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Intellectual Property
Office**

An Agency of
Industry Canada

**Office de la propriété
intellectuelle
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d'Industrie Canada

LEGAL AND TECHNICAL IMPLICATIONS OF CANADIAN ADHERENCE TO THE MADRID PROTOCOL

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Canada

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I INTRODUCTION

This paper is intended to be a background resource document for use in developing a Canadian position as to whether it would be in Canada's interest to adhere to the Madrid Protocol. In particular, it is intended to provide a detailed overview of the legal and technical implications that Canadian adherence to the Protocol would have for the functioning of the Canadian Trade-marks Office and for Canadian trademark law. The views expressed in the paper are those of the author and do not necessarily reflect official positions of the Canadian Intellectual Property Office.

To give an appropriate context, this paper also includes analysis of relevant provisions in the Paris Convention for the Protection of Industrial Property; the North American Free Trade Agreement; the Agreement on Trade-Related Aspects of Intellectual Property Rights; the Nice Agreement Concerning the International Classification of Goods and Services for the Registration of Marks; and the Trademark Law Treaty. A list of the changes that Canada would need to make to adhere to the TLT are set out in Annex I.

This paper assumes that the reader has a basic working knowledge of the Protocol. For information on the Protocol generally, the reader is referred to WIPO's Internet website (address: <http://www.wipo.int>) under the heading "Activities & Services" and then "International Marks".

Abbreviations

Throughout this paper, the following abbreviations are used:

- 1) "CTMA" for the Canadian Trade-marks Act;
- 2) "CTMO" for the Canadian Trade-marks Office;
- 3) "CTMR" for the Canadian Trade-marks Regulations;
- 4) "IB" for the International Bureau of the World Intellectual Property Organization;
- 5) "Madrid Agreement" for the Madrid Agreement Concerning the International Registration of Marks;
- 6) "Madrid Regulations" for the Common Regulations under the Madrid Agreement Concerning the International Registration of Marks and the Protocol Relating to that Agreement [References in this paper to the Madrid Regulations are to the version amended as of to April 1, 2002.];
- 7) "NAFTA" for the North American Free Trade Agreement;
- 8) "Protocol" for the Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks;
- 9) "TLT" for the Trademark Law Treaty;
- 10) "TRIPS" for the Agreement on Trade-Related Aspects of Intellectual Property Rights; and
- 11) "WIPO" for the World Intellectual Property Organization.

II THE CANADIAN TRADE-MARKS OFFICE AS AN OFFICE OF ORIGIN

1. Who Could Use Canada to File an International Application

Pursuant to Article 2 of the Protocol, an international application can only be filed on the basis of a national application or registration (referred to as the basic application or registration) in one of the contracting parties or on the basis of several such applications and/or registrations in one contracting party. Article 2(2) of the Protocol requires that international applications be filed with the IB through the intermediary of the office (referred to as the "Office of origin") with which the basic application was filed or by which the basic registration was made.

Pursuant to Article 2(1) of the Protocol, only a person who is a national of Canada, or is domiciled, or has a real and effective industrial or commercial establishment, in Canada, would have the right to file an international application using the CTMO as the office of origin. Paragraph B.II.02.04 of WIPO's *Guide to the International Registration of Marks* states that the "interpretation of "national", "domicile" or "real and effective commercial or industrial establishment" is a matter for the laws of the Contracting Parties to determine, each as far as it is concerned."

Although not dealt with explicitly in the Protocol, it would appear that the connection that Article 2(1) of the Protocol requires an applicant to have with a contracting party needs only to exist at the time of the filing of the international application. An international registration will therefore not become invalid because its owner ceases to have a connection with the office of origin or even if the owner ceases to have any connection with any contracting party of the Protocol. The question of whether a connection exists would only again become relevant at the time of any change in ownership of the mark, where it would (under Article 9 of the Protocol) be necessary for the new owner to be a person who, under Article 2(1), is a person entitled to file international applications.

2. Language

Rule 6(1)(b) of the Madrid Regulations provides that any international application governed by the Protocol “shall be in English or French according to what is prescribed by the Office of origin, it being understood that the Office of origin may allow applicants to choose between English and French”. The CTMO, as an office of origin, would of course allow applicants to choose between English and French.

3. Preparation and Presentation of International Application

International applications can only be presented to the IB by an office of origin (Rule 9(1) Madrid Regulations) and they must be presented on the official form that has been prepared by the IB (Rule 9(2)(a) Madrid Regulations).

Subject to what is mentioned in the following paragraph, neither the Protocol nor the Madrid Regulations prescribe what the relative roles are of the applicant and the office of origin in the completion of the official form. In this regard, WIPO’s *Guide to the International Registration of Marks* states in paragraph B.II.07.02:

“Whether the applicant can or must complete the official international application form or whether the form is completed by the Office on the basis of information supplied by the applicant depends on the practice of the Office concerned. The Offices of some Contracting Parties provide forms for requesting the presentation of an international application which are different from the official international application form and which applicants may be permitted or required to use as prescribed by the law of the Contracting Party.”

If the CTMO were acting as the office of origin for the filing of an international application, Article 3(1) of the Protocol and Rule 9 of the Madrid Regulations would require it to

- 1) sign the international application;
- 2) make a declaration certifying the filing date of the international application and certifying that the particulars appearing in the international application correspond to the particulars appearing, at the time of the certification, in the basic application or registration; and
- 3) present the application to the IB.

With respect to the declaration, Rule 9(5)(d) provides:

“The international application shall contain a declaration by the Office of origin certifying

- (i) the date on which the Office of origin received ... the request by the applicant to present the international application to the International Bureau,
- (ii) that the applicant named in the international application is the same as the applicant named in the basic application or the holder named in the basic registration, as the case may be,
- (iii) that any indication referred to in paragraph (4)(a)(viii) to (xi) [i.e. an indication that the mark is a color or a combination of colors as such, or is a three-dimensional, sound, collective, certification or guarantee mark, or a description of the mark by words] and appearing in the international application appears also in the basic application or the basic registration, as the case may be,
- (iv) that the mark that is the subject matter of the international application is the same as in the basic application or the basic registration, as the case may be,
- (v) that, if color is claimed as a distinctive feature of the mark in the basic application or the basic registration, the same claim is included in the international application or that, if color is claimed as a distinctive feature of the mark in the international application without having been claimed in the basic application or basic registration, the mark in the basic application or basic registration is in fact in the color or combination of colors claimed, and
- (vi) that the goods and services indicated in the international application are covered by the list of goods and services appearing in the basic application or basic registration, as the case may be.”

4. Official Application Form

A copy of the official application form (for international registrations governed exclusively by the Protocol) is included in Annex II. Having regard to the above, three alternative procedures would be available to the CTMO for the completion of boxes 1 to 12 of the official form: 1) it could require the applicant to complete these boxes; 2) it could insist on completing these boxes itself based on information received from the applicant in some other form; or 3) it could give the applicant the choice to complete the boxes itself or have the office complete them.

It would seem that one of the primary reasons why an office might choose to complete these boxes itself would be to facilitate filing in jurisdictions that do not have either English or French as an official language. In the Canadian context, particularly since both Canadian official languages are accepted under the Protocol, there would not appear to be any significant reason for not requiring an applicant to itself complete boxes 1 to 12 of the official application form. Requiring the applicant to complete these boxes itself would help reduce the workload of the CTMO and would avoid the possibility of errors being made by the CTMO in transferring data to the WIPO official form. It is noted, however, that if the CTMO decides, as is likely, to send international applications electronically to the IB, data capture will be unavoidable unless the CTMO receives the data electronically from the applicant.

As is discussed below [under the heading “Notification of irregularities”], if the CTMO were to decide that an applicant should itself complete boxes 1 to 12 of the official application form, the CTMO would no doubt still want to carry out a careful check of the boxes completed by the applicant in order to avoid any irregularities referred to in Rule 11(4) for which the CTMO would then have the responsibility for remedying. In the interest of providing good client service, the CTMO may wish to go even further in its review of boxes completed by the applicant to try to identify at least any obvious irregularities for which the applicant would be responsible for remedying so that they might be corrected before the CTMO presents the international application to the IB. The CTMO would, however, need to ensure that the process of checking for irregularities not unduly delay the forwarding the application to the IB, bearing in mind (in accordance with Article 3(4) of the Protocol) that for an international registration to bear the date on which the international application was received by the office of origin, the international application must be received by the IB within two months of that date.

The CTMO would be required to complete box 13 which contains the certification and signature of the international application by the office of origin.

5. Forwarding International Application to the IB

In accordance with Rule 2 of the Madrid Regulations and the Administrative Instructions, the CTMO would have the option of sending the international application (and any other communication) to the IB by mail, by telefacsimile, or by electronic means in a way agreed upon between the CTMO and the IB. If the international application was to be sent by telefacsimile, Section 9 of the Administrative Instructions would require the original of the page of the official form bearing the reproduction or reproductions of the mark to be sent to the IB within a one-month period after the telefacsimile.

6. Fees

In connection with the filing of an international application through the intermediary of the CTMO, an applicant would be required to pay, in advance, an international fee to the IB and could be required to pay a separate fee to the CTMO.

Article 8(1) of the Protocol authorizes the fee that could be charged by the CTMO. It provides: “The Office of origin may fix, at its own discretion, and collect, for its own benefit, a fee which it may require from the applicant for international registration or from the holder of the international registration in connection with the filing of the international application or the renewal of the international registration.”

As to the international fee for the registration of a mark, Article 8(2) of the Protocol provides that it shall include “(i) a basic fee, (ii) a supplementary fee for each class of the International Classification, beyond three, into which the goods or services to which the mark is applied will fall; and (iii) a complementary fee for any request for extension of protection under Article 3ter.” In accordance with Madrid Rule 34(2), the international fee may be paid by the applicant directly to the IB. Alternatively, where the office of origin agrees to collect and forward the fee to the IB, the applicant may, if it so wishes, pay fees to the IB through that office. An applicant cannot however be required to use an office to pay any fee that is due to the IB.

Madrid Rule 35(1) provides that all payments due to the IB, including the international fee, must be made to the IB in Swiss currency irrespective of the fact that, where the fees are paid by an office, it may have collected the fee in another currency.

The CTMO would therefore need to consider whether it would be willing to collect (presumably in Canadian dollars) and forward (in Swiss francs) the international fee for the registration of a mark to the IB on behalf of the applicant. In this regard it is noted that the official application form includes a fee calculation sheet, part (a) of which provides a simple mechanism for authorizing the debiting of fees from a current account opened with the IB, which account could be either an account kept by the CTMO, the applicant or the applicant's trademark agent. The CTMO would also need to decide whether it would collect and forward all other fees due to the IB, for example renewal fees. At the present time, most offices in the Madrid system have not agreed to collect any fees that are due to the IB.

[See also the discussion of fees below in Part III.]

7. Notification of Irregularities

After an international application is presented to the IB by an office of origin, the IB proceeds to check the application for irregularities. Where the IB considers that an international application contains an irregularity, it will notify both the applicant and the office of origin of the irregularity. Depending upon the nature of the irregularity, some irregularities must be remedied by the applicant, some by the office of origin and some by either the applicant or the office of origin.

Fees Irregularities

In accordance with Rule 11(3) of the Madrid Regulations, where the fees for an international application are paid to the IB by the office of origin and the IB considers that the amount of the fees received is less than the amount of the fees required, it will notify both the office of origin and the applicant. The missing amount may be paid by the office of origin or by the applicant within three months from the date of the notification. As noted above, the Protocol does not require fees to be paid through the intermediary of the office of origin and the CTMO could thus decide that the applicant should have the sole responsibility for responding to a Rule 11(3) notice, meaning that the applicant would be required to pay the missing amount (in Swiss francs) directly to the IB. Even if the CTMO decided to offer the service of collecting and forwarding missing amounts to the IB, it would still not be required to take any initial responsibility for responding to a Rule 11(3) notice and could simply ignore the notice unless and until the applicant requested the CTMO to make the payment on its behalf.

Irregularities that Must be Remedied by Office of Origin

Rule 11(4) of the Madrid Regulations sets out a number of irregularities that can be remedied only by the office of origin. The rationale for placing the responsibility on the office of origin to remedy these irregularities is that the office should not have forwarded an international application containing such defects to the IB. The irregularities thus relate either to errors made by the office in completing the application form or errors made by the applicant (where the office allows or requires the applicant to itself complete part of the official application form) that the office should have identified and had corrected by the applicant before forwarding the application to the IB.

Where the IB considers that an international application presented to it by the CTMO contained one of the irregularities specified in Rule 11(4), it would notify the CTMO and at the same time inform the applicant. The CTMO would then have 3 months from the date of notification of the irregularity to remedy the irregularity. Depending upon the nature of the irregularity, the CTMO could choose to respond on its own to the notice of irregularity or it could choose to consult with the applicant.

The irregularities covered by Rule 11(4) are:

- i) the application is not presented on the official form or isn't typed;
- ii) where an application is sent to the IB by telefacsimile, the original of the page bearing the mark (required by Rule 2 and Section 9 of the Administrative Instructions) has not been received by the IB;
- iii) the application is missing an essential element (such as a reproduction of the mark or an indication of the goods or services) that is required by Rule 15(1) for the determination of the date of the international registration;
- iv) there are irregularities relating to the entitlement of the applicant to file the application;
- v) the declaration by the office of origin referred to in Rule 9(5)(d) is defective; and
- vi) the application is not signed by the office of origin.

If, as is likely, the CTMO were to decide that any applicant using the CTMO to present an international application should itself complete boxes 1 to 12 of the official application form, the CTMO would no doubt still want to carry out a careful check of the boxes completed by the applicant in order to avoid any irregularities referred to in Rule 11(4) for which the CTMO would then have the responsibility for remedying.

Declaration of Intention to Use Irregularities

In accordance with Rule 11(6) of the Madrid Regulations, where a declaration of intention to use is required but is missing or does not comply with the applicable requirements, the IB will notify both the applicant and the office of origin. The CTMO, as an office of origin, would not however appear to have any responsibility to ensure that a missing or corrected declaration is provided to the IB.

Goods and Services Irregularities

In accordance with Rules 12 and 13 of the Madrid Regulations, where the IB considered that there were irregularities with respect to the classification or indication of goods and services in an international application presented by the CTMO, it would notify the CTMO and inform the applicant. The CTMO would then be given the opportunity to comment or make a proposal to remedy the irregularity within three months from the date of the notification. The applicant would have no separate right to communicate to the IB with respect to these irregularities. In a note that was prepared by the IB during the drafting of Rule 12, it was stated: "It is understood that the fact that the applicant was informed of a proposed classification and grouping notified by the International Bureau to the Office of origin will enable the applicant to take action before that Office in order to give his view on the proposal by the International Bureau." Before responding to the notification of an irregularity under Rule 12 or 13, the CTMO would likely want to allow time for the applicant to submit comments to it. Alternatively, the CTMO could, upon receipt of the notification from the IB, immediately send a notice to the applicant requesting its views within a short period of time.

Other Irregularities

With respect to irregularities other than those discussed above (i.e. other than those referred to in Rules 11(3),(4) or (6); 12 or 13), Rule 11(2) of the Madrid Regulations requires the IB to notify the applicant of the irregularity and at the same time inform the office of origin. It would then be up to the applicant to remedy the irregularity by communicating directly with the IB. The CTMO would not be required to be involved in respect of any such irregularities (although it may of course wish to provide some general assistance to applicants in overcoming irregularities).

8. Changes in Basic Application or Registration

In accordance with Articles 6(3) and (4) of the Protocol and Rule 22 of the Madrid Regulations, the CTMO would be required to notify the IB if there were certain changes in the basic application or registration either within the first five years of the term of the international registration or after that five year period as a result of a proceeding commenced within the five year period. In particular, the CTMO would be required to notify the IB if "the basic application or the registration resulting therefrom, or the basic registration, as the case may be, has been withdrawn, has lapsed, has been renounced or has been the subject of a final decision of rejection, revocation, cancellation or invalidation, in respect of all or some of the goods and services listed in the international registration."

Expungements, Withdrawals and Final Rejections

Any expungement of a Canadian basic registration or of a Canadian registration resulting from a Canadian basic application in respect of some or all of the goods and/or services listed in the international registration would need to be notified to the IB. Similarly, any withdrawal or final rejection of a Canadian basic application in respect of some or all of the goods and/or services listed in the international registration would need to be notified to the IB.

Amendments

There are a whole range of amendments that could be made to a Canadian basic application consistent with ss. 30 to 33 CTMR, some at any time before registration and some only before advertisement of the mark for opposition. Certain amendments if made before the presentation of the international application would affect the contents of the international application, certain amendments if made after the international application would need to be notified to the IB, and certain amendments would have no consequences at all in relation to the international application or registration regardless of when they were made.

When presenting to the IB an international application based on a Canadian basic application, the CTMO would be required in accordance with Article 3(1) of the Protocol, Rule 9(5)(d) of the Madrid Regulations and Box 13(a)(ii) of the official application form, to certify that the particulars appearing in the international application correspond to the particulars appearing, *at the time of the certification*, in the basic application. In particular, the CTMO would have to certify that the following indications correspond: the applicant; the mark; any claim for color; any indication of the mark as being a color or a combination of colors as such, a three-dimensional mark, a sound mark or a collective, certification or guarantee mark; any description of the mark; and the list of goods and/or services. What matters for an international application is the status of these elements in the basic application at the time of the certification. With respect to any amendments to the basic application before the certification, the Protocol neither imposes any restrictions on what the CTMO could accept nor requires the CTMO to notify the IB of any such

amendments.

With respect to amendments to the basic application after the certification, these would have to be notified to the IB if they could be construed as being a withdrawal of the basic application in respect of all or some of the goods or services listed.

Goods and Services

Any restriction of the list of goods and/or services subsequent to the time of certification would have to be notified to the IB. Any broadening, however, of the list of goods and/or services after the time of certification (which could happen if the basic application had been amended to restrict the list of goods and/or services between its initial filing and the time of certification of the international application and the applicant subsequently decided to return to its original list) would not have to be notified to the IB.

