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Canadian tips under the Madrid Protocol.

Unique and unusual issues to consider when pursuing a Canadian designation

Speakers: Philip Lapin, Nora Labbancz

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Our Speakers



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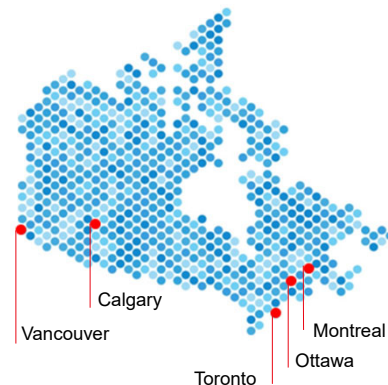
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Who we are

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
- 125+ lawyers, agents and technical consultants
- 10,000+ patents & trademarks filed annually
- Litigation bench strength and record of success



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Canadian tips under the Madrid Protocol

1. Correspondence issues
2. Confusing provisional refusals
3. Amending a Canadian designation
4. Inherent distinctiveness
5. Specificity of goods and services
6. CIPO threats of final refusals
7. Divisional applications
8. Examination delays



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Correspondence issues

- CIPO will **not** correspond with foreign representative of International Registration
- After the courtesy letter, CIPO will only correspond with:
 - Applicant or its appointed Canadian trademark agent
 - WIPO (some but not all communications)

LETTRE DE COURTOISIE	COURTESY LETTER
Ceci est une lettre de courtoisie, aucune réponse n'est requise.	This is a courtesy letter, no response is required.
La notification de désignation que nous avons reçue concernant cette demande vous identifie comme représentant du requérant auprès du Bureau international de l'Organisation Mondiale de la Propriété Intellectuelle (OMPI).	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).
Conformément au <i>Règlement sur les marques de commerce</i> du Canada, une personne qui souhaite représenter des tiers auprès du Bureau du registraire des marques de commerce de l'Office de la propriété intellectuelle du Canada doit résider au Canada et figurer sur la liste canadienne des agents de marques de commerce agréés.	Pursuant to the Canadian <i>Trademarks Regulations</i> , 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.
Veuillez noter que des copies de courtoisie des notifications envoyées à l'OMPI tel que requis par le Protocole de Madrid ainsi que toute autre correspondance ultérieure provenant de notre bureau seront envoyées directement au requérant ou à l'agent de marques de commerce canadien nommé.	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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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)		✓	✓
★ Subsequent Provisional Refusals (i.e., subsequent Examiner's Reports)		✓	
★ Notice of Default		✓	
Refusal (with appeal deadline)		✓	
Confirmation of Total Provisional Refusal (i.e., refusal after expiry of appeal period)			✓
Abandonment Notice		✓	
Statement of Grant of Protection (including Canadian registration certificate)		✓	✓

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Confusing provisional refusals

- Provisional Refusals from CIPO are long + confusing
- What is the Examiner objecting to?
- Only one minor request

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

I. Name of the Office:
Canadian Intellectual Property Office

II. International registration number:
[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:
The provisional refusal affects all the goods and services.

VI. Grounds for refusal (where applicable, see item VII):
This examiner's report concerns the above identified Protocol application. To avoid abandonment proceedings, a proper response must be received by this office by January 20, 2024. 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.

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

Upon satisfactory compliance with the above-mentioned requirement, further office action will be undertaken.

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,
Amanda Falkenham
Examination Section
819-839-5208
fax: 819-953-2476

VII. Information relating to an earlier mark:

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Confusing provisional refusals

(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 services (this list may be in the language of the earlier application or registration):
Not applicable

VIII. Provisions of the applicable law:
Paragraph 12(1)(c) of the Trademarks Act
Paragraph 12(1)(d) 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
Paragraph 31(d) of the Trademarks Regulations
Section 29 of the Trademarks Regulations

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

(i) Time limit to request a review or file an appeal or otherwise respond to the opposition:
2024-01-20

(ii) Calculation of time limit (the time limit runs from):
2023-07-20

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

(iv) Whether the request for review, appeal or response has to be filed in a specific language or through a local representative:
Correspondence must be in French or English

(v) Other requirements, if any:
Not applicable

X. Date and signature of the Office:
Registrar of Trademarks
2023-07-20


4 pages to raise one minor issue!

