



**IPIC**

An Analysis of the  
Singapore Treaty on the Law of Trademarks  
and Implications for Canada of its Adoption

Prepared by the  
International Trade-mark Issues Committee  
of the  
Intellectual Property Institute of Canada

January 19<sup>th</sup>, 2010

## Table of Contents

Introduction	Page 3
What is the Singapore Treaty?	Page 3
How the Singapore Treaty arose	Page 3
The purpose of the Singapore Treaty	Page 3
The coming into force of the Singapore Treaty	Page 3
Signatories to the Singapore Treaty	Page 4
Impact of the Singapore Treaty on common law rights	Page 4
Implications for Canada of adopting the Singapore Treaty	Page 4
Analysis of the Articles of the Singapore Treaty	Page 7
Analysis of the Regulations of the Singapore Treaty	Page 26

## **Introduction**

This document was produced by the IPIC International Trade-mark Issues Committee of the Intellectual Property Institute of Canada (IPIC), in the context of Canada's consideration of its adoption of the *Singapore Treaty on the Law of Trademarks*. The following seeks to provide an overview of the implications of the adoption of the Treaty for Canada and Canadian residents and businesses. This document is not a submission by IPIC to the Government of Canada.

## **What is the Singapore Treaty on the Law of Trademarks?**

The registration of trade-marks differs around the world. Each region/country maintains its own trade-mark registry and dictates the procedures by which the administration of such registration occurs. The Singapore Treaty aims to standardize such procedures among all regional and national trade-mark registries.

## **How the Singapore Treaty arose**

The Singapore Treaty was adopted by a diplomatic conference of member states of the United Nations' World Intellectual Property Organization (WIPO) which took place in Singapore in March 2006.

The Singapore Treaty arose in response to perceived weaknesses in the Trademark Law Treaty (TLT), an earlier attempt to standardize trade-mark registration procedures. However, it does not replace the TLT; countries and intergovernmental organizations may ratify or accede to each treaty separately. For example, Canada is not a signatory to the TLT nor will it likely be.

## **What is the purpose of the Singapore Treaty?**

The Singapore Treaty creates a structure for the international harmonization of administrative procedures for trade-mark registration while keeping pace with the continued advances of modern technology.

## **The coming into force of the Singapore Treaty**

The Singapore Treaty came into force on March 16, 2009, three months after its ratification by Australia.

In order to come into force, ten countries or intergovernmental organizations had to deposit their instruments of ratification or accession with the Director General of WIPO. The first ten countries to do so were Singapore, Switzerland, Bulgaria, Romania, Denmark, Latvia, Kyrgyzstan, United States, Republic of Moldova, and Australia.

Since that time, Spain, Poland, Estonia, France, Mali, the Russian Federation, the Netherlands and Lichtenstein have ratified or acceded to the Treaty.

## **Signatories to the Singapore Treaty**

As of January 15, 2009, 58 countries are signatories to the Treaty, and thus, in addition to the countries identified above, another 41 countries are considering adhering to it.

The signatories include significant trading partners to Canada, such as France, the United States of America, Australia, the United Kingdom and China.

## **Does it impact common law rights?**

The treaty does not appear to impact common law rights.

## **Implications for Canada of adopting the Singapore Treaty**

An International treaty which aims to standardize trade-mark registration procedures among all regional and national trade-mark registries is beneficial because it would make national trade-mark registration systems more user-friendly and reduce compliance costs for businesses seeking to protect their trade-marks.

Ratification of the Treaty by Canada would contribute to the realization of the aims of the Treaty and send a clear signal to the international community of Canada's commitment to provide an efficient and effective trade-mark registration regime that is consistent with international best practice.

The *Canadian Trade-marks Act* (TMA) is already consistent with a substantial number of standards and rules of the Singapore Treaty. Nevertheless, critical differences exist and addressing these issues could prove costly both for the Government in amending the legislation and for applicants who would likely face higher filing and renewal costs.

Key differences are:

- use and registration abroad basis for foreign filers; Article 3(4)(iv) states that the filing of certified copy of a foreign registration cannot be required. Currently, to obtain a registration based on foreign use and registration in Canada, a certified copy of the foreign registration must be filed (Section 31(1) of TMA). If the requirement to file a certified copy is eliminated from the Canadian Act in order to adhere to the Singapore Treaty, there would be no mechanism for the Canadian Trade-marks Office (or third parties) to obtain proof of the validity of the applicant's claim, although the requirement could be changed from a certified copy of the Certificate of Registration to simply a copy (as in the United States). The validity of the applicant's claim could be challenged, however, in opposition proceedings.
- division of applications (Article 7 ); currently Canada does not allow for this. Implementing such a provision would likely not be too onerous and would add flexibility for an applicant. An advantage would include the ability to maintain the original filing date in respect of the divided out goods or services. While the ability to divide could result in more fees payable by the applicant/registrant, these may

be in line with fees currently payable in connection with an application to extend the goods or services covered by an existing registration or with a new application.

- the Nice Classification system (Article 9); currently in Canada wares and services are worded in ordinary commercial terms. Adoption of Nice will impact Canadian legislation and practice significantly. For example, it will add a layer of complexity to s. 30(a) of the TMA regarding the requirement to describe an applicant's goods and services specifically in ordinary commercial terms in the application. Singapore also will affect other sections of the TMA, such as Section 37, when an application is to be refused by the Registrar, i.e. for non-compliance with section 30; and Section 38, grounds of opposition again for non-compliance with Section 30. In addition, it is not known whether the adoption of Nice would affect the application of the factors for assessing confusion in section 6(5) of the TMA, during prosecution, opposition or (by the Courts) in infringement actions, whether these factors would be applied within a class, or more broadly across trade channels as currently applied.

Other considerations of adhering to Nice are:

- the classification of all existing applications and registrations - applicants and registrants should be notified of the classification applied and be provided with an opportunity to request reclassification of incorrect classifications;
- potential additional fees (application, renewal, extensions of time) – a consequence of adhering to Nice is that fees may be charged on a per class basis versus per application/registration as currently charged, unless the current fee structure continues to apply, regardless of classification;
- the impact on prosecution - many applications could be bogged down during the prosecution stage, as descriptions and classifications of goods and services are fine-tuned to comply with Nice (as is the present case in the United States) but this could be addressed by greater availability/responsiveness of Examiners to deal with such issues by email and phone (as also is the case in the United States)
- renewal every 10 years (Article 13) - in Canada renewal is every 15 years

Another concern relates to the Assembly mandated to take control over further development and amendments to the Treaty and Regulations (Articles 23). Though amendments to the Treaty, as opposed to the Regulations, would require a diplomatic conference, the Assembly would determine when to convene a diplomatic conference for such purpose (Article 25).

In summary, though Canada does not need to adopt it, adherence to the Singapore Treaty would provide Canada with a few meaningful enhancements to its current filing regime, such as division of applications and relief measures for failure to comply with time limits (including continued processing and reinstatement, in addition to extensions of time). Nonetheless, there are potentially burdensome requirements that are likely to follow, such as classification of goods and services and potential additional fees.

Indeed, it seems that the changes required to the TMA are significant compared with the benefit which likely would be for only a small percentage of trade-mark owners. Nevertheless, Canada may want to adopt the Treaty to send a message to the international community that it is ready for change.

# **Analysis of the Articles of the Singapore Treaty on the Law of Trademarks**

## **ARTICLES**

### **Article 1: ABBREVIATED EXPRESSIONS**

Provides definitions for 22 abbreviated terms used in the Treaty.

*Comments:*

*The definitions are straightforward but there is no definition of “signs” which can be registered as marks (Article 2(1)) and which may be visible or non-visible (Rule 3). Some of the terms used are different than those typically used in Canada. For example, the term “holder” is used to describe the current owner of the registration, whereas the Canadian Trade-marks Office uses “registrant” or “owner”.*

*Definition sections are common to legal documents including treaties and are useful in helping those reviewing or utilizing provisions of the Treaty. The “abbreviated expressions” include definitions that speak to the source and amendment of the Treaty, that is, definitions which speak to Treaty concerns beyond the functioning of national trade-marks offices or the World Intellectual Property Organization (WIPO). This is relevant to observers because it makes clear the international nature of the Treaty.*

*Most of the “abbreviated expressions” are identical to, or recognizably interchangeable with definitions of equivalent meaning in the TMA. This is useful in that those familiar with the TMA should be able to readily understand aspects of the Treaty because the “abbreviated expressions” are fairly transparent. Even those unfamiliar with trade-mark law should be able to make good use of the definitions in analyzing the Treaty.*

*The Trademark Law Treaty is included among the “abbreviated expressions”. This is not unexpected in that the Trademark Law Treaty is a document which seeks to simplify and harmonize aspects of domestic trade-mark law that are helpful to applicants seeking registration of a trade-mark in their own country. The reference to the Trademark Law Treaty in the “abbreviated expressions” suggests a concerted effort to ensure the Trademark Law Treaty and the Treaty complement each other.*

### **Article 2: MARKS TO WHICH THE TREATY APPLIES**

A contracting party (party) to the Treaty must apply the Treaty to trade-marks consisting of signs that can be registered as trade-marks under that party’s law. The Treaty applies to trade-marks relating to goods or services or both goods and services but does not apply to collective marks, certification marks and guarantee marks.

