April 24, 2012

By Email: alison.bunting@ic.gc.ca

Ms. Alison Bunting
Trade-marks Branch
Canadian Intellectual Property Office
50 Victoria Street, Room 4012
Gatineau, Québec K1A 0C9

Dear Ms. Bunting:

Re: Proposed Amendments to the Trade-marks Regulations

FICPI Canada wishes to thank the Canadian Intellectual Property Office for the opportunity to comment on the proposed amendments to the Trade-marks Regulations.

As you may know, FICPI (the Federation Internationale des Conseils en Propriété Industrielle), comprises over 5000 intellectual property attorneys in private practice in over 80 countries around the world. 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, including practitioners responsible for at least dozens of opposition files at any one time. Our clients span all types and sizes of businesses, including multi-national corporations, small and medium size enterprises, and individuals.

FICPI Canada is very supportive of all initiatives that result in the development, improvement or enhancement of electronic communications, as is the case with some of the proposed changes. We applaud CIPO's efforts in this regard.

However FICPI Canada must express some concern regarding other revisions.

On the issue of newly proposed rule 14(4) FICPI Canada is of the view that the ability to rely on both languages should be preserved. Utilization of both English

and French can be important for such things as relying on wording contained in foreign registrations and as such is an important practice tool. We see no good justification for requiring applications to be entirely French or entirely English.

On the question of appropriate representation of sound marks as contemplated by new R. 28 (10), we are of the view that not all representations listed in sub-sections (a) to (d) should be required. We believe that applications for sound marks should contain a written description but that only one other means of representation, that is, either an electronic recording or a drawing graphically representing the mark should be required. Adding a third means of representation does not seem to add substantial benefit to third parties and could be onerous for applicants. FICPI Canada believes an accurate description should be considered to have provided a broad indication of the nature of the rights claimed and that this can be used in conjunction with either a graphical or electronic representation to afford the requisite specificity that will permit a proper analysis when determining the scope of the rights. We also recommend that the Trade-marks Act be amended to provide statutory support for the registrability of sound marks.

FICPI Canada is of the view that the proposed changes associated with rule 31(2) are inadvisable. Accuracy of the register in terms of the information contained in pending applications is very important. Interested parties must have available to them a register that, to the extent possible, accurately reflects rights, and pending rights, of trade-mark owners. Rules 30, 31 and 32 as currently drafted provide a balance allowing some flexibility to applicants whilst at the same time encouraging Applicants to consider and establish accurate rights at the time of filing. The current proposals would allow applicants to file and prosecute applications with inaccurate use claims with no penalty provided a valid claim was contained in the application at the time of publication. An applicant could validly claim proposed use at the time of filing, later revising he application to make a claim to prior use, and then finally revising back to proposed use just prior to publication so as to avoid successful challenge as to the use claim. Inaccurate claims to prior use have the effect of deterring third parties, who might in fact have better rights, from filing or opposing an application with an invalid claim.

With respect to the changes involving Opposition, we would suggest that initial requests for an extension of time in which to oppose should be communication between the prospective Opponent and the Board. At this point in the procedure, the Opponent is likely considering the merit of Opposition and may simply need more time to satisfy itself that there is no need to Oppose. As such, we do not think the Applicant should be copied on such requests.

We believe further clarity is required in terms of the deemed dates, and perhaps even times, of service relating to the requirements set out in proposed rule 37(6).

It also is unclear how a party can provide an e-mail address for service and as such, clarification is required.
We are of the view that further explanation as to the how the proposed changes to the Opposition related rules will be applied is required, for example in respect of orders for cross-examination in instances wherein parties cannot agree and how these may affect other deadlines relating to evidence.

As suggested previously, FICPI Canada does not support the change from coincident to sequential filing of written arguments as this will fundamentally change the nature of the procedure, which as it stands works quite well. We believe that the sequential filing of Written Arguments could in fact increase the need for oral hearing adding unnecessary cost and complexity to the procedure. We would urge CIPO to reconsider this aspect of the proposed regulations.

The revisions to rule 48 involving transfers are of concern to FICPI Canada. Members of our organization believe that it would be best to continue to require documentation in support of the request. This prevents abuse and renders it more likely that easy transfer is not abused. Requiring documentation also affords challengers in later proceedings to access the documents to assess the validity of the transfer. We think this information should be on record for review in such cases.

In terms of other possible changes to Opposition Practice, current cooling off procedures are, in the view of FICPI Canada, not meeting the needs of clients. It should be possible for parties to request two or three extensions totaling 9 months as consent to shorter periods can encourage a party to move as quickly as possible to consider settlement offers. We also strongly advocate extending the cooling off period to at least the conclusion of the evidence stage. We are also of the view that in some cases, for example where negotiations extended to several countries, a longer period of time might legitimately be needed to avoid requiring a party to advance to the next stage of the proceedings. While parties can each obtain a nine month cooling off extension of time, after nine months one party needs to proceed. If for example this happens at the evidence stage, a party is forced to complete the complex and costly process of collecting evidence in spite of having every hope of successful negotiation during the other party's cooling off period. The procedure should be structured so this may be avoided.

One means of addressing this problem would be to recognize the consent of the other party to the late filing of evidence (with limits) in the event negotiations break down or the last deadline expires without agreement effected. The rigidity of the current system is preventing parties from carrying out such strategies even in cases where they may be full agreement as to what might be reasonable. The current procedures in many ways hinder the viability of the very useful and often used option of settlement.

FICPI Canada wishes to thank the Canadian Intellectual Property Office for the opportunity to comment on the proposed amendments to the Trade-marks Regulations.

Yours truly,

Robert B. Storey, Past President and Member of Council - FICPI Canada
Coleen Morrison, Treasurer