

## Trade-marks Regulations (SOR/96-195)

Enabling Statute: Trade-marks Act

Regulation current to January 25th, 2011

Attention: See coming into force provision and notes, where applicable.

# Trade-marks Regulations

SOR/96-195

Registration April 16, 1996

## TRADE-MARKS ACT

### Trade-marks Regulations

P.C. 1996-490 April 16, 1996

His Excellency the Governor General in Council, on the recommendation of the Minister of Industry and the Treasury Board, pursuant to subsections 11.13(1)<sup>\*</sup> and (4) to (6)<sup>\*</sup> and 29(1)<sup>\*\*</sup>, paragraph 30(h), subsections 37(1), 38(1)<sup>\*\*\*</sup>, (6)<sup>\*\*\*\*</sup> and (7)<sup>\*\*\*\*</sup>, 41(1), 44(1), 45(1)<sup>\*\*\*\*\*</sup>, 46(2) to (4)<sup>\*\*\*\*\*</sup>, 47(1) and (2), 53(1)<sup>\*\*\*\*\*</sup> and 59(2) and sections 60<sup>\*\*\*\*\*</sup> and 65<sup>\*\*\*\*\*</sup> of the *Trade-marks Act*, is pleased hereby to repeal the *Trade Marks Regulations*, C.R.C., c. 1559, and to make the annexed *Regulations respecting Trade-marks*, in substitution therefor.

\* S.C. 1994, c. 47, s. 192

\*\* S.C. 1994, c. 47, s. 197

\*\*\* S.C. 1992, c. 1, s. 134

\*\*\*\* S.C. 1993, c. 15, s. 66(2)

\*\*\*\*\* S.C. 1994, c. 47, s. 200(1)

\*\*\*\*\* S.C. 1992, c. 1, s. 135(1)

\*\*\*\*\* S.C. 1993, c. 44, s. 234

\*\*\*\*\* S.C. 1993, c. 44, s. 238(4)

\*\*\*\*\* S.C. 1994, c. 47, s. 201

## TRADE-MARKS REGULATIONS

1. [Repealed, SOR/2007-91, s. 2]

### INTERPRETATION

2. The following definitions apply in these Regulations.

"Act" means the *Trade-marks Act*. (*Loi*)

"applicant" means a person who files an application for the registration of a trade-mark, pursuant to section 30 of the Act, or who is the last transferee of an application for the registration of a trade-mark recognized under section 48. (*requérant*)

"Journal" means the *Trade-marks Journal* referred to in subsection 66(3) of the Act. (*Journal*)

"trade-mark agent" means a person whose name is entered on the list of trade-mark agents referred to in section 21. (*agent de marques de commerce*)

### CORRESPONDENCE

3. (1) Correspondence intended for the Registrar or the Office of the Registrar of Trade-marks shall be addressed to the "Registrar of Trade-marks".

(2) Correspondence addressed to the Registrar may be physically delivered to the Office of the Registrar of Trade-marks during ordinary business hours of the Office and shall be considered to be received by the Registrar on the day of the delivery.

(3) For the purposes of subsection (2), where correspondence addressed to the Registrar is physically delivered to the Office of the Registrar of Trade-marks outside of its ordinary business hours, it shall be considered to have been delivered to the Office during ordinary business hours on the day when the Office is next open for business.

(4) Correspondence addressed to the Registrar may be physically delivered to an establishment that is designated by the Registrar in the Journal as an establishment to which correspondence addressed to the Registrar may be delivered, during ordinary business hours of that establishment, and

(a) where the delivery is made to the establishment on a day that the Office of the Registrar of Trade-marks is open for business, the correspondence shall be considered to be received by the Registrar on that day; and

(b) where the delivery is made to the establishment on a day that the Office of the Registrar of Trade-marks is closed for business, the correspondence shall be considered to be received by the Registrar on the day when the Office is next open for business.

(5) For the purposes of subsection (4), where correspondence addressed to the Registrar is physically delivered to an establishment outside of ordinary business hours of the establishment, it shall be considered to have been delivered to that establishment during ordinary business hours on the day when the establishment is next open for business.

(6) Correspondence addressed to the Registrar may be sent at any time by electronic or other means of transmission specified in the Journal.

(7) For the purposes of subsection (6), where, according to the local time of the place where the Office of the Registrar of Trade-marks is located, the correspondence is delivered on a day when the Office is open for business, it shall be considered to be received by the Registrar on that day.

(8) For the purposes of subsection (6), where, according to the local time of the place where the Office of the Registrar of Trade-marks is located, the correspondence is delivered on a day when the Office is closed for business, it shall be considered to be received by the Registrar on the day when the Office is next open for business.

(9) Subsection (6) does not apply to the following:

(a) evidence submitted pursuant to subsection 11.13(5) of the Act;

(b) evidence submitted pursuant to subsection 38(7) of the Act; and

(c) an affidavit or a statutory declaration furnished pursuant to subsection 45(1) of the Act.

SOR/99-292, s. 1.

**4.** (1) Communication in respect of a trade-mark shall be in writing, but the Registrar may also consider oral communications.

(2) The Registrar may request that an oral communication be confirmed in writing.

