THE CANADIAN BAR ASSOCIATION
L'ASSOCIATION DU BARREAU CANADIEN

May 20, 2010

Stephanie Golden
Canadian Intellectual Property Office
Regulatory Affairs
50 Victoria Street
Place du Portage Phase II, 4th Floor
Gatineau, QC K1A 0C9

Dear Ms. Golden:

**Re: Proposed Practice Notices – "Persons", "Description of Colour Claims" and "Opposition Deemed Withdrawn, Application Deemed Abandoned"**

On behalf of the National Intellectual Property Section of the Canadian Bar Association (CBA Section), we are pleased to comment on the proposed practice Notices posted on the Consultation and Discussions section of the website of the Canadian Intellectual Property Office (CIPO) (www.cipo.gc.ca), on April 20, 2010.

Our position on the proposed notices is as follows:

- We support the changes suggested by CIPO in the proposed Notice on "**Persons**".
- We suggest modifications to the proposed Notice on "**Description of Colour Claims**", to accomplish the objective of allowing clear and accurate colour claims in applications.
- We do not support the proposed Notice on **"Opposition Deemed Withdrawn, Application Deemed Abandoned"** and strongly favour the current practice. If CIPO's intent is to give more certainty to time lines, we make suggestions to assist in resolving this issue without risk of unfairness and resulting decline in public confidence in the registration system.

We provide further comments on the latter two proposed Notices below.

**"Description of Colour Claims"**

The *Trade-marks Act* currently provides that unless a mark is for a word not depicted in special form, there must be a drawing. If colour is claimed as part of the mark, Rule 28 of the *Trade-marks Regulations* specifies that the colour must be described. Rule 28 also allows for a drawing of the mark to be lined for colour using the colour chart set out in the Rule. The colour chart does not include the full spectrum of colours. In many cases, applicants choose a written description of the colour(s) of their marks , either due to the limitations of the chart or because the colours can be described more accurately in writing.

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The objective of the Rule is to ensure the colour(s) in the mark are clearly represented. No doubt, this is also the rationale behind the proposed Notice. The proposed Notice suggests the use of a colour code and reference system where the lining in Rule 28 will not work. The proposed Notice provides the example of the PANTONE system, although the Office is clear that it does not endorse one system over any other.

Providing applicants with choice in how to clearly describe the colours in their marks is helpful. However, we believe there should be flexibility in whether a colour code and reference system is used. For example, a clear written description can be more effective in some cases than a colour system or the chart set out in Rule 28. This is especially true when describing the fading of one colour to another. We support allowing applicants to use (a) the Rule 28 chart through lined drawings, (b) a written description clearly setting out the colours, or (c) a colour code and reference system. We suggest the following amendment to paragraph 3 of the proposed Notice:

> Where the colour claim is for a colour not found in Rule 28 of the Trade-marks Regulations, the applicant is required to include a written description of the colour(s) or a description of the colour code and reference system for each colour(s) claimed. Should…

If applicants are permitted only to use either the Rule 28 chart or a colour code and reference system, this can result in disparities in protection for their marks. The colour code and reference system is much more specific than the Rule 28 chart. Applicants fortunate enough to have colours falling within the Rule 28 chart would have broad protection for their colour marks, while those unfortunate enough to fall outside the chart would have narrower protection. We do not believe this was the intent of this proposed Notice, and could be avoided by our suggested amendment.

We recognize that one of CIPO's goals is to become more electronically efficient. We support the goal of improving CIPO's electronic capability to the point that it will be easier to deal with colour claims and that descriptions will become unnecessary.

**"Opposition Deemed Withdrawn, Application Deemed Abandoned"**

The current practice in situations involving the withdrawal of an opposition or the abandonment of an application, either during opposition or after allowance, is to send two letters. The first letter provides a "warning." The warning letter avoids applicants being penalized by an inadvertent error arising from either inaction or a mistake by practitioners, by self-filing applicants or by the Opposition Board or Office itself. Anecdotal evidence from practitioners suggests that these errors are growing in number. We are aware of instances where practitioners have missed deadlines due to docketing issues. We are also aware of instances where the Office has lost correspondence or even entire files, where mail has been misdirected and never reached the right addressee, and where properly filed opposition evidence has gone missing at the Opposition Board. Only after the "warning" letter does not resolve the situation, the second letter is sent making abandonment or withdrawal final. We heartily endorse the current practice.

We believe that the proposed Notice's intent was to reduce or eliminate seemingly repetitive steps. However, eliminating the "warning" letter could result in applicants or opponents being denied the right to continue their applications or oppositions through no fault of their own. The manifest unfairness of that situation would result in a loss of public confidence in the registration system.

Further, the proposed Notice indicates that the Registrar considers that "there is no authority" to grant a retroactive extension in these situations. It is our understanding, having reviewed the case law, that there is authority to grant retroactive extensions in oppositions where there has been a deemed abandonment or withdrawal: see, for example, *Bensusan Restaurant Corp.* v. *Blue Note Restaurant Inc.* (2000), 10 C.P.R. (4th) 550. We do not understand the basis for the Registrar's belief and ask that if the proposed Notice proceeds, that this element in particular be reconsidered.

However, we recommend that CIPO not proceed with the proposed Notice and look at alternate means of reducing time delays in situations involving "deemed" abandonment or withdrawal. We suggest that the Office or Opposition Board consider providing applicants and opponents with a set deadline to respond to the first letter setting out the deemed abandonment or withdrawal situation. That time frame could be relatively short, for example, four weeks. After this deadline, the second letter making the abandonment or withdrawal final could be sent automatically. This would still maintain the benefits of the current practice – allowing parties the time to identify inadvertent errors or breakdowns in communications between the applicant or opponent and the Office or Opposition Board.

Changing from a system allowing for inadvertent errors to be easily corrected to one where correction must be addressed through the courts seems to be a significant step backward. Parties will be forced to take action to protect substantive rights at great cost, both in terms of expense and public confidence in the system. We do not believe that this was the intent of the proposed Notice. If CIPO instead makes the change we suggest, it will gain certainty in its time lines for handling files and the inherent fairness of the current system will be preserved.

We would be pleased to discuss any of these submissions at greater length with CIPO.

Yours very truly,

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

Alexandra Steele
Chair, National Intellectual Property Section