and registrants may file the statement of use at any time prior to advertisement of the application in the Trade-marks Journal.

Our comments on specific proposals in the discussion document incorporate recommendations to permit information on use to be obtained, encouraged and maintained on the Register.

III. PART 1 – PROPOSED AMENDMENTS TO THE TRADE-MARKS REGULATIONS

Examination and General Provisions

Correspondence

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.

The impact of *dies non* on the deemed date of receipt of a communication should be clarified. 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. Subsection 66(2) of the *Trade-marks Act* has not been amended, and states 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”.

RECOMMENDATION:

- 1. The CBA recommends amendments to subsections 3(7) and 3(8) of the Regulations should provide that the date on which the Office receives the communication shall constitute the date of receipt of the communication, if it was received on a date that the Office was open for business.**

Paragraph 5(2)(e) should be deleted 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 subsection 30(g) of the *Act*.

While “representative for service” may be omitted, “agent” should not be. The exception from the requirement for correspondence specific to an application should extend to changes to agent and agent addresses.

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 Trade-marks, 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".

The impact of stating that the parties “must” notify the Registrar of all changes of address should be clarified. If a party may obtain relief from the consequences of failure to respond to any correspondence by advising that the correspondence was not received due to a change in address, then this should not unduly impact parties or their representatives.

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.

RECOMMENDATION:

- 2. The CBA Section recommends that the requirement to identify the trademark in correspondence with the Office be maintained. Omitting the trademark will add inconvenience and time to connecting correspondence with the right file.**

What Is Missing

The Trade-marks Office should be encouraged to communicate electronically with users – applicants, registrants and parties in opposition or non-use proceedings. Users should have a mechanism available to indicate their desire that all correspondence to them from the Office be sent electronically, and that the Office accept their electronic communications. In addition, the Office should adopt the practice widely followed in the United States of telephone communications with examiners for 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.

TM Agents

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.

RECOMMENDATION:

- 3. The CBA Section recommends that the notice in writing regarding the appointment of a trademark agent may be in any correspondence relating to an application, registration, opposition section 45 proceeding or any other business before the Office, and that it be clarified that a separate letter to the Registrar is not required.**

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.

This change will 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. Their companies are not easy to locate, and it is difficult for a party seeking recourse for improper conduct to succeed.

RECOMMENDATION:

- 4. The CBA Section recommends that any entity, other than the registrant or its appointed agent wishing to renew a registration provide CIPO with their name, full contact information and an address for service in Canada.**

Third Party Correspondence – TM Examination

22. A new provision should be added 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 parties 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.

This concept is welcome, but further clarification is sought. For example, it is unclear what is meant by “pertinent”; it should be confirmed that this is not a substitute for examination by the Trade-marks Office (TMO); and, the impact of both the third party correspondence and the step of forwarding a copy of the correspondence to the applicant is unclear. Is the intent to permit owners of other marks to know that the TMO will consider the impact of their marks on registrability and entitlement issues? Applicants should not have to respond to both the Registrar’s correspondence and that of third parties.

Address for Service

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 Trade-marks 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)

RECOMMENDATION:

5. **Given the importance of service rules in Canada, the CBA Section recommends that the word “may” be replaced with “shall” in s. 25. Attempting to contact and serve documents on persons outside Canada can be time-consuming and expensive and the results are uncertain. Requiring a Canadian contact address, ideally that of a Canadian agent who can be easily identified and contacted, is preferred.**

26. It is proposed that 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.

RECOMMENDATION:

- 6. The CBA Section recommends that the test not be that an address be “kept up to date”, but instead that the mail properly served is returned, and the Registrar has made some attempt to contact the party by using other mail resources.**

We question whether it is permissible, in accordance with administrative law, for a tribunal to simply decide to no longer “serve” documents on a party, for any reason. In addition, the comment that “they will no longer be served” appears to include service not only by the Registrar, but other parties to the proceeding. When could a party decide that an applicant, registered owner or other has not kept an address up to date? What if the party knew the actual address of the opposite party, but the opposite party had not kept its recorded address in the Trade-marks Office up to date. The spectre of parties deciding to punish each other for failure to keep addresses up to date, and the consequences in additional time, appeals, judicial reviews suggests that this proposal should be reviewed.

General

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

Presumably an address need not be in English or French. For example, Via Roma for an address in Italy should not need to be translated. Similarly, it is common for applicant names to include some local indication of corporate status.

RECOMMENDATION:

- 7. It should be clarified that this does not apply to local addresses, to the extent that the addresses refer to locally used street or other geographic names, nor to any part of the applicant’s name. Neither the applicant’s name nor its address should have to be in English or French.**

Advertisement of Applications

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

1. The representation, description or both of the trademark;
2. The name and address of the applicant and the applicant's trademark agent, if any;
3. The application number;
4. The filing date of the application and priority date, if any;

5. 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;
6. In the case of an application for a certification trademark or a trademark consisting of standard characters, a note to that effect;
7. The particulars of any translation or transliteration; and
8. In the case of evidence of acquired distinctiveness and/or the particulars of the territorial restriction, a note to that effect.