Comments:

*The word “signs” includes both visible signs and non-visible signs, such as sounds and smells. Canada would need to consider whether to expand the types of marks, including sounds and smells, permitted to be registered and how to index such marks to facilitate meaningful searchability.*

*Article 2 provides that the Treaty applies to “signs” (‘marks’ is the word used in the TMA) which can be registered as trade-marks in a party’s country.*

*A ‘sign’ (or ‘mark’) becomes a “trade-mark” when adopted by a person or entity for the purposes of distinguishing that party’s goods or services from the goods or services of others.*

*It should be noted that Article 2 makes clear that the Treaty does not apply to collective marks, certification marks and guarantee marks. These are marks which are different in nature from trade-marks although they are normally covered by a nation’s trade-mark act. Their differing nature makes it difficult for them to be covered by an international treaty. While the TMA provides protection for marks such as certification marks, it does not cover collective or guarantee marks.*

### **Article 3: APPLICATION**

This Article defines what an application for registration of a trade-mark filed with the national trade-marks office may contain.

(1) Indications or elements contained in or accompanying an application; fee

(a) Any party to the Treaty can require in an application some or all of 16 listed indications or elements.

(b) An applicant may file a declaration of actual use and evidence of such use, as required by the law of the party.

(c) Any party may require fees to be paid to that party’s trade-mark office in respect of an application.

(2) An application may relate to several goods and/or services covering one or more classes in the Nice Classification.

(3) Any party may require that, where a declaration of intent to use has been filed, the applicant provide within a time limit fixed by the law of that party, subject to the minimum time limit provided in the Treaty’s regulations (Regulations), evidence of actual use as required by the law of that party.

(4) No party may demand that requirements other than those referred to in paragraphs (1) and (3) and in Article 8 be complied with in respect of an application. In particular, a party cannot require the following:

(i) any certificate of, or extract from, a register of commerce;

- (ii) an indication of the applicant's carrying on of an industrial or commercial activity, or evidence to that effect;
- (iii) an indication of the applicant's carrying on of an activity corresponding to the goods and/or services listed in the application, or evidence to that effect;
- (iv) the furnishing of evidence to the effect that the mark has been registered in another country, except where the applicant claims the application of Article 6 *quinquies* of the Paris Convention

(5) A party can require evidence to be filed during examination of the application where the trade-marks office of that party reasonably doubts the truth of any indication or element contained in the application.

## Appendix 1

Summary of the 16 elements for Article 3, paragraph (1) (a):

- request for registration;
- name and address of applicant;
- name of the State in which the applicant is a national, has a domicile, and has a real and effective business establishment, if any;
- if the applicant is a legal entity, its legal nature and the legal jurisdiction under which the legal entity is organized;
- if the applicant has a representative, the name and address of the applicant's representative,
- an address for service, if one is required under Article 4(2)(b)
- if the applicant wishes to claim priority of an earlier application, a declaration claiming priority and any supporting evidence that may be required under Article 4 of the Paris Convention;
- if the applicant wishes to claim protection resulting from the display of goods and/or services in an exhibition, a declaration to that effect, and any supporting evidence as required by the law of the party;
- a representation of the trade-mark;
- a statement indicating the type of trade-mark and any specific requirements applicable to that type of trade-mark;
- a statement indicating that the applicant wishes that the trade-mark be registered and published in the standard characters used by the Office;
- a statement that the applicant wishes to claim color as a distinctive feature of the trade-mark;
- a transliteration of the trade-mark or portions of the trade-mark;
- a translation of the trade-mark or portions of the trade-mark;
- the names of the goods and services classed in accordance with the Nice Classification system;
- a declaration of intention to use the trade-mark

### *Comments:*

*The 16 indications and elements under (1) (a) are summarized in Appendix 1, which include requirements such as the name and address of the applicant, translation of the trade-mark, etc.*

*The indications and elements that can be required by a party under paragraphs (1) and (3), combined with Article 8, are exhaustive.*

*The specific provisions in subparagraphs 4(i) to (iv) are meant to eliminate some of the more burdensome requirements that exist in some countries.*

*The language of the Article makes it clear that it remains the option of a national trade-marks office to decide what an application should contain.*

*The permissive nature of this Article is important; the presence of Article 3 does not automatically force changes to filing bases or other foundation elements of national trade-mark law just because a country has ratified the Treaty.*

#### **Article 4: REPRESENTATION; ADDRESS FOR SERVICE**

(1) Any party may require that a representative for service be appointed for any purpose (i) have the right to practice before the Office, and “where applicable” be admitted to practice before the Office (“Office” is defined to be the agency “entrusted” with registration of mark, and thus would be CIPO if extended to Canada) (ii) that such representative provide, as its address, an address “in a territory prescribed by the party.

*Comments:*

*That would seem to suggest that the party can set rules for:*

- when a representative is required,*
- who can be a representative for service, and can, for example, require such representative to be qualified in some way,*
- “registered” in some way before the party’s office,*
- and require that the address for the representative be in the party’s territory.*

(2) Mandatory Representation

The party may require that a foreign (neither a domicile or real and effective industrial or commercial establishment) applicant (or other interested person) be represented by a “representative”.

If the party does not require a representative in this context, the party may require the applicant to have an “address for service in that territory”.

*Comments:*

*In Canada, the applicant must give “the address of its principal office or place of business in Canada, if any, and if the applicant has no office or place of business in Canada, the address abroad, and the name and address in Canada of a person or firm to whom any notice in respect of the application or registration may be sent, and upon whom service of any proceedings in respect of the application or registration may be given or served with the same effect as if they had been given or served on the applicant or registrant himself”. (Section 30(g) of TMA)*

*Thus, the TMA now requires an applicant without a presence in Canada to have a Canadian service address. However, the section doesn't require that "person or firm" to be qualified in any way, eg., by being registered trade-mark agents.*

*Looking at the Regulations under the TMA (Rules), though, and in particular, s.8, correspondence shall be with the applicant (Rules, s.8(1) ), but, shall be with a trade-mark agent if one is appointed (Rules, s.8(2)). The term "trade-mark agent" is defined (Rules, s.2) as "a person whose name is entered on the list of trade-marks agents"..., and thus means a "registered" Canadian trade-mark agent.*

*NOTE that s. 8 of the Rules deals with "prosecution of an application". It is not clear that this applies to registered marks.*

*Also, s.9 of the Rules provides that "where a trade-mark agent is not a resident of Canada, the agent shall appoint an associate agent who is a resident of Canada." (NB, the word "agent", and NOT "trade-mark agent" is used in s. 9. The word "agent" is not defined.) IPIC has suggested that this really means "trade-mark agent", eg., one who is qualified as a registered trade-mark agent in Canada. Plus, that person should be appointed by a trade-mark agent, ie., one who is registered.*

*The Treaty seems to suggest that we can require applicants and registrants to have a representative (that is not the case now). The Treaty doesn't require that foreign applicants have a 'representative' (although it can require all applicants to have one).*

*Thus, the Treaty permits a party to stipulate that applicants must be represented by agents for any purpose and also permits a party to require that representatives be qualified, or registered. This seems to go farther than the TMA and Rules, where correspondence may be with an applicant, (s. 8(1) of the Rules).*

*Further, the Treaty seems to support broad regulation of agents.*

### *(3) Power of Attorney*

*The party may require any representative to be appointed in a separate communication (a power of attorney), which can deal with one or multiple matters, and the party may require the power of attorney to be filed, and set a time limit to do so, and also deem any communication sent by a person for whom a power of attorney has not been filed to have no effect.*

*Comments:*

*Since Canada does not require powers of attorney, this doesn't really have any impact.*

*The other important provision is Article 4(5), which states that no party may demand that requirements other than those referred to in paragraphs (3) and (4) and Article 8 be complied with.*

## Article 5: FILING DATE

(1) sets the minimum requirements for obtaining a filing date (to be received in a language required under Article 8(2) - which can be a language set by the party's Office), namely:

- indication that registration of a mark is sought
- identity of applicant
- "indications allowing the applicant or its representative, if any, to be contacted by the Office" - namely, an address
- sufficiently clear representation of the mark
- list of goods/services
- If a declaration of proposed use or use is required under Article 3, (which is a matter of discretion for the party, under Article 3) then such declaration or evidence of use

A party can elect to give a filing date with some of the above.

