

# Trade-marks Act

(R.S.C., 1985, c. T-13)

(as amended up to December 30, 2018)

An Act relating to trade-marks and unfair competition

## Short Title

### Short title

1 This Act may be cited as the *Trade-marks Act*.

R.S., c. T-10, s. 1.

## Interpretation

### Definitions

2 In this Act,

**certification mark** means a mark that is used for the purpose of distinguishing or so as to distinguish goods or services that are of a defined standard with respect to

(a) the character or quality of the goods or services,

(b) the working conditions under which the goods have been produced or the services performed,

(c) the class of persons by whom the goods have been produced or the services performed, or

(d) the area within which the goods have been produced or the services performed,

from goods or services that are not of that defined standard; (*marque de certification*)

**confusing**, when applied as an adjective to a trade-mark or trade-name, means, except in sections 11.13 and 11.21, a trade-mark or trade-name the use of which would cause confusion in the manner and circumstances described in section 6; (*créant de la confusion*)

**Convention** means the Convention of the Union of Paris made on March 20, 1883 and any amendments and revisions thereof made before or after July 1, 1954 to which Canada is party; (*Convention*)

**country of origin** means

(a) the country of the Union in which the applicant for registration of a trade-mark had at the date of the application a real and effective industrial or commercial establishment, or

(b) if the applicant for registration of a trade-mark did not at the date of the application have in a country of the Union an establishment as described in paragraph (a), the country of the Union where he on that date had his domicile, or

(c) if the applicant for registration of a trade-mark did not at the date of the application have in a country of the Union an establishment as described in paragraph (a) or a domicile as described in paragraph (b), the country of the Union of which he was on that date a citizen or national; (*pays d'origine*)

**country of the Union** means

(a) any country that is a member of the Union for the Protection of Industrial Property constituted under the Convention, or

(b) any WTO Member; (*pays de l'Union*)

**distinctive**, in relation to a trade-mark, means a trade-mark 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 is adapted so to distinguish them; (*distinctive*)

**distinguishing guise** means

(a) a shaping of goods or their containers, or

(b) a mode of wrapping or packaging goods

the appearance of which is used by a person for the purpose of distinguishing or so as to distinguish goods or services manufactured, sold, leased, hired or performed by him from those manufactured, sold, leased, hired or performed by others; (*signe distinctif*)

**geographical indication** means an indication that identifies a wine or spirit, or an agricultural product or food of a category set out in the schedule, as originating in the territory of a WTO Member, or a region or locality of that territory, if a

quality, reputation or other characteristic of the wine or spirit or the agricultural product or food is essentially attributable to its geographical origin; (*indication géographique*)

**owner**, in relation to a certification mark, means the person by whom the defined standard has been established; (*propriétaire*)

**package** [Repealed, 2014, c. 32, s. 7]

**person** includes any lawful trade union and any lawful association engaged in trade or business or the promotion thereof, and the administrative authority of any country, state, province, municipality or other organized administrative area; (*personne*)

**person interested** includes any person who is affected or reasonably apprehends that he may be affected by any entry in the register, or by any act or omission or contemplated act or omission under or contrary to this Act, and includes the Attorney General of Canada; (*personne intéressée*)

**prescribed** means prescribed by or under the regulations; (*prescrit*)

**proposed trade-mark** means a mark that is proposed to be used by a person for the purpose of distinguishing or so as to distinguish goods or services manufactured, sold, leased, hired or performed by him from those manufactured, sold, leased, hired or performed by others; (*marque de commerce projetée*)

**protected geographical indication** means a geographical indication that is on the list kept pursuant to subsection 11.12(1); (*indication géographique protégée*)

**register** means the register kept under section 26; (*registre*)

**registered trade-mark** means a trade-mark that is on the register; (*marque de commerce déposée*)

**registered user** [Repealed, 1993, c. 15, s. 57]

**Registrar** means the Registrar of Trade-marks who is described in subsection 63(1); (*registraire*)

**related companies** means companies that are members of a group of two or more companies one of which, directly or indirectly, owns or controls a majority of the issued voting stock of the others; (*compagnies connexes*)

**release** has the same meaning as in subsection 2(1) of the *Customs Act*; (*dédouanement*)

**representative for service** means the person or firm named under paragraph 30 (g), subsection 38(3), paragraph 41(1)(a) or subsection 42(1); (*représentant pour signification*)

**trade-mark** means

(a) a mark that is used by a person for the purpose of distinguishing or so as to distinguish goods or services manufactured, sold, leased, hired or performed by him from those manufactured, sold, leased, hired or performed by others,

(b) a certification mark,

(c) a distinguishing guise, or

(d) a proposed trade-mark; (*marque de commerce*)

**trade-name** means the name under which any business is carried on, whether or not it is the name of a corporation, a partnership or an individual; (*nom commercial*)

**use**, in relation to a trade-mark, means any use that by section 4 is deemed to be a use in association with goods or services; (*emploi ou usage*)

**wares** [Repealed, 2014, c. 32, s. 7]

**WTO Agreement** has the meaning given to the word *Agreement* by subsection 2 (1) of the *World Trade Organization Agreement Implementation Act*; (*Accord sur l'OMC*)

**WTO Member** means a Member of the World Trade Organization established by Article I of the WTO Agreement. (*membre de l'OMC*)

R.S., 1985, c. T-13, s. 2; 1993, c. 15, s. 57; 1994, c. 47, s. 190; 2014, c. 20, s. 369, c. 32, ss. 7, 53; 2017, c. 6, s. 60.

### **When deemed to be adopted**

**3** A trade-mark is deemed to have been adopted by a person when that person or his predecessor in title commenced to use it in Canada or to make it known in Canada or, if that person or his predecessor had not previously so used it or made it known, when that person or his predecessor filed an application for its registration in Canada.

R.S., c. T-10, s. 3.

### **When deemed to be used**

**4 (1)** A trade-mark is deemed to be used in association with goods if, at the time of the transfer of the property in or possession of the goods, in the normal course of trade, it is marked on the goods themselves or on the packages in which they are distributed or it is in any other manner so associated with the goods that notice of the association is then given to the person to whom the property or possession is transferred.

**Idem**

**(2)** A trade-mark is deemed to be used in association with services if it is used or displayed in the performance or advertising of those services.

**Use by export**

**(3)** A trade-mark that is marked in Canada on goods or on the packages in which they are contained is, when the goods are exported from Canada, deemed to be used in Canada in association with those goods.

R.S., 1985, c. T-13, s. 4; 2014, c. 32, ss. 53, 54(F).

**When deemed to be made known**

**5** A trade-mark is deemed to be made known in Canada by a person only if it is used by that person in a country of the Union, other than Canada, in association with goods or services, and

- (a)** the goods are distributed in association with it in Canada, or
- (b)** the goods or services are advertised in association with it in
  - (i)** any printed publication circulated in Canada in the ordinary course of commerce among potential dealers in or users of the goods or services, or
  - (ii)** radio broadcasts ordinarily received in Canada by potential dealers in or users of the goods or services,

and it has become well known in Canada by reason of the distribution or advertising.

R.S., 1985, c. T-13, s. 5; 2014, c. 32, s. 53.

**When mark or name confusing**

**6 (1)** For the purposes of this Act, a trade-mark or trade-name is confusing with another trade-mark or trade-name if the use of the first mentioned trade-mark or trade-name would cause confusion with the last mentioned trade-mark or trade-name in the manner and circumstances described in this section.

**Idem**

**(2)** The use of a trade-mark causes confusion with another trade-mark if the use of both trade-marks in the same area would be likely to lead to the inference that the goods or services associated with those trade-marks are manufactured, sold, leased, hired or performed by the same person, whether or not the goods or services are of the same general class.

**Idem**

**(3)** The use of a trade-mark causes confusion with a trade-name if the use of both the trade-mark and trade-name in the same area would be likely to lead to the inference that the goods or services associated with the trade-mark and those associated with the business carried on under the trade-name are manufactured, sold, leased, hired or performed by the same person, whether or not the goods or services are of the same general class.

