

May 21, 2010

By Email: stephanie.golden@ic.gc.ca

Lisa Power
Director, Trade-marks Branch
Canadian Intellectual Property Office
Patent Branch
50 Victoria Street
Gatineau, Québec
K1A 0C9

Attn: Stephanie Golden

Dear Ms. Power:

Re: Proposed Practice Notices – Trade-marks Branch

FICPI Canada wishes to thank the Canadian Intellectual Property Office for the opportunity to comment on the proposed Practice Notices relating to “Persons”, Description of Colour Claims, and Opposition/Application Deemed Abandoned.

As you may know, FICPI (the Federation Internationale des Conseils en Propriété Industrielle), comprises more than 3500 intellectual property attorneys in private practice in 86 countries. FICPI Canada is a self-governing national association of FICPI and represents the interests of Canadian patent and trade mark professionals. Our membership includes senior professionals at most major Canadian intellectual property firms. Our clients span all types and sizes of businesses, including multi-national corporations, small and medium size enterprises, and individuals.

We are in agreement with the suggested Office position in respect of the proposal relating to the applicant’s identity as a “person” pursuant to Section 2 of the *Trade-marks Act*. Our members will gladly assist applicants by providing advice, when necessary, to ensure applicants meet the statutory requirements.

With respect to descriptions pertaining to colour claims, we agree with the premise that an applicant must be precise in terms of the rights claimed. However, we are of the view that PANTONE references are not widely known by the public and that in many cases a written description (such as “cherry red”) can provide a more accurate claim, especially in instances wherein colours blend from one shade to another. Furthermore, reliance on written descriptions avoids the unnecessary time and expense of ensuring each colour claimed is mapped against a PANTONE colour code reference. We therefore believe that applicants should be permitted to use any method that is clear including a written description only.

FICPI Canada is troubled by the CIPO proposal in respect of deemed withdrawal and abandonment. It appears that the proposed procedure would result in applications proceeding directly to abandonment, or oppositions proceeding to withdrawal, in cases where neither evidence nor a statement that no evidence is to be filed are received within the time limits. The result of the proposed practice change would be that applicants or opponents would, at times, lose the right to continue the proceedings through to the decision stage. This could occur through no fault of the party failing to meet the requirements, for example when the Board misplaces or loses evidence or mail is misdirected. Our members have reported loss of evidence or even the entire file; thus we do not feel this is an unsubstantiated concern. We are strongly of the view that whether there was inadvertence in failing to act, or an oversight on the part of the Board in not realizing the requirements had been met, the procedure must include measures to remedy unintended abandonment or withdrawal. Clerical mistakes do occur and a party should not lose its right to continue the proceedings because of mere inadvertence.

To take a position that a missed deadline should result in absolute loss of rights or discontinuance of the proceedings is unduly harsh, contrary to the principles of natural justice, and not consistent with the treatment accorded applicants in other jurisdictions. In support we rely on the measures set out in the Singapore Treaty including Article 14, which looks to remediation of errors and omissions. These are of course minimum standards and we would encourage CIPO to apply the principle broadly across all procedures including wherein an unintentional failure to act leads to loss of rights or precludes a party from continuing opposition proceedings.

The application of the contemplated procedure would have the effect of being final in cases where the opposition was deemed withdrawn or the application deemed abandoned. It would seem that a decision regarding deemed withdrawal or abandonment could not be appealed. This means that owing to inadvertence on the part of a party *or the Board*, there could be entire loss of rights; as in the case of an applicant who faces refile with a later entitlement date, or the loss of the ability to rely on grounds not available outside opposition, or loss of favourable material dates in respect of the opponent. The decision

regarding deemed abandonment or withdrawal could not, it seems, be reviewed by a court and thus the impact is particularly severe.

We disagree with the apparent position of the Office that there is no authority to grant a retroactive extension after deemed abandonment or withdrawal pursuant to s. 38 and 47(2). We submit that a retroactive extension is indeed possible at least until the point of the allowance or withdrawal being entered on the public record. The proper statutory interpretation is that the decision maker is entitled to reopen the decision of deemed withdrawal or abandonment until such time. In this regard we point to s. 39(2) & (3) which afford opponents the right to proceed in spite of an application having been allowed. These provisions, taken together with the expansive wording of s. 47 indicate that the Registrar is within her rights to grant a retroactive extension of time after deemed abandonment or withdrawal. Just as the Registrar is compelled to consider applications for extensions of time after the statutory period has elapsed, so should the Registrar be compelled to consider all evidence and representations of the parties regardless of whether the evidence (or statement that no evidence will be filed) is received within the time limits or not.

