

Madrid Examination and Procedures Manual - International Trademarks under the Madrid System

Madrid Examination and Procedures Manual - International Trademarks under the Madrid System.....	1
CANADA - Contracting Party to the Madrid Protocol.....	4
Accession Declarations.....	6
How the Madrid System works as an Office of Origin	7
Who can file an AIR using CIPO as Office of Origin?.....	7
Contents of the AIR	8
Basic Application or Registration:.....	8
Designated Contracting Parties:.....	8
Representative.....	9
Languages and Correspondence	9
Trademark	9
Goods and Services.....	9
Claimed Priorities.....	10
MM17 – Claim of Seniority: European Community	10
MM18.....	10
Attachments.....	10
Fee Calculation	11
Submitting to CIPO for Certification.....	11
Certification of the AIR by CIPO	11
Pre-Certification Irregularities.....	12
Responding to Pre-Certification Irregularities	12
Presenting the Certified AIR to WIPO	13
WIPO Irregularities.....	13
Responding to WIPO Irregularities	13
Registration of the AIR	14
5-Year Dependency Period.....	14
Ceasing of Effect.....	14
Division or Merger.....	14
Certification of Change in Ownership of the International Registration (WIPO Form MM5)	15
Other Transactions with WIPO	15

WIPO's MM Forms.....	15
Contact Madrid	15
CIPO as a Designated Office	16
Role of CIPO as a Designated Office	16
Receiving Designations.....	16
Filing date of a Protocol Application.....	17
Examination of Protocol Applications	18
Search of the Canadian Trademarks Database and Register	18
Examiner Research.....	18
Approval of the Protocol application for advertisement.....	18
Refusal of the Protocol application	18
Total Provisional Refusal.....	18
Responding to a Total Provisional Refusal (Examiner's Report)	19
Maintaining an objection	19
Abandonment of Protocol application	19
Confirmation of Total Provisional Refusal	19
Divisions and Mergers.....	20
Division of an IR	20
Merger of IR	20
Opposition.....	21
Registration.....	21
Statement of Grant of Protection	21
Renewal.....	21
Effect on Protocol Applications.....	22
Effect on Protocol Registrations	22
Notifications from WIPO.....	23
Limitation.....	23
Effect on Protocol applications:	23
Effect on Protocol registrations:	24
Renunciation	25
Effect on a Protocol Application	25
Effect on a Protocol Registration.....	25
Complete Cancellation of the IR	25
Effect on a Protocol Application	25
Effect on Protocol Registration.....	25
Partial Cancellation of the IR	25

Effect on a Protocol Application	26
Effect on a Protocol Registration.....	26
Complete Cancellation due to Ceasing of effect of the Basic Application or Registration.....	26
Effect on a Protocol Application	26
Effect on a Protocol Registration.....	26
Partial Cancellation due to Ceasing of effect of the Basic Application or Registration.....	26
Effect on a Protocol Application	26
Effect on a Protocol Registration.....	26
Change of Name/Address of the Holder of the IR.....	27
Renewal or Non-Renewal of IR	27
Effect on a Protocol Application	27
Effect on a Protocol Registration.....	27
Corrections to the International Register.....	27
Effect on a Protocol Application	28
Effect on a Protocol Registration.....	28
Change in ownership (Transfers/Mergers).....	28
Effect on a Protocol Application	29
Effect on a Protocol Registration.....	29
Irregularity notifications from WIPO	29
Recording license agreements	29
Transformation.....	29
Replacement.....	30
Requesting corrections to WIPO.....	30
Managing an IR.....	30

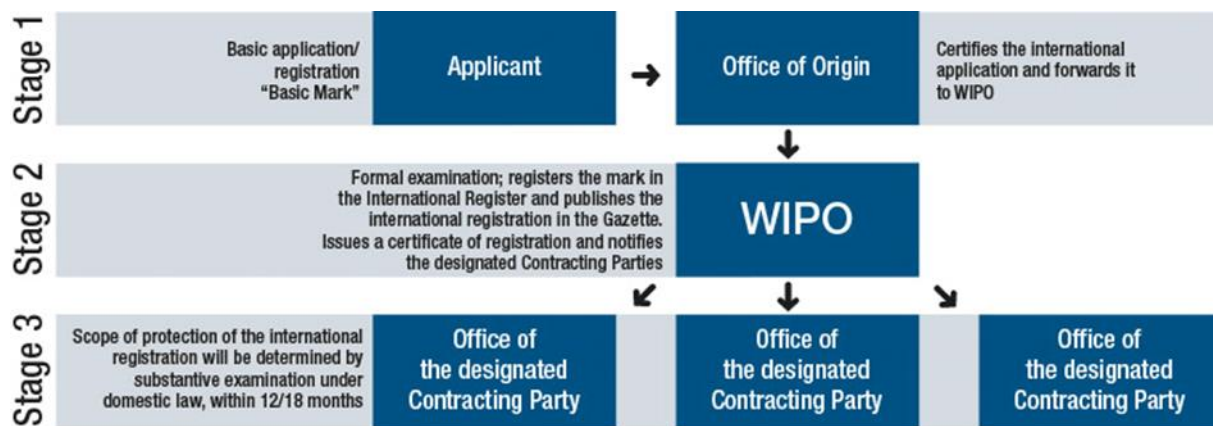
CANADA - Contracting Party to the Madrid Protocol

Canada became a Contracting Party to the Madrid Protocol on June 17th 2019.

The Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks (Madrid Protocol) is an international treaty that offers businesses and innovators the possibility of obtaining trademark protection in more than 100 countries by filing one single international application in one language with the World Intellectual Property Organization (WIPO). One overall payment is made in one currency, the Swiss Franc (CHF), thus simplifying the application process and providing financial savings for those seeking to obtain and maintain protection for their trademarks internationally.

The International Bureau of the WIPO, located in Geneva, Switzerland administers the international registration system. The Canadian Intellectual Property Office (CIPO) is responsible for the administration and processing of trademarks in Canada. CIPO's mandate is to deliver high quality and timely IP services to customers, and to increase awareness, knowledge and effective use of IP by Canadians.

Figure 1 below illustrates the different stages of the Madrid System explaining the basic steps involved and the responsibilities of each party.



Source: http://www.wipo.int/madrid/en/how_madrid_works.html

Figure 1

Overall, the international procedure under the Madrid Protocol comprises three stages.

Before filing an application for international registration (AIR), also referred to as the international application, with its national intellectual property office, the applicant will need to have already registered, or have filed a national application, in the “home” intellectual property office (known as the Office of origin). In Canada, these will be known as the basic application or basic registration (also referred to as the basic mark). The applicant must then submit the AIR through this same IP Office, which will certify and forward it to WIPO.

During stage 2, WIPO conducts a formal examination of the AIR and assesses conformity with rules 12 and 13 of the *Common Regulations under the Madrid Agreement Concerning the International Registration of Marks and the Protocol Relating to that Agreement* (Common Regulations). Once the application is approved, WIPO will notify the IP Offices in all the territories where protection of the trademark is sought by the applicant.

Next, for stage 3, the IP Offices of the territories where protection of the trademark is sought will make a decision within the applicable time limit (12 or 18 months) in accordance with their legislation. WIPO will record the decisions of each of the IP Offices in the International Register and notify the applicant of these decisions. If one IP Office refuses to protect the trademark, either totally or partially, this decision will not affect the decisions of other IP Offices. The applicant can contest a refusal decision directly before the IP Office concerned in accordance with the legislation in that country. If an IP Office accepts to protect the trademark, it will issue a statement of grant of protection.

To distinguish between international trademarks under the Madrid System from national trademarks filed and registered in Canada with CIPO, it is important to be familiar with the following definitions:

- a “**basic application**” refers to a national application that has been filed in Canada with CIPO and serves as the basis for an AIR;
- a “**basic registration**” refers to a registration of a trademark that is on the Canadian register and serves as the basis for an AIR;
- a “**Protocol application**” refers to a request filed with WIPO to extend the protection of an international registration (IR) to Canada which will be examined for compliance with Canadian legislation;
- a “**Protocol registration**” refers to a trademark that has been registered in Canada as a result of a “Protocol application”;
- the “**Office of Origin**” means the trademark office of the Contracting Party which may receive and certify an application for the international registration of a trademark. In Canada, this office is CIPO; and
- a “**contracting party**” refers to a member to the Madrid Protocol.

