

AN OVERVIEW OF THE TRADE-MARKS REGULATIONS (1996)

by

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The *Trade-Marks Regulations* (1996) were published in the 1996.05.01 edition of the *Canada Gazette - Part II* (vol. 130, No 9, pp. 1306 - 1326) and came into force on 1996.04.16 (DORS/96 - 195 P.C. 1996-490). Here is a brief overview of these regulations.

GENERAL PROVISIONS AND CORRESPONDENCE: RULES 1 - 17

One may now correspond with the Registrar by facsimile for all matters, other than for an application for the registration of a trade-mark (r. 3). Communication can be made (except for the Opposition Board) with the general number for the mail room at, (819) 997-3671. A facsimile is deemed to be received by the Registrar on the day it is transmitted, where the transmission takes place before midnight, at Hull time. Transmission by facsimile does not require a copy of confirmation. The following, however, can not be transmitted by facsimile: whatever requires to be accompanied by payment and whatever is required to be signed on the original (for example, evidence in opposition matters or in a section 45 proceedings).

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The general rule pertaining to correspondence is that in order to cancel the registration of a trade-mark, or, to appoint a representative for service (section 41(1)), each communication addressed to the Registrar shall deal with only one application or one registration of a trade-mark (r. 5). This is not the case however for the transfer of rights, (section 48) and for the change of name or address of an applicant or of a registered owner.

If the trade-mark application is pending, the correspondence must indicate the name of the applicant, as well as the application number (if available) and the trade-mark itself. If the trade-mark is registered however, one must indicate the registration number, the application number and the trade-mark itself (r. 7). If an address needs to be furnished it should include the street name and number (if it exists) and the postal code (r. 6).

All documents filed with the Office of the Registrar of Trade-marks shall be presented on white paper. The document does not necessarily have to be typed, however it must be presented clearly and legibly. It should measure (r. 13) a minimum of 8 1/2" x 11" (21 cm x 28 cm) and a maximum of 8 1/2" x 14" (22 cm x 35 cm). Left and upper margins should measure at least 1" (2.5 cm). (Theoretically, these dimensions should also apply to evidence that is filed).

The regulations no longer include forms in Schedule II. Moreover, there is no longer the requirement that the seal of the Trade-Mark Office be appended on certificates issued by the Registrar. The prescribed fees are now payable to the Receiver General, in Canadian currency, and must be forwarded to the Registrar (r. 12).

Finally, the French translation of the Trade-Marks Journal has become the *Journal des Marques de Commerce* (r. 2).

TRADE-MARK AGENTS: RULES 18-23

To be eligible to sit for a qualifying examination, one must meet one of the following conditions. Either be a barrister or solicitor entitled to practise as such in a province, or, a notary entitled to practise as such in the province of Quebec. Otherwise, one must have worked in Canada in the area of Canadian trade-mark law and practice including the preparation and prosecution of applications for the registrations of trade-marks, for a period of not less than 24 months. The rules do not specify if the work necessarily has to be on a continuous basis nor if it necessarily has to be under the supervision of a registered agent. Furthermore, the previous "proof of good reputation" requirement no longer exists (r. 18).

The following persons may be entered on a list of trade-mark agents:

- (a) A Canadian resident who has passed the qualifying examination;
- (b) A barrister solicitor, or notary entitled to practice as such in the province of Quebec, who has submitted an affidavit declaring that he has worked for at least 24 months in the area of trade-mark law including the preparation and prosecution of applications for registration of trade-marks (the rules do not specify if it has to be Canadian trade-mark law nor if the years of work necessarily have to have been on a continuous basis in Canada).
- (c) A resident of any other country who is entitled to practise before the Trade-Marks Office of that country. If he does not reside in Canada, however, he shall appoint an associate agent who is a resident of Canada (r. 9);
- (d) Any firm having the name of at least one of its members entered on the list as a trade-mark agent (r. 21).

As to the Examining Board, its members are appointed by the Registrar. The Registrar is no longer a member of the Examining Board (r. 19). With regards to the renewal of one's registration as trade-mark agent, the Registrar will in the future send only one notice of renewal (r. 22).

APPLICATIONS FOR REGISTRATION: RULES 24 - 29

The previous requirement to file a specimen of the trade-mark no longer exists. Rather, the Registrar may require that a specimen of the trade-mark as used be furnished if he deems it to be appropriate. This policy applies retroactively for all pending applications (r. 29).