RECOMMENDATION:

8. **The CBA Section recommends that this section should be amended to add: “5. 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 Regulation, elects to provide.”**

Application for Registration

Since amended section 30(d) of the *Trade-marks Act* permits, “any prescribed information or statement”, a new provision should be added to permit any applicant to 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. If no statement of use is filed the application should be deemed to have been filed based on proposed use.

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

Section 33(f) of the amended *Trade-marks Act* requires that “any prescribed fees” must be paid to obtain a filing date. If the prescribed fees are made up of a class filing fee an underpayment of a per class fee would result in there being no filing date which has serious ramifications for priority and entitlement. It appears that this cannot be remedied by a CIPO practice of accepting the initial fee and then a later “top up” in light of the *Dutch Industries* case.

Representation or Description of the Trademark

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 *Trade-marks Journal*, the Registrar may require an applicant to submit a new representation.

It should be clarified that the common practice of showing the placement of a trademark on an object, e.g., a dotted outline of a bottle, with a comment that the bottle does not form part of the trademark, will still be permissible. Showing how the mark is displayed is helpful to the examiner and others who review the Register.

This should not apply to matter included in a representation or description for the purpose of explaining the features of the mark, including the placement of a mark on 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 a similar statement.

Standard Characters

43. Where a graphic representation is required, an application for a trademark that is not in standard characters may contain a representation that consists of more than one (1) view of the trademark, where that is required to clearly define the sign, but in no case more than six (6) views.

This comment is found under “standard characters”, but actually applies to marks that are not in standard characters. It should be clarified what is meant by a “view”, and how it will apply to non-traditional marks such as moving images or holograms.

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).

If colours, *per se*, are now permissible subject matter for an application, it should be confirmed that the “graphic representation” is merely a sample of the colour, and not a representation of the colour applied to any particular object.

No directions are given, on possible requirements, possible specimens, or future requirements for marks that consist of taste, scent or texture.

Goods and Services

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.

The proposed amendment introduces the concept of “clear, accurate and precise” description. This needs to be reconciled with the existing “ordinary commercial terms” requirement.

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)

It should be clarified whether this section will apply to all applications, including those processed pursuant to the Madrid Protocol. If so, two months may be too short a term. As well, it is unclear whether the two month period applies from the issuance of a default notice or could an applicant be in default, not know it, and then be too late to remedy the default.

Divided Applications

56. ...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;

RECOMMENDATION:

9. The CBA Section recommends that the requirement for a statement of withdrawal of opposition from an opponent be removed as a precondition for acceptance of a divisional application.

A statement from an opponent that the opposition will be withdrawn for the classes, goods or services should not be a precondition for acceptance of a divisional application. An applicant may wish to delete classes, goods 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.

Amendments

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.

This raises the concept of introducing a “substantially the same test”. What specifically does this mean and how does it relate to the “alter its distinctive character” test?

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.

While flexibility in amending marks is desirable, permitting marks to be amended after advertisement may 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”. Steps to protect an opponent are necessary.

The interaction between these provisions and the Madrid Protocol must be considered. Once a Canadian applicant files an International Application (IA) under the Madrid Protocol, and that IA results in an International Registration (IR), 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.

Renewal

The amended *Trade-marks Act* provides that prescribed renewal fees shall be paid. It would be possible under Article 13 of the Singapore Treaty to set a base fee for renewal (adjusted, presumably, for class fees) and adjust that fee up or down based on whether a voluntary declaration of use or evidence of use has been filed. As a result making a declaration of use or evidence of use voluntary, upon renewal, is not prohibited. This, added to a declaration of use or proof of use on application, will go a long way to address the many problems identified by trademark owners, experts and practitioners concerning use.

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).

The *Act* states:

46. (1) 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 twelve and six month reference conveys the idea that renewals can be done only six months in advance, and for six months following the expiry of the ten year term. Many companies plan for and budget their renewals well in advance of the renewal term, and to restrict renewals to only six months in advance is too short.

RECOMMENDATION:

10. The CBA Section recommends renewal of a registration up to a year in advance, and that a six-month grace period be provided.

The impact will be to shorten the current grace period. Presumably, the notice of non-renewal will now advise of the six-month term, calculated from the actual renewal deadline instead of the date of the TMO letter.

RECOMMENDATION:

11. The CBA Section recommends that the TMO 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 online services available on CIPO's web site.

This will pose an inconvenience for small, self-represented registrants and unnecessarily add to the complexity of IP services.

The Register

The discussion document lists the information required to be published on the Trade-mark Register:

71. Amend s. 52 of the Regulations to indicate, in respect of each registered trademark...

(b) The name and address of the applicant and of the applicant's trademark agent, if any;

(f) In the case of a registration for a certification trademark or a trademark consisting of standard characters, a note to that effect;

(h) In the case of evidence of acquired distinctiveness and/or territorial restriction, a note to that effect.

RECOMMENDATION:

12. The CBA Section recommends that, in subsection 71(b), the Register should also include the name and address of the registrant, and its trademark agent.

It should be clarified in subsection 71(f) whether all details of the certification mark will be available.

It should be clarified in subsection 71(h) whether all details filed during prosecution relating to acquired distinctiveness and/or territorial restriction will remain available.

RECOMMENDATION:

13. The CBA Section recommends that, since information on use or evidence of use is permitted under the Singapore Treaty, this provision be amended to add “(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”.

