

# Trademarks Examination Manual

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Trademarks Examination Manual.....	1
1 Introduction.....	12
1.1 General information.....	12
2 Examination of applications as to form.....	12
2.1 Pre-examination.....	12
2.2 Request for expedited examination.....	12
2.3 Requirements for application – subsection 30(1).....	13
2.4 Contents of application – subsection 30(2).....	13
2.4.1 Identity of the applicant.....	13
2.4.1.1 Individuals.....	14
2.4.1.2 Partnerships.....	14
2.4.1.3 Associations.....	14
2.4.1.4 Joint ventures.....	14
2.4.1.5 Corporations.....	14
2.4.1.6 Use of French or English form of corporate name.....	15
2.4.1.7 Correcting the identification of an applicant.....	15
2.4.2 Postal address of the applicant.....	15
2.4.3 Representation or description of the trademark.....	16
2.4.3.1 Multiple views – paragraph 30(a) of the Regulations.....	16
2.4.3.2 Size of visual representation – paragraph 30(b) of the Regulations.....	16
2.4.3.3 Three-dimensional shape – paragraph 30(c) of the Regulations.....	16
2.4.3.4 Visual representations in colour – paragraph 30(d) of the Regulations.....	16
2.4.3.5 Visual representations in B&W – paragraph 30(e) of the Regulations.....	17
2.4.3.6 Sound recording – paragraph 30(f) of the Regulations.....	17
2.4.3.7 Clear and concise description – paragraph 30(g) of the Regulations.....	17
2.4.3.8 Colour description – paragraph 31(f) of the Regulations.....	17
2.4.3.8.1 Name of the colour.....	17
2.4.3.8.2 Colour identification system.....	17
2.4.3.8.3 Principal parts.....	18

2.4.3.8.4 Gradations .....	18
2.4.4 Statements of trademark type.....	18
2.4.5 Ordinary commercial terms for specific goods or services – paragraph 30(2)(a) of the Act and section 29 of the Regulations.....	19
2.4.5.1 Ordinary commercial terms .....	20
2.4.5.2 Specific goods or services.....	20
2.4.5.3 Context of the goods and services .....	21
2.4.5.4 “and the like”, “and similar goods”, “including”, “related to”, “related services”, “etc.”, and “featuring”.....	21
2.4.5.5 “namely”, “consisting of” or “specifically” .....	22
2.4.5.6 “in the nature of”, “such as”, “comprising”, “containing”, “in particular” or “particularly” .....	22
2.4.5.7 “accessories”, “equipment”, “apparatus”, “systems” and “products” .....	22
2.4.5.8 Parts and fittings .....	23
2.4.5.9 Devices.....	23
2.4.5.10 Computer software and computer programs.....	23
2.4.5.11 Discs and other blank or pre-recorded media .....	24
2.4.5.12 Pharmaceutical, veterinary, botanical, nutraceutical, homeopathic, medicinal and medicated preparations, remedies, supplements, extracts, functional foods and enhanced water	24
2.4.5.13 Intangibles.....	25
2.4.5.14 Advertising, promotion and marketing – benefit to a third party .....	25
2.4.5.15 Services related to the electronic transmission of data .....	25
2.4.5.16 Telecommunication-related services .....	26
2.4.6 Signature of applicant .....	26
2.4.7 Nice Classification – Subsection 30(3) of the Trademarks Act.....	26
2.4.7.1 Versions and editions.....	27
2.4.7.1.1 Effect of new edition on applications .....	27
2.4.7.1.2 Edition applicable to amendments to group the goods or services of registrations...	27
2.4.7.2 Grouping goods and services according to the Nice Classification.....	27
2.4.7.2.1 Material composition .....	28
2.4.7.2.2 Reference to other classes .....	29
2.4.7.2.3 Class and context .....	29

2.4.7.2.4 Kits, gift baskets and goods sold as a unit .....	29
2.4.8 Priority – Section 34 of the Trademarks Act .....	30
2.4.8.1 Application requirements .....	30
2.4.8.2 Withdrawing a priority request .....	31
2.4.8.3 Dies Non .....	31
2.4.8.4 Force Majeure .....	32
2.4.9 Standard characters – Section 31 of the Trademarks Act .....	33
2.4.10 Non-traditional trademarks .....	33
2.4.10.1 Sound .....	34
2.4.10.2 Hologram .....	34
2.4.10.3 Moving image (motion) .....	35
2.4.10.4 Scent.....	35
2.4.10.5 Taste.....	35
2.4.10.6 Colour per se.....	36
2.4.10.7 A three-dimensional shape.....	36
2.4.10.8 Mode of packaging goods.....	36
2.4.10.9 Texture .....	37
2.4.10.10 Positioning of a sign.....	37
2.4.10.11 Combinations .....	38
2.4.10.12 Acceptable formats of electronic files .....	38
2.5 Certification marks — Sections 23, 24 and 25 and Paragraph 30(2)(b) of the <i>Act</i> .....	38
2.5.1 Definition of Certification Mark .....	39
2.5.2 Owner not engaged .....	39
2.5.3 Example of certification mark .....	39
2.5.4 Descriptive of place of origin — Section 25 .....	39
2.5.5 Defined standard .....	40
2.5.6 Amending Applications to and from Certification Marks .....	40
2.6 Applications to extend the statement of goods or services – paragraph 41(1)(c) and subsection 41(2) of the Act.....	41
2.6.1 Conversion to an ordinary trademark application.....	41
2.6.2 Affidavit of continuous use.....	41

2.7 Divisional applications.....	42
2.7.1 Definitions.....	42
2.7.2 Why divide an application? .....	42
2.7.3 Filing a divisional application prior to advertisement .....	42
2.7.4 Steps deemed to have been taken.....	43
2.7.5 Filing a divisional application after advertisement.....	43
2.7.6 Applications filed prior to June 17, 2019.....	43
2.7.7 Mergers .....	44
2.7.8 Dividing an application to extend the statement of goods or services.....	44
2.7.9 Pending assignment .....	44
2.8 Amendments to an application.....	44
2.8.1 Changing the identity of the applicant.....	44
2.8.2 Changing the representation or description of the trademark.....	45
2.8.3 Amendments to goods or services .....	45
2.8.4 Adding a divisional application indication .....	45
2.8.5 Adding or deleting certain statements.....	46
2.8.6 Amending an application to/from a certification mark.....	46
3 Search / Confusion.....	47
3.1 Purpose of the search .....	47
3.2 Definition of confusion — subsection 6(2) .....	48
3.2.1 Surrounding circumstances – subsection 6(5) .....	49
3.2.1.1 Paragraph 6(5)(a) — Inherent distinctiveness and extent to which trademark has become known.....	50
3.2.1.1.1. Inherent distinctiveness.....	50
3.2.1.1.2. Extent to which a trademark has become known.....	51
3.2.1.2 Paragraph 6(5)(b) – Length of time used.....	51
3.2.1.3 Paragraph 6(5)(c) – Nature of goods or services .....	52
3.2.1.4 Paragraph 6(5)(d) – Nature of the trade.....	52
3.2.1.5 Paragraph 6(5)(e) – Degree of resemblance between the trademarks .....	52
3.3 Test of confusion.....	54
3.3.1 The relevant consumer.....	54

3.3.2 First impression and imperfect recollection.....	55
3.3.3 Likelihood vs. possibility.....	55
3.3.4 Both official languages .....	55
3.3.5 Trademarks in their totality.....	55
3.3.6 Evidence in the Form of a Letter of Consent Supporting No Likelihood of Confusion.....	56
3.3.7 Doubt as to confusion .....	56
3.4 Searching.....	57
3.5 Discovering a confusing trademark .....	57
3.5.1 Confusion with a registered trademark – Paragraph 12(1)(d) .....	57
3.5.2 Confusion with a co-pending application .....	57
3.5.2.1 Persons entitled to registration.....	57
3.5.2.2 Notification of applicants.....	58
3.5.2.3 Identical entitlement dates .....	58
3.5.2.4 Active applications.....	58
3.5.3 Same owner – Section 15.....	58
3.5.4 Confusion with a certification mark .....	59
3.5.5 Confusion with a Newfoundland registration .....	59
4 Examination of the trademark.....	60
4.1 Purpose of examination.....	60
4.2 Definition of trademark.....	60
4.3 Paragraph 12(1)(a) – Names and surnames .....	60
4.3.1 Definition of “word” .....	61
4.3.2 Definition of name or surname .....	61
4.3.3 Merely a name or a surname .....	61
4.3.4 Meaning of “primarily” .....	62
4.3.5 Test to determine primary meaning .....	62
4.3.6 Given name and surname .....	64
4.3.7 Surnames with “& Sons”, “Brothers”, “Inc.”, “Co.”, etc. ....	65
4.3.8 Compound surnames.....	65
4.3.9 Surnames that include accents or other characters .....	65
4.3.10 Reference sources – paragraph 12(1)(a) .....	65

4.3.11 Historical significance .....	66
4.3.12 Font embellishments .....	66
4.4 Paragraph 12(1)(b) – Clearly descriptive or deceptively Misdescriptive .....	66
4.4.1 Introduction.....	67
4.4.2 Examination under paragraph 12(1)(b).....	67
4.4.3 Test for clearly descriptive.....	67
4.4.3.1 First impression.....	68
4.4.3.2 In association with the goods or services.....	69
4.4.4 Depicted, written or sounded .....	70
4.4.5 Misdescriptiveness .....	70
4.4.6 Deceptively misdescriptive .....	71
4.4.7 In the English or French language .....	71
4.4.8 Character or quality.....	72
4.4.9 Embellishment of clearly descriptive words .....	72
4.4.10 “Sounded” test applied to composite trademarks .....	73
4.4.10.1 Determination of Whether Words are the Dominant Feature of a Combination Trademark .....	74
4.4.11 Trademarks which merely suggest character/quality.....	75
4.4.12 Conditions of production .....	75
4.4.13 Persons employed in the production .....	75
4.4.13.1 Professional designation .....	76
4.4.14 Place of origin .....	76
4.4.14.1. Geographic name .....	77
4.4.14.2. Origin of goods or services .....	77
4.4.14.3. Deceptively misdescriptive of the place of origin .....	78
4.4.14.4. Character of goods or services .....	78
4.4.14.5. Place of origin and top level domains (TLDs).....	79
4.4.15 Pharmaceuticals .....	79
4.4.16 Abbreviations, acronyms or initials .....	79
4.4.17 Top level domains (TLDs).....	79
4.4.18 Hashtag (#).....	80

4.5 Paragraph 12(1)(c) – Name of goods or services.....	80
4.6 Paragraph 12(1)(d) – Confusion .....	81
4.7 Paragraph 12(1)(e) – Prohibited marks.....	81
4.7.1 Paragraphs 9(1)(a), (b) and (c).....	81
4.7.2 Paragraph 9(1)(d).....	82
4.7.3 Paragraph 9(1)(e) .....	82
4.7.4 Paragraphs 9(1)(f), (g), (g.1) and (h) .....	83
4.7.4.1 Paragraph 9(1)(h.1).....	84
4.7.5 Paragraphs 9(1)(i) and 9(1)(i.1) .....	84
4.7.5.1 Paragraph 9(1)(i.2).....	84
4.7.5.2 Paragraph 9(1)(i.3).....	84
4.7.6 Paragraph 9(1)(j).....	84
4.7.7 Paragraph 9(1)(k).....	85
4.7.7.1 Falsely suggest a connection.....	86
4.7.7.2 Significant public reputation.....	86
4.7.7.3 Musical bands .....	87
4.7.7.4 Consent .....	87
4.7.8 Paragraph 9(1)(l).....	87
4.7.9 Paragraph 9(1)(m).....	88
4.7.10 Paragraph 9(1)(n).....	88
4.7.10.1. Paragraph 9(1)(n.1) .....	89
4.7.11 Paragraph 9(1)(o).....	89
4.7.12 Section 10.....	89
4.7.13 Sections 9 and 10 – Informing the applicant .....	90
4.7.14 Paragraph 9(2)(a) – Consent .....	90
4.7.14.1 Paragraph 9(2)(b).....	90
4.7.15 Paragraph 12(1)(f) and section 10.1 – Plant variety denominations.....	91
4.7.16 Paragraphs 12(1)(g), (h) and (h.1) – Protected geographical indications for wines, spirits or agricultural products and food .....	91
4.7.17 Paragraph 12(1)(i) — Olympic and Paralympic Marks Act.....	91
4.8 Subsection 12(2) – Functionality .....	92

4.8.1 Purpose.....	92
4.8.2 Examples.....	93
4.8.2.1 A three-dimensional shape.....	93
4.8.2.2 Colour .....	94
4.8.2.3 Sound .....	94
4.8.2.4 Taste.....	94
4.8.2.5 Scent.....	94
4.9 Paragraph 32(1)(b) – Not Inherently Distinctive .....	94
4.9.1 General.....	94
4.9.2 Distinctiveness .....	95
4.9.3 Inherently distinctive .....	95
4.9.4 Examination .....	96
4.9.5 Examples.....	96
4.9.5.1 Geographic locations .....	97
4.9.5.2 Generic designs.....	97
4.9.5.3 Names of colours .....	97
4.9.5.4 One- and two-letter or -number trademarks.....	97
4.9.5.5 English and French .....	98
4.9.5.6 Foreign characters and words .....	98
4.9.5.7 Multiple surnames.....	98
4.9.5.8 Names and honorifics .....	98
4.9.5.9 Laudatory words and phrases.....	98
4.9.5.10 Provides generic information.....	99
4.9.5.11 Combinations of unregistrable elements.....	99
4.9.5.12 Paragraphs 12(1)(a), or (b) of the Act.....	99
4.9.5.13 Possessive determiners.....	100
4.9.5.14 Internet TLDs, and URLs .....	100
4.9.5.15 Phone numbers.....	100
4.9.5.16 Forms of business association.....	100
4.9.5.17 Colour(s) applied to the surface of a three-dimensional object .....	100
4.9.6 Overcoming an objection raised under paragraphs 37(1)(d)/32(1)(b).....	101

4.10 Subsection 32(1) – Evidence of Distinctiveness.....	101
4.10.1 General.....	101
4.10.2 Form of Evidence.....	102
4.10.2.1 Master affidavits .....	102
4.10.2.2 Additional affidavits .....	103
4.10.2.3 Survey evidence .....	103
4.10.2.4 Restriction as to territory .....	104
4.10.2.5 Voluntary restrictions as to territory .....	104
4.10.3 Determining acquired distinctiveness .....	104
4.11 Disclaimers – Section 35 .....	105
5 Examination of Official Marks .....	106
5.1 Public authority – Official marks.....	106
5.1.1 Obligation to evaluate public authority status in Canada .....	106
5.1.2 Test to determine public authority status .....	106
5.1.2.1 Governmental control .....	107
5.1.2.2 Public benefit .....	108
5.1.3 Evidence of adoption and use of an official mark .....	108
6 Examiners' reports.....	109
6.1 Subsection 37(2) – Notification of objections .....	109
6.2 First reports .....	109
6.2.1 Goods or services.....	110
6.2.1.1 Nice Classification .....	110
6.2.2 Paragraph 12(1)(a) .....	110
6.2.3 Paragraph 12(1)(b).....	110
6.2.4 Paragraph 12(1)(c) .....	111
6.2.5 Paragraph 12(1)(d).....	111
6.2.6 Paragraph 12(1)(e) .....	111
6.2.7 Paragraph 12(1)(f).....	111
6.2.8 Paragraphs 12(1)(g), (h) and (h.1) .....	111
6.2.9 Dates of entitlement.....	111
6.3 Second or maintaining actions .....	112

6.4 Subsequent actions.....	112
6.4.1 Evidence.....	112
6.4.2 Deletion of goods or services.....	113
6.4.3 Additional information.....	113
6.4.4 Clarification by examiners.....	113
6.4.5 Further entitlement objections after pre-publication search .....	113
6.4.6 Section 44 or 45 notices.....	113
6.4.7 Consent – confusing trademarks.....	113
6.5 Telephone amendments .....	114
6.5.1 Written confirmation not required .....	114
6.5.2 Written confirmation required .....	114
6.5.3 Standard Procedure for Telephone Amendments .....	115
6.6 Approval and advertisement .....	115
6.7 Default and abandonment .....	116
6.8 Extensions of time.....	116
6.8.1 To respond to an Examiners' report .....	116
6.8.2 Extensions of time to respond to a notice issued under section 44.1 of the Trademarks Act	118
6.8.3 Extensions of Time on Force Majeure.....	119
6.8.4 Fees for extension of time requests.....	120
6.9 Refusal .....	120
6.10 Notification of third-party rights.....	121
6.10.1 Background.....	121
6.10.2 Communication procedures .....	121
6.10.3 Appropriate grounds .....	122
6.10.4 Required information.....	122
6.10.5 Timing.....	122
6.10.6 Continued monitoring .....	122
7 Representation.....	122
7.1 Definition of trademark agent and associate trademark agent.....	123
7.2 Power to appoint .....	123
7.3 Persons authorized to act .....	123

7.3.1 Self-representation .....	123
7.3.2 Representation by a trademark agent .....	124
7.3.3 Status of trademark agents .....	124
8 Transitionals .....	124
8.1 Introduction to transitional provisions .....	124
8.2 Filing date not granted .....	125
8.3 Filing date granted .....	125
8.3.1 Bases for registration (claims) .....	126
8.3.2 Not inherently distinctive .....	126
8.3.3 Section 14 .....	126
8.3.4 Certification marks .....	126
8.3.5 Utilitarian function .....	127
8.3.6 Distinguishing guise .....	127
8.3.7 Nice classification .....	127
8.3.8 Associated marks .....	127
8.3.9 Standard character trademarks .....	127
8.3.10 Non-traditional trademarks .....	127
8.3.11 Fees .....	128
8.4 Advertised and Allowed .....	128
8.5 Registered .....	129

# 1 Introduction

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## 1.1 General information

The Trademarks Examination Manual (the “Manual”) is designed to serve the needs of trademark examiners as well as applicants and their agents. The Trademarks Office (“the Office”), a branch of the Canadian Intellectual Property Office (“CIPO”), is the official government body which receives and processes applications submitted by individuals and companies who wish to register their trademarks.

This Manual incorporates the interpretation of provisions of the Trademarks Act (the “Act”) and the Trademarks Regulations (the “Regulations”) by the Courts with the goal of providing consistent, high-quality decision-making by the Office.

It should be noted that the Manual is a reference guide only and is not binding on the Office; it is in no way intended to replace the Act or Regulations. In the case of any inconsistency between the Manual and the legislation, the Act and Regulations must be followed.

## 2 Examination of applications as to form

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### 2.1 Pre-examination

The processing of an application involves several different operational units of the Office. The majority of trademark applications are filed electronically and sent directly to the Formalities Section. The Incoming Correspondence Unit (the “ICU”) receives paper-based applications for initial processing and then forwards the application to the Finance and Administration Directorate which is responsible for receiving and processing fees.

After processing the filing fees, the ICU transfers the application to the Formalities Section which then assigns the application a number. The Formalities Section then grants the application a filing date if the application contains the filing requirements listed under subsection 33(1) of the Act.

The application is formalized and entered into the trademarks database. Receipt of the application is then acknowledged and sent to the applicant. The Formalities Section then transfers the application to the Examination Section where it is searched and examined.

### 2.2 Request for expedited examination

The Office has published two practice notices entitled [Requests for expedited examination](#) and [Requests for expedited examination in the context of the COVID-19 pandemic](#). The Registrar will accept requests for expedited examination in the form of an affidavit or statutory declaration, by a person having knowledge of the facts, setting out the specific circumstances and reasons for the request. The affidavit

or statutory declaration must clearly set out how the criteria outlined in the applicable practice notice has been met.

### **How to file a request**

Requests must include the name of the applicant and, if known, the application number (for further information, please refer to the practice notice [Identifying an application](#)). In compliance with subsection 4(1) of the Regulations, a request for expedited examination must not relate to more than one application for the registration of a trademark.

Requests must be submitted by mail or fax using the contact information outlined below.

Request for expedited examination  
c/o Deputy Director, Examination Division  
Trademarks Office  
Canadian Intellectual Property Office  
50 Victoria Street  
Gatineau, Quebec K1A 0C9  
fax: 819-953-2476

## **2.3 Requirements for application – subsection 30(1)**

Subsection 30(1) of the Act contains a pre-condition for filing an application for the registration of a trademark. Specifically, a person may file an application if they are using or propose to use, and are entitled to use, the trademark in Canada in association with those goods or services listed in the application. It is the responsibility of the applicant to ensure that use of the trademark in Canada does not contravene any other legislation.

## **2.4 Contents of application – subsection 30(2)**

After an application receives a filing date, examiners begin the initial examination to ensure that all the formal requirements of the application have been satisfied as set out in subsection 30(2) of the Act.

As part of the examination, examiners will also assess whether the goods or services have been properly grouped according to the classes of the [Nice Classification](#).

### **2.4.1 Identity of the applicant**

Paragraph 31(a) of the Regulations sets out that for the purposes of paragraph 30(2)(d) of the Act, an application must contain the name of the applicant.

In order to be entitled to registration of a trademark, an applicant must be a “person”. For the purposes of a trademark application, a “person” may be an individual, partnership, trade union, association, joint venture, or corporation. Furthermore, in accordance with section 2.1 of the Act, a person can include “two or more persons who, by agreement, do not have the right to use the trademark in Canada except on behalf of both or all of them.”

The Registrar will generally not require an applicant to confirm that it is a “person”; the onus rests ultimately with the applicant to ensure compliance with the Act.

#### ***2.4.1.1 Individuals***

When the applicant is an individual, he/she shall provide a surname and at least one given name. Any trading styles used can also be incorporated in the applicant's identification, but the applicant must not be identified by a trading style alone.

Example: “John Smith trading as Smith’s Deli”

Example: “Jane Miller, doing business as Jane’s Consulting Services”

#### ***2.4.1.2 Partnerships***

Trademark applications may be filed in the name of a partnership, which is considered a lawful association. Generally, a group of persons conducting a business as a partnership does so under a trading style.

Example: “Mary Jones and John Smith, a partnership, doing business as Jones Smith Enterprises”

The onus of determining whether a partnership is a legal entity rests with the applicant.

#### ***2.4.1.3 Associations***

Associations are membership organizations, with the primary focus of providing services and benefits to members of a specific group.

Example: “The Canadian Medical Association”

#### ***2.4.1.4 Joint ventures***

Trademark applications may be filed by two or more persons who are engaged jointly in commercial activities (a joint venture) which is another form of lawful association. The full names of the parties of the joint venture must be set out in the application, as well as any trading name, if applicable. Only the general partners in a joint venture need be named, not any limited partners.

Example: “ABC Inc. and XYZ Co., a joint venture doing business as Alpha Enterprises”

The Office does not require information establishing the degree of involvement of each party to the joint venture. Such information may be required, however, to disclose the procedure by which the trademark may be assigned or ownership resolved if the joint venture is dissolved. This requirement will be dictated by the facts in each case, and the documentation submitted at the time of transfer should deal with this question.

#### ***2.4.1.5 Corporations***

A corporation may be a private organization or a public authority (e.g., a municipal or provincial corporation or a provincial or federal statutory body). The application must contain the full name of the corporation. It is not a requirement to name the jurisdiction under whose laws it was incorporated.

Care must be taken to ensure that the corporation, and not an individual, is identified as the applicant. In the following examples, if the applicant is XYZ Ltd., all information preceding XYZ Ltd. is considered superfluous and must not be included when identifying the applicant:

- Jack Jones, President of XYZ Ltd.
- Jack Jones on behalf of XYZ Ltd.
- Jack Jones, attorney of XYZ Ltd.

Individuals who intend to incorporate at a later date must ensure that the application does not identify the applicant as the as-yet-uncreated corporation, as it is not considered to be a “person” under the Act.

Where a division or component of a corporation is engaged in commercial activity associated with the use of a trademark, examiners would accept the following:

- General Furniture Ltd., operating through its division Bowes Furniture Manufacturing Co.
- General Furniture Ltd., sometimes doing business as Bowes Furniture Manufacturing

In both cases, “General Furniture Ltd.” would be considered the applicant.

#### ***2.4.1.6 Use of French or English form of corporate name***

Subsection 10(3) of the *Canada Business Corporations Act* states that:

Subject to subsection 12(1), the name of a corporation may be set out in its articles in an English form, a French form, an English form and a French form, or a combined English and French form, so long as the combined form meets the prescribed criteria. The corporation may use and may be legally designated by any such form.

Therefore, an applicant whose name incorporates both a French and English version (e.g., Pamplemousse Inc./ Grapefruit Inc.) will be recognized as the same entity whether identified only as Pamplemousse Inc. or as Grapefruit Inc.

#### ***2.4.1.7 Correcting the identification of an applicant***

Please see section [2.8.1 Changing the identity of the applicant](#) of this Manual.

## **2.4.2 Postal address of the applicant**

Paragraph 31(a) of the Regulations sets out that for the purposes of paragraph 30(2)(d) of the Act, an application must contain the postal address of the applicant. A postal address is the address at which mail can be received, as distinct from the actual street or rural address.

The postal address must be a complete mailing address and must include the street name and number, where one exists, and the postal code, where applicable.

In Canada, a postal code is assigned by Canada Post as part of a complete postal address. Therefore, a Canadian postal address must include a postal code in order to comply with paragraph 31(a) of the Regulations.

In other countries where a postal code forms part of the postal address, the applicant must provide the postal code in order to comply with paragraph 31(a) of the Regulations.

An address for correspondence may also be provided if the applicant wishes to receive mail at a different address.

Where an applicant consists of two or more persons, only one address may be provided (see subsection 6(1) of the Regulations).

### **2.4.3 Representation or description of the trademark**

Also see section [2.4.10](#) of this Manual regarding the application requirements for non-traditional trademarks.

Paragraph 30(2)(c) of the Trademarks Act provides that an application is required to contain a representation or description, or both, that permits the trademark to be clearly defined.

The following subsections summarize the requirements prescribed for the purpose of paragraph 30(2)(c) of the Act.

#### ***2.4.3.1 Multiple views – paragraph 30(a) of the Regulations***

A visual representation may contain more than one view of the trademark but only if the multiple views are necessary for the trademark to be clearly defined. If an application contains a visual representation that contains views which are not, in the opinion of the examiner, required to clarify the trademark, the examiner will require the applicant to file a revised application which removes the extraneous views.

#### ***2.4.3.2 Size of visual representation – paragraph 30(b) of the Regulations***

Any two-dimensional visual representation provided in an application must not exceed 8cm x 8cm. For applications filed using the online system, visual representations will be reformatted automatically to fit this size requirement.

#### ***2.4.3.3 Three-dimensional shape – paragraph 30(c) of the Regulations***

If the trademark consists in whole or in part of a three-dimensional shape, any visual representation provided by the applicant must be a two-dimensional graphic or photographic representation. The Office will not accept, for example, a physical specimen of the trademark as meeting this requirement.

#### ***2.4.3.4 Visual representations in colour – paragraph 30(d) of the Regulations***

If colour is claimed as a feature of the trademark, or if the trademark consists exclusively of a single colour or a combination of colours without delineated contours, any visual representation provided by the applicant must be in colour. If an application includes a visual representation that is not in colour, but colour is claimed as a feature of the trademark, the examiner will require the applicant to file an

amended application which either 1) removes the colour claim or 2) has a visual representation that is in colour.

#### ***2.4.3.5 Visual representations in B&W – paragraph 30(e) of the Regulations***

If colour is not claimed as a feature of the trademark, or if the trademark does not consist exclusively of a single colour or a combination of colours without delineated contours, any visual representation must be in black and white. If an application includes a visual representation that is in colour, but does not include a colour claim, the examiner will require the applicant to file an amended application which either contains 1) a colour claim or 2) a visual representation that is in black and white.

#### ***2.4.3.6 Sound recording – paragraph 30(f) of the Regulations***

If the trademark consists in whole or in part of a sound, a representation must include a recording of the sound in the form of an MP3 file, the size of which may not be larger than 10MB. Applications filed by paper may provide electronic files of sounds on a CD, DVD, or USB stick.

#### ***2.4.3.7 Clear and concise description – paragraph 30(g) of the Regulations***

Any description of the trademark provided by the applicant must be clear and concise. If, in the opinion of the examiner, the description of the trademark is vague or contains extraneous information which does not permit the trademark to be clearly defined, the examiner will require the applicant to file an amended application which includes an acceptable description.

#### ***2.4.3.8 Colour description – paragraph 31(f) of the Regulations***

Also see the practice notice entitled “Describing Colour”.

Paragraph 31(f) of the Regulations requires applications that claim colour as a feature of the trademark to name each colour and indicate the principal parts of the trademark that are in that colour. Similarly, paragraph 31(g) of the Regulations specifies that if a trademark consists exclusively of a single colour or a combination of colours without delineated contours, the application must contain the name of each colour.

##### ***2.4.3.8.1 Name of the colour***

Where an application is required to provide the name of a particular colour, its generic name should be used. For example, “blue,” “red,” “magenta,” “teal,” and “mauve” are acceptable generic colour names. Additionally, colour names which incorporate adjectives to add specificity, such as “greyish-green,” “medium orange,” or “purplish-blue,” are also acceptable.

Examiners will generally not question how colours are described unless there is a discrepancy between the appearance of the colour shown in the visual representation and the written description.

##### ***2.4.3.8.2 Colour identification system***

In order to more accurately describe a colour, an applicant may reference a colour identification system. Should the name of the colour identification system be the subject of a registered trademark, the name of

the system must be set out in uppercase letters and the description must include the statement that the name of the system is a registered trademark. The following would be an example of an acceptable colour claim:

Colour is claimed as a feature of the trademark. The letter “A” in the trademark is the colour light blue (PANTONE\* 317C). \*PANTONE is a registered trademark.

Reference to a colour system alone (i.e. PANTONE\* 32C) is not acceptable since the colour claim in the application must always include the name of the colour(s). While the Office does not endorse or recommend any one colour identification system, any system referenced should be readily accessible and understandable by the general public.

#### *2.4.3.8.3 Principal parts*

Applications which claim colour(s) as a feature of the trademark must provide an indication, by way of written description, of the principal parts of the trademark that are in each colour. What constitutes the “principal parts” of a particular trademark will depend on the complexity of the trademark. However, in general, the application need only describe the readily-identifiable elements of a trademark that appear in each colour. For example, if a trademark contained a forest scene, an acceptable colour claim might be:

Colour is claimed as a feature of the trademark. The sky is blue, the grass is green, the tree trunks are brown and the leaves are red, orange, and yellow.

#### *2.4.3.8.4 Gradations*

If a trademark contains a colour claim and a colour appears in gradations, the application should describe the transition. For example, acceptable colour claims for trademarks that contain a gradation of colour(s) could read:

Colour is claimed as a feature of the trademark. The spheroid design transitions from dark red in the upper-left portion to light red in the lower-right portion.

Colour is claimed as a feature of the trademark. The swirl design transitions left to right from purple to red to blue.

## **2.4.4 Statements of trademark type**

Also see Section [2.4.10](#) of this Manual regarding the application requirements for non-traditional trademarks.

Paragraph 31(e) of the Regulations prescribes, for the purpose of paragraph 30(2)(d) of the Act, that if a trademark consists in whole or in part of

- a three-dimensional shape
- a hologram
- a moving image
- a mode of packaging goods

a sound  
a scent  
a taste  
a texture  
the positioning of a sign

the application must include a statement to that effect. For example, the following statement would meet this requirement:

“The trademark consists in whole or in part of a hologram.”

Paragraph 31(f) of the Regulations prescribes, for the purpose of paragraph 30(2)(d) of the Act, that if colour is claimed as a feature of the trademark, the application must include a statement to that effect. For example, the following statement would meet this requirement:

“Colour is claimed as a feature of the trademark.”

Paragraph 31(g) of the Regulations prescribes, for the purpose of paragraph 30(2)(d) of the Act, that if a trademark consists exclusively of a single colour or a combination of colours without delineated contours, the application must include a statement to that effect. For example, the following statement would meet this requirement:

“The trademark consists exclusively of the colour red without delineated contours.”

Paragraph 31(h) of the Regulations prescribes, for the purpose of paragraph 30(2)(d) of the Act, that if a trademark is a certification mark, the application must include a statement to that effect. For example, the following statement would meet this requirement:

“The trademark is a certification mark.”

## **2.4.5 Ordinary commercial terms for specific goods or services – paragraph 30(2)(a) of the Act and section 29 of the Regulations**

Paragraph 30(2)(a) of the Act requires that an application for a trademark contain “a statement in ordinary commercial terms of the goods or services in association with which the trademark is used or proposed to be used”. Furthermore, section 29 of the Regulations states that the statement of goods or services “must describe each of those goods or services in a manner that identifies a specific good or service”.

A representative listing of acceptable goods and services that are considered to be ordinary commercial terms for specific goods or services can be found in the Goods and Services Manual.

For goods or services not found in the Goods and Services Manual, acceptable listings can be used to indicate, by analogy, the kinds of statements that would also be acceptable to describe similar goods or services. A statement of goods or services is acceptable if it is as specific as, or more specific than, a related or similar listing.

#### ***2.4.5.1 Ordinary commercial terms***

A statement of goods or services is considered to be in ordinary commercial terms where research discloses that similar language and scope has been used by others in the same industry to describe the applicant's goods or services (see *Dubiner v. Heede International Ltd.* (1975), 23 C.P.R. (2d) 128 and *Mövenpick-Holding AG v. Sobeys Capital Incorporated*, 2010 TMOB 41).

Simply because a statement of goods or services can be understood does not mean that it is a description that is customarily used in the trade (see *Decra-Loc Canada Ltd. v. Pave Tech Inc.* (1995), 61 C.P.R. (3d) 553).

Examiners will conduct research to determine whether there are commercial uses of the description of goods and services in question that would demonstrate that they are described as they normally would be in the trade.

Where ordinary commercial terms cannot be found, the statement of goods or services must be clear and concise; technical, lengthy or ambiguous descriptions of the characteristics of the goods or services are not acceptable.

Registered trademarks cannot be used in statements of goods or services since they are not considered to be in ordinary commercial terms.

#### ***2.4.5.2 Specific goods or services***

Section 29 of the Regulations requires that statements of goods or services must describe each of those goods or services in a manner that identifies a specific good or service. For example, while “clothing” is an ordinary commercial term, it does not identify a specific good, whereas “exercise clothing” is considered to be specific since the functional type of clothing has been provided.

In order to specifically define a good, it may be necessary to include the area of use of the good. For example, the statement “catalysts” on its own is not specific enough for the purposes of the Regulations. However “catalysts for use in oil processing” and “catalysts for use in the manufacture of industrial chemicals” both define the areas of use for the catalysts and render the description acceptable. Including the area of use becomes especially important in cases where a term can have different meanings. For example, “crimping irons” can be used for hair but also for mending or molding leather or iron.

Similarly, “consulting” services may be an ordinary commercial term, but further specificity, by indicating the field of use, is required. For example, “consulting in the field of workplace safety” is considered to be a specific service stated in ordinary commercial terms.

While a statement of services may be more difficult to specify than a statement of goods, the Regulations require some specificity in association with services where it is reasonable to expect that a more specific statement of services in ordinary commercial terms can be provided by an applicant (see *Sentinel Aluminium Products Co. v. Sentinel Pacific Equities Ltd.* (1983), 80 C.P.R. (2d) 201).

The following three-part test will be considered in determining whether the statement goods or services identifies a specific good or service within the meaning of section 29 of the Regulations:

1. Are the goods or services described in a manner such that it is possible to assess whether paragraph 12(1)(b) of the Act applies? A trademark that clearly describes a character or quality of the goods or services is not registrable.