**Idem**

**(4)** The use of a trade-name causes confusion with a trade-mark if the use of both the trade-name and trade-mark in the same area would be likely to lead to the inference that the goods or services associated with the business carried on under the trade-name and those associated with the trade-mark are manufactured, sold, leased, hired or performed by the same person, whether or not the goods or services are of the same general class.

**What to be considered**

**(5)** In determining whether trade-marks or trade-names are confusing, the court or the Registrar, as the case may be, shall have regard to all the surrounding circumstances including

**(a)** the inherent distinctiveness of the trade-marks or trade-names and the extent to which they have become known;

**(b)** the length of time the trade-marks or trade-names 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 trade-marks or trade-names in appearance or sound or in the ideas suggested by them.

R.S., 1985, c. T-13, s. 6; 2014, c. 32, s. 53.

## **Unfair Competition and Prohibited Marks**

### **Prohibitions**

## **7 No person shall**

- (a)** make a false or misleading statement tending to discredit the business, goods or services of a competitor;
- (b)** direct public attention to his goods, services or business in such a way as to cause or be likely to cause confusion in Canada, at the time he commenced so to direct attention to them, between his goods, services or business and the goods, services or business of another;
- (c)** pass off other goods or services as and for those ordered or requested; or
- (d)** make use, in association with goods or services, of any description that is false in a material respect and likely to mislead the public as to
  - (i)** the character, quality, quantity or composition,
  - (ii)** the geographical origin, or
  - (iii)** the mode of the manufacture, production or performance of the goods or services.
- (e)** [Repealed, 2014, c. 32, s. 10]

R.S., 1985, c. T-13, s. 7; 2014, c. 32, ss. 10, 53, 56(F).

### **Warranty of lawful use**

**8** Every person who in the course of trade transfers the property in or the possession of any goods bearing, or in packages bearing, any trade-mark or trade-name shall, unless before the transfer he otherwise expressly states in writing, be deemed to warrant, to the person to whom the property or possession is transferred, that the trade-mark or trade-name has been and may be lawfully used in connection with the goods.

R.S., 1985, c. T-13, s. 8; 2014, c. 32, ss. 53, 54(F).

### **Prohibited marks**

**9 (1)** No person shall adopt in connection with a business, as a trade-mark or otherwise, any mark consisting of, or so nearly resembling 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;

**(d)** any word or symbol likely to lead to the belief that the goods or services in association with which it is used have received, or are produced, sold or performed under, royal, vice-regal or governmental patronage, approval or authority;

**(e)** the arms, crest or flag adopted and used at any time by Canada or by any province or municipal corporation in Canada in respect of which the Registrar has, at the request of the Government of Canada or of the province or municipal corporation concerned, given public notice of its adoption and use;

**(f)** the emblem of the Red Cross on a white ground, formed by reversing the federal colours of Switzerland and retained by the Geneva Convention for the Protection of War Victims of 1949 as the emblem and distinctive sign of the Medical Service of armed forces and used by the Canadian Red Cross Society, or the expression “Red Cross” or “Geneva Cross”;

**(g)** the emblem of the Red Crescent on a white ground adopted for the same purpose as specified in paragraph (f);

**(g.1)** the third Protocol emblem — commonly known as the “Red Crystal” — referred to in Article 2, paragraph 2 of Schedule VII to the *Geneva Conventions Act* and composed of a red frame in the shape of a square on edge on a white ground, adopted for the same purpose as specified in paragraph (f);

**(h)** the equivalent sign of the Red Lion and Sun used by Iran for the same purpose as specified in paragraph (f);

**(h.1)** 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*;

**(i)** any territorial or civic flag or any national, territorial or civic arms, crest or emblem, of a country of the Union, if the flag, arms, crest or emblem is on a list communicated under article 6<sup>ter</sup> of the Convention or pursuant to the obligations under the Agreement on Trade-related Aspects of Intellectual Property Rights set out in Annex 1C to the WTO Agreement stemming from that article, and the Registrar gives public notice of the communication;

**(i.1)** any official sign or hallmark indicating control or warranty adopted by a country of the Union, if the sign or hallmark is on a list communicated under article 6<sup>ter</sup> of the Convention or pursuant to the obligations under the Agreement on Trade-related Aspects of Intellectual Property Rights set out in Annex 1C to the WTO Agreement stemming from that article, and the Registrar gives public notice of the communication;

**(i.2)** any national flag of a country of the Union;



**(i.3)** any armorial bearing, flag or other emblem, or the name or any abbreviation of the name, of an international intergovernmental organization, if the armorial bearing, flag, emblem, name or abbreviation is on a list communicated under article 6<sup>ter</sup> of the Convention or pursuant to the obligations under the Agreement on Trade-related Aspects of Intellectual Property Rights set out in Annex 1C to the WTO Agreement stemming from that article, and the Registrar gives public notice of the communication;

**(j)** any scandalous, obscene or immoral word or device;

**(k)** any matter that may falsely suggest a connection with any living individual;

**(l)** the portrait or signature of any individual who is living or has died within the preceding thirty years;

**(m)** the words “United Nations” or the official seal or emblem of the United Nations;

**(n)** any badge, crest, emblem or mark

**(i)** adopted or used by any of Her Majesty’s Forces as defined in the *National Defence Act*,

**(ii)** of any university, or

**(iii)** adopted and used by any public authority, in Canada as an official mark for goods or services,

in respect of which the Registrar has, at the request of Her Majesty or of the university or public authority, as the case may be, given public notice of its adoption and use;

**(n.1)** any armorial bearings granted, recorded or approved for use by a recipient 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; or

**(o)** 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.

### **Excepted uses**

**(2)** Nothing in this section prevents the adoption, use or registration as a trade-mark or otherwise, in connection with a business, of any mark

(a) described in subsection (1) with the consent of Her Majesty or such other person, society, authority or organization as may be considered to have been intended to be protected by this section; or

(b) consisting of, or so nearly resembling as to be likely to be mistaken for

(i) an official sign or hallmark mentioned in paragraph (1)(i.1), except in respect of goods that are the same or similar to the goods in respect of which the official sign or hallmark has been adopted, or

(ii) an armorial bearing, flag, emblem or abbreviation mentioned in paragraph (1)(i.3), unless the use of the mark is likely to mislead the public as to a connection between the user and the organization.

R.S., 1985, c. T-13, s. 9; 1990, c. 14, s. 8; 1993, c. 15, s. 58; 1994, c. 47, s. 191; 1999, c. 31, s. 209(F); 2007, c. 26, s. 6; 2014, c. 32, ss. 11, 53, 56(F).

### **Further prohibitions**

**10** Where any mark has by ordinary and *bona fide* commercial usage become recognized in Canada as designating the kind, quality, quantity, destination, value, place of origin or date of production of any goods or services, no person shall adopt it as a trade-mark in association with such goods or services or others of the same general class or use it in a way likely to mislead, nor shall any person so adopt or so use any mark so nearly resembling that mark as to be likely to be mistaken therefor.

R.S., 1985, c. T-13, s. 10; 2014, c. 32, s. 53.

### **Further prohibitions**

**10.1** Where a denomination must, under the *Plant Breeders' Rights Act*, be used to designate a plant variety, no person shall adopt it as a trade-mark 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 therefor.

1990, c. 20, s. 79.

### **Further prohibitions**

**11** No person shall use in connection with a business, as a trade-mark or otherwise, any mark adopted contrary to section 9 or 10 of this Act or section 13 or 14 of the *Unfair Competition Act*, chapter 274 of the Revised Statutes of Canada, 1952.

R.S., c. T-10, s. 11.

### **Further prohibitions**

**11.1** No person shall use in connection with a business, as a trade-mark or

otherwise, any denomination adopted contrary to section 10.1.

1990, c. 20, s. 80; 2014, c. 32, s. 56(F).