Suggesting that the Registrar is functus at the date upon which the evidence or statement was due seems contrary to the findings of Heald J. in *Centennial Grocery Brokers Ltd. v. Registrar of Trade-marks* (1972) 5 CPR (2d) 235 at 237:

Applicant here is in effect arguing that the combined effect of s. 38(1)(2) [now 39(1)(2)] is that the Registrar must allow an application immediately after the time for opposition has expired unless within that time an opposition has been filed or a request for extension has been received.

With deference, I cannot give effect to this argument...In the case at bar, the application was made outside the 30-day period and such an application is surely contemplated under the provisions of s. 46(2) [now 47(2)]. Fournier, J., would seem to agree with this view where he says at p. 7: "After the expiration of the time fixed and up to the date on which a registration is allowed, the Registrar, in his discretion, may grant an extension of time, if he is satisfied that the circumstances justify such an extension."

Dr. Fox has dealt with this question in his vol. I, 2nd ed., at p. 367 as follows: "The meaning of the word "thereupon" contained in section 38(1) and section 39(1) does not necessarily require registration to be effected by the Registrar immediately...."

as well as the decision of Jerome A.C.J in *Max Factor & Co. v. Registrar of Trade Marks* (1982), 60 CPR (2d) 158 at 160.

In *Ault Foods v. Canada (Registrar of Trade Marks)* (1992), 45 CPR 93d 479 MacGuigan J., on behalf of the Court, considered it essential that the Registrar must deal with requests for extension of time, including those after the deadline, before reaching a determination regarding allowance. He stated:

As Wilson J. put it for the Supreme Court in *Oakwood Development Ltd. v. St. Francois Xavier (Rural Municipality)* (1985), 20 D.L.R. (4th) 641 at p. 649, [1985] 2 S.C.R. 164, 61 N.R. 321, a statutory decision-maker must "be seen to have turned its mind to all the factors relevant to the proper fulfillment of its statutory decision-making function". The potential unfairness which the appellant claimed would be the result of a decision against it, even if true, could not be placed on the same footing as the unfairness in procedure the Registrar committed against the respondent.

By analogy, in order to determine allowance or withdrawal, the Registrar is required to turn her mind to evidence or statements that no evidence will be filed regardless of whether the actions occurred within the statutory period or not. Thus, in the period between notification of deemed abandonment, or withdrawal, and actual recordal on the public record of abandonment or withdrawal the party affected should be permitted to make a request for a retroactive extension of time, under s. 47 to file the evidence or the requisite statement.


In view of the foregoing, we suggest that it is entirely consistent with the scheme of the *Act* for the Registrar to send warning letters prior to deeming abandonment or withdrawal. Any concern regarding certainty can be dealt with by specifying a short period of time to remedy the deficiency. We would suggest a period of 2-3 weeks from the date of the official letter.

However, if the Registrar is adverse to the sending of such warning letters, and in the case of requests made after deemed withdrawal or abandonment but before the change is entered on the public record, we suggest a practice notice which makes it clear that retroactive extensions of time to file the evidence or statement will be considered at least up until the point at which the public record has been changed to reflect the new status. (We would consider it appropriate for the Registrar to allow a period of at least two weeks between the letter deeming abandonment or withdrawal and recordal on the public record.)

We believe the same reasoning is applicable in respect of the deemed abandonment for failure to file a Declaration of Use and suggest a practice notice permitting retroactive extensions of time be possible, again up until the point of public recordal of the deemed abandonment.

FICPI Canada wishes to thank the Canadian Intellectual Property Office for the opportunity to provide comments. If CIPO has any comments about our submissions, please do not hesitate to contact the undersigned.

Respectfully submitted,



Robert B. Storey, President - FICPI Canada
Coleen Morrison, Secretary