2. Does the statement identify a specific good or service to ensure that the applicant will not have an unreasonably wide ambit of protection? For example, goods described as “computer software”, without further specification, would give the applicant an unreasonably wide ambit of protection.
3. Are the goods or services described in a sufficiently specific manner such that it is possible to assess confusion? A trademark that is confusingly similar to a registered trademark or a pending trademark is not registrable.

#### **2.4.5.3 Context of the goods and services**

In some cases, the context of a statement of goods or services may serve to specify an otherwise unacceptable statement. Goods or services may be acceptable when they are understood as being sufficiently specific in the context of the entire statement of goods or services.

For example, “cases” alone are not acceptable as they could include any type of “cases” from camera cases to pillowcases. However, in an application for “cameras, tripods, and cases”, the goods “cases” would be acceptable as it is clear from the context that the “cases” would be restricted to camera cases. Similarly “delivery” services alone is not acceptable as the service could include any type of delivery from flower delivery to furniture delivery. However, an application for “restaurant services and delivery” would be acceptable as “delivery” would be understood to mean food delivery.

**Note:** Goods or services which are separated by semi-colons (;) are generally considered to stand on their own and therefore must meet the requirements of paragraph 30(2)(a) of the Act and section 29 of the Regulations without regard to the other listed goods or services.

#### **2.4.5.4 “and the like”, “and similar goods”, “including”, “related to”, “related services”, “etc.”, and “featuring”**

Statements of goods or services must be specific and avoid indefinite words and phrases. As a general rule, the following indefinite terms cannot be used to specify goods or services which would otherwise require further specification: “and the like”, “and similar goods”, “including”, “related to”, “and related services”, “etc.” and “featuring”. Such terms are generally only acceptable when they follow specific goods or services.

For example, since “restaurant services” describes a specific service, “restaurant services including take-out services” would be acceptable. Similarly, since “mutual fund services” describes a specific service, “mutual fund services including mutual fund distribution” would be acceptable. However, “financial services relating to mutual fund services” would not be acceptable as financial services alone are not considered to describe a specific service.

In some circumstances, indefinite terms may be used in a statement of goods or services if they are used to provide further specification which is not essential to determining the specific nature. For example, “roller-type lint remover for use in removing foreign particles from clothing, furniture, upholstery and the like” is acceptable since the goods have already been specifically defined as being for “removing foreign particles from clothing, furniture, upholstery” and the indefinite term “and the like” merely indicates other similar uses.

As a general rule, the term “featuring” will only be acceptable when it follows specific goods or services. For example, since “casual clothing” is acceptable, “casual clothing featuring pants, dresses

and shorts” is also acceptable. However, “clothing featuring pants, dresses and shorts” would not be acceptable since “clothing” is not considered to describe a specific good.

The Office accepts the use of “featuring” where the applicant must indicate the specific content or field of interest (e.g., books, computer games, movies, music, photos, etc.) of CDs, DVDs, optical, floppy or other discs. For example, “compact discs featuring topics of instruction in astronomy” and “digital videodiscs featuring computer games” are acceptable.

#### ***2.4.5.5 “namely”, “consisting of” or “specifically”***

Goods and services that require further specification may be specified using the definite terms “namely”, “consisting of” or “specifically”.

For example, “alarms” are considered to be too broad but may be further specified by using the definite term “namely” to list the type of alarms, e.g., “alarms, namely fire, car, and burglar”. Similarly, “consulting” is considered to be too broad but may be further specified by using the definite term “namely”, e.g., “consulting services, namely business management consulting” or by using the definite term “specifically”, e.g., “consulting services, specifically capital investment consulting”.

**Note:** The Office, for purposes of clarity, does not accept the colon (: ) instead of “namely”.

#### ***2.4.5.6 “in the nature of”, “such as”, “comprising”, “containing”, “in particular” or “particularly”***

These terms may be acceptable in a statement of goods or services where the kind, sort or type of goods or services has been specified and the goods or services following any of these terms are considered to comply with paragraph 30(2)(a) of the Act.

For example, “clothing in particular casual wear” is understood to be limited to “casual wear” which is listed as acceptable in the Goods and Services Manual. However, “clothing comprising outerwear” is not considered to be acceptable since “outerwear” is not considered to be a specific kind, sort or type of clothing. Goods stated as “gift baskets containing cheese, bread and prepared meats” are understood to be limited to the goods listed after “containing” which are acceptable pursuant to paragraph 30(2)(a) of the Act.

However, “electrical systems comprising modules” would not be acceptable since “modules” are not considered to be ordinary commercial terms nor are they specific goods.

Similarly, “entertainment services such as hockey games” are understood to be limited to “hockey games” which are considered to be in ordinary commercial terms for specific services and do not encompass other services.

However, “entertainment services in the nature of music events” are not considered to be acceptable since the kind, sort or type of music event has not been specified.

#### ***2.4.5.7 “accessories”, “equipment”, “apparatus”, “systems” and “products”***

As a general rule, goods described by the terms “accessories”, “equipment”, “apparatus”, “systems”, or “products” are not considered acceptable without further specification since they are considered to include different types of goods with different channels of trade which are not necessarily sold in close proximity.

For example, “automobile accessories” could reasonably include everything from air deodorizers to first-aid kits to portable televisions. However, “hair accessories” are acceptable since the accessories are reasonably understood in the trade to be a recognized set of items with the same channels of trade that are typically sold in close proximity, such as barrettes, clips, and side combs.

Similarly, “telecommunications equipment” could include everything from end user items such as fax machines and two-way radios, to goods that support telecommunications delivery such as communication towers and fibre optic cables. However, “hair cutting equipment” is acceptable since the function or the area of use of the equipment can be reasonably understood to be very narrow, since hair cutting is clearly understood to be a singular activity and the equipment confines itself to manual or power operated tools for cutting hair.

Another example is “teaching apparatus” which could reasonably include everything from computer software, to notebooks, to videodiscs. However, “anesthetic delivery apparatus” is acceptable since the function or area of use of the apparatus can be reasonably understood to be very narrow and the goods are understood in the trade to refer to a limited set of items in the medical field such as the anesthetic machine, vaporizers, ventilators, and monitors.

Goods including the term “systems” may be acceptable if the goods are reasonably understood in the trade to be a recognized set of items that is often sold as one complete unit, such as “suspension systems for motor vehicles”, which are specific ordinary commercial terms for the system of springs, shock absorbers and linkages that connect a motor vehicle to its wheels.

Goods including the term “products” may be acceptable if the goods are ordinary commercial terms for specific goods, such as “dairy products”, which are considered to be foodstuffs made from milk that are sold through the same channels of trade in close proximity to each other.

#### ***2.4.5.8 Parts and fittings***

In general, “parts” and “fittings” are acceptable if the goods for which the “parts” and “fittings” are intended are acceptable pursuant to paragraph 30(2)(a) of the Act and section 29 of the Regulations. For example, “dish washer parts and fittings” would be acceptable since the goods “dish washers” are considered to be ordinary commercial terms for specific goods.

#### ***2.4.5.9 Devices***

Where ordinary commercial terms for the goods cannot be found, the term “devices” may be acceptable if the field and function are provided and the goods meet the requirements of the three-part test described in section [2.4.5.2](#) of this Manual. For example, the Goods and Services Manual lists as acceptable the goods “medical devices for the qualitative detection of antibodies in human specimens collected as plasma or dried blood spots” and “electronic medical devices implanted in the eye to help restore vision”.

#### ***2.4.5.10 Computer software and computer programs***

An identification of “computer software” or “computer programs” is not acceptable without further specification. The specific function of the computer software must be provided and, if the area of use is not obvious from the function of the computer software, the specific area of use should also be provided. Acceptable entries for computer software can be found in the Goods and Services Manual.

#### ***2.4.5.11 Discs and other blank or pre-recorded media***

The goods “pre-recorded discs” and “pre-recorded magnetic data carriers” are not considered to be specific pursuant to paragraph 30(2)(a) of the Act and section 29 of the Regulations. The specific format of these goods must be described, e.g., “floppy disks”, “hard disks”, “CDs”, “DVDs”, “CD-ROMs” and “magnetic-stripe cards”. The specific content of these goods must also be described, e.g., movies, music, photos, language instruction, computer games, hotel room key cards or phone cards.

Discs that contain pre-recorded media may also specify content by indicating the specific field of interest, followed by the words “containing topics”, “featuring topics” or “containing information”, e.g., “featuring topics related to the game of baseball”, “containing topics of instruction in astronomy”, “containing information in the field of trademarks”. However, “topics in the field of business consulting” is not considered to be a specific field of interest since “business consulting” is a general term that encompasses a wide variety of topics.

If the content of the discs is described by indicating only a specific field of interest, it is understood that the primary purpose of the discs is to provide information. While the discs may include various audio-visual components, the Office considers that the discs do not contain software nor do they contain books, computer games, movies, music etc., unless the applicant explicitly states that they do.

If either the pre-recorded discs or the pre-recorded magnetic data carriers contain computer software, the function of the software must be provided and, if the area of use is not obvious from the function of the computer software, the area of use should also be provided.

**Note:** The goods “pre-recorded audiotapes”, “pre-recorded videotapes”, “pre-recorded videocassettes”, “pre-recorded audio cassettes”, “audio tape recordings” and “video tape recordings” are considered to indicate a specific format and specific content since the nature of the media limits the content to solely magnetic recordings of sounds and visual images and are therefore acceptable as indicated.

#### ***2.4.5.12 Pharmaceutical, veterinary, botanical, nutraceutical, homeopathic, medicinal and medicated preparations, remedies, supplements, extracts, functional foods and enhanced water***

Goods that are described as “preparations”, “remedies”, or “supplements” for “pharmaceutical”, “veterinary”, or “medicinal” use are not considered specific pursuant to paragraph 30(2)(a) of the Act and section 29 of the Regulations. The Registrar requires such goods to be specified in greater detail by either:

- naming the disease; or
- specifying the disease group or type of disease, disorder or condition to be treated; or
- by indicating the specific type of medication.

Veterinary pharmaceuticals, preparations or medicines are often divided into areas relating to specific animals or groups of animals, and often relate to the prevention rather than treatment of disease. For example, “pharmaceutical preparations for the treatment of infectious diseases, namely respiratory infections, eye infections” requires the type of “infectious diseases” to be specified. However, “veterinary pharmaceutical preparations for the treatment of infectious diseases in poultry” require only the type of animal or group of animals to be specified.

#### **2.4.5.13 Intangibles**

Intangibles such as “web sites”, “electricity”, “domain names”, “steam”, and “waste gas” should not be listed in a statement of goods since they are considered to be services, such as the following from the Goods and Services Manual: “website design”, “web hosting”, “energy recycling services that capture and converts wasted energy into electricity and useful steam”, “selling domain names”, “domain name registration”, and “waste gas treatment services”. Where an application lists such intangibles in the statement of goods, and it appears that the applicant may actually be offering services, the examiner will so advise the applicant.

#### **2.4.5.14 Advertising, promotion and marketing – benefit to a third party**

In view of the *Ralston Purina Co. v. Effem Foods Ltd.* (1997), 81 C.P.R.(3d) 528 decision, examiners will question services where it is not clear that a real service is provided to the public. The criterion is whether a third party benefits from the service. For example, if the applicant's “advertising” and “marketing” services simply make the public aware of the applicant's own products, there is not considered to be a benefit to the public. In order to determine if the service is being offered to a third party, examiners may ask for further specificity by questioning the means or manner by which the service is provided. For example, the following would be considered acceptable:

- “Database marketing services, in the form of compiling customer specific databases for marketing purposes and consulting, designing, printing, and collecting marketing information”
- “Promoting the sale of credit card accounts through the administration of incentive award programs”

In circumstances where the public does benefit from promotional services, in spite of the fact that they relate to the promotion of the applicant's own goods and services, the services will be considered acceptable. For example, “providing coupon programs pertaining to a line of food products” is considered a service within the meaning of section 4 of the Trademarks Act.

Examiners will question “cooperative advertising” as it is generally understood to be a cost sharing arrangement between the retailer and supplier for the advertising and promotion of their products.

In order to be acceptable, the statement of services must be described so that it is clear that the services are offered to a third party, and the services must be described in specific and ordinary commercial terms in compliance with paragraph 30(2)(a) of the Act and section 29 of the Regulations.

#### **2.4.5.15 Services related to the electronic transmission of data**

As a general rule, services including the term “data” such as “data transmission services”, “electronic transmission of data”, “data and voice telecommunications” or “electronic transmission of data and documents via computer terminals” or services that relate to data such as “delivery of messages by electronic transmission” or “electronic-store-and-forward messaging” are not acceptable without further specification since “data” in this context can include any information in numerical form that can be digitally transmitted or processed (including audio, video, voice, or any other form of data).

If the essential nature of the services involves providing data to customers, the applicant should set out the specific nature of the data (e.g., financial advice, client lists, video news show, music, etc.), and the

general means by which it is communicated to the customer (e.g., online databases, online stores, Web sites, email, pager, or cellular text messages, etc.).

If the essential nature of the services involves providing the ability to communicate (i.e., transmission services), then the applicant should set out the specific means of communication (e.g., satellite, wireless, telephone lines, cable network, cellular, wide-area network, fax, etc.), and the general nature of the data transmitted. It is understood that the applicant may have limited control over the exact content being transmitted if they only supply the means of transmission.

#### ***2.4.5.16 Telecommunication-related services***

Generally, services that include the term “telecommunications” (e.g., “telecommunication services”), or that relate to “telecommunication services” (e.g., “communication services”, “information technology services”, “electronic commerce services”), are not considered acceptable without further specification, since “telecommunication” in this context can include any communication at a distance. Therefore, services that either include the term “telecommunications” or relate to “telecommunication services” should specify the nature of the services (i.e., the specific type of communication) and the field of the services (i.e., area of business the applicant provides these services).

For example, the following would be considered acceptable:

“Providing multiple user access to a global computer network”.

In certain circumstances, the statement of services is so specific that the area of business is obvious from the specific type of communication.

For example, the following would be considered acceptable:

“Videoconferencing services”

“Wireless digital messaging services”

“Personal Communication Services” or

“Radio broadcasting services”.

## **2.4.6 Signature of applicant**

A signature is not required for filing a trademark application. The Trademarks Office will also accept trademark applications and correspondence which have been stamped with electronic signatures such as those currently used by a number of firms.

An application by a partnership may be signed by one of the partners if the partners are named. If the partnership comprises general and limited partners, the application may be executed by a partner who can bind the partnership. An application by a corporation may be signed by an officer authorized to sign on its behalf, and the title of the signing officer should be provided. The signature of each of the parties in a joint venture may be affixed to the application.

## **2.4.7 Nice Classification – Subsection 30(3) of the Trademarks Act**

The [Nice Classification](#) is an international system for the classification of goods and services established by the Nice Agreement consisting of a list of 34 classes for goods and 11 for services.

While goods or services must be stated “in ordinary commercial terms” and “in a manner that identifies a specific good or service”, even where goods or services are considered to comply with paragraph 30(2)(a) of the Act and section 29 of the Regulations, additional details may be required to group them according to the classes of the Nice Classification.

The Goods and Services Manual should be consulted in order to determine the exact classification of goods or services. For goods or services not found in the Manual, examiners will consult the Class Headings and Explanatory Notes, as well as the [General Remarks](#) of the Nice Classification to determine the appropriate class for particular goods or services.

#### ***2.4.7.1 Versions and editions***

Any annual revisions to the Nice Classification are published electronically by the World Intellectual Property Organization (WIPO) on its website, and enter into force on January 1<sup>st</sup> of each year. Each of these versions includes all the changes adopted since the previous version. Changes between versions consist of additions, deletions, or modifications of goods and services in a given class. Typically, new versions do not transfer goods or services from one class to another.

New editions of the Nice Classification enter into force every five (5) years, and include all changes adopted annually since the previous edition, as well as all goods or services that were transferred from one class to another.

##### ***2.4.7.1.1 Effect of new edition on applications***

Any changes incorporated in new editions of the Nice Classification apply only to applications having a filing date on or after the effective date of the edition.

For applications filed prior to the effective date of a new edition, an applicant will have the option of complying with either the edition that was in effect at the filing date of the application or the new edition. However, if the applicant chooses to have the new edition apply, the application must conform to the new edition for all the goods or services listed in the application. In other words, an application cannot have some goods or services conform to the current edition and other goods or services conform to a previous edition. Furthermore, once an applicant chooses to have a newer edition apply, the application may not be amended to use a previous edition.

##### ***2.4.7.1.2 Edition applicable to amendments to group the goods or services of registrations***

When a registered owner amends a registration to group goods or services according to the Nice Classification, either voluntarily or in response to a notice issued by the Registrar under subsection 44.1(1) of the Trademarks Act, the application must comply with the edition of the Nice Classification in force on the date of the amendment.

#### ***2.4.7.2 Grouping goods and services according to the Nice Classification***

Goods or services that could have a number of uses should generally be classified in a single class according to their primary function. If goods or services are normally in a particular class, applicants

cannot obtain registration in another class merely by identifying a use or purpose for which the goods or services could then fall into another class or classes.

For example, “essential oils” are classified in Class 3. This cannot be in Class 1 even if the applicant indicates that it is used in the manufacture of other finished products. An “essential oil” is always placed in Class 3 regardless of its ultimate use.

However, if it can be shown that goods or services could have a number of uses, then two or more classes could be appropriate. The statement of goods or services must clearly indicate the basis for the multiple Nice classification with language that is appropriate to the respective classes.

For instance, the identification of “clock radios” could be classed in Class 9 with respect to “radios” and “Class 14” with respect to clocks. Examiners should not question the classification by an applicant as long as both indicated classes are correct, or the individual goods or services are in an appropriate class. In this case, either Class 9 or 14 or both would be appropriate.

However, where applicants have not indicated an appropriate class, examiners will need to request confirmation.

For example, if the “clock radio” is primarily a radio which incorporates a clock (in Class 9) or if it is primarily a clock which incorporates a radio” (in Class 14), a “clock radio” cannot be placed in any other class.

Services are typically classified according to the branches of activities and their field of use. However, certain services can be placed in multiple classes on the basis of the purpose for which the services activity is rendered. In those cases, the purpose of the activity will determine classification.

For example, the term “business planning” would normally be in Class 35, but if it concerns any financial aspect of “business planning” then it could be placed in Class 36.

Since the Goods and Services Manual accepts “business planning” as acceptable, examiners will not question the services if the applicant has placed “business planning” in Class 35.

Where the applicant has not indicated an appropriate class, examiners will request an applicant confirm the purpose for which the service is being rendered.

For example, an examiner will require further clarification of the services if an applicant places “business planning” in Class 36, as it will be necessary for the applicant to identify the type of business planning being done to justify its placement in this class, such as “business planning, namely, investment planning”.

#### *2.4.7.2.1 Material composition*

As mentioned above, a finished product is typically classified according to its function and purpose. However, if a statement of goods is specific, but the goods could be placed in more than one class depending on the material composition, then the applicant should identify the material composition of the good.

For example, while the goods “statues” are considered to be in ordinary commercial terms for specific goods, they must be further defined in order to be grouped into the appropriate class. The classification of goods such as “statues” will depend upon its material composition. For example, “statues of non-precious metal” in Class 6; “statues of precious metal” in Class 14; statues made of wax, wood, plaster, or plastic would fall into Class 20; and “statues made of glass or porcelain” in Class 21.

However, where an item is made for a particular industry, despite the fact that knowledge of that industry would indicate that the goods would be made from various materials, the precise material composition may not be required. For instance, structural parts of an automobile can be made of metal or plastic, but an examiner would not question the material composition of the parts, since structural parts for automobiles would be placed in Class 12.

#### *2.4.7.2.2 Reference to other classes*

Statements such as “transport services of all goods in Classes 32 and 33” or “computer software in the field of services in Classes 41 and 45” are not acceptable. While “transport services” and “computer software” can be grouped according to the classes of the Nice classification, these statements are not considered to be in ordinary commercial terms for specific goods or services. The applicant must state the goods being covered in Classes 32 and 33, e.g., “food transportation services” and must identify the services in Classes 41 and 45, e.g., “computer software for computer virus protection”.

The exclusion of other classes, such as “goods not included in other classes”, is also unacceptable since such wording is not considered to be ordinary commercial terms.

#### *2.4.7.2.3 Class and context*

In some cases, the context of the goods or services within a particular class may serve to clarify an otherwise unacceptable statement of goods or services. When a statement of goods or services includes a term that has multiple meanings, the class in which it is placed can aid an examiner to determine the meaning of the good or service.

For example, the statement “pants, jeans and mufflers” in Class 25 would not require further clarification as the class and context serves to indicate that the applicant is seeking registration for clothing and not for engine mufflers in Class 7.

However, if the applicant simply listed the goods “mufflers” alone, this statement is void of context and will need to be redefined. Once redefined, the examiner will then be in a position to determine if the applicant has placed “mufflers” in the appropriate class. If the classification is incorrect, the examiner will inform the applicant that the classification is incorrect.

The goods “skin lotions” are understood to mean cosmetics in Class 3 and are therefore not medicated. However, if the goods are medicated, the “skin lotions” must be further defined to justify their placement in Class 5.

Lastly, care must be taken concerning the scope of goods or services when viewed in the context of the class. For example, an application for various articles of “clothing” in Class 25 would not include “articles of clothing for protection against accidents” in Class 9. Similarly, an application for various types of “cases” in Class 18 could not include within its scope “violin cases” in Class 15.

#### *2.4.7.2.4 Kits, gift baskets and goods sold as a unit*

Goods such as “kits”, “gift baskets” and goods described as being “sold as a unit” must comprise goods belonging to a single class.

The Office classifies “kits” according to their purpose, e.g., “nail care kits” in Class 3, “first-aid kits” in Class 5, “sewing kits” in Class 26 and “Easter egg colouring kits” in Class 28.

Accordingly, “kits” that have no stated purpose need to list the items of which the kit is composed. Moreover, if a kit having no stated purpose is composed of goods that can be classified in various classes, the applicant must list each good under its appropriate class.

The same process for “kits” should be applied to the classification of “gift baskets”. For example, “gift baskets of fresh fruits” will be placed in Class 31, the Class which contains fruit. However, for “gift baskets containing cheese, crackers and wine”, the applicant would have to list each good under its appropriate class, e.g., “gift baskets containing cheese” in Class 29, “gift baskets containing crackers” in Class 30, and “gift baskets containing wine” in Class 33.

Similarly, goods comprising items that are “sold as a unit” must comprise goods belonging to a single class, for example, “computer software for tax preparation and electronic instructional manuals sold as a unit” would be placed in Class 9.

Acceptable Nice Classes for kits, gift baskets and items sold as a unit can be found in the Goods and Services Manual.

## **2.4.8 Priority – Section 34 of the Trademarks Act**

Also see the practice notice entitled “Priority Claims”.

Under the terms of the Paris Convention, an applicant (or successor-in-title) who is a citizen or national of, or domiciled in, a country of the Union, or has a real and effective industrial or commercial establishment in a country of the Union, may file an application for the registration of a trademark in Canada, and may claim as the filing date the date they filed an application in or for a Union country for the same or substantially the same trademark for use in association with the same kind of goods or services.

### ***2.4.8.1 Application requirements***

In accordance with subsection 34(1) of the Trademarks Act, in order for an applicant to be entitled to priority in Canada based on an earlier-filed application, a request setting out the date and country of filing of the earlier application must be filed with the Registrar within a period of six months after the date on which the earliest application was filed. Such a request for priority may be filed in one of the following ways:

1. by including the request in an initial application, provided that the application is filed within the above-noted six-month period;
2. by amending an application to include the request, provided that the amendment is made within the six-month period; or
3. by filing a separate request in respect of an application at any time within the six-month period.

The Office will permit the request for priority to be amended to correct an error at any time within the six-month period of time. After the expiry of the six-month period of time, no amendment will be permitted to the date, country, or goods or services indicated in the request since it is considered that such an amendment would be inconsistent with subsection 34(1) of the Act.

Subsection 34(1) of the Act does not require that a priority request include the number of the earlier application. However, the Office considers that it is highly desirable for it to be able to make available to the public either the number of, or a copy of, the earlier application. Accordingly, where a priority request does not include the number of the earlier application, the Office will, pursuant to subsection 34(2) of the Act, require the applicant to either provide the Office with the number or submit a certified copy of the earlier application.

Should an error be made in indicating the number of the earlier application, the Office will permit the number to be corrected at any time before registration. Since subsection 34(1) of the Act does not require the request to include the number, the Office considers that an amendment of the number is permitted in accordance with subsection 35(1) of the Regulations.

For the purposes of the priority request referred to in paragraph 34(1)(a) of the Act, the Office does not consider there to be any requirement to identify the specific goods or services in respect of which priority is claimed. Rather, it is sufficient that the request indicates that the priority application was filed for registration of the same or substantially the same trademark for use in association with the same kind of goods or services.

However, if an applicant chooses to limit the priority claim to goods only, to services only, or to specific goods or services, the limitations to the goods or services covered by the priority claim may only be made within the above-noted six month period. After the expiry of the six-month period, no amendment to remove any such limitation will be permitted since this would be considered to be the making of a new request for priority outside of the time limits permitted by paragraph 34(1)(a).

#### ***2.4.8.2 Withdrawing a priority request***

Pursuant to subsection 33(2) of the Regulations, a request for priority may be withdrawn by filing a request to that effect before the application is advertised under subsection 37(1) of the Act.

#### ***2.4.8.3 Dies Non***

In accordance with subsection 66(1) of the Trademarks Act, any time limit that expires on a day when the Trademarks Office is closed for business is deemed to be extended to the next day when the Office is open for business. All persons are entitled to these extensions regardless of their place of residence or of the designated establishment to which documents are delivered.

For example, if the six-month period for a priority claim falls on a Saturday and the following Monday is a statutory holiday, the applicant will be given until the Tuesday to file the trademark application and include the appropriate priority claim.

Since section 66 of the Act applies to any day the Office is closed (and not just statutory holidays) another example is if the six-month period falls on a Sunday, the applicant will be given until Monday to file the trademark application with a priority claim.

However, if the applicant would like to amend the priority request in the initial application, it is the examiner's responsibility to properly apply the Office practice with respect to priority claims.

#### **2.4.8.4 Force Majeure**

Also see the practice notice entitled “Extensions of Time due to Force Majeure for Priority and Renewal”.

Subsection 34(5) of the Trademarks Act permits an applicant to apply for an extension of time to file an application for registration having a claim to priority:

An applicant is not permitted to apply under section 47 for an extension of the six-month period referred to in paragraph (1)(a) until that period has ended, and the Registrar is not permitted to extend the period by more than seven days.

An applicant may apply for an extension of time to file an application referred to in paragraph 34(1)(a) of the Act only after the time limit has passed. Therefore, only a request under subsection 47(2) of the Act is applicable. The applicant must pay the prescribed fee (to find out the exact amount of the fee, please consult the [list of fees for trademarks](#)) as well as explain the reason(s) why it could not do the act within the prescribed period. Evidence that the event has occurred is not required so long as the event was clearly described in the request.

If the Registrar grants the extension of time, the period may only be extended by a maximum of seven days.

Requests for these types of extensions of time must be addressed as follows and sent by mail or fax:

**REQUEST FOR EXTENSION OF TIME ON FORCE MAJEURE**

c/o Deputy Director, Examination Division

Trademarks Office

Canadian Intellectual Property Office

50 Victoria Street

Gatineau, Quebec K1A 0C9

Fax: 819-953-2476.

While not explicitly stated as such, subsection 34(5) provides relief measures for applicants to extend time limits due to a “force majeure” event. Force majeure (often called “act of God”) is a legal concept that allows a party to suspend its obligations when certain circumstances beyond its control arise, making performance of its obligations impossible. The Supreme Court of Canada defined an “act of God,” at least as it pertains to contract law, in *Atlantic Paper Stock Ltd. v. St. Anne-Nack*, [1976] 1 SCR 580 at 583 as an “event, beyond control of either party, [that] makes performance impossible.” The Court described the uncontrollable character of the event as being something “unexpected” and “beyond reasonable human foresight and skill.” In addition to the unexpected character of an event, the event must also “strike at the root” of the reason why the obligation cannot be met. When considering the occurrence of a force majeure event, courts are not interested in the occurrence of the event per se, but the specific effect of the event on the obligations of the parties. In addition to “acts of God,” force majeure events can also include political or medical events.

Examples of force majeure events include, but are not limited to:

- ice storms, fires, explosions, earthquakes, droughts, tidal waves, floods;
- wars, hostilities (whether or not war declared), invasions, acts of foreign enemies, mobilisations, embargos;

- rebellions, revolutions, insurrections, or civil wars;
- contamination by radio-activity from any nuclear fuel, or from any nuclear waste from the combustion of nuclear fuel, radio-active toxic explosive, or other hazardous properties of any explosive nuclear assembly;
- riots, commotions, strikes, go slows, lock outs or disorder (unless solely restricted to employees of the party);
- virus/bacterial epidemic outbreaks;
- acts or threats of terrorism

## **2.4.9 Standard characters – Section 31 of the Trademarks Act**

Also see the practice notice entitled “Standard Character Trademarks”.

A standard character trademark contains a combination of prescribed letters, numbers and symbols without any claim to a particular font, size or colour.

Section 31 of the Trademarks Act sets out that an application for a standard character trademark must include:

- a representation that consists only of characters for which the Registrar has adopted standard characters; and
- a statement to the effect that that the applicant wishes the trademark to be registered in standard characters.

The Office has created a standard character set that lists the letters, numerals, punctuation marks, diacritics and typographical symbols that may be used when filing a standard character trademark. The standard character set is available on the practice notice entitled “Standard Character Trademarks”.

Furthermore, paragraph 30(e) of the Trademarks Regulations requires that the representation of a trademark in standard characters must be in black on a white background.

If an applicant requests registration of a trademark that appears to be in standard characters but (i) does not include or reference a standard character statement, or (ii) contains characters not in the standard character set, the trademark will be treated as a design trademark. In such cases, the trademark will be scanned and represented as filed.

Pursuant to paragraph 35(2)(e) of the Trademarks Regulations, an application cannot be amended to add or remove a statement in paragraph 31(b) of the Act, namely that the trademark consists of standard characters, unless the application has not been advertised and the trademark remains substantially the same.

## **2.4.10 Non-traditional trademarks**

Also see the practice notice entitled “Non-traditional Trademarks”.

Paragraph 30(2)(c) of the Trademarks Act provides that an application is required to contain a representation or description, or both, that permits the trademark to be clearly defined and section 30 of the Trademarks Regulations lists the requirements that are prescribed. The following sections summarize the application content requirements for non-traditional trademarks consisting in whole or in part of a sound, hologram, moving image (motion), scent, taste, colour per se, a three-dimensional shape, a mode of packaging goods, a texture, or a positioning of a sign.

#### ***2.4.10.1 Sound***

Pursuant to paragraph 31(e) of the Trademarks Regulations, if the trademark consists in whole or in part of a sound, a statement to that effect must be included in the application.

For a trademark containing or consisting of a sound to be clearly defined pursuant to paragraph 30(2)(c) of the Act, the application must include a clear and concise description as well as an electronic recording of the sound. Electronic recordings must not contain any looping or repetition of the sound, nor include any sounds that do not form part of the trademark. A visual representation of the trademark may be included in the application but is not required.

An example of an acceptable description of a sound trademark would be:

The trademark consists of the sound of a lion's roar, the audio representation of which is included in the application.

#### ***2.4.10.2 Hologram***

A hologram is defined as a three-dimensional picture made by laser light reflected onto a photographic substance without the use of a camera. Although holograms can be a singular image, they can also show different images when viewed from different angles.

Pursuant to paragraph 31(e) of the Regulations, if the trademark consists in whole or in part of a hologram, a statement to that effect must be included in the application.

For a trademark containing or consisting of a hologram to be clearly defined pursuant to paragraph 30(2)(c) of the Act, the application must include a visual representation in the form of one or more still images, sufficient in number and clarity, to demonstrate the holographic effect in its entirety. The application must also include a clear and concise description of the visual effect when the hologram is viewed from different angles.

The application may also include a digital representation of the trademark, in the form of a moving image (animation) clip, that demonstrates the holographic effect in its entirety.

If the visual representation depicts different views of the same trademark, a statement to that effect must be included in the application to comply with section 27 of the Regulations.

If colour is claimed as a feature of the hologram, the application must also contain a statement to that effect and the visual representation(s) must be in colour. If colour is not claimed as a feature, the visual representation(s) must be in black and white.

An example of an acceptable description of a hologram trademark without a claim to colour(s) would be:

The trademark consists of a hologram of a dove in flight. The visual representation included in the application depicts the full range of the holographic effect.

An example of an acceptable description of a colour hologram trademark would be:

The trademark consists of a hologram of a map of the world as depicted in the visual representation. The trademark has a holographic rainbow colour effect and the applicant claims the colours red, orange, yellow, green, blue, indigo, violet as a feature of the trademark.

#### ***2.4.10.3 Moving image (motion)***

Pursuant to paragraph 31(e) of the Regulations, if the trademark consists in whole or in part of a moving image, a statement to that effect must be included in the application.

For a trademark containing or consisting of a moving image to be clearly defined pursuant to paragraph 30(2)(c) of the Act, the application must include a electronic representation of the trademark, in the form of a moving image (animation) clip, that demonstrates the full range of the moving image. The animation clip must run only once and not repeat or loop. A visual representation which consists of a static frame-by-frame representation of the motion will only be accepted if it is submitted with the animation clip. The application must also include a clear and concise description of the whole visual effect of the animation from start to end.

If colour is claimed as a feature of the animation, the application must also contain a statement to that effect and the visual representation(s) must be in colour. If colour is not claimed as a feature, the visual representation(s) must be in black and white.

An example of an acceptable description of a moving image trademark would be:

The trademark consists of a moving image of a book being opened and a page turned, as shown in the representation included in the application.

#### ***2.4.10.4 Scent***

Pursuant to paragraph 31(e) of the Regulations, if the trademark consists in whole or in part of a scent, a statement to that effect must be included in the application.

For a trademark containing or consisting of a scent to be clearly defined pursuant to paragraph 30(2)(c) of the Act, the application must include a clear and concise description of the scent.

Examples of acceptable descriptions for scent trademarks include:

The trademark consists of the scent of strawberry.

The trademark is a coconut scent diffused throughout a retail store setting.

#### ***2.4.10.5 Taste***

Pursuant to paragraph 31(e) of the Regulations, if the trademark consists in whole or in part of a taste, a statement to that effect must be included in the application.

For a trademark containing or consisting of a taste to be clearly defined pursuant to paragraph 30(2)(c) of the Act, the application must include a clear and concise description of the taste.

An example of acceptable descriptions of a taste trademark would be:

The trademark consists of the taste of black licorice.

#### ***2.4.10.6 Colour per se***

Pursuant to paragraph 31(g) of the Regulations, if the trademark consists of a single colour or combination of colours without delineated contours, a statement to that effect must be included in the application.

For a trademark consisting of colour per se to be clearly defined pursuant to paragraph 30(2)(c) of the Act, the application must include a description that provides the common name of the colour(s). A visual representation consisting of a square swatch in each colour is also required.

The application must not include a statement that colour is claimed as a feature of the trademark as colour is the trademark and not merely a feature thereof.

An example of acceptable descriptions of a colour per se trademark would be:

The trademark consists exclusively of the colour red without delineated contours, as shown in the visual representation.