Another illustration explaining the difference between the Office of Origin and a Designated Contracting Party is shown in Figure 2 below.

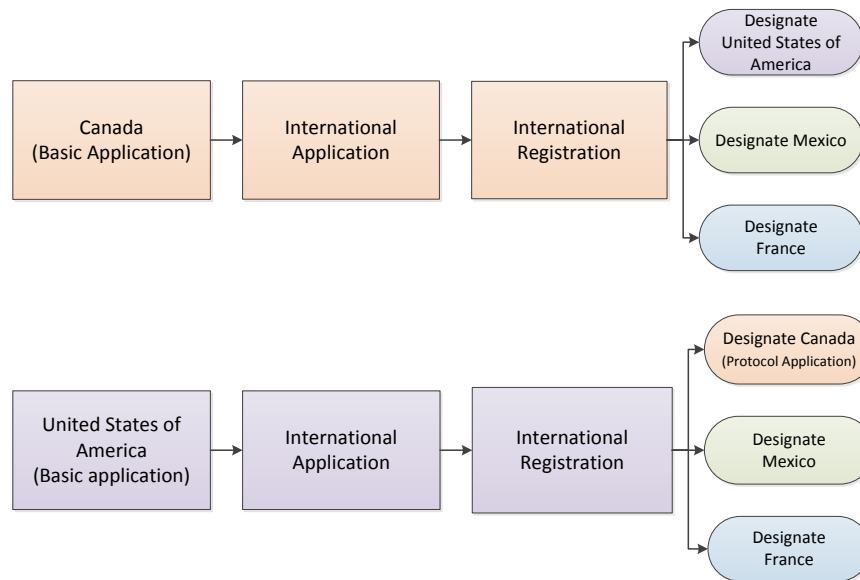


Figure 2

In the top portion, a Canadian application is used as the basis for an international application in which the United States of America, Mexico and France have been designated as contracting parties in which the applicant wishes to request protection of the trademark. In the bottom portion, an application pending in the United States of America is used as the basis for an international application in which Canada, Mexico and France have been designated as contracting parties in which the applicant wishes to request protection of the trademark. When this reaches CIPO, it is referred to as a Protocol application.

Accession Declarations

Each new member to the Madrid Protocol can chose to make certain declarations concerning the operation of the International Registration System. Canada has chosen to make four (4) declarations as part of its accession to the Madrid Protocol.

Article 5(2)(b) of the Madrid Protocol which extends the provisional refusal period from twelve (12) to eighteen (18) months. This means that the provisional refusal (what is nationally referred to as the examiner's report, must be sent before the end of the eighteen (18) months after CIPO is notified of the designation.

Article 5(2)(c) of the Madrid Protocol allows Canada to send a notification to WIPO informing them that a provisional refusal based on an opposition may be issued on a Protocol application after the eighteen (18) month time limit. What this means is that there is a possibility that if the opposition period has not yet occurred and more than eighteen (18) months have passed since the date of notification of designation, Canada will be able to send a notification of provisional refusal based on an opposition if a statement of opposition is filed on that Protocol application.

Article 8(7)(a) of the Madrid Protocol provides for the ability to charge individual fees. These fees will be the equivalent of the national fees, but in Swiss Francs (CHF).

Rule 20bis(6)(b) of the Common Regulations declares that the recording of licenses is provided for by national law but the recording of these licenses in the International Register alone has no effect.

CIPO as an Office of Origin

Canadians wishing to register their trademarks in any of the contracting parties of the Madrid Protocol can do so by filing an AIR with CIPO.

How the Madrid System works as an Office of Origin

The Registrar has certain responsibilities as an Office of Origin under the Madrid Protocol. The *Trademarks Regulations* will list the content required to complete WIPO's model form (MM2) via the Madrid eFiling service which will be accessible on CIPO's website in English or in French. These requirements will be clearly laid out in the online filing system and the fee will be automatically calculated, payable in Swiss Francs within the system, and will include the WIPO filing fee for the AIR and the fee for each contracting party that has been designated. Note that CIPO will not require any fee for the certification of the AIR.

The Registrar will review the particulars appearing in the AIR and certify that they correspond to those appearing in the basic application or registration. If clarification or more information is required, the Registrar will contact the applicant. If not, the AIR is certified and forwarded to WIPO.

Also different from the national registration system, transfer of ownership requests must be presented directly to WIPO. In cases where the new owner is unable to obtain the signature of the previous owner of the IR, the request accompanied by evidence of the transfer, may be filed with the Registrar for presentation to WIPO.

The Registrar will also notify WIPO of any change or proceeding affecting the scope of protection in the basic application or registration within five years of the date of the IR (Ceasing of effect). For example, if the applicant makes changes to the statement of goods or services, our practice will be to notify WIPO when the basic application matures to registration or at the expiration of the five year period, whichever is the case.

When submitting the AIR using the Madrid eFiling system, fees are payable directly to WIPO and cannot be paid using a CIPO account. The applicant or trademark agent must use a WIPO current account or a credit card to pay all fees related to the AIR or the maintenance of the IR.

Who can file an AIR using CIPO as Office of Origin?

In accordance with section 98 of the *Trademarks Regulations*, there are two conditions that a person must meet to be entitled to file an AIR through CIPO.

- a. the person is a national of or is domiciled in Canada or has a real and effective industrial or commercial establishment in Canada.
- b. the person is the applicant of a previously filed Canadian application or the registered owner of a Canadian registration.

A person must submit their AIR through the same IP Office that they have already registered, or have filed an application for a basic trademark. Additionally, a person must group the goods or services of their basic application or registration according to the classes of the *Nice Classification* prior to seeking international registration.

Contents of the AIR

WIPO requires that the applicant submit the “Application for international registration governed exclusively by the Madrid Protocol” (commonly referred to as the MM2 form) to their Office of Origin for certification. To facilitate this process, Canada has chosen to adopt WIPO’s filing system, Madrid eFiling, which is an electronic version of the MM2 form.

Basic Application or Registration:

To be able to file the AIR, the applicant must have already filed an application for the registration of a trademark with CIPO or own a trademark that is registered with CIPO. This will serve as the basic application or basic registration for the AIR.

When using the Madrid eFiling service, the applicant will not be able to upload as a basic application or registration if:

- the basic application is not yet formalized (status pre-formalized);
- the goods or services listed in the basic application have not been grouped according to the classes of the Nice Classification;
- the trademark is not a word (or words) with or without standard character claim and does not include a visual representation
- the applicant is trying to upload an official mark, a trademark registered under the laws of Newfoundland, a 6ter mark, a Mark Protected by Federal Act of Incorporation (i.e. Girl Guides or Boy Scouts or Scouts).

Designated Contracting Parties:

The applicant must identify in the AIR the contracting parties where they wish to request protection of their trademark. These are referred to as the designated contracting parties.

Under the Madrid System, an applicant from any Contracting Party may designate any other member of the Madrid Union. However, the Contracting Party whose office is the Office of Origin cannot be designated in an AIR. That means that when using CIPO as the Office of origin, Canada cannot be included as a designated contracting party.

For each designated Contracting Party, the applicant may seek protection for all or only some of the goods or services contained in the basic application or registration.

It is important to note that the total filing fee will include the WIPO base fee and be calculated based on the number of contracting parties that are designated in the AIR (either the collective fee or their individual fees), and the number of Nice classes of goods or services included in the AIR. The [Schedule of Fees](#) for the Madrid System in Swiss Francs (CHF) is available on the

WIPO website. WIPO also offers an International Registration of Marks [Fee Calculator](#) which can help applicant decide whether or not to include certain contracting parties in their AIR.

Representative

The applicant may choose to appoint a WIPO representative for the processing of the AIR as well as any other proceedings before WIPO.