Basis of Application

Ss.30 to 32 CTMR permit certain amendments to be made to an application in respect of the basis on which registration is sought. For example, before advertisement, an application may be amended to change the application from one alleging use or making known to one for a proposed trademark. Amendments of this nature would not need to be notified to the IB.

Identification of Mark

With one exception, ss.31(b) and 32(a) CTMR prohibit any amendment to an application that would change the trademark. The one exception is that an application may be amended before advertisement to change the trademark “in respects that do not alter its distinctive character or affect its identity”.

Ss.31(b) and 32(a) CTMR would not appear to ever permit an amendment to an application that would change any indication of the mark as being a three-dimensional mark or a sound mark.

In practice, where an application as initially filed is ambiguous as to what it covers (including as to whether it is intended to cover a three-dimensional mark or a sound mark), the CTMO will give the applicant an opportunity to amend the application to clarify what is intended. Once clarified, however, no further amendment will be permitted. This possibility of amendment to clarify ambiguities would be unlikely to ever lead to a requirement to notify the IB under Article 6(4) of the Protocol since the CTMO would no doubt insist on the ambiguity being clarified in the basic application before forwarding any international application based on that basic application to the IB.

In accordance with the exception under s.31(b) CTMR, the CTMO will, before advertisement, permit non-substantial amendments to an application that change the mark, any claim for color, or any description of the mark. Consideration will need to be given to whether such changes would effectively constitute a partial withdrawal of the basic application as it stood at the time of the certification and, if so, to what the implications would be for the international application or registration. It may be that the obligation to notify the IB of changes under Article 6(4) of the Protocol could be interpreted as not applying to non-substantial changes. However, to avoid any problems in this area, it might be best to simply amend the Canadian Trade-marks Regulations to prohibit any amendment of the trademark covered by a Canadian application (including amendments to claims to color or to descriptions of the mark) once that application has served as a basis for an international application.

Disclaimers

Section 35 CTMA permits the Registrar to require an applicant to disclaim the right to the exclusive use apart from the trademark of such portion of the trademark as is not independently registrable, but it also notably provides that “the disclaimer does not prejudice or affect the applicant’s rights then existing or thereafter arising in the disclaimed matter, nor does the disclaimer prejudice or affect the applicant’s right to registration on a subsequent application if the disclaimed matter has then become distinctive of the applicant’s wares or services”. It would not seem that a disclaimer would be construed as a withdrawal of the basic application and thus it would not appear necessary for the CTMO to notify the IB of disclaimers.

[Disclaimers are also discussed below in Part IV of this paper under the heading “Disclaimers”.]

Applicant Named

Changes to the applicant named in the basic application after the time of the certification, whether as a result of a transfer or a change of name, do not need to be notified to the IB. In this regard, paragraph B.II.77.05 of WIPO’s

Guide to the International Registration of Marks states:

“Although an international application must be filed by the person who is the holder of the national or regional registration or application on which it is based, the validity of an international registration is not affected if it and the national or regional registration or application subsequently become owned by different persons. (It does not even matter if the national or regional application or registration is transferred to a person who would not qualify to be the holder of an international registration). Since however the international registration continues to be dependent on the fate of the basic mark, the holder of an international registration runs a risk if, during the five-year dependency period, he does not control the basic mark.”

9. Divisionals and Mergers

In accordance with Rule 23 of the Madrid Regulations, where a basic Canadian application or registration was divided within the five-year period referred to in Article 6(3) of the Protocol, the CTMO would be required to notify the IB, which in turn would record the notification and notify the offices of the designated contracting parties and the holder of the international registration. Currently, Canadian law generally does not permit applications or registrations to be divided (the one related exception being that subsection 48(1) of the Trade-marks Act allows for partial assignments); however, should Canada decide to join the TLT, it would be required by Article 7 of that treaty to permit the division of applications and registrations in certain circumstances.

Rule 23 of the Madrid Regulations also requires notification to the IB where, during the five-year period referred to in Protocol Article 6(3), several basic applications are merged into a single application or there is a merger of any registrations which resulted from the basic application or applications. Nothing in the TLT or the Protocol would require contracting parties to provide for a procedure for merger of applications or registrations. The CTMA generally does not provide for mergers of applications or registrations; however, it would seem that in some cases applications to extend the statement of wares or services in respect of which a trademark is registered pursuant to s.41 CTMA could result in merged registrations that would need to be notified under Rule 23 of the Madrid Regulations.

10. Renewal of International Registration

An international registration must be renewed every ten years to remain in force (Article 7(1) of the Protocol). As with other fees, the renewal fee may be paid by the holder of the international registration directly to the IB. The CTMO could agree to collect and forward renewal fees to the IB on behalf of holders where it is the office of origin or the office of the contracting party of the holder (Rule 34(2) of the Madrid Regulations). Article 8(1) of the Protocol would permit the CTMO to charge a handling fee in connection with the collecting and forwarding of renewal fees. At the present time, most offices in the Madrid system have not agreed to collect and forward fees to the IB.

[Issues relating to term and renewal are also discussed below in Part VIII.]

11. Subsequent Designations

Article 3ter of the Protocol provides that requests for territorial extensions (which are referred to in the Madrid Regulations as designations of contracting parties) may be made subsequently to the international registration. Subsequent designations of Protocol contracting parties can be based on international registrations effected under the Protocol or, in some situations as set out in Rule 24(1) of the Madrid Regulations, on international registrations effected under the Madrid Agreement.

Rule 24(2) of the Madrid Regulations provides that a subsequent designation may be presented to the IB by the holder or by the office of the contracting party of the holder. The CTMO would, whenever it is the office of the contracting party of a holder, be required, upon request, to act for the holder in presenting a subsequent designation to the IB.

In presenting subsequent designations, the CTMO would need in each case to verify that the official form for subsequent designations was correctly completed, sign the form, certify the date on which it received the request to present the subsequent designation and then forward the form to the IB by mail, telefacsimile or electronic means. As in the case of forwarding international applications, the CTMO would need to ensure that its handling process, including the checking for irregularities, not unduly delay the forwarding of the subsequent designation to the IB, bearing in mind (in accordance with Rule 24(6) of the Madrid Regulations) that for a subsequent designation to bear the date on which it was received by the office of origin, it must be received by the IB within two months of that date.

It would not seem possible for the CTMO to charge the holder a fee for presenting subsequent designations to the IB. See paragraph B.III.24.02 of WIPO's *Guide to the International Registration of Marks* which states: “In con-

trast to the position with regards to the presentation of an international application or the renewal of an international registration, there is no provision for an Office to charge a fee in connection with the presentation through it of a subsequent designation.”

12. Change or Cancellation of International Registration

In accordance with Articles 9 and 9bis of the Protocol, the IB will, upon request, record various changes concerning an international registration including a change in ownership, any change in the name or address of the holder, the appointment of a representative, any limitation of the goods or services and any renunciation, cancellation or invalidation.

Rule 25(1)(b) of the Madrid Regulations provides that, in general, a request for the recordal of a change may, at the option of the holder, be presented either 1) directly by the holder, or 2) through the office of the contracting party of the holder [“Contracting Party of the holder” is defined in Madrid Article 1(xxvibis)]. In the case of a request for the recordal of a change in ownership, Rule 25(1)(b) also permits the request to be made by the office of the contracting party of the transferee.

If Canada was to adhere to the Protocol, it would seem that the CTMO would be required to accept to present to the IB any request for recordal of a change whenever it was requested to do so as the office of the contracting party of the holder, or in the case of a change in ownership, as the office of the contracting party of the transferee. Further, it would not seem possible for the office to charge the holder a fee for this service. See paragraph B.III.28.04 of WIPO’s *Guide to the International Registration of Marks* which states: “There is no provision for an Office to charge a fee in connection with the presentation through it of a request for the recordal of a change or a cancellation.”

III THE CANADIAN TRADE-MARKS OFFICE AS THE OFFICE OF A DESIGNATED CONTRACTING PARTY

1. IB Notification to CTMO of Designations of Canada

Where Canada was designated at the time an international registration was effected, the IB would in accordance with Article 3(4) of the Protocol notify the international registration to the CTMO without delay after the registration is effected.

Where Canada was designated subsequent to the international registration, the IB would in accordance with Article 3ter(2) of the Protocol notify to the CTMO the recordal of the request for territorial extension to Canada (i.e., the subsequent designation of Canada) without delay after the recordal.

2. Potential Effective Delay in Notification

There will normally be a time delay (and in some cases a significant time delay) between the effective date of a designation of Canada and the date on which the IB notifies this to the CTMO. This is due to the following factors.

First, the international registration will generally bear a date up to two months earlier than the date on which the registration is actually effected in view of the following provisions in Article 3(4) of the Protocol:

“The International Bureau shall register immediately the marks filed in accordance with Article 2. The international registration shall bear the date on which the international application was received in the Office of origin, provided that the international application has been received by the International Bureau within a period of two months from that date. If the international application has not been received within that period, the international registration shall bear the date on which the said international application was received by the International Bureau.”

Similarly, although under Article 3ter(2) of the Protocol a subsequent designation is effective only from the date on which it has been recorded in the International Register, in accordance with Rule 24(6) of the Madrid Regulations the recordal date is the earlier of the date of receipt by the IB and the date of receipt by an office if the designation is received by the IB within two months from that date.

In addition, where communications of international applications and subsequent designations are delayed by irregularities in postal or delivery services, Rule 5(4) of the Madrid Regulations could excuse a six month delay beyond the two month period allowed under Article 3(4) or Rule 24(6).

3. Implications of Effective Delay in Notification

Consideration will need to be given to what the implications for the CTMO and the Canadian public would be of the time delay that would normally occur between the effective date of a designation of Canada and the date on

which the IB notifies this to the CTMO.

The fact that Rule 5(4) of the Madrid Regulations could excuse up to a sixth month delay where communications are delayed by irregularities in postal or delivery services can probably be largely ignored since such cases would presumably occur only very rarely.

The CTMO has in the past had, at least in theory, a general policy to wait at least six months from the earlier of the date of first use, the date of making known and the filing and priority dates of an application before advertising in the Trade-marks Journal in order to be sure that potential conflicts with later filed applications claiming priority had been considered. In practice the CTMO seldom needed to focus on this question since it has normally taken at least 6 months to process an application to the point of advertisement. Currently the only applications in the CTMO that might be ready for advertisement within six months of filing are applications subject to a special order for advanced prosecution; where they are ready, the CTMO has been letting these applications proceed to advertisement within the six month period on the basis that earlier conflicting priority applications would be infrequent and any resulting problems could be resolved by the courts.

If Canada adhered to the Protocol and it was to decide that it wished to be sure that potential conflicts with later filed applications claiming priority had been considered, it would need to ensure that advertisement of a mark not take place until about eight or nine months after the filing date, i.e., the six month priority period and an additional two to three months to provide time for the receipt from the IB of notifications of pertinent Canadian designations under the Protocol (bearing in mind the backdating that takes place under Article 3(4) of the Protocol and Rule 24(6) of the Madrid Regulations). Even this would not take account of the fact that Rule 5(4) of the Madrid Regulations could excuse up to a sixth month delay where communications are delayed by irregularities in postal or delivery services but, as noted above, this potential occurrence can probably be largely ignored since such cases would presumably occur only very rarely.

4. Effect of International Registrations in Canada

Article 4(1)(a) of the Protocol provides: "From the date of the registration or recordal effected in accordance with the provisions of Articles 3 and 3ter, the protection of the mark in each of the Contracting Parties concerned shall be the same as if the mark had been deposited direct with the Office of that Contracting Party. If no refusal has been notified to the IB in accordance with Article 5(1) and (2) or if a refusal notified in accordance with the said Article has been withdrawn subsequently, the protection of the mark in the Contracting Party concerned shall, as from the said date, be the same as if the mark had been registered by the Office of that Contracting Party."

The first sentence of Article 4(1)(a) of the Protocol would be satisfied under Canadian law by deeming the international registration or recordal date to be the date of filing of the application in Canada.

On a first reading, one might conclude that the second sentence of Article 4(1)(a) of the Protocol would require that the remedies that are available for infringement (e.g. damages, accounting of profits) be available effective from the international registration or recordal date instead of from the actual date of registration of the trademark in Canada as would currently be the case under the CTMA. It appears, however, that the availability of remedies is an issue that is outside the scope of the subject matter covered by the Protocol and that each contracting party is therefore free to decide how it should be dealt with.

It would seem that the spirit of Article 4(1) of the Protocol is that the holder of an international registration designating country X should be in a no less favourable position than a person who had, on the date of designation of country X, filed a national application there; if there is no refusal within the prescribed period, or if any such refusal is withdrawn, the holder should be in a no less favourable position than the owner of a registration resulting from the national application. This intention that at least equal treatment be provided would, in the Canadian context, appear to be satisfied if remedies for infringement were only to be available at the end of the period for refusal.

In paragraphs 330 and 334 of the Main Committee Summary Minutes at the Diplomatic Conference on the Protocol, the Director General of WIPO stated that, with respect to the second sentence of Article 4(1)(a), an international registration would have a deposit effect until it was known whether the registration was affected by a refusal, and that it had to be clear that once any doubt as to the validity of a registration in a designated contracting party had been lifted, the registration effect in that contracting party was equivalent to a national registration made on the date of the international registration.

In an article by Gerd Kunze, *The Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks*, 82 TMR 58, it is stated at page 68:

"New provisions were made in Article 4 with respect to the effect of the international registration. To avoid future difficulties in interpreting the provision, it was clearly stated that the international trademark registration has the effect of

a national registration only in those cases in which the international office was not notified of a refusal of protection according to Article 5 or, in the case of such a refusal, the refusal had subsequently been withdrawn. This should make it perfectly clear that the international trademark registration cannot serve as a basis for an action for trademark infringement prior to the conclusion of the procedure.”

5. Time Limits For Refusals

Article 5(1) of the Protocol gives each contracting party “the right to declare in a notification of refusal that protection cannot be granted in the said Contracting Party to the mark which is the subject of such extension.”

[It should be noted that, on the subject of refusals, the Madrid Regulations sometimes use slightly different terminology than the Protocol. In particular, it may be noted that Rule 1(xix) of the Madrid Regulations defines the term “notification of provisional refusal” to mean “a declaration by the Office of a Contracting Party, in accordance with ... Article 5(1) of the Protocol”.]

Examination

Article 5(2)(a) of the Protocol provides that “[a]ny Office wishing to exercise such right shall notify its refusal to the International Bureau, together with a statement of all grounds, ... before the expiry of one year from the date on which the notification of the extension referred to in paragraph (1) has been sent to that Office by the International Bureau.” Article 5(2)(b) of the Protocol allows a contracting party to change the one year time limit to 18 months and Canada would no doubt make use of this option if it were to adhere to the Protocol.

To comply with Article 5(2)(a) and (b) of the Protocol, the Examination Branch CTMO would have to notify the IB of any refusal together with all the possible grounds of refusal within 18 months after the CTMO has been sent a notification of the international application by the IB. The CTMO could withdraw any such refusal at any time before or after the expiry of the 18 month period; however, no new grounds of refusal could be raised by the Examination Branch after the expiry of the 18 month period.

Although the Examination Branch would normally probably wish to raise all ex officio (i.e. examination-stage) grounds of refusal in a single notification, it would be permissible under the Protocol to raise additional ex officio grounds of refusal in separate notifications provided that all such notifications were issued within the 18 month time period.

Opposition

Article 5(2)(c) of the Protocol provides that contracting parties may also declare that where a refusal of protection may result from an opposition such a refusal may be notified by the contracting party to the IB after the 18-month period. Where such a declaration has been made (as would no doubt be the case for Canada if it adhered to the Protocol), Article 5(2)(c) then provides: “Such an Office may, with respect to any given international registration, notify a refusal of protection after the expiry of the 18-month time limit, but only if:

- (i) it has, before the expiry of the 18-month time limit, informed the International Bureau of the possibility that oppositions may be filed after the expiry of the 18-month time limit, and
- (ii) the notification of the refusal based on an opposition is made within a time limit of not more than seven months from the date on which the opposition period begins; if the opposition period expires before this time limit of seven months, the notification must be made within a time limit of one month from the expiry of the opposition period.”

Rule 16(1) of the Madrid Regulations requires a communication under Article 5(2)(c)(i) to include the number, and the name of the holder of the international registration in respect of which oppositions may be filed after the expiry of the 18-month time limit as well as, where known, the dates on which the opposition period begins and ends. Rule 16(1)(b) of the Madrid Regulations requires that where the opposition dates are not known at the time of the Article 5(2)(c)(i) communication, they must be communicated at the latest at the same time as any notification of a provisional refusal based on an opposition. The following explanation of Rule 16(1)(b) is given in paragraph 9 of WIPO document MM/WG\2\4 dated April 11, 2001:

“The information about the start and end dates of the opposition period is required solely in order for the International Bureau to be able to check that the requirements of Article 5(2)(c)(ii) have been met. In practice therefore, where an Office has been unable to include this information in the communication under subparagraph (a) [i.e the Article 5(2)(c)(i) communication], it may send it only in the case where an opposition has actually been filed.”

In order to comply with Article 5(2)(c) of the Protocol and Rule 16(1) of the Madrid Regulations in respect of a given international registration, the CTMO would be required to:

1) notify the IB before the expiry of the 18 month period (i.e. within 18 months after the IB notification to the CTMO of the international registration or recordal) that oppositions may be filed after the 18-month period and inform the IB of the number, and the name of the holder, of that international registration;

2) provide the IB with the dates on which the opposition period begins and ends, either at the time of the notification referred to in subparagraph 1) above or at the latest at the same time as any notification of a provisional refusal based on an opposition (In Canada, the opposition period would begin on the advertisement of the application in the Trade-marks Journal and end two months thereafter in accordance with subsection 38(1) CTMA unless an extension of this time period was granted under section 47 CTMA.); and

3) notify the IB of the grounds of refusal raised in the opposition before the earlier of seven months from the date of advertisement of the application and one month from the expiry of the opposition period.