#### ***2.4.10.7 A three-dimensional shape***

Pursuant to paragraph 31(e) of the Regulations, if the trademark consists in whole or in part of a three-dimensional shape, a statement to that effect must be included in the application.

For a trademark containing or consisting of a three-dimensional shape to be clearly defined pursuant to paragraph 30(2)(c) of the Act, the application must include a visual representation. The representation should only include those portions of the three-dimensional object that form part of the trademark. However, if the representation includes elements that do not form part of the trademark (e.g. in order to further clarify the trademark), they must be shown in dashed lines and the application must include a statement that the portions of the representation shown in dashed lines do not form part of the trademark.

If the visual representation depicts different views of the same trademark, a statement to that effect must be included in the application to comply with section 27 of the Regulations.

If colour is claimed as a feature of the three-dimensional shape, the application must include a statement to that effect and the visual representation(s) must be in colour. If colour is not claimed as a feature, the visual representation(s) must be in black and white.

#### ***2.4.10.8 Mode of packaging goods***

Pursuant to paragraph 31(e) of the Regulations, if the trademark consists in whole or in part of a mode of packaging goods, a statement to that effect must be included in the application.

For a trademark containing or consisting of a mode of packaging goods to be clearly defined pursuant to paragraph 30(2)(c) of the Act, the application must, in addition to a clear and concise description, include a visual representation.

If the visual representation depicts different views of the same trademark, a statement to that effect must be included in the application to comply with section 27 of the Regulations.

If colour is claimed as a feature of the mode of packaging goods, the application must include a statement to that effect and the visual representation(s) must be in colour. If colour is not claimed as a feature, the visual representation(s) must be in black and white.

An example of acceptable descriptions of a mode of packaging goods trademark would be:

The trademark is a mode of packaging goods and consists of the way the goods are wrapped in green cellophane, as depicted in the drawing. The colour green is claimed as a feature of the trademark.

#### ***2.4.10.9 Texture***

Pursuant to paragraph 31(e) of the Regulations, if the trademark consists in whole or in part of a texture, a statement to that effect must be included in the application.

For a trademark containing or consisting of a texture to be clearly defined pursuant to paragraph 30(2)(c) of the Act, the application must include a clear and concise description of the tactile qualities of the trademark. The application may include a visual representation of the texture if it would add clarity to the description.

If the visual representation depicts different views of the same trademark, a statement to that effect must be included in the application to comply with section 27 of the Regulations.

If colour is claimed as a feature of a texture trademark, the application must include a statement to that effect and the visual representation(s) must be in colour. If colour is not claimed as a feature, the visual representation(s) must be in black and white.

Examples of acceptable descriptions of a texture trademark include:

The trademark consists of the texture of 100 grit sand paper on the surface of the associated goods.

The trademark consists of the texture of fine leather on the surface of the bottle as depicted in the visual representation.

The trademark consists of the waffle type texture as applied to the surface of toilet paper as depicted in the visual representation.

#### ***2.4.10.10 Positioning of a sign***

Pursuant to paragraph 31(e) of the Regulations, if the trademark consists in whole or in part of the positioning of a sign, a statement to that effect must be included in the application.

For a trademark containing or consisting of the positioning of a sign to be clearly defined pursuant to paragraph 30(2)(c) of the Act, the application must, in addition to a description, include a visual representation of the trademark.

Where the applicant is seeking registration of the position of a sign on a three-dimensional object, any representation must show the three-dimensional object in dashed lines, and the application must include a statement that the object shown in dashed lines does not form part of the trademark but is included merely to show the positioning of the sign.

Where the applicant is seeking registration of the position of colour(s) as applied to the whole or portions of the surface of a three-dimensional object, the application must include a statement that colour is claimed as a feature of the trademark, and the visual representation(s) must be in colour. This is required because in this situation the colour is considered as a feature of the positioning of the trademark.

If the visual representation depicts different views of the same trademark, a statement to that effect must be included in the application to comply with section 27 of the Regulations.

An example of acceptable descriptions of a position trademark would be:

The trademark consists of the position of a fanciful horse design applied to a three-dimensional bottle, as shown in the visual representation. The bottle shown in dashed lines does not form part of the trademark but is included merely to show the positioning of the design.

The trademark consists of the position of a v-shaped stitching design as applied to a pocket, as shown in the visual representation. The pocket shown in dashed outline does not form part of the trademark but is included merely to show the position of the trademark.

#### ***2.4.10.11 Combinations***

Applications for trademarks that consist of a combination of two or more trademark types must meet the minimum requirements for each trademark type. For example, an application for a trademark that consists of both a sound and a moving image must meet the requirements for a sound trademark as well as the requirements for a moving image trademark.

#### ***2.4.10.12 Acceptable formats of electronic files***

Applications filed by paper may attach electronic representations of images, animations, or sounds provided on a CD, DVD, or USB stick. Alternatively, applicants who file by paper may include still images of the trademark on separate pages; the images must be clearly labeled to indicate the order in which they appear in the visual representation of the trademark.

When providing electronic files containing multiple still visual representations, applicants may provide either one image per file or all images in one file. If one image per file is provided, only the first image provided will appear in correspondence from the Office.

The following provides a summary of the requirements when providing audio and visual representations in electronic format whether an application is filed by paper or online.

<b>File content</b>	<b>File extension</b>	<b>Max representations</b>	<b>Max file size</b>
Sound recording	.MP3	1	10 MB
Moving image	.MP4	1	10 MB
Still image	.PNG / .TIF / .JPG / .GIF	No maximum	10 MB

## **2.5 Certification marks — Sections 23, 24 and 25 and Paragraph 30(2)(b) of the Act**

## **2.5.1 Definition of Certification Mark**

A certification mark is defined in section 2 of the Trademarks Act as “a sign or combination of signs that is used or proposed to be used for the purpose of distinguishing or so as to distinguish goods or services that are of a defined standard from those that are not of that defined standard, with respect to

- a. the character or quality of the goods or services,
- b. the working conditions under which the goods are produced or the services performed,
- c. the class of persons by whom the goods are produced or the services performed, or
- d. the area within which the goods are produced or the services performed”.

## **2.5.2 Owner not engaged**

According to paragraph 30(2)(b) and subsection 23(1), a certification mark may be registered only by a person who is not engaged in the manufacture, sale, leasing or hiring of goods or the performance of services such as those in association with which the certification mark is used or proposed to be used.

The owner of a certification mark may be engaged in activities other than certification, such as the sale of goods or the performance of services, other than those covered by the certification mark. The owner may use the same trademark as a certification mark on goods and as an ordinary trademark on services, or vice versa. However, the applicant cannot use the same trademark to both indicate defined standards for goods or services and to distinguish those same goods or services from the goods or services of others.

## **2.5.3 Example of certification mark**

An example of a certification mark is one registered by a trade association to identify the goods or services of its members. For example, the certification mark of the Association of Professional Engineers of Ontario certifies to the purchaser of engineering services that those services have been performed by qualified professional engineers. The Association of Professional Engineers of Ontario is the owner of the certification mark and is responsible for the quality of services performed. The professional engineer who performs the services is not the owner of the certification mark but is authorized by the owner to use the mark in association with the services rendered.

## **2.5.4 Descriptive of place of origin — Section 25**

An application for registration of a certification mark must satisfy most of the same registrability requirements under section 12 of the Act as an application for an ordinary trademark. However, a certification mark which is descriptive of the place of origin of the goods or services is registrable if:

- a. the applicant is the administrative authority of a country, state, province, or municipality, including or forming part of the area indicated by the mark; or

- b. is a commercial association having an office or representative in such area.

The owner of any certification mark registered under section 25 of the Act shall permit the use of the mark in association with any goods or services produced or performed in the area of which the mark is descriptive.

## 2.5.5 Defined standard

Paragraph 30(2)(b) of the Trademarks Act requires an application for the registration of a certification mark to contain particulars of the defined standard that the use of the certification mark is intended to indicate.

In view of the decision of the Trademarks Opposition Board in *Molson Breweries v. Labatt Brewing* (1996), 69 C.P.R. (3d) 274, an application for the registration of a certification mark does not comply with the requirements of paragraph 30(2)(b) of the Act unless the application sets out in a meaningful way particulars of the defined standard. To be meaningful, the particulars should allow a member of the public to ascertain the precise nature of the defined standard. For example, an acceptable defined standard can include details on the qualifications required from the persons producing the goods or providing the services, or the norms of quality or performance or production of the goods or services.

Where the details of the defined standard are very lengthy, the applicant must make a copy available to the public and include in the application the name and a summary of the relevant portions of the relevant document(s). As stated in *Molson Breweries v. Labatt Brewing* (1996), 69 C.P.R. (3d) 274 at 283 (T.M.O.B):

It would not be imposing too onerous a burden on an applicant to furnish a meaningful “defined standard” when the certification mark application is initially filed or to update the defined standard as the need arises. Further, easy access to the standard which a certification mark symbolizes would appear to be in the public interest. Presumably, the particulars of the defined standard need not be set out in its entirety in the trademark application as long as reference is made to the titles of published manuals, or the like, where the standard may be found.

It is not acceptable for the applicant to provide a website address where the defined standard may be viewed electronically since such information may not always be available to public inspection.

Where the details of the defined standard are very lengthy and the applicant does not wish to submit a paper copy, the Office will accept an electronic version of the defined standard in an acceptable format provided that a summary of the standard is included in the application. It is the responsibility of the applicant to ensure that the electronic version of the defined standard is submitted in such a format that is easily readable and accessible to the public in accordance with subsection 29(1) of the Act.

**Note: in all cases, a brief summary of the standard will need to be included in the application. A mere reference to another document is not acceptable.**

## 2.5.6 Amending Applications to and from Certification Marks

See section [2.8.6 Amending an application to/from a certification mark](#) in this Manual.

## **2.6 Applications to extend the statement of goods or services – paragraph 41(1)(c) and subsection 41(2) of the Act**

Paragraph 41(1)(c) of the Trademarks Act provides that the registered owner of a trademark may amend the statement of the goods or services in respect of which the trademark is registered.

Subsection 41(2) of the Act provides that an application to extend the statement of goods or services in respect of which a trademark is registered has the effect of an application for registration of the trademark in respect of the goods or services specified in the application for amendment. In other words, an application to extend the statement of goods or services of a trademark registration will be examined as a new application.

### **2.6.1 Conversion to an ordinary trademark application**

There are occasions when an applicant may wish to convert an application to extend the statement of goods or services to an ordinary trademark application.

In such a situation, a new application number will be assigned to the application. The newly created application will be granted the same filing date as the application to extend.

Examiners must ensure that the ordinary application replacing the extension of goods or services application contains the same trademark, statement of goods or services, and name and address of the applicant.

The Office will also permit the applicant to revert to an ordinary application for registration if the registration on which an extension of goods or services application is dependent becomes expunged or cancelled.

If the applicant requests this change, a revised application must be filed, deleting reference to the registration on which the extension application was based.

### **2.6.2 Affidavit of continuous use**

For trademarks previously registered pursuant to subsection 12(2) of the Trademarks Act, section 29 of the Unfair Competition Act or Rule 10 of the Trade Mark and Design Act, where the registration of the trademark which is the subject of an application to extend the goods or services is contrary to either paragraphs 12(1)(a) or (b), the Registrar does not require a showing of acquired distinctiveness pursuant to subsection 32(1) if the goods or services in respect of the application to extend are in the same class as the goods or services covered by the registration. In such a case, the Office accepts an affidavit of continuous use.

The evidence must establish that use of the trademark has been continuous in association with the goods or services originally registered, from the date of the initial evidence establishing secondary meaning until the date of application to extend. The evidence should also show use of the trademark in respect of the extended goods or services prior to the date of application to extend.

## **2.7 Divisional applications**

### **2.7.1 Definitions**

An original application is an application for the registration of a trademark which has been limited under subsection 39(1) of the Trademarks Act for the purpose of filing a divisional application.

A divisional application is an application for the registration of a trademark which covers some or all of the goods or services which were limited from an original application. A divisional application can also be divided, whereupon it becomes an original application for the divisional application derived from it.

### **2.7.2 Why divide an application?**

An applicant may choose to file a divisional application for reasons which include, but are not limited to, the following:

- if a confusion objection is raised in respect of particular goods or services of an application, the applicant may decide to divide out those goods or services so that portion of the application can proceed to advertisement;
- if a clearly descriptive objection has been raised or maintained in relation to some of the goods or services of the application, the applicant may wish to divide out the impugned goods or services so that the original application can proceed to advertisement; or
- if an opposition is filed against an application, the applicant may divide out some of the goods or services to allow the original application to proceed to registration.

### **2.7.3 Filing a divisional application prior to advertisement**

Under section 39 of the Trademarks Act, an applicant may limit an application to one or more of the goods or services that were within its scope and file a divisional application for the registration of the same trademark. An applicant may also divide a divisional application, in which case section 39 of the Act applies as if that divisional application were an original application.

A divisional application may only be filed if the original application is active (i.e. not abandoned, refused, or registered).

When filing a divisional application, the applicant must reference the application number of the original application, if known, and clearly indicate that it is a divisional application.

The scope of the goods or services that can be divided will depend on where the application is in the registration process. If the original application has not been advertised at the date the divisional application is filed, the goods or services that can be divided must be within the scope of the original application on its filing date (without taking into account a claim to priority). If the original application has been advertised, the goods or services that can be divided must be within the scope of the original application on the day on which the divisional application is filed.

A divisional application is considered a separate application, including with respect to the payment of any fees. However, if the prescribed filing fees have been paid on the original application, they are considered to have been paid on any divisional application. The end result, then, is that no additional application fee is due on a divisional application. As well, the divisional application's filing date is deemed to be the original application's filing date. The Registrar will send the applicant a notice to confirm the creation of the divisional application and provide the new application number.

**Note:** The prescribed application fee is adjusted every year on the first of January. The amount for the first class of goods or services depends on the date on which the payment is received by the Registrar. Similarly, the amount for any additional Nice classes also depends on the date on which the payment is received, even if the prescribed fee for the first class of goods or services to which the application relates was paid prior to the annual adjustment. To find out the exact amount of a fee, please consult the [list of fees for trademarks](#).

## **2.7.4 Steps deemed to have been taken**

Subject to the exceptions listed in section 40 of the Trademarks Regulations, any action taken in respect of the corresponding original application or original Protocol application, up to and including the day on which the divisional application is filed, is deemed to be an action taken in respect of the divisional application.

### Example 1

If an examiner's report has issued on the original application before a divisional application was filed, the deadline to respond to the report will also apply to the divisional application and the Office will not re-issue a new examiner's report.

### Example 2

If a transfer has been requested on the original application before a divisional application was filed, but could not be processed due to missing information, the transfer will be deemed to have been requested on the divisional application. Once the missing information has been provided, the request will be processed on both the original and divisional applications. Please note that the prescribed fee for the recording of the transfer will have to be paid on each divisional application (to find out the exact amount of the fee, please consult the [list of fees for trademarks](#)).

## **2.7.5 Filing a divisional application after advertisement**

An application may also be divided any time after advertisement but before registration so long as the goods and services divided out are within the scope of the original application on the day on which the divisional application is filed (see paragraph 39(1)(b) of the Act). Please refer to the Practice Notice published by the Trademarks Opposition Board entitled "Divisional Applications in Opposition" for more information on dividing an application after the application has been opposed.

## **2.7.6 Applications filed prior to June 17, 2019**

Applications filed prior to the coming-into-force of the amended Trademarks Act can be divided. For more information on the prescribed registration fee, please refer to the “Guide to Transitional Provisions of Bill C-31”.

### **2.7.7 Mergers**

Under paragraph 41(1)(f) of the Trademarks Act, if a trademark that is the subject of an application that has been previously divided proceeds to registration, it may be merged with other registrations of the trademark that stem from the same original application and where the trademarks are the same and have the same registered owner.

### **2.7.8 Dividing an application to extend the statement of goods or services**

Applications filed under subsection 41(2) of the Act to extend the statement of goods or services in respect of which a trademark is registered may be divided. However, upon registration, the divisional application will be merged automatically with the original registration it was intended to extend and not the original application it was divided from.

In the case of an application in respect of a registered trademark that is a word mark or a distinguishing guise, the divisional application should, at the time of filing, include a statement under paragraph 31(b) of the Act to the effect that the applicant wishes the trademark to be registered in standard characters or paragraph 31(e) of the Regulations that the trademark consists in whole or in part a three-dimensional shape or mode of packaging goods, as applicable. Consideration should be given to paragraph 35(2)(e) of the Regulations since it will only be permissible to add or delete these statements if the application has not been advertised and the trademark remains substantially the same.

Moreover, when a divisional application which stems from an original application to extend the statement of goods or services proceeds to registration and is merged automatically, the Office will change the “type” of the registered trademark to a standard character, a three-dimensional shape or a mode of packaging goods, as applicable.

### **2.7.9 Pending assignment**

Should there be a pending transfer of any of the registrations that stem from the same original application, the request to merge will only be processed once the transfer is registered to ensure that all registrations are in the name of the same registered owner.

## **2.8 Amendments to an application**

### **2.8.1 Changing the identity of the applicant**

Where a trademark application incorrectly identifies the applicant's name, the applicant may, if the situation meets the exception listed in paragraph 35(2)(a) of the Trademarks Regulations, request a correction to the error. The following are examples of the most common errors made when identifying the applicant:

1. The application identifies the applicant as "ABC Limited" instead of "ABC Inc.," or vice versa; "XYZ of Canada Ltd." instead of "XYZ Ltd.," or vice versa. The office will accept the change of the entity description
2. The application is filed in the old name of the applicant when a change of name occurred prior to the filing date of the application. The Office will accept this correction upon receipt of correspondence setting out the details of the error and a revised application which correctly identifies the applicant. This situation is not contrary to paragraph 35(2)(a) of the Regulations as the actual "identity" of the applicant has not changed.

**Note:** The Office will amend an application to reflect a *change of name* of the applicant upon receipt of a written request; no fee is required. As a general rule, there is no requirement to provide the Office with evidence of a change of name. If the name change is a result of a merger, amalgamation or a change in corporate status, the Office will require some evidence that details the circumstances in which the name changed. Non-notarized extracts of corporate registers or copies of the certificate of merger/amalgamation will suffice as evidence of the change in corporate status or a change of name resulting of a merger/amalgamation.

3. When an application identifies an applicant that does not have a legal entity descriptor, the Office will accept a request to correct the applicant's identity to add one (e.g. from "Farm Foods" to "Farm Foods Ltd." or to "Mary Smith trading as Farm Foods").

## **2.8.2 Changing the representation or description of the trademark**

Pursuant to paragraph 35(2)(b) of the Trademarks Regulations, an application may not be amended to change the representation or description of the trademark, unless the application has not been advertised and the trademark remains substantially the same.

## **2.8.3 Amendments to goods or services**

Subject to the exceptions listed in paragraph 35(2)(c) of the Trademarks Regulations, an application may be amended to change the statement of goods or services. An application may not be amended to broaden the scope of the statement of goods or services beyond the scope of

- a. that statement on the filing date (determined without taking into account any claim to priority) of the application; and
- b. the narrower of that statement as advertised and that statement as amended after advertisement.

## **2.8.4 Adding a divisional application indication**

When filing a divisional application, the applicant must reference the number of the original application, if known, and clearly indicate that it is a divisional application. Moreover, pursuant to paragraph 35(2)(d) of the Trademarks Regulations, an application may not be amended to add an indication that it is a divisional application.

## **2.8.5 Adding or deleting certain statements**

In view of paragraph 35(2)(e) of the Trademarks Regulations, an application must not be amended to add or delete a statement referred to in paragraph 31(b) of the Act or paragraph 31(e), (f) or (g) of the Regulations, unless the application has not been advertised and the trademark remains substantially the same.

Paragraph 31(b) of the Act requires an applicant to include in their application a statement to the effect that they wish the trademark to be registered in standard characters.

Paragraph 31(e) of the Regulations requires an applicant to include in their application, if the trademark consists in whole or in part of a three-dimensional shape, a hologram, a moving image, a mode of packaging goods, a sound, a scent, a taste, a texture or the positioning of a sign, a statement to that effect.

Paragraph 31(f) of the Regulations requires an applicant to include in their application, if colour is claimed as a feature of the trademark, a statement to that effect, along with the name of each colour claimed and an indication of the principal parts of the trademark that are in that colour.

Paragraph 31(g) of the Regulations requires an applicant to include in their application, if the trademark consists exclusively of a single colour or a combination of colours without delineated contours, a statement to that effect, along with the name of each colour.

## **2.8.6 Amending an application to/from a certification mark**

In view of paragraph 35(2)(f) of the Trademarks Regulations, an application for a regular trademark may be converted to an application for a certification mark (or vice versa) by adding or deleting the statement referred to in paragraph 31(h) of the Regulations, but only prior to the application being advertised.

This is consistent with the decision of *Mister Transmission (International) Ltd. v. Registrar of Trade Marks* (1978), 42 C.P.R. (2d) 123 (F.C.T.D.), at 126-127:

While the registered mark and the certification mark are used for quite different purposes, the first for the purpose of distinguishing the services of the owner of the mark from services performed by others, and the other for the purpose of distinguishing services of the defined standard from services that are not of such a defined standard and they are thus marks of different categories or types, both are included in the definition of “trade mark” in s. 2 of the Act and there is nothing in the Act, as there was in para. 28(1)(b) 3 of the Unfair Competition Act, 1932 (Can.), c. 38 and also R.S.C. 1952, c. 274, which prohibits a person from owning registered marks of both types so long as he complies with s-s. 23(1) and is not engaged in the performance of services of the kind in association with which the certification mark is used. If he is not so engaged, the fact he is on the register as being the owner by assignment of a registered trade

mark with which the certification mark is confusing appears to me to be irrelevant to his right to registration of the certification mark.

And at 129:

Subsection 23(2) appears to remedy this by providing that use by a licensee of the owner shall be deemed to be use by the owner. But plainly, such use is not deemed to be equivalent to engaging in the manufacture, sale, leasing or hiring of wares or the performance of services. If it were, the owner would be disqualified by s-s. 23(1), with the result that no one could ever qualify to register a certification mark.

And further, at 129-130:

But, in my opinion, it does not follow that, because a trade mark is used by a registered user and because, for the purposes of the Act, that use has the same effect as use by the registered owner, the registered owner must be deemed to be engaged in the manufacture, sale, leasing or hiring of the wares or the performance of the services in association with which the trade mark is used.

## 3 Search / Confusion

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### 3.1 Purpose of the search

In addition to ensuring that an application complies with the formal provisions of the Trademarks Act and Regulations, examiners also play a role in protecting the rights of other owners and their trademarks. This is accomplished by reviewing the results of a trademark search. The purpose of the search is to determine whether the trademark:

- a. is not entitled to registration under paragraph 37(1)(c) of the Act because it is confusing with a trademark which is the subject of a pending application;
- b. is confusing pursuant to paragraph 12(1)(d) of the Act with a trademark which is registered;
- c. is not registrable in view of paragraph 12(1)(e) because it consists of, or so nearly resembles as to be likely to be mistaken for, a mark which is protected under section 9 of the Act;
- d. is a denomination the adoption of which is prohibited by section 10.1 (see paragraph 12(1)(f)); or
- e. is in whole or in part a protected geographical indication and the application covers wines or spirits not originating in a territory indicated by the geographical indication, or agricultural products or foods belonging to the same category as the agricultural product or food identified by the geographical indication and not originating in a territory indicated by the geographical indication (see paragraphs 12(1)(g), (h) and (h.1)).

If the trademark is confusing with a trademark which is the subject of a pending application, examiners must determine who is entitled to registration and raise an objection on the application of the non-entitled person.

If the trademark is confusing with a registered trademark, an objection must be raised pursuant to paragraph 12(1)(d) of the Act.

If the trademark consists of, or so nearly resembles as to be likely to be mistaken for, a prohibited mark, an objection must be raised pursuant to paragraph 12(1)(e) of the Act.

If the trademark consists of a plant variety denomination, or so nearly resembles a plant variety denomination as to be likely to be mistaken therefore, and the application covers the plant variety or another plant variety of the same species, an objection must be raised pursuant to paragraph 12(1)(f) of the Act.

If the trademark is in whole or in part a protected geographical indication and the application covers wines or spirits not originating in a territory indicated by the geographical indication, or the application covers agricultural products or foods belonging to the same category as the agricultural product or food identified by the geographical indication and not originating in a territory indicated by the geographical indication, an objection must be raised pursuant to paragraph 12(1)(g), (h) or (h.1) of the Act, as applicable.

Note: The Registrar of Trademarks keeps a list of protected geographical indications and, in the case of geographical indications identifying an agricultural product or food, translations of those indications, in accordance with subsection 11.12(1) of the Act.

The search is a key process in the examination of a trademark application. Keeping in mind that registration of a trademark gives an owner an exclusive right to use of that trademark in Canada in respect of the goods or services in association with which it is registered, examiners must be consistent in the manner of consulting the search results.

## **3.2 Definition of confusion — subsection 6(2)**

Subsection 6(2) of the Trademarks Act describes the manner and circumstances in which one trademark would cause confusion with another:

The use of a trademark causes confusion with another trademark if the use of both trademarks in the same area would be likely to lead to the inference that the goods or services associated with those trademarks are manufactured, sold, leased, hired or performed by the same person, whether or not the goods or services are of the same general class or appear in the same class of the Nice Classification.

In deciding the question of confusion, Ritchie J. set forth the following criteria in *Rowntree Co. Ltd. v. Paulin Chambers Co. Ltd.* (1967), 54 C.P.R. 43 at page 47:

It is enough, in my view, if the words used in the registered and unregistered trade marks are likely to suggest the idea that the wares with which they are associated were produced or marketed by the same person.

In *Benson & Hedges (Canada) Ltd. v. St-Regis Tobacco Corp.* (1968), 57 C.P.R. 1 at page 4, Ritchie J., after reviewing subsection 6(2) stated:

I have italicized the words “would be likely to lead to the inference” as it appears to me to be clear that in opposing an application for registration, the holder of a trade mark which is already registered is not required to show that the “mark” which is the subject of the application is the same or nearly the same as the registered mark, it being enough if it be shown that the use of this

mark would be likely to lead to the inference that the wares associated with it and those associated with the registered trade mark were produced by the same company.

In other words, the issue is not confusion between the trademarks themselves, but confusion as to the source of the associated goods or services.

### **3.2.1 Surrounding circumstances – subsection 6(5)**

In determining the likelihood of confusion, examiners must consider all the surrounding circumstances, including the following as listed in subsection 6(5) of the Act:

- a. the inherent distinctiveness of the trademarks and the extent to which they have become known;
- b. the length of time the trademarks have been in use;
- c. the nature of the goods, services or business;
- d. the nature of the trade; and
- e. the degree of resemblance between the trademarks, including in appearance or sound or in the ideas suggested by them..

In *Haw Par Brothers International Ltd. v. Registrar of Trade Marks* (1979), 48 C.P.R. (2d) 65, Marceau J. stated at page 70:

...[I]n order to determine whether trade marks are confusing within the meaning of the Act, that is, whether their concurrent use is likely to lead a purchaser to believe that the associated products come from the same source, the surrounding circumstances, particularly five major factors, must be taken into account.

In the *Pianotist Case*, reported in (1906) 23 R.P.C. 774, Parker J., after reviewing the surrounding circumstances which had been the subject of judicial consideration on many occasions, stated at page 777:

You must take the two words. You must judge of them, both by their look and by their sound. You must consider the goods to which they are to be applied. You must consider the nature and kind of customer who would be likely to buy those wares. In fact, you must consider all the surrounding circumstances; and you must further consider what is likely to happen if each of those trade marks is used in a normal way as a trade mark for the goods of the respective owners of the marks.

In *Ortho Pharmaceutical Corp. v. Mowatt & Moore Ltd.* (1972), 6 C.P.R. (2d) 161 (F.C.T.D.), wherein Heald J. discussed the “surrounding circumstances” at page 166:

Section 6(5) requires the Court, in determining whether the trade marks are confusing, to consider the particular matter listed in paras. (a), (b), (c), (d) and (e) thereof and also “all the surrounding circumstances”.

An additional “surrounding circumstance” which, in my view I am entitled to consider, is the fact that both of the subject marks have in them an element common to the trade — that is — they both have in them the terminal letters “pak”.

The factors listed in subsection 6(5) are not exhaustive, and do not necessarily receive equal weight. See *Bally Schufabriken A.G./Bally's Shoe Factory Limited v. Big Blue Jeans Limited Ltd./Ltée* (1992), 41 C.P.R. (3d) 205 at 210 (F.C.T.D.) as well as the comments by Rouleau J. in *Leaf Confections Ltd. v. Maple Leaf Gardens Ltd.*, (1986), 12 C.P.R. (3d) 511 (F.C.T.D.), affirmed (1988), 19 C.P.R. (3d) 331 (F.C.A.):

Nevertheless, it is clear in considering the elements of s-s. 6(5) of the Trade Marks Act, R.S.C. 1970, c. T-10, each element need not be interpreted as having equal weight. A particular case might justify greater significance being given to one criterion over others. As previously stated, I find the respondent's mark and design to be a strong one, well-known throughout Canada. In such cases the courts have held that the distinction between the wares and the nature of the trade of the two competing marks becomes less important.

### ***3.2.1.1 Paragraph 6(5)(a) — Inherent distinctiveness and extent to which trademark has become known***

#### *3.2.1.1.1. Inherent distinctiveness*

A trademark which is coined, arbitrary, unique, and not descriptive of the associated goods or services are generally considered inherently distinctive. Case law regarding confusion has asserted that the higher the inherent distinctiveness of a trademark, the larger the scope of protection that should be afforded to that trademark.

For example, a trademark such as KODAK, which is a purely arbitrary word in association with photographic film, possesses more inherent distinctiveness than a trademark such as CORTI-VET in association with a veterinary preparation containing cortisone. In other words, the quality of inherent distinctiveness is easily attributed to the trademark KODAK because, unlike CORTI-VET, KODAK has no suggestive or descriptive properties, nor does it suggest any other relation to the goods associated with it, namely photographic film or photographic equipment.

When it comes to comparing trademarks, examiners are directed to the following from H.G. Fox, *Fox on Canadian Law of Trade-marks and Unfair Competition*, Fourth Edition, Chapter 8:

If the words are distinctive, in the sense of being invented words, small differences will not be sufficient to distinguish them, whereas if the words are common or descriptive in meaning, they must be taken with their disadvantages. No person is entitled to fence in the common of the English language and words of a general nature cannot be appropriated over a wide area.

The ambit of protection that should be afforded to a common word was discussed in the decision of *General Motors Corp. v. Bellows*. At the trial level, (1947), 7 C.P.R. 1 at page 8, Cameron J. made the following comments:

In considering whether marks are similar, consideration ought to be given to the nature of the words themselves, and a distinction drawn between a fancy or invented word and an ordinary word in everyday use. In the case of a purely invented word, the scope is very much wider than that of an ordinary word.

On appeal to the Supreme Court of Canada, (1949), 10 C.P.R. 101 at page 115, Rand J. stated the following:

Mr. Fox submitted this basic consideration: that where a party has reached inside the common trade vocabulary for a word mark and seeks to prevent competitors from doing the same thing, the range of protection to be given him should be more limited than in the case of an invented or unique or non-descriptive word; and he has strong judicial support for that proposition: *Office Cleaning Services Ltd v. Westminster Window & Gen'l Cleaners Ltd.* (1944), 61 R.P.C. 133 at page 135; (1946), 63 R.P.C. 39; *Br. Vacuum Cleaner Co. v. New Vacuum Cleaner Co.*, [1907] 2 Ch. 312 at page 321; *Aerators Ltd. v. Tollitt*, [1902] 2 Ch. 319.

#### *3.2.1.1.2. Extent to which a trademark has become known*

Examiners are limited in their ability to make judgments about the extent to which a trademark has become known in Canada. Generally, where a trademark has become well-known as the distinguishing sign of a particular person, it should be given a wider ambit of protection than one that has not been used or known to the Canadian public.

#### *3.2.1.2 Paragraph 6(5)(b) – Length of time used*

Examiners are also limited in their ability to make judgments about the length of time trademarks have been in use. However, it is generally accepted that a trademark which has seen substantial use over a long period of time deserves more protection than a trademark which has seen less use over a short period of time and therefore has been known to a lesser extent.

In *United Artists Corp. v. Pink Panther Beauty Corp.* (1998), 80 C.P.R. (3d) 247 at 259-60 (F.C.A.), the Court articulated this criterion in the test of confusion:

The length of time that a mark has been used is obviously a factor which will contribute to confusion on behalf of the consumer in determining the origin of wares or services. A mark that has been in use a long time, versus one newly arrived on the scene, is presumed to have made a certain impression which must be given some weight.

Likewise, in *Advance Magazine Publishers Inc. v. Masco Building Products Corp.*(1999), 86 C.P.R. (3d) 207 at p.219, the Federal Court found that longstanding prior use of the senior trademark is an important consideration:

In my view, the Chairman of the Opposition Board erred in saying that the use by the respondent of the mark VOGUE in association with door locks and lock hardware could not result in a likelihood of confusion with the well known appellant's trade mark in the mind of the average consumer. The Opposition Board "seems to have ignored the fact that the respondent was a newcomer entering a field extensively occupied by the appellant and borrowing in so doing the whole of a name already well-established in that very field by the appellant". As stated by Mr. Justice Décarý in *Miss Universe* at page 626:

It was the duty of the respondent to select a name with care so as to avoid any confusion — as is required under the definition of "proposed trade-mark" in section 2 of the Act — and so as to avoid the appearance that he intended to jump on the bandwagon of an already famous mark.

Where both trademarks have been used for a long time in the same area without evidence of confusion, it is arguable that confusion would be unlikely to occur in the future, thus allowing for the registration of both trademarks. However, in *Mr. Submarine Ltd. v. Amandista Investments Ltd.* (1987), 19 C.P.R. (3d)

3, the Court found that the defendant's marks MR. SUBS'N PIZZA and MR. 29 MIN. SUBS'N PIZZA were confusing with the trademark MR. SUBMARINE although there was no evidence of actual confusion despite ten years of concurrent use in the same area.

### ***3.2.1.3 Paragraph 6(5)(c) – Nature of goods or services***

When making a decision concerning the issue of confusion, examiners must consider the nature of the goods or services associated with the trademarks. Therefore, examiners must clearly understand the description of goods or services as it appears in the applications or registrations.

In general, the greater the similarity in the goods or services of two trademarks, the greater the likelihood of confusion. While differences in goods or services may not always be the main consideration in a determination of confusion, they always remain an important consideration. As the Federal Court of Appeal stated in *Reynolds Presto Products Inc. v. P.R.S. Mediterranean Ltd.*, 2013 FCA 119:

There is a greater likelihood of confusion if two trade-marks that resemble each other are used in association with the same products (or substantially the same products) in the same markets. As a result, the resemblance of the two trade-marks should not be viewed in isolation but rather in conjunction with the nature of the wares and the nature of the trade.

### ***3.2.1.4 Paragraph 6(5)(d) – Nature of the trade***

Similar to the nature of the goods or services themselves is the consideration of the nature of the trade in which those goods or services circulate. The risk of confusion is greater where the goods or services, even if they are dissimilar, are distributed or provided in the same types of stores or venues.

The nature of the trade extends the consideration of the type of trading environment as well. This relates both to the environment and to the nature of the consumer. For example, examiners must take into account situations in which the goods of one owner is traded on a wholesale level and the other through retail outlets because a professional consumer purchasing at the wholesale level is less likely to be confused than a casual shopper in a retail setting.