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Amending a Canadian Designation

- The **visual representation** must be **identical** to the IR

Example:

If IR contains the following representation: 

then the representation in the Canadian designation **cannot** be amended to: 

- Nice classification** must be **identical** to the IR

Example:

Canadian designation of an IR covering only "Class 14: statues" **can only** be amended to include goods in Class 14, for example:

Class 14: statues of precious metal; statues of precious stones

Nationally filed Canadian application covering only "Class 14: statues" **can** be amended to:

Class 14: statues of precious metal

Class 19: statues of stone

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Changes affecting a Canadian Designation

The following changes must be communicated to WIPO (and will not be considered by CIPO):

- 1) Change of owner's name or address
- 2) Changes to the specification of goods or services **before** a total provisional refusal is issued



Such amendments can be made through eMadrid

- 3) Change of ownership





NOTE: Canadian agent will be automatically **revoked** for the Canadian designation

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Inherent distinctiveness

- New type of objection available since 2019: **trademark is not inherently distinctive**
- Examples of marks considered by TMO to have no inherent distinctiveness:

Trademarks which are primarily geographic locations	e.g., LONDON OR PARIS
Designs that look like the goods/services	e.g.,  for "wine" or  for "electrical apparatus"
Names of colours common for the goods	e.g., WHITE for "paper" or RED for "toy fire engines"
One or two letter or number marks	e.g., X or 5
Laudatory terms/phrases	e.g., WONDERFUL or WORLD'S BEST

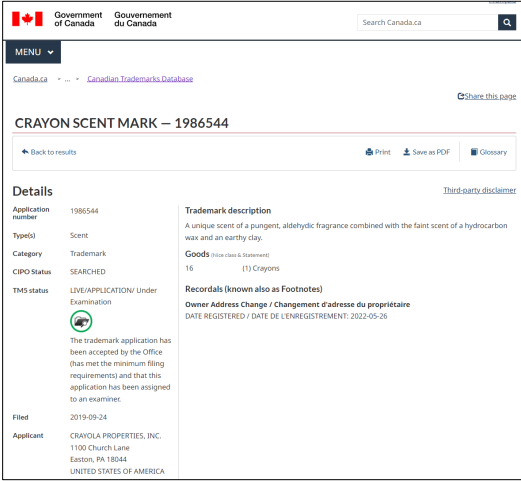
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Inherent distinctiveness

Other examples of marks which are not inherently distinctive:

- mark is primarily merely a surname
- mark is clearly descriptive
- mark is a combination of unregistrable elements
 - e.g., **ALFREDSON'S BEST CARROTS** for "carrots"
- mark is non-traditional ...
 - shape of goods/packaging, sound, colour *per se*, taste, scent, texture



The screenshot displays the Canadian Trademarks Database entry for application number 1986544. The title is 'CRAYON SCENT MARK - 1986544'. The details section includes:

- Application number:** 1986544
- Type(s):** Scent
- Category:** Trademark
- CIPO Status:** SEARCHED
- TMS status:** LIVE/APPLICATION/ Under Examination
- Trademark description:** A unique scent of a pungent, aldehydic fragrance combined with the faint scent of a hydrocarbon wax and an earthy clay.
- Goods:** (1) Crayons
- Records (known also as Footnotes):** Owner Address Change / Changement d'adresse du propriétaire. DATE REGISTERED / DATE DE L'ENREGISTREMENT: 2022-05-26.
- Filed:** 2019-09-24
- Applicant:** CRAYOLA PROPERTIES, INC., 1100 Church Lane, Easton, PA 18044, UNITED STATES OF AMERICA.

A note states: 'The trademark application has been accepted by the Office (has met the minimum filing requirements) and that this application has been assigned to an examiner.'