IV. PART 2 – IMPLEMENTATION OF THE MADRID PROTOCOL

The CBA Section requests further time to consult on the implementation of the Madrid Protocol beyond the two month consultation currently provided.

The Madrid Protocol is a detailed and specific document, and the discussion document primarily addresses specific steps and requirements, making comment unnecessary. One point of some national discretion is fees, and since this consultation does not address fees, the impact and usefulness of the Madrid Protocol to Canadian and other trademark owners cannot be fully addressed. Our comments focus on the interaction between current Canadian procedures and any steps that appear to be voluntary, or for which a choice is given under the Madrid Protocol. The focus should be maximizing the benefits for Canadian trademark owners.

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 indicate if a signature of the applicant is required (which, for Canada, should not be necessary).

Clearly requiring a declaration of intention to use a mark at filing will also 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 an opposition later on and only then become aware of the requirement.

RECOMMENDATION:

- 14. The CBA Section recommends that Canada maintain a declaration of intent to use requirement for all applicants using the Madrid Protocol to acquire rights in Canada, given the historic importance of use as a basis for trademark rights in Canada, and to ensure that all applicants for IRDCs are aware, on making the request to extend rights to Canada.**

The proposed regulations contemplate replacing, revising or amending the Common Regulations from time to time. Updated Common Regulations cannot be automatically incorporated into the *Act* and Regulations, as this would allow amendment of the *Act* and Regulations by someone or something other than Parliament or the Governor in Council, respectively.

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

7. An application for international registration shall: ...
d. Be accompanied by the certification fee (if any) set out in the Tariff of Fees

The certification fee is charged by the Office of Origin (OO) to ensure that the International Application (IA) reflects the national application and meets the requirements of the Protocol. This fee will be kept by the OO, 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 IR or from the holder of the IR in connection with the filing of the IA or the renewal of the IR.” Since fees are not part of this consultation, it is difficult to comment.

RECOMMENDATION:

- 15. The CBA Section 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 US application or registration, and \$150 per class if the IA is based on multiple US applications.

8. For the purposes of paragraph 7(a) above, the application shall be filed with the Registrar of Trade-marks by using the online application service that may be accessed through the Canadian Intellectual Property Office’s website (if available).

RECOMMENDATION:

16. The CBA Section recommends that, while electronic filing is likely more convenient for both applicants and the Registrar, paper filing should also be permitted.

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;...

This relates to the “dependency” of the IR on the basic application or registration of the applicant in its home country. It should be clarified that the obligation to notify the International Bureau (IB) will occur on expiry of any appeal period for the decision or impact of withdrawal, limitation, cancellation abandonment, expungement, rejection, expiry, or otherwise, and that five years refers to the period after the date of the IR.

13. Where the review of the international application reveals any 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.

14. If there are no irregularities or if any irregularities are remedied, the Registrar shall take all reasonable steps to ensure that the application is received by the International Bureau within two months from the date the Registrar received the request (pursuant to paragraph 7).

15. If the irregularities are not remedied within a six month period, the Registrar shall refuse to forward the international application to the International Bureau and the international application is deemed never to have been filed.

The two-month period originates with Article 3(4) of the Protocol, assigning a date to the IR that is the date the Office of origin received the IA, if the IB receives it within two months. Otherwise, the IR will be assigned the date the IA was received by the IB. Practically this will require examination by the TMO, with a notice of irregularities to the applicant or agent, a response or amendment to the form, approval of any changes by the TMO and then submission to the IB within two months. Further, the suggestion that the Registrar will use “all reasonable efforts” to ensure receipt within two months will be cold comfort to an applicant in any case where the Registrar suggests that despite its best efforts, the two month date was not met. Given current delays to first examination, there will have to be much speedier turnaround by the TMO, or else applicants will lose the benefit of the IA filing date.

These provisions seem to require that:

- the TMO will need to dedicate resources to processing IAs;
- all correspondence between IA applicants or agents must be sent electronically, with clear notations of deadlines and the impact of missed deadlines;
- care must be taken to clearly indicate the difference between the two-month and six-month periods; and
- this may lead to a two track system, with all other applications not receiving the same immediate attention.

RECOMMENDATION:

17. The CBA Section recommends that the Registrar confirm that regular applicants, who have the same need for speedy service, should not suffer delays as a result of redirected resources to process IAs and IRDCs, particularly since IRDCs may be a small percentage of the overall filings in Canada.

For item 13 in the regulations, an “irregularity” includes 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”.

The proposed amended regulations permit amendment to a mark after it is certified. Upon this kind of amendment, once the mark is no longer identical to the mark shown in the IA, it is unclear as to what will happen to the IA. A mark in an IA or IR may not be amended. 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.

13 h refers to the fact that “*the prescribed fee is missing or insufficient*”. Clarify that this applies to the Registrar’s “certification fee”, and not the fees payable to the IB (as discussed below).

Missing from the list in 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).

RECOMMENDATION:

18. The CBA Section recommends that the Regulations be amended to include “the name and address of the applicant’s representative, if any”, since the Rules also provide for communication to the representative, and the communication has the same effect as one addressed to the applicant or holder of an IA or IR.

