

TECHNICAL ASPECTS REGARDING THE TRANSFER AND CHANGE IN OWNER OF A TRADE-MARK IN CANADA

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On December 5th, 2001, the Canadian trade-marks office issued a practice notice intended to provide guidance on its current practices governing some technical aspects of transfers and change of names. Although welcomed, this notice left some doubts on the nuts and bolts of changes affecting a trade-mark since the earlier and sometimes contradictory practice notices were not repealed. Hence the following clarification.

ASSIGNMENT

Legal basis: section 48 and rule 48.

Documents to be furnished: "evidence satisfactory to the Registrar of the transfer". It could be the instrument of transfer (original, certified copy, photocopy or telecopy of same, in English or French, with the date of assignment and executed by the assignor); it could also be an original, certified copy, photocopy or telecopy, in English or French, of a notarial declaration as to the assignment, with a reference to the date of the assignment.

Further details: the address of the assignee should be furnished and, absent an address in Canada, the name and address of a Canadian representative for service should be indicated.

Power of attorney: not required.

Statutory Fees: \$50.00 per trade-mark, whether registered or not.

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Comment: no need to amend a pending application to reflect the current assignee; the name of the assignor shall be the same as the one referred to in the application or registration.

CHANGE OF ADDRESS

Legal basis: paragraph 41(1)(a).

Documents to be furnished: no supporting documents required; a request wherein the new address is given shall be sufficient; an indication of the date of change of address is optional but if no date is furnished the record will indicate the date of the request as the date of the change.

Power of attorney: not required.

Statutory Fees: \$25.00 per request, irrespective of the number of trade-marks, registered or not, included in the same request; no fees to be paid if the request is for pending applications only.

Comment: no need to amend a pending application to reflect the new address.

CHANGE OF NAME

Legal basis: paragraph 41(1)(a).

Documents to be furnished: no supporting documents required; a request wherein the new name is given shall be sufficient; an indication of the date of the change of name is optional; if documents are nevertheless submitted, the former name, exactly as indicated on the Register, and the new name should appear on the documents submitted.

Power of attorney: not required.

Statutory Fees: \$25.00 per registered trade-mark; no fees for pending applications.

Comment: a pending application should be amended to reflect the new name of the applicant.

CHANGE OF CORPORATE STRUCTURE

Legal basis: paragraph 41(1)(a).

Documents to be furnished: it could be the instrument evidencing the change (original, certified copy, photocopy or telecopy of same, in English or French, with the date of change); it could also be an original, certified copy, photocopy or telecopy, in English or French, of a notarial declaration as to the change, with a reference to the date of the change.

Power of attorney: not required.

Statutory Fees: \$25.00 per registered trade-mark; no fees to be paid if application is pending.

Comment: no need to amend a pending application to reflect the change; if this change amounts to an assignment, it should be treated accordingly.

MERGER

Legal basis: paragraph 41(1)(a).

Documents to be furnished: it could be the instrument evidencing change (original, certified copy, photocopy or telecopy of same, in English or French, with the date of merger); it could also be an original, certified copy, photocopy or telecopy, in English or French, of a notarial declaration as to the change, with a reference to the date of the merger.

Power of attorney: not required.

Statutory Fees: \$25.00 per registered trade-mark; no fees to be paid if application is pending.

Comment: no need to amend a pending application to reflect the change; if this change amounts to an assignment, it should be treated accordingly.

CANCELLATION (Voluntary)

Legal basis: paragraph 41(1)(b).

Documents to be furnished: no supporting documents required; need only a request (original, certified copy, photocopy or telecopy of same) from the owner, its representative for service or a trade-mark agent alleging to be a representative of the owner.

Power of attorney: not required.

Statutory Fees: \$25.00 per registered trade-mark; no fees for pending applications.

APPOINTMENT OF AGENT

Legal basis: subsection 42(1) and rule 11.

Documents to be furnished: none since "appointment of trade-mark agent need not to be in writing".

Power of attorney: not required.

Statutory Fees: \$25.00 per request, irrespective of the number of trade-marks, registered or not, included in the same request; no fees to be paid if the request is for pending applications only.

Comment: no need to amend a pending application.

LIEN (OR LICENCE)

Legal basis: paragraph 26(2)(c).

Documents to be furnished: original, copy, photocopy or telecopy of the document "affecting the rights to the trade-mark".

Power of attorney: not required.

Statutory Fees: \$25.00 per registered trade-mark; no fees for pending applications.

Comment: a lien, a licence or a judgment affecting a pending application will only appear at the time of the registration; same fees and documents for the removal of a lien, licence or judgments.

DECLARATION OF USE

Legal basis: subsection 40(2).

Documents to be furnished: original, certified copy, photocopy or telecopy of the executed declaration (simple signature of representative; no notarization, legalization or oath required).

Power of attorney: not required.

Statutory Fees : \$200.00 final fee to be paid ; no fees if extension to existing registration.

Comment: no specimen or proof of use required.

CORRECTING AN ERROR

Legal basis: paragraph 41(1)(a) and rule 33.

Documents to be furnished: supporting documents (original, certified copy, photocopy or telecopy of same) and explanation as to the nature of the error.

Power of attorney: not required.

Statutory Fees : \$25.00 per registered trade-mark; no fees for pending applications.

Comment: no fees to be paid if the error emanates from the Registrar; modifications affecting the identity of the applicant, the trade-mark, the basis of the application or the description of the wares and services shall be made in accordance with rules 30 to 33.

AMENDMENT TO THE STATEMENT OF WARES (which does not extend it)

Legal basis: paragraph 41(1)(c) and rule 31(e).

Documents to be furnished: none, but simply a request from the owner, its representative for service or a trade-mark agent alleging to be a representative of the owner.

Power of attorney: not required.

Statutory Fees : \$25.00 per registered trade-mark; no fees to be paid if application is pending.

Comment: if this amendment is to extend the statement of wares or services of a registered trade-mark, statutory fees are at \$300.00 at the time of the filing, but there are no final fees to be paid; the statement of wares or services of an unregistered trade-mark cannot be extended until the issuance of the registration.

AMENDING THE DEFINED STANDARD

Legal basis: paragraph 41(1)(d).

Documents to be furnished: no supporting documents; a request by the registered owner, its representative for service or a trade-mark agent alleging to be a representative of the registered owner, which request states the particulars of the defined standard of the certification mark.

Power of attorney: not required.

Statutory Fees : \$25.00 per registered certification mark; no fees to be paid if application is pending.

DISCLAIMER

Legal basis: paragraph 41(1)(e).

Documents to be furnished: no documentation required; need only a request signed by the owner, its representative for service or a trade-mark agent alleging to be a representative of the owner.

Power of attorney: not required.

Statutory Fees : \$25.00 per registered trade-mark; no fees to be paid if application is pending.

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