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Canadian and U.S. Trademark Prosecution.

Northern (high)lights and key differences
that brand owners and counsel should
know

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Our Speakers



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- **Rising Star in Trademarks**
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- **Lexpert-Ranked – Intellectual Property**
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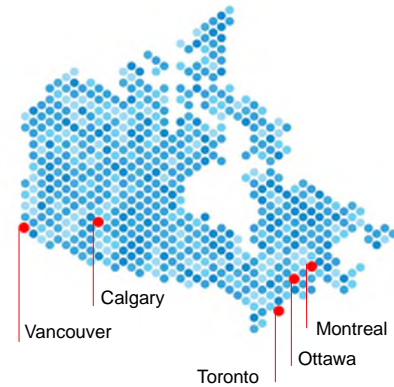
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Who We Are

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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Overview

Canadian and U.S. Trademark Prosecution – Key Differences

Filing Applications

Prosecuting Applications

International Compliance

TMOB/TTAB Proceedings

Registrations

Miscellaneous

Key Takeaways

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Filing Applications

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Filing Applications - Key Differences

No filing basis

- Since **June 17, 2019**, a filing basis is no longer required in Canada, bringing Canadian filing requirements closer to those of many other countries but further from those of the U.S.

No use necessary for registration

- All applications can proceed to registration once the opposition period has expired, without the need to assert use or file a Declaration of Use.
- However, use remains an important element of Canadian trademark law, including when assessing priority of rights, in opposition and cancellation proceedings, and in enforcement.

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Prosecuting Applications

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Prosecuting Applications - Key Differences

No Supplemental Register

- Canada has only a single Register, the equivalent of the U.S. Principal Register. An inherently non-distinctive mark cannot be registered until it has acquired a certain level of distinctiveness (or “secondary meaning”) through extensive use in Canada.

No “state” (provincial) registrations

- Canada has no equivalent of state trademark registrations in the U.S., with only a single, federal Register. However, some registrations may be limited to a specific geographic region of Canada – for example, registrations for inherently non-distinctive marks claiming evidence of secondary meaning.

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Prosecuting Applications - Key Differences

Less effective consent agreements

- If the Canadian Trademarks Office concludes there is a risk of confusion among consumers, despite an agreement between the parties, it will maintain the objection to fulfill its role of public protection.

No required disclaimers

- The Canadian Trademarks Office routinely required applicants to disclaim the right to exclusive use of any portion of a trademark that was not independently registrable (due to descriptiveness, for example). In 2007, the Canadian Trademarks Office disposed of disclaimer requirements. While an applicant may voluntarily enter a disclaimer, such voluntary disclaimers are fairly uncommon.

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Prosecuting Applications - Key Differences

Not inherently distinctive objections

- The Canadian Trademarks Office may now object to trademarks that are “not inherently distinctive”. Objections may be overcome with either written arguments or evidence of acquired distinctiveness as of the filing date.

Amendments by telephone

- Examining Attorneys at the USPTO encourage informal communications to speed up prosecution, often accepting substantive amendments to the record, and withdrawing objections, over the phone. In Canada, Examiners will accept only minor amendments, such as correcting Nice Classifications or typographical errors, over the phone.

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Prosecuting Applications - Key Differences

Slowness of the Canadian TMO

- The current delay from filing to examination is almost three years. Similarly, in contentious proceedings before the Trademarks Opposition Board (i.e., Canada's equivalent to the U.S. TTAB), it can take anywhere from 18 to 24 months to schedule an oral hearing.

Timing in response to Office Actions

- In Canada, an applicant may request a six-month extension of time once within the lifecycle of its application to respond to an "Examiner's Report" if it raises one or more substantive objections. Additional six-month extensions of time are available only in exceptional circumstances.

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International Compliance

Madrid Protocol Applications & Nice Classification

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International Compliance - Key Differences

Limited Madrid correspondence

- The Canadian Trademarks Office will not deposit all correspondence with WIPO, nor will it send correspondence to a foreign representative. Rather, the Trademarks Office will only send correspondence to the applicant or an appointed Canadian agent.

Nice Classification in Canada

- Canada's *Trademarks Act* requires every trademark application to contain a statement describing the applicant's goods and/or services "in ordinary commercial terms" in the sole discretion of the Examiner and, in some cases, goods and services listed in the Nice Classification will not be acceptable without further specification.

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TMOB/TTAB Proceedings

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TMOB/TTAB Proceedings - Key Differences

Simple opposition procedures

- Oppositions in Canada occur by way of summary proceeding and tend to be less expensive than the more complex procedures in place in the United States. In particular, the deposition process is considerably more restricted in Canada. As a result, a decision can be secured in Canada at a much lower expense, and often more quickly, than in the U.S.

A difference in “cancel culture”

- At present, only a party that may be damaged by another’s registration may seek cancellation of a registration in an *inter partes* proceeding before the TTAB on the basis that the mark has been abandoned without an intent to resume use. Once the regulations implementing the *Trademark Modernization Act* are established, U.S. cancellation proceedings will be (somewhat) similar to those in Canada.

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Registrations

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Registrations - Key Differences

Nationwide protection upon registration

- Unless it is geographically restricted, a Canadian trademark registration gives brand owners protection in every province across the country and can be secured even where there is no inter-provincial or international trade.

Straightforward renewal procedure

- In Canada, renewal is a relatively simple process; a trademark owner can maintain a registration by paying the renewal fees every ten years. Unless a registration is attacked, it is never necessary to provide proof of use.

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Miscellaneous

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Miscellaneous - Key Differences

Availability of “prohibited marks”

- Canadian law provides for “prohibited marks”, often known as “official marks”, which are available to universities (even U.S. universities) and Canadian public authorities. These marks can be very powerful as they are not limited to specific goods or services, may be descriptive or lack inherent distinctiveness, and can be confusing with a regular trademark. Prohibited marks can form the basis of an objection against a later-filed regular trademark application, which often cannot be overcome except with the consent of the official mark owner.
- Moreover, these marks can issue to “registration” in a few months, and do not expire or require renewal. They can be removed only by application to the Federal Court, or by voluntary withdrawal by the owner.

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Key Takeaways

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Key Takeaways - Contentious Issues

01

Do not assume that a worldwide coexistence and settlement agreement will allow a client's application to register in Canada in the face of a confusion objection.

02

Consult with Canadian counsel regarding consent agreements – if using them, specific language must be included to increase the likelihood of acceptance by the Canadian Trademarks Office.

03

Be sure to take advantage of non-use cancellation proceedings against cited registrations if the marks do not appear to be in use in Canada.

04

Be cautious in cases where there is a conflicting prohibited mark.

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Key Takeaways - Miscellaneous

01

Given the significant backlog at the Canadian Trademarks Office, counsel your clients to plan ahead when it comes to seeking registered trademark protection in Canada. Remember – use of a mark is **not** required to obtain a registration in Canada.

02

Appoint a Canadian agent to handle your clients' Madrid filings ASAP – there is no benefit to waiting, and many firms (including us) do not charge for assuming responsibility for these applications.

03

Expect more Canadian companies to consider relying upon use in the U.S. to expedite registration of marks in the U.S.

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Questions?

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