With respect to the first requirement (i.e. to notify the IB before the expiry of the 18 month period that oppositions may be filed after the 18-month period), this notice could in some cases be sent together with any provisional refusal notified to the IB at the examination stage. It is however not intended that such notices be routinely sent with all examination-stage provisional refusals but rather only where applicable in respect of particular applications. Rule 16(1)(a) of the Madrid Regulations requires that information about possible late oppositions shall be given “where it has become apparent with regard to a given international registration designating that Contracting Party that the opposition period will expire too late for any provisional refusal to be based on an opposition to be notified to the International Bureau within the 18-month time limit referred to in Article 5(2)(b)”. In the Canadian context (and bearing in mind s.39(3) CTMA), it would seem that this would only be apparent in one of the two following situations:

1) where a given application has been approved for advertisement before the 18-month time limit but sufficiently close to that time limit so that, taking into account whatever extensions of time for filing oppositions may be permitted [as discussed below, the maximum length of extensions of time for filing oppositions would need to be limited], it is possible that the opposition period may end only after the end of the 18-month time limit; or

2) where a given application has been pending for a sufficient number of months (possibly 14 or 15 months) without approval that there is no longer any possibility of the mark being registered before the expiry of the 18 month time limit.

With respect to the second requirement (i.e. to provide the IB with the dates on which the opposition period begins and ends), the CTMO would probably only wish to provide this information if, and at the same time as, it makes any notification of a provisional refusal based on an opposition. One important reason for this is that, under the current CTMA (bearing in mind particularly the possibilities of withdrawals from allowance under s.39(3) CTMA and retroactive extensions of time under s.47(2) CTMA), the CTMO would not be in a position to identify end dates of opposition periods with any certainty until after registration. As noted in the following paragraph, Canadian adherence to Madrid would require some limitations on the granting of extensions of time to file statements of opposition and possibly some changes to s.39(3) CTMA but those changes may not completely eliminate all potential problems in identifying end dates of opposition periods.

With respect to the third requirement (i.e. to notify the IB of the grounds of refusal raised in the opposition before the earlier of seven months from the date of advertisement of the application and one month from the expiry of the opposition period), in practice this means that extensions of time for filing statements of opposition would have to be limited to a total of three or four months beyond the initial two month period provided under s.38(1) CTMA and the CTMO would have to put in place a very tight system for monitoring the filing of statements of opposition in order to ensure that the IB is notified of the grounds of refusal within the seven month period following the date of advertisement. It is to be noted that these grounds of refusal need be provisional only and could be withdrawn at any time but no new grounds of opposition could be raised more than seven months after the date of advertisement. The Trade-marks Opposition Board would thus not be able to keep its current discretion to authorize new grounds of opposition to be added at a later stage. S.39(3) CTMA might also need modification since it would not be possible to withdraw an application from allowance to consider a missed request for an extension of time to file a statement of opposition more than seven months after the date of advertisement; as well, a withdrawal from allowance would probably not be possible once the IB has been notified that the opposition period expired without an opposition having been filed. In addition, some restrictions would need to apply in respect of the grant under subsection 47(2) CTMA of retroactive extensions of time to file a statement of opposition.

Under Article 5(5) of the Protocol, if the CTMO failed to notify a provisional or final refusal within the specified time limits, the CTMO would lose its right (at both the examination and the opposition stage) to object to the request for the extension of protection of the international registration to Canada. This would not however affect the ability of Canadian courts to later invalidate the effects of the international registration in Canada for any reason.

6. Grounds of Refusal

Article 5(1) of the Protocol provides: "...Any such refusal can be based only on the grounds which would apply, under the Paris Convention for the Protection of Industrial Property, in the case of a mark deposited direct with the Office which notifies the refusal. However, protection may not be refused, even partially, by reason only that the applicable legislation would permit registration only in a limited number of classes or for a limited number of goods or services."

The key provision in the Paris Convention having an effect on the grounds of refusal that are potentially available is Article 6^{quinquies} which provides that trademarks duly registered in the country of origin may be refused protection only on the following grounds:

"1. when they are of such a nature as to infringe rights acquired by third parties in the country where protection is claimed;

2. when they are devoid of any distinctive character, or consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, place of origin, of the goods, or the time of production, or have become customary in the current language or in the bone fide and established practices of the trade of the country where protection is claimed;

3. when they are contrary to morality or public order and, in particular, of such a nature as to deceive the public. It is understood that a mark may not be considered contrary to public order for the sole reason that it does not conform to a provision of the legislation on marks, except if such provision itself relates to public order."

Article 6^{quinquies} B also provides that the above is subject to the application of Article 10bis, meaning that protection may be refused if registration of the mark would be contrary to honest practices in industrial or commercial matters.

Although on its face, Article 6^{quinquies} appears to be very far reaching, it has traditionally been accepted to have application only to requirements relating to the *form* of the mark and not to any other requirements such as requirements relating to use. In this regard, reference may be made to Bodenhausen, *Guide to the Application of the Paris Convention for the Protection of Industrial Property* at page 110 where it is stated:

"Whenever a trademark is duly registered in the country of origin, the other countries of the Union are obliged to accept and protect it, even if, as regards its form, that is, with regard to the signs of which it is composed, such trademark does not comply with the requirements of the domestic legislation, subject to the additional rules, particularly the grounds for refusal or invalidation of any mark, considered on its individual merits, established by the Article. This rule will therefore apply to trademarks consisting of numbers, letters, surnames, geographical names, words written or not written in a certain language or script, and other signs of which the trademark is composed.

The member States are, however, not obliged to interpret the notion of a trademark in a manner which differs from that of their national legislation. If therefore a three-dimensional object as such, or a "signature tune," is registered as a trademark in the country of origin but is not considered a "trademark" in another country, this latter country is not obliged to register and protect these subjects. Member States are equally free, regardless of Article 6^{quinquies}, to apply to trademark applications other provisions of their domestic law not concerning the signs of which a trademark is composed, such as a requirement of previous use of the mark, or the condition that the applicant must possess an industrial or commercial enterprise."

This view that Article 6^{quinquies} of the Paris Convention concerns only the form of the mark was accepted in a January 2, 2002 report of the Appellate Body of the World Trade Organization in *United States - Section 211 Omnibus Appropriations Act of 1998*, AB-2001-7.

Under the Canadian Trade-marks Act, there are a number of requirements concerning the signs of which a mark is composed, such as those found in section 12 of the Canadian Trade-marks Act. All of these, however, appear to be easily justifiable as falling within one of the exceptions allowed under Article 6^{quinquies} of the Paris Convention. Accordingly, it would appear that neither the incorporation of Article 6^{quinquies} of the Paris Convention through Article 5(1) of the Protocol nor anything else in the Protocol would prevent the CTMO from raising any ground of refusal that is currently available as a ground of refusal under the CTMA. However, under the Protocol and the Madrid Regulations as they currently stand, it could be impractical to raise certain grounds of refusal. Further, a number of constraints would also be created if Canada were to adhere to the TLT. [Detailed discussion of these issues is found below in Parts IV, V and VI.]

7. Contents of Notifications of Provisional Refusal

Rules 17(1), (2) and (3) of the Madrid Regulations set forth what must be contained in notifications of provisional refusal:

“(1) [Notification of Provisional Refusal] (a) A notification of provisional refusal may comprise a declaration stating the grounds on which the Office making the notification considers that protection cannot be granted in the Contracting Party concerned (“ex officio provisional refusal) or a declaration that protection cannot be granted in the Contracting Party concerned because an opposition has been filed (“provisional refusal based on an opposition”) or both.

(b) A notification of provisional refusal shall relate to one international registration, shall be dated and shall be signed by the Office making it.

(2) [Contents of the Notification] A notification of provisional refusal shall contain or indicate

- (i) the Office making the notification,
- (ii) the number of the international registration, preferably accompanied by other indications enabling the identity of the international registration to be confirmed, such as the verbal elements of the mark or the basic application or basic registration number,
- (iii) [Deleted]
- (iv) all the grounds on which the provisional refusal is based together with a reference to the corresponding essential provisions of the law,
- (v) where the grounds on which the provisional refusal is based relate to a mark which has been the subject of an application or registration and with which the mark that is the subject of the international registration appears to be in conflict, the filing date and number, the priority date (if any), the registration date and number (if available), the name and address of the owner, and a reproduction, of the former mark, together with the list of all or the relevant goods and services in the application or registration of the former mark, it being understood that the said list may be in the language of the said application or registration,
- (vi) either that the grounds on which the provisional refusal is based affect all the goods and services or an indication of the goods and services which are affected, or are not affected, by the provisional refusal,
- (vii) the time limit, reasonable under the circumstances, for filing a request for review of, or appeal against, the ex officio refusal or the provisional refusal based on an opposition and, as the case may be, for filing a response to the opposition, preferably with an indication of the date on which the said time limit expires, and the authority with which such request for review, appeal or response should be filed, with the indication, where applicable, that the request for review, the appeal or the response has to be filed through the intermediary of a representative whose address is within the territory of the Contracting Party whose Office has pronounced the refusal.

(3) [Additional Requirements Concerning a Notification of Provisional Refusal Based on an Opposition] Where the provisional refusal of protection is based on an opposition, or on an opposition and other grounds, the notification shall, in addition to complying with the requirements referred to in paragraph (2), contain an indication of that fact and the name and address of the opponent...”

Rule 18 of the Madrid Regulations sets out the consequences, and the process to be followed, for irregular notifications of provisional refusal.

8. Confirmation or Withdrawal of Provisional Refusal

Rule 17(5) of the Madrid Regulations provides:

“[Confirmation or Withdrawal of Provisional Refusal] (a) An Office which has sent to the International Bureau a notification of provisional refusal shall, once all procedures before the said Office relating to the protection of the mark have been completed, send to the International Bureau a statement indicating either

- (i) that protection of the mark is refused in the Contracting Party concerned for all goods and services:
- (ii) that the mark is protected in the Contracting Party concerned for all goods and services requested, or
- (iii) the goods and services for which the mark is protected in the Contracting Party concerned.

(b) Where, following the sending of a statement in accordance with subparagraph (a), a further decision affects the protection of the mark, the Office shall, to the extent it is aware of that decision, send to the International Bureau a further statement indicating the goods and services for which the mark is protected in the Contracting Party concerned.”

Rule 17(5) of the Madrid Regulations is a new provision that was approved by a WIPO Working Group at a meeting in June 2001. In paragraph 40 of the official report (WIPO document MM/WW/2/6) of that meeting, it is stated in relation to Rule 17(5):

“Summarizing the discussion, the Chair noted that there was a consensus that Offices should send information to

the International Bureau once a situation had been reached where what was in practice likely to be a final decision had been taken. It was up to each Office to decide when this stage had been reached and in particular to determine whether the proceedings of a Trial and Appeal Board amounted to “procedures before the Office.””

The intention here would appear to be to give contracting parties flexibility to exclude (for the purposes of determining under Rule 17(5)(a) when all procedures before the office have been completed) procedures before opposition boards that are legally constituted external to the trademark office. In the current Canadian context, it appears clear that proceedings before the Trade-marks Opposition Board should be treated as being included in “procedures before the Office” (bearing in mind that, under the CTMA, actions of both the CTMO at the examination stage and the Board at the opposition stage are legally actions of the Registrar of Trade-marks) and the following analysis proceeds on that assumption.

In order to comply with Rule 17(5)(a) of the Madrid Regulations, whenever the CTMO sent a notification of provisional refusal, whether on the basis of an office action or on grounds raised in an opposition, the CTMO would subsequently need to inform the IB of the decision that terminated procedures before the CTMO. In the context of an international registration designating Canada, the decision that would terminate procedures before the CTMO would be either 1) a decision to refuse the protection of the mark in Canada for all requested goods and services; 2) a decision to grant the protection of the mark in Canada in respect of all requested goods and services; or 3) a decision to grant the protection of the mark in Canada in respect of some but not all of the requested goods and services. These decisions would ordinarily (i.e. ignoring the possibility of a court ordering a procedure to be re-started) correspond, respectively, to the following decisions under the existing Canadian national procedures: 1) a decision to refuse an application under s.37(1) or s.38(8) CTMA in respect of all the wares and services covered by the application [This would normally be a decision of the Registrar of Trade-marks but, bearing in mind s.39(1) CTMA, it could effectively also be a court decision overturning the rejection of an opposition by the Registrar of Trade-marks]; 2) the registration of a trademark in accordance with s.40 CTMA in respect of all of the wares and services covered by the application; or 3) the registration of a trademark in accordance with s.40 CTMA in respect of some of the wares and services covered by the application as initially filed [This could happen as a result of a voluntary amendment by the applicant to limit the list of wares and services or following a decision to refuse the application under s.37(1) or s.38(8) in respect of some of the wares and services covered by the application].

The latter mentioned situation of a refusal for some wares and services followed by a registration for the remaining wares and services is not explicitly provided for in the CTMA; however, there has been a long-standing practice of the Trade-marks Opposition Board to make split decisions of this nature under s.38(8) CTMA and this practice appears to have been accepted by the Federal Court (See *Produits Menagers Coronet Inc. v. Coronet-Werke Heinrich Schlerf GmbH* (1986), 10 C.P.R. (3d) 482). Should Canada decide to adhere to the Protocol, some consideration should be given to amending the CTMA to explicitly set out what, if anything, is acceptable in terms of split decisions. Consideration in this regard should also take into account the requirements of TLT Article 7 in accordance with which applicants must be permitted to divide applications by distributing among one or more divisional applications (all having the same filing date and any right of priority) the goods and/or services listed in the initial application.

In order to comply with Rule 17(5)(b) of the Madrid Regulations, the CTMO would need to advise the IB of any decisions of the Federal Court or the Supreme Court of Canada that were made after a decision terminating procedures before the CTMO in respect of an international registration designating Canada and that affected the protection of the mark. This would primarily seem to cover the equivalent of court decisions based on appeals of decisions to refuse an application under s.37(1) or 38(8) CTMA. Court decisions upholding, on appeal, decisions by the Registrar of Trade-marks under s.38(8) CTMA to reject an opposition would not appear to need to be notified since they would precede the decision (i.e. registration) terminating procedures before the CTMO. As discussed above, court decisions overturning decisions by the Registrar of Trade-marks under s.38(8) CTMA to reject an opposition would appear to require notification pursuant to Rule 17(5)(a)(i) of the Madrid Regulations since in view of s.39(1) CTMA they would effectively terminate procedures before the office. Court decisions invalidating the effects of an international registration in Canada (the equivalent of the expungement of a trademark registration pursuant to s.57 CTMA) would arguably also in some circumstances fall within the scope of Rule 17(5)(b) of the Madrid Regulations but this would be of no significance since as discussed below under the heading “Invalidation in Canada of Effects of International Registration” Protocol Article 5(6) in any event requires all invalidations to be notified to the IB.

In order for the CTMO to obtain the information necessary to permit notifications of the equivalent of court decisions based on appeals of decisions to refuse an application under s.37(1) or 38(8) CTMA, it would be important to ensure that s.61 CTMA (which requires the Registry of the Federal Court to file with the Registrar of Trade-marks a copy of every judgment or order made by the Federal Court or by the Supreme Court of Canada relating to any trademark on the register) applied to such decisions.

9. Statement of Grant of Protection Where No Provisional Refusal

Where the office of a designated contracting party decides that it is not going to refuse protection to an international registration or a subsequent designation, the mark will be automatically protected in that contracting party at the end of the time limit for refusal that applies in accordance with Article 5(2) of the Protocol. There is therefore no requirement for an office to issue any notification when it decides that it is not going to refuse protection. Rule 17(6) of the Madrid Regulations does, however, provide an optional procedure allowing an office, once it has made a decision not to refuse protection, to send to the IB a statement of grant of protection, which will be recorded in the International Register, published in the Gazette and transmitted by the IB to the holder.

In particular, Rule 17(6) of the Madrid Regulations would permit an office to send to the IB any of the following:

- “(i) a statement to the effect that all procedures before the Office have been completed and that the Office has decided to grant protection to the mark that is the subject of the international registration;
- (ii) a statement to the effect that the ex officio examination has been completed and that the Office has found no grounds for refusal but that the protection of the mark is still subject to opposition or observations by third parties, with an indication of the date by which such oppositions may be filed;
- (iii) where a statement in accordance with subparagraph (ii) has been sent, a further statement to the effect that the opposition period has expired without any opposition or observations being filed and that the Office has therefore decided to grant protection to the mark that is the subject of the international registration.”

From a holder’s point of view, a statement of grant of protection could be very useful in providing early notice in situations where the office makes a decision not to refuse protection well before the end of the relevant time limit for refusal and the holder would otherwise have to wait until the end of the refusal period to know whether a notification of refusal will be issued. The CTMO would therefore want to give consideration to sending a statement of grant of protection in appropriate cases. In accordance with Rule 17(6) of the Madrid Regulations, the CTMO could decide to send a statement only after all procedures before the office had been completed (i.e. at the time of registration) or it could decide to send a first statement after completion of the examination stage (i.e. at approval for advertisement) together with a further statement after the opposition period had expired with no opposition having been filed (this would in practice be at registration since in view of s.39(3) CTMA it would only be at registration that the CTMO could say with any certainty that the opposition period had expired).

10. Invalidation in Canada of Effects of International Registration

The Protocol would place no restrictions on the ability of Canadian courts to invalidate for any reason the effects of an international registration in Canada. The only restriction on invalidation would be, according to Article 5(6) of the Protocol, that it “may not be pronounced without the holder of such international registration having, in good time, been afforded the opportunity of defending his rights.”

Article 5(6) of the Protocol and Rule 19(1) of the Madrid Regulations would require the CTMO to notify the IB of any decision by the Federal Court or the Supreme Court of Canada to invalidate, in whole or in part, the effects in Canada of an international registration. This would be the equivalent of a decision to expunge a trademark registration in accordance with s.57 CTMA. In order for the CTMO to obtain the information necessary to permit such notifications, it would be important to ensure that s.61 CTMA applied to decisions invalidating the effects in Canada of international registrations.

11. Transformation from an International Application to a Canadian National Application

Where Canada was designated in an international application and the international registration was cancelled (in respect of some or all of the goods and services listed in the registration) at the request of the office of origin under Article 6(4) of the Protocol, Article 9^{quinquies} would give the holder of the cancelled international registration three months to file a replacement national application in the CTMO in respect of those goods or services for which the registration was cancelled. The CTMO would be required to accord to this national application the same filing and priority dates to which the international registration was entitled.