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

Fee calculation and payment will be complicated. In addition to a certification fee payable to the Registrar (see 7(d) of the discussion document), a series of fees will be payable to the IB (a basic fee, the supplementary fees payable per class, and the complementary fee or individual fee for extensions to other countries). Fees could be set and collected by the Registrar (under Article 8 of the Protocol) for submitting the IA to the IB. For those payable to the IB, the Protocol Rules assume that an account will be set up with the IB, and fees will be payable in Swiss francs.

RECOMMENDATION:

19. The Registrar should 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 pay those fees directly to the IB. Since the Registrar is also submitting the IA, it would be easier for applicants to request the Registrar to submit the fee with the IA. At least until all involved parties (the TMO, applicants and their agents) become familiar with the procedure, the Registrar should assist both with the calculation of fees and the payment of fees. The Registrar should assist with both the calculation of fees and payment of fees to the IB.

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.

RECOMMENDATION:

20. The CBA Section recommends that any reference to “applicant” in the above provision be amended to refer to its representative, if any.

Under Rule 12 of the Common Regulations, any issues about classification must be dealt with within three months, and any effect on fee payment is also time-limited.

RECOMMENDATION:

21. The CBA Section recommends that the applicant be fully informed of the implications of the amendments to classification or specification on goods or services so it may ensure that appropriate fees are paid in a timely manner.

International Registrations Designating Canada (IRDC)

The premise of the Madrid Protocol is that once the application to extend the protection of the IR is communicated to the national office members, the application will be treated as a national

application. No special examination of the applications is required. With the wish to keep a use-based registration system, the declaration of intention to use requirement is recommended, to ensure all registrants seeking the benefits of registration in Canada meet the same minimum requirements of having at least an intent to use their trademark in Canada.

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.

The amendment contemplates that an IRDC is deemed to be filed in accordance with section 30 of the *Act*. Absent other language in the Regulations this may be problematic in an opposition proceeding involving an IRDC as it seems to suggest that the section 30 based grounds of opposition are removed by virtue of the operation of the deeming language.

Priority claim of an IRDC

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.

RECOMMENDATION:

22. The CBA Section recommends that, while it is generally assumed that the "request for extension of protection" will only apply to a request for extension of protection to Canada, this should be clarified.

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.

Item a. should include 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.

This applies to notification of “grounds” of opposition, not that the opposition decision ought to be made within the time limits. It should be clarified in what cases, will “if applicable” apply?

The timing limitations in this section appear, as noted in the discussion document under “Opposition”, to prevent the use of the maximum nine month cooling off extension before filing a statement of opposition. That should encourage parties to actually 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 the case in Europe, for example). This appears to prevent parties from amending the grounds of opposition at any time after the described term of the earliest of “seven months after the beginning of the opposition period or within one month after the end of the opposition period”. A few other limitations are noted in a paper by Alan Troicuk on the Madrid Protocol on the CIPO website:¹

Section 9(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.

¹ Troicuk, Alan, “ Legal and Technical Implications of Canadian Adherence to the Madrid Protocol” *CIPO* (January 2012) [www.cipo.ic.gc.ca/eic/site/cipointernet-internetopic.nsf/vwapj/mcProtocoleMadrid-tmMadridProtocol-eng.pdf/\\$file/mcProtocoleMadrid-tmMadridProtocol-eng.pdf](http://www.cipo.ic.gc.ca/eic/site/cipointernet-internetopic.nsf/vwapj/mcProtocoleMadrid-tmMadridProtocol-eng.pdf/$file/mcProtocoleMadrid-tmMadridProtocol-eng.pdf)

Opposition

RECOMMENDATION:

23. The CBA Section recommends that, as soon as an opposition is filed, the Registrar must transmit the notification of the opposition to the applicant or its designated representative. At that time, 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.

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.

It should be clarified whether extensions of time to file a counterstatement will be permitted.

We assume that the provisions on a "counterstatement" in amended section 38 of the Trade-marks Act will apply to opposition proceedings relating to IRDCs.

Evidence

It appears that paragraphs 40 and 41 ought to be reversed. It should be clarified whether extensions of time will be permitted.

The comments below with on Part 3 and opposition evidence also apply with respect to Madrid Protocol opposition evidence.

The discussion document has no provisions on written argument or hearings. The CBA Section requests clarification on whether the regular provisions for oppositions at this stage will apply.

Transformation

This section requires a review of both Article 6 of the Protocol (on dependence of the IR and all related rights granted following the extension of the IR on the originating national rights for

five years from the date of the IR) and Article 9 quinquies, permitting transformation to national rights.

The discussion document explains the concept of dependence (as in Article 6 of the Protocol). Canada, if acting as an OO, must notify the IB of any decision within five years of the date of the IR affecting the originating rights, whether either the application, if still pending, be limited, withdrawn, abandoned or refused, or the registration limited, cancelled or otherwise invalidated. Article 6(3)(iii) extends the five year term if a proceeding (such as a section 45 proceeding) or an opposition or opposition appeal, was started within the term. Under Article 6, the protection of the IR, and by implication all extended rights in countries to which the IR has been extended, “may no longer be invoked” (Article 6(3)) and the OO is obliged to notify the IB.