This person can be the appointed Canadian trademark agent appearing in the basic application or registration. However, the applicant may choose someone else. CIPO will correspond with this appointed representative for the certification of the AIR as well as to respond to any WIPO Irregularities.

Languages and Correspondence

The applicant can choose to communicate with CIPO in English or French. However, communication with WIPO may be in French, English or Spanish. In addition, if the applicant wishes to designate the EUIPO, a second language of correspondence that is different from the language of the AIR must be also be identified, and the applicant can choose from English, French, Spanish, Italian or German.

Trademark

If the trademark consists solely of a word (or words), the applicant will not be required to include a graphic representation of the trademark in the AIR since the trademark will have been populated in the trademark field as it appears in the Canadian trademarks database.

If the basic application or registration includes a claim to standard characters, it must also be included in the AIR when using the Madrid eFiling system. If the basic application or registration does not include a claim to standard characters, and the trademark consists solely of a word (or words), the applicant may include the standard character claim in the AIR for certification using the Madrid eFiling system.

If the basic application or registration includes a colour representation or a colour claim, the colour representation or the colour claim will have to be included as such in the Madrid eFiling system. If the representation in the basic application or registration is in colour, only one representation will be required in the AIR; however, if the representation in the basic application or registration is in black and white and the basic application or registration includes a colour claim, the applicant will be required to include a second representation of the same trademark in colour. This can be done by uploading the second representation in the attachments section in the Madrid eFiling system.

The applicant must always include a visual representation of the trademark if it does not solely consist of a word (or words).

Goods and Services

The applicant may include in the AIR all or only some of the goods or services contained in the basic application or registration. If the list of goods or services is amended when completing the AIR, it is important to keep in mind that any amendments may inadvertently expand the scope of goods or services beyond what exists in the basic application or registration, which would result in a pre-certification irregularity issued a CIPO examiner.

The applicant may also limit the scope of goods or services for which protection is being sought in some of the designated contracting parties. This would be done by creating a limitation list within Madrid eFiling.

For example, if the main list of goods in the AIR includes classes 1 to 5 with designations to ten Contracting Parties, the applicant can include the following limitations within Madrid eFiling reducing both the scope of goods and cost for some of the designated contracting parties:

Contracting Party	Class(es) of goods or services for which protection is sought
Australia	Classes 1, 4 and 5
Japan	Classes 1 and 5

For the remaining eight designated Contracting Parties, protection is being sought for classes 1 to 5, and for Australia and Japan, protection is only being sought for the goods indicated in the limitation tab within Madrid eFiling (i.e., classes 1, 4 and 5 and classes 1 and 5, respectively). Fees will only be calculated based for those classes.

The example provided shows a limitation relating to entire classes of goods. However, the applicant may prefer to retain the class but want to reduce, within the class, the scope of protection being sought.

Claimed Priorities

The applicant may include a Paris Convention priority claim if the filing date of the earliest application is within six months of the filing date of the AIR.

For example, if the basic application is filed on June 3rd, 2019 and it is the earliest application filed in a country of the Union for the same trademark for the same or similar goods or services, that basic application's filing date can be included as a claimed priority date in an AIR filed on September 17th, 2019.

MM17 – Claim of Seniority: European Community

When the applicant has included the EU as a designated contracting party in the AIR and wishes to claim seniority under the Madrid Protocol, the MM17 section must be completed within the Madrid eFiling system.

MM18

If the applicant has included the United States of America as a designated contracting party in the AIR, the "Declaration of intention to use the trademark (United States of America)", commonly known as the MM18 form, **must** be completed within the Madrid eFiling service.

An [MM18](#) signed by the applicant can also be included in the attachments section within Madrid eFiling when a registered Trademark Agent is completing the AIR for the applicant. Note however that the mandatory fields of the MM18 within Madrid eFiling must still be completed to be able to proceed.

Attachments

By default and when applicable, a PDF version of the MM18 will appear in the attachments section. The applicant may also include attachments within the Madrid eFiling system in this section. As previously mentioned, if the basic application or registration included a black and white representation of the trademark with a colour claim, the colour representation of the trademark will have to be included under the attachments section.

Fee Calculation

The AIR is subject to the payment of the following WIPO filing fees:

1. A basic fee (higher if the trademark is in colour);
2. A complementary fee in respect of each designated contracting party for which an individual fee is not payable;
3. A supplementary fee in respect of each class of goods and services beyond the third; for certain contracting parties, the complementary fee is replaced by an "individual fee".

If the applicant has designated a Contracting Party that has made the declaration in accordance with Article 8(7) of the Protocol, it will be necessary to pay that Contracting Party's individual fee. The amount of the individual fee is determined by each Contracting Party. However, an individual fee may not be higher than the registration fee of a trademark in the office of that Contracting Party. [A list of Contracting Parties that have chosen to receive individual fees under the Madrid Protocol can be found on the WIPO website \(fees shown in Swiss francs\).](#)

The Madrid eFiling service calculates AIR fees based on the WIPO handling fees *and* the designated contracting party's individual fees. It also takes into account the number of classes included in all the "limitation lists". If an applicant wishes to calculate fees beforehand, the [WIPO fee calculator](#) is a useful tool.

Submitting to CIPO for Certification

The AIR in the Madrid eFiling system can be submitted electronically to CIPO for certification once the applicant is satisfied with its contents. The applicant will receive an email confirmation that the AIR was submitted successfully. An additional email will be sent to confirm that payment of the AIR was received by WIPO.

Certification of the AIR by CIPO

The CIPO examiner will review the contents of the AIR to certify that it corresponds to the content of the basic application or registration. The review will consist of certifying the following:

- the owner's information in the AIR is the same as in the basic application or registration;
- the owner is entitled to file the AIR using CIPO as the Office of Origin;
- the trademark in the AIR is the same as the trademark in the basic application or registration including any colour claims or any statement regarding 3D, sound, certification trademark, description, or other; and

- the goods or services listed in the AIR, including any limited lists are within scope of the goods or services appearing in the basic application or registration.

Pre-Certification Irregularities

If the examiner is unable to certify the AIR as submitted by the applicant, pre-certification irregularities will be communicated directly to the applicant through the Madrid eFiling service with an email notification to the applicant informing them of the issues and inviting them to respond within Madrid eFiling.

Pre-certification irregularities may include a variety of issues including but not limited to the applicant not being entitled to file an AIR via CIPO, a missing colour claim or issues regarding the scope of goods or services.

Responding to Pre-Certification Irregularities

The applicant will have 2 weeks to respond to any pre-certification irregularities within the Madrid eFiling system. To do so, the applicant must access the Madrid eFiling system and respond within the section where the irregularity was raised. Note that at this point the applicant will not be able to make any changes to other sections as these will have read-only access and be “locked” from editing.

If the applicant notices an error in any of the locked sections, he or she may contact the examiner to re-open these sections. The examiner will recall the AIR and raise the pre-certification irregularity following the conversation with the applicant or their representative.

For example, if the applicant forgot to include a contracting party under the designated contracting parties section, the examiner may raise an irregularity indicating that a “change was requested to the “Designated Contacting Parties” section following a conversation with the applicant”. This will “unlock” the corresponding section within Madrid eFiling and the applicant will then be able to add (or remove) the contracting party that was subject of the requested change.

It is important to track the status of the AIR. WIPO will recognize the filing date of the AIR as the international registration date only if CIPO certifies and forwards the AIR before the end of a period of two months following receipt of the AIR. .

In the event of pre-certification irregularities issued by the examiner, a complete and timely response will give the examiner sufficient time to review the response and forward it to WIPO before the two-month certification deadline.

However, if any pre-certification irregularities remain unresolved beyond the two-month certification deadline, the AIR will only be forwarded to WIPO when all pre-certification irregularities are resolved and the international registration date will be the date the certified AIR is received by WIPO. If the applicant does not respond to the irregularities raised by an examiner, CIPO will consider the AIR closed until such a time as the applicant provides a response. Note that the default provisions contained in section 36 of the *Trademarks Act* do not apply.