**5.** (1) Subject to subsection (2), each communication addressed to the Registrar shall deal with only one application for the registration of a trade-mark or one registered trade-mark.

(2) Subsection (1) does not apply in respect of

(a) a change in the name or address of an applicant for the registration of more than one trade-mark;

(b) a change in the name or address of a registered owner of more than one registered trade-mark;

(c) an application to cancel a registration;

(d) a transfer or other document affecting the rights to an application for the registration of a trade-mark or the rights to a registered trade-mark; and

(e) an appointment of a representative for service or a change in the name and address of a representative for service.

**6.** (1) Any address required to be furnished pursuant to the Act or these Regulations shall be a complete mailing address and shall include the street name and number, where one exists, and the postal code.

(2) Where the Registrar has not been notified of a change of address, the Registrar is not responsible for any correspondence not received by an applicant, registered owner, trade-mark agent or representative for service.

**7.** (1) Correspondence in respect of an application for the registration of a trade-mark shall include

(a) the name of the applicant;

(b) the application number, if one has been assigned; and

(c) the trade-mark.

(2) Correspondence in respect of a registered trade-mark shall include

(a) the registration number;

(b) the application number; and

(c) the trade-mark.

**8.** (1) Subject to subsections (2) and (4), correspondence relating to the prosecution of an application for the registration of a trade-mark shall be with the applicant.

(2) Subject to subsection (3) and sections 9 and 11, correspondence referred to in subsection (1) shall be with a trade-mark agent, where the trade-mark agent has been authorized to act on behalf of the applicant in one of the following ways:

(a) the trade-mark agent filed the application with the Registrar as the agent of the applicant;

(b) the trade-mark agent is appointed as the agent of the applicant in the application or an accompanying document; or

(c) the trade-mark agent is appointed as the agent of the applicant after the application is filed.

(3) Where a trade-mark agent referred to in subsection (2) appoints another trade-mark agent as associate or substitute agent, correspondence shall be with the associate or substitute agent.

(4) Where a person requests recognition of a transfer of an application pursuant to section 48, correspondence in respect of the recognition of the transfer shall also be with the person who requests that recognition.

**9.** (1) Where a trade-mark agent is not a resident of Canada, the agent shall appoint an associate agent who is a resident of Canada.

(2) Where an associate trade-mark agent is not appointed pursuant to subsection (1), the Registrar shall correspond with the applicant.

**10.** Sections 8 and 9 apply, with such modifications as are necessary, to parties to oppositions.

**11.** (1) The appointment of a trade-mark agent need not be made in writing, but the Registrar may require the agent to file a written authorization from the person or firm that that agent claims to represent, where the circumstances described in any of paragraphs 8(2)(a) to (c) have not occurred or the appointment has not been clearly established.

(2) Where a trade-mark agent fails to file an authorization required pursuant to subsection (1), the Registrar may notify the person or firm that the agent claims to represent, and shall, subject to section 8, continue to correspond with the person or firm notified until the written authorization is filed.

## **GENERAL**

**12.** The fees set out in the schedule are payable to the Receiver General and shall be forwarded to the Registrar.

**13.** Except as otherwise provided in these Regulations, all documents filed with the Office of the Registrar of Trade-marks shall be on white paper that measures at least 8 inches by 11 inches, or 21 cm x 28 cm, but not more than 8 1/2 inches by 14 inches, or 22 cm x 35 cm, on one side only, with left and upper margins of at least 1 inch or 2.5 cm.

**14.** (1) An application for the registration of a trade-mark shall contain the information required by section 30 of the Act, and shall be presented clearly and legibly, in the manner specified by the Registrar in the Journal and on the appropriate form published by the Registrar in the Journal, or in any other form that allows for the furnishing of the same information.

(2) Any document to be submitted to the Registrar relating to the registration of a trade-mark or a registered trade-mark shall be presented clearly and legibly, in the manner specified by the Registrar in the Journal and on the appropriate form published by the Registrar in the Journal, or in any other form that allows for the furnishing of the same information.

### **JOURNAL**

**15.** The Registrar shall publish, on a weekly basis, the Journal, which shall include

- (a) every advertisement made pursuant to subsection 37(1) of the Act;
- (b) the particulars of every registration of a trade-mark made or extended pursuant to the Act;
- (c) the particulars of the Registrar's rulings required to be published pursuant to section 64 of the Act;
- (d) every public notice required pursuant to subsection 9(1) of the Act; and
- (e) every order made by the Minister pursuant to subsection 66(2) of the Act.

**16.** Every advertisement of an application published pursuant to subsection 37(1) of the Act shall set out

- (a) the trade-mark claimed;
- (b) a note of any disclaimer;
- (c) the name and address of the applicant and the representative for service, if any;
- (d) the application number;
- (e) the date of filing of the application and the date of priority claimed pursuant to section 34 of the Act, if any;
- (f) a summary of the information filed by the applicant pursuant to paragraphs 30(a) to (d) and (g) of the Act;
- (g) in the case of an application for a proposed trade-mark, a certification mark or a distinguishing guise, a note to that effect;
- (h) where the benefit of subsection 12(2) or section 14 of the Act is claimed, a note to that effect;
- (i) the particulars of any territorial restriction applicable pursuant to subsection 32(2) of the Act; and
- (j) the particulars of any translation or transliteration furnished to the Registrar in accordance with paragraph 29(a) or (b).