Article 6 provides for protection of the IR to be lost if there is a decision “in respect of all or some of the goods and services listed in the IR”. One interpretation is that all rights in the IR are lost if the decision impacts all or some of the goods or services. That is not apparently the way this works. Instead, the IR seems to remain in place for any goods or services not impacted by a decision.

Article 9 quinquies provides a mechanism to preserve rights, by requesting transformation. The discussion document gives the example of a US applicant requesting transformation, but presumably, in Canada, there are two aspects to this: first, the impact on any IR, and related extended rights, to any Canadian IR owner; and second, the impact on the owner of an IRDC if its national rights are impacted.

RECOMMENDATION:

24. The CBA Section recommends more certainty as to the impact on Canadian IR holders of Articles 6 and 9 quinquies of the Madrid Protocol.

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.

It should be clarified what is intended by “transform... a protected international trademark into a registered trademark”. Does this mean the former IR rights are now only “national” TM rights? Will a “transformation” application in Canada be subject to regular examination?

50..... (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”.

It should be clarified what is intended by this provision.

Replacement

Under Article *4bis* of the Protocol, existing “national” registrations that subsequently become the subject of an IR are deemed to be replaced if the national rights are for the same mark, goods and services. The 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 Troicuk,² there are “important divergences of practices and of interpretation amongst the Contracting Parties”.

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.

² *ibid*

A registration currently includes useful information like the filing date, the date of first use or the date of the declaration of use, geographic limitations, disclaimers (especially if registered before October 2007) and any consents from other parties.

It should be clarified that all information in the Canadian registration, including any information about a use in Canada claim, or other filing grounds, information about registration under section 12(2) or section 14, and any disclaimer and consent, will continue to be shown on the Register following any replacement.

58. The international registration has the priority date of the registered trademark in respect of all the relevant goods and services covered by the registered trademark.

59. (a) the priority date, if any, of the registration and

(e) information relating to other rights acquired by virtue of the registration in Canada.

The Common Regulations state that if a holder of an IR 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”.

It should be clarified what is intended by the references to priority date and “information” in 58 and 59. 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.

The impact of an IR on geographically limited Canadian registrations is not clear. If a registrant owns a registration in Canada that is limited to certain areas, and that registrant subsequently obtains an IR, 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.

RECOMMENDATION:

25. The CBA Section recommends that that all relevant use claims, any limitations relating to disclaimers or sections 12(2) and 14 claims, geographic limitations and consents are maintained on the Register following any replacement.

Change in ownership of the International Registration

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

The Troicuk paper raises numerous issues relating to assignments. One point³ is that while the IB is required to notify Contracting Parties of any assignment, the Contracting Parties may declare the assignment has no effect in their country. Rule 27(4) of the Common Regulations confirms this. While the amendments to the *Trade-marks Act* have eliminated “associated marks”, presumably it would not be in the public interest to have confusing marks owned by different parties.

While proposed amendment 62 (marks may be held non-distinctive if a transfer results in confusing marks being held by two or more parties) addresses the possible validity of coexisting confusing marks, the impact of confusing marks owned by multiple parties is not merely the potential for non-distinctiveness of specific marks. It is the lack of usefulness of the Register as an indicator of rights, and also to predict the registrability of new applications.

RECOMMENDATION:

26. The CBA Section recommends that proposed regulation 63 confirm that the Registrar may reserve the right to declare that the change in ownership shall have no effect in Canada.

64. Requests to record a change in 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 the following conditions have been met:

a. the assignee cannot obtain the assignor’s signature on the request to record the change:

It should be clarified whether this means 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 (1)(b).

There seems to be no equivalent to 64(a) in Rule 25. We ask for clarification of what is intended.

Divisionals

It should be clarified whether the provisions on division of applications, for example, to deal with examination or opposition issues, apply to IRDCs.

³ at p. 72

V. PART 3 – PROPOSED AMENDMENTS TO OPPOSITION AND SECTION 45 SUMMARY CANCELLATION PROCEEDINGS

As a general observation, many changes in this section have nothing to do with the treaties, and are changes that have been discussed in earlier consultations. Earlier consultations, for example the opposition consultation, considered amendments to a regime considerably different from the new regime and are, at least in some instance, of limited use.

The discussion document notes that both oppositions and section 45 proceedings are “mechanisms that help maintain ...balance in the marketplace by providing reasonably swift and cost-effective administrative decisions.” Particularly with the latter, the Registrar has a chance to take control of the Register and address abuses that will most certainly arise from permitting registration without use, in crowding the Register with marks that are not in use, and marks covering goods and services not in use. In consultations, the government suggested that it would use section 45 summary non-use proceedings to address potential abuse.

RECOMMENDATION:

27. The CBA Section recommends that the Regulations specifically have the commencement of a section 45 proceeding by the Registrar occur on the third [or fifth] 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 or services. If a statement of use covers only some of the registered goods or services, the proceedings commenced by the Registrar shall apply only to the remaining goods or services. Proceeding in this fashion will not impact the ability of any other person to commence section 45 proceedings after the third anniversary of the registration for any goods or services.

Correspondence – Opposition and Summary Cancellation Proceedings

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 a copy to the other party of that correspondence.