(2) the party may state that a filing date is not to be accorded until fees are received but only if at the time of becoming a party, this was a requirement.

(3) ways and time limits for correcting filing defects can be set in the Regulations.

(4) A party may not demand any other requirements for a filing date.

*Comments:*

*Comparing this with the situation in Canada, Section 30 of the TMA sets out the minimum filing requirements. They include the wares/services (a), the grounds (b-e), certification particulars, the address (g), a drawing (h), and a statement of satisfaction of intent to use (i). The Act does not state that until such info is filed, a filing date will not be assigned. Instead, it is the Rules (s. 25) that state that "the date of filing of an application for the registration of a trade-mark is the date on which the following are delivered to the Registrar:*

*an application setting out:*

- *the name and address of the applicant*
- *wares/services proposed, used, made known*
- *for non-proposed use applications, the date of first use/making known,*
- *name of country of use, and information of foreign registration or application*
- *fee*
- *drawing, unless solely a word.*

*So, if Canada became a Treaty member, we could not require both the name and address of the applicant. We could require the name, and then an address of the applicant OR its representative. Also, for design marks, if the application was "sufficiently clear" that a design was sought, is a drawing required? The meaning of "clear representation of the mark (Treaty) vs. "drawing" are probably the same. Since Canada now requires a fee to get a filing date, we could continue to do so.*

*It should be noted that the statement required in 30(i) of the TMA doesn't seem to be included in Article 3 of the Treaty. However, that statement is not required to get a filing date.*

*Also, Article 3 permits a party to require a declaration of intent to use the mark and, IN ADDITION, OR INSTEAD OF, a declaration of actual use AND evidence. Article 5 permits a party who requires a declaration of proposed use to require that it be included to get a filing date and that a party who requires a declaration of use under Article 3 may require such declaration and evidence of use to get a filing date. The Canadian Rules set out “the date of first use”, which could be viewed to be a “declaration of use”. However, the information on foreign applications/registrations would no longer be required. (Query, does that basis of filing have to be eliminated?)*

## **Article 6: SINGLE REGISTRATION FOR GOODS AND/OR SERVICES IN SEVERAL CLASSES**

A single application containing goods and/or services in multiple classifications will result in a single registration.

*Comments:*

*The Treaty allows that where goods/services belonging to several classes of the Nice Classification have been included in one and the same application, such application shall result in one and the same registration. This is absent from the TMA as we do not have the Nice classification system in Canada. Nevertheless, an application in Canada can contain any number of goods or services as can the resultant registration.*

## **Article 7: DIVISION OF APPLICATION AND REGISTRATION**

At any time prior to a decision in the application process, any opposition proceeding and any appeal proceeding concerning the registrability of a mark, a single application containing several goods and/or services may be divided by the applicant into two or more divisional applications while preserving the filing date and any priority rights of the original application.

At any time during a proceeding or appeal in which the validity of a registration is challenged, a single registration containing several goods and/or services may be divided by the applicant into two or more divisional registrations while preserving the registration date and any priority rights of the original registration. However, division of a registration may be disallowed by parties which allow third parties to oppose marks prior to registration.

*Comments:*

*The Treaty allows any application/registration listing several goods/services to be divided into two or more applications/registrations. This ability to divide an application presently does not exist under the TMA.*

## **Article 8: COMMUNICATIONS**

Article 8 deals with communication standards used by the parties. These communication requirements are between an applicant and the parties' Offices and do not apply to

those between an applicant and another interested party. Communications can be either on paper or electronic and they can also be in any language authorized by the trademarks office in question. In the case where more than one language is accepted by the party, communications must be submitted in only one of those languages. There are no requirements for notarizations and other types of legalizations of documents submitted to a party unless these are required under the Treaty; however an official translation may be required by the party in accordance with its language requirements.

Article 8 also addresses signature requirements, which are largely up to the party in question; however, it is also stated that a paper signature provided in a form which conforms to the Regulations respecting the Treaty would have to be accepted. Further, signatures would not be subjected to additional certification unless these are specifically required by the party in question as they relate to transfers or surrenders of rights.

Article 8 also reserves the right to the parties, however, to require further evidence of a paper signature if there is any doubt as to its authenticity. Finally, any electronic communications and electronic filings may be required to be in a format which is in a format or standard that is specified in the Regulations.

*Comments:*

*The Treaty allows any party to choose the means of transmittal of communication and whether it accepts communication on paper, communication in electronic form or any other form of communication. The TMA allows communication to be physically delivered or sent by electronic or other means of transmission.*

*The Treaty allows any party to require that any communication be in a language admitted by the Office. The TMA allows communication in French and English.*

*The Treaty states that any party may require that a communication on paper be signed by the applicant, holder or other interested person. Although this is not specifically stated in the TMA it is customary to sign communications.*

*The Treaty states that no party may require the attestation, notarization, authentication, legalization or other certification of any signature except, where the law of the party so provides, if the signature concerns the surrender of a registration. The TMA is silent on this point.*

*The Treaty states that no party may demand that, in respect to the above mentioned points, requirements other than those referred to in this Article be complied with. The TMA is silent on this point as well; however it is customary that unless the requirement is specifically stated, the requirement will not be demanded by a party.*

## **Article 9: CLASSIFICATION OF GOODS AND/OR SERVICES**

Article 9 deals with the naming and grouping of wares and services (or goods and services according to their nomenclature), as they would be identified in applications, registrations and publications. Essentially, all goods and services must be named individually and grouped by class according to the Nice Classification system and further, must be preceded by the corresponding class number and in the order of the

Nice Classification system. The section also explicitly states that goods and services will not be considered to be similar or dissimilar merely by virtue of the classes in which they are grouped in an application, registration or publication thereof.

*Comments:*

*In Canada, we do not adhere to the Nice Classification system. Wares and services are worded specifically in ordinary commercial terms. Adoption of the Treaty and thus Nice will impact the Canadian legislation and practice significantly. Section 30 (a) of the TMA will be directly affected since it deals with the wording of wares and services in ordinary commercial terms as it relates to the contents of the application. This will also indirectly impact the following sections: Section 37, when an application is to be refused by the Registrar i.e., for non compliance of section 30; and Section 38, grounds for opposition again for non compliance with Section 30.*

*Other considerations of adhering to Nice are the classification of all existing applications and registrations and a corrective process that will have to be put in place to address discrepancies; a fee per class versus a fee per application and how this will also affect fees for renewals and extensions; and the impact on prosecution (will applications be bogged down during prosecution stage fine tuning descriptions of goods and services within Nice (as is the present case in the United States))?*

#### **Article 10: CHANGES IN NAMES OR ADDRESSES**

*Comments:*

*This Article specifically relates to Section 41 of the TMA. Overall, Canadian practice will not be significantly affected since the general guidelines are similar. Adoption may require a modest modification to practice with respect to how requests are set out, the payment of a fee and the submission of evidence, if required.*

*It does not appear that the Treaty's requirements relating to changes of address and ownership raise any substantive issues for Canadians.*

#### **Article 11: CHANGE IN OWNERSHIP**

*Comments:*

*This Article specifically relates to Section 48 of the TMA. What the TMA sets out in 3 short paragraphs the Treaty addressed in 2 pages. There is greater specificity as to the requirement of each situation of a transfer of a trade-mark and the type of evidence required. In many cases certified supporting evidence will be required versus a simple assignment form currently filed in the Trade-marks Office (that said, the simple form of assignment usually relates to a more formal agreement which is not filed in the Trade-marks Office). Overall, this will not significantly impact practice.*

## **Article 12: CORRECTION OF MISTAKE**

Article 12 concerns correcting mistakes in an application or registration. It allows for the correction of mistakes existing on one or more applications/registrations. Simultaneous correction of a mistake on registrations and applications is permitted. A party can demand proof that a mistake is exactly that.

The nature of corrections that can be requested is limited such that fundamental rights or facts in a registration or application cannot be altered through the correction process.