12. Advertisement

As noted above under the heading “Implications of Effective Delay in Notification”, because of the backdating of international registrations and recordals of subsequent designations and because of the six-month priority period, the CTMO may wish (but wouldn’t be required) to delay advertisement of applications, both domestically filed and internationally filed, in the Trade-marks Journal (for at least eight months from the earlier of the date of first use, the date of making known and the filing and priority dates of an application) in order to be sure that at least most potential conflicts with later international registrations claiming priority have been considered.

Article 3(4) of the Protocol provides: “Marks registered in the International Register shall be published in a

periodical gazette issued by the International Bureau, on the basis of the particulars contained the international application.” This periodical gazette is currently called “WIPO Gazette of International Marks” and its required contents are specified in Rule 32 of the Madrid Regulations.

Article 3(5) of the Protocol provides: “With a view to the publicity to be given to marks registered in the International Register, each Office shall receive from the International Bureau a number of copies of the said gazette free of charge and a number of copies at a reduced price, under the conditions fixed by the Assembly referred to in Article 10.... Such publicity shall be deemed to be sufficient for the purposes of all the Contracting Parties, and no other publicity may be required of the holder of the international registration.”

Even though international registrations and recordals of subsequent designations would have been advertised in the WIPO Gazette of International Marks, it may nevertheless be desirable to re-advertise international registrations and recordals of subsequent designations in the Trade-marks Journal 1) to give adequate notice that the request for extension of protection to Canada may be opposed; and 2) because the listing of the wares and services may have changed after examination by the CTMO. This re-advertisement would need not necessarily include all the particulars of the international application but could instead make a reference to the publication in Les Marques Internationales together with an indication of any subsequent changes to the list of goods and services. No fee can be charged for any such re-advertisement in view of Article 3(5) of the Protocol.

13. Replacement of a Canadian Registration by an International Registration

Article 4^{bis} of the Protocol provides:

“(1) Where a mark that is the subject of a national or regional registration in the Office of a Contracting Party is also the subject of an international registration and both registrations stand in the name of the same person, the international registration is deemed to replace the national or regional registration, without prejudice to any rights acquired by virtue of the latter, provided that:

- (i) the protection resulting from the international registration extends to the said Contracting Party under Article 3ter(1) or (2),
- (ii) all the goods and services listed in the national or regional registration are also listed in the international registration in respect of the said Contracting Party,
- (iii) such extension takes effect after the date of the national or regional registration.

(2) The Office referred to in paragraph (1) shall, upon request, be required to take note in its register of the international registration.”

If Canada were to adhere to the Protocol, it would appear to be appropriate to include in the Trade-marks Act a provision which would give effect to Article 4^{bis} of the Protocol, so that the owner of a national registration in Canada which is replaced by the designation effect of an international registration would keep the benefit of the date of the earlier national registration and could obtain a recording of that effect in the Canadian trademark register.

14. Fees

Articles 8(4),(5) and (6) of the Protocol provide for the distribution to contracting parties of the complementary and supplementary fees as well as any surplus of the basic fees after deduction of the IB’s expenses. Article 8(7)(a) allows contracting parties, in connection with international registrations and renewals of international registrations, to replace their share in the revenues produced by the supplementary and complementary fees by an individual fee set by that contracting party. This individual fee “may not be higher than the equivalent of the amount which the said Contracting Party’s Office would be entitled to receive for a ten-year registration, or from the holder of a registration for a ten-year renewal of that registration, of the mark in the register of the said Office, the said amount being diminished by the savings resulting from the international procedure.” Canada will very likely wish to ask for individual fees.

[See also the discussion of fees above in Part II.]

15. Transitional Provision

In accordance with Article 14(5) of the Protocol, Canada could when adhering to the Protocol “declare that the protection resulting from any international registration effected under this Protocol before the date of entry into force of this Protocol with respect to it cannot be extended to it”. Such a declaration could be made by Canada with permanent effect or only for a temporary period of time.

To date only three countries have made a declaration under Article 14(5): Estonia, Hungary and Turkey. One

apparent difficulty with making a declaration under Article 14(5) is that it would appear to apply only to international registrations effected under the Protocol. Thus it appears to place a restriction in respect of the relatively small number of registrations effected under the Protocol since April 1996 but does not affect the hundreds of thousands of registrations made under the Madrid Agreement, whether before or after that date.

IV CONTENTS OF APPLICATIONS (ACCEPTABILITY OF CURRENT CANADIAN REQUIREMENTS)

1. Statement of Specific Wares or Services

S.30(a) CTMA requires “a statement in ordinary commercial terms of the specific wares or services in association with which the mark has been or is proposed to be used.”

This requirement can be maintained under both the TLT and the Protocol.

In accordance with Rule 13 of the Madrid Regulations, the IB will suggest amendment of terms in an international application that are too vague for the purposes of classification, incomprehensible or linguistically incorrect and will invite the office of Origin to propose changes within three months. Where the final term used is not acceptable to Canada, a provisional refusal could be issued.

None of the NAFTA, TRIPS or Paris Convention deal with this question.

[For a detailed discussion see below under the heading “Identification of Goods and Services”.]

2. Use in Canada and Making Known in Canada

S.30(b) CTMA requires “in the case of a trade-mark that has been used in Canada, the date from which the applicant or his named predecessors in title, if any, have so used the trade-mark in association with each of the general classes of wares or services described in the application.”

S.30(c) TMA requires “in the case of a trade-mark that has not been used in Canada but is made known in Canada, the name of a country of the Union in which it has been used by the applicant or his named predecessors in title, if any, and the date from and the manner in which the applicant or named predecessors in title have made it known in Canada in association with each of the general classes of wares or services described in the application.”

TLT

TLT Article 3 contains certain restrictions on what a contracting party can require in relation to use requirements. The key provisions in Article 3 are set out below:

“(1)(a) Any Contracting Party may require that an application contain some or all of the following indications or elements:

...
(xvii) a declaration of intention to use the mark, as required by the law of the Contracting Party.

(b) The applicant may file, instead of or in addition to the declaration of intention to use the mark referred to in subparagraph (a)(xvii), a declaration of actual use of the mark and evidence to that effect, as required by the law of the Contracting Party.

...

(6) Any Contracting Party may require that, where a declaration of intention to use has been filed under paragraph (1)(a)(xvii), the applicant furnish to the Office within a time limited fixed in its law, subject to the minimum time limit prescribed in the Regulations, evidence of the actual use of the mark, as required by the said law.

(7) No Contracting Party may demand that requirements other than those referred to in paragraphs (1) to (4) and (6) be complied with in respect of the application. ...”

TLT Rule 3(6) further provides:

“The time limit referred to in Article 3(6) shall not be shorter than six months counted from the date of allowance of the application by the Office of the Contracting Party where that application was filed. The applicant or holder shall

have the right to an extension of that time limit, subject to the conditions provided for by the law of that Contracting Party, by periods of at least six months each, up to a total extension of at least two years and a half.”

Canada could, consistent with TLT Article 3, continue to require, in every case where a trademark was used before the filing date of the application, that the date of first use be provided, either as a part of the declaration of actual use referred to in TLT Article 3(1)(b) or as part of the evidence of actual use referred to in TLT Article 3(6). In accordance with TLT Rule 3(6), however, Canada would have to give an applicant until at least until three years after the notice of allowance of the application to provide the date of first use. This means that until the end of the three-year period, Canada would (even in the case of mark that had been used in Canada prior to the filing date) have to accept a mere declaration of intention to use the mark without any indication that the mark had been used or what the date of first use was. If Canada were to consider this problematic, one way to at least partly get around the TLT restrictions would be to provide some special incentive for an applicant to voluntarily provide the date of first use information at an early date (e.g. one might provide that in examination and opposition proceedings, an applicant's rights would be assessed as of the filing or priority date of the application unless an earlier date of first use had been provided at or shortly after the time of filing).

TLT Article 3 would appear to prohibit Canada from maintaining s.30(c) CTMA as a mandatory requirement, i.e. Canada could not require that the information specified in s.30(c) be provided in every case where a trademark has not been used in Canada but is made known in Canada. The apparent objectives of s.30(c) might still however be met if Canada were:

1) to generally require applicants to file a statement that use had commenced in Canada, either as a part of the declaration of actual use referred to in TLT Article 3(1)(b) or as part of the evidence of actual use referred to in TLT Article 3(6); and

2) to exempt an applicant from the requirement above in 1) if the applicant were to provide the information specified in s.30(c) CTMA.

In passing, it is noted that it might be desirable to give some consideration to removing “making known” as a basis of filing a trademark application in Canada, bearing in mind that no international obligation requires Canada to have such a basis and that it appears that no other country currently has such a basis in its law.

Since TLT Article 9(1) requires that registrations and publications group goods and services according to the classes of the Nice Classification, any requirement to provide dates of first use or s.30(c) CTMA information would probably be better linked with the Nice classes rather than the current vague “general classes”.

Protocol

There is no provision under the Madrid Regulations for ss.30 (b) and (c) CTMA information to be included in an international application. It would be consistent with the Protocol to amend the Regulations to require this information to be provided whenever Canada was designated but a Canadian request to make an amendment for such a mandatory requirement would likely face considerable opposition from other contracting parties. Even an amendment to permit the information to be included as an optional element in the international application when Canada was designated could face opposition from other contracting parties.

Regardless of whether the Madrid Regulations required or allowed ss.30 (b) and (c) CTMA information to be included in international applications when Canada was designated, Canada could (subject to the above-discussed limitations under the TLT) issue provisional refusals if the information was not provided. If this were to be done, Canada could try to reduce the number of provisional refusals by increasing international awareness of these special Canadian requirements e.g. by requesting the IB to include a notice in its Madrid Guide; applicants could then choose to send the information directly to Canada if it cannot be included in the international application. Issuing provisional refusals to obtain ss.30 (b) and (c) CTMA information could, however, place a considerable additional workload on the CTMO and make quite complicated the use of the Protocol for international applications designating Canada.

As an alternative to having a mandatory requirement to provide ss.30 (b) and (c) CTMA information, Canada could provide some special incentive for providing at least some portions of this information. One possible incentive for applicants to provide at least date of first use information would be to provide that, in examination and opposition proceedings, an international applicant's rights would be assessed as of the international registration or recordal date unless a date of first use was provided. If Canada were to do this, it would probably ask the IB to include a notice in the Madrid Guide suggesting to applicants that they send date of first use information directly to the CTMO. Canada might also try (despite the possible opposition as discussed above) to have Rule 9 amended to permit date of first use information for Canada to be included, at the option of the applicant, in the international application (probably in

addition to or as an alternative to a statement of intention to use which as discussed below could be required under Rule 7(2) of the Madrid Regulations).

TRIPS and NAFTA

Ss.30(b) and (c) CTMA are both consistent with TRIPS and NAFTA. Some important restrictions on use requirements are however found in TRIPS Article 15.3 and in the almost identical NAFTA Article 1708.3. TRIPS Article 15.3 provides:

“Members may make registrability depend on use. However, actual use of a trademark shall not be a condition for filing an application for registration. An application shall not be refused solely on the ground that intended use has not taken place before the expiry of a period of three years from the date of application.”

Paris Convention

The Paris Convention does not deal with this question. In particular, as discussed above under the heading “Grounds of Refusal”, Article 6^{quinquies} of the Paris Convention has no application in respect of use requirements.

[For a related discussion see the heading “Requirements for Use: Before Registration”.]

3. Registration and Use Abroad

S.30(d) CTMA requires “in the case of a trade-mark that is the subject in another country of the Union of a registration or an application for registration by the applicant or his named predecessor in title on which the applicant bases his right to registration, particulars of the application or registration and, if the trade-mark has neither been used nor made known in Canada, the name of a country in which the trade-mark has been used by the applicant or his named predecessor in title, if any in association with each of the general classes of wares or services described in the application.”

S.31(1) CTMA provides “An applicant whose right to registration of a trade-mark is based on a registration of the trade-mark in another country of the Union shall, before the date of advertisement of his application in accordance with section 37, furnish a copy of the registration certified by the office in which it was made, together with a translation thereof into English or French if it is in any other language, and such other evidence as the Registrar may require to establish fully his right to registration under this Act.”

Paris Convention

Both s.30(d) and 31(1) are consistent with the Paris Convention.

Even where an application is based on a registration in the country of origin, it would seem that there are no limitations in the Paris Convention on the ability of a contracting party to require use of a trademark before registration. As discussed above under the heading “Grounds of Refusal”, the limitations in Article 6^{quinquies} of the Paris Convention do not apply because they relate only to questions of form. S.16(2) CTMA is accordingly not required in order for Canada to comply with its obligations under the Paris Convention.

TLT

S.30(d) CTMA would appear to be consistent with the TLT since it only applies if one *chooses* to base an application upon registration and use abroad under s.16(2) CTMA. It is noted that the only reason for doing this would be to avoid the requirement to use the mark in Canada before registration, which requirement is expressly permitted under TLT Articles 3(1)(b) and 3(6).

s.31(1) CTMA appears to be inconsistent with TLT Article 3(7)(iv) which provides:

“...In particular, the following may not be required in respect of the application throughout its pendency:

...
(iv) the furnishing of evidence to the effect that the mark has been registered in the register of marks of another Contracting Party or of a State party to the Paris Convention which is not a Contracting Party, except where the applicant claims the application of Article 6^{quinquies} of the Paris Convention.”

An applicant who bases an application in Canada on a foreign registration for the purposes of s.16(2) CTMA would not appear, even implicitly, to be claiming the application of Article 6^{quinquies} of the Paris Convention. The

purpose of basing an application on a foreign registration would in essence appear to be to avoid the normal requirement that a mark must be used in Canada before registration. As discussed above, however, under the heading “Grounds of Refusal”, Article 6 of the Paris Convention has no application in respect of use requirements.

Protocol

Under the Protocol, reliable information would automatically be provided concerning the basic application or registration and there would seem to be no reason to require the evidence referred to in s.31(1) CTMA.

The Madrid Regulations do not explicitly provide for the use information required under s.30(d) CTMA to be included in an international application. It would be consistent with the Protocol to amend the Madrid Regulations to explicitly require or allow this information to be provided in an international application designating Canada but one could expect that any proposal for such an amendment would face opposition from other contracting parties.

One possible mechanism by which Canada might arrange to have this information included in an international application would be for Canada to require (pursuant to Rules 7(2) and 9(5)(f) of the Madrid Regulations) international applications designating Canada to include a declaration of intention to use and to specify as the exact wording of the required declaration a statement to the following effect: “The applicant, or the applicant’s predecessor in title, has used the trademark in association with (named goods or services) in (named country or countries) and the applicant, by itself or through a licensee, or by itself and through a licensee, intends to use the trademark in Canada.” Whether specifying such wording would be consistent with existing Rule 7(2) of the Madrid Regulations is a question that would require careful study.

Regardless of whether some mechanism is found to allow or require s.30(d) CTMA information to be included in international applications designating Canada, Canada could refuse to give the benefit of s.16(2) (i.e. an exemption from the requirement to establish use in Canada before registration) to anyone who does not comply with s.30(d). How this would work in practice would depend on the approach taken with respect to requiring use before registration. At least some changes would probably be needed to the current approach particularly bearing in mind the limited filing date requirements permitted by TLT Article 5 and s.25(a)(iii) CTMR which provides that in order to obtain a filing date, an applicant must, except in the case of a proposed trademark, furnish either a date of first use or making known or the pertinent s.16(2) CTMA information.

Other

Neither the NAFTA or TRIPS deal with this question (except to the extent that they incorporate the Paris Convention).

[For a related discussion see the heading “Requirement to Use Before Registration”.]

4. Proposed Use

S.30(e) CTMA requires “in the case of a proposed trade-mark, a statement that the applicant, by itself or through a licensee, or by itself and through a licensee, intends to use the trade-mark in Canada.”

Ss.40(2)&(3) TMA provide:

“(2) When an application for registration of a proposed trade-mark is allowed, the Registrar shall give notice to the applicant accordingly and shall register the trade-mark and issue a certificate of registration on receipt of a declaration that the use of the trade-mark in Canada, in association with the wares or services specified in the application, has been commenced by

- (a) the applicant;**
- (b) the applicant’s successor in title; or**
- (c) an entity that is licensed by or with the authority of the applicant to use the trade-mark, if the applicant has direct or indirect control of the character or quality of the wares or services.**

“(3) An application for registration of a proposed trade-mark shall be deemed to be abandoned if the Registrar has not received the declaration referred to in subsection (2) before the later of

- (a) six months after the notice by the Registrar referred to in subsection (2), and**
- (b) three years after the date of filing of the application in Canada.”**

TLT

TLT Article 3(1)(a)(xvii) permits contracting parties to require “a declaration of intention to use the mark, as required by the law of the Contracting Party.”

TLT Article 3(6) provides:

“Any Contracting Party may require that, where a declaration of intention to use has been filed under paragraph (1)(a)(xvii), the applicant furnish to the Office within a time limited fixed in its law, subject to the minimum time limit prescribed in the Regulations, evidence of the actual use of the mark, as required by the said law.”

TLT Rule 3(6) provides:

“The time limit referred to in Article 3(6) shall not be shorter than six months counted from the date of allowance of the application by the Office of the Contracting Party where that application was filed. The applicant or holder shall have the right to an extension of that time limit, subject to the conditions provided for by the law of that Contracting Party, by periods of at least six months each, up to a total extension of at least two years and a half.”

S.30(e) CTMA is acceptable in view of TLT Article 3(1)(a)(vii). Ss.40 (2) and (3) CTMA are generally acceptable in view of TLT Article (6) and TLT Rule 3(6) with the exception that minimum time limit for filing a declaration of use set out in s.40(3)(b) would need to be changed to three years after the allowance of the application.