By using “that is the subject of an opposition proceeding”, is the initial request for an extension of time to file a statement of opposition excluded? It should be clarified whether the obligation will apply to all correspondence.

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

It should be clarified that this does not include the initial correspondence to the Registrar requesting the initiation of a section 45 proceeding.

Service – Opposition and Summary Cancellation Proceedings

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.

As a general comment, 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. “In any other manner” presumably is meant to include electronic communication, and that should be specifically mentioned.

Having the “consent” of the other party may not be necessary if “notice” has been provided. Also, the use of facsimile machines has virtually ceased. 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.

RECOMMENDATIONS:

28. The CBA Section recommends that:

- a. “service by facsimile” should require the other party to notify, either immediately before or after transmission, that a facsimile communication has been sent;
- b. “in any other manner” should specifically include electronic communications;
- c. “consent”, in (d) should be replaced with “notice”.

29. The CBA Section recommends that the regulations should be amended to create a new provision setting out effective dates for the various methods of

service:

- 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

30. The CBA Section recommends that the effective date of service for electronically served documents also be included. It should be "on the date appearing on the transmission record as the date of communication".
31. The CBA Section recommends that the regulations should be amended to 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.
32. The CBA Section recommends that, if this section will be applied in the calculation of any date, the Registrar should notify the parties and give them an opportunity to comment on the "deemed" date. Notification in this manner will ensure that any special factors that could impact the actual receipt of communications are considered. Also, clarify what is intended by "a reasonable time after the deadline". Since the timing for any act is limited, this "reasonable time" should be interpreted to mean only "days" and not any longer.

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.

It should be clarified whether a fax is a "paper form".

Case Management – Opposition and Summary Cancellation Proceedings

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.

RECOMMENDATION:

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

Given the many deadlines in opposition and summary non-use proceedings, it is not clear why case management would be used, and what situations the Registrar would find appropriate for case management. 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 the deadlines. The idea that the Registrar might “narrow issues” in an opposition could be seen by the parties as removing from consideration valid grounds of opposition or defenses to the opposition grounds, to the detriment to the parties.

While the Registrar must “inform parties” of proposed directions and seek their comments, it is not clear what the impact of the comments would be. If, for example, both parties object to any changes in proceedings, issues or timetables, will the Registrar still proceed? It should be clarified why the proceedings would be necessary, when they might be used, and how deadlines might be applied. In addition, it should be confirmed that in no case would deadlines be shorter than those in the Regulations.

Opposition Proceedings

Evidence – Opposition Proceedings

The discussion document proposes that deadlines be calculated by setting specific terms for doing any act, and the next step starting from that term, vs. the act. Given how long current deadlines have been in place, it is not clear that changing calculation will add more certainty, clarity and transparency. Setting deadlines in this fashion will not result in opposition proceedings being handled any more quickly than is now the case.

Consideration should be given to reversing the order of evidence at least for evidence about an opposition ground that the applicant, at the time of filing the application, did not propose to use the trademark in Canada with the applied-for goods or services. Of course, an opponent cannot know what the applicant is contemplating or doing at the application date with its “proposal” to use. In consequence, consideration should be given to the evolving USTTAB case law on the applicant’s burden to show plans or other steps. Alternatively, Regulations could be amended to add at least a limited form of documentary discovery between the parties before evidence is filed by the opponent on this ground.

What is Missing

A better, more certain description of what is meant by “is deemed to be abandoned” or “deemed to be withdrawn” would be useful. It does not mean “is abandoned” or “is withdrawn.” Deemed abandonment is generally treated by the Opposition Board as meaning that the application or opposition is in default. The Board generally assumes that notice of deemed abandonment or withdrawal, if not responded to, will, in due course, result in abandonment of the application or withdrawal of the opposition. The parties are uncertain of when “formal” abandonment or withdrawal of the opposition will take place and the circumstances when it might not. Provisions clarifying the effect of any notice of “deemed” abandonment or withdrawal of an opposition, and what acts might overturn that decision (e.g. inadvertent missed deadlines) ought to be added to the regulations.

Cross-Examination

The proposals on timing of cross-examination, in 17 – 21, have been discussed in previous consultations, and many organizations have already responded. The main concern continues to be the fact that parties may not have an opportunity to file evidence in response to issues arising from cross-examination. Such evidence cannot be filed except with leave. Since the results of a request for leave are uncertain, and parties may risk such leave request being denied, there is a potential inequity in this procedure.

Cross-examination frequently leads to one or both parties wanting to address an issue in their own evidence. Since proposed *section 17* suggests that the actual deadline for completion of cross-examination is four 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 is completed. If leave to file additional evidence in response to cross-examination is granted, the other party may want an opportunity to cross-examine any witness on the “new” evidence. For timing and efficiency, this does not seem preferable to the current system.

RECOMMENDATION:

34. The CBA Section recommends that the parties may, following any cross-examination, seek leave to file additional evidence in response to issues arising in the cross-examinations, that leave will be granted unless there is a strong reason not to, and further that the parties will be provided with an opportunity to cross-examine the affiant or affiants on any additional evidence for which leave has been granted.

Written Representations

While the proposal to have arguments filed *seriatum*, vs. together is welcomed, the opponent should be given the right to file a “rebuttal” within a short time, restricted to the issues raised in the applicant’s written representations. This may reduce the circumstances in which an oral hearing is requested, which benefits all parties.