However, examiners must not only consider whether the respective trademark owners sell their goods in the same channels, but also whether they are entitled to do so. In *Eminence S.A. v. Registrar of Trade Marks* (1977), 39 C.P.R. (2d) 40 at page 43, Dubé J. stated:

Even if Fabergé does not sell its products in the same places as appellant, it is legally entitled to do so. It matters little that at the present time Fabergé's wares are sold in hairdressing salons rather than in drug stores.

### ***3.2.1.5 Paragraph 6(5)(e) – Degree of resemblance between the trademarks***

In most cases, it is the degree of resemblance between the trademarks in appearance, sound or in the ideas suggested by them that is the dominant factor in assessing a likelihood of confusion. If the trademarks do not resemble one another, it is unlikely that a finding on the remaining factors would lead to a likelihood of confusion: the other factors become significant only if the trademarks are found to be identical or very similar.

The Supreme Court of Canada in *Masterpiece Inc. v. Alavida Lifestyles Inc.*, (2011), 92 C.P.R. (4th) 361 held that the word ‘resemblance’ in the Act refers to “the quality of being either like or similar” and that the phrase ‘degree of resemblance’ implies that trademarks having some differences may still result in confusion.

When assessing confusion between trademarks, the first word or first syllable in a trademark is generally the most important for the purpose of confusion. In *Conde Nast Publications Inc. v. Union des Editions Modernes* (1979), 46 C.P.R. (2d) 183, Cattanach J. stated at page 188:

It [respondent] has appropriated the appellant's mark in its entirety and added thereto as a suffix the words “age tendre”. It is axiomatic that the first word or the first syllable in a trade mark is far the more important for the purpose of distinction. Here the first and most important word in the mark which the respondent seeks to register is identical to the mark registered by the appellant.

However, the first portion may not always be the most important, since it is the distinguishing feature and idea of each mark that must be considered. In the Supreme Court of Canada decision of *Masterpiece Inc. v. Alavida Lifestyles Inc.* (2011) 92 C.P.R. (4th) 361 (S.C.C), Rothstein J. commented as follows in para. 64-65 of the decision:

While the first word may, for purposes of distinctiveness, be the most important in some cases, I think a preferable approach is to first consider whether there is an aspect of the trade-mark that is particularly striking or unique. Here there is nothing striking or unique about the word “Living” or the words “the Art of Living”. “Masterpiece” is the word that distinguishes Alavida and Masterpiece Inc. from other sources of retirement residence services. It is a reasonable conclusion that “Masterpiece” is the dominant word in these trade-marks, and it is obviously identical as between Alavida and Masterpiece Inc. By the same token, in the context of the retirement residence industry, the idea evoked by the word “Masterpiece”, high quality retirement lifestyle, is the same for both Alavida and Masterpiece Inc.

Finally, the word “Living” is identical as between the Alavida and Masterpiece Inc. trade-marks. Given these striking similarities, it is, in my respectful view, very difficult not to find a strong resemblance as a whole between the two, Masterpiece Inc.’s trade-marks and Alavida’s trade-mark.

When considering confusion between a word mark and a mark comprised of words shown in a special font or stylized format, it is not a proper approach to conclude that the differences in the appearance of the words will eliminate the likelihood of confusion. In the decision of *Masterpiece Inc. v. Alavida Lifestyles Inc.* (2011) 92 C.P.R. (4th) 361 (S.C.C), the Supreme Court of Canada affirmed that the way a word mark is presented may not eliminate the likelihood of confusion since a mark registered as words may be used in any design format, including that similar to the applicant’s mark. Rothstein J. commented as follows in para. 58-59 of the decision:

The problem with an analysis which takes into account limited use becomes apparent by observing that the bare words “Masterpiece Living” could be presented in many ways under the registration. Nothing would prevent Alavida from altering its advertising to highlight the word “Masterpiece” and give the word “Living” less prominence, just as Masterpiece Inc. had done, or from changing the font or style of lettering that it had used. For this reason, it was incorrect in law to limit consideration to Alavida’s post-application use of its trade-mark to find a reduced likelihood of confusion. Actual use is not irrelevant, but it should not be considered to the

exclusion of potential uses within the registration. For example, a subsequent use that is within the scope of a registration, and is the same or very similar to an existing mark will show how that registered mark may be used in a way that is confusing with an existing mark.

## 3.3 Test of confusion

Examiners must put themselves in the position of an ordinary purchaser and ask whether a person with imperfect recollection would be likely to infer that the goods or services associated with the applicant's trademark and those associated with another trademark are manufactured, sold, leased or hired by the same person.

### 3.3.1 The relevant consumer

In *Mattel Inc. v. 3894207 Canada Inc.*, 2006 S.C.C. 22, the Supreme Court explained the proper approach to the issue of the relevant consumer:

What, then, is the perspective from which the likelihood of a “mistaken inference” is to be measured? It is not that of the careful and diligent purchaser. Nor, on the other hand, is it the “moron in a hurry” so beloved by elements of the passing-off bar: *Morning Star Co-Operative Society Ltd. v. Express Newspapers Ltd.*, [1979] F.S.R. 113 (Eng. Ch. Divat p. 117. It is rather a mythical consumer who stands somewhere in between, dubbed in a 1927 Ontario decision of Meredith C.J. as the “ordinary hurried purchasers”: *Klotz v. Corson* (1927), 33 O.W.N. 12 (Ont. H.C.), at p. 13. See also *Barsalou v. Darling* (1882), 9 S.C.R. 677 (S.C.C.), at p. 693. In *Aliments Delisle Ltée/Delisle Foods Ltd. v. Anna Beth Holdings Ltd.* (1992), 45 C.P.R. (3d) 535 (T.M. Opp. Bd.), the Registrar stated at p. 538:

When assessing the issue of confusion, the trade marks at issue must be considered from the point of view of the average hurried consumer having an imperfect recollection of the opponent’s mark who might encounter the trade mark of the applicant in association with the applicant’s wares in the marketplace.

And see *American Cyanamid Co. Record Chemical Co.*, [1972] F.C. 1271 (Fed, T.D.), at p. 1276, *aff’d* (1973), 14 C.P.R. (2d) 127 (Fed. C.A.). As Cattnach J. explained in *Canadian Schenley Distilleries*, at p. 5:

That does not mean a rash, careless or unobservant purchaser on the one hand, nor on the other does it mean a person of higher education, one possessed of expert qualifications. It is the probability of the average person endowed with average intelligence acting with ordinary caution being deceived that is the criterion and to measure that probability of confusion. The Registrar of Trade Marks or the Judge must assess the normal attitudes and reactions of such persons.

Having repeated that, I fully agree with Linden J.A. in *Pink Panther* that in assessing the likelihood of confusion in the marketplace “we owe the average consumer a certain amount of

credit” (para. 54). A similar idea was expressed in *Michelin & Cie v. Astro Tire & Rubber Co. of Canada* (1982), 69 C.P.R. (2d) 260 (Fed. T.D.), at p. 263:

... one must not proceed on the assumption that the prospective customers or members of the public generally are completely devoid of intelligence or of normal powers of recollection or are totally unaware or uninformed as to what goes on around them.”

Examiners must remember that even sophisticated consumers of expensive items are not immune to confusion and cannot be credited with total recall. See, for example: *System Development Corp. v. Acorn Computers Ltd.* (1986), 11 C.P.R.(3d) 401 (T.M.O.B); *Nelmetal Ltd. v. Personal Software Inc.* (now *Visicorp*) (No. 2) (1986), 12 C.P.R.(3d) 496; *Telesoft v. Taurus Computer Products Inc.* (1987), 18 C.P.R.(3d) 120 (T.M.O.B); *MicroAge Computer Stores, Inc. v. North American Microtech Inc.* (1988), 19 C.P.R.(3d) 289 (T.M.O.B); *Mitac Inc. v. Mita Industrial Co.*(1992), 40 C.P.R.(3d) 387 (F.C.T.D.).

### **3.3.2 First impression and imperfect recollection**

In *Veuve Clicquot Ponsardin c. Boutiques Cliquot Ltée*, 2006 SCC 23, [2006] 1 S.C.R. 824 (S.C.C.), Binnie J. explained the test of confusion in the following words:

The test to be applied is a matter of first impression in the mind of a casual consumer somewhat in a hurry who sees the [trademark] at a time when he or she has no more than an imperfect recollection of the [prior] trademarks, and does not pause to give the matter any detailed consideration or scrutiny, nor to examine closely the similarities and differences between the trademarks.

### **3.3.3 Likelihood vs. possibility**

It is also important to remember that the test is one of likelihood, not one of possibility. See *Veuve Clicquot Ponsardin v. Boutiques Cliquot*, 2006 SCC 23, at paragraph 37; *Mattel U.S.A. Inc. v. 3894207 Canada Inc.*, 2006 SCC 22 (S.C.C.), (2005), 38 C.P.R. (4th) 214 (F.C.A.); *Carling O’Keefe Breweries of Canada Ltd. v. Anheuser-Busch Inc.* (1986), 10 C.P.R. (3d) 433 (Fed. C.A.).

### **3.3.4 Both official languages**

Examiners must determine whether there is a likelihood of confusion with either English or French speaking consumers as well as whether the average bilingual consumer would also likely be confused. If there is a likelihood of confusion amongst any of these linguistic groups there is a likelihood of confusion. See *Choice Hotels International Inc. v. Hotels Confortel Inc.* (1996), 67 C.P.R. (3d) 340 (F.C.T.D.) and *SmithKline Beecham Corp. v. Pierre Fabre Médicament* (2001), 11 C.P.R. (4th) 1 (F.C.A.).

### **3.3.5 Trademarks in their totality**

Where the trademark(s) being considered are composite marks, it is the totality of the trademarks which must be considered. In *Battle Pharmaceuticals v. The British Drug Houses Ltd.*, (1944) Ex. C.R. 239, Thorson J. said at page 60:

It is the combination of the elements that constitutes the trade mark and gives distinctiveness to it, and it is the effect of the trade mark as a whole, rather than of any particular element in it, that must be considered.

### **3.3.6 Evidence in the Form of a Letter of Consent Supporting No Likelihood of Confusion**

It is not a requirement to submit evidence in the form of a letter of consent when an application is being examined to show that the applicant's trademark is not likely to cause confusion with another trademark. However, applicants are permitted to submit letters of consent, or consent agreements, containing information about surrounding circumstances which could establish that there is no likelihood of confusion. This information should shed new light on the test of confusion as described under subsection 6(5) of the Trade-marks Act.

To illustrate, if an applicant submits a letter of consent, or consent agreement, the following information may be relevant:

1. The parties have operated their businesses in different areas;
2. The trademark for which the registration is in question (the pending application) had acquired distinctiveness and a reputation in Canada, as it was frequently and continuously used in Canada for a number of years;
3. There is no real confusion between the trademarks in question during their cohabitation period (coexistence), and
4. if coexistence abroad is mentioned, the following factors pertaining to the foreign jurisdiction are considered relevant to determine if there is a likelihood of confusion:
  - a. the market condition;
  - b. the channels of trade used by the trademark owners;
  - c. the type of goods and services offered;
  - d. the legal test applicable to establish likelihood of confusion; and
  - e. the existence of any mechanism to facilitate the reporting of cases of confusion.

### **3.3.7 Doubt as to confusion**

Where examiners are in doubt as to whether the applicant's trademark is likely to cause confusion with another trademark, they shall cause the application to be advertised in the manner prescribed. If the other

trademark is registered, pursuant to subsection 37(3) of the Trademarks Act, the owner of the registered trademark shall be notified, by registered letter, of the advertisement of the application.

## **3.4 Searching**

A complete search must include a search of pending, registered, abandoned and refused trademarks under the Trade Marks and Design Act, the Unfair Competition Act, the Trademarks Act and the Newfoundland Register. A search of the refused and abandoned trademarks is made to be aware of past decisions or research which has been compiled and which might apply to the case at hand.

The names of applicants and registered owners are useful to examiners, particularly in cases where the applicant is also the owner of previously registered trademarks which would otherwise be found confusing. See section 15 of the Trademarks Act.

The list of geographical indications is also searched when the application covers such goods.

Subject matter protected pursuant to Article 6ter of the Paris Convention must be reviewed when searching trademarks comprising flags, coats of arms, emblems and the like. See paragraph 9(1)(i) of the Trademarks Act and section [4.7.5 Paragraphs 9\(1\)\(i\) and 9\(1\)\(i.1\)](#) of this Manual.

## **3.5 Discovering a confusing trademark**

### **3.5.1 Confusion with a registered trademark – Paragraph 12(1)(d)**

If the trademark is confusing with a registered trademark, examiners must raise an objection under paragraph 12(1)(d) of the Trademarks Act. Subsection 37(2) of the Act requires the Registrar to notify the applicant regarding the reasons for the objection and the applicant must be given an opportunity to respond. If the examiner remains of the opinion that the trademark is confusing with the registered trademark, the application may be refused pursuant to subsection 37(1) of the Trademarks Act.

The applicant may attempt to overcome a citation of confusion with a registered trademark by either applying to the Federal Court to have the trademark struck from the register pursuant to sections 18 or 57, or by requesting that a notice be sent pursuant to sections 44 or 45 of the Trademarks Act.

### **3.5.2 Confusion with a co-pending application**

If the trademark is confusing with a trademark which is the subject of a pending application, the examiner must determine who is entitled to registration and raise an objection on the application of the non-entitled person.

#### ***3.5.2.1 Persons entitled to registration***

Paragraph 37(1)(c) of the Act specifies that the Registrar shall refuse an application for the registration of a trademark if he is satisfied that the applicant is not the person entitled to registration of the

trademark because it is confusing with another trademark for the registration of which an application is pending.

When trademarks of pending applications are confusing, the applicant with the earlier entitlement date (i.e. filing date or priority filing date) will be the person entitled to registration of the trademark.

#### ***3.5.2.2 Notification of applicants***

When confusion exists between pending trademarks and no other objections or requirements are outstanding, examiners will accept for advertisement the application of the entitled person. At the same time, examiners will notify the non-entitled person of the objection and give the reason for non-entitlement, namely, the earlier filing date or priority filing date of the other application.

Where the non-entitled person's application encounters a co-pending confusing application which is the subject of opposition proceedings, it will not be held in abeyance pending the opposition outcome, and will receive an examiner's report citing the confusing trademark and a period of time in which to reply. See *Anheuser-Busch, Inc. v. Carling O'Keefe Breweries of Canada Ltd.* (1982), 69 C.P.R. (2d) 136. If the non-entitled person wishes to oppose the earlier filed application, requests for extensions of time may be granted pending the completion of the opposition process.

The Registrar will not issue correspondence to applicants informing them of co-pending and confusing applications with a later filing date or priority filing date.

Where the entitled person's application encounters a co-pending confusing application which has been advertised (but not yet registered), subsection 37(4) of the Act gives the Registrar the authority to withdraw the advertisement of the non-entitled application.

#### ***3.5.2.3 Identical entitlement dates***

In cases where two confusing pending applications have the same entitlement date, both applications will be approved for advertisement since it cannot be said that one applicant is entitled to registration over the other.

#### ***3.5.2.4 Active applications***

In view of paragraph 37(1)(c) of the Act, a co-pending confusing application must be active (i.e. not abandoned) in order for a confusion objection to be raised.

### **3.5.3 Same owner – Section 15**

This section provides that “confusing trademarks are registrable if the applicant is the owner of all of the confusing trademarks.” If the applicant is the owner of the other trademarks, examiners will not raise a confusion objection.

Minor variations in the manner in which the owner's name is set out may not necessarily indicate a difference in ownership. Where it is clear that the identity of the owner of the confusing trademarks is the same, the examiner will not cite those trademarks as confusing. For example, ABC Co. Ltd. is considered to be the same owner as ABC Co. Ltd. doing business as XYZ Ventures.

### **3.5.4 Confusion with a certification mark**

Section 24 of the Trademarks Act provides for the registration of a trademark that is confusing with a registered certification mark if the owner of the registered certification mark consents and if the trademark exhibits an “appropriate difference”. The trademark must be used “to indicate that the goods or services in association with which it is used have been manufactured, sold, leased, hired or performed by [the applicant] as one of the persons entitled to use the certification mark.” The Registrar must, however, expunge the registration should the owner of the certification mark withdraw consent, or upon cancellation of the registration of the certification mark. See subsections 23(2) and (3) of the Trademarks Act.

### **3.5.5 Confusion with a Newfoundland registration**

Sections 67 and 68 of the Trademarks Act provide for the protection of trademarks registered under the Laws of Newfoundland before Newfoundland became part of Canada. Newfoundland registrations are not considered registered trademarks on the register required to be maintained under the Trademarks Act. As such, examiners will not raise a 12(1)(d) objection for trademarks considered to be confusing with Newfoundland registrations. Instead, the examiner will draw the applicant's attention to the Newfoundland registration and inform them that the application can proceed upon receipt of confirmation that registration of the trademark will be subject to the provisions of subsection 67(1) of the Act.

Where an application for a trademark is confusing with a Newfoundland registration in respect of only some of the goods or services in the pending application, the applicant may provide confirmation that registration of the trademark will be subject to the provisions of subsection 67(1) of the Act with respect to the goods or services in association with which use of the applicant's trademark would be likely to cause confusion with the Newfoundland registration.

Since trademarks registered pursuant the laws of Newfoundland prior to April 1, 1949 do not form part of the register, the amendment provisions of the Trademarks Act do not apply.

However, since the laws of Newfoundland permitted the owner of a trademark to cancel its entry on the register, the Office will cancel a trademark registered pursuant to the laws of Newfoundland prior to April 1, 1949 upon submission of such a request from the owner of the Newfoundland registration.

Additionally, since the laws of Newfoundland permitted the ownership of a trademark to be transferred, the Office will record a transfer of ownership of a Newfoundland trademark upon submission of acceptable documentation which would allow the Office to record the change in ownership, as well as the fee of \$1 that was required under the laws of Newfoundland.

Where there has not been a transfer of ownership but the name of the owner of the Newfoundland registration has changed over the years, the Office will record the change in name of the owner of the Newfoundland registration upon submission of acceptable documentation that illustrates the successive changes in name from the owner of the Newfoundland registration as shown on the database to the present name of the owner. If the owner is unable to supply the documentation showing the successive name changes, the Office may accept an affidavit or statutory declaration stating the current name of the owner who registered the trademark under the laws of Newfoundland.

# 4 Examination of the trademark

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## 4.1 Purpose of examination

A formal review of the application serves to establish its registrability under the Trademarks Act.

Upon receiving the application, examiners will carefully review its contents, giving particular consideration to the following:

- Is the subject matter a trademark as defined in section 2?
- Is the trademark registrable under section 12?
- If the trademark is not registrable pursuant to paragraph 12(1)(a) or (b), is it registrable on proof of acquired distinctiveness?
- If the trademark is not inherently distinctive, is it registrable on proof of acquired distinctiveness?

## 4.2 Definition of trademark

Section 2 of the Act defines a trademark as meaning:

- a. a sign or combination of signs that is used or proposed to be used by a person for the purpose of distinguishing or so as to distinguish their goods or services from those of others, or
- b. a certification mark

A “sign” includes “a word, a personal name, a design, a letter, a numeral, a colour, a figurative element, a three-dimensional shape, a hologram, a moving image, a mode of packaging goods, a sound, a scent, a taste, a texture and the positioning of a sign”.

## 4.3 Paragraph 12(1)(a) – Names and surnames

Also see the practice notice entitled “Paragraph 12(1)(a) of the Act — Name or Surname”.

Paragraph 12(1)(a) of the Trademarks Act provides that a trademark is registrable if it is not a word that is primarily merely the name or the surname of an individual who is living or who has died within the preceding thirty years.

The statute generally follows the historical principle of common law that all people should be able to identify their goods or services by their names or surnames, providing the name or surname was used honestly and not with the intent of passing off the goods or services as those of another person with the same or a similar name.

Research must be conducted to determine whether a trademark is the name or surname of an individual who is living or has died within the previous thirty years. Once the name or surname has been located, the test to determine its primary meaning must be applied. Examiners must determine what would be the response of the general public in Canada to that word. If they consider that a person in Canada of ordinary intelligence and of ordinary education in English or French would be more likely to respond to the word by thinking of it as a name or surname than as something else, an objection under paragraph 12(1)(a) will be raised. If, on the other hand, the average Canadian would be just as likely or more likely to respond to the word as something other than a name or surname, an objection should not be raised.

Examiners will raise an objection pursuant to paragraph 12(1)(a) despite the surname being pluralized or in the possessive form.

### **4.3.1 Definition of “word”**

The Interpretation Act provides that the singular includes the plural, so that “a word” in paragraph 12(1)(a) includes “words”.

Furthermore, in *Standard Oil Co. v. Registrar of Trade Marks* (1968), 55 C.P.R. 49 at page 58, Jackett P. notes that names are included in the definition of “word”:

For trade mark purposes, there are at least three classes of “words”, viz., dictionary words, names, and invented words. They are all words, in my view, at least for the purposes of the Trade Marks Act.

### **4.3.2 Definition of name or surname**

The Office considers a surname to be the name common to members of a family, and considers a name to be a given name or initials combined with a surname for the purpose of individualizing members of the same family.

### **4.3.3 Merely a name or a surname**

When confronted with a word which might be prohibited under paragraph 12(1)(a), examiners must first review the research results to determine whether the word is merely (i.e., only, nothing more than) a surname. An objection may be raised under paragraph 12(1)(a) if the word is only a name or surname that is not found to have any other significance.

If research shows that the word is a name or surname, but also has another significance, a second inquiry must be commenced.

The other significance may be that the word is coined, that the word has a dictionary meaning, that the word is the name of a geographical place.

In the decision of the Exchequer Court in *Standard Oil Co. v. Registrar of Trade Marks* (1968), 55 C.P.R. 49, Jackett, P., made the following comments at page 58:

As far as the appellant was concerned, therefore, FIOR was a word invented by it for use as its trade mark in this connection. It follows, therefore, that FIOR is not “merely” the surname of a

living person because it also has existence as a word invented by the appellant or persons working for it for trade mark purposes.

And further commented at pages 58-59:

Certainly, from the point of view of the people called “Fior” and their immediate circle of friends and acquaintances, the answer is that FIOR is principally if not exclusively a surname, and, from the point of view of the trade mark advisers of the appellant, the answer is that it is principally, if not merely, an invented word. The test, for the purposes of s. 12(1)(a) is not, in my view, the reaction of either of these classes of persons. The test must be what, in the opinion of the respondent or the Court, as the case may be, would be the response of the general public of Canada to the word. My conclusion is that a person in Canada of ordinary intelligence and of ordinary education in English or French would be just as likely, (if the two characters (surname and invented word) are of equal importance, it cannot be said that it is “primarily merely” a surname), if not more likely, to respond to the word by thinking of it as a brand or mark of some business as to respond to it by thinking of some family of people (that is, by thinking of it as being the surname of one or more individuals). Indeed, I doubt very much whether such a person would respond to the word by thinking of there being an individual having it as a surname at all.

Examiners will not consider that the other significance of the trademark is as a brand of the applicant due to use of the trademark. In this respect, the Trademarks Opposition Board, in *Molson Breweries, a Partnership v. John Labatt Ltd.* (1997) 79 C.P.R. (3d) 512, noted that what is meant by the “also a trademark” in the test for 12(1)(a) is that the trademark would just as likely be seen as a trademark because it is coined, and not because the average consumer would associate the word with a particular source:

Thus, the opponent has met its evidential burden to show that the trade-mark LABATT is the surname of living individuals or those recently deceased. The issue then becomes whether or not the mark LABATT is primarily merely a surname. In this regard, the applicant submitted that, in line with the decision in *Standard Oil Co. v. Registrar of Trade Marks* (1968), 55 C.P.R. 49 (Ex. Ct.), LABATT is not only a surname but also a trade-mark. However, in *Standard Oil*, President Jackett held that FIOR was not only a rare surname but also a coined word that most Canadians would perceive as such. In other words, FIOR had an inherent status as a coined word. In the present case, LABATT has no such status; it is a surname and nothing else. LABATT may well be perceived as a trade-mark by the Canadian public but it is not due to its inherent status as a coined word but rather to its extensive use as a trade-mark. To allow that fact to avoid the prohibition in Section 12(1)(a) of the Act is to render the provisions of Section 12(2) meaningless as they relate to Section 12(1)(a).

#### **4.3.4 Meaning of “primarily”**

When the research results indicate that the word has name or surname significance as well as another significance, examiners must decide what is the primary (i.e. chief, principal, first importance) meaning of the word.

#### **4.3.5 Test to determine primary meaning**

In order to determine the primary meaning of a word, examiners must determine what in their opinion would be the response of the general public of Canada to that word. The primary meaning is not to be determined subjectively, that is, examiners must not base their findings on what they consider to be the primary meaning of the word. Instead, they must ask themselves what would be the response of a person in Canada of ordinary intelligence and of ordinary education in English or French as to the primary meaning of the trademark.

Examiners must then balance the name or surname significance of the word and the other significance of the word found in dictionaries or provided by applicants in their responses. If they believe the name or surname significance overwhelms the other significance in the mind of the hypothetical Canadian, an objection pursuant to paragraph 12(1)(a) must be made to the application. If the examiner believes that the other significance of the word predominates in the mind of the hypothetical Canadian, no objection should be made.

In the event that the surname significance and the other significance of the word are equal when the test is applied, no objection should be raised pursuant to paragraph 12(1)(a).

In *Elder's Beverages (1975) Ltd. v. Registrar of Trade Marks (1979)*, 44 C.P.R. (2d) 59, Mr. Justice Cattanach allowed registration of the trademark ELDER'S, stating at page 63:

In my opinion the two characters of the word “elder”, one as a surname and the other as a dictionary word, are each of substantial significance and therefore it cannot be said that the word is “primarily” a surname.

In the *Standard Oil Co. case*, Jackett, P. found on the evidence that FIOR is “a word that is...the surname of an individual who is living.” It was also established by evidence that FIOR was created by the applicant by combining the first letters of each of the words “fluid iron ore reduction”. FIOR was an invented word and not “merely” a surname. After reviewing the evidence and the law, President Jackett stated at page 59:

My conclusion is that a person in Canada of ordinary intelligence and of ordinary education in English or French would be just as likely, (if the two characters (surname and invented word) are of equal importance, it cannot be said that it is “primarily merely” a surname), if not more likely, to respond to the word by thinking of it as a brand or mark of some business as to respond to it by thinking of some family of people (that is, by thinking of it as being the surname of one or more individuals). Indeed, I doubt very much whether such a person would respond to the word by thinking of there being an individual having it as a surname at all.

In *Registrar of Trade Marks v. Coles Book Stores Ltd. (1972)*, 4 C.P.R. (2d) 1, Mr. Justice Judson of the Supreme Court of Canada approved the test of the hypothetical person in the FIOR case. In the COLES case, Judson J. found that COLES is a surname well-known to the general public in Canada. He also found that the dictionary meaning of the word “cole” and its plural form “coles” are largely obsolete. at page 3, refusing registration, he stated:

My only possible conclusion in this case is that a person in Canada of ordinary intelligence and of ordinary education in English or French would immediately respond to the trade mark “Coles” by thinking of it as a surname and would not be likely to know that “Coles” has a dictionary meaning.

In *Galanos v. Registrar of Trade Marks (1982)*, 69 C.P.R. (2d) 144, Mr. Justice Cattanach applied the test in allowing registration of the trademark GALANOS and said as follows at page 155:

I have difficulty in appreciating that the purchasing public would respond to the word “Galanos” prominently displayed on the label of a bottle of toilet water by spontaneously thinking of it as being the surname of an individual.

In my opinion a Canadian of ordinary intelligence and education in English or French would be as likely, if not more likely, to respond to the word by thinking of it as a coined, fanciful or invented word used as a brand or trade mark of a business as by thinking of it as primarily merely the surname of an individual.

Therefore, examiners should give weight to the applicant's argument that the word or words adopted are for trademark purposes and should have regard to the public perception of the word or words. Once this has been done, and if it is decided that the word or words are not “merely” a name or surname, i.e., they have dictionary meaning, geographical significance, and so on, then the “primary” meaning of the word or words must be decided.

In *Juneau v. Chutes Corp.* (1986), 11 C.P.R. (3d) 260 (T.M.O.B.), the trademark JUNEAU was held to be primarily merely the surname of a living individual even though “Juneau” is the capital of Alaska and a county or town in the state of Wisconsin. This was because a majority of Canadians, particularly those in the province of Quebec, would immediately respond to the trademark JUNEAU as having a surname significance as opposed to having any of the geographic significances put forward by the applicant.

#### **4.3.6 Given name and surname**

A trademark which appears to be a combination of a given name and a surname, or the initial(s) of a given name or names and a surname, should not be objected to under paragraph 12(1)(a) unless the exact combination can be located in a Canadian directory or other suitable source.

Only then should the test to determine primary meaning be applied.

In *Gerhard Horn Investments Ltd. v. Registrar of Trade Marks* (1983), 73 C.P.R. (2d) 23, Cattanach J., in allowing registration of the trademark MARCO PECCI, said at page 25:

What is precluded by para. 12(1)(a) from registration as a trade mark is the “name or surname of an individual who is living or has died within the preceding thirty years” and the name of a fictitious person is not precluded thereby from registration except when by chance the fictitious name coined by the applicant for registration thereof coincides with the name of a living person or a person who bore such name and has been dead for less than thirty years.

And later at page 30:

The first and foremost consideration is whether the word or words sought to be registered in the mark is the name or surname of a living individual or an individual who has recently died. It is when that condition precedent is satisfied, and only then, that consideration need be given to the question whether the trade mark applied for is “primarily merely” a name or surname rather than something else.

And again at page 31:

It is not enough that the fictitious name may resemble the name that could be borne by an actual person or might be thought by the public to be names or surnames. That thought only becomes

material when it is established by evidence that there is a living person of the name or surname in question.

### **4.3.7 Surnames with “& Sons”, “Brothers”, “Inc.”, “Co.”, etc.**

Words comprised of a name or surname followed by “& Sons”, “Brothers”, “Inc.”, “Co.”, etc., are not objectionable under paragraph 12(1)(a) as the additional matter takes away the “primarily merely” element.

**Note:** such a trademark may not be inherently distinctive. Also see section [4.9 Not Inherently Distinctive](#) in this Manual.

### **4.3.8 Compound surnames**

A trademark composed of two or more surnames, either separated by a hyphen or not, will not be considered contrary to paragraph 12(1)(a) of the Act unless the an individual having that exact combination can be found in a Canadian directory or other suitable source.

A trademark comprising two words which are primarily merely surnames separated by any indicia, other than a hyphen, such as the word “and” or by an ampersand, oblique sign, asterisk, comma and so on, is not contrary to paragraph 12(1)(a). In such a case, the trademark as a whole cannot be said to be primarily merely the surname of an individual, following the decision of Cattanaich J. in *Gerhard Horn Investments Ltd. v. Registrar of Trade Marks* (1983), 73 C.P.R. (2d) 23.

### **4.3.9 Surnames that include accents or other characters**

A surname may contain accents, umlauts and other similar characters (e.g. Müller, Noël, Côté). When performing a search of Canadian directories, any query made that includes the aforementioned characters may provide results that do not have these characters shown (e.g. Muller, Noel, Cote). However, examiners should still raise an objection pursuant to paragraph 12(1)(a) of the Act when the trademark includes these characters, even though the names or surnames found in the search do not show them.

### **4.3.10 Reference sources – paragraph 12(1)(a)**

Sources of information most commonly referred to regarding name and surname significance include Canadian telephone directories, encyclopedias, social media, and language dictionaries. It is not possible or reasonable for examiners to conduct exhaustive directory searches.

Examiners will also consult dictionaries and other relevant source documents to determine if the word or words have other meanings.

In *Standard Oil Co. v. Registrar of Trade Marks* (1968), 55 C.P.R. 49, the President of the Exchequer Court considered an objection by the applicant that the appearance of FIOR in directories of certain Canadian cities as a surname is not a proper evidentiary basis for concluding that it is the surname of an individual. President Jackett did not accept this proposition and stated at page 57:

In my view, it was open to the respondent to conclude from the fact that FIOR has appeared in directories in Canada as a surname, that the balance of probability is that FIOR is the surname of one or more individuals in Canada who are living. If the appellant had had any doubt as to the correctness of this conclusion, he had ample opportunity to cause the facts to be checked and to place evidence with regard thereto before the respondent or the Court. He has not done that and I can only conclude, as the respondent did, that the balance of probability is that there are individuals in Canada whose surname is Fior.

While social media may be considered by examiners when conducting research, care should be given to ensure that results appear genuine. Examiners must remain mindful that for an objection to be raised, the response of a person in Canada of ordinary intelligence and of ordinary education in English or French to the trademark must be that of a name or surname.

### **4.3.11 Historical significance**

A trademark may have name or surname significance and, at the same time, call to mind an individual bearing the same name in the field of literature, art, music, history, politics, commerce, science or the like. If the examiner believes that the average Canadian consumer would respond to the trademark as the name or surname of an individual who has died more than thirty years ago, the trademark would not contravene paragraph 12(1)(a) of the Act. For example, the primary significance of the name Sir John A. MacDonald would be historical whereas the surname MacDonald alone would elicit a different response and therefore be objectionable under paragraph 12(1)(a).

### **4.3.12 Font embellishments**

An objection under paragraph 12(1)(a) may still be raised even if the trademark includes embellishments to the lettering of the name or surname. In *Davidoff Comercio E Industria Ltda v. Davidoff Extension S.A.* (1989), 24 C.P.R. (3d) 230, the Chairman of the Opposition Board, G.W. Partington, had the following to say at page 234 of the decision:

In my view, the embellishments to the lettering of the applicant's trade-mark DAVIDOFF Design, namely, the underline extending the length of the trade-mark and the dot within the capital letter "D" would be perceived by the average consumer of the applicant's wares to be an integral part of the stylized lettering of the word "Davidoff" and could not be dissociated from the word itself: see *Canadian Jewish Review Ltd. v. Registrar of Trade Marks* (1961), 37 C.P.R. 89, 22 Fox Pat. C.49. As well, I would note that the dot in the "D" which forms an additional element of the applicant's trade-mark does not appear in any of the specimens or evidence adduced by the applicant. As such, there is no additional design matter in the applicant's trade-mark to constitute a registrable mark, within the scope of the decision in *John Labatt Ltd. v. Registrar of Trade Marks* (1984), 79 C.P.R. (2d) 110.

## **4.4 Paragraph 12(1)(b) – Clearly descriptive or deceptively Misdescriptive**

### **4.4.1 Introduction**

Trademarks must be examined for any clearly descriptive or deceptively misdescriptive meanings, in English or French, as applied to the character or quality, place of origin, conditions of, or persons employed in the production of the associated goods or the performance of the services. The purpose of an objection under paragraph 12(1)(b) is to ensure that no one person be able to appropriate such a trademark and place legitimate competition at an undue disadvantage in relation to language that is common to all. See *General Motors Corp. v. Bellows* (1949), 10 C.P.R. 101, at 112-113.

The word “clearly” is not used in the sense of “accurately”, but rather of “easy to understand...evident, plain.” See *Thorold Concrete Products Ltd. v. Registrar of Trade Marks* (1961), 37 C.P.R. 166 at 172.

The purpose of denying registration to deceptively misdescriptive marks is to prevent the public from being misled with respect to the goods or services and to prevent the person making such misrepresentations from obtaining an unfair advantage over competitors. The word “deceptive” is key. A misdescriptive word is registrable, but a deceptively misdescriptive word is not.

