

Is Change Coming to Canada's Official Marks Regime? Possibly

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Official marks, described by some as an arcane, unusual, noteworthy or curious feature of Canadian trademark law, may be up for change.

Official marks, provided for under Section 9(1)(n)(iii) of the *Canadian Trade-marks Act*, are badges, crests, emblems or marks adopted and used by a Canadian public authority as an official mark for wares or services, and in respect of which the Registrar of Trade-marks has given public notice of its adoption and use. Official marks have been subject to some criticism, as Section 9(1)(n)(ii) does not define who constitutes a public authority; provide for any examination of official marks; create any objection or opposition regime; and provide for any duration (and renewal) for an official mark.

In March 2013, Parliament's Standing Committee on Industry, Science and Technology issued a report on the "Intellectual Property Regime in Canada". The report included a recommendation for change to Canada's official mark regime:

"The Committee recommends that the Government of Canada introduce legislation which amends parts of the *Trade-marks Act* dealing with official marks to restrict the scope of official marks to important national government symbols and to narrow the definition of public authorities to avoid stifling innovation and distorting markets"

The proposed changes in Bill C-611, An Act to Amend the Trade-marks Act (*public authority*), include a definition of who constitutes a public authority, an objection/opposition procedure to the public notice of official marks, and the provision for renewals of public notice for official marks every ten years.

On June 9, 2014, a private member's bill¹ was put before Canada's Parliament, seeking to amend the *Trade-marks Act* to address official marks. In the Spring of 2013, the Canadian Government introduced Bill C-56, the *Combating Counterfeit Products Act* (reintroduced as Bill C-8 in the Fall of 2013), and earlier this year, the Government introduced Bill C-31, the *Economic Action Plan 2014 Act*, No. 1 (which contained significant amendments to the *Trade-marks Act*, including amendments relating to the Madrid Protocol, Singapore Treaty and Nice Agreement). Neither Bill contained amendments relating to official marks.

The proposed grounds of objection/opposition would be:

- (a) the mark has not been adopted or used in Canada by the public authority;
- (b) the body that requested the Registrar to give public notice is not a public authority;
- (c) the mark is identical to, or so nearly resembling as to be likely to be mistaken for, a registered trademark whose date of registration predates the first granting of public notice in respect of the mark that is the subject of the statement of objection and may significantly undermine the ability of that trademark owner to fully exploit their registered trademark, or may result in confusion;
- (d) the mark is a generic term, such that its protection as an official mark may unduly restrict the ability of traders to accurately describe their wares or services; or
- (e) the granting of the official mark does not serve the public interest.

Of particular note, is that the Bill's transition provisions include that all existing official marks would be subject to objection/opposition within three months of proclamation into force of the Bill, which could mean that the Canadian Trade-marks Office would see a sharp increase in opposition proceedings, should this Bill pass.

Private member's bills rarely pass in Canada, but on occasion, the contents of such bills find their way into government bills at a later date. Given the recommendation in the Standing Committee's report, it may be that at least part of Bill C-611 will find its way into Canadian trademark law in the future.

To learn more about Bill C-611, click [here](#).

¹ A private member's bill is a bill put forward by a parliamentarian who is not a member of the governing party