# Geographical Indications

## Definitions

**11.11 (1)** The following definitions apply in this section and in sections 11.12 to 11.24.

**Minister** means the Minister designated under subsection (2). (*ministre*)

**responsible authority** means, in relation to a wine or spirit, or an agricultural product or food of a category set out in the schedule, the person, firm or other entity that, in the Minister's opinion, is, by reason of state or commercial interest, sufficiently connected with and knowledgeable about that wine or spirit or that agricultural product or food to be a party to any proceedings under this Act. (*autorité compétente*)

## Designation of Minister

**(2)** The Governor in Council may, by order, designate any federal minister to be the Minister for the purposes of this section and sections 11.12 to 11.24.

## When indication confusing with trade-mark

**(3)** For the purposes of sections 11.13 and 11.21, an indication identifying an agricultural product or food is confusing with a trade-mark if the use of both the indication and the trade-mark in the same area would be likely to lead to the inference that the agricultural product or food associated with the indication originates from the same source as the goods or services associated with the trade-mark.

## What to be considered

**(4)** For the purposes of sections 11.13 and 11.21, in determining whether an indication is confusing with a trade-mark, the Registrar or the Federal Court, as the case may be, shall have regard to all the surrounding circumstances, including

**(a)** the length of time that the indication has been used to identify the agricultural product or food with which it is associated as originating in the territory, or the region or locality of a territory, and the extent to which it has become known;

**(b)** the degree of resemblance between the indication and the trade-mark,

including in appearance or sound or in the ideas suggested by them; and

**(c)** with respect to the trade-mark,

**(i)** its inherent distinctiveness and the extent to which it has become known,

**(ii)** the length of time that it has been in use, and

**(iii)** the nature of the goods, services or business that is associated with it.

1994, c. 47, s. 192; 2017, c. 6, s. 61.

## **List**

**11.12 (1)** There shall be kept under the supervision of the Registrar a list of geographical indications and, in the case of geographical indications identifying an agricultural product or food, translations of those indications.

### **Statement of Minister — indication**

**(2)** If a statement by the Minister in respect of an indication is published on the website of the Canadian Intellectual Property Office setting out the information mentioned in subsection (3), the Registrar shall enter the indication, and any translation of the indication set out in the statement, on the list if

**(a)** no statement of objection has been filed and served on the responsible authority in accordance with subsection 11.13(1) and the time for the filing of a statement of objection has expired; or

**(b)** a statement of objection has been so filed and served, but it has been withdrawn or deemed under subsection 11.13(6) to have been withdrawn or it has been rejected under subsection 11.13(7) or, if an appeal is taken, it is rejected in the final judgment given in the appeal.

### **Statement of Minister — translation**

**(2.1)** If a statement by the Minister is published on the website of the Canadian Intellectual Property Office setting out the information mentioned in subsection (3.1) in respect of a translation of an indication on the list that identifies an agricultural product or food, the Registrar shall enter the translation on the list if

**(a)** no statement of objection has been filed and served on the responsible authority in accordance with subsection 11.13(1) and the time for the filing of the statement of objection has expired; or

**(b)** a statement of objection has been so filed and served, but it has been withdrawn or deemed under subsection 11.13(6) to have been withdrawn or it has been rejected under subsection 11.13(7) or, if an appeal is taken, it is rejected in the final judgment given in the appeal.

#### **Information — indication**

**(3)** For the purposes of subsection (2), the statement by the Minister must set out all of the following information:

**(a)** that the Minister proposes that the indication and, if applicable, a translation of the indication, in the case of an indication that identifies an agricultural product or food, be entered on the list;

**(b)** in the case of an indication that identifies a wine or spirit, that the indication identifies a wine or that the indication identifies a spirit;

**(b.1)** in the case of an indication that identifies an agricultural product or food, the common name of the agricultural product or food and the category set out in the schedule to which it belongs;

**(c)** the territory, or the region or locality of a territory, in which the wine or spirit or the agricultural product or food is identified as originating;

**(d)** the name of the responsible authority in relation to the wine or spirit or the agricultural product or food and the address of the responsible authority's principal office or place of business in Canada or, if the responsible authority has no office or place of business in Canada, the name and address in Canada of a person or firm on whom any document may be served with the same effect as if it had been served on the responsible authority itself;

**(e)** the quality, reputation or other characteristic of the wine or spirit or the agricultural product or food that, in the Minister's opinion, qualifies that indication as a geographical indication;

**(f)** that, except in the case of an indication identifying a wine or spirit or an agricultural product or food as originating in Canada, the indication is protected by the law applicable to the territory in which the wine or spirit or the agricultural product or food is identified as originating, as well as particulars of the protection.

#### **Information — translation**

**(3.1)** For the purposes of subsection (2.1), the statement by the Minister must set out all of the following information:

**(a)** that the Minister proposes that the translation be entered on the list;

- (b) the indication on the list that corresponds to the translation;
- (c) the common name of the agricultural product or food that the indication identifies and the category set out in the schedule to which it belongs;
- (d) the name of the responsible authority in relation to the agricultural product or food and the address of the responsible authority's principal office or place of business in Canada or, if the responsible authority has no office or place of business in Canada, the name and address in Canada of a person or firm on whom any document may be served with the same effect as if it had been served on the responsible authority itself.

#### **Removal from list**

(4) The Registrar shall remove an indication or any translation of an indication from the list

- (a) on the publication of a statement by the Minister on the website of the Canadian Intellectual Property Office specifying that the indication or the translation is to be removed; or
- (b) if the Federal Court makes an order under subsection 11.21(1) for the removal of the indication or the translation.

#### **Obvious error**

(5) The Registrar may, within six months after the day on which an indication or a translation of an indication is entered on the list, correct any error in that entry that is obvious from the documents relating to the indication or the translation in question that are, at the time that the entry is made, on file in the Registrar's office.

#### **Evidence of entry**

(6) A copy of any entry on the list purporting to be certified to be true by the Registrar is evidence of the facts set out in it.

#### **Evidence of statement**

(7) Evidence of a statement by the Minister may be given by the production of a copy of the statement purporting to be certified to be true by the Registrar.

#### **Certified copies**

(8) The Registrar shall, on request and on payment of the prescribed fee, furnish a copy certified by the Registrar of any entry on the list or of any statement by the Minister.

## **Statement of objection**

**11.13 (1)** Within two months after the publication of a statement referred to in subsection 11.12(2) or (2.1), any person interested may, on payment of the prescribed fee, file with the Registrar, and serve on the responsible authority in the prescribed manner, a statement of objection.

### **Grounds — indication**

**(2)** A statement of objection with respect to an indication may be based on any of the following grounds:

**(a)** that, when the statement by the Minister is published, the indication is not a geographical indication;

**(b)** that, when the statement by the Minister is published, the indication is identical to a term customary in common language in Canada as the common name for the wine or spirit or the agricultural product or food;

**(c)** that, except in the case of an indication identifying a wine or spirit or an agricultural product or food as originating in Canada, when the statement by the Minister is published, the indication is not protected by the law applicable to the territory in which the wine or spirit or the agricultural product or food is identified as originating;

**(d)** in the case of an indication identifying an agricultural product or food, that, when the statement by the Minister is published, the indication is confusing with

**(i)** a registered trade-mark,

**(ii)** a trade-mark that was previously used in Canada and that has not been abandoned, or

**(iii)** a trade-mark in respect of which an application for registration was previously filed in Canada and remains pending.

### **Grounds — translation**

**(2.1)** A statement of objection with respect to a translation may be based on any of the following grounds:

**(a)** that, when the statement by the Minister is published, the translation is not a faithful translation of the indication;

**(b)** that, when the statement by the Minister is published, the translation is identical to a term customary in common language in Canada as the common name for the agricultural product or food;

**(c)** that, when the statement by the Minister is published, the translation is confusing with

**(i)** a registered trade-mark,

**(ii)** a trade-mark that was previously used in Canada and that has not been abandoned, or

**(iii)** a trade-mark in respect of which an application for registration was previously filed in Canada and remains pending.