Fees can be charged for correction; however, a party is compelled to correct its own mistakes, without fee, when requested.

If a mistake cannot be corrected, a party is not compelled to correct a mistake.

*Comments:*

*The provisions in Article 12 reflect those presently in place before the Canadian Trade-marks Office. This article does not change the current law in Canada.*

## **Article 13: DURATION AND RENEWAL OF REGISTRATION**

Article 13 describes the duration of and requirements for the renewal of registrations, although there is recognition that renewal for only certain goods or services within a registration may be possible in some jurisdictions.

Fees for renewal, payable at times chosen by a party, are contemplated. This is in keeping with Canadian practice.

If a party doubts the veracity of any aspect of a renewal request it may require evidence supporting that party of the renewal request.

Renewal may not be used as a means to compel examination of the substance of the registration.

*Comments:*

*Most of the provisions are recognizable under Canadian practice. However, the renewal period is stated to be 10 years. Currently the renewal period in Canada is 15 years. Aside from the renewal period, this article does not change the current law in Canada.*

## **Article 14: RELIEF MEASURES IN CASE OF FAILURE TO COMPLY WITH TIME LIMITS**

(1) A party can request that deadlines relating to trade-mark applications or registrations be extended, provided that the request is filed before the expiry of the time limit.

(2) After a deadline has passed, the applicant can request an extension of the time limit (within two months of the deadline), continued processing of the application (if the request is filed within two months of the deadline and the omitted act is completed within

that period) or reinstatement of the rights of the applicant (supporting facts and evidence relating to the reason for the failure to comply with the time limit must be provided). All such requests must indicate the identification of the requesting party, the trade-mark application or registration number, and the time limit in issue.

(3) A party need not provide the relief in (2) in certain circumstances set out in the Regulations (see Rule 9 (4) of the Regulations).

(4) A party can require payment of a fee to accompany requests for relief.

(5) No requirements other than those in Articles 8 and 14 can be imposed by a party in relation to requests for relief.

*Comments:*

*Under s. 47(1) of the TMA, an extension of time may be granted if the applicant provides reasons and the registrar is satisfied that the circumstances justify it. However, the Treaty does not require reasons for the granting of an extension of time.*

*The crucial difference between the provisions of the Treaty and the TMA is that the Act requires exceptional circumstances and a prescribed fee must be provided to the registrar in order to be granted a relief measure after the expiry of a time limit.*

#### **Article 15: OBLIGATION TO COMPLY WITH THE PARIS CONVENTION**

A party must comply with the Paris Convention provisions relating to trade-marks.

*Comments:*

*There is no specific provision in the TMA that requires compliance with the Paris Convention. However, the TMA does recognize the Paris Convention.*

#### **Article 16: SERVICE MARKS**

A party must register service marks in accordance with the Paris Convention provisions relating to trade-marks.

*Comments:*

*Canada already permits the registration of marks for services (also known as “service marks” in some jurisdictions) and respects the Paris Convention in association with such marks.*

*Under the Treaty, service marks are essentially the same as trade-marks; however a service mark is only used with respect to services whereas trade-marks are used in the sale of goods. The TMA does not make such a distinction and encompasses both goods and services.*

*While most first world countries allow for the registration of service marks, it may be that a country does not. Adherence to this Treaty is, therefore, favourable to all in that it makes uniform the registration of service marks in all countries ratifying the Treaty.*

#### **Article 17: REQUEST FOR RECORDAL OF A LICENSE**

Where a party has provisions for recording licenses, the licenses must be filed in accordance with the Regulations (Rule 10).

*Comments:*

*Licenses do not need to be recorded under the TMA but they can be placed on file, if requested.*

#### **Article 18: REQUEST FOR AMENDMENT OR CANCELLATION OF THE RECORDAL OF A LICENSE**

Where a party requires the recordal of a license, it may also request the recordal of any amendments to, or cancellation of, such license with the Office.

*Comments:*

*As licenses do not need to be recorded under the Canadian law, amendments and cancellations do not need to be filed either, although they can be, if desired.*

#### **Article 19: EFFECTS OF THE NON-RECORDAL OF A LICENSE**

The validity of a trade-mark will not be called into question on the basis that a license has not been recorded with the Office. The trade-mark will enjoy the same protection regardless of whether the license is recorded.

A licensee is entitled to join infringement proceedings and is entitled to damages which may result therefrom without the requirement of a license being recorded against the subject mark.

In situations where there are proceedings concerning acquisition, maintenance and/or enforcement of trade-marks, there is no requirement to record a license so that use of the trade-mark by the licensee is deemed use by the owner.

*Comments:*

*As licenses do not need to be recorded in Canada, the non-recordal of a license with the Office does not affect the validity of the registration of the mark. Furthermore, Canadian law does not require the recordal of a license as a condition for any right that the licensee may have nor as a condition for the use of a mark by a licensee to be deemed to constitute use by the holder in proceedings relating to the acquisition, maintenance and enforcement of marks.*

## **Article 20: INDICATION OF THE LICENSE**

The validity of a trade-mark registration will not be questioned in cases where, even though a party requires an indication that the mark is used under license, there is full or partial non-compliance with such a requirement by the user.

*Comments:*

*In Canada, there is no requirement that there be an indication that the mark is used under license. Non indication does not affect the validity of the registration of the mark which is the subject of the license or the protection of that mark in Canada if licensing arrangement and quality control by the owner of the mark can be shown.*

See Section 50(2) of the *TMA*: For the purposes of this Act, to the extent that public notice is given of the fact that the use of a trade-mark is a licensed use and of the identity of the owner, it shall be presumed, unless the contrary is proven, that the use is licensed by the owner of the trade-mark and the character or quality of the wares or services is under the control of the owner.

## **Article 21: OBSERVATIONS IN CASE OF INTENDED REFUSAL**

Article 21 merely provides an opportunity for the applicant or requesting party to reply, within a specified time limit, to any objections/refusals raised by an Office, the nature of such objections/refusals being in response to (a) the division of an application or registration; (b) recording a change in name or address; (c) recording a change in ownership; (d) correcting a mistake that has been reflected on the Register; (e) requesting renewal; (f) requesting recordal of a license and requesting an amendment or cancellation of a recordal of a license. However, if a the applicant or requesting party has already been granted an extension and has responded to a particular objection or objections raised by an Office, this Article does not give the applicant or requesting party an additional opportunity to extend time again to respond to the objection/refusal.

*Comments:*

*Canada already provides for responses and imposes reasonable time limits and allows for extensions of those time limits.*

*This Article appears rather straight forward and necessary to adhere to standard prosecution practices in other countries. It would seem rather draconian not to have an opportunity to respond to any refusals/objections.*

*Article 21 refers back to many other Treaty Articles and it would be essential that applicants or practitioners address the requirements of these Articles in responding to office actions before the Canadian Trade-marks Office because the Articles are similar in some ways to concerns traditionally raised by the Canadian Office but may differ in subtle ways. It would be incumbent on the Canadian Trade-mark Office to make any changes in its traditional objections arising from adherence to the Treaty, to the extent implemented in the *TMA*, explicit in communications to applicants.*

## **Article 22: REGULATIONS**

This is the Treaty Article serving as a preamble to the Regulations which are in place to provide details as to how to implement the Treaty and its provisions, any administrative requirements, etc. and the Model Forms for all parties to use. It indicates that where there is conflict between the Articles of the Treaty and Rules, the Articles prevail. It also provides that three-fourths of the votes cast must support any amendments to the Regulations and that in some defined instances, the vote must be unanimous with abstaining votes not considered to be a vote (you must vote to count). [Note, the votes are cast in Assembly, where each Contracting Party is represented by one delegate. See Article 23.]

*Comments:*

*Perhaps some may have concerns as to the unanimous vote but then again, it does not require all members to vote, only those that do count. This means of counting votes suggests that parties should stay current on activity surrounding the Treaty to ensure votes are not overlooked.*

## **Article 23: ASSEMBLY**

Article 23 relates to the creation of an organizational body to be called the “Assembly”, which will be tasked with certain matters, namely, the development of the Treaty, the amendment of Regulations, the determination of conditions for the date of application of such amendments and the performance of functions relating to the implementation of provisions of the Treaty. Article 23 also sets out how decisions will be taken by the Assembly, namely voting rights and quorums.

