



November 16, 2009

Canadian Intellectual Property Office  
Trade-marks Branch  
50 Victoria Street  
Place du Portage II  
Gatineau, QC K1A 0C9

Attention: Iyana Goyette

Dear Ms. Goyette,

**Re: Consultation Use and Registration Abroad – (Section 16(2) of the *Trade-marks Act*)**

On behalf of the National Intellectual Property Section of the Canadian Bar Association (CBA Section), I am writing to respond to the request for comments on the Draft Practice Notice (Notice) regarding above-noted consultation. We welcome the opportunity to provide these comments.

We recently responded to another consultation by the Office, in relation to a draft Practice Notice on Extensions of Time Requests. The comments we made with respect to that consultation are relevant, and a copy of our submission is attached. Reliance upon s. 16(2) is an important and common ground of application. Filing of a certified copy of the foreign registration in order to complete the application is generally out of the control of the applicant, and therefore all necessary time to file that certified copy should be given to applicants.

We agree that any application that contains an “incomplete” claim under s. 16(2) should not be accepted, and that the examiners of the Trade-marks Office should continue to request any necessary amendments to applications that are not in accordance with the approved form for a s.16(2) filing basis. We assume in this context that “incomplete” refers to missing information or erroneous or incorrect statements.

However, the draft Notice raises several important concerns:

- The second bullet point in the Notice uses the words “...has been used as of the filing date in Canada.” This implies that a s. 16(2) claim requires the applicant to have used the mark in the Union country where the mark is already registered or an application for registration filed, *as of the filing date in Canada*. To the extent that it does so, the Notice is making law. Neither s. 16(2) nor s. 30(d) of the *Trade-marks Act* refer to use as of the

filing date. These words are also not found in the online form for a s. 16(2) claim. While subsequent judicial interpretation may or may not bear out this requirement, to the extent that the Notice imports a requirement that does not currently exist, it should be removed.

- The Notice has the potential to adversely affect registrations and applications that have issued in the past. The Trade-marks Office has permitted amendments to add in s. 16(2) claims up to the date of advertisement for over 50 years. If the Notice suggests a new limitation, namely that the use must have occurred at the date of filing in Canada, this could put hundreds of registrations at risk.
- Should an application contain an incomplete claim, the applicant or its agent should be given an opportunity to rectify that situation. The Registrar should not, as the Notice now reads, simply order that the application proceed to advertisement without the s.16(2) claim. The applicant should not lose a filing ground without the full opportunity to complete its application.
- Under the Notice, an applicant is able to make amendments only prior to the date of the decision of the Registrar to advertise the application. Apart from the uncertainty of when the Registrar's decision to advertise occurs, s. 30 of the *Regulations* explicitly permits applications to be amended either before or after the application is advertised "except as provided in sections 31 and 32." Section 32 of the *Regulations* directs that an amendment "from one that does not allege that the trade-mark has been used and registered in or for a country of the Union to one that does so allege" cannot be made after advertisement in the Journal. Thus, any amendment to add this ground should be permitted until the day of advertisement. Any change to an earlier date would need a regulatory amendment.
- The Notice incorrectly lists the criteria to complete a s. 16(2) claim. The Notice indicates that an application is "complete" when particulars of the application are provided. However, this omits the requirement to file a certified copy of the foreign registration. An application is not complete when only the particulars of the application/registration and the use claim are before the Registrar.

If the Registrar wishes to clarify what constitutes a proper s. 16(2) claim, we suggest that the Notice be revised as follows:

The Trade-marks Office considers that claims made under subsection 16(2) of the *Trade-marks Act* are complete when the Office has received:

- full particulars of the registration of the trade-mark in or for the country of origin of the applicant;
- the name of a country in which the applicant has used the mark; and
- a certified copy, or photocopy of a certified copy of the applicant's foreign registration.

If the Application contains an incomplete s. 16(2) claim, the applicant or its agent will be asked to correct the claim. Failure to do so within the time specified, subject to any granted extension of time, will result in the application being found to be in default. Any

amendment of an application to add a s. 16(2) claim must comply with the *Regulations*. In particular, amendments must be received prior to advertisement (s. 30(d) of the *Regulations*).

We would be happy to discuss this matter with CIPO at any time.

Yours truly,

*(Original signed by Kerri Froc for Alexandra Steele)*

Alexandra Steele  
Chair, National Intellectual Property Section



THE CANADIAN  
BAR ASSOCIATION  
L'ASSOCIATION DU  
BARREAU CANADIEN

October 30, 2009

Canadian Intellectual Property Office  
Regulatory Affairs  
50 Victoria Street  
Phase II, 4<sup>th</sup> Floor  
Gatineau, QC K1A 0C9

Attention: Patrice Lemyre

Dear Mr. Lemyre:

**Re: Proposed Practice Notice - Extensions of Time in Examination**

On behalf of the Trade-marks Committee of the Canadian Bar Association's National Intellectual Property Section (CBA Committee), I am pleased to respond to the above-noted consultation. We appreciate CIPO's desire to streamline the examination process while still serving the needs of clients. However, the CBA Committee believes that the uncertainty created by the proposed Practice Notice would outweigh any advantages. Our reasons for this position are set out in detail below.