**17.** The particulars published in the Journal of a registration of a trade-mark made or extended pursuant to the Act shall include

- (a) the number and date of the registration;
- (b) the name of the registered owner;
- (c) the application number; and
- (d) the issue number and date of the issue of the Journal in which the application was advertised.

### **ELIGIBILITY FOR EXAMINATION**

**18.** Subject to subsection 20(2), a person is eligible to sit for a qualifying examination relating to trade-mark law and practice if, before October 1 of the year

in which the person proposes to sit for the examination, the person resides in Canada and

(a) is a barrister or solicitor entitled to practise as such in a province, or a notary entitled to practise as such in the Province of Quebec; or

(b) has worked in Canada in the area of Canadian trade-mark law and practice, including the preparation and prosecution of applications for the registration of trade-marks, for a period of not less than 24 months.

#### **EXAMINING BOARD**

**19.** The members of an examining board shall be appointed by the Registrar and at least two members of the board shall be trade-mark agents nominated by the Intellectual Property Institute of Canada.

SOR/2003-209, s. 1.

#### **QUALIFYING EXAMINATION**

**20.** (1) The examining board shall

(a) set the qualifying examination relating to trade-mark law and practice;

(b) set the date for the qualifying examination; and

(c) conduct the qualifying examination during the month of October in each year.

(2) The Registrar shall give notice in the Journal of the date of the next qualifying examination and shall state in the notice that any person who proposes to sit for the examination shall

(a) within the time specified in the notice, notify the Registrar in writing and submit to the Registrar an affidavit or statutory declaration setting out the person's experience, duties and responsibilities in the area of trade-mark law and practice; and

(b) pay the fee set out in item 20 of the schedule.

(3) The Registrar shall designate the place or places where the qualifying examination is to be held and shall, by registered mail, at least four weeks before the day fixed for the examination, notify any person who has complied with the requirements of subsection (2).

#### **LISTING OF TRADE-MARK AGENTS**

**21.** The Registrar shall, on written request and payment of the fee set out in item 19 of the schedule, enter on a list of trade-mark agents the name of

(a) any resident of Canada who has passed the qualifying examination relating to Canadian trade-mark law and practice, including the preparation and prosecution of applications for registration of trade-marks;

(b) any resident of Canada who is a barrister or solicitor entitled to practise as such in a province, or a notary entitled to practise as such in the Province of Quebec, who has

(i) passed the qualifying examination relating to trade-mark law and practice, or

(ii) worked in the area of trade-mark law, including the preparation and prosecution of applications for registration of trade-marks, for a period of not less than 24 months and who has submitted an affidavit or statutory declaration to that effect to the Registrar;

(c) a resident of any other country who is entitled to practise before the trade-marks office of that country; and

(d) any firm having the name of at least one of its members entered on the list as a trade-mark agent.

#### **RENEWAL**

**22.** (1) During the period beginning on January 1 and ending on March 31 of each year,

(a) a resident of Canada whose name is entered on the list of trade-mark agents shall, in order to maintain the resident's name on the list, pay the fee set out in item 21 of the schedule;

(b) a resident of any other country whose name is entered on the list of trade-mark agents shall, in order to maintain the resident's name on the list, file a statement signed by the agent setting out the agent's country of residence and declaring that the agent is in good standing before the trade-mark office of that country; and

(c) a firm having the name of at least one of its members entered on the list of trade-mark agents shall, in order to maintain the firm's name on the list, file a statement signed by one of its members whose name is on the list, indicating all of its members whose names are on the list.

(2) Where a trade-mark agent fails to comply with the applicable requirement set out in subsection (1), the Registrar shall send a written notice to the trade-mark agent requiring that, within three months after the date of the notice, the trade-mark agent shall file

(a) the statement required by paragraph (1)(b) or (c), as applicable; or

(b) the fee set out in item 21 of the schedule.

(3) Where a trade-mark agent fails to comply with a notice referred to in subsection (2), the Registrar shall remove the name of the agent from the list of trade-mark agents.

**23.** (1) The name of a trade-mark agent that has been removed from the list of trade-mark agents pursuant to subsection 22(3) may be reinstated if the agent applies to the Registrar within one year after the date of the removal of the agent's name from the list, and

(a) files the statement required by paragraph 22(1)(b) or (c), as applicable; or

(b) pays the fees set out in items 21 and 22 of the schedule.

(2) A firm is entitled to have its name remain on the list of trade-mark agents where

(a) the name of at least one of its members is on the list; and

(b) the statement required by paragraph 22(1)(c) is filed.

### **APPLICATION FOR REGISTRATION**

**24.** A separate application shall be filed for the registration of each trade-mark, but a single application is sufficient where the trade-mark is used, made known or proposed to be used in association with both wares and services.