After your AIR is forwarded to WIPO, the status is dependent on the review process and service standards. You may use the Madrid Monitor to track the status of your international application and registration as it moves through the WIPO examination process.

Presenting the Certified AIR to WIPO

Once the examiner is satisfied that the contents of the AIR correctly reflect the contents of the basic application or registration, the AIR is certified and submitted electronically to WIPO using the Madrid eFiling service. The applicant will receive an email confirmation that the AIR was certified and submitted to WIPO for review and registration.

When WIPO receives the AIR, the details of the AIR will be uploaded into their database called the [Madrid Monitor](#).

WIPO Irregularities

Upon examination of the AIR, WIPO may issue a notification of irregularity if there are deficiencies in the AIR or if clarification is required. WIPO communicates these irregularities within the Madrid eFiling system (with notification by email) to the applicant and with a copy to CIPO. Irregularities are not always fatal to the registration of a trademark and can range from insufficient payment to incorrect classification of goods.

Certain irregularities will be remedied by CIPO. For example, the applicant is not entitled to file an AIR as he is not a national of Canada and has not provided a Canadian address.

Other irregularities will need to be remedied by the applicant either directly with WIPO, for example, in the case of missing fees, or through CIPO, for example, in the case of an incorrect classification of goods or services.

In all cases, the notification will clearly indicate who must provide a response.

Irregularities must be remedied with WIPO within three months. Where the irregularity is not remedied, the AIR could be declared abandoned in some cases. Generally this information will be included in the irregularity letter sent by WIPO.

There are three distinct kinds of WIPO irregularities. These are:

- irregularities with respect to the classification of goods and services (Rule 12 of the Common Regulations);
- irregularities with respect to the indication of goods and services (Rule 13 of the Common Regulations);
- other irregularities (Rule 11 of the Common Regulations).

For more information on each type of irregularity and how they can be overcome, the applicant is invited to review the [Guide to the International Registration of Marks under the Madrid Agreement and the Madrid Protocol](#).

Responding to WIPO Irregularities

All responses to irregularities can be submitted within the Madrid eFiling service. The applicant will be required to attach a response to each individual irregularity and, if applicable, pay any outstanding fees using the [WIPO E-payment](#) service. The WIPO irregularity responses attached to the AIR will have to be sent to CIPO for review using the Madrid eFiling system. Once all issues are resolved, CIPO will forward the AIR and responses to WIPO.

Where clarification is required, a CIPO examiner will contact the applicant or their representative for any missing information.

Registration of the AIR

If WIPO is satisfied that the AIR conforms to the applicable requirements, the trademark is registered and WIPO sends a certificate to the holder and notifies the Offices of the designated Contracting Parties of the international registration, as applicable. WIPO also informs the Office of Origin of the registration and provides the international registration number.

WIPO publishes the details of the international registration in the WIPO Gazette of International Marks, the official publication of the Madrid System, which can be accessed via the Madrid Monitor (www.wipo.int/madrid/monitor/en).

5-Year Dependency Period

Although the international registration appears to be independent from the basic application or registration from which it stemmed, there is a period of five (5) years during which certain changes that are made to the basic application or registration must be communicated to WIPO. At the end of the five (5) year dependency period, the international registration becomes completely independent of the basic application or registration.

Ceasing of Effect

If any changes are made to the scope of protection during the five (5) year period, or if a change in scope is the result of a proceeding that began during this five (5) year period, CIPO must communicate to WIPO the effect the change has on the international registration. This is referred to as a ceasing of effect notification and can be total or partial depending on whether any goods or services remain in the international registration and on the goods or services that were included from the basic application or registration.

For example, the AIR was submitted using a basic registration that contained both goods and services. Four years later, the basic registration is subject to summary expungement proceedings under section 45 of the *Trademarks Act*. Two years later the proceedings come to a close the services has been removed from the basic registration due to non-use. Since the proceedings began with the five (5) year period and there are changes in the scope of protection, CIPO will notify WIPO the change by way of a ceasing of effect.

Division or Merger

CIPO must communicate to WIPO the basic application or registration numbers that remain linked to the international registration following the recording of a division or merger on the basic application or registration.

This is done at the time the division or merger is recorded in the Canadian Trademarks Database or register by sending an electronic transaction to WIPO informing it of the update the basic application or registration information for the international registration

Certification of Change in Ownership of the International Registration (WIPO Form MM5)

A transferee of an international registration may file with the Registrar a request for the recording of a change in ownership of the international registration for the presentation to WIPO if the transferee:

- is a national of or is domiciled in Canada, or has a real and effective industrial or commercial establishment in Canada; and
- has been unable to obtain, on a request for the recording of a change in ownership of the international registration, the signature of the holder of the international registration or of the holder's representative recorded in accordance with rule 3(4)(a) of the Common Regulation.

The request must be in English or French and be filled by completing the form issued by WIPO and providing it to the Registrar by facsimile.

The request must be accompanied by evidence of the transfer and a statement to the effect that the transferee made efforts to obtain the signature of the holder of the international registration or that of their representative recorded in accordance with Rule 3(4)(a) of the Common Regulations, and that their efforts were not successful.

The Registrar must then transmit to WIPO a request for the recording of a change in ownership that is filed in accordance with the above and if the Registrar considers the evidence of the transfer to be satisfactory. This will be done by sending an electronic transaction to WIPO.

Other Transactions with WIPO

Once the trademark is registered at WIPO, all modifications to the international registration must be made directly with WIPO. These include but are not limited to subsequent designations, changes in ownership, and renewals.

WIPO's MM Forms

WIPO has made available on their website a multitude of [required forms](#) to be used to request changes to the information related to the international registration as it appears in WIPO's International Register.

There are currently three electronic services offered by WIPO for the Madrid System namely the [e-subsequent designation](#), [e-renewal](#) and [e-payment](#).

Contact Madrid

WIPO also offers a web based correspondence service where applicants or holders of international registrations, or their WIPO representatives, can ask questions or submit forms. It is referred to as "[Contact Madrid](#)" and enquiries can be sent in English, French and Spanish.

CIPO as a Designated Office

CIPO is considered the Designated Office when an AIR that was filed in another Contracting Party has included Canada in the list of designated contracting parties where the applicant wishes to extend protection of the trademark to.

The Madrid Examination and Procedures guide explains the procedures for examining a trademark application filed through the international system. The registrability of the trademark is determined in the same manner as that of a trademark application filed under the Canadian national system and is assessed in accordance with the provisions of the *Trademarks Act* and *Regulations*. The owner of the international registration can obtain protection with the same effects as a nationally filed trademark application filed directly with CIPO.

Role of CIPO as a Designated Office

As a Designated Office, CIPO is responsible for receiving, examining and processing of international trademarks for which Canada has been designated under the Protocol (Protocol applications).

In addition, and when applicable, CIPO is responsible for updating the Canadian trademarks register to reflect changes to the details of the international registration as it pertains to Canada. WIPO communicates these changes to CIPO via electronic notifications on a weekly basis. Examples include changes:

- in ownership of the international registration;
- in name or address of the holder of the international registration;
- to the scope of protection of the list of goods or services

The practices of the Canadian Trademarks Office as well as provisions of the *Trademarks Act* and *Regulations* are applied to all Protocol applications that are received under the Madrid System and include:

- receiving the designation notification from WIPO and assigning it an application number (Protocol application);
- examination of the Protocol application for compliance with the *Trademarks Act* and *Regulations*;
- advertisement of the Protocol application by publishing it on the CIPO website;
- opposition proceedings;
- registration of the Protocol application (becomes a Protocol registration).
- renewal dependent on the international registration

Receiving Designations

CIPO receives electronic notifications from WIPO on a weekly basis informing it of international registrations for which the owner is seeking to extend protection to Canada. This designation can be part of an initial designation as part of a new international registration or can be part of a subsequent designation from an existing international registration. In Canada, these designations are referred to as “Protocol applications”.

A Protocol application means an application referred to in subsection 103(1) or (2) of the *Trademarks Regulations* or a divisional application referred to in subsection 134(1) of the *Regulations*. It is considered an application filed under subsection 30(1) of the *Trademarks Act* and is assessed for compliance with the *Act* and its *Regulations*.