### **4.4.2 Examination under paragraph 12(1)(b)**

If an objection under paragraph 12(1)(b) objection is raised, the examiner must explain the reasons for it when reporting to the applicant. It is not enough to quote dictionary meanings of a word and leave it to the applicant to determine how the trademark is clearly descriptive or deceptively misdescriptive in association with the associated goods or services.

Furthermore, the examiner must indicate whether the objection relates to all the associated goods or services, or only to some (in which case examiners should specifically identify those goods or services to which the objection relates).

It is important to keep in mind that the context within which a paragraph 12(1)(b) determination is made encompasses the meaning conveyed by the trademark and its relationship to the goods or services to which it is applied. See the *KOLD ONE* decision, *Provenzano v. Registrar of Trade Marks* (1977), 37 C.P.R. (2d) 189 and affirmed (1978), 40 C.P.R. (2d) 288 (F.C.A).

The question to be asked is: What, as a matter of first impression, does the trademark tell the potential purchaser of the goods or services? What does the trademark lead such people to believe about the quality, character, or conditions of production, etc.? Does the trademark tell them what the goods or services are, or describe them or describe a property which is commonly associated with them? If so, the trademark should remain free for use by any other traders in the marketplace to describe their goods or services.

If the trademark deceptively misdescribes a property of the goods or services, then the examiner must raise an objection under paragraph 12(1)(b). The essence of unregistrability in this case is that the consumer would be deceived into believing the associated goods or services have a particular characteristic or quality when in fact they do not.

### **4.4.3 Test for clearly descriptive**

#### ***4.4.3.1 First impression***

In deciding whether a trademark is clearly descriptive or deceptively misdescriptive in the English or French language, the trademark must be considered as to the immediate impression created. In *Wool Bureau of Canada Ltd. v. Registrar of Trade Marks* (1978), 40 C.P.R. (2d) 25, Collier J. stated at page 27: “The decision that a mark is clearly descriptive is one of immediate impression; it must not be based on research into the meaning of words.”

It follows that examiners must not rely on any obsolete, archaic or unusual significance of a trademark in relation to the goods or services. The meaning of the trademark in common parlance, not the etymological meaning, is the determining factor in determining whether a trademark is clearly descriptive or deceptively misdescriptive of the goods or services. Authoritative sources, including dictionaries, may be used for this purpose. See *John Labatt Ltd. v. Carling Breweries Ltd.* (1974), 18 C.P.R. (2d) 15.

The fact that a particular combination of words does not appear in any dictionary does not prevent a trademark from being found to be clearly descriptive or deceptively misdescriptive. If each portion of a trademark has a well-known meaning in English or French, it may be that the resultant combination would be contrary to paragraph 12(1)(b) of the Trademarks Act. In *Oshawa Group Ltd. v. Registrar of Trade Marks* (1980), 46 C.P.R. (2d) 145, Cattanach J. stated at pages 148-149:

With respect to trade marks such as HYPER-VALUE and HYPER-FORMIDABLE which are coined in the sense that the well-known French and English prefix “hyper” is combined with the well-known English word “value” and the word “formidable” which is a well-known word in both the French and English languages, the resultant combinations do not appear in any dictionary but because those combinations do not appear it cannot be said that they are devoid of meaning. The components of the coined marks do have dictionary status and for that reason I do not think that resort might not be had to dictionaries for instruction as to the meaning of the components and, if possible, to ascertain there from the meanings of the resultant words. This is particularly so when the initial word is a prefix, as “hyper” is, used with prepositional force or as an adverb or adjective.

And further at page 152:

In ascertaining the impression that the trade marks HYPER-FORMIDABLE and HYPER-VALUE convey to determine if such marks are clearly descriptive it is the impression of the probable user of the appellant's services which is to be ascertained.

Further, in *Mitel Corporation v. Registrar of Trade Marks* (1984), 79 C.P.R. (2d) 202, Dubé J determined that the trademark SUPERSET was contrary to paragraph 12(1)(b) when used in association with subscribers' telephone instruments. Dubé J. stated the following at page 206:

Undoubtedly, the decision whether a trade mark is clearly descriptive is one of first impression....The Court must place itself in the shoes of the ordinary consumer who sees the trade mark advertised in store windows, or reads it in newspaper advertisements, or hears it over the radio or the television. The use of a dictionary may be useful, but a coined mark which has not acquired dictionary status still remains within the ambit of paragraph 12(1)(b)....In such instances the Court may look at the component parts of the trade mark in order to assess what the mark as a whole looks, or sounds like. Words or prefixes having a laudatory connotation are

prima facie descriptive terms, although in certain associations such epithets may have lost their descriptive impact.

However, the courts have found that where a trademark has developed a particular meaning in some other country, although the word may not be known to the ordinary dealer in, or user of, the goods or services in Canada, that trademark must be considered as a part of the common parlance for the purpose of applying paragraph 12(1)(b). In *Home Juice Co. v. Orange Maison Ltée.* (1970), 1 C.P.R. (2d) 14, Pigeon J. stated the following at page 16 of the decision:

Respondent has contended that the current meaning in France is not to be considered, that regard must be had only to the meaning current in Canada and that, in the absence of any evidence, whether by dictionaries or otherwise, that the meaning in question was current in Canada at the date of registration, no account should be taken of a recent meaning found in France only. This contention would have serious consequences if it was accepted. One result would be that a shrewd trader could monopolize a new French expression by registering it as a trade mark as soon as it started being used in France or in another French-speaking country and before it could be shown to have begun being used in Canada.

In my opinion, the wording of s. 12 does not authorize such a distinction. It refers to a description 'in the English or French languages'. Each of these two languages is international. When they are spoken of in common parlance they are considered in their entirety and not as including only the vocabulary in current use in this country, a vocabulary that is extremely difficult to define especially in these days when communication media are no longer confined within national boundaries.

#### ***4.4.3.2 In association with the goods or services***

In deciding whether a trademark is clearly descriptive or deceptively misdescriptive, it must be determined what first impression the trademark would create upon the everyday user or purchaser of the goods or services. The trademark must be considered in the context of the associated goods or services. See *Wool Bureau of Canada Ltd. v. Registrar of Trade Marks* (1978), 40 C.P.R. (2d) 25 and *Mitel Corporation v. Registrar of Trade Marks* (1984), 79 C.P.R. (2d) 202.

In *Wool Bureau of Canada Ltd. v. Registrar of Trade Marks* (1978), 40 C.P.R. (2d) 25, Collier J. considered the registrability of the trademark SUPERWASH and applied the test as follows:

The Court, in considering whether the impugned expression is clearly descriptive, must endeavour to put itself in the position of the everyday user of the wares. It seems to me the ordinary user or dealer in sweaters and men's hosiery, fabricated from wool, would know that wool has, traditionally, been susceptible to shrinkage when the garment is washed. In my opinion, that notional person, as a matter of immediate impression, would conclude that "superwash" applied to particular woolen goods, described a garment that washed very, or extremely well, with little or no resultant shrinkage.

When considering descriptiveness, regard must also be given as to whether the trademark is grammatically correct. In *Clarkson Gordon v. Registrar of Trade Marks* (1985), 5 C.P.R. (3d) 252, the trademark AUDITCOMPUTER was found not to be clearly descriptive since it was considered an awkward and cumbersome combination of two words.

#### **4.4.4 Depicted, written or sounded**

When applying the test of registrability under paragraph 12(1)(b), examiners must consider all types of trademarks – not just trademarks consisting exclusively of words – given the inclusion of the words “depicted, written or sounded” in the paragraph.

For example, a trademark that consists of a design can be clearly descriptive or deceptively misdescriptive of the associated goods or services. In *Frost Steel and Wire Co. Ltd. v. Lundy* (1925), 57 O.L.R. 494, the Court was considering the validity of a trademark which consisted of the picture of a knot used in a wire fence. In holding the registration invalid, Rose J. stated at page 498:

There are, however, very few reported cases in which the Courts have had to consider the question whether a design mark that is merely descriptive is capable of registration. But it is difficult to see why there should be any difference between the rules to be applied in the case of a design and those applied in the case of a word.

Similarly, the hearing officer in *Ralston Purina Co. v. Effem Foods Ltd.* (1990), 31 C.P.R. (3d) 52, (a cat's head design for pet food) stated at page 55:

In the present case, I consider that the use of the applicant's mark on a can or package of cat food would clearly indicate that the character of the wares are such that they are intended for cats.

A trademark which consists of a miss-spelled word can contravene paragraph 12(1)(b) if it would be pronounced the same as a clearly descriptive word. For example, the trademark THOR-O-MIX, for use in association with ready-made concrete, was refused by the Registrar as being clearly descriptive of the character of the goods. In *Thorold Concrete Products Ltd. v. Registrar of Trade Marks* (1961), 37 C.P.R. 166, Kearney, J. stated at page 172:

When I first sounded the instant trade name, it plainly had the same significance for me as if it were written “thorough-mix”, and I think that in like circumstances the general public would be similarly impressed.

Trademarks consisting in whole or in part of a sound would also fall under the criterion of “when sounded” under the test for clear descriptiveness.

#### **4.4.5 Misdescriptiveness**

While paragraph 12(1)(b) prohibits the registration of trademarks which are deceptively misdescriptive, there is no bar to registration of misdescriptive trademarks if they are not likely to lead the average purchaser to believe erroneously that the associated goods or services possess some characteristic or quality. In his *Canadian Law of Trade Marks and Unfair Competition*, Third Edition, H.G. Fox argues for the registrability of clearly misdescriptive words:

Many words may be clearly misdescriptive of the wares or services in association with which they are used but are by no means deceptively misdescriptive. In a sense a clearly misdescriptive word may be quite distinctive. Its very misdescriptiveness attracts the senses and thus makes for distinctiveness. In such a case a word of that type ought to constitute a good trade mark and ought to be registrable. If, on the other hand, a mark is deceptively misdescriptive, the reverse is the case. Thus, the mark “North Pole” might well be descriptive of the character or quality of the wares if used in association with ice cream or frozen foods, just as the word “Frigidaire” has

been held to be descriptive of refrigerators and refrigerating systems. But while the use of the words “North Pole” would be misdescriptive of bananas or oranges it would not be deceptively misdescriptive. It would be the use of a geographical name dislocated or disconnected from the origin of the goods.

#### **4.4.6 Deceptively misdescriptive**

The principle which underlies a paragraph 12(1)(b) objection as it concerns deceptive misdescriptiveness is that a trademark must not mislead the public by ascribing a character or quality to goods or services that they do not possess. For example, in *Deputy Attorney-General of Canada v. Biggs Laboratories (Canada) Limited* (1964), 42 C.P.R. 129, the trademark SHAMMI in association with a transparent polyethylene glove, was denied registration because the glove did not contain any chamois or shammy. In finding the trademark SHAMMI deceptively misdescriptive of the character or quality of the goods, Dumoulin J. stated at page 130:

An article advertised for sale as containing certain components which, in truth, it does not have, surely must be considered as deceptively misleading to the purchasing public.

However, in *Lake Ontario Cement Ltd. v. Registrar of Trade Marks* (1976), 31 C.P.R. (2d) 103, Dubé J. held that the word PREMIER was not deceptively misdescriptive as applied to the goods “sand and gravel and ready-mixed concrete” and “concrete blocks and bricks ordinarily used in the construction of buildings and homes”. Dubé J. found that the word PREMIER denotes a degree of quality that might be attained by the goods and, insofar as the goods did not meet that quality, the word PREMIER would be misdescriptive of the quality of the goods. However, ordinary dealers in or purchasers of the goods would perceive PREMIER as an indirect reference to the quality of the goods and would not be led to believe that the goods being purchased were of the best quality.

#### **4.4.7 In the English or French language**

A word in a language other than English or French which is clearly descriptive of the character or quality of the goods or services is not prohibited by paragraph 12(1)(b). In *Gula v. Manischewitz Co.* (1947), 8 C.P.R. 103, it was held that even though the word “tam” meant “taste” or “tasty” to a Hebrew- or Yiddish-speaking person, the trademark TAM TAM was not unregistrable.

Paragraph 12(1)(b) also does not preclude the registration of a trademark consisting of a combination of French and English words which are individually clearly descriptive of the goods or services. In *Coca-Cola Co. v. Cliffstar Corp.* (1993), 49 C.P.R. (3d) 358, the applicant applied to register the trademark LE JUICE for juices. The opposition under paragraph 12(1)(b) was rejected because:

The applicant's proposed mark is comprised of the French word “le” and the ordinary English word “juice”. The former word is a definite article in the French language. The latter word is clearly descriptive in the English language of the character of the wares “fruit juices” and the applicant has conceded this by including a disclaimer in its application. The combination of the two words, however, does not offend the provisions of s. 12(1)(b) of the Act.

However, such a trademark may be considered to be not inherently distinctive (see section [4.9 Not Inherently Distinctive](#) in this Manual).

## 4.4.8 Character or quality

A trademark is not registrable if it is clearly descriptive or deceptively misdescriptive in the English or French language of the character or quality of the associated goods or services. As to what constitutes the character of the goods or services, the examiner may be guided by the words of Cattanach J. in *Drackett Co. of Canada Ltd. v. American Home Products Corp.* (1968), 55 C.P.R. 29 at page 34, where he states that “...the word ‘character’ as used in s. 12(1)(b) must mean a feature, trait or characteristic of the product.”

Trademarks which clearly describe the function or result of using goods or services can also contravene paragraph 12(1)(b). The trademarks STA-ZON, a distortion of “stays on”, and SHUR-ON, a distortion of “sure on”, as applied to eyeglass frames, were held not to be proper trademarks. In *Kirstein Sons & Co. v. Cohen Bros., Limited* (1907), 39 S.C.R. 286 at page 288, Mr. Justice Davies stated: “He could not pre-empt nor claim the exclusive use of the idea descriptive of some merit in the article.”

In the *ULTRA FRESH* decision (*Thomson Research Associates Ltd. v. Registrar of Trade Marks* (1982), 67 C.P.R. (2d) 205), the function of the goods was held to be clearly descriptive of their character. Mahoney J. stated at page 208:

I agree with the respondent that “ultra fresh” is clearly descriptive. It is not descriptive of the bacteriostats and fungistats themselves but it does clearly describe, or deceptively misdescribe, the condition of the products, e.g., the underwear, after treatment with those bacteriostats and fungistats.

On appeal, (1983), 71 C.P.R. (2d) 287, Thurlow, C.J. stated at page 288:

In our view, *ULTRA FRESH* is clearly descriptive of the function, the purpose and the effect when used as intended, of the bacteriostats and fungistats in association with which it is used as a trade mark. It follows that its registration was properly refused as being contrary to para. 12(1)(b) of the Trade marks Act, R.S.C. 1970, c. T-10.

Trademarks which are common to a particular trade, such as the word “fashions” in the clothing trade or “pack” in the food trade, which express a special or distinguishing attribute of goods or services, can also clearly describe the character of the goods and are not registrable.

With respect to the meaning of the word “quality” as it applies in paragraph 12(1)(b), examiners will find objectionable those words which describe a degree of excellence reputed to be achieved by the goods or services (e.g., *SUPERWASH* as applied to the yarn or fabric in sweaters or hosiery, or *NO. 1* in association with brewed alcoholic beverages).

Trademarks such as *SUPERIOR*, *EXCELLENT*, *QUALITY*, *BEST*, *ULTRA*, *SUPER*, *SUPREME* or *PERFECT*, which laud the merits or superiority of the goods or services, are also clearly descriptive of their quality and are not registrable.

The decision of *Mitel Corporation v. Registrar of Trade Marks* (1984), 79 C.P.R. (2d) 202, reflects the same line of reasoning regarding laudatory trademarks, as the trademark *SUPERSET* was found to be clearly descriptive.

## 4.4.9 Embellishment of clearly descriptive words

The Office considers that trademarks which include design elements added to clearly descriptive words are not registrable if the design elements are mere embellishments of the letters comprising the words and cannot be dissociated from the words themselves. See *Canadian Jewish Review Ltd. v. Registrar of Trade Marks* (1961), 37 C.P.R. 89; *Ingle v. Registrar of Trade Marks* (1973), 12 C.P.R. (2d) 75 and *John Labatt Ltd. v. Registrar of Trade Marks* (1984), 79 C.P.R. (2d) 110.

Likewise, trademarks which consist of clearly descriptive words in fanciful lettering are not registrable if there are no distinctive design features exclusive of the words. In *John Labatt Ltd. v. Registrar of Trade Marks* (1984), 79 C.P.R. (2d) 110, Cattanach J. had the following to say on this matter at page 120:

In this case, as in the *CANADIAN JEWISH REVIEW* case, the words “super bock” form the material part of the trade mark and in spite of the added embellishments to some of the letters of the word “bock” and the sequence of the letters of the word “super” positioned above the word “bock” where the meaning of the combination dictates it must be positioned on a gentle curve still spell out “super bock”.

As Cameron J. has said, “without the words there would be no special features or design”.

Since the two words “super bock” form a most material part of the trade mark, despite the disclaimer of those two words, and there is no design feature exclusive of the letters and their positioning it follows from the reasoning of Cameron J. which I adopt and apply, the trade mark as a whole cannot be other than clearly descriptive of the character or quality of the wares with which they are associated and so not registrable.

**Note:** This principle also applies to trademarks considered to be unregistrable pursuant to paragraph 12(1)(a) or (c) of the Act.

#### **4.4.10 “Sounded” test applied to composite trademarks**

Paragraph 12(1)(b) of the Trademarks Act stipulates that a trademark is registrable if it is not, whether depicted, written or sounded, either clearly descriptive or deceptively misdescriptive in the English or French language of the character or quality of the associated goods or services of the conditions of or the persons employed in their production or of their place of origin.

In *Best Canadian Motor Inns Ltd. v. Best Western International, Inc.* (2004), 30 C.P.R. (4th) 481, (hereinafter referred to as “*Best Canadian Motor Inns Ltd.*”) the Federal Court ruled on the interpretation of paragraph 12(1)(b) in relation to composite trademarks (combination trademarks, i.e. trademarks consisting in a combination of signs).

Specifically, the Federal Court concluded that the words “BEST CANADIAN MOTOR INNS” were the dominant feature of the trademark (shown below) and, given that these words were clearly descriptive of the character or quality of the applicant's services, the trademark in its entirety, when sounded, was found unregistrable pursuant to paragraph 12(1)(b)Act.



In light of this decision, the Trademarks Office considers that a combination trademark, when sounded, is not registrable pursuant to paragraph 12(1)(b) of the Act if it contains word elements that are:

1. clearly descriptive or deceptively misdescriptive in the English or French language of the character or quality of the associated goods or services or of the conditions of or the persons employed in their production or of their place of origin; and
2. the dominant feature of the trademark.

#### ***4.4.10.1 Determination of Whether Words are the Dominant Feature of a Combination Trademark***

The Canadian Oxford Dictionary defines the word “dominant” as

1. dominating, prevailing, most influential. 2. (of a high place) prominent, overlooking others. (...).” It defines the word “dominate” as “(...) 2. tr. & intr. (of a person, sound, event, etc.) be the most influential or conspicuous factor in (...).

Le Petit Robert defines the word “dominant” as

1. Qui exerce l'autorité, domine sur d'autres (...) 2. Qui est le plus important, l'emporte parmi d'autres (capital, premier, prépondérant, primordial, principal) (...).” It defines the word “dominer” as: “2. Exercer une influence qui l'emporte sur les autres (...) 2. Être le plus apparent, le plus fort, le plus important, parmi plusieurs éléments (l'emporter, prédominer) (...).

In determining whether a word element is the dominant feature of a combination trademark, examiners will consider whether a prospective consumer would, as a matter of first impression, perceive the word element as being the most influential or prominent feature of the trademark. In doing so, examiners will look at the trademark in its totality, and compare the visual impression created by the word element(s) to the visual impression created by the design element(s). Where the design element of the trademark does not stimulate visual interest, the word element will be deemed dominant.

Factors that may be considered by examiners in assessing the visual impression created by the elements include the size of the words and the size of the design, the font, style, color and layout of the lettering of the words, as well as the inherent distinctiveness of the design element.

Based on the definitions above, the Office takes the position that only one element in a trademark can be dominant. Therefore, in situations where the word element and the design element are considered to be equally influential or prominent in a trademark, the Office considers that neither can be the dominant feature of the trademark.

When the word element of a combination trademark is not the dominant feature of the trademark, the Registrar considers that the trademark in its totality cannot, when sounded, be clearly descriptive or deceptively misdescriptive of the associated goods or services.

#### **4.4.11 Trademarks which merely suggest character/quality**

A trademark does not contravene paragraph 12(1)(b) of the Act if it merely suggests the character or quality of the associated goods or services. The trademark WATERWOOL was held registrable in association with clothing in *Deputy Attorney-General of Canada v. Jantzen of Canada Limited* (1964), 46 C.P.R. 66 at page 72. President Jackett reviewed the evidence and concluded as follows:

My first impression, and my present impression, is that WATERWOOL may mystify the person who is confronted with it in association with a garment; it may even vaguely suggest some association with wool; but it does not describe the garment as being made of the wool of any animal.

The GRO-PUP case is often cited with respect to a trademark found to be merely suggestive rather than clearly descriptive. This case is reported as *Kellogg Co. of Canada Ltd. v. Registrar of Trade Marks* [1940] Ex. C.R. 163. After reviewing the evidence, Angers J. stated at page 170:

...I do not think that the word “Gro-Pup” is descriptive of the article to which it is to be applied, namely, dog food; it is at the utmost suggestive of the result which it is liable to produce.

However, in *Quaker Oats Co. of Canada Ltd. v. Ralston Purina Canada Inc.* (1987), 18 C.P.R. (3d) 114, the trademark HELPING DOGS LIVE LONGER LIVES was refused for being clearly descriptive and not registrable. At page 119 of the decision, the Chairman of the Opposition Board, G.W. Partington, had the following to say in finding the trademark clearly descriptive of the result.

...I am of the view that the average purchaser of dog food would immediately conclude that the trade mark HELPING DOGS LIVE LONGER LIVES as applied to such wares would clearly describe to the purchaser that the use of the applicant's wares would result in their pet living a longer and healthier life. As such, the present situation is clearly distinguishable from that considered by Mr. Justice Angers in *Kellogg Co. of Canada Ltd. v. Registrar of Trade Marks*, [1939] 3 D.L.R. 65, [1940] Ex. C.R. 163, where the learned trial judge concluded that the trade mark GRO-PUP as applied to dog food was “at the utmost suggestive of the result which it is liable to produce”. Further, I do not consider that the GRO-PUP decision can any longer be considered as authority for the proposition that the result that an article of commerce is liable to produce is not such as to render a description of that result unregistrable as a trade mark for that article: see *Sharp Kabushiki Kaisha v. Dahlberg Electronics, Inc.* (1983), 80 C.P.R. (2d) 47 at pages 51-5.

#### **4.4.12 Conditions of production**

If a trademark is clearly descriptive or deceptively misdescriptive of the conditions of production, an objection under paragraph 12(1)(b) of the Act will be raised. In *Staffordshire Potteries Ltd. v. Registrar of Trade Marks* (1976), 26 C.P.R. (2d) 134, the Court refused the application for registration of the trademark KILNCRAFT on the grounds that the first impression of a person seeing the trademark would be that the goods (tableware) were produced by a kiln process. It followed that if the goods were not produced in this way, the trademark would be deceptively misdescriptive.

#### **4.4.13 Persons employed in the production**

A trademark that is clearly descriptive or deceptively misdescriptive of the persons employed in the production of the goods, or the performance of the services, is not registrable. For example, the trademark POTTER would not be registrable for pottery goods, nor would BAKER be registrable for baked goods or bakery services.

#### **4.4.13.1 Professional designation**

When confronted with a trademark that appears to be the title of a profession, research is conducted to determine whether the trademark, as a whole, is a professional designation. Where research discloses that the trademark, as a whole, consists of a professional designation, examiners are to apply the first impression test in light of the applicant's goods or services. See *Wool Bureau of Canada Ltd. v. Registrar of Trade Marks* (1978), 40 C.P.R. (2d) 25 and *Mitel Corp. v. Registrar of Trade Marks* (1984), 79 C.P.R. (2d) 202. If it is considered that the prospective consumer, when faced with the trademark as a whole would immediately, as a matter of first impression, conclude that the goods or services are produced by a professional from that designation, the trademark will be found to be clearly descriptive or deceptively misdescriptive of the persons employed in the production of the goods and services and unregistrable pursuant to the provisions of paragraph 12(1)(b) of the Trademarks Act. See *Life Underwriters Assn. of Canada v. Provincial Assn. of Québec Life Underwriters* (1988), 22 C.P.R. (3d) 1 and *Lubrication Engineers, Inc. v. Canadian Council of Professional Engineers* (1992), 41 C.P.R. (3d) 243.

Moreover, the Office considers that the mere addition of an abbreviation, acronym or initials of the professional designation contained in the trademark will not render the trademark registrable. See *Life Underwriters Assn., supra*; *College of Traditional Chinese Medicine Practitioners and Acupuncturists of British Columbia v. Council of Natural Medicine College of Canada* (2009), 80 C.P.R. (4th) 265.

Examiners will note, however, that in *Ontario Dental Assistants Assn. v. Canadian Dental Assn.*, 2013 FC 266, the Federal Court determined that a professional designation *can* be a valid certification mark:

To the extent the case of *Life Underwriters Assn. of Canada/Assoc. des assureurs-vie du Canada v. Provincial Assn. of Quebec Life Underwriters/Assoc. Provinciale des assureurs-vie du Québec*, [1988] F.C.J. No. 564 (Fed. T.D.), and cases before the Opposition Board following that decision are relied upon to suggest that a professional designation can never serve to be a valid certification mark, I disagree. Nothing in the Act so limits the ability of a professional designation to validly act, in use, as a certification mark, provided such a designation meets the necessary criteria outlined above with respect to lack of clear descriptiveness, distinctiveness, absence of a likelihood of confusion, and proper use.

#### **4.4.14 Place of origin**

A trademark is clearly descriptive of the place of origin if the trademark as a whole is a geographic name and the associated goods or services originate from the location of that geographic name.

A trademark is deceptively misdescriptive of the place of origin if the trademark, or a portion of the trademark, is a geographic name that is not the place of origin of the associated goods or services, and the average Canadian consumer or dealer would be misled into the belief that the associated goods or services had their origin in the location of the geographic name in the trademark.

#### ***4.4.14.1. Geographic name***

A trademark is considered to be a geographic name if research shows that the trademark has no other meaning than as a geographic name. In the decision of *MC Imports Inc. v. Afod Ltd.*, 2016 FCA 60, Trudel, J.A, made the following comments at para. 65:

If the wares or services originate in the place referred to by the trade-mark, then the trade-mark is clearly descriptive of place of origin. There is no ambiguity when the trade-mark is the name of the place of origin that would invite further inquiry: referring to the place of origin by its name is the pinnacle of clarity. This is why the perspective of the ordinary consumer of the wares or services is unnecessary. As stated earlier, when filing an application for registration of a trade-mark referring to a geographical place, an applicant should not be allowed to benefit from the consumer's lack of knowledge in geography.

However, if research shows that the trademark has other established meanings, such as a given name, surname, dictionary word, ordinary commercial term, or other recognized meaning from an authoritative source, the examiner must then consider the first impression of the average Canadian consumer or dealer of the applicant's goods or services to determine whether the geographic name is the primary or predominant meaning.

In assessing whether a trademark is a geographic name, examiners may have regard to the names of continents, countries, provinces, states, regions, cities, neighbourhoods, and streets. See *Lum v. Dr. Coby Cragg Inc.* (2015), 134 C.P.R. (4th) 409 and *General Motors of Canada v. Decarie Motors Inc.* (2000), 9 C.P.R. (4th) 368.

Examiners will keep in mind that, when depicted, a design may be the equivalent of the geographic name of that place if the average Canadian consumer or dealer of the associated goods or services would recognize the design as depicting that geographical place as a matter of first impression. For example, a trademark consisting of a representation of a map of Italy for use in association with wines may be considered as the equivalent of the geographic name of Italy.

Examiners will also consider that, when sounded, a misspelling or a phonetic equivalent of a geographic name is treated the same as the actual geographic name, e.g., SHECAWGO, KAYBEK.

The adjectival, plural or possessive form of a geographic name is also treated the same as the actual geographic name, e.g. CUVEE DU VATICAN, TORONTOS, CANADA'S NATIONAL LAW FIRM.

#### ***4.4.14.2. Origin of goods or services***

If a trademark is determined to be a geographic name, the actual place of origin of the associated goods or services will be ascertained by way of confirmation provided by the applicant. This confirmation can be provided either voluntarily when an application is filed, or in reply to an examiner's written request.

Examiners will request confirmation of the place of origin of the associated goods or services regardless of the address of the applicant.

Goods or services may be found to originate from a geographic location if they are manufactured, produced, grown, assembled, designed, provided or sold there, or if the main component or ingredient is made in that geographic location.

The fact that a geographic name may identify more than one location does not remove a trademark from the ambit of paragraph 12(1)(b) since its primary significance remains a geographic name. For example, the fact that QUEBEC can refer to the city or the province does not remove its primary meaning as a geographic name.

In some cases, the meaning of a word can signify multiple geographic places but the primary meaning is one particular location. For example, the words AMERICA or AMERICAN can refer to the continents of North America and South America but also the United States of America. Despite referring to several different geographical places, to the average Canadian consumer, the meaning of the words AMERICA and AMERICAN is primarily that of the United States of America.

When two geographic terms are combined in the same trademark, the primary significance of the composite may still be geographic if consumers would believe that the goods or services originate from or are provided in both of the locations named in the trademark, e.g., CANADA USA.

#### ***4.4.14.3. Deceptively misdescriptive of the place of origin***

If the associated goods or services do not in fact originate from the location of the geographical name in the trademark, the examiner must determine whether the trademark is deceptively misdescriptive of the place of origin. If, as a matter of first impression, the average Canadian consumer or dealer of the applicant's goods or services would be misled into the belief that the associated goods or services had their origin in the geographic place referred to in the trademark, the trademark is considered to be deceptively misdescriptive of the place of origin.

In determining whether a trademark is deceptively misdescriptive of the place of origin, the examiner will consider that the average Canadian is aware that certain cities, states, areas and countries are widely recognized as manufacturing, trading or industrial centres, and a likely source of a wide variety of goods and services, or have established reputations as producers or manufacturers of certain goods or services. For example, Switzerland is known for cheese, chocolate and watches, Britain is known for bone china and finished steel, and Spain, France, Germany, California, Australia, Okanagan, and Niagara are known for wines.

In *Atlantic Promotions Inc. v. Registrar of Trade Marks* (1984), 2 C.P.R. (3d) 183, the Court upheld the Registrar's decision that MILAN SHOWERGEL in association with lathering soaps, detergent rinses and like showering material was deceptively misdescriptive of the place of origin of the goods.

Similarly, in *T.G. Bright & Co., Ltd. v. Registrar of Trade Marks* (1985), 4 C.P.R. (3d) 64, the Court upheld the Registrar's refusal of the application for the trademark CASABLANCA in association with wines. The trademark was deemed deceptively misdescriptive of the place of origin of the goods. Also see the decision in respect of the trademark BRIGHTS FRENCH HOUSE (1986), 9 C.P.R. (3d) 239.

#### ***4.4.14.4. Character of goods or services***

In some cases, a geographical name forms part of a unitary expression that may clearly describe the character of the associated goods or services, but not necessarily their place of origin. For example, CANADIAN BACON is a term used for back bacon and clearly describes the **character** of prepared meats. Similarly, SWEDISH MASSAGE is a type of massage that clearly describes the **character** of massage services.

#### ***4.4.14.5. Place of origin and top level domains (TLDs)***

Trademarks consisting of, or containing, one of the 255 country code top level domain names (TLDs) (such as .ca, .fr, .uk, .us) must be examined as to place of origin of the associated goods or services.

For example, the Office considers the following TLDs to clearly mean:

.ca - Canada

.fr - France

.uk - United Kingdom

.us - United States

A trademark that consists of or contains one of these terms is considered unregistrable pursuant to paragraph 12(1)(b) of the Act if the trademark, when considered in its totality, as a matter of first impression, is clearly descriptive or deceptively misdescriptive of the place of origin of associated goods or services. The addition of one of these terms to a clearly descriptive trademark will not render it registrable.

Also see section [4.9 Not Inherently Distinctive](#) in this Manual.

### **4.4.15 Pharmaceuticals**

Where a trademark application lists goods or services in the field of pharmaceuticals, examiners should conduct research to determine if the trademark consists of an **International Nonproprietary Name** (INN). An INN identifies a pharmaceutical substance or active pharmaceutical ingredient by a unique name that is globally recognized and is public property. To make INN's universally available, they are placed in the public domain by the World Health Organization (WHO), hence their designation as “nonproprietary”. They can be used without any restriction whatsoever to identify pharmaceutical substances. As such, any trademark which consists of an INN will generally be unregistrable in view of paragraph 12(1)(b) of the Act.

### **4.4.16 Abbreviations, acronyms or initials**

Trademarks consisting of or containing abbreviations, acronyms or initials are examined for any clearly descriptive or deceptively misdescriptive meanings, in English or French, as applied to the character or quality, place of origin, conditions of, or persons employed in the production of the associated goods or the performance of the services.

A trademark that consists, of or contains, an abbreviation, acronym or initial is considered unregistrable pursuant to paragraph 12(1)(b) of the Act if the trademark, when considered in its totality and as a matter of first impression in association with the goods or services, is clearly descriptive or deceptively misdescriptive. The Office considers that the mere addition of an abbreviation, acronym or initial of a clearly descriptive word or phrase contained in the trademark will not render the trademark registrable.

### **4.4.17 Top level domains (TLDs)**

Trademarks consisting of, or containing, top level domain names such as .com, .net, .org, are unregistrable pursuant to paragraph 12(1)(b) of the Act if the trademark, when considered in its totality, as a matter of first impression, clearly describes or deceptively misdescribes that the goods or services are provided online. The addition of one of these terms to a clearly descriptive trademark will not make it registrable.

Also see section [4.9 Not Inherently Distinctive](#) in this Manual.

#### **4.4.18 Hashtag (#)**

Trademarks, whether sounded, written, or depicted, that contain or consist of the hash symbol (#), commonly referred to as a hashtag, must be examined for any clearly descriptive or deceptively misdescriptive meanings, in English or French, as applied to the character or quality, place of origin, conditions of, or persons employed in the production of the associated goods or the performance of the services.

A “hashtag” is a form of metadata comprised of a word or phrase prefixed with the hash symbol (#) often used in social-networking sites to identify or facilitate a search for a keyword or topic of interest.

Merriam-Webster dictionary defines the term “hashtag” as:

A word or phrase preceded by the symbol # that classifies or categorizes the accompanying text (such as a tweet).

TERMIUM Plus defines “hashtag” as:

A keyword, a keyword string, or a theme preceded by the pound or number sign and used to index and categorize content.

A trademark that consists of, or contains, the hash symbol (#) or the word “HASHTAG” will be considered unregistrable pursuant to paragraph 12(1)(b) of the Trademarks Act, if the trademark, as a matter of first impression is considered to be clearly descriptive or deceptively misdescriptive of the character or quality of the goods or services. Therefore, the addition of the # symbol or equivalent word to a clearly descriptive trademark will not render it registrable.

By way of example, the trademark #ITALY for shoes and the retail sale of clothing and shoes, would be deemed to be clearly descriptive or deceptively misdescriptive of the place of origin of the goods and services since the trademark clearly describes that the shoes and clothing originate from Italy.