**25.** Subject to section 34 of the Act, the date of filing of an application for the registration of a trade-mark is the date on which the following are delivered to the Registrar:

(a) an application setting out the following information, namely,

(i) the name and address of the applicant,

(ii) the wares or services in association with which the trade-mark is proposed to be used, or has been used or made known, and

(iii) in the case of a trade-mark other than a proposed trade-mark,

(A) the date of first use or making known of the trade-mark in Canada, or

(B) the name of a country in which the trade-mark has been used and information respecting the registration or application for registration in or for a country of the Union on which the right to registration is based;

(b) the application fee set out in item 1 of the schedule; and

(c) a drawing of the trade-mark, unless the trade-mark consists solely of a word or words not depicted in a special form.

SOR/99-292, s. 2.

**26.** (1) Paragraph 25(a) applies in respect of an application to extend the statement of wares or services in respect of which a trade-mark is registered.

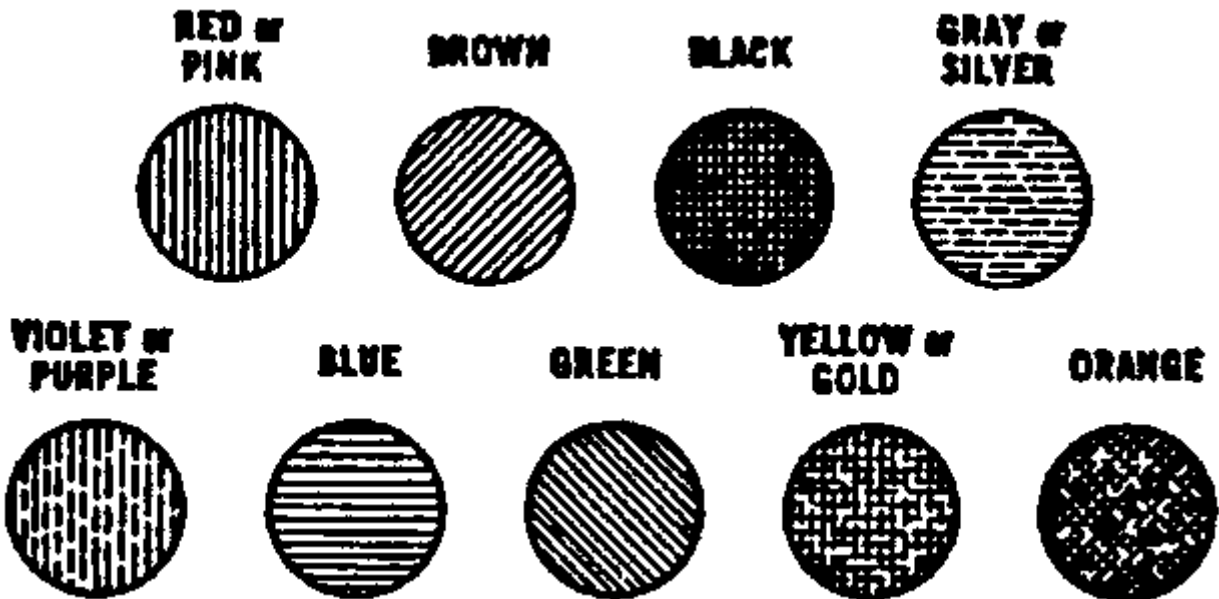
(2) The application referred to in subsection (1) shall be accompanied by the fee set out in item 3 of the schedule.

**27.** (1) Where a drawing of a trade-mark is required by paragraph 30(h) of the Act, the drawing shall be in black and white, no larger than 2 3/4 inches by 2 3/4 inches or 7 cm x 7 cm, and shall not include any matter that is not part of the trade-mark, and may be on paper that satisfies the requirements of section 13.

(2) Where the drawing of the trade-mark on file is not suitable for reproduction in the Journal, the Registrar may require an applicant to file a new drawing.

**28.** (1) Where the applicant claims a colour as a feature of the trade-mark, the colour shall be described.

(2) Where the description referred to in subsection (1) is not clear, the Registrar may require the applicant to file a drawing lined for colour in accordance with the following colour chart:



**29.** The Registrar may require an applicant for the registration of a trade-mark to furnish to the Registrar, as applicable,

(a) a translation into English or French of any words in any other language contained in the trade-mark;

(b) where the trade-mark contains matter expressed in characters other than Latin characters or in numerals other than Arabic or Roman numerals, a transliteration of the matter in Latin characters and Arabic numerals; and

(c) a specimen of the trade-mark as used.

#### **AMENDMENT OF APPLICATION FOR REGISTRATION**

**30.** Except as provided in sections 31 and 32, an application for the registration of a trade-mark may be amended either before or after the application is advertised pursuant to subsection 37(1) of the Act.

**31.** No application for the registration of a trade-mark may be amended where the amendment would change

(a) the identity of the applicant, except after recognition of a transfer by the Registrar;

(b) the trade-mark, except in respects that do not alter its distinctive character or affect its identity;

(c) the date of first use or making known in Canada of the trade-mark to an earlier date, except where the evidence proves that the change is justified by the facts;

(d) the application from one not alleging use or making known of the trade-mark in Canada before the filing of the application to one alleging such use or making known;

or

(e) the statement of wares or services so as to be broader than the statement of wares or services contained in the application at the time the application was filed pursuant to section 30 of the Act.