Protocol registrations are Protocol applications that have matured to registration.

Filing date of a Protocol Application

The filing date of the Protocol application is either the date of the international registration or the date borne by the subsequent designation. This date is communicated in the notification of designation received by WIPO and will be earlier than the date that CIPO receives the notification. This is different than the national process where the filing date is the date on which CIPO receives all of the information required under section 33 of the *Trademarks Act*.

A Paris Convention priority claim may have been included in the designation. This date will be considered when assessing entitlement against a co-pending confusing trademark.

If the language of the designation notification is identified as Spanish, an offer for future communication in English or French will be included in the acknowledgement and filing notice in accordance with *Canada’s Official Languages Act*. By default, the Registrar will communicate in English with the applicant.

If a WIPO representative was included in the designation notification but does not appear on the Canadian list of Trademark agents, the Registrar will, when CIPO receives the designation, issue a courtesy letter informing that the representative that any future correspondence regarding the Protocol application will be directly with the applicant or the appointed Canadian agent if one is appointed.

If the designation is for a collective, certification or guarantee mark, which are different terms used in other jurisdictions to reference the same or similar type of trademark, it will be considered and examined as a certification mark in Canada.

CIPO is required to inform WIPO within 18 months of the notification date whether each trademark can be protected in Canada. CIPO will issue a total provisional refusal to WIPO at the examination stage if objections are raised or requirements are necessary for the trademark application, and follow up with a final decision once all proceedings before the Office, including any appeals to the courts, have been completed. WIPO will forward all letters from CIPO relating to the international designation to the holder of the trademark, or their representative.

To be consistent with the national process, paper files will be created for Protocol applications using existing outputs namely the cover label, the pdf of the designation notification, the edit sheet and the examiner research sheet. The next available application number will be used and once the paper file is assembled a pink sticker with the letter “M” will be added next to the Protocol application number on the file jacket.

Examination of Protocol Applications

Protocol applications are subject to the same examination process as national applications. They must meet the registrability requirements of the *Trademarks Act* and *Regulations*, as well as follow or meet or office practices and procedures. Please refer to the *Trademarks Examination Manual* for more information on the examination of national applications.

Examiners will be responsible for reviewing Protocol applications that are awaiting examination and will examine them on a “first come - first serve” basis as is done with national applications.

Search of the Canadian Trademarks Database and Register

For Protocol applications, the examination process begins with a search of the Canadian Trademarks Database for confusion or entitlement against existing trademark applications or registrations. For more details on the examination search process and assessment, see the *Trademarks Examination manual*.

Examiner Research

In addition to a confusion search, examiners are required to research the trademark using various reliable sources to ensure that the Protocol application does not contravene the *Trademarks Act*, e.g. for example to ensure the trademark is not clearly descriptive or has inherent distinctiveness. Please refer to the *Trademarks Examination Manual*

Once the examiner has completed the search and research and analyzed the results, there are two (2) possible outcomes for the Protocol application: approval for advertisement or refusal.

Approval of the Protocol application for advertisement

If the examiner determines that the Protocol application meets all of the requirements, is not unregistrable and is compliant with the Canadian *Trademarks Act* and *Regulations*, the Protocol application is approved. The examiner sends an approval notice to the applicant informing them of the impending advertisement of the Protocol application on the CIPO Website by way of the *Trademarks Journal* for opposition purposes.

Refusal of the Protocol application

The refusal process for a Protocol application is slightly different than for a national application since the first correspondence is referred to as a total provisional refusal and is sent to WIPO. It is the equivalent of the examiner’s first report and lists all of the examiner’s objections and/or the requirements that must be met by the applicant.

Total Provisional Refusal

If following the examination of the trademark by CIPO the Protocol application is not compliant with the *Trademarks Act* or *Regulations*, a notification will be sent to WIPO listing the objections. This is referred to as a Total Provisional Refusal and must be issued by CIPO before the 18-month deadline (from the date of notification of the designation to Canada) set by WIPO. This is the equivalent of an examiner’s first report that would include all of the objections to registration as well as any requirements that have not been met.

As a courtesy, since the applicant will have a period of six (6) month to respond to the total provisional refusal, CIPO will also send a copy (including the examiner's first report) to the applicant or their Canadian trademark agent if one has been appointed. It is important to note that WIPO's practice is to forward the Total Provisional Refusal to the holder of the international registration or the appointed WIPO representative. This means that the applicant may also receive the document from WIPO, sometimes even after already having submitted a response to CIPO.

Any request to amend the statement of goods or services prior to the issuance of a Total Provisional Refusal will not be accepted. The procedure under the Madrid System required that the holder of the IR request a Limitation of the goods or services of the IR in respect of Canada [directly with WIPO using the MM6 form](#). This request will then be forwarded to CIPO who will make changes accordingly.

Responding to a Total Provisional Refusal (Examiner's Report)

When the applicant receives a Total Provisional Refusal, the response must be sent directly to CIPO and not to WIPO. Responses can be filed using CIPO's online e-service for filing an amended application or by paper mail or fax. The applicant may choose to appoint a Canadian Trademark Agent to file the response to the Total Provisional Refusal.

It is possible to request for the extension of the deadline to respond and in this regard, the same national practice applies. Please see the practice titled "*Extensions of time in Examination and to respond to a section 44.1 notice*".

The examiner will assess the response provided by the applicant and determine whether the Protocol application can be approved or if any objections will be maintained or any of the requirements remain outstanding

Maintaining an objection

If the examiner is maintaining an objection raised in a total provisional refusal, it is the same process as for national applications in that a correspondence is issued to the applicant, or Canadian trademark agent if one has been appointed, detailing why the objection is maintained and instructing the applicant that a response must be filed with CIPO before a period of six (6) months from the date of the examiner's report.

At this time, if there are no new grounds raised by the examiner and if the 18-month period to send a provisional refusal has not expired, WIPO is not notified.

Abandonment of Protocol application

If the applicant does not respond by the deadline specified in the examiner's report, the Protocol applicant will be considered to be in default of the prosecution of the Protocol application. In such cases, a notice of default will be sent to the applicant, or their Canadian trademark agent informing them of the default and provide a period of two months to remedy the default. If a response is not received within the deadline, the Protocol application will be abandoned and a Confirmation of Total Provisional Refusal will be sent to WIPO informing them of the refusal of the Protocol application for failure to respond.

Confirmation of Total Provisional Refusal

If after considering the applicant's response the examiner believes that the Protocol application cannot be protected in Canada, a refusal letter will be issued by CIPO and sent to the applicant. The refusal is subject to a two-month appeal period with the Federal Court of Canada. Once all appeal periods have expired and an appeal is not filed with the Canadian Courts, CIPO will send a Confirmation of Total Provisional Refusal to WIPO informing them of the refusal of the Protocol application and the refusal will be recorded on the International Register.

Divisions and Mergers

Divisions and mergers of international registrations were introduced in the Madrid System in February 2019. All requests for division of the international registration must be filed with CIPO using the required form available on the WIPO Website.

Division of an IR

An applicant may choose to divide the international registration with respect to the designation to Canada if an examination report reveals an objection to the registration of the trademark with respect to some goods or services. The applicant may wish to request to divide out (limit) goods or services that have been the subject of an objection from the original Protocol application and divide them out to a new divisional Protocol application to allow them to proceed to advertisement.

By way of example, if the Protocol application is for goods in classes 25 and 32 and the examiner has raised an objection that the trademark is confusing with another trademark for only the goods in class 32, the applicant could send a request using the [MM22](#) form (Request for the division of an international registration) to divide out from the original Protocol application the goods in class 32 and add them in a new international registration designating Canada by way of a divisional Protocol application. The original Protocol application would then continue in the registration process for the goods in class 25.

Division of an international registration can only be requested for a Protocol application and will not be accepted for a Protocol registration. The examiner reviews the MM22 form as well as the contents of the divisional Protocol application and, if acceptable, forwards it to WIPO, who in turn reviews the form and if everything is in order, records the division in the International Register and forwards a notification of confirmation of division of the international registration to CIPO. The examiner will then record the division in the database and a notification will be sent to the applicant.