Another example would be the trademark HASHTAG FRESH for fruits and vegetables and the retail sale of food. As the word “FRESH” after the word “HASHTAG” is clearly descriptive of the character of the goods and services, the trademark as a whole is considered to be clearly descriptive since the trademark clearly describes that the fruits and vegetables are fresh.

When considering the hash symbol (#) or the word hashtag, examiners will also consider the overall impression and placement. If the symbol or word immediately precedes a number (YOUR #1 CHOICE, #19 RALPH) or is being used as a pound or number symbol (THE DOG#, PICK UR #) the symbol will not be construed as being a hashtag.

### **4.5 Paragraph 12(1)(c) – Name of goods or services**

The name of the goods or services in any language is not registrable as a trademark as it could never distinguish goods or services of one person from those of others.

Examiners must request that an applicant provide a translation of any words in the trademark which are not English or French, pursuant to paragraphs 30(2)(d) of the Act and 31(d) of the Regulations.

If the trademark consists in whole or in part of characters other than Latin characters, examiners must request a transliteration of those other characters into Latin characters following the phonetics of the language of the application (in order to assess how the trademark is sounded) pursuant to paragraph 31(b) of the Regulations.

If a trademark is a compound word written as one word, the applicant may not be required to provide a translation or a transliteration of any portion comprising the trademark. However, if a portion of the trademark stands out as separate, such as having a different print, a different colour, etc, the applicant will be requested to provide a translation into English or French of any words in any other language. The applicant may also have to provide a transliteration of any matter expressed in characters other than Latin characters or in numerals other than Arabic or Roman numerals contained in the trademark.

If the trademark or translation of the trademark is the name of the goods or services, then an objection must be raised pursuant to the provisions of paragraph 12(1)(c) of the Trademarks Act. See *Brulerie des Monts Inc. v. 3002462 Canada Inc.* (1997), 75 C.P.R. (3d) 445 (F.C.T.D.).

A trademark which is the name of the goods or services **cannot** become registrable on a showing of acquired distinctiveness under subsection 12(3) of the Act.

## 4.6 Paragraph 12(1)(d) – Confusion

See [Section 3](#) of this Manual for a discussion of confusion.

## 4.7 Paragraph 12(1)(e) – Prohibited marks

Certain trademarks which may not be adopted or used are listed in sections 9, 10 and 10.1 of the Trademarks Act. The prohibition against registration applies both to trademarks that consist of these prohibited marks and to trademarks so nearly resembling as to be likely to be mistaken for them.

In view of the principles laid out in *Olympic Association v. Allied Corp.* (1989), 28 C.P.R. (3d) 161 (FCA), the Registrar considers that the relevant date for assessing registrability pursuant to paragraph 12(1)(e) of the Act is the date of the decision to refuse the applicant's registration.

Where applicable, public notice is considered to have been given by the Registrar when the particulars of the prohibited mark are published on CIPO's website by way of the Trademarks Journal.

### 4.7.1 Paragraphs 9(1)(a), (b) and (c)

A trademark is not registrable if it consists of, or so nearly resembles as to be likely to be mistaken for:

- a. the Royal Arms, Crest or Standard;

- b. the arms or crest of any member of the Royal Family;
- c. the standard, arms or crest of His Excellency the Governor General

In *T.S. Simms & Co. Ltd. v. Commissioner of Patents*, [1938] Ex. C.R. 326, a representation of a crown closely resembling the royal crown included in the Royal Crest was refused registration on the basis that it was prohibited by section 14 of the Unfair Competition Act (which corresponds to section 9 of the Trademarks Act):

I do not believe that section 14 forbids the use of a crown in general; in my opinion, however, it does forbid the use of the crown forming part of the Royal Arms or crest or of the arms or crest of a member of the Royal Family or of a crown so nearly resembling them that it may lead to mistake.

### 4.7.2 Paragraph 9(1)(d)

An objection under paragraph 9(1)(d) of the Act will be raised in respect of any trademark that suggests an association with, or patronage of, a royal, vice-regal or governmental authority.

However, a trademark which merely alludes in a general way to royalty, a crown, etc. is generally registrable. For example, in *A.B. Statens Skogsindustrier v. Registrar of Trade Marks* (1964), 46 C.P.R. 96, the trademark ROYAL BOARD THREE CROWNS & Design was held not to offend paragraph 9(1)(d) of the Act.

In *Canada Post Corp. v. MacLean Hunter Ltd.* (1994), 55 C.P.R. (3d) 559, the trademark LASER POST in association with personalized direct-mail services and personalized direct-mail goods, was refused because it was concluded that there was a significant association in the public mind between the word “post” and the opponent when it is used for mail-related goods and services. Further, customers would assume that Canada Post had approved, authorized, sponsored or licensed the applicant's use of the trademark LASER POST.

**Note:** Paragraph 9(1)(d) does not extend to foreign governments, in view of the decision in *Institut National des Appellations d'Origine v. Chock Full O'Nuts Corp.* (2000) 9 C.P.R. (4th) 394.

### 4.7.3 Paragraph 9(1)(e)

Examples of arms, crests or flags for which public notice has been given of their adoption and use by a municipal or government authority and which are unacceptable matter for trademarks are as follows:

The **Coat-of-Arms of Canada**, which was subject of a notice under paragraph 9(1)(e) in the Trademarks Journal of April 13, 1955.

The **Canadian Red Ensign** with the shield of the Coat-of-Arms of Canada in the flag, which was also subject of a notice under paragraph 9(1)(e) in the Trademarks Journal of April 13, 1955.

The Canadian Flag

On April 14, 1965, and pursuant to the provisions of paragraph 9(1)(e), public notice was given in the Trademarks Journal of the adoption and use of the Canadian Flag. This flag consists of an eleven-point maple leaf in a white square with red bars on either side, of the proportion two by length and one by

width. Since the national flag of Canada is a prohibited mark, examiners will raise an objection pursuant to paragraph 12(1)(e) of the Act for any application for a trademark consisting of or containing the Canadian flag.

Notwithstanding the above, on September 2, 1965, Order-in-Council PC 1965-1623, was passed entitled Purposes and Conditions of Use By the Public of Certain Canadian Symbols and Emblems, in which consent was given in section 4 to use the maple leaf on a trademark or in a design incorporating the particular eleven-point maple leaf that forms part of the national flag (see prohibited mark 970441 published pursuant to paragraph 9(1)(i) of the Trademarks Act). Such consent was granted on the condition that:

- a. the use of the design or trademark conforms to good taste;
- b. an applicant for the registration of such design or trademark disclaims, in the application, the right to the exclusive use of the maple leaf; and
- c. the owner of such design or trademark will not attempt to prevent anyone else from using the maple leaf.

The consent pertains to the use of the eleven-point maple leaf as part of a combination trademark; there must be some registrable portion of the trademark other than the eleven-point maple leaf.

In cases where a trademark includes a representation of the Canadian flag, both a consent and a disclaimer are required. Consent may be requested at the following address:

State Ceremonial and Canadian Symbols  
State Ceremonial and Corporate Events Directorate  
Department of Canadian Heritage  
Ottawa, Ontario  
K1A 0M5

#### **4.7.4 Paragraphs 9(1)(f), (g), (g.1) and (h)**

These paragraphs list prohibitions against adoption or use as a trademark of the emblem of the Red Cross on a white ground, the expressions “Red Cross” or “Geneva Cross”, the emblem of the Red Crescent on a white ground, the third Protocol emblem, and the sign of the Red Lion and Sun used by Iran.

An objection will be raised when a trademark **as a whole** consists of, or so nearly resembles as to be likely mistaken for, the prohibited marks listed in these paragraphs. If additional elements, such as words, design features, etc., are added to the trademark, the trademark as a whole may not consist of, or so nearly resemble as to be mistaken for, these prohibited marks. Note that if a colour other than red is claimed as a feature of the trademark, then the trademark would not be considered to contravene the provisions of these paragraphs.

#### ***4.7.4.1 Paragraph 9(1)(h.1)***

This paragraph prohibits the adoption of any mark consisting of, or so nearly resembling as to be likely to be mistaken for, the international distinctive sign of civil defence (equilateral blue triangle on an orange ground) referred to in Article 66, paragraph 4 of Schedule V to the Geneva Conventions Act.

### **4.7.5 Paragraphs 9(1)(i) and 9(1)(i.1)**

Under Article 6ter of the Paris Convention, the Registrar may receive a communication from the International Bureau of the World Intellectual Property Organization advising of a request for protection in respect of a territorial or civic flag; a national, territorial or civic arm, crest or emblem; or an official sign or hallmark indicating control or warranty.

#### ***4.7.5.1 Paragraph 9(1)(i.2)***

The prohibition against adoption for use as a trademark of any national flag of a country of the Union requires neither a communication from the International Bureau nor public notice by the Registrar.

#### ***4.7.5.2 Paragraph 9(1)(i.3)***

Under Article 6ter of the Paris Convention, the Registrar may receive a communication from the International Bureau of the World Intellectual Property Organization advising of a request for protection in respect of any armorial bearing, flag or other emblem, or the name or any abbreviation of the name, of an international intergovernmental organization.

Public notice is given by way of advertisement in the Trademarks Journal. The information that is published in the Trademarks is also entered in the database which enables both the public and examiners to find any prohibited marks during a search.

### **4.7.6 Paragraph 9(1)(j)**

Paragraph 9(1)(j) of the Trademarks Act prohibits the adoption of any trademark consisting of, or so nearly resembling as to be likely to be mistaken for, any scandalous, obscene or immoral word or device.

In examining a trademark in respect of paragraph 9(1)(j) examiners may be guided by the following:

- A scandalous word or design is one which is offensive to the public or individual sense of propriety or morality, or is a slur on nationality and is generally regarded as offensive. It is generally defined as causing general outrage or indignation.
- A word is obscene if marked by violations of accepted language inhibitions or regarded as taboo in polite usage. This word “obscene” is generally defined as something that is offensive or disgusting by accepted standards of morality or decency; or offensive to the senses.

- A word or design is immoral when it is in conflict with generally or traditionally held moral principles, and generally defined as not conforming to accepted standard of morality.

In order to determine if a trademark is scandalous, obscene or immoral, examiners must determine whether the trademark would offend the feelings or sensibilities of a not insignificant segment of the public.

In *La Marquise Footwear Inc. Re.* (1946), 64 R.P.C. 27, Mr. Justice Evershed overruled the Registrar's decision to refuse to register the non-invented word OOMPHIES for shoes on the admitted ground that “oomph” was American slang for sex appeal. Evershed J., while overruling the Registrar, made it quite clear that he had no disagreement with the principles upon which the Registrar acted, stating at page 30:

I must wholeheartedly accept the proposition that it is the duty of the Registrar (and it is my hope that he will always fearlessly exercise it) to consider not merely the general taste of the time, but also the susceptibilities of persons, by no means few in number, who still may be regarded as old fashioned and, if he is of the opinion that the feelings or susceptibilities of such people will be offended, he will properly consider refusal of the registration.

Additionally, *Miss Universe, Inc. v. Bohna* (1991), 36 C.P.R. (3d) 76 (T.M.O.B.) [affirmed (1992) 43 C.P.R. (3d) 462 (F.C), and reversed for confusion (1994), 58 C.P.R. (3d) 381 (F.C.A)] states at 82 of the decision:

I must say that at present we live in what is commonly called a “permissive age” where previously accepted moral standards are undergoing change. The difficulty is to determine what are the acceptable standards today and what would still be considered immoral, scandalous, or obscene by some people by no means few in number.

Although it does not specifically say “not insignificant”, the wording “by no means few in number” connotes the same idea.

In another case, the refusal to register a trademark was based on the argument that the trademark would offend people's religious sensibilities. In *Hallelujah Trade Mark* [1976] R.P.C. 605, the word HALLELUJAH was refused registration in respect of articles of clothing for women on the grounds that the word had an overwhelming religious significance and, as applied to the goods, would offend accepted mores of the time. As such, the Office is of the view that trademarks containing any religious references are generally not considered to be proper subject matter for obtaining a trademark registration.

A trademark consisting of the representation of a topless dancer combined with a second representation of the torso of a topless dancer was found contrary to paragraph 9(1)(j) and was refused by the Registrar pursuant to paragraph 12(1)(e) (see application No. 409,882).

#### **4.7.7 Paragraph 9(1)(k)**

A trademark that consists of or so nearly resembles as to be likely to be mistaken for any matter that may falsely suggest a connection with any living individual is unregistrable pursuant to the provisions of paragraph 12(1)(e) of the Trademarks Act.

The purpose of raising an objection pursuant to paragraphs 12(1)(e) and 9(1)(k) of the Trademarks Act is not to deny registration of the individual's name or any matter related to the individual but to ensure

that there is no appropriation or exploitation of the name or other matter for commercial purposes without permission from the individual. As Justice Montgomery stated in *Baron Philippe de Rothschild, S.A. v. La Casa de Habana Inc.* (1987), 19 C.P.R. (3d) 114, “One cannot commercially exploit another's name or likeness without his permission. In my view the tort of appropriation of personality has been committed and must be enjoined.”

#### ***4.7.7.1 Falsely suggest a connection***

Since the wording of paragraph 9(1)(k) lends itself to a broad interpretation, examiners must pay particular attention to any way in which a trademark might “falsely suggest a connection with any living individual”. Examiners must be aware of any details such as a nickname, caricature, original element of clothing or some other characteristic which the public associates with the living individual and which cannot be registered as a trademark if it falsely suggests a connection with that individual. See *Carson v. Reynolds* (1980), 49 C.P.R. (2d) 57.

Examiners must consider whether the average consumer of the associated goods or services would be misled by the use of the trademark into assuming that the individual has sponsored, approved or supported the applicant's goods or services or that the applicant's goods or services are a “spin-off” from the individual's activities. See *Jean Cacharel, S.A. v. Reitman's (Canada) Ltd.* (1984), 3 C.P.R. 459 and *Daniel Hecter v. SA Daniel D. Société Anonyme* (1990), 31 C.P.R. (3d) 61.

If the living individual is the applicant, then there is no false connection and the registrability of the trademark is not contrary to paragraph 12(1)(e).

However, if the applicant is not the living individual then consent as described in paragraph 9(2)(a) will be required to overcome the objection.

In view of *Jack Black L.L.C. v. Canada (Attorney General)* (2014), 127 C.P.R. (4th) 192, and in cases where consent to the use and registration of the trademark pursuant to paragraph 9(2)(a) of the Act has not been provided, the Registrar may consider arguments based on evidence filed by way of affidavit or statutory declaration that establishes that no connection with the living individual was ever intended by the applicant, that there have been no complaints from the living individual concerning the use of the trademark in Canada, and that there have been no instances of the goods and services being sold or provided on the mistaken belief that they are in any way connected to the living individual.

#### ***4.7.7.2 Significant public reputation***

When assessing registrability of the name of any living individual or any matter which would falsely suggest a connection with any living individual, examiners must determine if the living individual has “significant public reputation”. A living individual is considered to have “significant public reputation” in Canada when a significant number of Canadians know of the particular individual with whom the trademark falsely suggests a connection. See *Carson*, supra; *Bousquet v. Barmish Inc.* (1991), 37 C.P.R. (3d) 516, affirmed (1993), 46 C.P.R. (3d) 510; and *Jack Black L.L.C.*, supra.

In the context of examination under paragraph 9(1)(k) of the Act, and following the principles laid out in *Bousquet*, supra, examiners will research information that is available to the general public in Canada to determine if there is evidence that the individual has “significant public reputation” and that a significant number of Canadians would be led to believe that the goods or services associated with the applicant's trademark are connected to the living individual. See *Jack Black L.L.C.*, supra. In conducting research, consideration may be given to websites referring to the living individual and evidence regarding the

number of Canadians who have accessed the websites as well as articles found in major Canadian daily newspapers with substantial circulation. See *Villeneuve v. Mazsport Garment Manufacturing Inc.* (2005), 50 C.P.R. (4th) 127 and *Waltrip v. Boogiddy Boogiddy Racing Inc.* (2007), 64 C.P.R. (4th) 357.

#### **4.7.7.3 Musical bands**

Where a trademark consists of any matter which would falsely suggest a connection with a musical band, an objection may be raised pursuant to paragraph 9(1)(k) of the Trademarks Act if it is determined through research that the musical band has a significant public reputation in Canada.

The word “band” is defined in the Canadian Oxford Dictionary as “a group of musicians playing jazz, rock, or pop music”. Given on the Interpretation Act provides that “words in the singular include the plural, and words in the plural include the singular”, paragraph 9(1)(k) of the Trademarks Act applies equally to a living individual and to living individuals.

#### **4.7.7.4 Consent**

Also see section [4.7.14](#) of this Manual.

An objection raised pursuant to paragraph 9(1)(k) of the Act can be overcome with a letter of consent as described in paragraph 9(2)(a) of the Act.

If consent is provided, the statement “Consent from XXX is of record” (where XXX is the name of the person(s) providing consent) will be included in the particulars of the application and published in the advertisement details.

For musical bands, consent can be provided by the members of the band, one member of the band if he or she is entitled to give consent, or by someone authorized to do so on their behalf (their manager, record company, etc.). The matter of determining who is authorized to provide consent on behalf of the band will rest with the applicant.

### **4.7.8 Paragraph 9(1)(l)**

Paragraph 9(1)(l) of the Trademarks Act prohibits the adoption of any trademark consisting of, or so nearly resembling as to be likely to be mistaken for, the portrait or signature of any individual who is living or has died within the preceding thirty years.

This prohibition may be overcome pursuant to paragraph 9(2)(a) of the Trademarks Act with a letter of consent from the individual whose portrait or signature is in the trademark. If consent is provided, the statement “Consent from XXX is of record” (where XXX is the name of the person(s) providing consent) will be included in the particulars of the application and published in the advertisement details.

A letter of consent is not required if the individual is the applicant.

If the trademark is in whole or in part not a signature *per se* (e.g. it is merely a name in a stylized font), consent is not required. In such situations, the applicant will be required to provide confirmation in writing that the trademark is not the signature of an individual.

A letter of consent from an authorized person, such as the executor of the individual's estate, is required if the individual has died within the preceding thirty years.

**Note:** A trademark which is in whole or in part a portrait or signature may also be prohibited pursuant to the provisions of paragraph 9(1)(k) of the Act if the mark falsely suggests a connection with a living individual.

**Note:** Examiners will not consider the registrability of a signature pursuant to the provisions of paragraph 12(1)(a) of the Act. The Office considers a signature of an individual to be inherently distinctive since it is unique to that individual.

### **4.7.9 Paragraph 9(1)(m)**

Paragraph 9(1)(m) of the Trademarks Act prohibits the adoption of any trademark consisting of, or so nearly resembling as to be likely to be mistaken for, the words "United Nations" or the official seal or emblem of the United Nations.

### **4.7.10 Paragraph 9(1)(n)**

This paragraph provides for the protection of any badges, crests, emblems or marks of her Majesty's Forces, of any university, or adopted and used by any public authority in Canada as an official mark for goods or services.

A mark for which public notice has been given under subparagraph 9(1)(n) is a bar to the registration of any trademark which so nearly resembles it so as likely to be mistaken for it.

In assessing the resemblance between a trademark and a mark prohibited under paragraph 9(1)(n), examiners will apply the test as set out in *Big Sisters Assn. of Ontario v Big Brothers of Canada* (1997), 75 C.P.R. (3d) 177:

the question must be determined in the context of whether a person, who, on a first impression, knowing of one mark only and having an imperfect recollection of it, would likely be deceived or confused.

In the same decision, Gibson J. also held that consideration may be given to the factors set out in paragraph 6(5)(e) of the Act, particularly the degree of resemblance between the marks in appearance or sound or in the ideas suggested by them.

Examiners will only consider the resemblance between the trademark and the prohibited mark, and not the nature of the goods or services or business nor the nature of the trade. See *Canadian Council of Professional Engineers v. APA-The Engineered Wood Assn.* (2000), 7 C.P.R. (4th) 239 (F.C.T.D.) at p. 258:

The wares or services in association with which the mark is sought to be used may be completely different, sold to completely different consumers, in completely different settings, through a completely different marketing and distribution system. Nonetheless, the mark cannot be adopted or registered in the face of the existence of an official mark.

Once public notice of a mark has been given under paragraph 9(1)(n), it becomes a prohibited mark and generally may not be adopted as a trademark. Accordingly, the trademark must defer to the prohibited mark where public notice has been given and an identical trademark, or one so nearly resembling as to be likely to be mistaken for it, is the subject of a pending application that has not been advertised in the

Trademarks Journal. See *Canadian Olympic Assn. v. Olympus Optical Co.* (1991), 38 C.P.R. (3d) 1 at pages 3-4:

Counsel for the appellant strongly urges that the June 11, 1986 public notice is not to be considered because the date on which registrability is to be determined is the date the application for registration was advertised or, at the latest, the date on which the opposition was filed. We are unable to agree. In our view, the appellant acquired no rights to registration on either of those dates and the question of registrability remained at large until the matter was finally disposed of. Indeed, this view is supported by *Canadian Olympic Assn.*, supra, in which MacGuigan J.A. stated at page 166, that the “right to register the mark is... prohibited from the time of the giving of the public notice”: see also *Park Avenue Furniture Corp. v. Wickes/Simmons Bedding Ltd.*, Court File No. A-263-89, judgment rendered June 24, 1991, per Desjardins J.A., at pages 9-12 [since reported 37 C.P.R. (3d) 413 at pages 422-4, 28 A.C.W.S. (3d) 103].

In our view, it is of no moment that the appellant submitted an application for registration or that the application was advertised or that the application was opposed before the June 11, 1986 public notice was given. What is critical is that at the time the application was disposed of that notice had been given. The office of the Registrar in disposing of the application was obliged by the statute to give full effect to the prohibition thus created.

The state of the register is of no relevance to the issue as to whether the a trademark consists of or so nearly resembles an official mark as to be likely to be mistaken for it. See *Canadian Olympic Association v. IMI Norgren Enots Ltd.* 23 C.P.R. (3d) 389).

#### ***4.7.10.1. Paragraph 9(1)(n.1)***

This paragraph provides for the protection of any armorial bearings granted, recorded or approved for use, pursuant to the prerogative powers of Her Majesty as exercised by the Governor General in respect of the granting of armorial bearings, if the Registrar has at the request of the Governor General given public notice of the grant, recording or approval.

### **4.7.11 Paragraph 9(1)(o)**

This paragraph of the Trademarks Act prohibits the adoption of any trademark consisting of, or so nearly resembling as to be likely to be mistaken for, the name “Royal Canadian Mounted Police” or “R.C.M.P.” or any other combination of letters relating to the Royal Canadian Mounted Police, or any pictorial representation of a uniformed member thereof.

### **4.7.12 Section 10**

In order to refuse a trademark under section 10, examiners must first establish that, in ordinary commercial usage, the trademark is recognized by dealers or purchasers in Canada as designating the kind, quality, quantity, destination, value, place of origin or date of production of any goods or services.

Use of the trademark by the applicant and others in printed matter such as catalogues, in a non-trademark sense as designating the kind, quality, quantity, destination, value, place of origin or date of production of any goods or services, may be a basis for a first office action.

In the opposition decision of *Simmonds Aerocessories Ltd. v. Elastic Stop Nut Corp.* (1960), 34 C.P.R. 245, the Registrar considered the registrability of the red fibre locking sleeve for a lock nut. After reviewing the evidence, which disclosed the use of like fibre locking sleeves in Canada by other manufacturers for several years, the application was refused pursuant to section 10.

Examiners may also refuse trademarks which, through frequent and prolonged use in the marketplace (e.g., “moped” for motor powered vehicles), are recognized by dealers in or purchasers of the goods as designating the kind of goods or services.

### **4.7.13 Sections 9 and 10 – Informing the applicant**

When examiners find a trademark that consists of, or so nearly resembles as to be likely to be mistaken for, a prohibited mark, they must, in communicating with the applicant, identify which part of sections 9 or 10 is being applied. They must also state that the trademark is not registrable under the provisions of paragraph 12(1)(e) of the Act.

### **4.7.14 Paragraph 9(2)(a) – Consent**

Paragraph 9(2)(a) of the Trademarks Act provides a means whereby, with the consent of Her Majesty or such other person, society, authority or organization considered protected by subsection 9(1), prohibited matter may be adopted, used or registered as a trademark. The consent must clearly indicate that it is consent to the use and registration of the trademark. The consent must include either the pending application number or the trademark and list the goods or services associated with the application, unless it can be interpreted as a blanket consent for any trademark application or any goods and services. Lastly, consent cannot be restricted to a period of time.

If consent is provided, the statement “Consent from XXX is of record” (where XXX is the name of the person(s) or organization(s) providing consent) will be included in the particulars of the application and published in the advertisement details.

If the applicant provides evidence sufficient for the Registrar to determine that a public authority no longer exists, an objection under paragraph 12(1)(e) and 9(1)(n)(iii) of the Act may be withdrawn pursuant to section 37 of the Act since the Registrar cannot be satisfied that the trademark is not registrable.

#### ***4.7.14.1 Paragraph 9(2)(b)***

Subparagraph 9(2)(b)(i) stipulates that an objection may only be raised if the trademark consists of, or so nearly resembles as to be likely to be mistaken for a prohibited mark mentioned in paragraph 9(1)(i.1), for goods that are the same or similar to the goods in respect of which the official sign or hallmark has been adopted.

Subparagraph 9(2)(b)(ii) stipulates that an objection may only be raised if the trademark consists of, or so nearly resembles as to be likely to be mistaken for a prohibited mark mentioned in paragraph 9(1)(i.3), and the use of the trademark is likely to mislead the public as to a connection between the user and the organization.

#### **4.7.15 Paragraph 12(1)(f) and section 10.1 – Plant variety denominations**

Where a denomination must, under the Plant Breeders' Rights Act, be used to designate a plant variety, no person shall adopt it as a trademark in association with the plant variety or another plant variety of the same species or use it in a way likely to mislead. Nor shall any person so adopt or so use any mark so nearly resembling that denomination as to be likely to be mistaken for it.

Agriculture and Agri-Food Canada has the mandate to grant rights for denominations of plant varieties under the Plant Breeders' Rights Act. These rights give owners control over the multiplication and sale of reproductive material. Protection is for up to eighteen years.

The grants are published in the Plant Varieties Journal, a copy of which is sent to the Trademarks Office regularly. The Office then incorporates this information in the register which enables both members of the public and examiners to find these prohibited marks during a search.

In cases where a trademark is the same as or similar to one of these prohibited marks and the application covers the plant variety or another plant variety of the same species, the examiner must raise an objection under paragraph 12(1)(f) of the Act.

**Note:** A disclaimer cannot overcome an objection raised under paragraph 12(1)(f) of the Act.

#### **4.7.16 Paragraphs 12(1)(g), (h) and (h.1) – Protected geographical indications for wines, spirits or agricultural products and food**

These paragraphs relate to protected geographical indications for wines, spirits or agricultural products and food. The Registrar of Trademarks is required to keep a list of protected geographical indications and, in the case of geographical indications identifying an agricultural product or food, translations of those indications, in accordance with subsection 11.12(1) of the Trademarks Act.

If the trademark is in whole or in part a protected geographical indication and the application covers wines or spirits not originating in a territory indicated by the geographical indication, or the application covers an agricultural product or food belonging to the same category as the agricultural product or food identified by the geographical indication and not originating in a territory indicated by the geographical indication, the application is contrary to paragraph 12(1)(g), (h) or (h.1) of the Act, as applicable.

To overcome an objection raised pursuant to paragraph 12(1)(g), (h) or (h.1), the applicant must provide a written statement that the goods originate in a territory indicated by the geographical indication.

A disclaimer does not overcome an objection raised pursuant to paragraph 12(1)(g), (h) or (h.1) of the Act.

#### **4.7.17 Paragraph 12(1)(i) — Olympic and Paralympic Marks Act**

Paragraph 12(1)(i) of the Trademarks Act states:

Subject to section 13, a trademark is registrable if it is not ...

(i) subject to subsection 3(3) and paragraph 3(4)(a) of the Olympic and Paralympic Marks Act, a mark the adoption of which is prohibited by subsection 3(1) of that Act.

Section 3 of the Olympic and Paralympic Marks Act states:

3. (1) No person shall adopt or use in connection with a business, as a trademark or otherwise, an Olympic or Paralympic mark or a mark that so nearly resembles an Olympic or Paralympic mark as to be likely to be mistaken for it.

(3) Subsections (1) and (2) do not apply to an organizing committee, the COC or the CPC.

(4) Nothing in subsection (1) or (2) prevents:

(a) the adoption, use or registration, as a trademark or otherwise, of a mark described in subsection (1) or (2) if the person has obtained the written consent of an organizing committee during any period prescribed by regulation or of the COC or the CPC during any other period, and acts in accordance with that consent;....

An objection must be raised if the trademark consists of or so nearly resembles an Olympic or Paralympic mark as to be likely to be mistaken for it. As of January 1, 2011, only marks found on schedule 1 of the Olympic and Paralympic Marks Act are to be considered. These trademarks will show up on the search results performed by examiners. To distinguish them, a footnote has been inserted indicating that these are not official trademarks but that they have been added as part of Bill C-47.

## **4.8 Subsection 12(2) – Functionality**

Examiners will assess, under subsection 12(2) of the Trademarks Act, whether the features of a trademark, in relation to the associated goods or services, are dictated primarily by a utilitarian function. See *Remington Rand v. Philips* (1995), 64 C.P.R. (3d) 467.

### **4.8.1 Purpose**

Subsection 12(2) of the Trademarks Act denies registration of a trademark if, in relation to the goods or services listed in the application, its features are dictated primarily by a utilitarian function. This provision is considered an absolute bar to registration since the Act does not permit an applicant to file evidence showing that the trademark had acquired distinctiveness as of the filing date. For this reason, an objection under subsection 12(2) of the Act may be overcome either by convincing the Registrar that the trademark's features are not dictated primarily by a utilitarian function, or by excluding those features from the trademark (by way of a statement to that effect and by depicting the feature(s) in dotted outline in any visual representation).

The legal principle of the functionality doctrine in trademark law prohibits registration of functional product features. The functionality doctrine, as noted by the Supreme Court of Canada in *Kirkbi AG v. Ritvik Holdings Inc.*, [2005] 3 S.C.R. 302, 2005 SCC 65 (“Kirkbi”), ensures that protection for utilitarian product features are provided through a limited-duration patent, and not through the potentially time-unlimited (by way of renewal) protection of a trademark registration.

A trademark's features are dictated primarily by a utilitarian function if those features are essential to the use or purpose of the goods or services listed in the application. As the Supreme Court noted in *Kirkbi*,

the issue is whether the trademark's features are primarily designed to perform a function and whether registration would grant a trader a monopoly on their functional features.

Given that the main purpose of this provision of the Act is to ensure that patent rights are not extended indefinitely through trademark protection, it will generally not be applicable to trademarks that consist of words.

## 4.8.2 Examples

The following is a non-exhaustive list of the types of trademarks for which a functionality objection under subsection 12(2) of the Act may be raised.

### 4.8.2.1 A *three-dimensional shape*

Trademarks which consist of a three-dimensional shape (whether the whole or only a part) of any of the goods in the application are unregistrable if the shape of the object primarily serves a function. This type of functionality has been detailed extensively by the courts in Canada. Examiners will conclude that a shaping of goods is functional by determining whether the shape serves no other purpose than to provide a function. In other words, if the shape does not appear to be merely ornamental, incidental, or arbitrary, an objection will generally be raised.

A good indication that a trademark consisting of a three-dimensional shape is functional is if the features of the trademark are covered by a patent (whether or not expired), since it is likely that the features of the trademark are dictated primarily by a utilitarian function.

For example, in *Imperial Tobacco Co. v. Registrar of Trade Marks* [1939] DLR 65, 1939 CanLII 261 (FC), the Federal Court agreed with the Registrar who refused the trademark, a distinguishing guise described as "a transparent outer wrapper with a coloured band extending around the package," for being functional and therefore unregistrable. The Court noted that the applicant owned two prior patents for these features and noted:

One cannot read the specifications of those two patents without concluding that they describe precisely the principal features of the trade mark for which the appellant now seeks registration. The alleged inventions disclosed in those patents were intended to perform certain functions, both the wrapper and the tearing strip, and one of the patents states that it was desirable to have the tearing strip of a colour different to that of the wrapper, so that the former would be readily visible by reason of its contrast with the outer wrapper.

It seems to me that the trade mark applied for was intended to replace the patents referred to, if they should be found to be invalid, as they were. In my opinion any combination of elements which are primarily designed to perform a function, here, a transparent wrapper which is moisture proof and a band to open the wrapper, is not fit subject-matter for a trade mark, and if permitted would lead to grave abuses.

In another example, the Federal Court of Appeals, in *Remington Rand Corp. v. Philips Electronics N.V.* ([1995], 191 NR 204 (FCA)), expunged registrations for a two-dimensional design and a distinguishing guise for a triple-headed rotary head assembly for electric razors, the features of the trademark being primarily functional:

Here, the shaver heads are functional and the three-headed equilateral triangular configuration is functional. The design mark, by depicting those functional elements, is primarily functional. [...]

The distinguishing guise in the case at bar is in my opinion invalid as extending to the functional aspects of the Philip shaver. A mark which goes beyond distinguishing the wares of its owner to the functional structure of the wares themselves is transgressing the legitimate bounds of a trademark.

#### ***4.8.2.2 Colour***

Colour(s), with or without delineated contours, are unregistrable if their purpose is primarily functional. For example, the colour red functions primarily as a warning in association with traffic signs and is therefore unregistrable for those goods. The colour blue indicates the supply of cold water in association with plastic and metal pipes and is therefore unregistrable for those goods.

#### ***4.8.2.3 Sound***

Sound marks will generally be considered functional if sound is essential to the purpose of the associated goods or services. For example, as the primary purpose of a ring tone, alarm clock, door bell, or security alarm is to provide sound, sound marks are generally unregistrable in association with these goods.

#### ***4.8.2.4 Taste***

Taste marks will generally be considered functional in association with goods or services whose primary purpose is to provide or impart a flavour. For example, a taste mark in association with food flavourings is unregistrable.

#### ***4.8.2.5 Scent***

Scent marks are generally unregistrable in association with goods whose primary function is to impart a scent. For example a scent mark in association with perfumes or air fresheners are unregistrable.

## **4.9 Paragraph 32(1)(b) – Not Inherently Distinctive**

### **4.9.1 General**

For an application for the registration of a trademark not to be refused, the trademark must have some degree of inherent distinctiveness or must have acquired distinctiveness at the time of filing of the application. The Registrar's authority to raise an objection that a trademark is not inherently distinctive stems from paragraph 32(1)(b) of the Trademarks Act (the "Act") which states:

An applicant shall furnish the Registrar with any evidence that the Registrar may require establishing that the trademark is distinctive at the filing date of the application for its registration if any of the following apply:

the Registrar's preliminary view is that the trademark is not inherently distinctive

The term "distinctive" is defined in section 2 as:

in relation to a trademark, describes a trademark that actually distinguishes the goods or services in association with which it is used by its owner from the goods or services of others or that is adapted so to distinguish them.

Paragraph 37(1)(d) provides that an application for registration shall be refused if the Registrar is satisfied that the trademark is not distinctive. If the Registrar is not satisfied that the trademark is not distinctive, then the application must be advertised.

## 4.9.2 Distinctiveness

As stated in H.G. Fox, *Canadian Law of Trade Mark*, 3rd ed. (Toronto: Carswell, 1972), at 25:

the essence of a protectable trade mark and the foundation of trade mark law...is and always has been distinctiveness. 'Distinctiveness means some quality in the trade mark which earmarks the goods so marked as distinct from those of other producers of such goods'.