RECOMMENDATION:

- 35. The CBA Section recommends provision for filing “rebuttal” argument by the opponent, without requiring leave, restricted to issues raised in the applicant’s written submissions.**

Oral Hearings

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

RECOMMENDATIONS:

- 36. The CBA Section recommends for section 25 that any party may request an oral hearing at an earlier date (such as contemporaneously with the filing of written argument).**
- 37. The CBA Section recommends, for section 27, that cancellation of the hearing, if the party withdraws, 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.

Section 45 Summary cancellation Proceedings

RECOMMENDATIONS:

- 38. The CBA Section recommends that, since the Registrar has the right to initiate section 45 proceedings, and the potential for “abuse” in eliminating use as a registration requirement is obvious and long-lasting, the Registrar should use section 45 proceedings to actively police against abuse.**
- 39. The CBA Section recommends that the regulations be amended to provide that on the third anniversary of any registration, if a declaration of actual use in Canada has not yet been filed regarding any mark, or any registered goods or services, the Registrar shall send a notice, pursuant to section 45, to the registered owner of such mark or its recorded agent.**

Written Representations

RECOMMENDATION:

- 40. The CBA Section recommends, for sections 31-33, 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 permitted, under the same conditions as set out above in the Opposition section.**

Hearings – Summary Cancellation Cases

RECOMMENDATION:

- 41. The CBA Section recommends, for sections 26-27, as in Oppositions, that steps be taken to ensure that a party is not surprised and disadvantaged by the cancellation of a hearing.**

VI. CONCLUSION

Given the depth of experience and knowledge of the CBA Section (in particular, the members of the Section’s Trade-marks Committee) on matters impacting the state of trade-marks law in Canada, it comes as no surprise that the above-noted submission delves into highly detailed recommendations on the proposed regulations. With the limited time provided to consider the amendments and prepare the submission, the CBA Section has aimed to provide its comments with a view to ultimately “getting the law right” through these Regulations.

The CBA Section welcomes this consultation and hopes to engage CIPO in an ongoing dialogue on ways to improve the IP system in trade-marks law and practice. If there are any questions or comments or if CIPO requires additional input regarding the comments made by the CBA Section in this submission, we request a meeting to facilitate further discussion.

VII. SUMMARY OF RECOMMENDATIONS

- 1. The CBA recommends amendments to subsections 3(7) and 3(8) of the Regulations should provide that the date on which the Office receives the communication shall constitute the date of receipt of the communication, if it was received on a date that the Office was open for business.**
- 2. The CBA Section recommends that the requirement to identify the trademark in correspondence with the Office be maintained. Omitting the trademark will add inconvenience and time to connecting correspondence with the right file.**
- 3. The CBA Section recommends that the notice in writing regarding the appointment of a trademark agent may be in any correspondence relating to an application, registration, opposition section 45 proceeding or any other**

- business before the Office, and that it be clarified that a separate letter to the Registrar is not required.**
- 4. The CBA Section recommends that any entity, other than the registrant or its appointed agent wishing to renew a registration provide CIPO with their name, full contact information and an address for service in Canada.**
 - 5. Given the importance of service rules in Canada, the CBA Section recommends that the word “may” be replaced with “shall” in s. 25. Attempting to contact and serve documents on persons outside Canada can be time-consuming and expensive and the results are uncertain. Requiring a Canadian contact address, ideally that of a Canadian agent who can be easily identified and contacted, is preferred.**
 - 6. The CBA Section recommends that the test not be that an address be “kept up to date”, but instead that the mail properly served is returned, and the Registrar has made some attempt to contact the party by using other mail resources.**
 - 7. It should be clarified that this does not apply to local addresses, to the extent that the addresses refer to locally used street or other geographic names, nor to any part of the applicant’s name. Neither the applicant’s name nor its address should have to be in English or French.**
 - 8. The CBA Section recommends that this section should be amended to add: “5. 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 Regulation, elects to provide.”**
 - 9. The CBA Section recommends that the requirement for a statement of withdrawal of opposition from an opponent be removed as a precondition for acceptance of a divisional application.**
 - 10. The CBA Section recommends renewal of a registration up to a year in advance, and that a six-month grace period be provided.**
 - 11. The CBA Section recommends that the TMO send the notice of non-renewal as soon as possible, given the shorter term from the date of the notice.**
 - 12. The CBA Section recommends that, in subsection 71(b), the Register should also include the name and address of the registrant, and its trademark agent.**
 - 13. The CBA Section recommends that, since information on use or evidence of use is permitted under the Singapore Treaty, this provision be amended to add “(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”.**
 - 14. The CBA Section recommends that Canada maintain a declaration of intent to use requirement for all applicants using the Madrid Protocol to acquire rights in Canada, given the historic importance of use as a basis for trademark rights**