While CIPO does not charge a fee for the division of a Protocol application, WIPO charges a fee of 177 Swiss francs (CHF) for recording the division in the International Register. If the fee is not paid, an irregularity will be issued by WIPO.

Merger of IR

Mergers can only be requested using the MM24 form (Request for the merger of international registrations resulting from the recording of division) and only once the trademark is registered in Canada. It is only possible to merge registrations that were divided from the same Protocol application. Neither CIPO or WIPO charge a fee to request a merger.

The examiner reviews the request to merge and, if acceptable, forwards it to WIPO who in turn reviews the form and if everything is in order, records the merger in the International Register and forward a notification of confirmation of merger of the international registration to CIPO.

If the confirmation of merger is received for a Protocol Registration, the examiner will record the merger in the Canadian trademarks register.

Opposition

Approved Protocol applications that are advertised on the CIPO website by way of the *Trademarks Journal* may be opposed by third parties. Please visit the Trademark's Opposition Board's [website](#) to learn about their role and activities and obtain more information about the opposition proceedings as well as the section 45 proceedings.

Registration

If no opposition is filed against the Protocol application or if an opposition is decided in favour of the application, it is registered. Once registered, it becomes a Protocol registration and CIPO will issue a Statement of Grant of Protection as well as a registration certificate.

Statement of Grant of Protection

CIPO will issue a Statement of Grant of Protection to WIPO informing WIPO that the Protocol application is now registered in Canada (it is now a Protocol registration). A certificate of registration is also issued and is annexed to the Statement of Grant of Protection, a copy of which is mailed to the owner of the Protocol registration or to their Canadian trademark agent if one has been appointed.

CIPO can send two different types of notifications when sending a Statement of Grant of Protection. The first one is referred to as a "Final Disposition on Status of a Mark – Statement of Total Grant of Protection (Rule 18ter(1))" and is issued for a Protocol application that was not the subject of a total provisional refusal based on examination or opposition. The second one is referred to as a "Final Disposition on Status of a Mark – Statement of Total or Partial Grant of Protection Following a Provisional Refusal (Rule 18ter(2))" and is issued when all objections and requirements that were listed in the total provisional refusal have been overcome or have been met and the trademark is found to be registrable in Canada.

Notwithstanding that the international registration term is ten years, the first registration term in Canada may be for a shorter period of time since the registration period will be dependent on the term remaining of the international registration when the Protocol application is registered. By way of example, if the international registration date is August 11, 2015 and the Protocol registration date in Canada is August 11, 2020, the term of protection in Canada will be of five years until it is renewed. The next registration term will begin August 11, 2025 and will be for ten years.

Renewal

The owner of the international registration must send renewal requests and payment directly to WIPO using the WIPO [e-renewal service](#) or the WIPO [MM11](#) form (Renewal of the international registration). Once the international registration is renewed, WIPO notifies CIPO of the renewal of the designation to Canada with respect to some or all of the goods or services. These

notifications of renewal of the international registration can be received on Protocol applications or registrations.

Effect on Protocol Applications

In the case of subsequent designations, the international registration may be renewed before the Protocol application has matured to registration. If this is the case, the renewal of the international registration will be recorded in the database and the registration term will be dependent on that renewal date. A notification of renewal of the international registration will be sent to the applicant.

Effect on Protocol Registrations

The renewal date of the Protocol registration is dependent on the registration date of the international registration and is communicated to CIPO by WIPO.

CIPO does not issue renewal notices nor will it collect renewal fees for Protocol registrations. When the renewal of an international registration is for a Protocol registration, CIPO will record the renewal and send a renewal certificate to the applicant.

In the example in Figure 3 below, the first protection period following the registration of the Protocol application in Canada is of eight years. The following period will be of ten years and will be synchronized with the IR protection period.

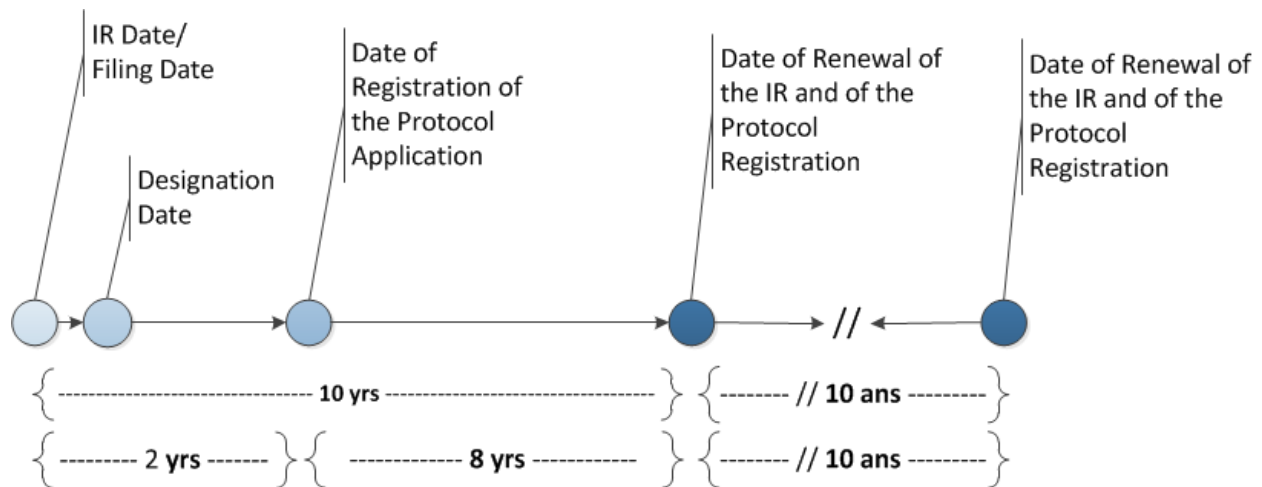


Figure 3

In Figure 4 below, the renewal of the international registration happens while the Protocol application is still undergoing examination. This means that the ten year protection period will be calculated from when the IR is renewed.

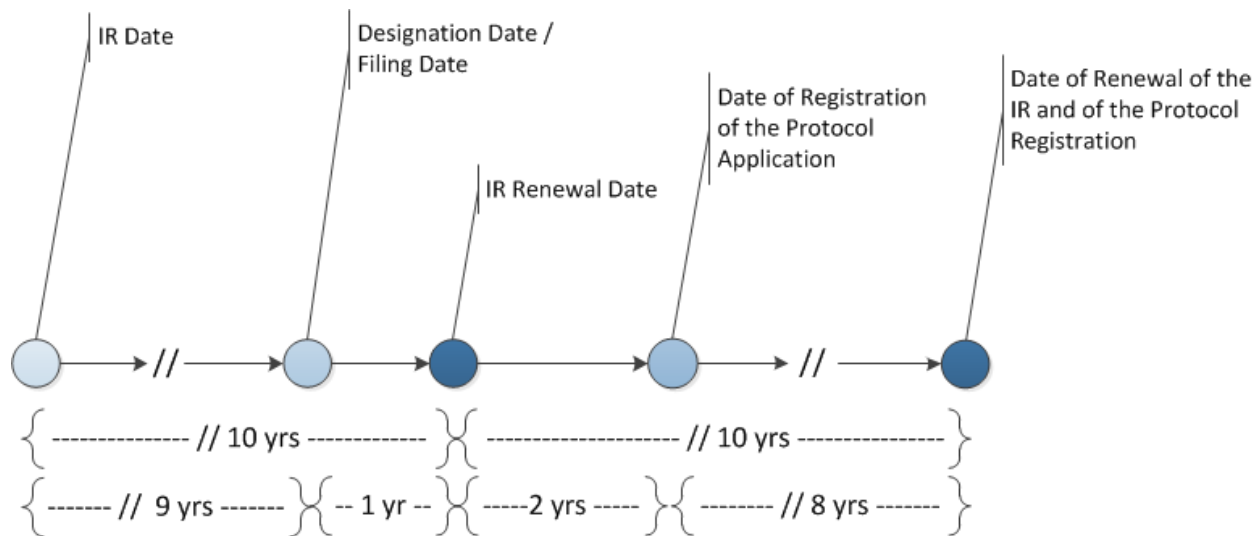


Figure 4

Notifications from WIPO

Any change made to the international registration will be communicated to CIPO by WIPO. This will be done by way of electronic notifications received on a weekly basis and may affect either Protocol applications or Protocol registrations.