### **Content**

**(3)** A statement of objection shall set out

**(a)** each ground of objection in sufficient detail to enable the responsible authority to reply to it; and

**(b)** the address of the objector's principal office or place of business in Canada, if any, and if the objector has no office or place of business in Canada, the address of the principal office or place of business abroad and the name and address in Canada of a person or firm on whom service of any document in respect of the objection may be made with the same effect as if it had been served on the objector.

### **Frivolous objection**

**(3.1)** At any time before the day on which the responsible authority files a counter statement, the Registrar may, at the responsible authority's request or on his or her own initiative, reject the statement of objection if the Registrar considers that the statement does not raise a substantial issue for decision and shall give notice of his or her decision to the objector and to the responsible authority.

### **Power to strike**

**(3.2)** At any time before the day on which the responsible authority files a counter statement, the Registrar may, at the responsible authority's request, strike all or part of the statement of objection if the statement or part of it

**(a)** is not based on any of the grounds set out in subsection (2) or (2.1); or

**(b)** does not set out a ground of objection in sufficient detail to enable the responsible authority to reply to it.

### **Counter statement**

**(4)** Within two months after a statement of objection has been served on the responsible authority, the responsible authority may file a counter statement with the Registrar and serve a copy on the objector in the prescribed manner, and if



the responsible authority does not so file and serve a counter statement, the indication or the translation shall not be entered on the list kept under subsection 11.12(1). The counter statement need only state that the responsible authority intends to respond to the objection.

### **Evidence and hearing**

**(5)** Both the objector and the responsible authority shall be given an opportunity, in the prescribed manner and within the prescribed time, to submit evidence and to make representations to the Registrar unless

**(a)** the responsible authority does not file and serve a counter statement in accordance with subsection (4) or if, in the prescribed circumstances, the responsible authority does not submit evidence or a statement that the responsible authority does not wish to submit evidence; or

**(b)** the objection is withdrawn or deemed under subsection (6) to have been withdrawn.

### **Service**

**(5.1)** The objector and the responsible authority shall, in the prescribed manner and within the prescribed time, serve on each other any evidence and written representations that they submit to the Registrar.

### **No evidence — objector**

**(6)** The objection is deemed to have been withdrawn if, in the prescribed circumstances, the objector does not submit and serve evidence or a statement that the objector does not wish to submit evidence.

### **No evidence — responsible authority**

**(6.1)** The indication or the translation shall not be entered on the list if, in the prescribed circumstances, the responsible authority does not submit and serve evidence or a statement that the responsible authority does not wish to submit evidence.

### **Decision**

**(7)** After considering the evidence and representations of the objector and the responsible authority, the Registrar shall accept or reject the objection, in whole or in part, and notify the parties of the decision and the reasons for it.

### **Effect of decision on translations**

**(8)** The Registrar shall not enter any translation of an indication on the list if the Registrar accepts the objection with respect to the indication or, if an appeal is taken, the objection is accepted in the final judgment given in the appeal.

1994, c. 47, s. 192; 2017, c. 6, s. 62.

#### **Prohibited adoption of indication for wines**

**11.14 (1)** No person shall adopt in connection with a business, as a trade-mark or otherwise,

**(a)** a protected geographical indication identifying a wine in respect of a wine not originating in the territory indicated by the protected geographical indication; or

**(b)** a translation in any language of the geographical indication in respect of that wine.

#### **Prohibited use**

**(2)** No person shall use in connection with a business, as a trade-mark or otherwise,

**(a)** a protected geographical indication identifying a wine in respect of a wine not originating in the territory indicated by the protected geographical indication or adopted contrary to subsection (1); or

**(b)** a translation in any language of the geographical indication in respect of that wine.

#### **Prohibited use**

**(3)** No person shall use in connection with a business, as a trade-mark or otherwise,

**(a)** a protected geographical indication identifying a wine in respect of a wine that originates in the territory indicated by the protected geographical indication if that wine was not produced or manufactured in accordance with the law applicable to that territory; or

**(b)** a translation in any language of the geographical indication in respect of that wine.

#### **Prohibited adoption of indication for spirits**

**(4)** No person shall adopt in connection with a business, as a trade-mark or otherwise,

(a) a protected geographical indication identifying a spirit in respect of a spirit not originating in the territory indicated by the protected geographical indication; or

(b) a translation in any language of the geographical indication in respect of that spirit.

#### **Prohibited use**

(5) No person shall use in connection with a business, as a trade-mark or otherwise,

(a) a protected geographical indication identifying a spirit in respect of a spirit not originating in the territory indicated by the protected geographical indication or adopted contrary to subsection (4); or

(b) a translation in any language of the geographical indication in respect of that spirit.

#### **Prohibited use**

(6) No person shall use in connection with a business, as a trade-mark or otherwise,

(a) a protected geographical indication identifying a spirit in respect of a spirit that originates in the territory indicated by the protected geographical indication if that spirit was not produced or manufactured in accordance with the law applicable to that territory; or

(b) a translation in any language of the geographical indication in respect of that spirit.

1994, c. 47, s. 192; 2014, c. 32, s. 56(F); 2017, c. 6, s. 63.

#### **Prohibited adoption of indication for agricultural products or food**

**11.15 (1)** No person shall adopt in connection with a business, as a trade-mark or otherwise,

(a) a protected geographical indication identifying an agricultural product or food of a category set out in the schedule in respect of an agricultural product or food belonging to the same category that does not originate in the territory indicated by the protected geographical indication; or

(b) a translation on the list kept under subsection 11.12(1) of the protected geographical indication in respect of that agricultural product or food.

#### **Prohibited use**

(2) No person shall use in connection with a business, as a trade-mark or

otherwise,

**(a)** a protected geographical indication identifying an agricultural product or food of a category set out in the schedule in respect of an agricultural product or food belonging to the same category that does not originate in the territory indicated by the protected geographical indication or adopted contrary to subsection (1); or

**(b)** a translation on the list kept under subsection 11.12(1) of the protected geographical indication in respect of that agricultural product or food.

### **Prohibited use**

**(3)** No person shall use in connection with a business, as a trade-mark or otherwise,

**(a)** a protected geographical indication identifying an agricultural product or food of a category set out in the schedule in respect of an agricultural product or food belonging to the same category that originates in the territory indicated by the protected geographical indication if that agricultural product or food was not produced or manufactured in accordance with the law applicable to that territory; or

**(b)** a translation on the list kept under subsection 11.12(1) of the protected geographical indication in respect of that agricultural product or food.

1994, c. 47, s. 192; 2014, c. 32, s. 56(F); 2017, c. 6, s. 64.

### **Exception when authorized**

**11.16 (1)** Sections 11.14 and 11.15 and paragraphs 12(1)(g) to (h.1) do not prevent the adoption, use or registration as a trade-mark or otherwise, in connection with a business, of a protected geographical indication, or any translation of it in any language, with the consent of the responsible authority.

### **Exception for personal names**

**(2)** Sections 11.14 and 11.15 do not prevent a person from using, in the course of trade, the person's name or the name of the person's predecessor in title, except where the name is used in such a manner as to mislead the public.

### **Exception for comparative advertising**

**(3)** Sections 11.14 and 11.15 do not prevent a person from using a protected geographical indication, or any translation of it in any language, in comparative advertising.

### **Exception not applicable to labels or packaging**

**(4)** Subsection (3) does not apply to comparative advertising on labels or packaging.

1994, c. 47, s. 192; 2014, c. 32, s. 56(F); 2017, c. 6, s. 64.

#### **Continued use — wines or spirits**

**11.17 (1)** Section 11.14 does not apply to the continued and similar use of a protected geographical indication identifying a wine or spirit, or any translation of it in any language, by a Canadian who has used it in a continuous manner in relation to any business or commercial activity in respect of goods or services

(a) in good faith before April 15, 1994; or

(b) for at least 10 years before that date.