*Comments:*

The *TMA* provides for the administration of same by the Minister of Industry. Indeed, under Section 65 of the Act, the Governor in Council may make regulations for carrying into effect the purposes and provisions of the act. The Governor in Council does not appear to have, though, power to develop the primary legislation. Further, it appears that the Governor in Council’s power to make regulations is restricted to certain areas. In general, it appears that the powers under Article 23 of the Treaty are more far-reaching but are voted on by the contracting states with one vote each or by inter-governmental organizations rather than being made by a single individual. The Governor in Council alone may make regulations under the Act. The Governor in Council also has specific power to amend certain subsections of Section 11 of the *TMA*. Otherwise, changes to the *TMA* generally must be made by Parliament, including the implementation of any changes to the Treaty or the Regulations.

*This Article involves administrative matters; there appear to be no relevant ramifications for Canada.*

## **Article 24: INTERNATIONAL BUREAU**

Article 24 of the Treaty provides that the International Bureau of WIPO will perform the administrative tasks concerning the Assembly. Certain other administrative tasks will be performed by the Director General of WIPO. The Director General may participate in Assembly meetings but does not have the right to vote. Essentially, it appears that the International Bureau and the Director General will back up the Assembly in administration.

*Comments:*

*On the face of it, it does not appear that the TMA provides for any equivalent of the International Bureau of WIPO role in the Treaty; however, it might be possible to make a slight comparison with the role of the Canadian Trade-marks Registrar in that the Registrar is the administrator in charge of, for instance, amendments to the register and other such administrative tasks. However, this may be stretching the comparison too far.*

*This Article involves administrative matters; there appear to be no relevant ramifications for Canada.*

## **Article 25: REVISION OR AMENDMENT**

Article 25 of the Treaty governs the method of revision of the Treaty. Article 25 states that the Treaty may only be revised or amended by a diplomatic conference and the convocation of all diplomatic conferences shall be decided by the Assembly.

*Comments:*

*This Article involves revising/amending the Treaty; Canada would need to attend meetings, conferences, etc. to ensure it keeps abreast of all developments. That being said, Canada already is represented at many such meetings.*

## **Article 26: BECOMING PARTY TO THE SINGAPORE TREATY**

Article 26 of the Treaty governs the method of becoming a party to the Treaty.

### Eligibility

Paragraph 26(1) defines who is eligible to become a party to the Treaty. It states that given that the conditions with respect to entry of the Treaty into force and effective date of ratifications and accessions as defined in Paragraphs 28(1) and 28(3), the following entities may sign and become party to the Treaty:

- (i) any State member of the WIPO in respect of which trade-marks may be registered with the entity's own trade-marks office;
- (ii) any intergovernmental organization which maintains a trade-marks office in which marks may be registered with effect in the territory in which the constituting treaty of the intergovernmental organization applies, in all its Member States or in those of its Member States which are designated for such purpose in the relevant application, provided that all the Member States of the intergovernmental organization are members of WIPO;

- (iii) any State member of WIPO in respect of which marks may be registered only through the trade-marks office of another specified State that is a member of WIPO;
- (iv) any State member of WIPO in respect of which marks may be registered only through the trade-marks office maintained by an intergovernmental organization of which that State is a member;
- (v) any State member of WIPO in respect of which marks may be registered only through a trade-marks office common to a group of States members of WIPO.

#### Ratification or Accession

Paragraph 26(2) defines the process of ratification or accession of the Treaty by a country or intergovernmental organization. The process of becoming a party to the Treaty is different for those countries or intergovernmental organizations which have signed the Treaty and for those which have not signed the Treaty.

*Ratification.* For those countries or intergovernmental organizations which have signed the Treaty, the process of becoming a party to the Treaty is called ratification. Subparagraph 26(2)(i) states that any entity referred to in Paragraph 26(1) may ratify the Treaty by depositing an instrument of ratification.

*Accession.* For those countries or intergovernmental organizations which have not signed the Treaty, the process of becoming a party to the Treaty is called accession. Subparagraph 26(2)(ii) states that any entity referred to in Paragraph 26(1) may accede to the Treaty by depositing an instrument of accession.

#### Effective Date of Deposit

Subsection 26(3) defines the date on which the deposit of an instrument of ratification or accession is effective. The effective date of deposit differs depending on the type of entity making the deposit:

- (i) in the case of any State member of WIPO in respect of which trade-marks may be registered with the entity's own trade-marks office, the date on which the instrument of that State is deposited;
- (ii) in the case of an intergovernmental organization, the date on which the instrument of that intergovernmental organization is deposited;
- (iii) in the case of any State member of WIPO in respect of which marks may be registered only through the trade-marks office of another specified State that is a member of WIPO, the date on which the following condition is fulfilled: the instrument of that State has been deposited and the instrument of the other specified State has been deposited;
- (iv) in the case of any State member of WIPO in respect of which marks may be registered only through the trade-marks office maintained by an intergovernmental organization of which that State is a member, the date on which the instrument of that intergovernmental organization is deposited;
- (v) in the case of any State member of WIPO in respect of which marks may be registered only through a trade-marks office common to a group of States members of WIPO, the date on which the instruments of all the States members of the group have been deposited.

Comments:

*This Article involves ratification of the Treaty; there appear to be no relevant ramifications for Canadian law and practice.*

## **Article 27: APPLICATION OF THE TLT 1994 AND THIS TREATY**

Article 27(1) provides that only this Treaty will apply to mutual relations of parties that are parties to both the Treaty and the TLT 1994, whereas only the 1994 TLT will apply when one of the parties is not a party to this Treaty but only to the 1994 TLT. As such, the two treaties are kept somewhat separate, and freedom is given to the parties to ratify it together or independently.

Article 27 pertains to the relations between parties covered by TLT and Singapore. In the case of relations between countries party to both treaties, Singapore governs. For relations wherein one party is a signatory to TLT only and the other to both, TLT governs.

### *Comments:*

If Canada joins Singapore and not TLT it will not have obligations regarding TLT signatories, only Singapore signatories. So while Article 27 links the treaties, the two remain separate instruments.

## **Article 28: ENTRY INTO FORCE; EFFECTIVE DATE OF RATIFICATIONS AND ACCESSIONS**

Article 28 relates to the coming into force of the Treaty, the instruments of ratification or accession that must be deposited by the entities referred to in Article 26(1). Article 28 of the Treaty therefore provides that it will enter into force once it has been ratified by ten eligible States or intergovernmental organizations.

The Treaty entered into force on March 16, 2009, three months after the 10<sup>th</sup> of the following 10 countries ratified or acceded to it:

- Singapore: Ratification - March 26, 2007
- Switzerland: Ratification - July 6, 2007
- Bulgaria: Accession - January 21, 2008
- Romania: Ratification - March 25, 2008
- Denmark: Ratification - June 24, 2008
- Latvia: Ratification – September 9, 2008
- Krygystan: Ratification – September 12, 2008
- United States of America: Ratification – October 1, 2008
- Republic of Moldova: Ratification – December 16, 2008
- Australia: Ratification – December 16, 2008

Additional countries have since ratified or acceded to the Treaty (see page 4 for details)

With the adoption of the Treaty, WIPO Member States are giving themselves an instrument for standardizing trade-mark office procedures to respond in an efficient manner to future challenges to the trade-mark system.

### *Comments:*

*Article 28 involves entry into force; there are no relevant ramifications for Canadian law and practice.*

## **Article 29: RESERVATIONS**

Article 29 permits a national government adhering to the Treaty to allow its trade-marks office to reserve the right to not have some provisions of the Treaty adhere to certain types of marks including defensive marks or derivative marks.

Further, a national Office that allows the registration of multi-class marks for goods or services separately, that is, not within the same registration, can reserve the right to continue such restrictions. This ability to restrict wares to one application and services to another, can lead to additional expense and paperwork for applicants.

A provision exists at Article 29(3) to allow for examination of a service mark registration, at its first renewal date, for the purposes of eliminating duplication of service mark registrations that may be held by a Registrant, that were based on applications filed before the Treaty came into force in that country. The purpose of this provision is unclear and appears to speak to countries who have only recently allowed the registration of services marks. This provision should not impact the rights of registrants before the Canadian Trade-marks Office.

Article 29(4) directs that any country of intergovernmental organization can require the recordal of a license as a condition to a licensee joining an infringement action brought by the registrant from who the licensee holds a license, or to pursue damages by way of infringement of a licensed mark.

These reservations must be declared at the time a country ratifies the Treaty, and may be withdrawn at anytime. No further reservations may be imposed by a party.

