



THE CANADIAN
BAR ASSOCIATION
L'ASSOCIATION DU
BARREAU CANADIEN

August 10, 2022

Via email: iyana.goyette@ised-isde.gc.ca

Trademarks and Industrial Designs Branch
Canadian Intellectual Property Office
Innovation, Science and Economic Development Canada
Place du Portage, Phase 1
50 Victoria Street
Gatineau, QC K1A 0C9

Dear Ms. Goyette:

Re: Public consultation on a new trademark practice notice

I write on behalf of the Intellectual Property Section of the Canadian Bar Association (the CBA Section), in response to CIPO's May 2022 consultation notice about the proposed practice notice¹ on requesting the Registrar of Trademarks to give public notice under subsection 9(4) of the *Trademarks Act*.

The Canadian Bar Association is a national association representing over 37,000 jurists, including lawyers, notaries, law teachers and students across Canada. We promote the rule of law, access to justice and effective law reform, and offer expertise on how the law touches the lives of Canadians every day. The CBA Section deals with law and practice relating to all forms of ownership, licensing, transfer and protection of intellectual property and related property rights, including patents, trademarks, copyright, industrial designs, plant breeders' rights, as well as trade secrets.

Overview

Section 215 of the *Budget Implementation Act, 2018, no. 2*² amends the *Trademarks Act* to create a simple mechanism to allow the Registrar to give public notice that subparagraph 9(1)(n)(iii) does not apply with respect to a badge, crest, emblem or mark that was the subject of a public notice of adoption and use as an official mark, if the entity that made the request for the public notice is not a public authority or no longer exists.

¹ Practice notice- Official Marks pursuant to subparagraph 9(1)(n)(iii): [online](#).

² *Budget Implementation Act, 2018, no. 2*: Introduced as Bill C-86, [online](#).

Subsection 9(4) of the *Act* states that the Registrar may, on their own initiative or at the request of a person who pays the prescribed fee (the requesting party), give public notice that subparagraph 9(1)(n)(iii) of the *Act* does not apply to the official mark. This notice may be given if the relevant entity (the holder) making the request for the public notice is not a public authority or no longer exists. On receipt of a request and payment of the prescribed fee, the request and the relevant file will be reviewed. If the Registrar is satisfied that it is necessary to do so, a notice will be sent to the official mark holder requesting evidence of the holder's public authority status. If the Registrar is not satisfied, a public notice will not be sent to the holder of the official mark.

The CBA Section has several comments on the draft practice notice:

Communication procedures

The practice notice should clarify whether requests can be submitted electronically or through the CIPO platform.

Required information and fee

The practice notice states that the requesting party should give information or evidence demonstrating that the official mark holder is not a public authority or no longer exists. We suggest clarifying how the evidence should be submitted. Presumably it would be by affidavit or statutory declaration. To avoid frivolous or abusive requests, we suggest a fee of \$750, or \$500 (the fee to request publication of the notice).

Reasons why the Registrar may not send a notice to the official mark holder

The reference to a “municipal government entity” in the practice notice is unclear and should be removed. The only issue is whether the holder is a public authority.

The reference to the fact that the request “does not raise any doubt” about the holder’s public authority status or its existence in the practice direction is inconsistent with the wording of subsection 9(3) and the reference to an “initial assessment.” We recommend amending the practice notice to clarify when the threshold is triggered: Does the requesting party have to raise a doubt as to whether the holder is a public authority, or establish that the holder is not a public authority?

Notice to the official mark holder

We suggest clarifying that a copy of the notice will be sent to the appointment agent of the holder.

Timing

The holder should be treated like the requesting party to file evidence. Presumably, the evidence should be in the form of an affidavit or a statutory declaration.

Extension of Time

The proceeding and its consequences can be significant for the holder. As a result, the holder should have an opportunity to seek additional time without having to show exceptional circumstances as defined because the procedure affects their substantive rights. The reasons for an extension of time should include that more time is required to consider the notice and file a proper response. This is consistent with section 9 in the *Extensions of time in Examination and to respond to a section 44.1 practice notice*³.

³ *Extensions of time in Examination and to respond to a section 44.1 practice notice*: [online](#)

Consequences of insufficient evidence of public authority status from the holder

The confirmation of insufficient evidence should be sent to the holder, the relevant agents and the requesting party. We recommend that the holder be given a full opportunity to respond, as is the case during Examination, regarding evidence sufficiency if the Registrar is of the view that it falls short. It is likely less cumbersome for CIPO and public authorities to resolve the issue at the outset, rather than triggering multiple new proceedings.

Thank you for soliciting our input. We would be pleased to discuss our feedback with you.

Yours truly,

(original letter signed by Julie Terrien for Vincent Yip)

Vincent Yip
Chair, Intellectual Property Section