- in Canada, and to ensure that all applicants for IRDCs are aware, on making the request to extend rights to Canada.**
- 15. The CBA Section recommends that the certification fee be in line with amounts collected in other jurisdictions.**
 - 16. The CBA Section recommends that, while electronic filing is likely more convenient for both applicants and the Registrar, paper filing should also be permitted.**
 - 17. The CBA Section recommends that the Registrar confirm that regular applicants, who have the same need for speedy service, should not suffer delays as a result of redirected resources to process IAs and IRDCs, particularly since IRDCs may be a small percentage of the overall filings in Canada.**
 - 18. The CBA Section recommends that the Regulations be amended to include “the name and address of the applicant’s representative, if any”, since the Rules also provide for communication to the representative, and the communication has the same effect as one addressed to the applicant or holder of an IA or IR.**
 - 19. The Registrar should 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 pay those fees directly to the IB. Since the Registrar is also submitting the IA, it would be easier for applicants to request the Registrar to submit the fee with the IA. At least until all involved parties (the TMO, applicants and their agents) become familiar with the procedure, the Registrar should assist both with the calculation of fees and the payment of fees. The Registrar should assist with both the calculation of fees and payment of fees to the IB.**
 - 20. The CBA Section recommends that any reference to “applicant” in the above provision be amended to refer to its representative, if any.**
 - 21. The CBA Section recommends that the applicant be fully informed of the implications of the amendments to classification or specification on goods or services so it may ensure that appropriate fees are paid in a timely manner.**
 - 22. The CBA Section recommends that, while it is generally assumed that the “request for extension of protection” will only apply to a request for extension of protection to Canada, this should be clarified.**
 - 23. The CBA Section recommends that, as soon as an opposition is filed, the Registrar must transmit the notification of the opposition to the applicant or its designated representative. At that time, 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.**
 - 24. The CBA Section recommends more certainty as to the impact on Canadian IR holders of Articles 6 and 9 quinquies of the Madrid Protocol.**

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25. The CBA Section recommends that that all relevant use claims, any limitations relating to disclaimers or sections 12(2) and 14 claims, geographic limitations and consents are maintained on the Register following any replacement.
26. The CBA Section recommends that proposed regulation 63 confirm that the Registrar may reserve the right to declare that the change in ownership shall have no effect in Canada.
27. The CBA Section recommends that the Regulations specifically have the commencement of a section 45 proceeding by the Registrar occur on the third [or fifth] 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 or services. If a statement of use covers only some of the registered goods or services, the proceedings commenced by the Registrar shall apply only to the remaining goods or services. Proceeding in this fashion will not impact the ability of any other person to commence section 45 proceedings after the third anniversary of the registration for any goods or services.
28. The CBA Section recommends that:
- a. "service by facsimile" should require the other party to notify, either immediately before or after transmission, that a facsimile communication has been sent;
 - b. "in any other manner" should specifically include electronic communications;
 - c. "consent", in (d) should be replaced with "notice".
29. The CBA Section recommends that the regulations should be amended to create a new provision setting out effective dates for the various methods of service:
- 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
30. The CBA Section recommends that the effective date of service for electronically served documents also be included. It should be "on the date appearing on the transmission record as the date of communication".
31. The CBA Section recommends that the regulations should be amended to 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.
32. The CBA Section recommends that, if this section will be applied in the calculation of any date, the Registrar should notify the parties and give them an opportunity to comment on the "deemed" date. Notification in this manner will ensure that any special factors that could impact the actual receipt of communications are considered. Also, clarify what is intended by "a reasonable

- time after the deadline”. Since the timing for any act is limited, this “reasonable time” should be interpreted to mean only “days” and not any longer.**
- 33. The Registrar must inform the parties of the proposed directions in writing and seek their comments before issuing the ruling. In making the ruling, the Registrar must consider all surrounding circumstances of the case and must balance the procedural interest of the parties and the public interest.**
 - 34. The CBA Section recommends that the parties may, following any cross-examination, seek leave to file additional evidence in response to issues arising in the cross-examinations, that leave will be granted unless there is a strong reason not to, and further that the parties will be provided with an opportunity to cross-examine the affiant or affiants on any additional evidence for which leave has been granted.**
 - 35. The CBA Section recommends provision for filing “rebuttal” argument by the opponent, without requiring leave, restricted to issues raised in the applicant’s written submissions.**
 - 36. The CBA Section recommends for section 25 that any party may request an oral hearing at an earlier date (such as contemporaneously with the filing of written argument).**
 - 37. The CBA Section recommends, for section 27, that cancellation of the hearing, if the party withdraws, not be automatic unless this impact has first been clearly noted in earlier correspondence from the Opposition Board.**
 - 38. The CBA Section recommends that, since the Registrar has the right to initiate section 45 proceedings, and the potential for “abuse” in eliminating use as a registration requirement is obvious and long-lasting, the Registrar should use section 45 proceedings to actively police against abuse.**
 - 39. The CBA Section recommends that the regulations be amended to provide that on the third anniversary of any registration, if a declaration of actual use in Canada has not yet been filed regarding any mark, or any registered goods or services, the Registrar shall send a notice, pursuant to section 45, to the registered owner of such mark or its recorded agent.**
 - 40. The CBA Section recommends, for sections 31-33, 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 permitted, under the same conditions as set out above in the Opposition section.**
 - 41. The CBA Section recommends, for sections 26-27, as in Oppositions, that steps be taken to ensure that a party is not surprised and disadvantaged by the cancellation of a hearing.**