#### **Definition of *Canadian***

**(2)** For the purposes of subsection (1), ***Canadian*** means

(a) a Canadian citizen;

(b) a *permanent resident* as defined in subsection 2(1) of the *Immigration and Refugee Protection Act* who has been ordinarily resident in Canada for not more than one year after the day on which they first became eligible to apply for Canadian citizenship; and

(c) an entity that carries on business in Canada.

#### **Use — certain cheeses**

**(3)** Section 11.15 does not apply to the use, in connection with a business, of any of the indications “Asiago”, “Feta”, “Φέτα” (Feta), “Fontina”, “Gorgonzola” or “Munster”, or any translation of them in any language, by a person if they or their predecessor in title used the indication or the translation in relation to any business or commercial activity in respect of an agricultural product or food of the category of cheeses, as set out in the schedule, before October 18, 2013.

#### **Use with qualifying term**

**(4)** Section 11.15 does not apply to the use, in connection with a business, of any of the indications “Asiago”, “Feta”, “Φέτα” (Feta), “Fontina”, “Gorgonzola” or “Munster”, or any translation of them in any language, in respect of an agricultural product or food of the category of cheeses, as set out in the schedule, if

(a) a qualifying term such as “kind”, “type”, “style” or “imitation” is used in connection with the indication or the translation; and

**(b)** the geographical origin of the cheese is clearly displayed on the cheese or on the packaging in which it is distributed, or is in any other manner associated with the cheese so that notice of the cheese's origin is given to the person to whom the cheese is transferred.

#### **Use of the indication “Beaufort”**

**(5)** Section 11.15 does not apply to the use, in connection with a business, of the indication “Beaufort”, or any translation of it in any language, by a person if

**(a)** the person or their predecessor in title used the indication or the translation for at least 10 years before October 18, 2013 in relation to any business or commercial activity in respect of an agricultural product or food of the category of cheeses, as set out in the schedule; or

**(b)** the person uses the indication or the translation in relation to any business or commercial activity in respect of a cheese product that was produced in the proximity of the Beaufort Range on Vancouver Island in British Columbia.

#### **Use of the indication “Nürnberger Bratwürste”**

**(6)** Section 11.15 does not apply to the use, in connection with a business, of the indication “Nürnberger Bratwürste”, or any translation of it in any language, by a person, if they or their predecessor in title used the indication or the translation in relation to any business or commercial activity in respect of an agricultural product or food of the category of fresh, frozen and processed meats, as set out in the schedule, for at least five years before October 18, 2013.

#### **Use of the indication “Jambon de Bayonne”**

**(7)** Section 11.15 does not apply to the use, in connection with a business, of the indication “Jambon de Bayonne”, or any translation of it in any language, by a person, if they or their predecessor in title used the indication or the translation in relation to any business or commercial activity in respect of an agricultural product or food of the category of dry-cured meats, as set out in the schedule, for at least 10 years before October 18, 2013.

#### **Restriction**

**(8)** For the purposes of subsections (3) and (5) to (7), no person is a predecessor in title if they only transferred the right to use the indication or the translation, or both.

1994, c. 47, s. 192; 2001, c. 27, s. 271; 2014, c. 32, ss. 53(F), 56(F); 2017, c. 6, s. 64.

#### **Exception for disuse**

**11.18 (1)** Sections 11.14 and 11.15 and paragraphs 12(1)(g) to (h.1) do not prevent the adoption, use or registration as a trade-mark or otherwise, in connection with a business, of a protected geographical indication, or any translation of it in any language, if the indication has ceased to be protected by the law applicable to the territory in which the wine or spirit or the agricultural product or food is identified as originating, or has fallen into disuse in that territory.

**Exceptions for customary names**

**(2)** Sections 11.14 and 11.15 and paragraphs 12(1)(g) to (h.1) do not prevent the adoption, use or registration as a trade-mark or otherwise, in connection with a business, of a protected geographical indication that is identical to

**(a)** a term customary in common language in Canada as the common name for the wine or spirit or the agricultural product or food;

**(b)** a customary name of a grape variety existing in Canada on or before the day on which the WTO Agreement comes into force; or

**(c)** a customary name of a plant variety or an animal breed existing in Canada on or before the day on which the indication is entered on the list kept under subsection 11.12(1).

**Exception for translation — customary term**

**(2.1)** Sections 11.14 and 11.15 and paragraphs 12(1)(g) to (h.1) do not prevent the adoption, use or registration as a trade-mark or otherwise, in connection with a business, of a translation of a protected geographical indication that is identical to a term customary in common language in Canada as the common name for a wine or spirit or an agricultural product or food.

**Exception for common names for wines**

**(3)** Subsections 11.14(1) to (3) and paragraph 12(1)(g) do not prevent the adoption, use or registration as a trade-mark or otherwise, in connection with a business, of the following indications in respect of wines:

**Exception for common names for spirits**

**(4)** Subsections 11.14(4) to (6) and paragraph 12(1)(h) do not prevent the adoption, use or registration as a trade-mark or otherwise, in connection with a business, of the following indications in respect of spirits:

**(a)** [Repealed, SOR/2004-85]

**(b)** Marc;

(c) [Repealed, SOR/2004-85]

(d) Sambuca;

(e) Geneva Gin;

(f) Genièvre;

(g) Hollands Gin;

(h) London Gin;

(i) Schnapps;

(j) Malt Whiskey;

(k) Eau-de-vie;

(l) Bitters;

(m) Anisette;

(n) Curacao; and

(o) Curaçao.

**Exception for common names for agricultural products or food**

(4.1) Section 11.15 and paragraph 12(1)(h.1) do not prevent the adoption, use or registration as a trade-mark or otherwise, in connection with a business, of the following indications in respect of an agricultural product or food:

(a) Valencia Orange;

(b) Orange Valencia;

(c) Valencia;

(d) Black Forest Ham;

(e) Jambon Forêt Noire;

(f) Tiroler Bacon;

(g) Bacon Tiroler;

(h) Parmesan;

(i) St. George Cheese;

(j) Fromage St-George; and

(k) Fromage St-Georges.

**Spelling variations**



**(4.2)** For purposes of subsection (4.1), the indications set out in paragraphs (f) and (g) include spelling variations of those indications in English and French.

**Exception — “county”**

**(4.3)** Section 11.15 and paragraph 12(1)(h.1) do not prevent the adoption, use or registration as a trade-mark or otherwise, in connection with a business, of the term “county”, or any translation of it in any language, in association with an agricultural product or food if that term is used to refer to the name of a territorial division or an administrative division of a territory.

**Powers of Governor in Council**

**(5)** The Governor in Council may, by order, amend any of subsections (3) to (4.1) by adding or deleting an indication in respect of a wine or spirit or an agricultural product or food, as the case may be.

1994, c. 47, s. 192; SOR/2004-85; 2014, c. 32, s. 56(F); 2017, c. 6, s. 65.

**Exception for failure to take proceedings**

**11.19 (1)** Sections 11.14 and 11.15 do not apply to the adoption or use of a trade-mark by a person if no proceedings are taken to enforce those sections in respect of that person’s use or adoption of the trade-mark within five years after use of the trade-mark by that person or that person’s predecessor-in-title has become generally known in Canada or the trade-mark has been registered by that person in Canada, unless it is established that that person or that person’s predecessor-in-title first used or adopted the trade-mark with knowledge that such use or adoption was contrary to section 11.14 or 11.15, as the case may be.

**Proceedings after five years**

**(2)** In proceedings respecting a registered trade-mark commenced after the expiry of five years from the earlier of the date of registration of the trade-mark in Canada and the date on which use of the trade-mark by the person who filed the application for registration of the trade-mark or that person’s predecessor in title has become generally known in Canada, the registration must not be expunged or amended or held invalid on the basis of any of paragraphs 12(1)(g) to (h.1) unless it is established that the person who filed the application for registration of the trade-mark did so with knowledge that the trade-mark was in whole or in part a protected geographical indication.

1994, c. 47, s. 192; 2014, c. 32, s. 14(F); 2017, c. 6, s. 66.