The Act provides for two different situations in which a trademark can be said to possess distinctiveness, the first being a trademark that "actually distinguishes" and the second being a trademark "adapted so to distinguish," the goods or services of the trademark owner from the goods or services of others.

On the one hand, a trademark "actually distinguishes" by acquiring distinctiveness through use, resulting in distinctiveness in fact. On the other hand, a trademark that is "adapted so to distinguish" is one that does not depend upon use for its distinctiveness because it is inherently distinctive [see *Astrazeneca AB v. Novopharm Ltd.*, 2003 FCA 57 (CanLII) at para 16].

## 4.9.3 Inherently distinctive

The phrase "not inherently distinctive" in paragraph 32(1)(b) refers to a trademark having "no inherent distinctiveness" (not registrable) as opposed to a trademark possessing a "low degree of inherent distinctiveness" (registrable).

There is a spectrum of inherent distinctiveness, ranging from no inherent distinctiveness to high inherent distinctiveness. Trademarks possess some inherent distinctiveness when nothing about them refers the consumer to a multitude of sources when assessed in relation to the associated goods or services. Where a trademark may refer to many sources, it is considered to have no inherent distinctiveness.

As stated by the Federal Court in *ITV Technologies Inc. v. WIC Television Ltd.*, 2003 FC 1056 (CanLII), *aff'd* 2005 FCA 96 (CanLII) at paras 119-121:

The inherent distinctiveness of a mark refers to its originality. A mark that is composed of a unique or invented name, such that it can only refer to one thing, will possess more inherent distinctiveness than a word that is commonly used in the trade.

For a trademark to lack inherent distinctiveness, it is not necessary that the trademark contravene paragraphs 12(1)(a), (b) or (c) of the Act. For example, in *Canadian Council of Professional Engineers v. Apa - The Engineered Wood Assn.*, 2000 CanLII 15543 (FC), the Federal Court noted that

while it may be true that a purely descriptive or a deceptively misdescriptive trademark is necessarily not distinctive, it is not correct to hold that merely because a mark is adjudged not to be either purely descriptive or deceptively misdescriptive, it is therefore distinctive.

Where a trademark does not have inherent distinctiveness, it may still acquire distinctiveness through for example, continuous and long-standing use. To establish this acquired distinctiveness, it must be shown that the trademark has become known to consumers as originating from one particular source.

#### **4.9.4 Examination**

Any assessment as to whether a trademark is inherently distinctive requires consideration of the trademark in association with the goods or services assuming no use (as defined in section 4 of the Act). In other words, is it the sort of trademark which can distinguish the source of the goods or services without first educating the public that it is a trademark?

One of the questions an Examiner must answer when deciding whether a trademark is inherently distinctive is whether other traders should be able, in the ordinary course of their businesses, to use the same trademark in association with the same goods or services.

While the fact that other traders are not currently using a trademark in association with their goods or services is not determinative, it is one of the factors that should be considered in assessing distinctiveness. The ultimate question is whether other traders should be free to use that trademark in association with their goods and services.

Alternatively, if research points to use in Canada by others in the trade, the trademark is likely to have no inherent distinctiveness as the public would not respond to the trademark as identifying only one source. A trademark is inherently distinctive when nothing about it refers the consumer to a multitude of sources (*Compulife Software Inc. v. Compuoffice Software Inc.*, 2001 FCT 559 (CanLII) at para 19).

The question of whether a trademark is distinctive (whether inherent or acquired) cannot be considered in the abstract but rather must be considered in relation to the goods or services for which registration is sought. It must also consider the first impression of the average Canadian consumer of those goods or services.

When raising an objection, examiners must provide a clear explanation why the trademark is not inherently distinctive. Examiners must also indicate whether the objection relates to all the associated goods or services, or only to some (in which case examiners should specifically identify those goods/services to which the objection relates). Moreover, if the Registrar's preliminary view is that the trademark is not inherently distinctive due to use of the trademark by others in the marketplace, that view must be informed by objective evidence which should be provided to the applicant, including the results of any research by the examiner. If only a portion of the trademark is considered not inherently distinctive, but other portions have at least some inherent distinctiveness, the trademark as a whole will be considered to have some inherent distinctiveness and an objection under paragraphs 37(1)(d) and 32(1)(b) of the Act will not be raised.

#### **4.9.5 Examples**

The following sections provide examples of trademarks that would, generally, be considered to have no inherent distinctiveness. What follows is not an exhaustive list; examiners must apply the relevant test on a case-by-case basis. Moreover, the examples are meant for illustrative purposes under the current legislation and in no way comment on the registrability of trademarks registered under previous legislation. If an objection under paragraphs 37(1)(d) and 32(1)(b) of the Act is raised, it will be because it is the Registrar's preliminary view that the trademark is not inherently distinctive.

#### ***4.9.5.1 Geographic locations***

Trademarks which are primarily geographic locations are generally not inherently distinctive even if the place is not known for those goods or services (see *London Drugs Limited v. International Clothiers Inc.*, 2014 FC 223 (CanLII):

This Court has consistently held that geographic designations ... are not inherently distinctive and should not be accorded a high degree of protection unless, of course, they have acquired distinctiveness over time. Nobody can claim a monopoly on a geographic name, especially when it is as well-known as LONDON. The best-known case in that respect is *California Fashion Industries Inc. v. Reitmans (Canada) Ltd.* (1991), 38 C.P.R. (3d) 439 (Fed. T.D.) ...

In any event, subsequent cases from this Court and from the Court of Appeal have confirmed that geographical names are not inherently distinctive, even when associated with wares and services that are not typically associated with that area: see *Wakefield Realty Corp. v. Cushman & Wakefield Inc.* (2004), 35 C.P.R. (4th) 460 (F.C.), [2004 FC 210 (CanLII)] at para 42, aff'd (2004), 37 C.P.R. (4th) 212 (F.C.A.) [2004 FCA 415 (CanLII)], at para 6; *Prince Edward Island Mutual Insurance Co. v. Insurance Co. of Prince Edward Island* (1999), 86 C.P.R. (3d) 342 (Fed. T.D.) [1999 CanLII 7462 (FC)] at paras 32-33.

#### ***4.9.5.2 Generic designs***

A trademark that consists of a design common to the trade lacks inherent distinctiveness unless it is depicted in a special or fanciful manner. For example, an ordinary representation of grapes and vine leaves for wine would not be considered capable of distinguishing one trader's wine from that of another. Other examples of designs common to the trade include cats, dogs or other animals for pet food or veterinary services, lightning flashes for electrical apparatus, orchard scenes for fruit.

#### ***4.9.5.3 Names of colours***

A trademark that is the word for a colour is considered to have no inherent distinctiveness in relation to goods that would ordinarily or typically be that colour (e.g. ORANGE in association with outerwear; WHITE with paper; RED with toy fire engines, YELLOW with tennis balls).

#### ***4.9.5.4 One- and two-letter or -number trademarks***

Single letter or number trademarks will generally be considered not inherently distinctive, due to the likelihood of other traders needing to use a simple, unembellished single letter or number in the form of initials, abbreviations, or to indicate an amount.

Two-letter or number trademarks can be inherently distinctive, but those commonly used in a specific field are generally not inherently distinctive. For example, GT and LE are used by a number of traders in the vehicle industry to indicate performance or limited-edition goods and do not serve to distinguish.

Furthermore, the addition of such letter(s) or number(s) to a trademark that is not inherently distinctive will not normally render the trademark as a whole inherently distinctive.

#### ***4.9.5.5 English and French***

Trademarks that consist of words/phrases that are clearly descriptive in both English and French lack inherent distinctiveness (e.g. FURNITURE STORE / MAGASIN DE MEUBLES in association with the retail sale of furniture, TASTY FRITES in association with french fries).

#### ***4.9.5.6 Foreign characters and words***

The examination of trademarks that consist of or contain words not in English or French, including those containing non-Latin characters, must consider the average Canadian consumer of the associated goods or services who has knowledge of that language. A ground for rejecting an application may exist where the trademark is not in English or French and this consumer is likely to understand the meaning of the word(s) or characters and the ordinary signification to them is something that should be available for use by other traders to describe their goods or services. Examples of such specific goods or services include newspapers targeted at specific portions of the community, translation services, or language training.

When words that lack inherent distinctiveness are combined with words in another language that have the same or similar meaning, the resultant combination may also lack inherent distinctiveness, especially in fields where it is common to include indications regarding characteristics of the goods or services in multiple languages (e.g. SIZE TAILLE TALLA in association with clothing).

#### ***4.9.5.7 Multiple surnames***

Two or more surnames that are not, individually, inherently distinctive are generally considered inherently distinctive when they are combined. The need for other traders to use the combination in relation to similar goods or services is relatively low. For example, SMITH JOHNSON, THOMPSON SPRATLEY are combinations that are, generally, inherently distinctive.

#### ***4.9.5.8 Names and honorifics***

The addition of common honorifics, either pre- (e.g. MRS., MR., DR., DAME, SIR) or post-nominally (e.g. ESQ.) to a surname or full name will generally not render a trademark inherently distinctive.

#### ***4.9.5.9 Laudatory words and phrases***

Words or phrases that laud the worth, importance or value of a good or service are generally not inherently distinctive. For example, the following non-exhaustive list includes words and phrases that are generally not inherently distinctive:

- ULTIMATE
- AUTHENTIC

- ORIGINAL
- QUALITY
- VALUE
- WONDERFUL
- TERRIFIC
- WORLD'S BEST
- CANADA'S BEST

These examples are in addition to words or phrases that are considered clearly descriptive under paragraph 12(1)(b) of the Act.

#### ***4.9.5.10 Provides generic information***

Trademarks that serve only to provide general information about or on any goods or services are not inherently distinctive e.g. FRAGILE in association with labels to be affixed to goods or packaging; CONTENTS ARE HOT for takeout restaurant services; the biohazard symbol in association with containers that could contain biohazardous materials; or the recycle symbol on plastic bags.

#### ***4.9.5.11 Combinations of unregistrable elements***

Trademarks for which an objection is raised under section 12 of the Act, particularly paragraphs 12(1)(a), (b) and (c), are considered not inherently distinctive. As well, the combination of words or designs that would, independently, be considered unregistrable under these paragraphs are generally not considered to be inherently distinctive.

For example, the following trademarks would be considered not inherently distinctive:

ALFREDSON'S BEST (in association with the goods "carrots") which consists of a surname and a word that is a laudatory epithet and considered to be clearly descriptive;

BEST CARROTS (in association with the goods "carrots") which consists of a word that would be considered clearly descriptive in combination with a word that is the name of the goods;

ALFREDSON'S CARROTS (in association with the goods "carrots") which consists of primarily merely a surname and a word that is the name of the goods;

ALFREDSON'S BEST CARROTS (in association with the goods "carrots") consists of a combination of primarily merely a surname, a laudatory epithet, and the name of the goods.

#### ***4.9.5.12 Paragraphs 12(1)(a), or (b) of the Act***

If an objection is raised because the trademark is primarily the name or surname under paragraph 12(1)(a) of the Act or because it is clearly descriptive or deceptively misdescriptive under paragraph 12(1)(b), the Examiner will also raise an objection under paragraphs 37(1)(d) and 32(1)(b). If an

objection is raised only under paragraph 12(1)(c) because the trademark is the name in any language of any of the goods or services, the examiner will not raise an objection under paragraphs 37(1)(d) and 32(1)(b) since the name of the goods or services can never acquire distinctiveness.

#### ***4.9.5.13 Possessive determiners***

Adding possessive determiners such as MY, OUR or YOUR to a clearly descriptive trademark does not render it inherently distinctive, e.g. OUR FINEST LEMONADE, YOUR NUMBER ONE HARDWARE STORE.

#### ***4.9.5.14 Internet TLDs, and URLs***

A trademark composed solely of a top-level domain (“TLD”) in association with the operation of a domain-name registry or registrar services is not inherently distinctive, as consumers are predisposed to view TLDs as a portion of a web address rather than as an indicator of the source of domain-name registry operator and registrar services.

The addition of a Uniform Resource Locator (URL) or TLD to an otherwise unregistrable trademark generally does not add to the inherent distinctiveness of the trademark. For example, WWW.BUYPOSTERS.COM in association with the sale of posters is not inherently distinctive because the addition of “www.” and “.com” to the clearly descriptive portion “buyposters” does not render the trademark as a whole inherently distinctive.

#### ***4.9.5.15 Phone numbers***

A trademark that consists of a numerical telephone number is not inherently distinctive as it serves only to identify the number assigned to a telephone; it does not inherently identify a source of goods or services.

#### ***4.9.5.16 Forms of business association***

Words and abbreviations that describe the legal form of a business such as: Limited, Company, Partnership, LLC, Ltd., GmbH, etc. generally are not inherently distinctive and do not add to the distinctiveness of a trademark (for example, in *D & S Meat Products Ltd. v. Peameal Bacon of Canada Ltd.*, 2013 TMOB 21 (CanLII) the Trademarks Opposition Board found that the addition of “LTD.” did not render the trademark registrable).

#### ***4.9.5.17 Colour(s) applied to the surface of a three-dimensional object***

Trademarks that consist of colour(s) applied to the surface of a three-dimensional object will generally not be considered inherently distinctive if research shows that they are commonly or generically used by a number of traders in the related marketplace. For example, the colour red applied to the surface of a fire hydrant lacks any inherent distinctiveness in association with the goods “hydrants” or the services “delivery of water for fire suppression purposes” but would be considered to have some inherent distinctiveness in association with “retail sale of hot peppers”.

## **4.9.6 Overcoming an objection raised under paragraphs 37(1)(d)/32(1)(b)**

An applicant may respond to an objection that a trademark is not inherently distinctive by submitting arguments that the Registrar's preliminary view should not be that the trademark is not inherently distinctive. Alternatively, an applicant may overcome an objection by filing evidence that the trademark was distinctive at the filing date of the application for its registration. Please refer to section [4.10 Evidence of Distinctiveness](#) of this Manual on assessing evidence of acquired distinctiveness.

## **4.10 Subsection 32(1) – Evidence of Distinctiveness**

### **4.10.1 General**

Subsection 32(1) of the Trademarks Act lists the circumstances in which the Registrar may require an applicant to file evidence establishing that the trademark is distinctive at the filing date (not taking into account any priority filing date):

- a. the applicant claims that their trademark is registrable under subsection 12(3);
- b. the Registrar's preliminary view is that the trademark is not inherently distinctive;
- c. the trademark consists exclusively of a single colour or of a combination of colours without delineated contours;
- d. the trademark consists exclusively or primarily of one or more of the following signs:
  - i. the three-dimensional shape of any of the goods specified in the application, or of an integral part or the packaging of any of those goods,
  - ii. a mode of packaging goods,
  - iii. a sound,
  - iv. a scent,
  - v. a taste,
  - vi. a texture

A trademark becomes distinctive in Canada when it has come to be recognized by the Canadian public as a trademark which, in association with the goods or services listed in the application, serves to distinguish the goods or services of the applicant from those of others. The trademark is said to have acquired a secondary meaning with respect to the goods or services in that when the trademark is presented to the public, whatever primary meaning it may have is submerged, and the trademark significance dominates.

## 4.10.2 Form of Evidence

As it is possible to appeal to the Federal Court of Canada the refusal of an application, any evidence filed under subsection 32(1) of the Act should be in a form which is admissible in the Federal Court of Canada and follow its rules of evidence.

Section 40 of the Canada Evidence Act provides:

In all proceedings over which Parliament has legislative authority, the laws of evidence in force in the province in which those proceedings are taken, including the laws of proof of service of any warrant, summons, subpoena or other document, subject to this Act and other Acts of Parliament, apply to those proceedings. R.S., c.E-10, s.37.

Evidence provided under subsection 32(1) of the Trademarks Act must be furnished by way of affidavit or statutory declaration and should be made by an affiant having first-hand knowledge of the situation. It is incumbent upon the applicant to produce the best evidence available.

Affidavits should be sworn and statutory declarations should comply with the requirements for Statutory Declarations in section 41 of the Canada Evidence Act. Each exhibit should be identified together with the signature of the notary or commissioner taking the affidavit or receiving the statutory declaration.

### *4.10.2.1 Master affidavits*

When submitting evidence of distinctiveness, the applicant must file a master affidavit. If filed on behalf of a company, the master affidavit should be submitted by a knowledgeable officer of the company and include the title or position of the signatory (i.e., president, manager, secretary) and the particulars of the applicant company (e.g. when and how it was founded, and where it carries on business). In all cases, the affiant must be identified and the basis and source of the person's knowledge explained. The affidavit should be accompanied by specimens of the trademark as used in relation to the goods or services. The following information should also be supplied:

- a. a statement of the nature of use (as described in section 4 of the Trademarks Act) of the trademark in association with all of the goods or services listed in the application;
- b. an explanation of the manner of association of the trademark at the time of transfer of property or transfer in the possession of goods;
- c. an explanation of the manner of use of the trademark in the advertisement of goods or services pursuant to sections 4 and 5 of the Trademarks Act, accompanied by specimens of advertising material;
- d. statements which clearly indicate the extent of use of the trademark for each defined territorial area in which the trademark is stated to have become distinctive. For example, in claiming that the trademark has acquired distinctiveness in Canada at the filing date, the applicant must show that the trademark has achieved secondary meaning in each of the territorial areas;
- e. information as to the length of time the trademark has been used in Canada in association with the goods or services listed in the application.

The extent of use may be stated in terms of units, price per unit, dollar volume of sales, or percentage of the market for the goods or services performed, sold, leased or hired in association with the trademark, separated by territorial area and by year. Further, sales figures should not be divided by territorial area based on a pro-rated calculation of the population but rather based on real figures. The evidence may refer to the mode of distribution, the number of distributors, and the number of outlets in which the product or services associated with the trademark is offered for sale.

As for the manner and extent of advertising, the evidence should indicate the type and number of advertisements and dollar volume for each type of media, separated by territorial area and by year. Information on the geographical area covered by the advertisements is essential.

The evidence provided must be limited to the relevant period, namely prior to the filing date of the application.

#### ***4.10.2.2 Additional affidavits***

Additional affidavits, i.e., from dealers in or users of the goods, will not be required in all cases to support a claim that the trademark had become distinctive at the filing date. The master affidavit may be sufficient as long as the criteria list in section [4.10.2.1](#) of this Manual are met, particularly where territorial sales and advertising are concerned.

Only when there is some doubt whether the trademark had acquired distinctiveness as of the filing date, and depending on the particular trademark and circumstances involved, will the Office require additional evidence, possibly in the form of supplemental affidavits.

These additional affidavits may be from advertising agencies, distributors, wholesalers, retailers and users who can attest as to the secondary meaning of the trademark in association with the goods or services at or preceding the filing date in Canada. These affidavits should also provide information as to the form of use, extent of use, length of use, and territory of use of the trademark in relation to the goods or services set out in the application.

#### ***4.10.2.3 Survey evidence***

Surveys are used extensively in commerce and many business decisions are based on their results. If a market survey is to be used as evidence, it should be carried out by a person who can file an affidavit which attests to the fact that the survey was conducted by an expert in designing, organizing, implementing and interpreting survey results. A qualified surveyor will set out the strategy and statistical basis of the survey and will explain the form of the questions asked and the manner in which the survey is conducted. All the results of the survey must be reported — both negative and positive — and the interpretation of the results fully explained.

A properly conducted survey was accepted as evidence of secondary meaning by Cameron J. in *Aluminum Goods Ltd. v. Registrar of Trade Marks* (1954), 19 C.P.R. 93. In completing his review of the evidence, Cameron J. stated at page 97:

It is sufficient to state that as a result of the questioning, 91% of 3,007 housewives and 96.5% of 505 dealers identified “Wear-Ever” as a brand. It is a significant fact that while 44% of the dealers questioned did not deal in “Wear-Ever” utensils, 96.5% of all identified “Wear-Ever” as a brand, thus indicating the widespread knowledge among dealers of the manner in which the word was used.

On the whole of the evidence I have no hesitation whatever in reaching the conclusion that the petitioner has satisfied the onus cast upon it by s. 29....

And further, at pages 97-98:

It is true, as pointed out by counsel for the Registrar of Trade Marks, that the recognition by dealers and users is not perhaps universal, a small percentage of those questioned stating that they thought the word referred to a quality of the wares and was not used as a brand. The section, however, requires only that the trade mark be generally recognized in the manner stated. To borrow a phrase used by the Master of the Rolls in the Sheen case — *Re J. & P. Coats Ltd's Application* (1936), 53 R.P.C. 355 at page 381 — the distinctiveness in fact in this case is as wide and as long continued as one could expect to find in any case.

In *Canadian Schenley Distilleries Ltd. v. Canada's Manitoba Distillery Ltd.* (1975), 25 C.P.R. (2d) 1, Judge Cattnach, after reviewing the law relating to survey evidence and reviewing the form and content of the survey submitted, admitted the survey evidence. At page 9, Cattnach J. stated:

In my view the admissibility of survey evidence and the probative value of that evidence when admitted is dependent on how the poll was conducted, the questions asked, how they were asked and how they were framed and what purpose the evidence is to be used for. There would be no objection to evidence being admissible when the poll is put forward not to prove the truth of the statements it contains but merely to show the basis of an expert's opinion, or as in the present instance, an assessment of the results of the survey.

In *Boyle-Midway (Canada) Ltd. v. Farkas Arpad Homonnay* (1976), 27 C.P.R. (2d) 178, a public opinion survey was refused by the Acting Registrar on the grounds that it was substantially in breach of all the rules governing admissibility of public survey evidence. Also see the decision of Mr. Justice Mahon in *Customglass Boats Ltd. v. Salthouse Brothers Ltd.* (1975), R.P.C. 589, for a review of Canadian, U.S. and British law on admissibility of public opinion evidence.

#### ***4.10.2.4 Restriction as to territory***

If the evidence shows that the trademark had become distinctive in only some areas of the country, examiners may permit the trademark to proceed to advertisement noting that registration will be restricted to a defined territorial area, pursuant to subsection 32(2) of the Trademarks Act. For example, in *Home Juice Co. v. Orange Maison Ltée* (1967), 53 C.P.R. 71 at pages 77-78, ORANGE MAISON was held to have acquired a distinctive meaning in relation to the orange juice of the respondent among dealers and purchasers of orange juice in the Province of Quebec.

#### ***4.10.2.5 Voluntary restrictions as to territory***

Voluntary exclusions of any province or territory are not permitted in view of section 19 of the Trademarks Act.

### **4.10.3 Determining acquired distinctiveness**

The evidence filed by the applicant must be sufficient to enable the examiner to conclude that the public in Canada, or in a defined territorial area, perceives the trademark as one which distinguishes the goods or services of the applicant from those of others. Any descriptive or surname significance will have been

subordinated in the mind of the public in relation to the associated goods or services, and its secondary meaning dominates.

It is not reasonable to expect that a trademark had acquired a secondary meaning to every last individual. Evidence of distinctiveness requires only that there be a substantial recognition of the secondary meaning of the trademark by dealers or the end consumer.

Nevertheless, the evidence of acquired distinctiveness must be strong and convincing. As Fox stated in *Canadian Law of Trade Marks and Unfair Competition*, 3rd edition at page 131:

There will, of course, always be considerable difficulty in convincing the Registrar, or the court, that a prima facie unregistrable word has acquired a secondary meaning sufficient to permit its registration, for the legislature and the courts have always shown a natural disinclination to allow any person to obtain by registration a monopoly in what others may legitimately desire to use.

The onus is on an applicant who contends that a trademark has acquired a secondary meaning to prove it. As Cattanach J. stated in *Standard Coil Products (Canada) Ltd. v. Standard Radio Corp.* (1971), 1 C.P.R. (2d) 155 at page 172, when considering whether the mark STANDARD had acquired a secondary meaning in Canada in association with the goods television tuners:

It remains for me to assess the probative value of such evidence. In so doing I am conscious that the onus on a person contending that a trade mark which is descriptive or laudatory of his wares has come to actually distinguish those wares is a heavy one and that onus is increased by the adoption of a word which lacks inherent distinctiveness.

Also in *Carling Breweries Ltd. v. Molson Companies Ltd.* (1984), 1 C.P.R. (3d) 191 (upheld (1988), 19 C.P.R. (3d) 129 (F.C.A.)), Strayer J. stated:

I am not only of the view that the onus lay instead on the applicant to prove distinctiveness within s-s. 12(2), but I also think that it was a very heavy onus given the nature of the mark CANADIAN. There are various authorities to the effect that where one must prove that a normally descriptive word has acquired a secondary meaning so as to make it descriptive of a particular product, the onus is indeed heavy: see, for example, *Canadian Shredded Wheat Co. v. Kellogg Co. et al* [1938] 2 D.L.R. 145 at pages 151-2, 55 R.P.C. 125 at page 142 (J.C.P.C.); *J.H. Munro Ltd. v. Neaman Fur Co. Ltd.* (1946), 6 C.P.R. 97 at page 113, [1947] 1 D.L.R. 868, 5 Fox Pat C. 194 at page 208 (Ex.Ct.). In my view, this is particularly true where the word is one such as “Canadian” which is first and foremost, legally and factually, an adjective describing any citizen of this country, and more particularly for present purposes any product of any sort having its point of origin in this country. As used in conjunction with the word “beer” it is capable of describing any such malt beverage produced in Canada by any brewer. The onus, as I have noted above, is on the applicant for registration of such a mark to demonstrate clearly that it has become so distinctive of his product that it has acquired a secondary meaning which would not, vis a vis the relevant public, normally be confused with the primary meaning of the word.

## **4.11 Disclaimers – Section 35**

This section enables an applicant to disclaim certain portions of a trademark which would otherwise be unregistrable. The Registrar generally no longer requires an applicant to provide disclaimers pursuant to

section 35 of the Act, but voluntary disclaimers will continue to be accepted. It is not permissible for an applicant to disclaim the trademark as a whole.

**Note:** Where a portion of the trademark consists of the eleven-point maple leaf, a disclaimer is required pursuant to the September 2, 1965 Order-in-Council PC 1965, 1623.

## **5 Examination of Official Marks**

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An official mark is an authorized mark derived from, or having the sanction of, persons in office and adopted and used by any public authority in Canada for goods or services.

In *Insurance Corporation of British Columbia v. Registrar of Trade Marks* (1979), 44 C.P.R. (2d) 1, Cattanach J. addressed the question of what constitutes an official mark at page 9, he stated:

What then is an “official” mark within the meaning of s. 9(1)(n)(iii). An official mark is not defined in the statute.

The Registrar in his reasons dated April 14, 1978, resorted to a dictionary meaning of the word “official”. One such definition was “derived from the proper office or officer or authority”.

The definition in the Shorter Oxford English Dictionary is to like effect reading “4. Derived from, or having the sanction of persons in office; hence authorized, authoritative.”

And further, at page 10:

The mark so adopted falls within the dictionary meaning of the word “official” and therefore is an “official mark” within the meaning of these words.

### **5.1 Public authority – Official marks**

#### **5.1.1 Obligation to evaluate public authority status in Canada**

In order for an entity to claim the benefit of subparagraph 9(1)(n)(iii) of the Trademarks Act, it must be a public authority in Canada. See *Canada Post Corporation v. United States Postal Service* (2005), 47 C.P.R. (4th) 177 (F.C.T.D.); affirmed (2007), 54 C.P.R. (4th) 121 (F.C.A.).

The Registrar will require evidence of public authority status on every request to publish an official mark pursuant to subparagraph 9(1)(n)(iii) of the Trademarks Act. See *Stadium Corporation of Ontario Ltd. v. Wagon-Wheel Concessions Ltd.*, [1989] 3 F. C. 132 (F.C.T.D.).

#### **5.1.2 Test to determine public authority status**

The Registrar will apply the two-part test, adopted by the Federal Court of Appeal in *Ontario Association of Architects v. Association of Architectural Technologists of Ontario*, 19 C.P.R. (4th) 417, hereinafter referred to as “Ontario Association of Architects”. The two-part test is made up of the following elements:

- a significant degree of control must be exercised by the appropriate government over the activities of the body; and
- the activities of the body must benefit the public.

### ***5.1.2.1 Governmental control***

In order to satisfy the first element of the two-part test an entity must be subject to governmental control within Canada. See *Canada Post Corporation v. United States Postal Service*. The test of governmental control calls for ongoing government supervision of the activities of the body claiming to be a public authority for the purpose of subparagraph 9(1)(n)(iii).

The fact that a self-regulatory body is statutory, and its objects and powers may be amended unilaterally and exclusively by the Legislature that created it, does not in law constitute “governmental control” in this context.

The test of governmental control requires that the government be enabled, directly or through its nominees, to exercise a degree of ongoing influence in the body's governance and decision-making.

The following are examples of the types of governmental control the Registrar may look for in evaluating public authority status (Ontario Association of Architects):

- legislation conferring powers on the relevant Minister to:
  - review the activities of the body;
  - request the body to undertake activities that, in the Minister's opinion, are necessary and desirable for implementing the intent of the Act;
  - advise the body on the implementation of statutory schemes.
- legislation conferring powers on the Lieutenant Governor in Council to:
  - approve the exercise of the body's regulation-making;
  - appoint members of the body's committees.

The fact that a body is incorporated as a non profit corporation with charitable objects, has obtained tax exempt status, the ability to issue charitable receipts to donors, or that, as a foreign charity operating in a Canadian province, it could be asked to provide its accounts, financial and corporate information to the government, is not sufficient to conclude that it is under sufficient significant government control to be a public authority. See *Big Sisters Association of Ontario and Big Sisters of Canada v. Big Brothers of Canada* (1997), 75 C.P.R. (3d) 177 and *Canadian Jewish Congress v. Chosen People Ministries Inc.* (2002), and *The Registrar of Trade-marks* (2002), 19 C.P.R. (4th) 186, affirmed (2003), 27 C.P.R. (4th) 193 (F.C.A).

### **5.1.2.2 Public benefit**

In determining whether a body's functions satisfy the public benefit requirement, it is relevant to consider its objects, duties and powers, including the distribution of its assets. In this context, a duty to do something that is of benefit to the public is relevant as an element of “public benefit”, even though it is not a “public duty” in the sense of being legally enforceable by a public law remedy, such as an order of mandamus or its equivalent. (Ontario Association of Architects)

Examples of activities which are for public benefit include:

- regulating the practice of a profession, setting and enforcing standards of professional competence and ethical conduct of the body's members;
- being under a duty to maintain an accurate register of members and to make it available for public inspection;
- the fact that the decisions of a statutory self-regulatory body regarding membership and discipline are subject to appeal to a Court of justice on questions of fact and law tends to indicate that the public benefits from the proper performance by the body of its functions.

The fact that the activities of a body may also benefit its members is not a fatal objection to characterizing them as also benefiting the public.

### **5.1.3 Evidence of adoption and use of an official mark**

In light of the Federal Court decision in *See You In - Canadian Athletes Fund Corporation vs. Canadian Olympic Committee* [2007, 57 C.P.R. (4th) 287, affirmed (2008), 65 C.P.R. (4th) 421 (F.C.A)], the Registrar will require evidence of adoption and use of an official mark. While the Trademarks Act does not define “adoption” or “use” in regards to official marks, it was held that a common feature of both “adoption” and “use” is that there is an element of public display. See *FileNET Corporation v. Canada (Registrar of Trade-marks)* (2002), 22 C.P.R. (4th) 328 (F.C.A.). Although sections 3 and 4 of the Trademarks Act are not applicable to official marks, these sections may nonetheless assist in the interpretation of the meaning of “adoption” and “use” of official marks.

The evidence adduced must demonstrate an element of public display. In *FileNET Corporation v. Canada (Registrar of Trade-marks)*, use consisting of advertising the mark on a government website in connection with an Internet service was considered sufficient use even though the actual service was not yet available.

However, the evidence in the following examples was found to be insufficient evidence of adoption and use of official marks:

In *Piscitelli v. Ontario (Liquor Control Board)* (F.C.T.D.) [2002] 1 F.C. 247, it was held that the display of a sign cannot constitute adoption or use of “millennium” as an official mark because the word millennium was not distinguished in any manner surrounding the text. In this case the usage of the word “millennium” in the sign was merely as a generic or descriptive expression and not as a “mark” within the meaning of section 9 of the Trademarks Act.

Internal use of a mark in correspondence, e-mails and memoranda is not considered evidence of adoption and use of the mark. See *You In- Canadian Athletes Fund Corporation vs. Canadian Olympic Committee* (unreported) 2007 FC 406.

Evidence of adoption and use of an official mark by a licensee will not be considered adoption and use by the public authority. See *Canada Post Corp. v. Post Office* (2000), 8 C.P.R. (4th) 289, *Canadian Rehabilitation Council for the Disabled d.b.a. Easter Seals/March of Dimes National Council v. Rehabilitation Foundation for the Disabled d.b.a. Ontario March of Dimes* (2004), 35 C.P.R. (4th), 270 (F.C.T.D).

## 6 Examiners' reports

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### 6.1 Subsection 37(2) – Notification of objections

Subsection 37(2) of the Trademarks Act states that:

The Registrar shall not refuse any application without first notifying the applicant of his objections thereto and his reasons for those objections, and giving the applicant adequate opportunity to answer those objections.

The Registrar's objections to registration are communicated to the applicant by way of an Examiners Report and deal with:

- the conformity of the application to the requirements of subsection 30(2) of the Act;
- the registrability of the trademark under section 12 of the Act;
- the applicant's entitlement to registration in light of co-pending and confusing applications in light of paragraph 37(1)(c) of the Act; and
- the distinctiveness of the trademark in view of section 32 of the Act.

### 6.2 First reports

Examiners' reports prepared after the initial examination of the application are called “first reports”. The examiners' first report should raise all outstanding objections and set out all requirements which need to be remedied before the application can proceed to advertisement. Examiners must not engage in piecemeal reporting since this leads to protraction of the examination process and a high incidence of oversight and error. It is also disconcerting for the applicant (or the agent) who has complied with the formal requirements of an examiner's report only to be told in a subsequent report that the examiner is now objecting to the registration of the trademark.

Furthermore, the examiner must indicate whether an objection relates to all the associated goods or services, or only to some (in which case examiners should specifically identify those goods or services to which the objection relates).

However, it must also be noted that there may be circumstances which justify raising issues not dealt with in an initial report.

First reports are, for the most part, written in standardized form. To comply with the provisions of subsection 37(2), examiners must give reasons for statutory objections and so will provide the information necessary for a full explanation of objections and requirements. Circumstances which require issuing of examiners' reports are described below.

## **6.2.1 Goods or services**

The statement of goods or services will be deemed unacceptable and an amended application should be required in the following cases:

1. If the applicant does not provide a statement in ordinary commercial terms of the goods or services in association with which the trademark is used or proposed to be used;
2. If the statements do not describe each of those goods or services in a manner that identifies a specific good or service.

The Goods and Services Manual on CIPO's website provides further information on the principles and guidelines that will be used in the assessment of the statement of goods or services and provides examples of what will be considered acceptable.

### ***6.2.1.1 Nice Classification***

Also see section [2.4.7](#) in this Manual.

Pursuant to subsection 30(3) of the Act, a trademark application must group all of the goods or services according to the classes of the Nice Classification, each group being preceded by the number of the class of the Nice Classification to which that group of goods or services belongs and presented in the order of the classes of the Nice Classification.

Examiners will notify applicants which of the goods or services, if any, in the application are not properly grouped according to the Nice Classification. Examiners may, where appropriate, provide guidance as to the appropriate class for a given good or service.