**32.** No application for the registration of a trade-mark may be amended, after it has been advertised in the Journal, to change

(a) the trade-mark in any manner whatsoever;

(b) the date of first use or making known in Canada of the trade-mark;

(c) the application from one alleging use or making known to one for a proposed trade-mark;

(d) the application from one that does not allege that the trade-mark has been used and registered in or for a country of the Union to one that does so allege; or

(e) the statement of wares or services so as to be broader than the statement of wares or services contained in the application at the time of advertisement.

SOR/99-292, s. 3.

**33.** (1) The Registrar may correct a clerical error in any instrument of record where

(a) the clerical error is discovered by the Registrar; or

(b) a request for correction is made by an applicant, registered owner or trade-mark agent of the applicant or registered owner.

(2) [Repealed, SOR/2003-209, s. 2]

SOR/2003-209, s. 2.

#### **ADVERTISEMENT OF APPLICATION FOR REGISTRATION**

**34.** Where the Registrar is not satisfied that an application for registration of a trade-mark should be refused pursuant to subsection 37(1) of the Act, the Registrar shall advertise the particulars of the application in the Journal.

#### **OPPOSITION**

**35.** A person who corresponds with the Registrar in respect of an opposition proceeding shall clearly state that the correspondence relates to the opposition proceeding.

**36.** After the Registrar has forwarded a copy of a statement of opposition to the applicant in accordance with subsection 38(5) of the Act, a party corresponding with the Registrar shall forward a copy of any correspondence in respect of the opposition, with the exception of a written argument filed pursuant to subsection 46(3), to the other party in the opposition proceeding.

**37.** (1) Any statement or other material required to be served on a party in an opposition proceeding under section 38 of the Act or these Regulations may be served on the party or their trade-mark agent or representative for service

(a) by personal service;

(b) by registered mail;

(c) by courier; or

(d) in any other manner with the consent of the party or their agent.

(2) For the purposes of subsection (1), unless the parties are agreed otherwise, if the party being served has appointed a trade-mark agent or has named a representative for service, service shall be effected on that agent or that representative for service.

(3) If service is effected by registered mail, service is deemed to be effected on the later of

(a) the date of mailing of the statement or material, and

(b) the day on which the party effecting service submits to the Registrar a notice in accordance with subsection (6).

(4) If service is effected by courier, service is deemed to be effected on the later of

(a) the date of delivery of the statement or material to the courier, and

(b) the day on which the party effecting service submits to the Registrar a notice in accordance with subsection (6).



(5) If service is effected by personal service or in any other manner with the consent of the party or their agent, service is deemed to be effected on the later of  
(a) the date of delivery of the statement or material to the person being served, and  
(b) the day on which the party effecting service submits to the Registrar a notice in accordance with subsection (6).

(6) The party effecting service shall notify the Registrar of the manner of service and  
(a) in the case of service by registered mail, the date of mailing of the statement or material;

(b) in the case of service by courier, the date of delivery of the statement or material to the courier; or

(c) in any other case, the date of delivery of the statement or material to the person being served.

SOR/2007-91, s. 3.

**38.** A statement of opposition shall be filed with the Registrar in duplicate.

**39.** Within two months after a copy of a statement of opposition has been forwarded to an applicant under subsection 38(5) of the Act, the applicant shall file a counter statement with the Registrar and serve a copy of the counter statement on the opponent.

SOR/2007-91, s. 4.

**40.** No amendment to a statement of opposition or counter statement shall be allowed except with leave of the Registrar and on such terms as the Registrar determines to be appropriate.

**41.** (1) Within four months after service of the counter statement, the opponent shall

(a) submit to the Registrar, by way of affidavit or statutory declaration, or in accordance with section 54 of the Act, the evidence that the opponent is relying on to support the opposition, or a statement that the opponent does not wish to submit evidence; and

(b) serve the applicant, where evidence is submitted, with a copy of the evidence or, where the opponent does not wish to submit evidence, with a copy of a statement that the opponent does not wish to submit evidence.

(2) Where the opponent does not submit either the evidence under subsection 38(7) of the Act or a statement that the opponent does not wish to submit evidence, within the time set out in subsection (1), the opposition shall be deemed to have been withdrawn for the purposes of subsection 38(7.1) of the Act.

SOR/2007-91, s. 5.

**42.** (1) Within four months after service of the opponent's evidence or statement referred to in paragraph 41(1)(a), the applicant shall

(a) submit to the Registrar by way of affidavit or statutory declaration, or in accordance with section 54 of the Act, the evidence that the applicant is relying on to support the application, or a statement that the applicant does not wish to submit evidence; and

(b) serve the opponent, where evidence is submitted, with a copy of the evidence or, where the applicant does not wish to submit evidence, with a copy of a statement that the applicant does not wish to submit evidence.

(2) Where the applicant does not submit either the evidence under subsection 38(7) of the Act or a statement that the applicant does not wish to submit evidence, within the time set out in subsection (1), the application shall be deemed to have been abandoned for the purposes of subsection 38(7.2) of the Act.

SOR/2007-91, s. 6.

**43.** Within one month after service on the opponent of the applicant's evidence referred to in section 42, the opponent

(a) may submit to the Registrar, by way of affidavit or statutory declaration, or in accordance with section 54 of the Act, evidence strictly confined to matters in reply; and

(b) shall, where submitting the evidence referred to in paragraph (a), serve the applicant with a copy of the evidence.