Protocol - Declaration of Intention to Use (s.30(e)CTMA)

Rule 9(5)(f) of the Madrid Regulations provides:

“Where the international application contains the designation of a Contracting Party that has made a notification under Rule 7(2), the international application shall also contain a declaration of intention to use the mark in the territory of that Contracting Party; the declaration shall be considered part of the designation of the Contracting Party requiring it and shall, as required by that Contracting Party,

(i) be signed by the applicant himself and be made on a separate official form annexed to the international application, or

(ii) be included in the international application.”

In box 11 (which is for the designation of contracting parties) of the current official application form for international registrations governed exclusively by the Protocol (See Annex II), there is an asterisk beside the indications “Singapore” and “United Kingdom” and a footnote at the bottom that reads: “* By designating Singapore or the United Kingdom, the applicant declares that he has the intention that the mark will be used by him or with his consent in the United Kingdom in connection with the goods and services identified in this application.”

Rule 7(2) of the Madrid Regulations provides:

“Where a Contracting Party requires, as a Contracting Party designated under the Protocol, a declaration of intention to use the mark, it shall notify that requirement to the Director General. Where that Contracting Party requires the declaration to be signed by the applicant himself and to be made on a separate official form annexed to the international application, the notification shall contain a statement to that effect and shall specify the exact wording of the required declaration. ...”

In accordance with the above, Canada could insist that all international applications designating Canada have annexed to them a separate official form containing the statement set out in s.30(e). It may be possible to provide for this statement to also be included in the international application itself but this is a matter that would have to be discussed with the IB. Consideration might also be given to whether the current statement included in box 11 would, if made applicable to Canada, satisfy the requirements of s.30(e) CTMA or, if not, whether s.30(e) might be amended so that it would.

S.30(e) CTMA only requires that a statement of intention to use be made in the case of an application based on proposed use. The statement is not required in cases where the application is based on one or more of the other bases set out in s.16 CTMA, i.e., actual prior use, making known, or use and registration abroad. There is, however, under the current Madrid Regulations, no provision for basis of registration information to be included in international applications and thus there would be no mechanism for distinguishing at the international level between international applications designating Canada based on proposed use and applications based on any other basis. Accordingly, if in accordance with Rule 7(2) of the Madrid Regulations, Canada were to require, as a contracting party designated under the Protocol, a declaration of intention to use, this requirement would necessarily have to be imposed in respect of all international applications designating Canada and not just in respect of international applications that for Canadian purposes are based on proposed use.

Protocol - Declaration of Actual Use (ss.40(2)&(3)CTMA)

The very nature of a proposed use application means that a declaration of actual use could not be included in an international application.

Theoretically, Canada would have the right to issue a provisional refusal of protection under Article 5(1) of the Protocol for the reason that the applicant had not submitted a declaration of actual use but from a practical point of view doing so would appear to pose a number of serious difficulties. For example, although any such provisional refusal would need to be notified by the CTMO to the IB within 18-months after the IB notification to the CTMO of the international registration or recordal, in accordance with TRIPS, NAFTA and TLT obligations, Canada would have to allow an applicant a significantly longer period of time within which to file any declaration of actual use. This means that the CTMO would need to issue provisional refusals in a large number of cases and maintain these until declarations of actual use were eventually submitted directly by the applicant to the CTMO. This would place a considerable additional workload on the CTMO and make quite complicated the use of the Protocol for international applications designating Canada. It would thus not appear feasible to have the declaration of use requirements of ss.40(2) and (3) CTMA apply in respect of international applications designating Canada.

TRIPS and NAFTA

S.30(e) CTMA and ss.40(2) and (3) CTMA are consistent with TRIPS and NAFTA including in particular TRIPS Article 15.3 and the almost identical NAFTA Article 1708.3. TRIPS Article 15.3 provides:

“Members may make registrability depend on use. However, actual use of a trademark shall not be a condition for filing an application for registration. An application shall not be refused solely on the ground that intended use has not taken place before the expiry of a period of three years from the date of application.”

Other

The Paris Convention does not deal with this question. In particular, as discussed above under the heading “Grounds of Refusal”, Article 6 of the Paris Convention has no application in respect of use requirements.

[For a related discussion see the heading “Requirements for Use: Before Registration”.]

5. Certification Marks

S.30(f) CTMA requires “in the case of a certification mark, particulars of the defined standard that the use of the mark is intended to indicate and a statement that the applicant is not engaged in the manufacture, sale, leasing or hiring of wares or the performance of services such as those in association with which certification mark is used.”

Article 7^{bis} of the Paris Convention requires countries to protect collective marks (which term would seem to include Canadian certification marks) but leaves countries free to determine the conditions under which collective marks are to be protected.

TLT Article 2(2)(b) expressly excludes certification marks from its application.

The Protocol does not exclude certification marks from its application; however, it would not seem likely that much use of the Protocol would be made for certification marks. If Canada was to be designated in an international application for a certification mark, it could ensure compliance with the special requirements for certification marks by issuing provisional refusals.

Neither the NAFTA or TRIPS deal with this issue.

6. Address for Service

S.30(g) CTMA requires “the address of the applicant’s principal office or place of business in Canada, if any, and if the applicant has no place of business in Canada, the address of his principal office or place of business abroad and the name and address in Canada of a person or firm to whom any notice in respect of the application or registration may be sent, and on whom service of any proceedings in respect of the application or registration may be given or served with the same effect as if they had been given to or served on the applicant or registrant himself.”

Paris Convention, NAFTA, TRIPS

Article 2(3) Paris Convention, Article 1703(3) NAFTA and Article 3 TRIPS all allow a contracting party, as an exception to national treatment, to require trademark applicants to provide an address for service in that contracting party.

TLT

TLT Articles 3(1)(a)(ii) and (v) allow contracting parties to require an application to contain the applicant's address and, where required under Article 4(2)(b), an address for service. Article 4(2)(b) provides: "Any Contracting Party may, to the extent that it does not require representation ..., require that, for the purposes of any procedure before the Office, any person who has neither a domicile nor a real and effective industrial or commercial establishment on its territory have an address for service on that territory."

Subject to the comments in the following paragraph, s.30(g) CTMA appears to be consistent with the TLT. Although there is no definition of "address for service" in the TLT, it seems reasonable to characterize the Canadian requirement for "the name and address ... of a person or firm to whom any notice...may be sent" as being an address for service.

Under the TLT, the address for service is to be provided for the purposes of any procedure *before the office* whereas under s.30(g) CTMA the address for service is to be provided as well for the purposes of *court proceedings*. There would, however, not appear to be anything in the TLT that would prevent a contracting party from deeming an address for service provided for office proceedings (or alternatively, where a representative has been appointed, the address of a Canadian representative) to also be the address for service for court proceedings in the absence of a contrary direction from the applicant/registrant.

Protocol

Rule 9(4)(a)(ii) of the Madrid Regulations requires the international application to contain the address of the applicant, given in accordance with the Administrative Instructions. This address is not required to be in the territory of any particular jurisdiction; however if the address furnished for the purposes of Rule 9(4)(a)(ii) is not in the territory of the contracting party whose office is the office of origin and the applicant has a domicile or an establishment in the territory of that contracting party, Rule 9(4)(c) requires that domicile or the address of that establishment to be additionally given in the international application. Section 12(d) of the Administrative Instructions optionally permits the international application to contain, in addition, telephone and facsimile numbers, an e-mail address and a different address for correspondence.

No provision is made in the Madrid Regulations for the inclusion in the international application of an address for service in each designated contracting party. It would appear to be open to Canada to issue a provisional refusal if no address for service in Canada (for procedures before both the CTMO and the courts) is provided but this could create workload problems for the office and make quite complicated the use of the Protocol for international applications designating Canada. Should Canada decide to adhere to the Protocol, it might wish to explore having the Madrid Regulations revised to permit the international application to contain an address for service for each designated contracting party.

7. Reproductions and Descriptions of the Mark

S.30(h) CTMA requires "unless the application is for the registration only of a word or words not depicted in a special form, a drawing of the trade-mark and such number of accurate representations of the trade-mark as may be prescribed."

S. 27 CTMR provides:

"(1) Where a drawing of a trade-mark (1) is required by paragraph 30(h) of the Act, the drawing shall be in black and white, no larger than 2 3/4 inches by 2 3/4 inches or 7 cm x 7 cm, and shall not include any matter that is not part of the trade-mark, and may be on paper that satisfies the requirements of section 13 [i.e. white paper that measures at least 8 inches by 11 inches, or 21 cm by 28 cm, but not more than 8_ inches by 14 inches, or 22 cm by 35 cm, with left and upper margins of at least 1 inch or 2.5 cm].

(2) Where the drawing of the trade-mark on file is not suitable for reproduction in the Journal, the Registrar may require an applicant to file a new drawing."

S.28 CTMR provides:

“(1) Where the applicant claims a colour as a feature of the trade-mark, the colour shall be described.

(2) Where the description referred to in subsection (1) is not clear, the Registrar may require the applicant to file a drawing lined for colour in accordance with the following colour chart: ...”

S.29(c) CTMR provides:

“29. The Registrar may require an applicant for the registration of a trade-mark to furnish the Registrar ...

(c) a specimen of the trade-mark as used.”

TLT

TLT Articles 3(1)(a)(ix) to (xii) allow contracting parties to require an application to contain:

“(ix) where the Office of the Contracting Party uses characters (letters and numbers) that it considers as being standard and where the applicant wishes that the mark be registered and published in standard characters, a statement to that effect;

(x) where the applicant wishes to claim color as a distinctive feature of the mark, a statement to that effect as well as the name or names of the color or colors claimed and an indication, in respect of each color, of the principal parts of the mark which are in that color;

(xi) where the mark is a three-dimensional mark, a statement to that effect;

(xii) one or more reproductions of the mark;”

Details of the number and nature of the reproductions that can be required under TLT Article 3(1)(a)(xii) are set out in TLT Rules 3(2) and 3(3). Model International Form No1 (together with TLT Article 3(2)(i)) requires contracting parties to accept reproductions in a square that is approximately 8x8 centimetres. Although not stated explicitly, it would seem implicit that under the TLT no office would be obliged to accept a reproduction the quality of which is insufficient for the purposes of, inter alia, publication.

S.30(h) CTMA and ss.27 to 29 CTMR appear to be consistent with the TLT subject to the following:

i) When Model International Form No1 is used by an applicant, Canada would have to accept a reproduction contained in a square of 8x8 centimetres.

ii) Canada could not require drawings lined for color as could be required under s.28(2) CTMR. To cover situations where a description according to TLT Article 3(1)(a)(x) is not considered to be clear, the only option available would seem to be to give the Registrar the right to require a reproduction of the mark in color.

iii) It is not entirely clear to what extent specimens can be required under the TLT. TLT Rule 3(3)(d) specifically authorizes a requirement for a specimen in respect of three-dimensional marks in limited circumstances but there is otherwise no reference in the TLT or the TLT Regulations to specimens. It may be, however, that the requirement for specimens for the purpose of examination in s.29(c) CTMR could in at least some situations be justified as being an evidentiary requirement permitted by TLT Article 3(8). In any event it would not appear that the CTMO would face any significant difficulties if it could not generally require specimens.

The CTMO might prefer to receive drawings on a separate sheet of paper; such a requirement would not however appear to be consistent with Model International Form No1 which contains a place for the reproduction on the same page as other information.

Protocol

Rule 9(4)(a) of the Madrid Regulations requires (in part) the international application to contain:

“(v) a reproduction of the mark that shall fit in the box provided on the official form [i.e. in a 8 cm x 8cm square]; that reproduction shall be clear and shall, depending on whether the reproduction in the basic application or the basic registration is in black and white or in color, be in black and white or in color,

(vi) where the applicant wishes that the mark be considered as a mark in standard characters, a declaration to that effect,

(vii) where color is claimed as a distinctive feature of the mark in the basic application or basic registration or where the applicant wishes to claim color as a distinctive feature of the mark and the mark contained in the basic application or basic registration is in color, an indication that color is claimed and an indication by words of the color or combination of colors claimed and, where the reproduction furnished under item (v) is in black and white, one reproduction of the mark in color,

(viibis) where the mark that is the subject of the basic application or the basic registration consists of a color or a combination of colors as such, an indication to that effect,

(viii) where the basic application or the basic registration relates to a three-dimensional mark, the indication “three-dimensional mark,”

(ix) where the basic application or the basic registration relates to a sound mark, the indication “sound mark,”

...

(xi) where the basic application or the basic registration contains a description of the mark by words and the applicant wishes to include the description or the Office of origin requires the inclusion of the description, that same description, ...”

Rule 9(4)(b)(iv) of the Madrid Regulations permits an international application to also include “where the applicant claims color as a distinctive feature of the mark, an indication in words, in respect of each color, of the principal parts of the mark which are in that color.”

Article 3(3) of the Protocol provides: “If the applicant claims color as a distinctive feature of his mark, he shall be required (i) to state the fact, and to file with his international application a notice specifying the color or combinations of colors claimed; (ii) to append to his international application copies in color of the said mark, which shall be attached to the notification given by the International Bureau; the number of such copies shall be fixed by the Regulations.”

From a legal point of view, since Article 5(1) of the Protocol allows any ground of refusal that is not contrary to the Paris Convention and since the Paris Convention does not contain any provisions regarding the furnishing of reproductions, nothing in s.30(h) CTMA or ss.27 to 29 CTMR would be inconsistent with the Protocol or the Madrid Regulations. Practically, however, if Canada were to adhere to the Protocol, it would be difficult for Canada to maintain (for international applications designating Canada notified to it by the IB) requirements relating to the reproduction and description of marks different from those established for the filing of international applications. This means that in practice Canada would need to accept 8x8 centimetre reproductions and to accept color reproductions instead of drawings lined for color.

A requirement as in s.29 CTMR to furnish a specimen upon request would seem acceptable where, as is currently the CTMO practice, it is used only occasionally when the registrability of the mark cannot otherwise be properly assessed.

In accordance with Rule 9(4)(vi) of the Madrid Regulations, Canada would receive notifications of international applications designating Canada that contain a declaration that the applicant wishes that the mark be considered as a mark in standard characters. As a result, it may be desirable to amend the CTMA or CTMR to indicate what the effect of such a declaration would be.

In accordance with Rule 9(4)(viii) of the Madrid Regulations, Canada would receive notifications of international applications designating Canada that contain the indication “three-dimensional mark”. As a result, it may be desirable to amend the Canadian Trade-marks Act or Regulations to clarify what the relation would be between such an indication and the provisions in the Trade-marks Act concerning distinguishing guises.

In accordance with Rule 9(4)(ix) of the Madrid Regulations, Canada could receive notifications of international applications designating Canada that contain the indication “sound mark”. The position of the CTMO is that the Canadian Trade-marks Act does not allow for the registration of sound marks. Nothing in the Protocol (or in the Paris Convention, the TLT, TRIPS or NAFTA) would require Canada to accept sound marks for registration and thus the CTMO could simply issue a refusal should it receive any applications containing the designation “sound mark”.

8. Translation or Transliteration of the Mark

Ss.29(a)&(b) CTMR provide:

**“The Registrar may require an applicant for the registration of a trade-mark to furnish to the Registrar, as applicable,
(a) a translation into English or French of any words in any other language contained in the trade-mark;
(b) where the trade-mark contains matter expressed in characters other than Latin characters or in numerals other than Arabic or Roman numerals, a transliteration of the matter in Latin characters and Arabic numerals;
...”**

This requirement is consistent with the Paris Convention, NAFTA, TRIPS, the TLT and the Protocol.

TLT

TLT Articles 3(1)(a)(xiii) and (xiv) allow contracting parties to require an application to contain:

“(xiii) a transliteration of the mark or of certain parts of the mark;

(xiv) a translation of the mark or of certain parts of the mark;”

TLT Rules 3(4) and (5) provide:

“(4) For the purposes of Article 3(1)(a)(xiii), where the mark consists of or contains matter in script other than the script used by the Office or numbers expressed in numerals other than numerals used by the Office, a transliteration of such matter in the script and numerals used by the Office may be required.

(5) For the purposes of Article 3(1)(a)(xiv), where the mark consists of or contains a word or words in a language other than the language, or one of the languages, admitted by the Office, a translation of that word or those words into that language or one of those languages may be required.”

Protocol

Rule 9(4)(a)(xi) of the Madrid Regulations requires the international application to contain a translation into the language of the international application (i.e. English or French) of any description of the mark by words in any other language. Rule 9(4)(a)(xii) of the Madrid Regulations requires, where the mark consists of or contains matter in characters or numbers expressed in numerals other than Arabic or Roman numerals, a transliteration of that matter in Latin characters and Arabic numerals.

Rule 9(4)(b)(iii) of the Madrid Regulations allows the international application to contain “where the mark consists of or contains a word or words that can be translated, a translation of that word or those words into ... English or French or both if the international application is governed exclusively by the Protocol ...” Should the CTMO wish to obtain a translation in a case where none has been provided in accordance with Rule 9(4)(b)(iii), the CTMO could issue a provisional refusal.

9. Statement of Entitlement to Use (s.30(i))

S.30(i) CTMA requires “a statement that the applicant is satisfied that he is entitled to use the trade-mark in Canada in association with the wares or services described in the application.”

Nothing in the Paris Convention, TRIPS or NAFTA would prevent Canada from maintaining this requirement.

The TLT contains an exhaustive list of the indications that a contracting party may require to be contained in an application and does not explicitly allow for a s.30(i) CTMA type requirement. It would appear however that Canada could require the s.30(i) statement to be included in any declaration of intention to use required in accordance with TLT Article 3(1)(xvii) or any declaration of actual use that an applicant chose to file in accordance with TLT Article 3(1)(b).

The Protocol does not explicitly allow for a s. 30(i) CTMA statement to be included in an international application. However, in accordance with Rules 7(2) and 9(5)(f) of the Madrid Regulations, in all cases where Canada was designated in an international application, it could require a declaration of intention to use and specify that that declaration must include the s.30(i) statement.

[Declaration of use requirements under the TLT and the Protocol are discussed in more detail above under the headings “Use in Canada and Making Known in Canada” and “Proposed Use”.]

10. Affidavit or Other Evidence

S.31(2) CTMA provides: “An applicant whose trade-mark has been duly registered in his country of origin and who claims that the trade-mark is registrable under paragraph 14(1)(b) shall furnish such evidence as the Registrar may require by way of affidavit or statutory declaration establishing the circumstances on which he relies, including the length of time during which the trade-mark has been used in any country.”