Under subsection 30(4) of the Act, the examiner has the final determination as to the class within which any goods or services are to be grouped, and this determination is not subject to appeal.

## **6.2.2 Paragraph 12(1)(a)**

An objection raised pursuant to paragraph 12(1)(a) should be supported by providing the approximate number of listings of a particular name or surname and where (e.g. phone directories, electoral rolls, internet search engines, social media) the examiner found said listing(s).

## **6.2.3 Paragraph 12(1)(b)**

An objection that a trademark is clearly descriptive or deceptively misdescriptive should be supported by identification of the sources of information on which the examiner based the objection and/or an explanation as to how that information applies to the description of the particular goods or services. An exception is made when the descriptive objection is based on the trademark being an obvious laudatory epithet.

#### **6.2.4 Paragraph 12(1)(c)**

An objection based on the fact that the trademark is the name of the goods or services in any language may be supported by the translation of the trademark as provided by the applicant.

#### **6.2.5 Paragraph 12(1)(d)**

An objection under paragraph 12(1)(d) of the Act should always be supported by providing the registration number, and a copy of the registration particulars, of the confusing trademark registration(s). Examiners should always verify that the copy relates to the appropriate registration identified by the registration number and that the registered trademark is in good standing (i.e. not expunged, refused, or abandoned).

#### **6.2.6 Paragraph 12(1)(e)**

When raising an objection under paragraph 12(1)(e) of the Act, examiners must be careful to distinguish between the basis for the objection and the reasons for it. The reasons for the objection are set out in subsection 9(1) and section 10 of the Act, while its basis is in the provisions of paragraph 12(1)(e).

For objections raised under section 10 of the Act, examiners must provide evidence which shows ordinary and bona fide commercial usage of the trademark.

#### **6.2.7 Paragraph 12(1)(f)**

When raising an objection pursuant to paragraph 12(1)(f), examiners must provide in the report details of the plant variety denomination as published in the Plant Varieties Journal.

#### **6.2.8 Paragraphs 12(1)(g), (h) and (h.1)**

When raising an objection pursuant to paragraphs 12(1)(g), (h) or (h.1), examiners should provide a copy of the particulars of the protected geographical indication.

#### **6.2.9 Dates of entitlement**

In view of *Attorney General of Canada v. Effigi Inc.* (2005), 41 C.P.R. (4th) 1 the filing or priority filing date is the only relevant consideration pursuant to paragraph 37(1)(c) of the Trademarks Act in

determining if the applicant is not the person entitled to registration of the trademark because it is confusing with another trademark for the registration of which an application is pending.

If the application bearing the later filing date discloses an earlier priority date in association with the same or similar goods or services, then it will be considered to be the entitled application.

Examiners must carefully assess the dates of entitlement with respect to each of the goods or services associated with the applications.

The examiner must send a report to both applicants explaining that they are entitled in respect of one set of goods but not entitled in respect of the other set of goods.

## **6.3 Second or maintaining actions**

An examiner's report contains a notice to the effect that a proper response should be filed within the stated time limit, failing which the Registrar will initiate abandonment procedures. This is considered to provide adequate time to answer objections, as required by subsection 37(2).

The Office considers that a proper response consists of a response wherein all objections or requests raised in the examination report have been addressed. If the applicant fails to file a proper response upon the expiration of the six months period, (s)he will be considered to be in default in the prosecution of the application pursuant to section 36 of the Trademarks Act and a notice of default will be issued.

Whereas the examiner's first action raises objections and requirements, the second action considers the applicant's response and identifies the areas in which the applicant has failed to overcome the objections raised in the initial report. A second action must review all issues relating to the formal requirements of the application and the registrability of the trademark which have not been satisfactorily answered in the applicant's response.

When reviewing submissions by an applicant which point to a number of advertised or registered trademarks similar to the subject trademark, the examiner must attempt to explain any perceived inconsistencies. See *Canadian Parking Equipment Ltd. v. Canada (Registrar of Trade Marks)* (1990), 34 C.P.R. (3d) 154.

Second actions will usually include a warning to the applicant that if the objections or requirements are not met in the applicant's next response, the application may be refused under section 37 of the Act. The applicant is again given six months to provide a proper response.

## **6.4 Subsequent actions**

Circumstances sometimes arise during the prosecution of an application which interfere with its early disposal and necessitate more than two reports.

### **6.4.1 Evidence**

The point at issue may be a statutory bar to registration of the trademark, such as an objection under paragraphs 12(1)(a) or 12(1)(b) of the Trademarks Act and the applicant may claim that the trademark is

registrable under subsection 12(3) of the Act. In such a situation, examiners may issue correspondence outlining the requirements for evidence, or provide a detailed evaluation of the evidence submitted by the applicant.

### **6.4.2 Deletion of goods or services**

An applicant's response may be accompanied by a revised application in which specific goods or services have been deleted in order to overcome the confusion objection raised by the examiner. Re-examination of the application would be required with respect to confusion, which may result in either the withdrawal of the confusion objection or the issuance of a further action which maintains the objection.

### **6.4.3 Additional information**

Examiners may issue a report to request further information on points raised in an applicant's argument, if the circumstances warrant it.

### **6.4.4 Clarification by examiners**

A further report may also be necessary where it appears to the examiner that the applicant has not understood the nature of a requirement or the reasons for an objection.

### **6.4.5 Further entitlement objections after pre-publication search**

A further report may also be necessary when an examiner has been made aware of a newly-filed application after completing a pre-publication search for confusing trademarks. In such a situation, the examiner must determine the entitled party and inform the non-entitled party that it does not appear to be the person entitled to registration.

### **6.4.6 Section 44 or 45 notices**

The applicant may request that a notice pursuant to the provisions of section 44 or 45 of the Trademarks Act be sent to the registered owner of a confusing registered trademark. This may result in an extended processing period and will require re-examination and further action by the examiner.

### **6.4.7 Consent – confusing trademarks**

Also see section [3.3.6](#) in this Manual.

There are no provisions in Canadian legislation which recognize the mutual consent of the parties as a basis for waiving the criteria enumerated at section 6 of the Trademarks Act. However, examiners may consider an agreement between an applicant and the owner of a cited trademark with respect to the coexistence of the two trademarks in accordance with Canadian jurisprudence.

## 6.5 Telephone amendments

Section 7 of the Trademarks Regulations states that the Registrar is not required to have regard to any communication that is not submitted in writing. However, in certain situations it may be more efficient to try to resolve an issue over the telephone.

### 6.5.1 Written confirmation not required

The following amendments may be made by examiners following a telephone conversation and after being given verbal confirmation from the applicant or appointed agent without necessitating written confirmation:

- Adding the statement “pantone is a registered trademark” to a colour claim where reference is made to the Pantone colour system.
- Adding a disclaimer for the Canadian 11 point Maple Leaf where the trademark design has incorporated it.

### 6.5.2 Written confirmation required

Any amendments that do not appear in section 6.5.1 of the Trademarks Examination Manual must only be made by an examiner upon receipt of written confirmation from the applicant or appointed agent. The following is a list of amendments for which written confirmation is required:

- Deleting a TM, MC or registration symbol from the trademark representation.
- Properly linking priority claims to amended statements of goods or services.
- Amending typographical errors contained in a statement of goods or services.
- Amending errors in punctuation contained in a statement of goods or services.
- Requesting a minor amendment to a statement of goods or services for compliance with paragraph 30(2)(a) of the *Trademarks Act* and section 29 of the *Trademarks Regulations*.
- Amending the classification of goods or services that are incorrectly classed according to the Nice classification.
- Requesting a minor change to goods or services for compliance with subsection 30(3) of the *Trademarks Act*.
- Requesting minor changes to the description of a colour claim.
- Requesting a visual representation of the trademark in colour or in black and white.

- Requesting a clearer visual representation of the trademark.
- Requesting a translation or transliteration of the trademark.
- Requesting a modification to an incorrectly identified trademark type.
- Requesting minor changes to a trademark description.
- Requesting more information for an incomplete mailing address.

### 6.5.3 Standard Procedure for Telephone Amendments

1. To initiate the telephone amendment, the examiner will call the applicant or the appointed trademark agent to discuss the proposed amendment or leave a voicemail providing the necessary information about the proposed amendment.
2. The applicant or their appointed trademark agent will be given **five business days** following this call to provide verbal confirmation (in the case of an amendment under section 6.5.1) or written confirmation (in the case of an amendment under section 6.5.2).
3. Once the examiner has received verbal or written confirmation, they will process the amendment and proceed with the prosecution of the application.
4. If the examiner has not received verbal or written confirmation within five business days, a standard report will be issued.

## 6.6 Approval and advertisement

Once an application complies with all the formal requirements and any statutory objections have been overcome, a pre-publication search will be conducted and if no co-pending confusing trademarks are found, an approval notice will be issued to the applicant. The particulars of the application will then be advertised on CIPO's website by way of the Trademarks Journal.

Applicants should review the approval notice for accuracy and if any errors are found, contact the Office as soon as possible.

Subsection 37(4) of the Act gives the Registrar the authority to withdraw the advertisement of an application for the registration of a trademark, so long as the trademark has not been registered.

Situations in which the Registrar may be satisfied that an application *should not have been advertised* include:

- the applicant was not entitled to registration in view of a confusing pending application;
- an objection under section 12 of the Act was overlooked or withdrawn in error

A situation in which the Registrar may be satisfied that an application was *incorrectly advertised* would be where information, amendments or statements that were included in the latest application were omitted from the advertisement in error.

If the Registrar withdraws the advertisement, the application is deemed never to have been advertised.

Alternatively, and depending on the nature of the error, the Office may publish an erratum in the Trademarks Journal which notes the error and provides the correct information.

## 6.7 Default and abandonment

If an applicant does not provide a proper response within the time period specified in an examiner's report, the application will be placed into default and the applicant will be sent a notice of default and given two months to remedy the default. The application will be treated as abandoned, pursuant to section 36 of the Trademarks Act, if the applicant fails to remedy the default within two months of the date of the notice.

## 6.8 Extensions of time

Also see the practice notice entitled "Extensions of time in Examination and to respond to a section 44.1 notice".

A person can apply under subsection 47(1) of the Act to extend a time limit to:

- remedy a default in the prosecution of an application under section 36 of the Act
- furnish the Registrar with a statement required under subsection 44.1(1) of the Act

Subsection 47(2) gives a person the opportunity to request an extension of time after that time has lapsed.

In view of section 14 of the Regulations, a person that applies for an extension of time under either subsections 47(1) or (2) of the Act must pay the prescribed fee. To find out the exact amount of a fee, please consult the [list of fees for trademarks](#). Therefore, a fee is required to apply for an extension of time and it does not depend on whether the extension is granted.

### 6.8.1 To respond to an Examiners' report

A notice is added to each examiner's report stating that a proper response is due within the stated time limit in order to avoid default and abandonment.

Prior to the publication of an amended practice notice on extensions of time in examination, the Office generally granted an applicant one (1) extension of time of up to a maximum of six (6) months to file a response to an examiner's report. Upon the expiration of twelve months from the initial date of the examiner's report, the Office would require that the applicant demonstrate exceptional circumstances justifying why it was not yet possible to file a proper response to an examiner's report.

Following this new practice, the Office will generally not grant an applicant an extension of time to file a response to an examiner's report issued on or after January 17, 2020 unless the applicant demonstrates exceptional circumstances justifying why it is not yet possible to file a proper response. The Office considers that a proper response consists of a response wherein all objections, requirements or requests raised in the report have been addressed.

If, at the expiry of the six month period after the date of the examiner's report, the applicant fails to file a proper response, or if the reasons provided in a request are not considered to justify an extension of time, the applicant will be considered in default in the prosecution of the application pursuant to provisions of section 36 of the *Trademarks Act* and a notice of default will be issued.

The following are examples of what could amount to an exceptional circumstance that would justify an extension of time:

1. Recent change in trademark agent  
There has been a very recent change in appointed trademark agent and the agent requires time to become familiar with the file.
2. Circumstances beyond the control of the person concerned  
Examples include illness, accident, death, bankruptcy, or other serious and unforeseen circumstances.
3. Transfer  
There is a request pending at the Office to record or register the transfer of an application or registered trademark, and said transfer would overcome a confusion objection.
4. Opposition  
The cited co-pending and confusing trademark is the subject of a pending opposition proceeding.
5. Section 45  
The cited registered trademark is subject to a pending section 45 proceeding.
6. Official mark  
The applicant is in the process of actively negotiating a consent from the holder of an official mark.
7. Division of a Protocol application  
The applicant has filed a request for the division, in respect of Canada, of the international registration on which the original Protocol application is based and is waiting on the International Bureau for notification that a divisional international registration has been created.
8. Respond to an objection which could lead to a refusal under paragraphs 37(1)(b), (c) or (d) of the *Act*  
The applicant requires more time to consider the objection and file a proper response. **Note:** The applicant may request an extension of time for this reason only once in the prosecution of the

application. However, if an applicant was granted extensions of time for this reason prior to January 17, 2020, the applicant may request only one additional extension of time for this reason.

9. Compile evidence of distinctiveness under subsection 32(1) of the *Act*

The applicant is in the process of compiling the sufficient evidence required to show that the trademark was distinctive at the filing date of the application. **Note:** The applicant may request an extension of time for this reason only once in the prosecution of the application. However, if an applicant was granted extensions of time for this reason prior to January 17, 2020, the applicant may request only one additional extension of time for this reason.

Note: In an effort to implement a smooth transition from the previous practice on extensions of time at examination, the practice of not granting an extension of time to reply to an examiner's report unless exceptional circumstances exist will only apply to trademark applications for which an examiner's report has been issued on or after January 17, 2020.

As a result, for applications for which an examiner's report has issued prior to January 17, 2020, the Office will generally grant an applicant one (1) extension of time of up to a maximum of six (6) months to file a response to an examiner's report, if the request is justified. Upon the expiration of twelve months from the initial date of the examiner's report, the Office will require that the applicant demonstrate exceptional circumstances justifying why it is not yet possible to file a proper response to an examiner's report.

## 6.8.2 Extensions of time to respond to a notice issued under section 44.1 of the Trademarks Act

Under subsection 44.1(1) of the Trademarks Act, the Registrar may give notice requiring the owner of a registered trademark to furnish, within six months of the date of the notice, a statement of the goods or services in respect of which the trademark is registered grouped in the manner described in subsection 30(3).

If at the expiry of the six month period mentioned above the applicant fails to file a statement, the Registrar will send a further notice that the registration may be expunged if the statement is not furnished within two months of this second notice.

The Office will generally only grant an extension of time if the registered owner can demonstrate exceptional circumstances justifying why it is not yet possible furnish a statement.

The following are examples of what could amount to an exceptional circumstance that would justify one six-month extension of time to furnish the statement:

1. Recent change in trademark agent

There has been a very recent change in appointed trademark agent and the agent requires time to become familiar with the file.

2. Circumstances beyond the control of the person concerned

Examples include illness, accident, death, bankruptcy or other serious and unforeseen circumstances.

### 3. Transfer

There is a pending request at the Office to register the transfer of the registered trademark.

## 6.8.3 Extensions of Time on Force Majeure

Also see the practice notice entitled “Practice notice on extensions of time due to force majeure for priority and renewal”.

Subsections 34(5) and 46(5) of the Trademarks Act permit an applicant to apply for an extension of time to file an application for registration based on a priority filing abroad

34(5) An applicant is not permitted to apply under section 47 for an extension of the six-month period referred to in paragraph (1)(a) until that period has ended, and the Registrar is not permitted to extend the period by more than seven days

or renew a registered trademark

46(5) A registered owner is not permitted to apply under section 47 for an extension of the prescribed period until that period has expired, and the Registrar is not permitted to extend the period by more than seven days.

An applicant may only apply for an extension of time in these situations after the time limit has passed (therefore, only a request under subsection 47(2) of the Act is applicable). The applicant must pay the prescribed fee as well as explain the reason(s) why it could not do the act within the prescribed period.

If the Registrar grants the extension of time, the period may only be extended by a maximum of seven days.

Requests for these types of extensions of time should be promptly brought to the attention of the Deputy Director of Examination.

While not explicitly stated as such, subsections 34(5) and 46(5) of the Act provide relief measures for applicants to extend time limits due to a “force majeure” event. Force majeure (often called “act of God”) is a legal provision that allows a party to suspend its obligations when certain circumstances beyond its control arise, making performance of its obligations impossible. The Supreme Court of Canada (SCC) defined an “act of God,” at least as it pertains to contract law, in *Atlantic Paper Stock Ltd. v. St. Anne-Nack*, [1976] 1 SCR 580 at 583 (hereinafter, “Atlantic”) as an “event, beyond control of either party, [that] makes performance impossible.” The SCC described the uncontrollable character of the event as being something “unexpected” and “beyond reasonable human foresight and skill.” In addition to the unexpected character of an event, the SCC stated in *Atlantic* that the event must also “strike at the root” of the reason why the obligation cannot be met. When considering the occurrence of a force majeure event, courts are not interested in the occurrence of the event per se, but the specific effect of the event on the obligations of the parties. In addition to “acts of God,” force majeure events can also include political or medical events.

Examples of force majeure events include:

- act of God (such as, but not limited to, fires, explosions, earthquakes, drought, tidal waves and floods);
- war, hostilities (whether war be declared or not), invasion, act of foreign enemies, mobilization, requisition, or embargo;
- rebellion, revolution, insurrection, or military or usurped power, or civil war;
- contamination by radio-activity from any nuclear fuel, or from any nuclear waste from the combustion of nuclear fuel, radio-active toxic explosive, or other hazardous properties of any explosive nuclear assembly;
- riot, commotion, strikes, go slows, lock outs or disorder (unless solely restricted to employees of the party);
- virus/bacterial epidemic outbreak;
- acts or threats of terrorism

#### **6.8.4 Fees for extension of time requests**

In view of section 14 of the Trademarks Regulations, a person that applies for an extension of time under section 47 of the Trademarks Act must pay the prescribed fee set out in item 1 of the Tariff of Fees. A person may only apply for an extension of time under section 47 if the period of time is fixed by the Act or prescribed by the Regulations. Therefore, a fee is not required to request an extension of time to respond to an examiner's report since the period of time to respond is not fixed in either the Act or its Regulations. Instances where a fee would be required include applying for an extension of time under subsection 47(1) or (2) to:

1. file an application within the six-month period referred to in paragraph 34(1)(a) of the Act;
2. file a request for priority under paragraph 34(1)(b) of the Act within the six-month prescribed period;
3. remedy a default in the prosecution of an application under section 36 of the Act;
4. furnish the Registrar with a statement required under subsection 44.1(1) of the Act;
5. pay the renewal fee under section 46 of the Act

**Note:** The prescribed fee is required to apply for the extension of time and is not dependent on whether the extension will be granted or refused.

## **6.9 Refusal**

Subsection 37(1) of the Trademarks Act states:

The Registrar shall refuse an application for the registration of a trademark if he is satisfied that

- a. the application does not conform to the requirements of section 30,
- b. the trademark is not registrable,
- c. the applicant is not the person entitled to registration of the trademark because it is confusing with another trademark for the registration of which an application is pending,  
or
- d. the trademark is not distinctive.

If the Registrar is not so satisfied, the Registrar shall cause the application to be advertised in the prescribed manner.

Where the paragraph warning of refusal has been included in a examiner's report and the subsequent response by the applicant has not convinced the examiner to withdraw an objection or requirement, and where no new arguments have been raised by the applicant which would require a response by the examiner pursuant to the provisions of subsection 37(2) of the Act, the examiner will recommend that the application be refused.

If the application is refused, the applicant will be notified by letter to that effect. The letter will be as explicit as possible so that the applicant is aware of the reasoning behind the refusal decision. The letter will also draw attention to the provisions of section 56 of the Act, whereby the applicant may appeal the Registrar's decision to the Federal Court.

## **6.10 Notification of third-party rights**

### **6.10.1 Background**

Notifications of third party rights are an informal way for third parties to bring to the attention of the Registrar information bearing on the registrability of a pending trademark application. This correspondence procedure is limited to three grounds, does not create an inter partes proceeding between the applicant and the third party, and does not replace opposition proceedings.

### **6.10.2 Communication procedures**

Third parties who wish to notify the Registrar of these grounds must submit a written request, by mail or fax, addressed as follows and that includes the name of the applicant and application number of the relevant application:

**NOTICE OF THIRD PARTY RIGHTS**  
c/o Deputy Director, Examination Division  
Trademarks Office  
Canadian Intellectual Property Office  
50 Victoria Street

Gatineau, Quebec K1A 0C9  
Fax: 819-953-2476

Notifications will be placed on the relevant file and available for public inspection. The Registrar will not provide to the person who submitted the notification information as to any action taken on the relevant application as a result of the notification. Receipt of notifications will be indicated by a note “Notification of third-party rights received on [date]” on the action history page of the relevant application on the trademarks database.

### **6.10.3 Appropriate grounds**

A notification of third party rights must only inform the Registrar of the following:

- confusion with a registered trademark under paragraph 12(1)(d) of the Trademarks Act;
- entitlement under paragraph 37(1)(c) of the Act;
- registered trademark(s) used to describe goods or services in the application

### **6.10.4 Required information**

A notification of third party rights must be limited to information related to the appropriate grounds along with a list of relevant registrations or pending applications, including the registration or application numbers. Written arguments or evidence of prior use will not be accepted or considered.

### **6.10.5 Timing**

While a notification may be filed at any time before a trademark is registered, subsection 37(4) of the Act prescribes the conditions under which the Registrar may withdraw the advertisement of an application. Please refer to the practice notice entitled “Withdrawal of Advertisement of a Trademark Application” for further information.

### **6.10.6 Continued monitoring**

Third parties who submit a notification should continue to monitor the status of the relevant application as it may be approved for advertisement despite the submission of a notification. Ongoing monitoring will give third parties the opportunity to take other appropriate action, such as filing a statement of opposition. Please note that filing a notification of third party rights does not stay or extend the time for filing a notice of opposition nor does it extend the deadline for responding to an examiner's report.

## **7 Representation**

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## 7.1 Definition of trademark agent and associate trademark agent

The Trademarks Regulations defines a trademark agent as it is defined in section 2 of the *College of Patent Agents and Trademark Agents Act*, namely:

an individual who holds a trademark agent licence or a trademark agent in training licence [...]

The Regulations defines an associate trademark agent as a trademark agent that is appointed by another trademark agent under subsection 22(2) or (3) of the Regulations.

## 7.2 Power to appoint

Subsection 22(1) of the Regulations provides that an applicant or registered owner can appoint one trademark agent or all the trademark agents at the same firm to represent them in any business before the Office.

Under subsection 22(2) of the Regulations, a trademark agent, other than an associate trademark agent may, in turn, appoint one trademark agent or all the trademark agents at the same firm as an associate trademark agent to represent the person that appointed them in any business before the Office.

## 7.3 Persons authorized to act

With some exceptions, a person may be represented by another person only if that other person is a trademark agent.

**Note:** In view of section 23.2 of the Regulations, if all the trademark agents at the same firm have been appointed, any written communication sent by the Registrar to the firm is considered to have been sent to all of the trademark agents at the firm.

### 7.3.1 Self-representation

Subsection 25(3) of the Trademarks Regulations provides that a person may represent themselves for the purposes of:

- a. filing an application for the registration of a trademark, an application for international registration referred to in sections 98 to 100 or a transformation application referred to in section 147;
- b. paying any fee prescribed in the Act;
- c. giving notice of an appointment or revocation of a trademark agent under section 23 of the Regulations;
- d. renewing the registration of a trademark under section 46 of the Act; or

- e. making a request or providing evidence of a transfer under section 48 of the Act.

In view of subsection 25(4) of the Regulations, the applicant or registered owner can be represented by another person (whether or not that person is a trademark agent or an individual whose name is included in the Register of Trademark Agents of the *College of Patent Agents and Trademark Agents Regulations*) that they have authorized, to do the acts listed in subsection 25(3). For each request, the authorized person must clearly explain that they have been authorized by the applicant or registered owner to act on behalf of the applicant/registered owner.

### **7.3.2 Representation by a trademark agent**

For any business before the office not listed under subsection 25(3) of the Regulations, if an applicant or registered owner has appointed a trademark agent the applicant/registered owner may not

- a. represent themselves; and
- b. no one other than the trademark agent or an associate trademark agent appointed by that trademark agent, is permitted to represent the applicant or registered owner

In such cases, examiners must not correspond with, or take action on any request initiated by, an applicant or registered owner, an agent which has not been appointed by the applicant/registered owner, or an associate agent not appointed by the agent appointed by the applicant/registered owner. This restriction includes telephone conversations - examiners must not discuss any particulars of the file with the applicant or registered owner if an agent was appointed.

### **7.3.3 Status of trademark agents**

The *College of Patent Agents and Trademark Agents* is solely responsible for determining the status of a trademark agent and will communicate any changes in status to the Office. Trademark agent inquiries regarding their status should be directed to the *College of Patent Agents and Trademark Agents*.

Unless a request falls under the exceptions listed in subsection 25(3) of the Regulations, correspondence should not be sent to an agent whose license is suspended, revoked or surrendered. In such cases, correspondence should be sent directly to the applicant or registered owner.

## **8 Transitionals**

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### **8.1 Introduction to transitional provisions**

Transitional provisions provide for the transition from an earlier act to the act that replaces it, or to phase in how a new or an amended act applies to persons affected by it. They may be included in an act if certain provisions of the previous act will apply for a significant period of time or if certain provisions only apply going forward to certain files but not others.

The transitional provisions with respect to the changes to the Trademarks Act and Regulations in Bill C-31 are found in Section 69.1 and 70-73 of the Act and sections 151-160 of the Regulations.

The following sections of the Manual details how applications will be dealt with depending on where they are in the registration process on the CIF date.

## 8.2 Filing date not granted

Applications that have been received by the Office but have not met the filing requirements set out in section 25 of the former Trade-marks Regulations will be re-assessed under the requirements set out in section 33 of the amended Trademarks Act.

If an application was not granted a filing date prior to the coming into force (CIF) date but did meet the requirements under subsection 33(1) of the amended Act, its filing date will be the CIF date. Examples of situations in which the Office would accept a previously unacceptable application include:

- Lack of a mailing address for the applicant but rather only an email address or phone number;
- No claim of previous use or intention to use the trademark;
- An incomplete claim to registration and use abroad;
- An application for a trademark that consists of a design did not include a drawing of the trademark but rather contained only a written description.

If, despite the above-mentioned re-assessment, all of the requirements under subsection 33(1) of the amended Act were not provided by the CIF date, the Registrar will issue a notice to the applicant setting out the outstanding requirements. Applicants will have two (2) months from the date of the notice to correct the deficiencies in the application. If the applicant does not submit the outstanding items within those two months, the application will be deemed never to have been filed.

Given that the application fee structure will change on the CIF date, the situation could arise that the only outstanding requirement is the prescribed fee under paragraph 33(1)(f) of the amended Act. In such a situation, the Registrar will send a notice to the applicant outlining this deficiency, unless the original application contained a general authorization to charge a deficiency.

**Note:** The prescribed application fee is adjusted every year on the first of January. The amount for the first class of goods or services depends on the date on which the payment is received by the Registrar. Similarly, the amount for any additional Nice classes also depends on the date on which the payment is received, even if the prescribed fee for the first class of goods or services to which the application relates was paid prior to the annual adjustment. To find out the exact amount of a fee, please consult the [list of fees for trademarks](#).

## 8.3 Filing date granted

All applications that have been granted a filing date but have not been advertised in the Trademarks Journal prior to the CIF date will be subject to most of the provisions of the amended Act. This includes applications that have:

- been filed but not assigned to an Examiner;
- an outstanding examiner's report; or
- replied to an examiners report

All of these applications will be re-assessed to ensure they meet the registrability requirements of the amended Act.

### **8.3.1 Bases for registration (claims)**

All previous bases for registration (prior use or making known in Canada, foreign registration and use, proposed use) of a trademark are removed in the amended Act. For applications not advertised at the CIF date, the Office will not require that the claims be removed; however, these claims will not appear in the particulars of the advertisement. As well, applications that include a foreign application or registration as a claim basis will no longer require a certified copy of the corresponding foreign registration.

### **8.3.2 Not inherently distinctive**

In view of paragraphs 32(1)(b) and 37(1)(b) of the amended Act, the Registrar will be able to refuse a trademark if it is not inherently distinctive. Therefore, applications that have not been advertised at the CIF date will require reassessment by an examiner for inherent distinctiveness and, if applicable, the applicant will be given the opportunity to furnish the Registrar with evidence that the trademark was distinctive at the time of filing the application. Further information regarding the determination of inherent distinctiveness will be provided in [4.9 Not Inherently Distinctive](#).

### **8.3.3 Section 14**

As the relevant section of the former Act has been removed, applicants may not claim the benefit of section 14 to overcome an objection under paragraphs 12(1)(a) or (b) after the amended Act comes into force. If an application claiming the benefit of section 14 has not been advertised at the CIF date, the applicant will be required to file a revised application removing the claim.

### **8.3.4 Certification marks**

Under the former Act, applications for certification marks must be based on use in Canada before the filing date of the application. However, prior use is no longer a requirement for the filing of certification marks under the amended Act. Applications for certification marks that were filed on the basis of

proposed use prior to the CIF date can proceed to advertisement if all other objections are overcome or requirements are met.

### **8.3.5 Utilitarian function**

Subsection 12(2) of the amended Act provides the Registrar the authority to object to the registration of a trademark that contains features that are dictated primarily by a utilitarian function. Applications that have not been advertised prior to the CIF date will require re-assessment by the examiner to assess whether a trademark is primarily functional.

### **8.3.6 Distinguishing guise**

As the amended Act no longer includes a definition of “distinguishing guise”, applications for distinguishing guises that have not been advertised at the CIF date will require amendment. In particular, applicants will be required to amend their application for a distinguishing guise to specify that the trademark is either (a) a three-dimensional shape, or (b) a mode of packaging goods.

### **8.3.7 Nice classification**

Under the amended Act, the goods and services in an application are to be grouped according to the classes of the Nice Classification. Therefore, applications that have not been advertised at the CIF date will need to be amended to properly group and class all of the associated goods or services.

### **8.3.8 Associated marks**

The concept of “associated marks”, as set out in section 15 of the former Act, will no longer exist in the amended Act. Therefore, at the CIF date, information pertaining to associated trademarks will be removed from all applications and registrations.

### **8.3.9 Standard character trademarks**

Under the transitional provisions of the new Regulations, an application filed before, but not yet advertised at the CIF date may be amended at any time prior to registration to add a statement that the applicant wishes the trademark to be registered in standard characters, but only if the trademark remains substantially the same.

### **8.3.10 Non-traditional trademarks**

An application filed before, but not yet advertised at the CIF date may be amended, at any time prior to registration, but only if the trademark remains substantially the same, to add a statement referred to in paragraphs 31(e) to (g) of the new Regulations.

### 8.3.11 Fees

The prescribed application fee will be the fee under the previous Tariff of Fees and the fee per additional Nice Class will not apply.

In addition, the prescribed registration fee is still required for applications having a filing date prior to the CIF date and that are not advertised at the CIF date.

**Note:** The prescribed registration fee is adjusted every year on the first of January. The amount depends on the date on which the payment is received by the Registrar, even if the application was filed or advertised prior to the annual adjustment. To find out the exact amount of a fee, please consult the [list of fees for trademarks](#).

## 8.4 Advertised and Allowed

Trademarks that have been advertised or allowed prior to the CIF date will be subject to most of the provisions of the former Act.

As the different bases of filing have been removed from the amended Act, applications will no longer require a declaration of use prior to registration.

In addition, the prescribed registration fee is still required for applications having a filing date prior to the CIF date and that are advertised, but not yet registered at the CIF date.

**Note:** The prescribed registration fee is adjusted every year on the first of January. The amount depends on the date on which the payment is received by the Registrar, even if the application was filed or advertised prior to the annual adjustment. To find out the exact amount of a fee, please consult the [list of fees for trademarks](#).

Where a trademark has been advertised but has not yet proceeded to allowance at the CIF date, a notice to the applicant will be given by way of a registration fee notice explaining that in order for the application to proceed to registration, the prescribed registration fee must be paid on or before 6 months from the date of the notice. As section 39 of the former Act will have been removed, it will not be possible to issue a further “notice of allowance”.

If the registration fee is paid, it is deemed to have been paid for all original and divisional applications from which it stems, and all divisional applications stemming from that application, if and as applicable.

For applications that are pending at the CIF, the term of registration will depend on the date on which the Registrar processes the fee for registration. For example, a trademark will be granted an initial term of 15 years if the payment of the registration fee is processed by the Registrar prior to the CIF date. Alternatively, a trademark will be granted a term of 10 years if the payment of the registration fee is processed by the Registrar on or after the CIF date.

The grouping of the goods or services according to the classes of the Nice Classification will not be required for an application that was filed and advertised prior to the CIF date since it is only required for the purposes of advertisement, renewal or following a notice issued under section 44.1 of the amended Act.

**Important:** In the case of a divisional application filed after the two-month period immediately following advertisement in respect of a word mark or a distinguishing guise, the divisional application

**must, at the time of its filing**, include a statement under paragraph 31(b) of the amended Act to the effect that the applicant wishes the trademark to be registered in standard characters, or under paragraph 31(e) of the new Regulations that the trademark consists in whole or in part of a three-dimensional shape or a mode of packaging goods, as applicable. These statements are required at the time of filing the divisional application in view of paragraph 35(2)(e) of the new Regulations since it will only be permissible to add or delete these statements if the application has not been advertised and the trademark remains substantially the same.

Moreover, when a divisional application which stems from an original application in respect of a word mark or distinguishing guise proceeds to registration, the applicant can request that the registrations be merged, in which case the Office will change the “type” of the resultant merged registration to a standard character, a three-dimensional shape or a mode of packaging goods, as applicable.

## 8.5 Registered

Under subsection 46(1) of the former Act, registered trademarks are subject to renewal every 15 years. During the transition to the amended Act, the fee, renewal term, and requirement to group and class goods or services according to the Nice classification will be dependent on several factors:

If renewal is requested after the coming-into-force (CIF) date of the new legislation for a registration that expired before the CIF date:

- the old renewal fee applies;
- the renewal period is for 15 years;
- the owner will not be required to group and class goods or services according to the Nice Classification; and
- the Registrar will, shortly after the renewal, send a notice requiring the grouping of goods or services according to the Nice classification.

If renewal is requested and processed before the CIF date and the registration expires after the CIF date:

- the old renewal fee applies;
- grouping the goods or services according to Nice is not required until a notice under section 44.1 of the amended Act is issued; and
- if the renewal period granted was for 15 years, it will be amended to 10 years as the effective date of renewal is after the CIF date of the amended Act;
- if the CIF date is known when the request is processed, and the effective date of renewal is after the CIF, the Office will grant 10 years

If renewal is requested after the CIF date for a registration that expired after the CIF date:

- the new renewal fee applies;

- the renewal period is for 10 years; and
- the registered owner will be required to group and class goods or services according to the Nice classification.

In all cases where the new renewal fees apply, the prescribed fee will be the basic renewal fee for the first class. If the goods or services are not correctly grouped and classed by the deadline to renew, owners will receive additional time to group and class the goods or services and pay the remaining fees. If the remaining fees are not paid, the Registrar will expunge the registration.

**Note:** The prescribed renewal fee is adjusted every year on the first of January. The amount depends on the date on which the payment is received by the Registrar, even if the registration expiry date is prior to the annual adjustment. To find out the exact amount of a fee, please consult the [list of fees for trademarks](#).