

Bereskin & Parr LLP

From filing to registration: proposed changes to practice

It could still be quite some time before proposed amendments are implemented. Efforts continue to streamline the Canadian trademark system and bring it into line with international practice

In Canada, trademark registrations may be obtained for words, logos, colour (as a feature of the trademark), certain three-dimensional trademarks, distinguishing guises (shapes or packaging) and certification marks. In addition, registration can now be obtained for sounds. Unique to Canada are official marks – marks adopted and used by public authorities which entitle the rights holder to a wide scope of protection, covering all goods and services.

While the Trademarks Act (RSC 1985, c T-13) does not specifically exclude non-traditional marks, the Canadian Intellectual Property Office (CIPO) and the courts have traditionally taken the position that these marks are not registrable. In perhaps the biggest development of 2012, CIPO began accepting applications for trademarks consisting of sound (CIPO, “Trademark consisting of a sound” (Quebec: Trademarks Branch, March 28 2012)). This major shift in practice followed an order of the Federal Court reversing the registrar’s refusal of an application by Metro-Goldwyn-Mayer Lion Corp to register its ‘roaring lion’ sound mark (*Metro-Goldwyn-Mayer Lion Corp v Attorney General of Canada* (March 1 2012), Ottawa T-1650-10 (FC)).

Since the practice notice was issued, 20 sound applications have been filed, including the famous TARZAN YELL, filed by Edgar Rice Burroughs, Inc for slot machines, action figures, online retail store services and publication of electronic fan magazines; the INTEL CORPORATION SOUND TRADEMARK, filed by Intel Corporation for computer-related wares; the MAC START-UP CHIME, filed by Apple Inc for computer-related wares; and SWEET GEORGIA BROWN, filed by Harlem Globetrotters International, Inc for performing basketball games and exhibitions.

Filing bases and technical requirements

Applications for registration may include multiple filing bases, including use in Canada, proposed use in Canada and use and registration abroad. It is preferable to include multiple filing bases. In the event that one filing basis is successfully challenged during opposition, the application may still be able to proceed on the other filing bases.

A claim to use and registration/eventual registration abroad can be made by a foreign applicant with a home-country registration or application in association with those goods or services used somewhere in the world. While case law is clear that use must have commenced before the addition of such a claim (eg, see *Effigi Inc v Major League Lacrosse LLC* 2012 TMOB 134), there is no clear pronouncement on whether such use must have commenced prior to the filing date of the Canadian application. CIPO currently permits such a claim to be added any time before advertisement of the Canadian application (regardless of whether use commenced before or after the filing date of the Canadian application).

If an application is based on use and registration abroad, the applicant must file a certified copy of the corresponding home-country registration before the Canadian application will be advertised. In the past, it was possible to obtain indefinite extensions where the foreign registration had not yet been issued. There has been a change in practice in this regard: CIPO has begun to deny extension requests on this basis at a certain point (approximately three years after filing). However, no practice notice has been issued to clarify how many extensions an applicant can obtain on this basis.

In terms of sound marks, the practice notice specifies that an application must:

- state that it is for the registration of a

sound mark;

- contain a drawing that graphically represents the sound;
- contain a description of the sound; and
- contain an electronic recording of the sound (CIPO, “Trademark consisting of a sound”, (Quebec: Trademarks Branch, March 28 2012)).

Applications for certification marks and distinguishing guises must be filed based on use in Canada. With respect to distinguishing guises, the applicant must file evidence showing that the mark has become distinctive in Canada as of the application filing date.

A request to give public notice of an official mark pursuant to Section 9(1)(n)(iii) of the Trademarks Act must be filed by a public authority. Although in the past, non-Canadian entities were able to obtain official marks based on foreign government control, Canadian courts have since interpreted ‘public authority’ to mean an entity subject to a significant degree of ongoing governmental control by a Canadian government, whose activities benefit the public (*Ontario Association of Architects v Association of Architectural Technologists of Ontario* (2002), 19 CPR (4th) 417 (FCA); *Canada Post Corporation v United States Postal Service* (2007), 54 CPR (4th) 121 (FCA); and *Maple Leaf Foods Inc v Consorzio del Prosciutto di Parma* 2012 FC 416).