### *Comments:*

*The Article permits States and Intergovernmental Organizations that have marks not contemplated by other sections of the Treaty namely, associated marks, defensive marks, or derivative marks, to declare through a 'reservation' to be declared at time of adoption of Treaty, that certain Articles of the Treaty will not apply to such marks. Such articles involve: contents of applications, declarations of use, and fees; when an filing date may be granted, additional requirements beyond those imposed by the Treaty; division of applications; use of forms; title changes; renewal.*

*These reservations may be problematic in that some marks that have different entitlement or enforcement characteristics may exist on a Register.*

*This Article does not appear to be limited only to marks on record with a State or Intergovernmental Organization at time of ratification or accession. It appears active post-ratification/accession. This means that certain parties will still have more liberal registration/maintenance capabilities than others. Joining the Treaty does not change that.*

## **Article 30: DENUNCIATION OF THE TREATY**

The Treaty's Article 30 allows for the "denunciation" of the Treaty by an adherent, to essentially stop this country's adhesion to the Treaty. This article also states the terms by which such a denunciation can occur. A party may denounce the Treaty by way of notification to the Director General. The effective date of denunciation is one year from

date of receipt of the notice of denunciation. No application pending at the effective date of denunciation will be impacted provided the denouncing party discontinues application of the Treaty to any registration as from the date upon which that registration is due for renewal.

*Comments:*

*There is no equivalent or directly related provision to this Article under Canadian legislation.*

*A party can remove itself from the Treaty. However, if a party denounces the Treaty it must still maintain something of a duplicate system until all relevant registrations undergo their first post-denunciation renewal. This makes departing the Treaty complicated.*

### **Article 31: LANGUAGES OF THE TREATY; SIGNATURE**

The Treaty's Article 31 sets the languages of the Treaty, including regarding publication of the official texts of the Treaty and its Regulations. There is provision for additional languages to be added. The languages of the Treaty are English, Arabic, Chinese, French, Russian and Spanish, with all texts in those languages being equally authentic. An official text in another language that is drafted in an official language of a party can be established after consultation with said party and any other interested party.

*Comments:*

*There is no equivalent or directly related provision to this Article under Canadian legislation.*

*More languages can be added, seemingly without limit, because there is no provision to limit the number of languages and no published requirements under which a new language would be added.*

### **Article 32: DEPOSITARY**

The Director General is the holder of the Treaty.

*Comments*

*There is no equivalent or directly related provision to this Article under Canadian legislation. This provision does not affect Canadian law or practice.*

## REGULATIONS

### Rule 1: ABBREVIATED EXPRESSIONS

Rule 1 of the Treaty's Regulations defines a number of terms used in the Treaty's Regulations and states that the abbreviated expressions defined in Article 1 of the Treaty have the same meaning for the purposes of the Treaty's Regulations. For example, the word "Treaty" means the "Treaty on the Law of Trademarks" and the word "Article" refers to the specified Article of the Treaty.

Under the Treaty's Regulations, the word "exclusive license" means a license which is only granted to one licensee and which excludes the holder from using the trade-mark and from granting licenses to any other person. Under the Treaty's Regulations, the word "sole license" means a license which is only granted to one licensee and which excludes the holder from granting licenses to any other person but does not exclude the holder from using the trade-mark. The word "non-exclusive license" means a license which does not exclude the holder from using the trade-mark or from granting licenses to any other person.

*Comments:*

*By way of comparison, there are no definitions of either "exclusive license", "sole license" or "non-exclusive license" in Canadian trade-marks legislation or regulations. The effect of adopting the Treaty for Canada would thus seem neutral on this point.*

### Rule 2: MANNER OF INDICATING NAMES AND ADDRESSES

Rule 2 of the Treaty's Regulations lists the name and address requirements that a party can impose on applicants, holders, representatives and interested parties.

Rule 2(1) of the Treaty's Regulations allows a party to require that where the name of a natural person is indicated, that the name be the family or principal name and the given or secondary name or the name or names customarily used by that person. Where the person is a legal person, the party may require that the full official designation be provided. Where the name of a representative is to be indicated, and that representative is a firm or partnership, a party must accept the indication of the name customarily used.

*Comments:*

*There is no comparable provision in Canadian legislation. Rule 25(a)(i) of the Canadian Trade-marks Regulations merely requires the "name...of the applicant". The effect of the eventual adoption of the Treaty by Canada regarding this point would thus seem neutral.*

Rule 2(2) of the Treaty's Regulations allows a party to require that where an address is to be indicated, that the address be provided in a way that satisfies the customary requirements of prompt postal delivery and that all the relevant information such as the house or building number be included. Finally, under this Rule of the Treaty's Regulations, an address may include a telephone or facsimile number, an e-mail address, or a different address for the purpose of correspondence.

Comments:

*By comparison, Rule 6 of the Canadian Trade-marks Regulations requires that any address provided by the applicant or holder under Canadian legislation be a “complete mailing address...and the postal code.” Although at first glance the requirement of the inclusion of a postal code seems to go beyond what the Treaty allows in terms of address requirements, the need for a postal code is likely consistent with the rule that an Office may impose “customary requirements of prompt postal delivery”. The effect of the eventual adoption of the Treaty by Canada regarding this point would thus seem neutral.*

*Under Rule 2(2) of the Treaty’s Regulations, where a communication to the trade-mark office of a party is in the name of two or more persons with different addresses, the party may require that such communication indicate a single address as the address for correspondence. The Correspondence portion of the Canadian Trade-marks Regulations (sections 3 to 11), does not address this issue. The fact that Canadian legislation does not address this particular point is likely because under Canadian trade-mark law, an application (or registration) cannot be in the name of two or more persons, unless they act as a single entity (such as a partnership), because of Canadian rules on distinctiveness and the fact that a trade-mark must act as an indication of a single source of merchandise or services. That said, insofar as Rule 2(1) simply allows an Office of a party to specify specific rules IF applications are in the name of two or more persons, the effect of the eventual adoption of the Treaty by Canada regarding this point would thus seem neutral.*

Rule 2(3) states that a party may require that communication with the party’s Office indicate the identification number with which the applicant, holder, representative, or interested party is registered. However, no party may refuse communication for failure to comply with this, except in the case of electronic applications.

Comments:

*There is no comparable provision in Canadian legislation.*

Rule 2(4) of the Treaty’s Regulations states that a party may require that names and addresses be in the script used by the party’s Office.

Comments:

*By comparison, Section 14 of the Canadian Trade-marks Regulations provides that an application or any document relating to the registration of or a registered trade-mark be “presented clearly and legibly, In the manner specified by the Canadian Trade-marks Office in the Journal...”. Insofar as a script could theoretically be specified by the Canadian Trade-marks Office in the Trade-marks Journal, this provision of the Treaty’s Regulation seems consistent with Canadian legislation and the effect of the eventual adoption of the Treaty by Canada regarding this point would thus seem neutral.*

### **Rule 3: DETAILS CONCERNING THE APPLICATION**

Rule 3 of the Treaty's Regulations outlines the details concerning trade-mark applications. Rule 3(1) for example allows the applicant to specify in the application that it wishes the trade-mark to be registered and published in the standard characters used by the trade-mark office of a party.

#### Comments

*By comparison, Canadian legislation, contains no provision that deals with "Standard Characters". However, section 25(c) of the Canadian Trade-marks Regulations requires that an application include a "drawing of the trade-mark, unless the trade-mark consists solely of a word or words not depicted in a special form" which effectively results in the registration and publication of trade-marks in standard characters.*

Rule 3(2) of the Treaty's Regulations allows applicants to claim colour as a distinctive feature of a trade-mark, and the trade-mark office of a party may require that the applicant indicate the name or code of the colour being claimed, as well as an indication, in respect of each colour, of the principal parts of the trade-mark which are in a specific colour

#### Comments

*By comparison, this provision is similar to section 28 of the Canadian Trade-marks Regulations which requires that where colour is claimed as a feature of the trade-mark, the colour must be described and a drawing lined for colour technically is required but rarely submitted or requested any longer.*

Rule 3(3) of the Treaty's Regulations specifies the number of reproductions of the subject trade-mark should be provided to the trade-mark office of a party, which is dependent on whether the application contains a statement that it wishes for the trade-mark to be published in standard characters if the applicant rather wishes to claim colour as a distinctive feature of a trade-mark

#### Comments:

*By comparison, section 30(h) of the TMA states that unless the application is only for the registration of a word or words not depicted in any special form, a drawing of the trade-mark (and such number of accurate representations of the trade-mark as may be prescribed by regulation) must be filed with the Canadian Trade-marks Office. The Canadian Trade-marks Regulations appear to indicate that only one reproduction is required (see section 27).*

Rule 3(4) of the Treaty's Regulations addresses reproduction requirements for three-dimensional trade-marks in an application.