**Acquired rights — wines**

**11.2 (1)** Section 11.14 and paragraph 12(1)(g) do not prevent the adoption, use or registration as a trade-mark in association with a wine of a protected geographical indication, or any translation of it in any language, by a person if they have, in good faith, before the later of January 1, 1996 and the day on which protection of the indication in the territory indicated by the indication begins,

(a) filed an application in accordance with section 30 for, or secured the registration of, the trade-mark in association with a wine; or

(b) acquired rights through use to the trade-mark in respect of a wine.

#### **Acquired rights — spirits**

**(2)** Section 11.14 and paragraph 12(1)(h) do not prevent the adoption, use or registration as a trade-mark in association with a spirit of a protected geographical indication, or any translation of it in any language, by a person if they have, in good faith, before the later of January 1, 1996 and the day on which protection of the indication in the territory indicated by the indication begins,

(a) filed an application in accordance with section 30 for, or secured the registration of, the trade-mark in association with a spirit; or

(b) acquired rights through use to the trade-mark in respect of a spirit.

#### **Acquired rights — agricultural products and food**

**(3)** Section 11.15 and paragraph 12(1)(h.1) do not prevent the adoption, use or registration as a trade-mark in association with an agricultural product or food of a category set out in the schedule of a protected geographical indication, or any translation of it in any language, by a person if they have, in good faith, before the day on which a statement by the Minister is published under subsection 11.12(2) or (2.1) in respect of the indication or translation,

(a) filed an application in accordance with section 30 for, or secured the registration of, the trade-mark in association with an agricultural product or food belonging to the same category; or

(b) acquired rights through use to the trade-mark in respect of an agricultural product or food belonging to the same category.

1994, c. 47, s. 192; 2014, c. 32, s. 56(F); 2017, c. 6, s. 67.

#### **Removal from the list**

**11.21 (1)** On the application of any person interested, the Federal Court has exclusive jurisdiction to order the Registrar to remove an indication or a translation from the list of geographical indications kept under subsection 11.12(1) on any of the grounds set out in subsection (2) or (3), as the case may be.

## **Grounds — indication**

**(2)** The grounds for the removal of an indication are

- (a)** that, on the day on which the application is made, the indication is not a geographical indication;
- (b)** that, on the day on which the application is made, the indication is identical to a term customary in common language in Canada as the common name for the wine or spirit or the agricultural product or food;
- (c)** that, except in the case of an indication identifying a wine or spirit or an agricultural product or food as originating in Canada, when the statement by the Minister in respect of the indication is published or on the day on which the application is made, the indication is not protected by the law applicable to the territory in which the wine or spirit or the agricultural product or food is identified as originating;
- (d)** in the case of an indication identifying an agricultural product or food, that, when the statement by the Minister is published, the indication is confusing with
  - (i)** a registered trade-mark, or
  - (ii)** a trade-mark that was previously used in Canada and that has not been abandoned; or
- (e)** in the case of an indication identifying an agricultural product or food, that
  - (i)** when the statement by the Minister is published, the indication is confusing with a trade-mark in respect of which an application for registration was previously filed in Canada, and
  - (ii)** on the day on which the application is made, that application for registration remains pending or the trade-mark is registered.

## **Grounds — translation**

**(3)** The grounds for the removal of a translation are

- (a)** that, on the day on which the application is made, the translation is identical to a term customary in common language in Canada as the common name for the agricultural product or food;
- (b)** that, when the statement by the Minister in respect of the translation is published, the translation is confusing with
  - (i)** a registered trade-mark, or
  - (ii)** a trade-mark that was previously used in Canada and that has not been

abandoned;

(c) that

(i) when the statement by the Minister in respect of the translation is published, the translation is confusing with a trade-mark in respect of which an application for registration was previously filed in Canada, and

(ii) on the day on which the application is made, that application for registration remains pending or the trade-mark is registered; or

(d) that, when the statement by the Minister in respect of the translation is published, the translation is not a faithful translation of the indication.

#### **How application is made**

(4) An application shall be made by the filing of an originating notice of motion, by counter-claim in an action for an act contrary to section 11.14 or 11.15, or by statement of claim in an action claiming additional relief under this Act.

#### **Summary proceedings**

(5) The proceedings on an application shall be heard and determined summarily on evidence adduced by affidavit unless the Federal Court directs otherwise.

#### **Effect of order on translation**

(6) If the Federal Court orders the removal of an indication identifying an agricultural product or food from the list, the Registrar shall remove any translation of that indication from the list.

2017, c. 6, s. 67.

#### **CETA indications**

**11.22** Paragraph 11.18(2)(a) and section 11.21 do not apply with respect to a protected geographical indication that is listed in Part A of Annex 20-A, as amended from time to time, of Chapter Twenty of the Comprehensive Economic and Trade Agreement between Canada and the European Union and its Member States, done at Brussels on October 30, 2016.

2017, c. 6, s. 67.

#### **Canada — Korea indications**

**11.23** Paragraphs 11.18(2)(a) and (c) and section 11.21 do not apply with respect to an indication that is a protected geographical indication and that is included in the following list:

(a) GoryeoHongsam;

- (b) GoryeoBaeksam;
- (c) GoryeoSusam;
- (d) IcheonSsal;
- (e) ginseng rouge de Corée;
- (f) ginseng blanc de Corée;
- (g) ginseng frais de Corée;
- (h) riz Icheon;
- (i) Korean Red Ginseng;
- (j) Korean White Ginseng;
- (k) Korean Fresh Ginseng;
- (l) Icheon Rice.

2017, c. 6, s. 67.

#### **Powers of Governor in Council**

**11.24** The Governor in Council may, by order, amend the schedule by adding or deleting a category of agricultural product or food.

2017, c. 6, s. 67.

## **Registrable Trade-marks**

#### **When trade-mark registrable**

**12 (1)** Subject to section 13, a trade-mark is registrable if it is not

- (a) a word that is primarily merely the name or the surname of an individual who is living or has died within the preceding thirty years;
- (b) whether depicted, written or sounded, either clearly descriptive or deceptively misdescriptive in the English or French language of the character or quality of the goods or services in association with which it is used or proposed to be used or of the conditions of or the persons employed in their production or of their place of origin;
- (c) the name in any language of any of the goods or services in connection with which it is used or proposed to be used;
- (d) confusing with a registered trade-mark;
- (e) a mark of which the adoption is prohibited by section 9 or 10;

- (f) a denomination the adoption of which is prohibited by section 10.1;
- (g) in whole or in part a protected geographical indication identifying a wine, where the trade-mark is to be registered in association with a wine not originating in a territory indicated by the geographical indication;
- (h) in whole or in part a protected geographical indication identifying a spirit, where the trade-mark is to be registered in association with a spirit not originating in a territory indicated by the geographical indication;
- (h.1) in whole or in part a protected geographical indication, and the trade-mark is to be registered in association with an agricultural product or food — belonging to the same category, as set out in the schedule, as the agricultural product or food identified by the protected geographical indication — not originating in a territory indicated by the geographical indication; and
- (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.

#### **Idem**

(2) A trade-mark that is not registrable by reason of paragraph (1)(a) or (b) is registrable if it has been so used in Canada by the applicant or his predecessor in title as to have become distinctive at the date of filing an application for its registration.

R.S., 1985, c. T-13, s. 12; 1990, c. 20, s. 81; 1993, c. 15, s. 59(F); 1994, c. 47, s. 193; 2007, c. 25, s. 14; 2014, c. 32, ss. 15(F), 53; 2017, c. 6, s. 68.

#### **When distinguishing guises registrable**

**13 (1)** A distinguishing guise is registrable only if

- (a) it has been so used in Canada by the applicant or his predecessor in title as to have become distinctive at the date of filing an application for its registration; and
- (b) the exclusive use by the applicant of the distinguishing guise in association with the goods or services with which it has been used is not likely unreasonably to limit the development of any art or industry.

#### **Effect of registration**

(2) No registration of a distinguishing guise interferes with the use of any utilitarian feature embodied in the distinguishing guise.