S.32(1) CTMA provides “An applicant who claims that his trade-mark is registrable under subsection 12(2) or section 13 shall furnish the Registrar with evidence by way of affidavit or statutory declaration establishing the extent to which and the time during which the trade-mark has been used in Canada and with any other evidence that the Registrar may require in support of the claim.”

These requirements are consistent with the Paris Convention, NAFTA, TRIPS, the TLT and the Protocol.

With respect to the TLT, Note 3.35 of the Notes for the Basic Proposal for the Treaty (Diplomatic Conference document TLT/DC/5) stated with respect to Article 3(7): “This paragraph establishes the exhaustive character of the list of requirements ... always subject, naturally, to the possibility of requiring under paragraph (8) the furnishing of evidence. It should however be understood that paragraph (7) does not preclude a contracting party from requiring, where necessary, during the examination of an application additional indications from the applicant concerning the registrability of the mark, for example, a statement of consent by a person whose name is the same as, or appears, in the mark, a description of the mark or documents concerning the ability of a certain person (such as a minor or a person under tutelage) to file an application.”

Under the Protocol, the CTMO would have to issue a provisional refusal (based on the substantive ground of non-compliance with s.12(1)(a) or (b) CTMA) whenever the requirements of ss.31(2) and 32(1) have not been complied with.

TRIPS Article 15.1 provides, in part: “Where signs are not inherently capable of distinguishing the relevant goods or services, Members may make registrability depend on distinctiveness acquired through use.”

S.14 CTMA was apparently included in the CTMA based on a belief that it was required by Article 6 B of the Paris Convention which allows trademarks registered in the country of origin to be refused only “1. when they are of such a nature as to infringe rights acquired by third parties in the country where protection is claimed; 2. when they are devoid of any distinctive character, or consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, place or origin, of the goods, or the time of production, or have become customary in the current language or in the bona fide and established practices of the country where protection is claimed; 3. when they are contrary to morality or public order and, in particular, of such a nature as to deceive the public....” It appears clear, however, that there is enough flexibility in the language of Article 6 B to permit Canada to repeal s.14 CTMA and apply the s.12(2) test for acquired distinctiveness to all applications.

11. Trade Unions or Commercial Associations

S.33 CTMA provides “Every trade union or commercial association that applies for the registration of a trade-mark may be required to furnish satisfactory evidence that its existence is not contrary to the laws of the country in which its headquarters are situated.”

The purpose of this provision is not entirely clear since the CTMO presumably must always be satisfied that an applicant falls within the meaning of the word person as defined in s.2 of the Act. Its inclusion in the CTMA may be related to Article 7bis of the Paris Convention which provides: “Nevertheless, the protection of these marks [collective marks] shall not be refused to any association the existence of which is not contrary to the law of the country of origin, on the ground that such association is not established in the country where protection is sought or is not constituted according to the law of the latter country.”

In any event, this specific requirement, as well as any general requirement by the CTMO for an applicant to establish that it is a person as that term is defined in s. 2 CTMA, would appear to be consistent with the Paris Convention, NAFTA, TRIPS, the TLT and the Protocol.

With respect to the TLT, reference may again be made to Note 3.35 of Diplomatic Conference document TLT/DC/5(see above under the heading “Affidavit or other evidence”).

Under the Protocol, in addition to the requirements to establish eligibility to file an international application in conformity with Article 2 of the Protocol, Rule 9(4)(b)(ii) permits the international application to contain: “where the applicant is a legal entity, indications concerning the legal nature of that legal entity ...” If CTMO was to want further

information regarding the legal status of an applicant to file an application, it would be necessary to issue a provisional refusal. It would seem, however, that since an international registration must be based on an application or registration in the country of origin which is in the same name as the international registration, it would be reasonable for the CTMO to normally assume that the legality of the organization or other entity concerned in the country of origin would have been established.

12. Priority Claims

S.34 CTMA provides “(1) When an application for the registration of a trade-mark has been made in any country of the Union [defined in s.2 to include WTO members] other than Canada and an application is subsequently made in Canada for the registration for use in association with the same kind of wares or services of the same or substantially the same trade-mark by the same applicant or his successor in title, the date of filing of the application in the other country is deemed to be the date of filing of the application in Canada, and the applicant is entitled to priority in Canada accordingly notwithstanding any intervening use in Canada or making known in Canada or any intervening application or registration if

(a) the application in Canada, including or accompanied by a declaration setting out the date on which and the country of the Union in which the earliest application was filed for the registration of the same or substantially the same trade-mark for use in association with the same kind of wares or services, is filed within a period of six months from that date, which period shall not be extended;

(b) the applicant or, if the applicant is a transferee, his predecessor in title by whom any earlier application was filed in any country of the Union was at the date of the application a citizen or national of or domiciled in that country or had therein a real and effective industrial or commercial establishment; and

(c) the applicant furnishes, in accordance with any request under subsections (2) and (3), evidence necessary to establish fully the applicant’s right to priority.

(2) The Registrar may request the evidence before the day on which the application is allowed pursuant to section 39.

(3) The Registrar may specify in the request the manner in which the evidence must be furnished and the period within which it must be furnished.”

S.34 appears to be consistent with the Paris Convention (with one possible exception discussed below), NAFTA, TRIPS and the TLT. It would seem, however, that the formal requirements of s.34 could not be applied in respect of international applications under the Protocol. Instead the CTMO would have to be satisfied with the information that would be included in the international application pursuant to Rule 9(4)(a)(iv) of the Madrid Regulations. The effect of this would seem to be that under the Protocol the CTMO would receive all appropriate information about the priority claim but could not require any evidence such as a certified copy of the priority document.

Paris Convention

Article 4D of the Paris Convention provides:

“(1) Any person desiring to take advantage of the priority of a previous filing shall be required to make a declaration indicating the date of such filing and the country in which it was made. Each country shall determine the latest date on which such declaration must be made.

(2) These particulars shall be mentioned in the publications issued by the competent authority, and in particular in the patents and the specifications relating thereto.

(3) The countries of the Union may require any person making a declaration of priority to produce a copy of the application (description, drawings, etc.) previously filed. The copy, certified as correct by the authority which received such application, shall not require any authentication, and may in any case be filed, without fee, at any time within three months of the filing of the subsequent application. They may require it to be accompanied by a certificate from the same authority showing the date of filing, and by a translation.

(4) No other formalities may be required for the declaration of priority at the time of filing the application. Each country of the Union shall determine the consequences of failure to comply with the formalities prescribed by this Article, but such consequences shall in no case go beyond the loss of the right of priority.

(5) Subsequently, further proof may be required. Any person who avails himself of the priority of a previous application shall be required to specify the number of that application; this number shall be published as provided for by paragraph (2), above.”

For full compliance with Article 4D of the Paris Convention, it would appear that section 34(b) CTMA should be amended to remove the requirement that the applicant or predecessor in title have been a citizen of (or otherwise connected with) the same Paris Union country in which the priority application was filed. Instead, s.34(b) should only require that the applicant or predecessor in title have been a citizen of (or otherwise connected with) any Paris Union country.

TLT

TLT Article 3(1)(a)(vii) allows a contracting party to require an application to contain: “where the applicant wishes to take advantage of the priority of an earlier application, a declaration claiming the priority of that earlier application, together with indications and evidence in support of the declaration of priority that may be required pursuant to Article 4 of the Paris Convention.”

Article 3(8) of the TLT permits a contracting party to require evidence where it reasonably doubts the veracity of any indication or element contained in the application.

Protocol

Protocol Article 4(2) provides: “Every international registration shall enjoy the right of priority provided for by Article 4 of the Paris Convention for the Protection of Industrial Property, without it being necessary to comply with the formalities prescribed in Section D of that Article.”

Rule 9(4)(a)(iv) of the Madrid Regulations requires the international application to contain: “where the applicant wishes, under the Paris Convention for the Protection of Industrial Property, to take advantage of the priority of an earlier filing, a declaration claiming the priority of that earlier filing, together with an indication of the name of the Office where such filing was made and of the date and, where available, the number of that filing, and, where the earlier filing relates to less than all the goods and services listed in the international application, the indication of those goods and services to which the earlier filing relates,”

In view of Article 4(1)(a) of the Protocol, the six month Paris Convention priority period would, for Protocol applications, run back from the date of the registration or recordal effected in accordance with 3 and 3ter of the Protocol and not necessarily from the filing date of the international application.

TRIPS/NAFTA

There are no provisions in NAFTA or TRIPs concerning priority requirements other than those incorporated by reference from the Paris Convention.

13. Disclaimers

S.35 CTMA provides: “The Registrar may require an applicant for registration of a trade-mark to disclaim the right to the exclusive use apart from the trade-mark of such portion of the trade-mark as is not independently registrable, but the disclaimer does not prejudice or affect the applicant’s rights then existing or thereafter arising in the disclaimed matter, nor does the disclaimer prejudice or affect the applicant’s right to registration on a subsequent application if the disclaimed matter has then become distinctive of the applicant’s wares or services.”

TLT

S.35 CTMA clearly appears to be permissible under the TLT particularly bearing in mind Note 3.35 of Diplomatic Conference document TLT/DC/5(see above under the heading “Affidavit or other evidence”).

Protocol

Rule 9(4)(b)(v) of the Madrid Regulations permits an international application to contain “where the applicant wishes to disclaim protection for any element of the mark, an indication of that fact and of the element or elements for which protection is disclaimed. Should the CTMO wish to obtain a disclaimer in a case where none has been provided in accordance with Rule 9(4)(b)(v), the CTMO could issue a provisional refusal.

The practice of at least some of the Madrid offices which require disclaimers is to issue what is in effect an acceptance subject to a disclaimer, that is, they issue what is, in Madrid terms, called a notification of provisional refusal, informing the holder that the protection in their country is subject to a disclaimer; if the holder does not respond in order to contest the requirement, the disclaimer stands and the mark is protected accordingly.

Other

The Paris Convention, NAFTA and TRIPS do not deal with requirements for disclaimers.

14. Forms

S.14(1) CTMR provides: “An application for the registration of a trade-mark ... shall be presented clearly and legibly, in the manner specified by the Registrar in the Journal and on the appropriate form published by the Registrar in the Journal, or in any other form that allows for the furnishing of the same information.”

Article 3(2) of the TLT requires each contracting party to accept an application made in accordance with the Model International Form specified in the TLT Regulations for an application for the registration of a mark.

With respect to Protocol applications, at least from a practical point of view Canada would have to accept international applications which conform to the requirements of the Protocol and the Madrid Regulations.

The Paris Convention, NAFTA, and TRIPS do not deal with requirements for the use of forms.

Given that s.14(1) CTMR does not require a particular form to be used, no issues of consistency with international treaties arise.

15. Signatures

Requirements for the signature of trademark applications are permitted by TLT Articles 3(1)(a)(xvi) and 3(4). Under Rule 9(2)(b) of the Madrid Regulations, however, international applications are only required to be signed by the office of origin although the latter may require that the international application be signed also by the applicant. The Paris Convention, NAFTA and TRIPS do not deal with requirements for signatures.

This is not currently an issue in Canada since requirements for signatures on Canadian trademark applications were removed in 1996.

V. IDENTIFICATION OF GOODS AND SERVICES

Canadian Law and Practice

S.30(a) CTMA requires trademark applications to contain a statement in ordinary commercial terms of the specific wares or services in association with which the mark has been or is proposed to be used.

There is no specific requirement under the CTMA for the grouping or classification of goods or services; however, where the trademark has been used or made known, ss.30(b), (c) and (d) require certain information to be provided for each of the general classes of wares or services described in the application. The Act does not define what is meant by a general class of wares or services.

For internal search purposes, the CTMO uses a software system to classify the goods and services in trademark applications. This classification is substantially the same as the Nice classification system; however, additional terms and a number of supplementary classes in the services area have been added.

Nice Agreement

The Nice Agreement provides for a classification of goods and services for the purposes of registering trademarks. The Classification consists of a list of classes - there are 34 classes for goods and eight for services - and an alphabetical list of the goods and services. The latter comprises some 11,000 items. Both lists are, from time to time, amended and supplemented by a Committee of Experts on which all contracting countries are represented.

Pursuant to the Nice Agreement, the Nice Classification has no substantive effect and serves only administrative purposes. The only specific obligation imposed by the Agreement on contracting countries is found in Article 2(3):

“The competent Offices of the countries of the Special Union shall include in the official documents and publications relating to registrations of marks the numbers of the classes of the Classification to which the goods or services for which the mark is registered belong.”

TLT

Pursuant to TLT Article 5(1)(a)(v), for the purpose of according a filing date a contracting party is prohibited, in respect of goods and services, from requiring more than “the list of the goods and/or services for which the registration is sought.”

Under TLT Article 3(1)(a)(xv), a contracting party may (other than for the purpose of according a filing date) require that an application contain “ the names of the goods and/or services for which the registration is sought, grouped according to the classes of the Nice Classification, each group preceded by the number of the class of that Classification to which that group of goods or services belongs and presented in the order of the classes of the said Classification”. It would appear that the degree of detail that may be required of an applicant with respect to the naming of the goods and services is a matter that is left to national law and that accordingly Canada could, consistent with the TLT, maintain the existing s.30(a) CTMA requirement that the naming of the wares and services be specific and in ordinary commercial terms.

TLT Article 9(1) provides:

“Each registration and any publication effected by an Office which concerns an application or registration and which indicates goods and/or services shall indicate those goods and/or services by their names, grouped according to the classes of the Nice Classification, and each group shall be preceded by the number of the class of that Classification to which that group of goods or services belongs and shall be presented in the order of the classes of the said Classification.”

In order to comply with TLT Article 9(1), the CTMO would have two choices, either:

- 1) do the grouping and numbering itself, or
- 2) require (as permitted under Article 3(1)(a)(xv)) the applicant to do the grouping and numbering.

TLT Article 9(2) makes clear that the Nice Classification has no substantive effect and only serves administrative purposes. It provides:

“(a) Goods or services may not be considered as being similar to each other on the ground that, in any registration or publication by the Office, they appear in the same class of the Nice Classification.

(b) Goods or services may not be considered as being dissimilar from each other on the ground that, in any registration or publication by the Office, they appear in several classes of the Nice Classification.”

Protocol

Protocol Article 3(2) provides:

“The applicant must indicate the goods and services in respect of which protection of the mark is claimed and also, if possible, the corresponding class or classes according to the classification established by the Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks. If the applicant does not give such indication, the International Bureau shall classify the goods and services in the appropriate classes of the said classification. The indication of classes given by the applicant shall be subject to control by the International Bureau, which shall exercise the said control in association with the Office of origin. In the event of disagreement between the said Office and the International Bureau, the opinion of the latter shall prevail.”

The provisions of Article 3(2) are further expanded in Rules 9(4)(a)(xiii), 12 and 13 of the Madrid Regulations.

Applicants are required, in international applications, to classify the goods and services in accordance with the Nice Classification; however the only consequence of failure to do so would appear to be that the IB will do the classification itself. Rule 9(4)(a)(xiii) requires that goods and services be indicated in precise terms and under Rule 13 the IB may suggest the replacement or deletion of terms which are vague, incomprehensible or linguistically incorrect.

Article 4(1)(b) of the Protocol provides: “The indication of classes of goods and services provided for in Article 3 shall not bind the Contracting Parties with regard to the determination of the scope of the protection of the mark.” The purpose of classification in accordance with the Nice Classification would thus appear to be for searching and for the purpose of establishing fees.

S.30(a) CTMA appears consistent with the Protocol. The CTMO could make a notification of refusal under Article 5(1) of the Protocol if it considered that the goods or services indicated in the international registration did not satisfy the requirements of s.30(a) CTMA. Currently, in respect of Canadian domestically filed applications, s.30(a) CTMA objections are fairly frequent and s.30(a) would therefore likely be a significant source of the provisional refusals that Canada would issue in respect of international applications designating Canada. It would however be possible for international applicants to reduce the number of provisional refusals based on this ground by including in the international application a Canada-specific list of goods and services. In this regard, Rule 9(4)(xiii) of the Madrid

Regulations permits an applicant to include in an international application “limitations of the list of goods and services in respect of one or more designated Contracting Parties”. To reduce its own workload and to assist international applicants, the CTMO could give consideration to whether there are specific measures that it could take to facilitate preparation of Canada-compliant lists of goods and services (e.g. by making available a keyword searchable electronic database of terms considered acceptable by the CTMO). Even though legally consistent with the Protocol, the circumstances in which it would in practice be appropriate to encourage international applicants to file a Canada-specific list of goods and services would need some discussion with the IB since it would seem that the IB could be subjected to an onerous administrative burden if country-specific lists of goods and services were to become common for a large number of applications.

The treatment of goods and services under the Protocol would seem to create some disadvantages for Canadians if Canada were to keep its current strict approach to the listing of goods and services. Under the Protocol, an international application can only cover goods and services that are covered in the basic application or registration. To some extent, this makes the Protocol more advantageous for nationals of countries that allow a broad listing of goods and services (while at the same time perhaps limiting the scope of protection closely to the specific goods or services listed) than for nationals of countries, such as Canada, that require narrow descriptions of goods and services while according a broad ambit of protection. Accordingly, if Canada were to decide to join the Protocol, it would need to give some consideration to whether it would be desirable to make some changes to the existing Canadian approach to goods and services to facilitate use of the Protocol by applicants relying on a Canadian basic application or registration. For example, consideration might be given to relaxing to some degree the current Canadian requirements for specificity in the listing of goods and services.

VI. REQUIREMENTS FOR USE

1. Requirement for Use Before Registration

Canadian Law

It is not possible to obtain a trademark registration in Canada unless, before registration, there has been use of the mark in Canada or alternatively, under certain conditions, there has been use in another country.

The basic rule in Canada is that an applicant must at the time of filing an application either state that it has already used the trademark in Canada since a specified date or make a declaration that it intends to use the trademark in Canada; in the latter case, after the allowance of the application but before the application is permitted to proceed to registration, the applicant must file a declaration stating that use has commenced *in Canada*. There are two situations in which an applicant is exempted from the above requirements to have used the mark in Canada before registration.