Applications for the registration of trade-marks no longer require to be signed. This may predict future filing by electronic mail (r. 25). The Registrar requires that only one drawing of a trade-mark be included with the application (r. 25). The drawing shall be in black and white and in the following format (r. 27):

- (a) It shall be no larger than 2 3/4" by 2 3/4" (7cm x 7cm).
- (b) It may be reproduced on paper that satisfies the requirements of r.13.

- (c) The Registrar may require an applicant to file a new drawing if it is not suitable for reproduction in the journal.

However, rule 28 provides that if in an application for trade-mark registration a colour is claimed as a feature, the colour shall be described. If the description is not clear, the Registrar may require the applicant to file a drawing lined for colour in accordance with the colour chart found at r. 28(2)

Rule 29 provides that the Registrar can require the translation in either French or English of what is not in either of these two languages. Furthermore, he may also require a transliteration of the material where the trade-mark contains material expressed in characters other than Latin characters or in numerals other than Arabic or Roman numerals.

Rule 25 was harmonized with section 34 of the *Act*, so that the date of the filing of an application is deemed to be the priority date claimed.

Note that rule 25 a)(iii)(B) does not take into consideration the new wording of paragraphs 16(2) of the *Act* (*i.e.*, in or for the country of origin) and 30 d) of the *Act* (*i.e.*, in or for another country of the Union). An amendment should be expected.

AMENDMENTS OF APPLICATIONS: RULES 30 - 34

Applications for the registration of a trade-mark can still be amended (r. 30). However, it is now clear that when a trade-mark application based on use or making known, has been advertised, it cannot be amended into an application for a proposed trade-mark.

It is now possible for the Registrar to correct clerical errors in any instrument of record, whether the error is discovered by the Registrar or a request is made by the applicant, registered owner or trade-mark agent of the applicant or registered owner. The certificate of correction no longer exists.

STATEMENT OF OPPOSITION: RULES 35 - 47

The statement of opposition must still be filed with the Registrar in duplicate (r. 38). All correspondence in respect of an opposition must clearly state that it relates to the opposition proceeding (r. 35).

A copy of all correspondence in an opposition proceeding must be forwarded to the other party involved. This requirement does not apply,

however, to the initial statement of opposition nor does it apply to written arguments (r. 36 and section 38(5) of the Act). Every exhibit to an affidavit or declaration filed in an opposition has to be filed with the affidavit or declaration (r. 45).

Documents are served either by registered mail, or, served personally. Priority mail, messenger services or facsimile are not accepted means of service. One may however correspond with the Registrar by facsimile. The number for the Opposition Board is: (819) 997-5092 (r. 3).

Former rules 40 to 49 have been re-numbered 38 to 47. Rule 39 pertains to the filing and service of the counter-statement of opposition; rule 41 pertains to the filing with the Registrar and service on the applicant of the evidence of the opponent by way of affidavit, or statutory declaration, or the statement that the opponent does not wish to submit evidence.

Rule 42 pertains to the evidence of the applicant and rule 43 covers evidence in reply. Cross-examinations and the admissibility of additional evidence are dealt with at rule 44. Additional evidence may be adduced at any time until a decision is rendered with leave of the Registrar and on such terms as the Registrar determines to be appropriate. Cross-examinations, however, are only possible before the Registrar gives notice that the parties may file written argument.

Hereinbelow is a table of those steps and related rules::

Statement of opposition	r. 38 et ss. 38(1)
Counter-statement	r. 39 et ss. 38(6) default ss. 38(7.2)
Evidence of the opponent	r. 41 et ss. 38(7) default ss. 38(7.1) and r. 41(2)
Evidence of the applicant	r. 42 et ss. 38(7) default ss. 38(7.2) and r. 42(1)
Reply evidence	r. 43 et ss. 38(7)
Request for cross-examination	r. 44(2)
Filing of the transcript	r. 44(4)
Withdrawal of affidavit	r. 44(5)
Filing of written arguments	r. 46(2)
Request for hearing	r. 46(4)

The Registrar's practise of withdrawing evidence from the file for failure to attend a cross-examination is now official (r. 44(5)). The party who proceeds with a cross-examination is responsible for the filing of transcripts, supporting documents and answers to undertakings (r. 44(4)). (However, the question

concerning the filing of a part of the cross-examination or a part of the re-examination still remains unclear).