#### **Not to limit art or industry**

**(3)** The registration of a distinguishing guise may be expunged by the Federal Court on the application of any interested person if the Court decides that the registration has become likely unreasonably to limit the development of any art or industry.

R.S., 1985, c. T-13, s. 13; 2014, c. 32, s. 53.

#### **Registration of marks registered abroad**

**14 (1)** Notwithstanding section 12, a trade-mark that the applicant or the applicant's predecessor in title has caused to be duly registered in or for the country of origin of the applicant is registrable if, in Canada,

- (a)** it is not confusing with a registered trade-mark;
- (b)** it is not without distinctive character, having regard to all the circumstances of the case including the length of time during which it has been used in any country;
- (c)** it is not contrary to morality or public order or of such a nature as to deceive the public; or
- (d)** it is not a trade-mark of which the adoption is prohibited by section 9 or 10.

#### **Trade-marks regarded as registered abroad**

**(2)** A trade-mark that differs from the trade-mark registered in the country of origin only by elements that do not alter its distinctive character or affect its identity in the form under which it is registered in the country of origin shall be regarded for the purpose of subsection (1) as the trade-mark so registered.

R.S., 1985, c. T-13, s. 14; 1994, c. 47, s. 194.

#### **Registration of confusing marks**

**15 (1)** Notwithstanding section 12 or 14, confusing trade-marks are registrable if the applicant is the owner of all such trade-marks, which shall be known as associated trade-marks.

#### **Record**

**(2)** On the registration of any trade-mark associated with any other registered trade-mark, a note of the registration of each trade-mark shall be made on the record of registration of the other trade-mark.

#### **Amendment**

**(3)** No amendment of the register recording any change in the ownership or in the name or address of the owner of any one of a group of associated trade-marks shall be made unless the Registrar is satisfied that the same change has occurred with respect to all the trade-marks in the group, and corresponding entries are made contemporaneously with respect to all those trade-marks.

R.S., c. T-10, s. 15.

## **Persons Entitled to Registration of Trade-marks**

### **Registration of marks used or made known in Canada**

**16 (1)** Any applicant who has filed an application in accordance with section 30 for registration of a trade-mark that is registrable and that he or his predecessor in title has used in Canada or made known in Canada in association with goods or services is entitled, subject to section 38, to secure its registration in respect of those goods or services, unless at the date on which he or his predecessor in title first so used it or made it known it was confusing with

- (a)** a trade-mark that had been previously used in Canada or made known in Canada by any other person;
- (b)** a trade-mark in respect of which an application for registration had been previously filed in Canada by any other person; or
- (c)** a trade-name that had been previously used in Canada by any other person.

### **Marks registered and used abroad**

**(2)** Any applicant who has filed an application in accordance with section 30 for registration of a trade-mark that is registrable and that the applicant or the applicant's predecessor in title has duly registered in or for the country of origin of the applicant and has used in association with goods or services is entitled, subject to section 38, to secure its registration in respect of the goods or services in association with which it is registered in that country and has been used, unless at the date of filing of the application in accordance with section 30 it was confusing with

- (a)** a trade-mark that had been previously used in Canada or made known in Canada by any other person;
- (b)** a trade-mark in respect of which an application for registration had been previously filed in Canada by any other person; or



(c) a trade-name that had been previously used in Canada by any other person.

### **Proposed marks**

(3) Any applicant who has filed an application in accordance with section 30 for registration of a proposed trade-mark that is registrable is entitled, subject to sections 38 and 40, to secure its registration in respect of the goods or services specified in the application, unless at the date of filing of the application it was confusing with

(a) a trade-mark that had been previously used in Canada or made known in Canada by any other person;

(b) a trade-mark in respect of which an application for registration had been previously filed in Canada by any other person; or

(c) a trade-name that had been previously used in Canada by any other person.

### **Where application for confusing mark pending**

(4) The right of an applicant to secure registration of a registrable trade-mark is not affected by the previous filing of an application for registration of a confusing trade-mark by another person, unless the application for registration of the confusing trade-mark was pending at the date of advertisement of the applicant's application in accordance with section 37.

### **Previous use or making known**

(5) The right of an applicant to secure registration of a registrable trade-mark is not affected by the previous use or making known of a confusing trade-mark or trade-name by another person, if the confusing trade-mark or trade-name was abandoned at the date of advertisement of the applicant's application in accordance with section 37.

R.S., 1985, c. T-13, s. 16; 1994, c. 47, s. 195; 2014, c. 32, s. 53.

## **Validity and Effect of Registration**

### **Effect of registration in relation to previous use, etc.**

**17 (1)** No application for registration of a trade-mark that has been advertised in accordance with section 37 shall be refused and no registration of a trade-mark shall be expunged or amended or held invalid on the ground of any previous use or making known of a confusing trade-mark or trade-name by a person other than the applicant for that registration or his predecessor in title, except at the instance

of that other person or his successor in title, and the burden lies on that other person or his successor to establish that he had not abandoned the confusing trade-mark or trade-name at the date of advertisement of the applicant's application.

#### **When registration incontestable**

**(2)** In proceedings commenced after the expiration of five years from the date of registration of a trade-mark or from July 1, 1954, whichever is the later, no registration shall be expunged or amended or held invalid on the ground of the previous use or making known referred to in subsection (1), unless it is established that the person who adopted the registered trade-mark in Canada did so with knowledge of that previous use or making known.

R.S., 1985, c. T-13, s. 17; 2014, c. 32, s. 56(F).

#### **When registration invalid**

**18 (1)** The registration of a trade-mark is invalid if

- (a)** the trade-mark was not registrable at the date of registration;
- (b)** the trade-mark is not distinctive at the time proceedings bringing the validity of the registration into question are commenced;
- (c)** the trade-mark has been abandoned;
- (d)** subject to section 17, the applicant for registration was not the person entitled to secure the registration; or
- (e)** the application for registration was filed in bad faith.

#### **Exception**

**(2)** No registration of a trade-mark that had been so used in Canada by the registrant or his predecessor in title as to have become distinctive at the date of registration shall be held invalid merely on the ground that evidence of the distinctiveness was not submitted to the competent authority or tribunal before the grant of the registration.

R.S., 1985, c. T-13, s. 18; 2014, c. 32, s. 19; 2018, c. 27, s. 218.

#### **Rights conferred by registration**

**19** Subject to sections 21, 32 and 67, the registration of a trade-mark in respect of any goods or services, unless shown to be invalid, gives to the owner of the trade-mark the exclusive right to the use throughout Canada of the trade-mark in respect of those goods or services.

R.S., 1985, c. T-13, s. 19; 1993, c. 15, s. 60; 2014, c. 32, s. 53.

## **Infringement**

**20 (1)** The right of the owner of a registered trade-mark to its exclusive use is deemed to be infringed by any person who is not entitled to its use under this Act and who

(a) sells, distributes or advertises any goods or services in association with a confusing trade-mark or trade-name;

(b) manufactures, causes to be manufactured, possesses, imports, exports or attempts to export any goods in association with a confusing trade-mark or trade-name, for the purpose of their sale or distribution;

(c) sells, offers for sale or distributes any label or packaging, in any form, bearing a trade-mark or trade-name, if

(i) the person knows or ought to know that the label or packaging is intended to be associated with goods or services that are not those of the owner of the registered trade-mark, and

(ii) the sale, distribution or advertisement of the goods or services in association with the label or packaging would be a sale, distribution or advertisement in association with a confusing trade-mark or trade-name; or

(d) manufactures, causes to be manufactured, possesses, imports, exports or attempts to export any label or packaging, in any form, bearing a trade-mark or trade-name, for the purpose of its sale or distribution or for the purpose of the sale, distribution or advertisement of goods or services in association with it, if

(i) the person knows or ought to know that the label or packaging is intended to be associated with goods or services that are not those of the owner of the registered trade-mark, and

(ii) the sale, distribution or advertisement of the goods or services in association with the label or packaging would be a sale, distribution or advertisement in association with a confusing trade-mark or trade-name.