First, where an applicant has a registration for the mark in a Paris Union country or a WTO member, the applicant need only declare that use of the mark has taken place somewhere in the world. It is generally understood that such use must have taken place before the filing of the Canadian application but the CTMA is not explicit on this point.

The second situation where an applicant is exempted from the requirement to have used the trademark in Canada is where, despite a lack of use *in Canada*, the mark has been used in a Paris Union country or a WTO member and has become well known in Canada (e.g. by overflow advertising); in this situation, the applicant need only declare that use of the mark has taken place in a Paris Union country or a WTO member.

In the Canadian Trade-marks Act, the above-described requirements for use before registration are linked with four bases, on the basis of one or more of which every Canadian trademark application must be filed. In accordance with s.16 CTMA, there are four bases for registration of a trademark:

- i) use in Canada before filing of the application (s.16(1));
- ii) making known in Canada of the trademark before filing of the application (s.16(1));
- iii) registration of the trademark in the applicant’s country of origin together with prior use of the trademark in any country (16(2)); and
- iv) proposed use (16(3)).

With respect to i), where a trademark has been used in Canada prior to the filing of an application for registration, s.30(b) CTMA requires that a date of first use be provided. There is jurisprudence to the effect that for this pur-

pose an applicant may provide a later date than the actual date of first use but that failure to provide a date is a basis for refusing an application during opposition proceedings. Failure to comply with s.30(b) is not a basis for invalidating a registration pursuant to s.18 CTMA.

With respect to ii), because of the definition of making known in s.5 CTMA, a trademark cannot be made known in Canada unless it has already been used in a country of the Paris Union or a WTO member. Where a trademark has not been used in Canada but is made known in Canada, s.30(c) CTMA requires the application to contain the name of a country of the Paris Union or a WTO member in which the mark has been used and the date from and manner in which the mark has been made known in Canada.

With respect to iii), when an application is filed on the basis of registration and use abroad, the registration does not have to exist at the date of filing; it is enough for a foreign application to have been filed. Proof of the foreign registration must, however, be filed before the Canadian application will be advertised (s.31 CTMA).

With respect to iv), a declaration of use must be filed before the application can proceed to registration (s.40(2) CTMA).

Paris Convention

There are no limitations in the Paris Convention on the ability of a contracting party to require use of a trademark before registration. As discussed above under the heading "Grounds of Refusal", the limitations in Article 6 of the Paris Convention do not apply because they relate only to questions of form, i.e., with regard to the signs of which the trademarks are composed.

It appears that both ss.16(2) and (3) CTMA were included in the Canadian Act because of a belief that they were required for compliance with the Paris Convention (notably Articles 6^{DIS} and 6). It appears clear, however, that this belief was incorrect and that nothing in the Paris Convention would prohibit the deletion of ss.16(2) and (3) from the Canadian Act.

TRIPS and NAFTA

Requiring use before registration is consistent with both TRIPS and NAFTA having regard to TRIPS Article 15.3 and the almost identical NAFTA Article 1708.3. TRIPS Article 15.3 provides:

"Members may make registrability depend on use. However, actual use of a trademark shall not be a condition for filing an application for registration. An application shall not be refused solely on the ground that intended use has not taken place before the expiry of a period of three years from the date of application."

TLT

Requiring use before registration is permitted under TLT Article 3, although some constraints are imposed with respect to what can be required as well as the timing of any requirements. In this regard, see the TLT discussion above under the heading "Use in Canada and Making Known in Canada".

Protocol

Rules 9(5)(f) and 7(2) of the Madrid Regulations make provision for contracting parties to require a declaration of intention to use the mark in the territory of that contracting party. As discussed above under the heading "Registration and Use Abroad", it may be possible for Canada to require such a declaration of intention to use to include a statement that the trademark has been used in a named foreign country. Otherwise, the Protocol makes no provision at all for any of the other use-related information that Canada currently requires, to be included in an international application.

In theory, there is nothing in the Protocol that would prevent Canada from requiring use before registration. Canada could, in respect of every international application designating Canada notified to it by the IB that did not comply with existing Canadian use-related requirements, issue a provisional refusal that would only be withdrawn when those requirements were satisfied. Such an approach, however, could place a significant additional workload on the CTMO and could subject Canada to criticism from other contracting parties, particularly since no other contracting party is at all likely to take a similar approach.

In view of the above, Canada, if it were to decide to join the Protocol, might wish to give consideration to exempting international registrations designating Canada from all of the existing Canadian pre-registration use-related requirements with the exception of a requirement that the applicant include in the international application a declara-

tion of intention to use the mark in Canada. This would mean in particular that international applications designating Canada would be exempted from the requirements in ss.30 b) to (d) and s.40(2) and that an international applicant would not be limited to one of the four bases of registration set out in s.16 CTMA.

The main purpose of the existing Canadian pre-registration use-related requirements would appear to be to discourage what is sometimes called “banking of trademarks” or “trafficking in trademarks” and to ensure that applicants are reasonably serious about making bona fide use of the mark in commerce before being allowed to obtain a registration. Canada would in particular need to consider how serious a problem, in relation to banking of trademarks, would be likely to be presented by applicants filing international applications designating Canada and whether there are other measures that could be put in place to counteract any potential abuses. For example, consideration could be given to providing an exemption from some use requirements to all Madrid applicants designating Canada but requiring any applicant making use of the exemption to file a declaration of actual use at some point after registration, e.g. after three years. (In this regard see the discussion below concerning requirements for use after registration.)

For related discussions on the impact of the Protocol on various of the specific Canadian pre-registration use-related requirements, see above under the headings: “Use in Canada and Making Known in Canada”, “Registration and Use Abroad”, and “Proposed Use”.

2. Requirement for Use After Registration

Canadian Law

Pursuant to s.45 CTMA the Registrar may at any time and, at the written request made after three years from the date of registration by any person shall, unless he sees good reason to the contrary, issue a notice requiring the owner of a registered trademark to establish that the trademark is in use. Failure to establish use in Canada or that the absence of use has been due to special circumstances that excuse such absence of use may result in the registration being amended or expunged.

Pursuant to ss.18 and 57 CTMA, a trademark registration may be expunged if the trademark has been abandoned. For a trademark to be abandoned there must be an intention to abandon the mark; however, the courts have been prepared to infer an intention to abandon where there has been a long period of non-use.

These Canadian post-registration use requirements are consistent with all of the Paris Convention, TRIPS, NAFTA, the TLT and the Protocol.

Paris Convention

Article 5C(1) provides:

“If, in any country, use of the registered mark is compulsory, the registration may be cancelled only after a reasonable period, and then only if the person concerned does not justify his inaction.”

TRIPS

Article 19.1 provides:

“If use is required to maintain a registration, the registration may be cancelled only after an uninterrupted period of at least three years of non-use, unless valid reasons based on the existence of obstacles to such use are shown by the trademark owner. Circumstances arising independently of the will of the owner of the trademark which constitute an obstacle to the use of the trademark, such as import restrictions on or other government requirements for goods and services protected by the trademark, shall be recognized as valid reasons for non-use.”

NAFTA

Article 1708(8) provides:

“Each party shall require the use of a trademark to maintain a registration. The registration may be cancelled for the reason of non-use only after an uninterrupted period of at least two years of non-use, unless valid reasons based on the existence of obstacles to such use are shown by the trademark owner. Each Party shall recognize, as valid reasons for non-use, circumstances arising independently of the will of the trademark owner that constitute an obstacle to the use of the trademark, such as import restrictions on, or other government requirements for, goods or services identified by the trademark.”

Article 13(4)(iii) provides that, in respect of a request for renewal the following may not be required: “the furnishing of a declaration and/or evidence concerning use of the mark.” Article 22(5) contains a transitional provision that allows contracting parties to exempt themselves from Article 13(4)(iii) but only for a limited period of time and in no case after October 28, 2004.

Protocol

Under the Protocol, it would seem that Parties would be free to establish such requirements regarding use after registration as they wished, and to invalidate the registrations of trademark owners who do not comply. The only limitation on the ability of a contracting party to invalidate a trademark registration effected under the Protocol is found in Article 5(6) which requires that the holder, in good time, be afforded the opportunity of defending his rights. It is noted however that it would not be possible to link use requirements directly with the international renewal process under Article 7.

Adherence to the Protocol by Canada might have as a potential side effect an increase in the number of marks on the Canadian register that are not actually being used (particularly if Canada removes any requirement for use before registration for international applications). If such an increase appeared likely, Canada might wish to consider using post-registration use requirements or other mechanisms to reduce this “deadwood” in the register. Canada could for example shorten the trademark term to ten years (as would be required under the TLT in any event) and require evidence of use to be filed at periodic intervals (although not at the time of renewal).

3. Possible New Approach to Canadian Use Requirements

Bearing in mind the above discussion of use requirements, it is evident that, in order to join the Protocol and the TLT, Canada would need to give serious consideration to making significant changes to current Canadian use requirements. For the purposes of stimulating discussion, the author puts forward the following approach that might be taken with respect to Canadian use requirements and that would be consistent with the Protocol and the TLT:

1. Abolish the current four bases of registration as found in ss.16(1) to (3) CTMA and instead provide that an applicant is entitled to secure the registration of a trademark that is registrable unless, at the earlier of the date of filing or the date of first use, it was confusing with a trademark that had been previously used, made known or applied for by another person or with a trade name that had been previously used or made known by another person.
2. Delete the requirement that an application contain the information specified in ss.30(b) to (d) CTMA.
3. No longer require that there be use (whether in Canada or elsewhere) before a trademark can proceed to registration in Canada.
4. Require, as a filing date requirement, an applicant to submit either a declaration of intention to use the trademark or a declaration of actual use in Canada (any declaration of actual use being required to include a date of first use in Canada).
5. If a declaration of intention to use was submitted at filing, allow the applicant to submit, at any time before registration, a declaration of actual use.
6. Provide that an applicant would only be permitted to rely on a claimed date of first use in opposition or examination procedures if the declaration of actual use including the date of first use was submitted to the TMO at filing or within a short period (e.g. two months) thereafter.
7. Provide that if no declaration of actual use was filed before registration, the applicant would be required to submit, on the expiry of a specified period (e.g. three years) after registration, an affidavit establishing either that the trademark is in use or that there are special circumstances justifying non-use.
8. Permit an opposition to be based on the ground that an applicant incorrectly claimed too early a date of first use. The only consequence for claiming a date later than the actual date of first use would be that in examination and opposition proceedings only the claimed date could be relied upon.

VII. RECORDAL OF CHANGES AND OTHER FACTS CONCERNING MARKS

[Note that some related issues are discussed above under the heading “Change or Cancellation of International

Registration”.]

1. Changes in Ownership

Canadian Law and Practice

S.26 CTMA provides:

“(1) There shall be kept under the supervision of the Registrar

(a) a register ... of transfers ... relating to each registered trade-mark ...

(2) The register referred to in paragraph (1)(a) shall show, with reference to each registered trade-mark, the following:

...

(c) a summary of all documents deposited with the application or subsequently thereto and affecting rights to the trade-mark ...”

S.48 CTMA provides:

“48. (1) A trade-mark, whether registered or unregistered, is transferable, and deemed always to have been transferable, either in connection with or separately from the goodwill of the business and in respect of either all or some of the wares or services in association with which it has been used.

(2) Nothing in subsection (1) prevents a trade-mark from being held not to be distinctive if as a result of a transfer thereof there subsisted rights in two or more persons to the use of confusing trade-marks and the rights were exercised by those persons.

(3) The Registrar shall register the transfer of any registered trade-mark on being furnished with evidence satisfactory to him of the transfer and the information that would be required by paragraph 30(g) in an application by the transferee to register the trade-mark.”

S.48 CTMR provides:

“The Registrar shall recognize a transfer of an application for registration of a trade-mark on receipt of a written request for recognition together with

(a) evidence of the transfer; and

(b) the information required by paragraph 30(g) of the Act in the case of a first application.”

S.48(3) CTMA must be read subject to s.15(3) CTMA which provides:

“No amendment of the register recording any change in the ownership or in the name or address of the owner of any one of a group of associated trade-marks shall be made unless the Registrar is satisfied that the same change has occurred with respect to all the trade-marks in the group, and the corresponding entries are made contemporaneously with respect to all those trade-marks.”

S.15(3) notably does not affect the ability of a trademark owner to transfer but only the obligation on the Registrar to register the transfer. As is made clear by s.48(2) CTMA, however, inappropriate transfers may result in a trademark being held not to be distinctive.

In view of s.48(1) CTMA, the CTMO registers partial transfers i.e. assignments in respect of only some of the goods or services for which the trademark has been used regardless of whether this results in rights to confusing trademarks being held in the names of different persons. In accordance with ss.49 and 50 CTMR, after registering a partial transfer, the CTMO treats the original application or registration as being two or more separate applications or registrations, subject to individual renewal etc.

Although the registration of partial transfers appears to be necessary in view of s.48(1) CTMA, it is inconsistent with the presumable intention of s.15(3) which is to protect the public interest by requiring registrations of confusing trademarks to be held in the name of one person only. For coherency, the CTMA should be amended to either:

i) prohibit the registration of partial transfers where this results in confusing trademarks being held by different persons, to be consistent with the intention of s.15(3); or

ii) remove the current constraints on the transfer of associated marks e.g. by deleting ss. 15(2) and (3) and amending s.15(1) to read: “Notwithstanding section 12 or 14, confusing trade-marks are registrable if the applicant is the owner of all such trade-marks.”

The basic issue is whether there is a need to protect the public interest by prohibiting the registration of transfers that result in registrations for confusing trademarks being held by different persons or whether sufficient protection is provided by allowing trademark registrations to be invalidated under s.18(1)(b) CTMA for lack of distinctiveness. It is to be noted that the protection accorded by the former is quite limited since s.15(3) would not in any event actually prevent a transfer but only its registration.

Paris Convention

Article 6^{quater} provides:

“(1) When, in accordance with the law of a country of the Union, the assignment of a mark is valid only if it takes place at the same time as the transfer of the business or goodwill to which the mark belongs, it shall suffice for the recognition of such validity that the portion of the business or goodwill located in that country be transferred to the assignee, together with the exclusive right to manufacture in the said country, or to sell therein, the goods bearing the mark assigned.

(2) The foregoing provision does not impose upon the countries of the Union any obligation to regard as valid the assignment of any mark the use of which by the assignee would, in fact, be of such a nature as to mislead the public, particularly as regards the origin, nature, or essential qualities, of the goods to which the mark is applied.”

In Bodenhausen, *Guide to the Application of the Paris Convention for the Protection of Industrial Property* it is stated at page 106 that the freedom under Article 6^{quater} (2) “may be exercised, for example, if a trademark is assigned for part only of the goods to which it is applied, and if these goods are similar to other goods for which the mark is not assigned. In such cases the public may be misled as to the origin or essential qualities of similar goods to which the assignor and assignee will apply the same trademark, independently.”

TRIPS

Article 21 provides:

“Members may determine conditions on the licensing and assignment of trademarks, it being understood that the compulsory licensing of trademarks shall not be permitted and that the owner of a registered trademark shall have the right to assign the trademark with or without the transfer of the business to which the trademark belongs.”

NAFTA

NAFTA Article 1708(11) is essentially identical to TRIPS Article 21.

TLT

TLT Article 11 establishes a means for requesting the recordal of a change in ownership and an exhaustive list of the possible requirements that a contracting party can make concerning the presentation of the request. Article 11 does not however affect the ability of a contracting party to establish whatever substantive requirements it wishes for the validity of a transfer including for example whether partial assignments are permitted.

TLT Article 11(1)(a) requires each contracting party to accept, as regards the presentation of a request for a change in ownership, a request made in accordance with Model International Form N04.

Where a change in ownership results from a contract, Article 11(1)(b) allows a contracting party to require, at the option of the requesting party, i) a certified copy of the contract, ii) a certified copy of an extract of the contract showing the change, iii) an uncertified certificate of transfer drawn up in the form and with the content as specified in Model International Form N05 and signed by both the holder and the new owner, or iv) an uncertified transfer document drawn up in the form and with the content as specified in Model International Form N06 and signed by both the holder and the new owner.

Where the change in ownership results from a merger, Article 11(1)(c) allows a contracting party to require a certified copy of a document originating from the competent authority and evidencing the merger.

Where the change in ownership results neither from a contract or a merger, Article 11(1)(e) allows a contracting party to require a certified copy of a document evidencing the change.

TLT Article 11 generally would not seem to require any change in Canadian practice. From a legal point of

view, however, it would probably be best to explicitly limit the discretion of the Registrar of Trade-marks to require evidence of a transfer under s.48(3) CTMA and s.48 CTMR to evidence that is permitted to be required under the TLT.

Protocol

Article 9 of the Protocol provides:

“At the request of the person in whose name the international registration stands, or at the request of an interested Office made ex officio or at the request of an interested person, the International Bureau shall record in the International Register any change in the ownership of that registration, in respect of some or all of the Contracting Parties in whose territories the said registration has effect and in respect of all or some of the goods and services listed in the registration, provided that the new holder is a person who, under Article 2(1), is entitled to file international applications.”

Although Article 9 of the Protocol states that the request can be made by an interested party, it seems to have been the intention that an interested party other than the holder only be able to request a change in ownership through the intermediary of an interested office. In paragraph 710 of the Main Committee Summary Minutes at the Diplomatic Conference on the Protocol, it is stated: “[the Chairman] explained that, in the event of a request submitted by an interested person, it was the office that had to take the responsibility of accepting or refusing that request and that the International Bureau made the entry on the instructions of an Office.” Rule 25(1)(b) of the Madrid Regulations reinforces this idea in that it provides that the request shall be presented by the holder, by the office of the contracting party of the holder or by the office of the contracting party of the transferee.

Under the Protocol it would seem that Parties would be completely free to determine under what circumstances changes in ownership would have the effect of invalidating the registration of a trademark. The only limitation on the ability of a contracting party to invalidate a trademark registration effected under the Protocol is found in Article 5(6) which requires that the holder, in good time, be afforded the opportunity of defending his rights.

