

Canadian Government Releases Consultation on Trademarks Act Regulations

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On October 1st, the Canadian Intellectual Property Office (“CIPO”) published a Discussion Document entitled *Proposed Amendments to the Trade-marks Regulations 2014*, designed to accompany amendments to the Trade-marks Act (“TMA”) passed earlier this year but not yet proclaimed in force. The amendments to the TMA and the accompanying Regulations are designed to both implement international treaties relating to trademarks, and modernize and harmonize Canadian trademark law and practice with that of other global partners. The consultation will be open until November 30, 2014.

Notable in its absence from the Discussion Document is any discussion of proposed fees that may apply once Nice Classification requirements become mandatory, or relating to Madrid Protocol filings. The accompanying notes to the Discussion Document indicate that decisions regarding the “nature and timing of these fee changes, if any, will be made at a later date and would be the subject of a separate consultation exercise”.



The key amendments to the Regulations that are most likely to impact owners of trademarks in Canada and abroad are the following:

- Implementation of the Madrid Protocol
 - Regulations to permit Canadian-originating applications for international registration, and Canadian-designated applications for international registration pursuant to the Madrid Protocol, and also dealing with oppositions to Madrid Protocol-based applications.
- Other Treaty Requirements
 - Simplification of application requirements to comply with the Singapore Treaty and suggested use of goods and services descriptions to meet both Canadian requirements for specificity, and Nice Agreement classification.
- Opposition and s.45 Non-use Proceedings
 - Case Management – permitting the Opposition Board (“Board”) to identify certain opposition files for special attention to reduce costs and delays. The Discussion Document does not identify the specific situations where case management might be proposed, but does suggest that the Board would be permitted to set timelines relating to the delivery and exchange of evidence, canvass issues, narrow issues and ensure the proceedings move along more efficiently. The suggestion of “canvassing and narrowing issues” sounds somewhat like mediation, which could be welcome in many opposition cases. However, the Discussion Document does not address which cases might be ones suitable for case management, confirm if parties themselves may request case management, or give any idea of how the proceedings might change if the Board was to decide to implement case management, apart from potentially stricter timelines;
 - new regulations (as opposed to case law guidelines) on the factors and evidence required by the Board to determine whether to grant leave to amend an opposition pleading or file additional evidence; and
 - amendments to rules on timing of evidence, cross-examination and written submissions, as well as the conduct of hearings. For example, it is proposed that cross-examination take place simultaneously with evidence preparation, and written submissions from the applicant will be filed after those of the opponent, which will allow the applicant to specifically respond to the opponent’s arguments. Hearings will no longer be held if only one party participates.
- Third Party Intervention in Examination

Permit third party correspondence pertaining to pending applications still in examination. Currently, the TMO refuses to accept correspondence about a pending application from anyone except the applicant or its agent. Third correspondence is proposed to be allowed to “provide examiners with information that could potentially help in their assessment of an application.” For brand owners wanting to make sure that the examiner carefully assesses potential confusion with a pending application, such an opportunity will be welcome.

- Correspondence

- All documents, including affidavits in oppositions and s. 45 non-use proceedings, may be filed electronically, and all renewal applications must be filed electronically.

- Filing Details for Non-traditional Trademarks

- Guidelines for filing drawings and other details of non-traditional trademarks, including colours, sound, holograms, moving images and position marks. While the TMA amendments will permit registration of new signs such as taste, smell and texture, the Discussion Document does not include any guidelines about those marks.

- Division of Applications and Merger of Registration

- Procedure to implement the TMA amendments introducing the concept of divisional applications to Canadian trademark practice. These will impact applicants seeking to use division of an application to overcome objections during prosecution, or resolve certain opposition issues.

- Clarification of When Amendments will be Permitted

- The Discussion Document proposes some softening of the restrictions on amending an application, to permit changing the applicant name to correct of an error, and the trademark itself if the mark remains “substantially the same”, both before and after advertisement.

The full text of the Discussion Document is available at the [CIPO website](#).

More detailed commentary on the proposed changes will be available shortly. Should you have any questions, please contact us.



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