**Current System**

The current Practice Notice dated July 15, 1998, states:

The Office currently grants extensions of time of six months upon expiration of the time limit to respond to an examiner's report, if the request is justified.

[U]pon the expiration of twelve months from the deadline to respond to an examiner's report, the office will require significant substantive reason(s) which clearly justify a further extension of time and which set out in detail the reason why it is not yet possible to respond to an examiner's report.

If the applicant files a request for an extension of time but fails to satisfy the requirement for significant substantive reasons, the applicant is given a warning that the reasons provided would not be sufficient for the grant of a future extension of time.

## **Proposed Practice Notice**

The proposed Practice Notice indicates that one extension of time of up to six months will generally be granted, and that further requests for extensions will generally not be considered. It goes on to state:

Upon the expiration of twelve months from the initial date of the examiner's report, the Office will require significant substantive reason(s), which clearly justify a further extension of time and which set out in detail the reason(s) why it is not yet possible to file a proper response to an examiner's report.

If at the expiry of the twelve month period mentioned above the applicant fails to file a proper response or if the reasons provided are not considered to justify a further extension of time, the applicant will be considered in default in the prosecution of the application pursuant to provisions of Section 36 of the *Trade-marks Act* and a notice of default will be issued.

The proposed Practice Notice specifically states that the applicant will not be permitted to file a request for an extension of time to remedy a default.

## **Detriments to Applicants**

There are numerous situations where a twelve-month period would not be considered to be adequate time to respond to an Examiner's Report. These include:

- when the application is based on a foreign registration that has yet to issue to registration;
- when an application includes a claim based on sections 12(2), 13 or 14 of the *Trade-marks Act* (the *Act*), requiring the applicant to produce substantial evidence in support of the claims;
- when a summary challenge has been initiated under section 45 of the *Act* in relation to a cited registration and a decision has yet to be rendered;
- when there is an ongoing opposition proceeding involving a cited mark;
- when a section 9 owner is in the process of withdrawing a cited official mark;
- when a third party cited registration is due for renewal in the immediate future or a cited application appears to be in default;
- when there is ongoing litigation involving the cited registration (in particular, when the validity of the cited registration is being challenged);
- when there is a change in owner of an application close to the deadline for responding to the Examiner's Report; and
- when there is a change in the agent or representative for service for the application in question or a change in the instructing principal for the application close to the deadline for responding to the Examiner's Report.

This list is meant to provide examples only and is not exhaustive of the situations where an extension of time beyond a twelve-month period would be warranted.

An effective system requires a degree of certainty. While the existing Practice Notice also provides no details as to what “significant substantive reasons” would justify a further extension, we believe that if CIPO should provide this clarification in any new Practice Notice. An applicant who faces one of the above situations and who has applied for an extension of time beyond the twelve month period from the initial date of the Examiner’s Report should be assured, prior to the filing of the extension request, that the above would justify a further extension.

However unintentional, we believe that the new practice could also result in some clearly unjust situations. For example, it appears that an extension request will not be granted to remedy a default situation, regardless of the circumstances. Even in the case where an application is placed into default as the result of an applicant failing to receive an Examiner’s Report, the new Practice Notice seems to prevent the default from being remedied by an extension request.

Further, it is unclear what constitutes a “proper” response to Examiner’s objections. There should be clarification that if an applicant files a response to some but not all objections, this will still be considered a proper response, and that CIPO intends to continue the current practice of permitting applicants to file further submissions if the initial response does not overcome the Examiner’s objections. Alternatively, if CIPO does not intend to follow its current practice, this should be stated clearly.

### **Impetus for Change**

We do not believe that there was any pressure from the public, applicants and practitioners, for a change to the current Office practice relating to extensions. If this change is seen as necessary or desirable from the perspective of the Office, we would appreciate more information about the reasons that would justify the potential negative effect on applicants. We anticipate that the effect of the proposed Practice Notice will be felt particularly by Canadian practitioners receiving instructions from foreign associates on behalf of foreign applicants, who generally require more time to respond to Examiner’s Reports. This is due to such factors as translation, the differences between the applicant’s domestic legal system and ours, and the desirability of coordinating the prosecution of applications in many jurisdictions.

### **Alternate Proposal**

If the goal of the proposed change is to expedite the examination process, an alternative may be to utilize the existing warning system more frequently in cases where further extensions of time do not seem warranted. This will ensure that applicants consider the matter carefully before filing extension requests while at the same time preventing defaults where applicants are actively engaged in moving their applications forward.

We would appreciate the opportunity for further dialogue before any implementation of a change in the practice regarding the grant of extensions of time in examination occurs.

Yours very truly,

*(Original signed by Kerri Froc for Marijo Coates)*

Marijo Coates  
Co-Chair, Trade-marks Committee  
National Intellectual Property Section