#### Comments:

*Under Canadian legislation, there are no provisions that deal specifically with three-dimensional trade-marks or that contemplate photographic reproductions.*

Rule 3(5) of the Treaty's Regulations addresses reproduction requirements for hologram trade-marks, motion trade-marks, colour trade-marks or position trade-marks.

*Comments*

*By comparison, there is no provision in the TMA or regulations that deals specifically with hologram trade-marks, motion trade-marks, trade-marks composed merely of colour schemes or position trade-marks.*

Rule 3(6) of the Treaty's Regulations addresses requirements for trade-marks consisting of non-visible signs, for example those based on smells and sounds.

*Comments:*

*By comparison, there are no provisions in the TMA or its regulations that deal specifically with trade-marks consisting of a non-visible signs.*

Rule 3(7) of the Treaty's Regulations addresses when a transliteration may be required (for example, where trade-mark consists of or contains matter in script other than that used by the trade-mark office at issue.

*Comments:*

*By comparison, section 29(b) of the Canadian Trade-marks Regulations states that the Canadian Trade-marks Office may require a transliteration of any matter expressed in characters other than Latin characters or in numerals other than Arabic or Roman numerals into Latin characters and Arabic numerals, respectively, which seems consistent with the Treaty's provisions.*

Rule 3(8) of the Treaty's Regulations addresses when translation may be required (for example, if trade-mark consists of words in a language other than language(s) admitted by the trade-mark office).

*Comments:*

*This provision is equivalent to section 29(a) of the Canadian Trade-marks Regulations that state that a translation into English or French may be required for any words in any other language contained in the trade-mark. This seems consistent with the provisions of the Treaty's Regulations and the eventual adoption of the Treaty by Canada would thus have a neutral effect on this point.*

Rule 3(9) of the Treaty's Regulations sets the time limit for furnishing evidence of actual use of a trade-mark must not be shorter than six months counted from the date of allowance of the application by the trade-mark office of the party at issue. Under that same rule, the rights to extension of time is subject to conditions provided for by the law of the party.

*Comments:*

*By comparison, section 40(3) of the TMA and current practice, an application for registration of a proposed trade-mark is deemed abandoned if the Canadian Trade-marks Office does not receive a declaration of use within the later of six months of the*

*application being allowed or three years from the application date. The Canadian Trade-marks Office readily grants extensions for a total of three years from the initial due date (in six month increments) after which time substantive and significant reasons are required for further extensions. This is greater than the at least 2.5 years required by the Treaty's Regulations and the effect of the eventual adoption of the Treaty by Canada would seem neutral.*

#### **Rule 4: DETAILS CONCERNING REPRESENTATION AND ADDRESS FOR SERVICE**

Rule 4 of the Treaty's Regulations provides details concerning the address which is to be used as the address for services when sending communications to an applicant or a holder. When a representative is appointed by the applicant, the address of that representative must be used as the address to which service is made. If a representative is appointed, then its address must be used whenever notifying the applicant or holder about something concerning its trade-mark application or registration. If no representative is appointed by the applicant or holder, then the address in the territory that has been provided by the applicant must be used.

The time limit to submit the power of attorney enabling a representative to act for an applicant when it was not already transmitted to the trade-marks office (as described in Article 4(3)(d) of the Treaty) must be counted from the receipt of any relevant communication by the applicant or its representative. The minimum delay that a party can set is one month if the address is in that same territory, or two months if it's outside it.

#### *Comments:*

*By comparison, under Canadian legislation, the aim of the TMA is to ensure that proper notification and service of documents is carried out where these have an impact on trade-mark applications and registrations. Particular attention is paid to persons who do not have an office or place of business in Canada.*

*Under Canadian legislation, if an applicant that has no office or place of business in Canada, it must provide the address of its principal office or place of business abroad as well as the name and address in Canada of a person or firm to which notice in respect of the application or registration may be sent, and on which service of any proceeding in respect of the application or registration may be given or served, with the same effect as if they had been given or served on the applicant or holder itself.*

*Regarding oppositions, under Canadian legislation, if an opponent has no office or place of business in Canada, it must provide the address of its principal office or place of business abroad and the name and address in Canada of a person or firm on whom service of any document in respect of the opposition may be made with the same effect as if they had been given or served on the opponent itself.*

*Regarding change in representation, under Canadian legislation, an applicant or holder may ask the Canadian Trade-marks Office to amend or to correct any error or enter any change in the name, address or description of the applicant's or holder's representative for service in Canada.*

*In addition, as the case may be, a holder of a trade-mark who has no office or place of business in Canada must name another representative for service, or supply a new and correct address of such a representative, within three months of receipt of a notice from the Canadian Trade-marks Office that its representative has died or that a letter addressed to such representative has been returned undelivered. If no new nomination is made within three months, the Canadian Trade-marks Office or Federal Court may dispose of any proceeding under the TMA without requiring service to the holder. The idea is to ensure that proper service of a proceeding can be effected at all times upon the foreign owner of a registered trade-mark.*

*Article 4 of the Treaty and Rule 4 of the Treaty's Regulations substantially mirror the concern that an applicant who has neither a domicile or real and effective commercial or industrial establishment within a party appoint a representative within its territory. In particular, both the TMA and its regulations and those of the Treaty require the appointment and the name and address of the foreign applicant's representative within the territory at issue, and both thus seem compatible on this point.*

*A substantial difference is that a power of attorney is not required to appoint a representative for Canada under the TMA and its regulations. However, insofar as the Treaty's Regulations set delays that are relevant only if power of attorney documents are required by a party, the adoption of the Treaty for Canada would seem neutral on this point.*

#### **Rule 5: DETAILS CONCERNING THE FILING DATE**

Under Rule 5 of the Treaty's Regulations, if an applicant submits an application without complying with requirements for a valid application (as described in Article (1)(a) of the Treaty), then the trade-mark office which receives the application must invite the applicant to comply with those requirement within a certain delay, which must be indicated in the invitation. The minimum delay that a party can set a one month if to the address is in that same territory, or two months if its outside it. A party can set a special fee to comply with the invitation if it so chooses.

If the applicant correctly responds to the invitation (and pays the special fee id required by law by the party), then its application must be treated as having a filing date of the moment the trade-mark office received all elements required by law for a valid application and the payment of all applicable fees.

#### *Comments:*

*By comparison, under Canadian legislation, the filing date of an application for registration of a trade-mark is the date on which the application setting out the following information is delivered to the Canadian Trade-marks Office: the name and address of the applicant, a drawing of the trade-mark (unless the trade-mark consists solely of words), the list of wares and services in association with which the trade-mark has been used in Canada (and the date of first use) or is proposed to be used, and the application fee. If the application does not contain this minimum information, an official letter indicating what information was lacking will be sent to the applicant or the applicant's representative. Until the missing information is completed, the application will not be considered filed.*

*The Treaty's Regulations are similar in that the trade-mark office must invite the applicant to comply with missing filing requirements within a certain amount of time and that the application will not be considered filed until this missing information is provided. Unlike the Treaty's Regulations, there is no special fee required to complete the missing information in Canada but insofar as the Treaty simply allows a party to provide for such a fee, the adoption of the Treaty by Canada would seem to be neutral on this point.*

## **Rule 6: DETAILS CONCERNING COMMUNICATIONS**

Rule 6 of the Treaty details formalities of “communications” (correspondence), in any form with a party’s trade-marks office. The language throughout Rule 6 is permissive, that is, each party’s trade-marks office may decide what formalities required within a “communication”. The language is broad enough to allow for such things as electronic signature and flexibility of date of receipt such that persons may submit “communications” to appointed sub-offices or even delivery agencies and still be granted a filing date. The flexibility in form and formality of communication is essential taking into account that not all applicant’s have local, immediate access to their national office due to geographical constraints, or they may not have the means of communicating electronically with their national office.

Unlike the other existing treaty called the Trademark Law Treaty, Rule 6 of the Treaty’s Regulations allows contracting parties the freedom to choose the form (paper or electronic) and means of transmittal of communications (i.e. physical means such as postal or courier services, or electronic means such as facsimile or e-mail) and whether they accept communications on paper, communications in electronic form or any other form of communication. This allows national trade-mark offices to move to entirely electronic systems for receiving and processing trade-mark applications, should they wish to do so, thus permitting the trade-mark offices to take advantage of electronic communication system as an efficient and cost saving alternative to paper communications.

