


ITMA review

The Journal of The Institute of Trade Mark Attorneys

Issue no. 379 October 2010



The Royal crown: CAFF mark fails to overcome protected emblem rules

Minor deviations from registered mark
cause major headache for Atlas

Section 21: becoming a threatened species?

VODKAT fails to convince court extended
passing off is now too broad

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Jeffrey Vicq

Report from Canada: Significant prosecution changes coming?

Significant changes to Canadian trademark practice have been proposed by the Canadian Intellectual Property Office. While draft legislation has not yet been introduced, the Office is pushing for amendments that would have a significant impact upon foreign filers. **Jeffrey Vicq** explains.

In June, 2010, the Canadian Intellectual Property Office (CIPO) held meetings with Canadian practitioners to discuss modernisation of the Canadian trade mark regime. Admittedly, as compared to the regimes of other G20 countries, Canadian prosecution practice certainly has its quirks: Canada does not ascribe to the Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks (Nice), or the Singapore Treaty on the Law of Trademarks (Singapore), nor does it adhere to the agreement or protocol supporting the Madrid System for the International Registration of Marks (Madrid). These factors, coupled with such concepts like the “associated mark”, Canada’s expansive “official marks” regime, and the highly limited opportunities for registration of non-traditional trade marks, have led some to suggest that the Canadian trade marks system is, well, anachronistic.

But this is nothing new. What is, perhaps, somewhat new, is that Canada appears to be coming under increasing pressure from trading partners for IP reform. Canada is now routinely cited on the “Priority Watch List” in a report issued by the Office of the United States Trade Representative to identify those countries that fail to adequately protect IP. Additionally, text leaked from current negotiations of the Canada–European Union Comprehensive Economic and Trade Agreement suggests the EU expects the reform of key parts of Canada’s intellectual property regime as part of any final trade deal.

In this context, CIPO advised

practitioners it was pushing hard for trade mark reform. Though the Canadian government has not announced an official position on Nice, Singapore or Madrid, CIPO has suggested that its proposals would help harmonise Canadian practice with that of our trading partners, thereby simplifying the use of the Canadian system for those abroad and reducing barriers to trade.

One such proposal concerns the adoption of the Nice Classification System — the standardised system for describing goods and services adopted by 83 jurisdictions around the world. Though CIPO has expressed a desire to adopt Nice, it has further advised that such adoption would not see Canada do away with its requirement that wares and services claims be filed using “ordinary commercial terms”. Instead, the organisation of an applicant’s goods and services claims into the various Nice classes would be an additional obligation on top of crafting the claims to conform to CIPO’s ordinary commercial term requirements.

CIPO also advised that there were no plans to otherwise integrate Nice classes into Canadian law – eg, improper classification would not be a ground to challenge a mark; confusion analyses would not take into account whether the marks were in the same class, etc. In this light, having no legal import, CIPO expressed its willingness internally to automate the classification process for applicants, in light of the Singapore Treaty’s requirement that applications be published (and not filed) with the applicable wares and services classes identified.

Given this, the proposed adoption of

the Nice Classification System appears to be mere window-dressing being effected merely to permit compliance with the Singapore Treaty. Absent significant revision to the current list of CIPO’s “ordinary commercial terms”, one must query the degree to which Canada’s adoption of Nice would materially reduce barriers to trade.

Another significant proposed change relates to the reduction in the number of filing bases available to all applicants, both domestic and foreign. Currently, applications in Canada can be filed on one or more of the following four filing bases: use in Canada; proposed use in Canada; application/registration and use abroad; and the rarely used “making known” in Canada. CIPO has proposed the deletion of both the “making known” and application/registration and use abroad filing bases from Canadian legislation.

Frequently used by foreign applicants, the application/registration and use abroad filing basis permits foreign trade mark owners who (a) are using their mark outside of Canada; (b) have a foreign application / registration for that mark in a Paris country; and (c) have a real and effective industrial or commercial establishment in that Paris country; to obtain a Canadian registration without commencing use of the mark in Canada.

This filing basis was brought into Canadian law following accession to the Paris Convention. However, CIPO has recently expressed the view that the Convention actually does not require the introduction of this basis into local law, and that it need not remain in Canadian legislation. Since domestic filers cannot avail

themselves of the basis, CIPO has suggested that the provisions give an unfair advantage to foreign filers. Additionally, CIPO suggested that the bases led to the registration of marks which were not actually being used in Canada, thereby cluttering up the register. For these reasons, CIPO argues, the basis ought to be deleted.

At first blush, this seems a not entirely unreasonable position – though the elimination of the filing bases will likely disappoint many foreign filers. However, the rationale becomes less clear when considered with CIPO's related proposal to contemporaneously amend the remaining filing bases to delete the requirement that an applicant commence use of the trade mark in Canada before it is registered.

Under this proposal, an applicant could obtain a trade mark registration without having to adduce evidence of use of the mark in Canada until three years after the registration issued. (The timing is driven by Singapore, which precludes contracting parties from requiring evidence of use until three years following registration).

In the light of this proposed change, the arguments in favour of deleting the application/registration and use abroad filing basis are largely undermined. And while forcing all owners to declare use within three years following registration would level the playing field as between foreign and domestic filers, deletion of the pre-registration use requirement eliminates a real disincentive to such trafficking: if the changes are approved, nefarious applicants will be able to obtain actual registrations more easily than ever before. This may result in increased costs for rights-holders, who will need to rely more heavily on monitoring programs to locate and challenge problematic applications before they become full-fledged registrations.

Precisely if, or how, these and other proposals will be implemented in Canada remains to be seen. What does appear clear from CIPO's efforts is that modernisation of the Act – for better or for worse – is more likely now than it has been at any time in the recent past.

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MUSEUM

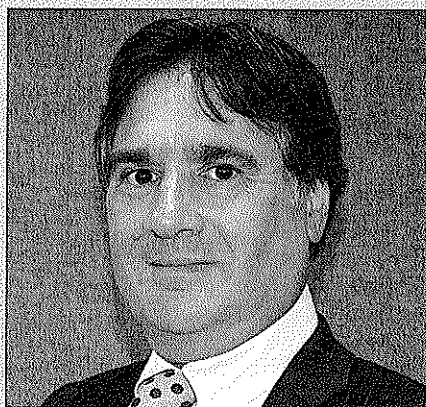
IDEAL CHRISTMAS PARTY VENUE

ITMA's affiliates, the Museum of Brands, Packaging and Advertising invites all ITMA's members to hire the world's only brand heritage venue for their Christmas party.

Founded by consumer historian Robert Opie, the museum displays the brands that have filled British shopping baskets for almost two centuries, and the protected trademarks that have helped them survive to next Christmas again and again. See a Victorian bottle of Bass Beer with its iconic triangle logo and a special display that explores the controversy of counterfeiting, passing off and intellectual property over two centuries.

Charm your guests into the Christmas spirit with drinks, canapés, music and festive cheer provided by the Museum of Brands' events team, and let 12,000 exhibits sweep you back in time to the days of the first Trademark Act of 1875 and beyond.

To experience the spirit of Christmas past and a wealth of trade marking heritage contact Francesca Stracqualursi: 020 7908 0880 or francesca@museumofbrands.com and don't forget that all ITMA's members will benefit from our 15% affiliates discount on venue hire.



NEWS OF MEMBERS

Laurie Heizler, (left) allied member of ITMA, has left Wright Hassall LLP in Leamington Spa and joined Spratt Endicott in Banbury.