Limitation

A limitation is a restriction of the list of goods or services in the IR for some or all of the designated contracting parties. It is a voluntary submission by the applicant [filed directly with WIPO using the “Request for the recording of a limitation of the list of goods and services” form \(MM6\)](#) and paying the required WIPO fee. WIPO will review and record the limitation in the International Register. WIPO will then forward the notification of Limitation to all of the affected designated contracting parties. When CIPO receives a limitation notification electronically from WIPO, it will be reviewed by the examiner and will affect Protocol applications or registrations in the following way:

Effect on Protocol applications:

When WIPO notifies the Registrar of the recording of a limitation of the list of goods or services, in respect of Canada, of an IR on which a Protocol application is based, and the recording results in a deletion of all goods or services from that list without giving rise to a new list, the Protocol application is deemed to be withdrawn as of the date of the limitation as recorded in the International Register.

If the recording results in a deletion of all goods or services from the list of a particular Nice Classification without giving rise to a new list for that particular class of the Nice Classification, the Protocol application is deemed amended accordingly as of the date of the limitation as recorded in the International Register.

When the recording results in a deletion of one or more of the goods or services from a list of a particular class of the Nice Classification and gives rise to a resulting new list for that particular

class of the Nice Classification, the Registrar must determine, with respect to each good or service whether the following requirements are met:

- The good or service is within the scope of the Protocol application on its filing date (not taking into account priority claim) and on the date of the recording in the International Register;
- The good or service is within the scope of the Protocol application as advertised, if the date of the recording in the International Register is on or after the day on which the Protocol application is advertised;
- The good or service is within the scope of the Protocol application as amended, if the Protocol application is amended on or after the day on which the Protocol application is advertised and if the date of the recording in the International Register is on or after the date of the amendment;
- The good or service is described in ordinary commercial terms and in a manner that identifies a specific good or service.

If the Registrar determines that the above requirements are met for all of the goods or services in the resulting list for a particular class, the Protocol application is deemed amended accordingly. If, however, the Registrar determines that the requirements above are not met for any good or service for a particular class, the Registrar must, in accordance with Rule 27(5) of the Common Regulations, send to WIPO a declaration that the limitation has no effect in Canada in respect of all of the goods and services in that class.

Effect on Protocol registrations:

When WIPO notifies the Registrar of the recording of a limitation of the list of goods or services, in respect of Canada, of an IR on which a Protocol registration is based, and the recording results in a deletion of all goods or services from that list without giving rise to a new list, the Registrar must cancel the Protocol registration effective on the date of the limitation as recorded in the International Register.

If the recording results in a deletion of all goods or services from that list of a particular Nice Classification without giving rise to a new list for that particular class of the Nice Classification, the Registrar must amend the register accordingly, effective as of the date of the limitation as recorded in the International Register.

When the recording results in a deletion of one or more of the goods or services from a list of a particular class of the Nice Classification and gives rise to a resulting new list for that particular class of the Nice Classification, the Registrar must determine, with respect to each good or service whether the following requirements are met:

- The good or service is within the scope of the Protocol registration on the date of recording in the International Register;
- The good or service is described in ordinary commercial terms and in a manner that identifies a specific good or service.

If the Registrar determines that the above requirements are met for all of the goods or services in the resulting list for a particular class, the Registrar must amend the register accordingly. If, however, the Registrar determines that the requirements above are not met for any good or service for a particular class, the Registrar must, in accordance with Rule 27(5) of the Common Regulations, send to WIPO a declaration that the limitation has no effect in Canada in respect of all of the goods and services in that class.

Renunciation

A renunciation is the removal of all of the goods or services from the IR for some of the contracting parties and must be filed directly with WIPO using form MM7 and paying the prescribed WIPO fee. A renunciation is used when the owner wishes to abandon the effects of the IR for all the goods and services in respect of some (but not all) of the designated Contracting Parties.

The goods and services will remain in the main list of the IR, but the mark will have no effect nor enjoy protection for the goods and services concerned in the designated Contracting Parties which are the subject of the renunciation.

Effect on a Protocol Application

If the Registrar is notified of a renunciation in respect of Canada for all of the goods or services that are listed in the IR, the Protocol application is deemed withdrawn as of the date of the renunciation as recorded in the International Register

Effect on a Protocol Registration

If the Registrar is notified of a renunciation in respect of Canada of all the goods or services that are listed in the IR, the Registrar must cancel the Protocol registration effective as of the date of the renunciation as recorded in the International Register.

Complete Cancellation of the IR

A cancellation is the result of a voluntary removal of some or all goods or services in respect of all of the designated contracting parties for a particular IR.

Effect on a Protocol Application

When the Registrar receives from WIPO a notification of the recording in the International Register of a cancellation of the IR for all of the goods or services that are listed in the IR, the Protocol application is deemed withdrawn as of the date of the recording of the cancellation in the International Register.

Effect on Protocol Registration

When the Registrar receives from WIPO a notification of the recording in the International Register of a cancellation of the IR for all of the goods or services that are listed in the IR, the Registrar must cancel the Protocol registration effective from the date the cancellation is recorded in the International Register.

Partial Cancellation of the IR

The notification of cancellation of the IR may be partial and concern at least one but not all of the goods or services listed in the IR.

Effect on a Protocol Application

If the cancellation is partial, the Protocol application is either withdrawn or amended accordingly.

Effect on a Protocol Registration

If the cancellation is partial, the Registrar must cancel the Protocol registration or amend the register accordingly.

Complete Cancellation due to Ceasing of effect of the Basic Application or Registration

Ceasing of effect happens when the Office of Origin cancels the basic application or registration within five (5) years from the IR date or following a proceeding that began within that five (5) year period.

WIPO notifies CIPO of a cancellation (as described above) of part or all of the goods or services in the IR which results in the removal of those goods or services from the Protocol application or registration.

The difference here is that it is flagged as a ceasing of effect meaning that the goods or services were not removed at the request of the applicant but rather due to a procedure involving the basic application or registration in the Office of Origin. This means that the goods or services that were removed from the Protocol application or Registration are eligible to be included in a transformation application (will be explained later in this guide).

Effect on a Protocol Application

For a complete cancellation due to ceasing of effect, the Protocol application is deemed withdrawn as of the date of the recording of the cancellation in the International Register.

Effect on a Protocol Registration

For a complete cancellation due to ceasing of effect, the Registrar must cancel the Protocol registration effective from the date the cancellation is recorded in the International Register.

Partial Cancellation due to Ceasing of effect of the Basic Application or Registration

The notification of cancellation of the IR due to ceasing of effect of the basic application or registration may be partial and concern at least one but not all of the goods or services listed in the IR.

Effect on a Protocol Application

For a partial cancellation due to ceasing of effect, the Protocol application is either withdrawn or amended accordingly.

Effect on a Protocol Registration

For a partial cancellation due to ceasing of effect, the Registrar must cancel the Protocol registration or amend the register accordingly.

Change of Name/Address of the Holder of the IR

The holder of the IR may wish to record a change of name or address which must be communicated to all of the designated contracting parties listed for the IR. This is done directly with WIPO using form MM5 and paying the prescribed WIPO fee.

When WIPO notifies CIPO of a change in the owner's name or address for a particular IR, CIPO will record the new owner's name/address in the Trademarks Database/Register

The effect on a Protocol Application and Registration is that the owner's name/address is updated. CIPO will not re-issue any office action. It is the responsibility of the applicant/registered owner to ensure a proper response is filed in time to any outstanding office actions.