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Inherent distinctiveness

Two 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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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
 - Consider Goods and Services Manual: <https://ised-isde.canada.ca/site/canadian-intellectual-property-office/en/trademarks/goods-and-services-manual>



TIP: Consider filing broadly and narrow only if required by CIPO

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Final Refusals

Prior to 2021:

- Refusals in examination almost non-existent

In 2021:

- CIPO advised that it would start issuing final refusals where second/subsequent response does not raise new arguments
- Final refusals can be appealed to the Federal Court

Therefore, the Examiner remains of the opinion that the mark is not merely suggestive but rather, it is considered, when sounded, to be clearly descriptive of an inherent characteristic of the goods identified above.

Lastly, the Examiner also remains of the opinion that the mark [REDACTED] in association with the goods

[REDACTED] is not inherently distinctive pursuant to paragraph 37(1)(d) of the *Trademarks Act* since trademarks that are considered to be clearly descriptive pursuant to paragraph 12(1)(b) of the *Act* are considered not inherently distinctive as well.

As such and given all the considerations above, the objection raised pursuant to paragraph 12(1)(b) and 37(1)(d) of the *Trademarks Act* is hereby maintained.

The applicant's written comments with respect to this matter are invited.

You are further advised that this application may be refused under subsection 37(1) of the *Trademarks Act* if your next response does not overcome all objections.

50, rue Victoria • Place du Portage 1 • Gatineau (Québec) K1A 0C9 • www.opic.ic.gc.ca
50 Victoria Street • Place du Portage 1 • Gatineau, Quebec K1A 0C9 • www.cipo.ic.gc.ca

Canada¹⁸⁴



S&B Observations: Refusals in examination have remained virtually non-existent post-2021

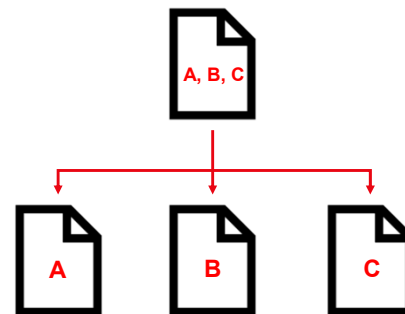


TIP: Nevertheless, put "best foot forward" to reduce risk of final refusal

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Divisional applications

- Since June 17, 2019, active applications can be divided
- No government fee
- Could be useful if:
 - objection raised or maintained during prosecution for only a subset of the goods/services; or
 - opposition only relates to a subset of the goods/services



TIPS: Consider filing divisional Protocol application to mitigate risk of final refusal
Consider subsequently merging Protocol registrations to save \$ on renewal fees

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Examination delays

CIPO is working on reducing the delays:

- Hiring more staff
- Revamped first Examiner's Reports (i.e., provisional refusals)
- Fast-tracking applications with pre-approved G&S
- Expedited examination

The screenshot shows the CIPO website header with the Canadian flag and the text "Government of Canada / Gouvernement du Canada". A search bar contains "Search Canada.ca". Below the header is a "MENU" dropdown and a breadcrumb trail: "Canada.ca > Canadian Intellectual Property Office". The main content area is titled "Trademarks" and features a graphic of a laptop with an envelope icon and the text "Make the switch to electronic trademark correspondence!". To the right, a box titled "Dates of Trademark Applications being distributed for Examination" lists three categories with their respective dates and durations:

Application Type	Date	Duration	Category
Applications not using the Pre-approved List of Goods and Services	April 30th, 2019	~53 mo.	Direct
Applications using the Pre-Approved List of Goods and Services	February 28th, 2022	~20 mo.	Madrid
Madrid (based on date of WIPO notification of designation)	May 18th, 2022	~18 mo.	

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Examination delays

Expedited examination is now available in the following circumstances:

- 1) Court action is expected or underway in Canada
- 2) Combatting counterfeit products at Canadian border
- 3) Registration required to protect IP from being "severely disadvantaged" on online marketplaces

If request is accepted, Office will examine application "as soon as possible" (typically within **1-2 weeks** of request).



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Top tips when designating Canada

1

Consider filing broadly and only narrow goods and services if CIPO objects

2

Appoint a Canadian agent

3

Consider whether eligible for expedited examination

4

Understand cases where evidence of acquired distinctiveness (secondary meaning) is likely to be required

5

File comprehensive arguments in response to objections

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Questions?

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Thank you.

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