The amendment to a statement of opposition or to a counter-statement is possible with leave (r. 40). Moreover, where in an opposition proceeding any extension of time is granted to a party, rule 47 provides that the Registrar may thereafter grant a reasonable extension of time to the other party for the taking of any subsequent step.

TRANSFER: RULES 48 - 50

The Registrar no longer requires the original instrument of transfer or a certified copy therefor, rather, evidence of the transfer alone is now sufficient (r. 48); photocopies or facsimiles are accepted.

The partial transfer of a trade-mark that is registered or is the object of an application for registration can be recognized by the Registrar. If it concerns an application for registration (r. 49), the Registrar may recognize the transfer; each owner must file an amendment of that application restricted to those wares or services for use in respect of which the person owns the trade-mark. Each said amended application will be considered as a continuation of the original application for the purposes of preserving the benefit of the date of filing of the original application, but each amended application will otherwise be treated in subsequent proceedings as a separate application. If the transfer pertains to a trade-mark that is already registered (r. 50), each owner is deemed to be a separate registered owner, and for the purposes of sections 43 to 46 of the Act, is deemed to have a separate registration of the trade-mark.

REGISTER: RULES 51 - 52

The kind of information that the Registrar must keep on the register of trade-marks has been revised in order to take into consideration the amendments to the Act.

OBJECTION TO AN INDICATION OF ORIGIN: RULES 53 - 61

Section 11.13 of the Act provides that an interested person may file a statement of objection within three months after the publication in the Canada Gazette of a statement by the Minister in respect of a geographical indication. The new rules, concerning objection proceedings are similar to those for opposition proceedings.

Hereinbelow is a table of those steps and related rules::

Statement of opposition	ss. 11.13(1)
Counter-statement	ss. 11.13(4) default ss. 11.13(4) <i>in fine</i>
Evidence of the opponent	ss. 11.13(5) and r. 55(1) default ss. 11.13(6) et r. 55(2)
Evidence of the authority	ss. 11.13(5) and r. 56
Reply evidence	ss. 11.13(5) and r. 57
Request for cross-examination	ss. 11.13(5) and r. 58(2)

Filing of the transcript	r. 58(4)
Withdrawal of evidence	r. 58(5)
Filing of written arguments	r. 60(3)
Request for hearing	r. 60(4)

The service of proceedings and evidence thereto are effected by registered mail or by personal service (r. 53). The person objecting must file the statement of objection with the Registrar and serve it on the responsible authority (subsection 11.13(1) of the Act). An amendment of a statement of objection or counter-statement is possible with leave from the Registrar (r. 54).

Where in an objection proceeding any extension of time is granted to a party, the Registrar may thereafter grant a reasonable extension of time to the other party for the taking of any subsequent step (r. 61). Moreover, additional evidence may be adduced where leave is granted by the Registrar (r. 58(1)).

However, the sole reason for an objection is that the indication is not a geographical indication (subsection 11.13(2) of the Act).

TRADE-MARKS: SUGGESTED FORMS

Paragraph 65 b) of the Act permits the Governor in Council to make regulations for carrying into effect the purposes and provisions of this Act, namely on the form of applications to the Registrar. In virtue of rule 15 of the previous Trade-Marks Regulations, one had to use the forms mentioned in schedule II of those regulations. Such forms are no longer mentioned in the Trade-Marks Regulations (1996). However, rule 14 of these regulations foresees that the Registrar may publish forms in the Trade-Marks Journal.

In fact, in the 1996.05.29 edition of the Trade-Marks Journal (vol. 43, No 2170, p. 152), the Registrar did publish suggested forms. These are nearly the same as those mentioned in the schedule II of the previous regulations.

It is of interest to remember that section 32 of the Interpretation Act R.S.C. 1985, c. I-21 is to the effect that once a form is prescribed, variations that do not modify the substance nor are of the type to induce error, do not invalidate the form used: see *Houde v. Commission des Ecoles Catholiques du Québec* (1977), (1978) 1 S.C.R. 937 Dickson J. at page 944. In any case, the non compulsory character of the forms proposed by the Registrar is recognized in his practice notice.

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