

SMART & BIGGAR

The Canadian Difference.

Exploring the unique issues of
designating Canada in Madrid Protocol
trademark applications

Speakers: Philip Lapin, Jamie-Lynn Kraft

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1

2

Our Speakers



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Barrister & Solicitor
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Senior Associate,
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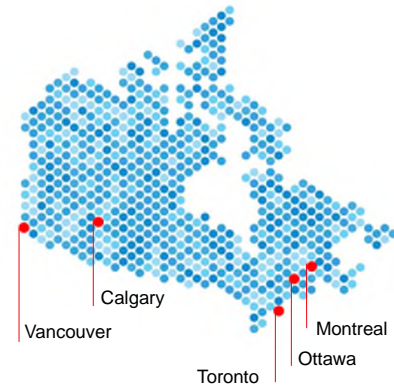
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2

Who we are

Canada's **leading IP law firm** with expertise at the interface of **technology** and **business law**

- Expertise in all areas of IP
- 130+ years serving clients
- 100+ lawyers, agents and technical consultants
- 8,000+ patents & trademarks filed annually
- Litigation bench strength and record of success



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3

4

Designating Canada in Madrid applications

1. Correspondence issues
2. Confusing provisional refusals
3. Inherent distinctiveness
4. Specificity of goods and services
5. Final refusals
6. Divisional applications
7. Examination delays



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4

5

Correspondence issues

- CIPO will not correspond with foreign representative of International Registration

COURTESY LETTER

This is a courtesy letter, no response is required.

The designation notification we have received regarding this application identifies you as the applicant's representative before the International Bureau of the World Intellectual Property Organization (WIPO).

Pursuant to the Canadian *Trademarks Regulations*, persons wishing to represent others before the Office of the Registrar of Trademarks of the Canadian Intellectual Property Office must reside in Canada and be on the Canadian list of registered trademark agents.

Please note that courtesy copies of the notifications sent to WIPO as required by the Madrid Protocol as well as any other future correspondence from our Office will be sent directly to the applicant or the appointed Canadian trademark agent.

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5

6

Correspondence issues

Correspondence	Foreign Agent	Applicant or CDN Agent	WIPO
Courtesy Letter upon designation	✓		
Approval Notice		✓	
Total Provisional Refusal (i.e. First Examiner's Report)		✓	✓
Maintaining objection raised in TPR (i.e. further Examiner's Report, no new objections)		✓	
Notice of Default		✓	
Refusal (with appeal deadline)		✓	
Confirmation of Total Provisional Refusal (i.e. Notice of Abandonment, or refusal after expiry of appeal period)			✓

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6

Confusing provisional refusals

- Provisional Refusals from CIPO are very confusing
- They are also very long
- What is the Examiner objecting to?
- Only 2 minor objections

MADRID PROTOCOL
Total Provisional Refusal of Protection
(Rule 17(1) of the Regulations under the Protocol)

I. Office making the notification:
 Canadian Intellectual Property Office

II. Number of the international registration:
 [REDACTED]

III. Name of the holder:
 [REDACTED]

IV. Information concerning the type of provisional refusal:
 Total provisional refusal based on an ex officio examination

V. Information concerning the scope of the provisional refusal:
 Total provisional refusal affects all the goods and/or services.

VI. Grounds for refusal (where applicable, see item VIII):
 This examiner's report concerns the above identified Protocol application. To avoid abandonment proceedings, a proper response must be received by this office by August 10, 2021. All correspondence respecting this Protocol application must indicate the file number.
 This Protocol application has been examined under the provisions of the Trademarks Act and Trademarks Regulations.
 In compliance with paragraph 31(d) of the Trademarks Regulations, the applicant is required to provide a translation (if any) into English or French of all words in any other language that are contained in the trademark.
 Upon receipt of the aforementioned translation, the Registrar may refuse the Protocol application in view of all provisions under section 37 of the Trademarks Act, including for the following grounds:

- paragraph 12(1)(c) and 37(1)(b) of the Trademarks Act, if the trademark is considered to be the name of the goods or services in any language;
- paragraph 12(1)(d) and 37(1)(b) of the Trademarks Act, if the trademark is found to be confusing with a registered trademark;
- paragraph 37(1)(c) of the Trademarks Act, if the applicant is not the person entitled to registration of the trademark because it is confusing with another trademark for the registration of which an application is pending; and
- paragraph 37(1)(d) of the Trademarks Act, if the trademark is not distinctive.

Any comments you may wish to submit will receive consideration.

Pursuant to paragraph 30(2)(a) of the Trademarks Act, an application for the registration of a trademark must contain a statement in ordinary commercial terms of the associated goods or services. Furthermore, section 29 of the Trademarks Regulations requires that the statement must describe each of those goods or services in a manner that identifies a specific good or service. It is considered that the following goods or services are not in specific and ordinary commercial terms:

1. advisory services relating to asphaltting (Class 37)
2. Recycling (Class 40)

By way of example only the following would be acceptable:

1. advisory services in the field of asphaltting (Class 37)
2. Recycling of waste (Class 40)

If these examples are not an accurate description of the applicant's goods or services, they can be used as a guide to the specificity and ordinary commercial term requirements.