On its face, Article 9 of the Protocol might be interpreted as requiring parties to register all changes in ownership when requested by a relevant person regardless of whether the transfer could affect the validity of the trademark registration. Article 9, however, only requires the IB to record the change and does not say what effect must be given to the change by the designated contracting parties. Rule 27 of the Madrid Regulations would require the IB to notify the designated contracting parties each of which would have the right to declare that change in ownership has no effect in that contracting party. In this regard, Rule 27(4) states that the “effect of such a declaration shall be that, with respect to the said Contracting Party, the international registration concerned shall remain in the name of the transferor.”

If a contracting party did not make a declaration under Rule 27(4), nothing in the Protocol would explicitly impose any requirements on the contracting party as to what, if any, legal effect would result from the recordal in the International Register of a change in the ownership of an international registration. The spirit of Rule 27(4) would, however, seem to be (at least as a general rule and perhaps subject to judicial decisions to the contrary in exceptional cases) that, except where a declaration is made, the person recorded as the new holder should enjoy all rights that flow from the international registration in the contracting party concerned.

With respect to partial assignments, Section 15 of the Administrative Instructions provides that any transferred part shall be cancelled under the number of the international registration and recorded as a separate international registration, which shall bear the original number together with a capital letter. In accordance with the discussion in the previous paragraph, contracting parties would not be required to give legal effect in their territory to partial assignments and could, if they wished, in individual cases, declare that partial assignments have no effect in that contracting party.

In practice, Canada would not likely wish to make declarations that particular changes in ownership are of no effect given the resources that this would require, the fact that no fee could be required for the work involved and that, at least from a strict legal point of view, failure to make such declarations would not in any event appear to oblige Canada to give any particular legal effect to the change in ownership.

Under the Protocol, it would be difficult for Canada to maintain the current requirements in s.48(3) CTMA that the Registrar of Trade-marks register transfers only “on being furnished with evidence satisfactory to him of the transfer and the information that would be required by paragraph 30(g) in an application by the transferee to register the trade-mark.” Canada may wish to consider giving recordals in the International Register of changes in ownership of international registrations having effect in Canada the same legal effect as the registration of a transfer under s.48(3) CTMA. If it does so, the CTMO would probably want to include such international recordals in its own database; it would not, however, be entitled to charge a fee for so doing. In deciding how to handle international recordals,

Canada would also need to consider whether to maintain the s.15(3) CTMA restriction on the transfer of associated marks and, if so, how to make such a restriction workable in the context of international records.

Under Article 9 of the Protocol, a change in ownership of an international registration can only be recorded if “the new holder is a person who, under Article 2(1), is entitled to file international applications [under the Protocol].” Although Article 9^{bis}(3) of the Madrid Agreement allows for the cancellation (in practice this has rarely, if ever, been done) at the request of the country of the former proprietor of a international registration that has been transferred to a person who is not entitled under the Agreement to apply for an international registration, under the Protocol there is no sanction that can be applied other than the non-entry of the transfer. It would seem that contracting parties are then left free to decide on the effect of the non-entered transfer. Canada could take the position that a non-entitled transferee would not be able to exercise any rights in respect of the international registration but that if a further transfer was effected to an entitled transferee the latter would be able to exercise those rights.

Where a change in ownership of an international registration cannot be recorded under Article 9 because the new holder lacks the necessary entitlement under the Protocol, it would also seem that there is no possibility of recording the change at the national level even in countries that place no restrictions on the transfer of national trademark registrations. In this regard, it is to be noted that the procedure under Article 9 for the transformation of international registrations into national registrations is not available as a possible solution since its application is limited to cases of “central attack” under Article 6(4). In view of the above, if Canada does not join the Protocol, it will not be possible for an international registration under the Protocol to be assigned to a Canadian business unless the Canadian business has a real and effective industrial or commercial establishment in a Protocol contracting party and thus qualifies under Article 2(1) of the Protocol.

2. Other Records

Canadian Law and Practice

s.26 CTMA provides (in part):

“(1) There shall be kept under the supervision of the Registrar

(a) a register of trade-marks and of transfers, disclaimers, amendments, judgments and orders relating to each registered trade-mark ...

(2) The Register referred to in paragraph (1) shall show, with reference to each registered trade-mark, the following:

...
(c) a summary of all documents deposited with the application or subsequently thereto and affecting the rights to the trade-mark;

...
(e) particulars of each change of name and address; and

(f) such other particulars as this Act or the regulations require to be entered thereon.”

In accordance with s.26(2)(c), the CTMO will, after registration of a mark, record on the register certain basic information about security interests and license agreements. What, if any, legal significance arises from such records is unclear. The CTMA does not expressly provide for any legal effect to be given to records of licenses on the register although it is sometimes suggested that such records might be considered to constitute public notice for the purposes of s.50(2) CTMA. The CTMA makes no reference at all to security interests.

S.41 CTMA provides:

“1. The Registrar may, on application by the registered owner of a trade-mark made in the prescribed manner, make any of the following amendments to the register:

- (a) correct any error or enter any change in the name, address or description of the registered owner or of his representative for service in Canada;
- (b) cancel the registration of the trade-mark;
- (c) amend the statement of the wares or services in respect of which the trade-mark is registered;
- (d) amend the particulars of the defined standard that the use of a certification mark is intended to indicate; or
- (e) enter a disclaimer that does not in any way extend the rights given by the existing registration of the trade-mark.”

With respect to applications, the basic principle is that any amendment may be made to an application while it is pending with the exception of certain prohibited amendments that are set out in ss.31 and 32 CTMA.

Paris Convention, NAFTA, TRIPS

None of the Paris Convention, NAFTA, and TRIPS deal with this issue.

TLT

Article 10 contains a list of the requirements that can be made in respect of requests for the recordal of changes in the name or address of applicants, holders of registrations and representatives. It also provides that, with respect to the presentation of a request for the recordal of such changes, contracting parties must accept any request made in accordance with the prescribed model form. The office may only require evidence where it reasonably doubts the veracity of any indication contained in the request.

Protocol

Article 9^{bis} provides:

“The International Bureau shall record in the International Register

- (i) any change in the name or address of the holder of the international registration,
- (ii) the appointment of a representative of the holder of the international registration and any other relevant fact concerning such representative,
- (iii) any limitation, in respect of all or some of the Contracting Parties, of the goods and services listed in the international registration,
- (iv) any renunciation, cancellation or invalidation of the international registration in respect of all or some of the Contracting Parties,
- (v) any other relevant fact, identified in the Regulations, concerning the rights in a mark that is the subject of an international registration.”

Details of the procedures for requesting the recordal of changes or cancellations are set out in Rules 25 and 26 of the Madrid Regulations.

Upon recordal of a change, Rule 27(1) of the Madrid Regulations requires the IB to notify the offices of the designated contracting parties in which the change has effect. The CTMO may wish to include such international recordals affecting Canada in its own database; it would not, however, be entitled to charge a fee for so doing.

In accordance with Rule 27(5)(a) of the Madrid Regulations, “[t]he Office of a designated Contracting Party which is notified by the International Bureau of a limitation of the list of goods and services affecting that Contracting Party may declare that the limitation has no effect in the said Contracting Party. The effect of such a declaration shall be that, with respect to the said Contracting Party, the limitation shall not apply to the goods and services affected by the declaration.”

Rule 20 of the Madrid Regulations provides for the possibility of recording in the International Register restrictions on the holder’s right to dispose of the international registration with regard to all or some of the designated contracting parties. This could cover recordal of a security interest or a court order, for example relating to bankruptcy, concerning the disposal of the holder’s assets. The Protocol leaves to national law what the effect of such recordings would be.

Rule 20^{bis} of the Madrid Regulations provides for the possibility of recording licenses in the International Register in respect of designated contracting parties but does not impose any obligation to do so. In accordance with Rule 20^{bis}(5), the office of a designated contracting party which is notified by the IB of the recording of a license in respect of that contracting party may declare that such recording has no effect in that contracting party. Although not explicitly stated, it would appear that the intention of Rule 20^{bis} is that if no Rule 20^{bis}(5) declaration is made by a contracting party, the recordal of a license in respect of that contracting party should be given the same legal effect, if any, as a recordal of a license under that contracting party’s national legislation. Rule 20^{bis}(6) allows for a contracting party to in effect enter a reservation to the application of Rule 20^{bis} by notifying the IB that the recording of licenses in the international register has no effect in that contracting party. In order to ensure legal clarity, should Canada decide to join the Protocol, it may be desirable for Canada to make a Rule 20^{bis} declaration.

VIII. TERM AND RENEWAL

Canadian Law and Practice

S.46 CTMA provides:

“(1) The registration of a trade-mark that is on the register by virtue of this Act is subject to renewal within a period of fifteen years from the day of the registration or last renewal.

(2) If the registration of a trade-mark has been on the register without renewal for the period specified in subsection (1), the Registrar shall send a notice to the registered owner and to the registered owner’s representative for service, if any, stating that if within six months after the date of the notice the prescribed renewal fee is not paid, the registration will be expunged.

(3) If within the period of six months specified in the notice, which period shall not be extended, the prescribed renewal fee is not paid, the Registrar shall expunge the registration.

(4) When the prescribed fee for the renewal of any trade-mark registration under this section is paid within the time limited for the payment thereof, the renewal takes effect as of the day next following the expiration of the period specified in subsection (1).”

Paris Convention

Article 5^{bis} provides:

“A period of grace of not less than six months shall be allowed for the payment of the fees prescribed for the maintenance of industrial property rights, subject, if the domestic legislation so provides, to the payment of a surcharge.”

NAFTA

Article 1708(7) provides:

“Each Party shall provide that the initial registration of a trademark be for a term of at least 10 years and that the registration be indefinitely renewable for terms of not less than 10 years when conditions for renewal have been met.”

TRIPS

Article 18 provides:

“Initial registration, and each renewal of registration, of a trademark shall be for a term of no less than seven years. The registration of a trademark shall be renewable indefinitely.”

TLT

TLT Article 13 contains an exhaustive list of the requirements that can be made in respect of a request for renewal. TLT Article 13(2) provides that, with respect to the presentation of a request for renewal, contracting parties must accept any request made in accordance with the prescribed model form. TLT Rule 8 requires contracting parties to accept renewal fees at any time between six months before and, subject to a surcharge, six months after the expiry of the registration. TLT Article 13(7) would require s.46 CTMA to be amended to require fixed 10 year initial and renewal terms.

Protocol

Article 6 provides:

“Registration of a mark at the International Bureau is effected for ten years, with the possibility of renewal under the conditions specified in Article 7.”

Article 7 provides:

(1) Any international registration may be renewed for a period of ten years from the expiry of the preceding period, by the mere payment of the basic fee and, subject to Article 8(7), of the supplementary and complementary fees provided for in Article 8(2).

(2) Renewal may not bring about any change in the international registration in its latest form.

(3) Six months before the expiry of the term of protection, the International Bureau shall, by sending an unofficial notice, remind the holder of the international registration and his representative, if any, of the exact date of expiry.

(4) Subject to the payment of a surcharge fixed by the Regulations, a period of grace of six months shall be allowed for renewal of the international registration.”

In accordance with Rule 34(2) of the Madrid Regulations, renewal fees could be paid directly by the holder of the international registration to the IB. Renewal fees could also be paid using as intermediary the office of origin or the office of the contracting party of the holder if that office accepts to collect and forward the fees.

Pursuant to Rule 31(3) of the Madrid Regulations, “[t]he International Bureau shall notify the Offices of the designated Contracting Parties concerned of the renewal and shall send a certificate to the holder.” Pursuant to Rule 31(4) of the Madrid Regulations, where an international registration is not renewed in respect of a designated contracting party, the IB shall notify the office of that contracting party accordingly. Where the designation of a contracting party is cancelled for reason of non-renewal, the effect of the extension of protection in that designated party would cease with no possibility of transforming the international registration into a national registration.

IX. REQUIREMENT FOR LOCAL AGENT

[Note that some related issues are discussed above under the heading “Address for service”.]

Canadian Law and Practice

In accordance with ss.8 to 10 CTMR, trademark applications may be prosecuted by the applicant or a registered trademark agent appointed by the applicant. Where an appointed agent is not a resident of Canada, that agent must appoint an associate agent who resides in Canada. The CTMO will then correspond only with the associate agent.

Paris Convention, NAFTA IP Chapter, TRIPS Agreement

Nothing in the Paris Convention, the NAFTA IP Chapter or the TRIPS Agreement would prevent a contracting party from requiring trademark applicants to appoint a local agent in that contracting party.

Article 2(3) Paris Convention, Article 1703(3) NAFTA and Article 3 TRIPS all allow a contracting party to make an exception to national treatment in respect of the appointment of agents. This means that countries are free to require foreign applicants to appoint a local agent without at the same time imposing such a requirement on domestic applicants.

NAFTA Chapter on Cross-Border Trade in Services

Article 1205 of the NAFTA prohibits local presence requirements but Canada has made a permanent reservation to this Article in respect of its current treatment of trademark agents as is permitted under Article 1206 of the NAFTA. Article 1210(3) of the NAFTA prohibits any citizenship or permanent residency requirement for the licensing or certification of professional service providers. The NAFTA, however, makes a distinction between the term “permanent resident” as used in Article 1210(3) and the term “resident” which is used in both Article 1205 and the Canadian reservations made with respect to trademark agents. Accordingly, the NAFTA does not require any change to the current residency requirements for trademark agents as established under the Trade-marks Act.

TLT

Article 4(1) provides: “Any Contracting Party may require that any person appointed as representative for the purposes of any procedure before its Office be a representative admitted to practice before the Office.”

Protocol

Rule 3(1)(a) of the Madrid Regulations provides that an applicant or the holder of an international application “may have a representative before the International Bureau”. The only limitation on who can be appointed as a representative before the IB is that the representative must have an address complying with the requirements of Rule 3(1)(b). Rule 3(1)(b)(ii) specifies that the address of that representative shall be “in respect of an international application governed exclusively by the Protocol, in the territory of a Contracting Party bound by the Protocol”. Rule 3(1)(b)(iv) specifies that the address of that representative shall be “in respect of an international registration, in the territory of a Contracting Party” (meaning in the territory of a contracting party to either the Agreement or the Protocol irrespective of which instrument governed the original international application).

With respect to representation before the office of origin or the office of a designated contracting party, paragraph 09.02 of WIPO’s *Guide to the International Registration of Marks* states:

“References in the Regulations or in this Guide to representation relate only to representation before the International Bureau. The questions of the need for a representative before the Office of origin or the Office of a designated Contracting Party (for example, in the event of a refusal of protection issued by such an Office), of who may act as a representative in such cases and of the method of appointment in such cases, are outside the scope of the Agreement, Protocol and Regulations and are governed by the law and practice of the Contracting Party concerned.”

Rule 17(2)(vii) of the Madrid Regulations allows a contracting party to require in a refusal that any request for review of, any appeal against, or any response to, the refusal has to be filed through the intermediary of a representative whose address is within the territory of that contracting party.

Annex I

TRADEMARK LAW TREATY

CHANGES REQUIRED TO CANADIAN LAW AND PRACTICE

1. In accordance with TLT Article 3, s.30(c) CTMA could not be maintained as a mandatory requirement, i.e., Canada could not require that the information specified in s.30(c) be provided in every case where a trade-mark has not been used in Canada but is made known in Canada.
2. In accordance with TLT Article 3(1)(a)(vi), the CTMO could not specifically ask for a representative for service for court proceedings as under s.30(g) CTMA but it could deem a representative for service for procedures before the Trade-marks Office to also be a representative for court proceedings.
3. In accordance with TLT Article 3(1)(a)(x), drawings lined for colour could no longer be required; however, a reproduction of the mark in colour could be required in accordance with TLT Rule 3(2)(b).
4. In accordance with TLT Article 3(6) and Rule 3(6), it would be necessary to allow, subject to extension requests, at least three years from the date of allowance to file a declaration of use. It would probably be best to effect this change by amending s.40(3) CTMA although it may alternatively be possible to rely only on changes in CTMO practice.
5. An applicant could, within the time frame referred to in the previous paragraph, be required to include in a declaration of use an indication of the date of first use; however a date of first use could not otherwise be required. Some amendments therefore appear to be required to the CTMA and/or CTMR (including possibly amendments to s.30(b) CTMA and ss.25(a)(iii) and 31(d) CTMR).
6. In accordance with TLT Article 3(7)(iv), it would appear necessary to delete the requirement in s.31(1) CTMA for a certified copy of the foreign registration.
7. In accordance with TLT Article 4(3)(b), it would be necessary to accept appointments of agent signed by a person covering all existing and future applications and/or registrations of that person.
8. To comply with TLT Article 5, the requirement in s.25 CTMR that the name and address of the applicant be provided to obtain a filing date would have to be replaced by a requirement to provide: "indications allowing the identity of the applicant to be established".
9. TLT Article 7 requires that applicants be permitted to divide applications.
10. In order to help the CTMO comply with the requirement in TLT Article 9(1) to group and number goods and services in accordance with the Nice Classification, s.30 CTMA might be amended to require, in accordance with TLT Article 3(1)(a)(xv), applicants to do the grouping and numbering.
11. TLT Articles 10 and 11 would not permit the requirement in s.7 CTMR that correspondence respecting a change in a registered trademark include the application number or an indication of the trademark or the requirement that correspondence respecting a change in an application include an indication of the trademark.

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12. The evidence which TLT Article 11 permits to be required in support of a request to register a transfer is more limited than that which the Registrar of Trade-marks has the legal right to require under s.48(3) CTMA and s.48 CTMR. Although the current practice of the Registrar is consistent with TLT Article 11, it may be desirable to amend s.48(3) CTMA and s.48 CTMR to include the TLT Article 11 limitations.
 13. TLT Article 13(7) would require s.46 CTMA to be amended to provide 10 year initial and renewal periods.
 14. The Trade-marks Office would be required to accept the model international forms contained in the TLT regulations.
 15. In accordance with Item 8 of Form 1 of TLT, reproductions of trademarks would have to be accepted in a square of 8X8 cm.

Annex II

(copy of international application)