



November 13, 2009

By Email: iyana.goyette@ic.gc.ca

Ms. Iyana Goyette
Canadian Intellectual Property Office
Trade-marks Branch
50 Victoria Street
Gatineau, Québec
K1A 0C9

Dear Ms. Goyette:

Re: Proposed Practice Notice for Section 16(2) of the Trade-marks Act

FICPI Canada wishes to thank the Canadian Intellectual Property Office for the opportunity to comment on the proposed practice notice regarding section 16(2) of the *Trade-marks Act*, which concerns applications based on use and registration abroad.

As you know, FICPI (the Federation Internationale des Conseils en Propriété Industrielle), comprises more than 3500 intellectual property attorneys in private practice in 86 countries. FICPI Canada is a self-governing national association of FICPI and represents the interests of Canadian patent and trade mark professionals. Our membership includes senior professionals at most major Canadian intellectual property firms. Our clients span all types and sizes of businesses, including multi-national corporations, small and medium size enterprises, and individuals.

The proposed practice notice would make two significant changes in how section 16(2) of the *Act* is applied by the Trade-marks Office. First, it would require that an application based on section 16(2) indicate that the mark was in use *as of the date of filing in Canada*. Secondly, it would permit an amendment to add a claim under section 16(2) only *prior to the decision of the Registrar of Trade-marks to advertise the application in the Trade-marks Journal*. FICPI Canada is opposed to these changes because it would call into question the validity of many

registrations that have issued based on section 16(2), and because the changes are not supported by the language of the statute and regulations nor any court decisions.

Section 16(2) itself makes no mention that use of the mark as of the filing date is a requirement. If that had been the intention of the Parliament, the language of the statute would reflect this. Compare, for example, section 12(2) and section 13(1)(a) which both set out a distinctiveness requirement that is a condition precedent to registration in certain cases. In both section 12(2) and section 13(1)(a), the statute expressly recites that the required distinctiveness must exist "at the date of filing an application for its registration". If Parliament had intended that the use requirement of section 16(2) must exist at the date of filing of the application, the statute would recite such a requirement in similar terms.

Moreover, section 16(2) has to be read in conjunction with section 30(d) which makes it clear that although section 16(2) refers to the requirement of a registration in the applicant's country of origin, such a registration need not exist at the date of filing of the application in Canada. It is sufficient that the applicant have a corresponding application in its country of origin. It would be illogical to interpret section 16(2) to impose a requirement that the use requirement must exist as of the filing date when it is clear that the foreign registration need not exist as of the Canadian filing date.

Similarly, sections 30-32 of the Regulations provide that an application can be amended prior to advertisement to rely on a foreign registration. For an amendment to rely on any earlier date of use in Canada, evidence must be submitted to justify the change. However, there is no requirement for evidence of use as of the filing date to make an amendment to rely on section 16(2) of the Act. Moreover, it is not permissible to amend after advertisement to rely on 16(2). These provisions are consistent with the interpretation that 16(2) requires a foreign registration and use somewhere as of the date of advertisement, not as of the filing date.

On a related point, the proposal that would limit amendments to the date of "the decision of the Registrar of Trade-marks to advertise the application" is completely contrary to the language of sections 30 and 32 of the Regulations which expressly permit such an amendment up until the date of advertisement, or at least the day before.

It is also noteworthy that section 18 of the Act does not support an interpretation of section 16(2) that includes a requirement of use as of the Canadian filing date. Nonetheless, if the proposed practice notice were to come into effect, countless registrations that have issued over the past 50 years based on section 16(2) may be called into question, especially if they issued from applications that were amended after filing to rely on section 16(2).

For all of the above reasons, FICPI Canada cannot support the proposed practice notice.

FICPI Canada wishes to thank the Canadian Intellectual Property Office for the opportunity to provide comments. If CIPO has any comments about our submissions, or if you consider it would be helpful to have a meeting with representatives from FICPI Canada, please do not hesitate to contact the undersigned.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'R. Storey', with a long horizontal line extending to the right.

Robert B. Storey
President - FICPI Canada