For further guidance on redefining the statements of goods or services, please refer to the Goods and Services Manual available on our website. This searchable tool is not an exhaustive list of acceptable terms, but it may be used as a guide to the specificity and ordinary commercial term requirements of the Trademarks Act and its Regulations.

The applicant is required to file an amended Protocol application, using the e-service on the CIPO website at www.cipo.ic.gc.ca, by fax at 819-953-2476 or by mail at the following address:

Registrar of Trademarks
 Place du Portage I
 50 Victoria Street, room C-114
 Gatineau, QC K1A 0G9

If the applicant has any specific questions in respect of this Office action, please contact the assigned examiner. Please note that for general inquiries, including assistance with filing of the revised Protocol application, queries about the status of an application or receipt of correspondence, you may contact our Client Service Centre toll free at 1-866-997-1936.

Yours truly,

Dana Lee
 Examination Section
 819-839-0073
 fax: 819-953-2476

VII. Information relating to an earlier mark:

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Confusing provisional refusals

(i) Filing date and number, and, if any, priority date:
 Not applicable

(ii) Registration date and number (if available):
 Not applicable

(iii) Name and address of the owner:
 Not applicable

(iv) Reproduction of the mark:
 Not applicable

(v) List of the relevant goods and/or services (this list may be in the language of the earlier application or registration):
 Not applicable

VIII. Corresponding essential provisions of the applicable law:
 Paragraph 12(1)(c) of the Trademarks Act
 Paragraph 30(2)(a) of the Trademarks Act
 Paragraph 37(1)(b) of the Trademarks Act
 Paragraph 37(1)(c) of the Trademarks Act
 Paragraph 37(1)(d) of the Trademarks Act
 Section 29 of the Trademarks Regulations
 Paragraph 31(d) of the Trademarks Regulations

IX. Information relating to the possibility to request a review or file an appeal:

(i) Time limit for requesting review or appeal:
 2021-08-10

(ii) Authority to which such request for review or appeal should be made:
 Registrar of Trademarks

(iii) Whether the request for review or appeal has to be filed in a specific language and/or through the intermediary of a representative whose address is within the territory of the Contracting Party:
 Correspondence must be in French or English

(iv) Other requirements, if any:
 Not applicable

X. Signature or official seal of the Office making the notification:
 Registrar of Trademarks

XI. Date of notification to the International Bureau:
 2021-02-10



• 4 pages to raise 2 minor issues!

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9

Inherent distinctiveness

New type of objection: **mark is not inherently distinctive**

- Well-known places (**London**)
- Designs that look like the goods/services (**an ordinary drawing of a dog for dog food**)
- Names of colours common for the goods (**WHITE for paper**)
- One or two letter or number marks (**X or 5**)
- Laudatory terms/phrases (**WONDERFUL, WORLD'S BEST**)



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9

10

Inherent distinctiveness

Other examples of **mark not inherently distinctive**:

- mark is primarily merely a surname
- mark is clearly descriptive
- mark is non-traditional ...
 - shape of goods/packaging, sound, colour *per se*, taste, scent, texture



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10

Inherent distinctiveness

Two (and a half) ways to overcome **not inherently distinctive objection**:

- i. argue that mark has some inherent distinctiveness
- ii. file affidavit evidence of significant reputation (**distinctiveness / secondary meaning**) as of Canadian filing date
 - must establish that a significant portion of Canadian target market would have been exposed to mark as of Canadian filing date
 - If evidence of distinctiveness only in a part of Canada, then registration will be limited to that part

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11

Specificity of goods and services

- Goods & services must be described:
 - in “**ordinary commercial terms**”
 - in “a manner that identifies a **specific** good or service”
- CIPO’s requirements are some of the strictest in the world



Tip: File broadly; narrow only if required by CIPO

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12

Final Refusal

Previously >>

- Refusals in examination almost non-existent

Now >>

- CIPO will start issuing final refusals
 - Where second or subsequent response does not raise new arguments
- Right of appeal to Federal Court within 2 months

Tip: Put “best foot forward” to reduce risk of final refusal

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Divisional applications

- Applications can be divided
 - Useful where:
 - Objection raised during prosecution only relates to subset of goods/services
 - Opposition only relates to subset of goods/services



Tip: Consider filing divisional application to mitigate risk of final refusal

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Examination delays

- Time between filing and examination significantly increased
 - Direct >> **30 months!**
 - Madrid >> 18 months

CIPO is working on reducing delays:

- Hiring more staff
- No more suggestions on acceptable goods/services in first report
- Fast-track for applications with pre-approved goods/services
- Final refusals
- Expedited examination

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15

Examination delays

Expedited examination now available:

- Court action underway in Canada
- Combatting counterfeit products at Canadian border
- Registration required to protect IP from being "severely disadvantaged" on online marketplaces
- Registration required to preserve priority claim following request from foreign IPO
- Application for COVID-related products/services

- If request is accepted
 - Office will examine application "as soon as possible"
 - Advantage could be lost if applicant requests EOT or misses deadlines

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16

Top tips when designating Canada

01

Designate early

02Appoint
Canadian agent**03**Be prepared to
establish
inherent or
acquired
distinctiveness**04**File
comprehensive
arguments in
response to
objections**05**Consider
whether eligible
for expedited
examination**SMART & BIGGAR**

17



Questions?

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18