Renewal or Non-Renewal of IR

All renewals have to be requested [directly to WIPO using either the e-service or the form available on the WIPO website](#). All Renewal fees also have to be paid directly to the WIPO. After renewal of the IR with WIPO, a notification of renewal will be sent to CIPO informing of the renewal of the designation of Canada for the particular IR.

Effect on a Protocol Application

If the notification of renewal is received on a Protocol application, CIPO will issue a notice of renewal to be sent to the applicant

Effect on a Protocol Registration

If the notification of renewal is received on a Protocol registration, CIPO will issue a renewal certificate which will be sent to the registered owner.

If the owner fails to renew the IR, WIPO will inform CIPO of the non-renewal which will result in the withdrawal of the Protocol application or an expungement for failure to renew of a Protocol registration

Corrections to the International Register

Corrections can happen at any time and for anything from a typo in the address to an incorrect trademark and can have minor or major effects on the Protocol applications or registrations. To handle corrections, the regulations have been drafted in a way that describes the effect on one or the other.

As a general rule, if WIPO notifies the Registrar of a correction of an IR affecting a Protocol application, the Protocol application is deemed amended accordingly effective on the day on which the error was made that gave rise to the correction of the IR.

On occasion, WIPO will need to make corrections to the International Register. When notified of a correction, the Registrar will modify the Protocol applications and registrations accordingly.

Effect on a Protocol Application

If the correction is not substantive, the Registrar will make the correction to the Protocol application.

If the correction is substantive and the Protocol application is not advertised, the Registrar will issue a Total Provisional Refusal informing WIPO (and applicant) of the grounds. The applicant will have the opportunity to respond within the same six (6) month deadline as usual in examination. It will essentially be the same process as any Total Provisional Refusal in examination but this Total Provisional Refusal following a correction notification may be issued after the original eighteen (18) month deadline; however it must be issued within eighteen (18) months from the date of the notification of correction.

If the Protocol application has already been advertised and the correction is substantive and affects all of the goods or services, the registrar will issue a Total Provisional Refusal informing WIPO (and applicant) of the grounds.

If the Protocol application has already been advertised and the correction is substantive but affects only some of the goods or services, the applicant will be invited, by correspondence from the Registrar, to either delete the goods or services affected by the correction and continue in the process or to choose that the Protocol application is deemed to never have been advertised and be examined as corrected (with the potential issuance of a Total Provisional Refusal informing WIPO (and applicant) of the grounds within eighteen (18) months from the date of notification of correction).

The applicant will have two (2) months to inform the Registrar of the decision.

If no response is received, the goods or services will be deleted from the Protocol application and the process will continue.

Effect on a Protocol Registration

If CIPO receives a correction notification from WIPO on a Protocol registration, and the Registrar considers that protection can continue to be granted to the IR as corrected, the Registrar will make the correction to the Protocol registration (amend the register).

If the Registrar considers that protection can no longer be granted to the IR as corrected, the Registrar will issue a Total or Partial Provisional Refusal (depending on whether the correction affects all or some of the goods or services) informing WIPO (and registered owner) of the grounds.

Following the owner's response, if the Registrar determines that protection can continue to be granted to the IR as corrected, the Registrar will make the correction to the Protocol registration (amend the register). If the Registrar determines that protection can no longer be granted to the IR as corrected, the Registrar either amends the Protocol registration (amends the register) and notifies WIPO of the resulting list of goods or services in the Protocol registration or cancels the Protocol registration and notifies WIPO of the Confirmation of Total Provisional Refusal for the Protocol registration.

Change in ownership (Transfers/Mergers)

WIPO notifies CIPO of any change in ownership for a particular IR.

A change in ownership may be partial and usually involves the addition of a letter to the IR number.

Effect on a Protocol Application

For a partial change in ownership, CIPO will create new Protocol application “file” with the new owner information and associated goods or services, all of the actions and documentation is copied over to the new “file”, the filing date is deemed to be the same and if anything is outstanding, existing deadlines continue to apply unless any issues happen to be resolved with change in ownership for those specific goods or services.

Effect on a Protocol Registration

For a partial change in ownership, CIPO will create a new Protocol registration “file” with the new owner information and associated goods or services, the registration date will be deemed to be the same and all of the actions and documentation is copied over; if anything is outstanding, existing deadlines continue to apply unless any issues happen to be resolved with the change in ownership for those specific goods or services.

Irregularity notifications from WIPO

As a Designated Contracting Party, the Registrar may receive an Irregularity Notification from WIPO if the information sent to them is not considered acceptable.

For example:

- Incorrect form was used
- Correct form was used but information is missing or not in the correct field
- Deadline has expired for particular transaction

For the irregularities that require a response, the Registrar will be required to send it to WIPO within two (2) months of the notification.

Recording license agreements

Canada has made a declaration under Rule 20bis(6)(b) of the Common Regulations which means that, when notified by WIPO of the recording of a license agreement in the international Register, the recording of said license has no effect in Canada and will not be recorded in the Canadian trademarks register. CIPO will only record license agreements in the Canadian trademarks register if the registered owner makes the request directly with CIPO.

Transformation

The transformation process is essentially converting a Protocol application or registration into a national application or registration. WIPO may cancel an IR in whole or in part at the request of the Office of Origin by way of cancellation due to ceasing of effect (described earlier). The cancelled goods or services can be included in a transformation application. The resulting national application or registration benefits from all of the steps that were taken in relation to the Protocol application or Protocol registration. The owner must file the request for transformation

directly with the Registrar, by electronic means, within three months after the cancellation is recorded on the International Register. There is no fee to file a transformation application.

Following the transformation of a Protocol application, the resulting application is subject to the same deadlines to respond, anything outstanding must be responded to within the original deadlines or the application resulting from the transformation will be considered in default of prosecution or abandoned.

Replacement

Under the Madrid System (Article 4bis of the Madrid Protocol), a trademark that is the subject of a national registration in the Office of a Contracting Party is, under certain conditions, deemed to be replaced by an IR of the same trademark. This is known as a “replacement” and trademark owners may request that the Registrar take note of this replacement in the Canadian Trademarks Database/Register.

If the owner of a Protocol registration already owns an existing Canadian trademark registration for the same trademark in association with some or all of the goods or services listed in the Protocol registration, the Protocol registration automatically benefits from the earlier priority or filing date for the relevant goods or services. The owner may eventually decide not to renew their Canadian trademark registration and only maintain their Protocol registration; however, it is very important to note that even in the case of replacement, the Canadian trademark registration will not be renewed automatically even though the Protocol registration has been renewed.

Requesting corrections to WIPO

Should an error be noticed in the information recorded on the International Register, CIPO may request that WIPO correct the information. Any such request by the Registrar to correct an error affecting the rights of an IR on the International Register must be received by WIPO within nine months from the date of publication of the erroneous entry in the International Register.

This time limit does not apply to errors made by WIPO while recording/uploading the data in the International Register as it is considered that WIPO was always in possession of the correct information.

The nine (9) month time limit also does not apply to non-substantive errors like a correction to the name or address of the owner or obvious mistakes (typographical errors) in the list of goods and services.

Managing an IR

Other than the 5 year dependency period mentioned previously, the IR is independent from the basic application or registration with respect to ownership changes, renewal, etc.

WIPO offers a variety of Madrid forms (MM forms) on their website which must be used for all amendments or any change to be made to the IR including subsequent designations. Generally, all these forms must be submitted directly to WIPO and not to CIPO (except the previously mentioned Change in Ownership (MM5 form) where the Registrar may certify an ownership change request).

Requests for renewal and subsequent designation must be sent using the WIPO online services. CIPO will not be able to process those requests. Payment of fees for these services must be made directly with WIPO which offers a deposit account service. For more information regarding this, please consult the WIPO website.

The Madrid System requires the payment of fees for all services requested which are payable directly to WIPO and must be paid in Swiss Francs (CHF) currency. More information regarding fees is available on the WIPO website.

It is important to note that all amendments made to an IR have a potential effect on the application or registration in each of the designated contracting parties in that IR. For example, if you amend the IR's owner name or address, all of the designated contracting parties will be notified of this change.