**44.** (1) No further evidence shall be adduced by any party except with leave of the Registrar and on such terms as the Registrar determines to be appropriate.

(2) Before giving notice in accordance with subsection 46(1), the Registrar may, on the application of any party and on such terms as the Registrar may direct, order the cross-examination under oath of any affiant or declarant on an affidavit or declaration that has been filed with the Registrar and is being relied on as evidence in the opposition.

(3) A cross-examination ordered pursuant to subsection (2) shall be held at a time, date and place and before a person agreed to by the parties or, in the absence of an agreement, as designated by the Registrar.

(4) A transcript of the cross-examination and exhibits to the cross-examination, and any documents or material undertaken to be submitted by the party whose affiant or declarant is being cross-examined, shall be filed with the Registrar by the party conducting the cross-examination, within the time fixed by the Registrar.

(5) If an affiant or declarant declines or fails to attend for cross-examination, the affidavit or declaration shall not be part of the evidence and shall be returned to the party who filed it.

**45.** (1) Every exhibit to an affidavit or declaration filed in an opposition shall be filed with the affidavit or declaration.

(2) Subject to subsection (3), all materials filed in an opposition shall be open to public inspection at the Office of the Registrar of Trade-marks.

(3) Written arguments shall not be open to public inspection until after they have been forwarded by the Registrar in accordance with subsection 46(3).

(4) A copy, photograph or sample of an exhibit referred to in subsection (1) shall be served on the other party unless the Registrar directs otherwise.

**46.** (1) Not less than 14 days after completion of the evidence, the Registrar shall give the parties written notice that they may, within one month after the date of the notice, file written arguments with the Registrar.

(2) No written argument shall be filed after the expiration of the period of one month referred to in subsection (1), except with leave of the Registrar.

(3) Written arguments, if any, shall be filed in duplicate and, after the written arguments of both parties have been filed or the period for filing written arguments has expired, the Registrar shall forward

(a) a copy of any written argument filed to every other party; and

(b) a notice to each party that a hearing may be requested.

(4) A party wishing to be heard by the Registrar shall give the Registrar written notice within one month after the date of the Registrar's notice referred to in paragraph (3)(b) and, on receipt of a notice from the party, the Registrar shall send the parties a written notice setting out the time, date and location of the hearing.

**47.** Where in an opposition proceeding any extension of time is granted to a party, the Registrar may thereafter grant a reasonable extension of time to the other party for the taking of any subsequent step.

#### **TRANSFER**

**48.** The Registrar shall recognize a transfer of an application for registration of a trade-mark on receipt of a written request for recognition together with

(a) evidence of the transfer; and

(b) the information required by paragraph 30(g) of the Act in the case of a first application.

**49.** (1) Where, as a result of a transfer of a trade-mark that is the subject of an application for registration, the trade-mark becomes the property of one person for use in association with some of the wares or services specified in the application and

of another person for use in association with other such wares or services, and the Registrar recognizes the transfer, each person shall file an amendment of that application restricted to those wares and services for use in respect of which the person owns the trade-mark.

(2) Each amendment referred to in subsection (1) is a continuation of the application for the purpose of preserving the benefit of the date of filing of the application, but shall otherwise be treated in subsequent proceedings as a separate application.

**50.** Where, as a result of a transfer, a registered trade-mark becomes the property of one person for use in association with some of the wares or services specified in the registration, and of another person for use in association with other such wares or services, and the transfer is registered by the Registrar, each person

(a) for the purposes of the Act, is deemed to be a separate registered owner of the trade-mark for use in association with the wares and services in respect of which the person has acquired or retained ownership of the trade-mark; and

(b) for the purposes of sections 43 to 46 of the Act, is deemed to have a separate registration of the trade-mark.

### **REGISTER**

**51.** A summary of an application for registration referred to in paragraph 26(2)(b) of the Act shall include the following information, where applicable:

(a) the name and address of the registered owner at the time of registration of the trade-mark;

(b) the trade-mark and any disclaimer with respect to that trade-mark;

(c) the wares and services in respect of which registration of the trade-mark has been requested and, in the case of a proposed trade-mark, in respect of which the declaration of use of the trade-mark in Canada required by subsection 40(2) of the Act has been filed;

(d) the number of the application for registration;

(e) the date of filing of the application and, where priority is claimed, the date of the priority filing of the application;

(f) the date or dates of first use of the trade-mark in Canada;

(g) the date or dates of first making known of the trade-mark in Canada; and

(h) the country of origin of the applicant or the applicant's predecessor in title and the name of a country other than Canada in which the trade-mark has been used.

**52.** The register, pursuant to paragraph 26(2)(f) of the Act, shall indicate, in respect of each registered trade-mark, the following particulars, where applicable:

(a) the territorial area to which the registration extends;

(b) the registration number;

(c) the registration number of each associated trade-mark;

(d) the name and address of the original registered owner;

(e) the name and address of the representative for service of the current registered owner;

(f) a notation disclosing whether registrability has been recognized pursuant to subsection 12(2) or section 13 or 14 of the Act;

(g) the number and date of any registration abroad on which the registration is based and the country in or for which the registration was made; and

(h) the date of filing any declaration of use.