Unlike most countries, Canada does not use a classification system for goods and services. CIPO informally classifies goods and services for indexing and search purposes only. Applications may cover any number of goods and services, with one comprehensive filing fee. Applications may be filed electronically and there is no requirement for the applicant to sign the application or file a power of attorney.

Examination and registration

All applications are examined on relative and substantive grounds. With respect to relative grounds, the most common objection is the requirement to define the goods and services “in ordinary commercial terms”. CIPO introduced a new Wares and Services Manual in 2009, which is subject to constant update and change. Many additions and changes have been made to it in 2012. Most notably, CIPO has relaxed its stance on ‘indefinite terms’, including ‘in the nature of’, ‘such as’, ‘comprising’, ‘containing’, ‘in particular’, ‘particularly’ and ‘featuring’. These terms are now acceptable in certain instances. Despite these changes, applicants continue to experience inconsistent goods and services objections.

Substantive objections include confusion with prior applications or registrations and inherent registrability issues, such as descriptiveness or name/surname objections.

In terms of overcoming descriptiveness and name/surname objections, foreign applicants have an advantage over Canadian applicants. A foreign applicant can rely on Section 14 of the act to overcome such an objection if:

- it has a corresponding home-country registration and use of the mark elsewhere; and
- it can show by way of affidavit evidence that the mark is “not without distinctive character” in Canada (through extensive use/advertising, including in Canada or through spillover advertising from the United States or elsewhere).

On the other hand, Canadian applicants must demonstrate, again through affidavit evidence, that the mark has “become distinctive” across Canada as of the filing date of the Canadian trademark application. If not, the registration will be limited to those provinces and territories where the mark has become distinctive.

Once all relative and substantive objections have been addressed, the application is advertised for opposition purposes. The opposition period is open for two months. If no opposition is filed or if an opposition is successfully overcome, the application will proceed to allowance. Payment of a registration fee – and in the case of proposed-use marks, filing of a declaration of use – is required before the application will proceed to registration.

Reforming the trademarks regime

CIPO had a flurry of activity in 2009 and 2010, launching consultations and releasing practice notices geared towards



Terry Edwards
Partner
tedwards@bereskinparr.com

Terry Edwards is a partner and registered trademark agent with Bereskin & Parr LLP. She practises exclusively in the trademark field, with an emphasis on clearance, prosecution and protection, including oppositions and non-use proceedings.



Meghan Dillon
Associate
mdillon@bereskinparr.com

Meghan Dillon is an associate, barrister, solicitor and registered trademark agent with Bereskin & Parr LLP. Her practice focuses on trademark prosecution, oppositions and related litigation.

streamlining the Canadian trademark system and bringing it into line with international practice. The last two years have been quieter, but CIPO remains committed to reforming the trademarks regime, and held a consultation in early 2012 focused on amendments to the Trademarks Regulations (CIPO, “Proposed

Amendments to the Trademarks Regulations – Update on Progress” (Quebec: Trademarks Branch, February 23 2012)).

The proposed amendments include, most notably, the following:

- Non-traditional marks – in addition to sound marks, colour (as a feature of the trademark) and certain three-dimensional trademarks (other than distinguishing guises), which in practice are already accepted by CIPO, the proposed amendments would allow for the registration of holograms and motion marks, which are not currently registrable.
- Amendments to applications – the proposed changes to the regulations would allow for the following amendments:
 - pre-advertisement amendment to an earlier date of first use, without filing evidence that the change is justified;
 - pre-advertisement amendment of a proposed use application to rely on use or making known, prior to the application filing date; and
 - post-advertisement amendment of a proposed use application to rely on use or making known, provided that such use does not pre-date the application filing date.
- Recordal of assignments – the proposed amendments to the regulations would allow for the recordal of assignments on request, as opposed to the current practice of requiring the filing of an assignment or other transfer documents.
- Opposition practice – the proposed amendments would no longer allow a party to delay the filing of evidence until after the completion of cross-examination of the other party’s witnesses, requiring instead that both parties complete cross-examinations within four months of the opponent filing its reply evidence. The amendments would also provide for the sequential filing of the opponent’s written argument, followed by the applicant’s, as opposed to the current practice of both parties filing their written submissions simultaneously.

It could still be some time before these proposed amendments are implemented. Adherence to the Madrid Protocol remains a possibility and is likely the impetus for many of the changes which have taken place in practice over the last few years. However, at this point, no specific commitment or timetable has been put forth. [WTR](#)