The Treaty also maintains a very important provision of the Trademark Law Treaty, namely that the authentication, certification or attestation of any signature on paper communication cannot be required. However, contracting parties are free to determine whether and how they wish to implement a system of authentication of electronic communications.

Under Rule 6 of the Treaty’s Regulations, the party may require that the signature of a natural person be accompanied by an indication of the family/secondary name, indication of the capacity in which that person signed may also be required. Under this Rule, the party may require that a signature be accompanied by the date on which the signing was effected. Where a communication to the trade-marks office of a party is on paper and a signature is required, handwritten signatures will be accepted or other forms (stamped signature, use of seal, etc.). A communication will be considered signed if a graphic representation of a signature accepted by that party is on the communication. The original may be required to be filed within a time limit and documents filed in electronic form may be required to be authenticated. Each party is free to determine how receipt of a document will be deemed to constitute receipt. Under Rule 6 of the Treaty’s Regulations, the date on which the trade-mark office of the party receives the communication must constitute its date of receipt.

Rule 6 of the Treaty's Regulations does not speak to "communications" with an applicant's appointed representative but if this Rule is read in conjunction with Rule 4 of the Treaty's Regulations, which allows for the appointment of representatives, there appears to be adequate protection for the appointed agent's "communications" with a national office on behalf of an applicant.

*Comments:*

*Rule 6 does not conflict with the existing ability of an applicant to address the Canadian trade-marks office under Canadian legislation. The effect of the eventual adoption of the Treaty would seem neutral on this point.*

### **Rule 7: MANNER OF IDENTIFICATION OF AN APPLICATION WITHOUT ITS APPLICATION NUMBER**

Rule 7 of the Treaty's Regulations addresses the issue of manner of identification of an application without its application number. This may be applicable when an application must be identified by its number but such number is not yet known (or hasn't yet been issued), in which case the provisional application number or a copy of the application with the date the application was received by the trade-mark office must suffice to identify the application.

Rule 7(1) of the Treaty's Regulations recognizes that there can be a gap between the time a trade-mark application is filed and the time it is assigned a filing (or serial) number by the trade-marks office with which it is filed. This rule also provides for means by which the existence of the application can nonetheless be recognized as existing. Rule 7(2) of the Treaty's Regulations provides that no national trade-marks office can ask for more than is required under Rule 7(1).

*Comments:*

*Rule 7 of the Treaty's Regulations adds little to practice before the Canadian Trade-marks Office. While Canadian legislation does not explicitly recognize this "gap" period, the Canadian Trade-marks Office has always allowed for correspondence between an applicant, or its duly appointed agent, prior to the issuance of the filing (or serial) number. The formalization of this practice, however, could be quite meaningful for parties who file applications in paper form with the Canadian Trade-marks Office because they do not immediately receive a serial number, in contrast to those who file online and immediately receive a serial number.*

### **Rule 8: DETAILS CONCERNING DURATION AND RENEWAL**

Rule 8 of the Treaty's Regulations (that implements Article 13(1)(c) of the Treaty) specifies the time period during which a holder can request renewal of its trade-mark and pay the applicable renewal fee. A holder must be allowed to request the renewal of its trade-mark (and pay the fee) at least six months before the renewal is actually due, or up to at least six months after the renewal is due. If the holder renews after the actual renewal date, the party may require it to pay a surcharge.

*Comments:*

*By comparison, under Canadian legislation (section 46 of the TMA), a holder can request the renewal of its trade-mark (and pay the related fee) any time during the registration period and up to six months after the renewal was actually due. This seems to conform to the minimum six month period stated in Rule 8 of the Treaty. The effect of the eventual adoption of the Treaty by Canada regarding this point would thus seem neutral.*

## **Rule 9: RELIEF MEASURES IN CASE OF FAILURE TO COMPLY WITH TIME LIMITS**

Rule 9 of the Treaty's Regulations corresponds to a number of provisions of the Treaty and sets out the party's obligations depending on the nature of the request made by an applicant or a holder. For example, under Rule 9(1) of the Treaty's Regulations, where an applicant or holder has requested an extension of time after the expiry of a time limit, the party must extend the time limit for a reasonable period of time and may require, in addition to certain identifying features of the application, that the request be filed within at least two months of the expiry of the time limit.

Under Rule 9 of the Treaty's Regulations, if the applicant or holder has asked for reinstatement of rights, the party may require, in addition to certain identifying features of the application, that the applicant or holder set out the facts behind the failure to comply. The request must be filed within a reasonable time (as set by the party) and the omitted act has to be completed within that period or, if required by the party, at the same time as the request. The party may require that the request and the act be completed within six months of the date of the original time limit.

Under Rule 9 of the Treaty's Regulations, if the applicant or holder has requested continued processing of the application (or registration) after the expiry of a time limit, the party may require, in addition to certain identifying features of the application, that the request be filed within at least two months of the actual expiry of the time limit. The omitted act must then be completed within that period or, if required by the party, at the same time as the request.

Rule 9 of the Treaty's Regulations also sets out the exceptions referred to in Article 14(3) of the Treaty (reinstatement of rights). These are the instances in which a party does not have to provide for any of the relief referred to in that Article 14(3). In brief, a party does not have to comply if the time limit for which relief is sought is one in which a relief measure regarding continued processing has already been granted; for filing a request for a relief measure; for payment of a renewal fee; for an action before an appeal board or other review body; for an action in inter partes proceedings; for filing a declaration claiming priority of an earlier application; for filing a declaration claiming protection from the display of goods and/or services in an exhibition; for filing a declaration to establish a new filing date for a pending application; and for the correction or addition of a priority claim.

*Comments:*

By comparison, under the Canadian legislation, section 47(1) of the TMA states that an extension may be granted by the Canadian Trade-marks Office "on such terms as he may direct", leaving a certain measure of discretion to the Canadian Trade-marks Office that may not technically be consistent with the Treaty's Regulations of allowing a "reasonable period of time". That said, the various extension of delays provided for by

the Canadian Trade-marks Regulations are quantified in a way that would at first glance seem consistent with the requirement that the delays be “reasonable”. Canadian legislation would thus seem inconsistent with the Treaty’s Regulations in this regard, and would require amendment if the Treaty is adopted by Canada.

*It is also note-worthy that the TMA (section 47(2)), contrary to the requirement stated in Rule 9 of the Treaty’s Regulations, does not allow that such requests be filed within two months of the expiry of the time limit. Rather, Section 47(2) of the TMA generally does not allow requests for extension of time filed after the expiration of the delay, which according to the current scheme will be allowed solely if the applicant or holder can demonstrate that its failure to file for the extension within the delay “was not reasonably avoidable”. This is inconsistent with the provisions found in Rule 9 of the Treaty’s Regulations, and as such would require amendment of the TMA were the Treaty adopted by Canada.*

*Pros: Adopting the Treaty’s scheme for extensions of delays would allow for more flexible treatment of issues of delays and generally favour applicants and holders that would more easily “save” applications and registrations concerning which delays were missed.*

*Cons: Adopting the scheme of Rule 9 of the Treaty’s Regulation would tend to allow delays to be missed by as much as two months, which may very well increase the time required to process trade-mark applications, registrations and renewals, thereby prolonging the period of uncertainty for third-parties waiting to know whether a given trade-mark will be (or remain) registered.*

#### **Rule 10: REQUIREMENTS CONCERNING THE REQUEST FOR RECORDAL OF A LICENSE OR FOR AMENDMENT OR CANCELLATION OF THE RECORDAL OF A LICENSE**

Regulation 10 of the Treaty’s Regulations provides the mechanism by which a request for recordal of a license can be effected. The regulation is permissive in nature and for the most part indicates what a party may require in order to record a license. The information covers the identity and address of the licensee, address for service, nature of the licensee (individual versus legal entity), the goods and services (classed in accordance with the Nice Classification System, which Canada does not use at present), whether the license is exclusive, non-exclusive or sole, territory and duration. Regulation 10 also addresses what a party may require in a request to amend or cancel the recordal of a license.

The Treaty’s Regulations sets out what supporting documentation a party may require in order to effect the recordal or amendment/cancellation of a license.

In summary, when considering the issue of recordal of a license, the laws of the party generally apply with respect to the recordal. Article 17 of the Treaty does indicate what a party may not require to effect the recordal, however, Rule 10 of the Treaty’s Regulations deals only with the permissive sections of Article 17 of the Treaty not the prohibitive ones.

*Comments:*

*Licenses do not need to be recorded under the TMA but can be placed on file, if desired.*