SOR/99-292, s. 4.

### **OBJECTION PROCEEDINGS UNDER SECTION 11.13 OF THE ACT**

**53.** (1) Any statement or other material required to be served on a party in an objection proceeding under section 11.13 of the Act or these Regulations may be served on the party or their trade-mark agent or representative for service

(a) by personal service;

(b) by registered mail;

(c) by courier; or

(d) in any other manner with the consent of the party or their agent.

(2) For the purposes of subsection (1), unless the parties are agreed otherwise, if the party being served has appointed a trade-mark agent or has named a representative for service, service shall be effected on that agent or that representative for service.

(3) If service is effected by registered mail, service is deemed to be effected on the later of

(a) the date of mailing of the statement or material, and

(b) the day on which the party effecting service submits to the Registrar a notice in accordance with subsection (6).

(4) If service is effected by courier, service is deemed to be effected on the later of

(a) the date of delivery of the statement or material to the courier, and

(b) the day on which the party effecting service submits to the Registrar a notice in accordance with subsection (6).

(5) If service is effected by personal service or in any other manner with the consent of the party or their agent, service is deemed to be effected on the later of

(a) the date of delivery of the statement or material to the person being served, and

(b) the day on which the party effecting service submits to the Registrar a notice in accordance with subsection (6).

(6) The party effecting service shall notify the Registrar of the manner of service and

(a) in the case of service by registered mail, the date of mailing of the statement or material;

(b) in the case of service by courier, the date of delivery of the statement or material to the courier; or

(c) in any other case, the date of delivery of the statement or material to the person being served.

SOR/2007-91, s. 7.

**54.** No amendment to a statement of objection or counter statement shall be

allowed except with leave of the Registrar on such terms as the Registrar determines to be appropriate.

**55.** (1) For the application of subsection 11.13(5) of the Act, within four months after service of the counter statement, the objector

(a) may submit to the Registrar, by way of affidavit or statutory declaration, the evidence that the objector is relying on to support the objection, or a statement that the objector does not wish to submit evidence; and

(b) shall serve the responsible authority, where evidence is submitted, with a copy of the evidence or, where the objector does not wish to submit evidence, with a copy of a statement that the objector does not wish to submit evidence.

(2) Where the objector does not submit either the evidence under subsection 11.13(5) of the Act or a statement that the objector does not wish to submit evidence, within the time set out in subsection (1), the objection shall be deemed to have been withdrawn for the purposes of subsection 11.13(6) of the Act.

SOR/2007-91, s. 8.

**56.** Within four months after service of the objector's evidence or statement referred to in paragraph 55(1)(a), the responsible authority

(a) may submit to the Registrar, by way of affidavit or statutory declaration, the evidence that the responsible authority is relying on; and

(b) shall serve the objector, where evidence is submitted, with a copy of the evidence.

SOR/2007-91, s. 9.

**57.** Within one month after service on the objector of the responsible authority's evidence referred to in paragraph 56(a), the objector

(a) may submit to the Registrar, by way of affidavit or statutory declaration, evidence strictly confined to matters in reply; and

(b) where submitting the evidence referred to in paragraph (a), shall serve the responsible authority with a copy of the evidence.

**58.** (1) No further evidence shall be adduced by any party except with leave of the Registrar on such terms as the Registrar determines to be appropriate.

(2) Before giving notice in accordance with subsection 60(1), the Registrar may, on the application of any party and on such terms as the Registrar may direct, order the cross-examination under oath of any affiant or declarant on an affidavit or statutory declaration that has been filed with the Registrar and is being relied on as evidence in the objection proceeding.

(3) A cross-examination ordered pursuant to subsection (2) shall be held at a time, date and place and before a person agreed to by the parties or, in the absence of an agreement, as designated by the Registrar.

(4) A transcript of the cross-examination and exhibits to the cross-examination, and any documents or material undertaken to be submitted by the party whose affiant or declarant is being cross-examined, shall be filed with the Registrar by the party conducting the cross-examination, within the time fixed by the Registrar.

(5) If an affiant or declarant declines or fails to attend for cross-examination, the affidavit or statutory declaration shall not be part of the evidence and shall be returned to the party who filed it.

**59.** (1) Every exhibit to an affidavit or statutory declaration filed in an objection proceeding shall be filed with the affidavit or declaration.

(2) Subject to subsection (3), all materials filed in an objection proceeding shall be open to public inspection at the Office of the Registrar of Trade-marks.

(3) Written arguments shall not be open to public inspection until after they have been forwarded by the Registrar in accordance with subsection 60(3).

(4) A copy, photograph or sample of an exhibit referred to in subsection (1) shall be served on the other party unless the Registrar directs otherwise.

**60.** (1) Not less than 14 days after completion of the evidence, the Registrar shall give the parties written notice that they may, within one month after the date of the notice, file written arguments with the Registrar.

(2) No written argument shall be filed after the expiration of the period of one month referred to in subsection (1), except with leave of the Registrar.

(3) Written arguments, if any, shall be filed in duplicate and, after the written arguments of both parties have been filed or the period for filing written arguments has expired, the Registrar shall forward

(a) a copy of any written argument filed to every other party; and

(b) a notice to each party that a hearing may be requested.

(4) A party wishing to be heard by the Registrar shall give the Registrar written notice within one month after the date of the Registrar's notice referred to in paragraph (3)(b) and, on receipt of a notice from the party, the Registrar shall send the parties a written notice setting out the time, date and location of the hearing.

**61.** Where in an objection proceeding any extension of time is granted to a party, the Registrar may thereafter grant a reasonable extension of time to the other party for the taking of any subsequent step.

SCHEDULE  
(Section 12)

**TARIFF OF FEES**

**PART I**

**FILING**

1. An application for the registration of a trade-mark, (a) where the application and fee are submitted on-line to the Office of the Registrar of Trade-Marks, via the Canadian Intellectual Property Office web site.....	\$ 250
(b) in any other case.....	300
2. A statement of opposition pursuant to subsection 38(1) of the Act.....	750
3. An application to amend the registration of a trade-mark by extending the statement of wares or services in respect of which the trade-mark is registered.....	450
4. [Repealed, SOR/2003-209, s. 4]	
5. [Repealed, SOR/2007-91, s. 10]	
6. A request to recognize the transfer of one or more trade-marks, for each trade-mark.....	100
7. A request to renew the registration of one or more trade-marks, for each trade-mark,.....	
(a) where the request and fee are submitted on-line to the Office of the Registrar of Trade-Marks, via the Canadian Intellectual Property Office web site.....	350
(b) in any other case.....	400
8. A request to send one or more notices pursuant to section 44 or 45 of the Act, for each notice.....	400
9. An application for an extension of time pursuant to subsection 47(1) or (2) of the Act, for each act.....	125
10. Each certified copy of a registration referred to in subsection 31(1) of the Act.....	50
11. [Repealed, SOR/2003-209, s. 6]	
12. A request pursuant to paragraph 9(1)(n) or (n.1) of the Act with respect to one or more badges, crests, emblems, marks or armorial bearings, for each badge, crest, emblem, mark or armorial bearing.....	500
13. [Repealed, SOR/2007-91, s. 11]	
14. A statement of objection pursuant to subsection 11.13(1) of the Act.....	1,000

## PART II

### REGISTRATION

15. A trade-mark, including, without further fee, the issuance of a certificate of registration of the trade-mark.....	\$ 200
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## PART III

### ISSUANCE

16. A certified copy in paper form of a document, other than a certified copy made under subsection 60(1) of the Act or Rule 318 or 350 of the <i>Federal Courts Rules</i> : (a) for each certification.....	\$35
(b) plus, for each page .....	1
17. A certified copy in electronic form of a document, other than a certified copy made under subsection 60(1) of the Act or Rule 318 or 350 of the <i>Federal Courts Rules</i> : (a) for each certification.....	35

(b) plus, for each trade-mark to which the request relates.....	10
18. A copy in paper form of a document, for each page,	
(a) where the person requesting makes the copy using equipment of the Office of the Registrar of Trade-marks.....	0.50
(b) where the Office makes the copy.....	1
18.1 A copy in electronic form of a document:	
(a) for each request.....	10
(b) plus, for each trade-mark to which the request relates.....	10
(c) plus, if the copy is requested on a physical medium, for each physical medium requested in addition to the first.....	10

## PART IV

### TRADE-MARK AGENTS

19. On request, to enter a name on the list of trade-mark agents:	
(a) where the request and fee are submitted on-line to the Office of the Registrar of Trade-Marks, via the Canadian Intellectual Property Office web site.....	\$ 300
(b) in any other case.....	350
20. Examination fee referred to in paragraph 20(2)(b).....	400
21. Annual registration fee referred to in paragraphs 22(1)(a) and (2)(b):	
(a) where the fee is submitted on-line to the Office of the Registrar of Trade-Marks, via the Canadian Intellectual Property Office web site.....	300
(b) in any other case.....	350
22. Reinstatement fee referred to in paragraph 23(1)(b).....	200

SOR/2003-209, ss. 3 to 9; SOR/2007-91, ss. 10 to 12.

### RELATED PROVISIONS

— **SOR/2007-91, s. 13:**

**13.** (1) Opposition proceedings relating to an application for the registration of a trade-mark that was advertised in the *Trade-marks Journal* before October 1, 2007 shall be conducted in accordance with sections 39, 41 and 42 of the *Trade-marks Regulations*, previously the *Trade-marks Regulations (1996)*, as they read on September 30, 2007.

**(2) If an application for the registration of a trade-mark is advertised with an error and then advertised with a correction, the date of the advertisement with the correction is deemed to be the date of the advertisement for the purpose of subsection (1).**

— **SOR/2007-91, s. 14:**

**14.** Objection proceedings relating to a geographical indication, in respect of which a statement referred to in subsection 11.12(2) of the *Trade-marks Act* was published in the *Canada Gazette* before October 1, 2007, shall be conducted in accordance with sections 55 and 56 of the *Trade-marks Regulations*, previously the *Trade-marks Regulations (1996)*, as they read on September 30, 2007.