### **Exception — *bona fide* use**

**(1.1)** The registration of a trade-mark does not prevent a person from making, in a manner that is not likely to have the effect of depreciating the value of the goodwill attaching to the trade-mark,

(a) any *bona fide* use of his or her personal name as a trade-name; or

(b) any *bona fide* use, other than as a trade-mark, of the geographical name of his or her place of business or of any accurate description of the character or quality of his or her goods or services.

### **Exception — utilitarian feature**

**(1.2)** The registration of a trade-mark does not prevent a person from using any utilitarian feature embodied in the trade-mark.

### **Exception**

**(2)** The registration of a trade-mark does not prevent a person from making any use of any of the indications mentioned in subsection 11.18(3) in association with a wine, any of the indications mentioned in subsection 11.18(4) in association with a spirit or any of the indications mentioned in subsection 11.18(4.1) in association with an agricultural product or food.

R.S., 1985, c. T-13, s. 20; 1994, c. 47, s. 196; 2014, c. 32, ss. 22, 56(F); 2017, c. 6, s. 69.

### **Concurrent use of confusing marks**

**21 (1)** Where, in any proceedings respecting a registered trade-mark the registration of which is entitled to the protection of subsection 17(2), it is made to appear to the Federal Court that one of the parties to the proceedings, other than the registered owner of the trade-mark, had in good faith used a confusing trade-mark or trade-name in Canada before the date of filing of the application for that registration, and the Court considers that it is not contrary to the public interest that the continued use of the confusing trade-mark or trade-name should be permitted in a defined territorial area concurrently with the use of the registered trade-mark, the Court may, subject to such terms as it deems just, order that the other party may continue to use the confusing trade-mark or trade-name within that area with an adequate specified distinction from the registered trade-mark.

### **Registration of order**

**(2)** The rights conferred by an order made under subsection (1) take effect only if, within three months from its date, the other party makes application to the Registrar to enter it on the register in connection with the registration of the registered trade-mark.

R.S., c. T-10, s. 21; R.S., c. 10(2nd Supp.), s. 64.

### **Depreciation of goodwill**

**22 (1)** No person shall use a trade-mark registered by another person in a manner that is likely to have the effect of depreciating the value of the goodwill attaching thereto.

### **Action in respect thereof**

**(2)** In any action in respect of a use of a trade-mark contrary to subsection (1), the court may decline to order the recovery of damages or profits and may permit the defendant to continue to sell goods marked with the trade-mark that were in his possession or under his control at the time notice was given to him that the owner of the registered trade-mark complained of the use of the trade-mark.

R.S., 1985, c. T-13, s. 22; 2014, c. 32, s. 53.

## **Certification Marks**

### **Registration of certification marks**

**23 (1)** A certification mark may be adopted and 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.

### **Licence**

**(2)** The owner of a certification mark may license others to use the mark in association with goods or services that meet the defined standard, and the use of the mark accordingly shall be deemed to be use thereof by the owner.

### **Unauthorized use**

**(3)** The owner of a registered certification mark may prevent its use by unlicensed persons or in association with any goods or services in respect of which the mark is registered but to which the licence does not extend.

### **Action by unincorporated body**

**(4)** Where the owner of a registered certification mark is an unincorporated body, any action or proceeding to prevent unauthorized use of the mark may be brought by any member of that body on behalf of himself and all other members thereof.

R.S., 1985, c. T-13, s. 23; 2014, c. 32, s. 53.

### **Registration of trade-mark confusing with certification mark**

**24** With the consent of the owner of a certification mark, a trade-mark confusing with the certification mark may, if it exhibits an appropriate difference, be registered by some other person to indicate that the goods or services in association with which it is used have been manufactured, sold, leased, hired or performed by him as one of the persons entitled to use the certification mark, but the registration thereof shall be expunged by the Registrar on the withdrawal at any time of the consent of the owner of the certification mark or on the cancellation of the registration of the certification mark.

R.S., 1985, c. T-13, s. 24; 2014, c. 32, ss. 25(F), 53(E).

### **Descriptive certification mark**

**25** A certification mark that is descriptive of the place of origin of goods or services, and not confusing with any registered trade-mark, is registrable if the applicant is the administrative authority of a country, state, province or municipality that includes or forms part of the area indicated by the certification mark, or is a commercial association that has an office or representative in that area, but the owner of any certification mark registered under this section shall permit its use in association with any goods or services produced or performed in the area of which it is descriptive.

R.S., 1985, c. T-13, s. 25; 2014, c. 32, s. 26.

## **Register of Trade-marks**

### **Register**

**26 (1)** There shall be kept under the supervision of the Registrar a register of trade-marks and of transfers, disclaimers, amendments, judgments and orders relating to each registered trade-mark.

### **Information to be shown**

**(2)** The register shall show, with reference to each registered trade-mark, the following:

- (a)** the date of registration;
- (b)** a summary of the application for registration;
- (c)** a summary of all documents deposited with the application or subsequently thereto and affecting the rights to the trade-mark;
- (d)** particulars of each renewal;
- (e)** particulars of each change of name and address; and
- (f)** such other particulars as this Act or the regulations require to be entered thereon.

R.S., 1985, c. T-13, s. 26; 1993, c. 15, s. 61; 2014, c. 32, s. 27.

### **Register under *Unfair Competition Act***

**27 (1)** The register kept under the *Unfair Competition Act*, chapter 274 of the Revised Statutes of Canada, 1952, forms part of the register kept under this Act and, subject to subsection 44(2), no entry made therein, if properly made

according to the law in force at the time it was made, is subject to be expunged or amended only because it might not properly have been made pursuant to this Act.

#### **Trade-marks registered before *Unfair Competition Act***

**(2)** Trade-marks on the register on September 1, 1932 shall be treated as design marks or word marks as defined in the *Unfair Competition Act*, chapter 274 of the Revised Statutes of Canada, 1952, according to the following rules:

**(a)** any trade-mark consisting only of words or numerals or both without any indication of a special form or appearance shall be deemed to be a word mark;

**(b)** any other trade-mark consisting only of words or numerals or both shall be deemed to be a word mark if at the date of its registration the words or numerals or both would have been registrable independently of any defined special form or appearance and shall also be deemed to be a design mark for reading matter presenting the special form or appearance defined;

**(c)** any trade-mark including words or numerals or both in combination with other features shall be deemed

**(i)** to be a design mark having the features described in the application therefor but without any meaning being attributed to the words or numerals, and

**(ii)** to be a word mark if and so far as it would at the date of registration have been registrable independently of any defined form or appearance and without being combined with any other feature; and

**(d)** any other trade-mark shall be deemed to be a design mark having the features described in the application therefor.

#### **Trade-marks registered under *Unfair Competition Act***

**(3)** Trade-marks registered under the *Unfair Competition Act*, chapter 274 of the Revised Statutes of Canada, 1952, shall, in accordance with their registration, continue to be treated as design marks or word marks as defined in that Act.

R.S., c. T-10, s. 26.

#### **List of trade-mark agents**

**28** There shall be kept under the supervision of the Registrar a list of trade-mark agents, which shall include the names of all persons and firms entitled to represent applicants and others in the presentation and prosecution of applications for the registration of a trade-mark or in other business before the Office of the Registrar of Trade-marks.

R.S., 1985, c. T-13, s. 28; 1993, c. 15, s. 62; 2014, c. 32, s. 28.

#### **Available to public**

**29 (1)** The following shall be made available to the public at the times and in the manner established by the Registrar:

- (a) the register;
- (b) all applications for the registration of a trade-mark, including those abandoned;
- (c) the list of trade-mark agents;
- (d) the list of geographical indications kept under subsection 11.12(1);
- (e) all requests made under paragraph 9(1)(n); and
- (f) all documents filed with the Registrar relating to a registered trade-mark, an application for the registration of a trade-mark, a request under paragraph 9(1)(n) and objection proceedings under section 11.13.

#### **Certified copies**

**(2)** The Registrar shall, on request and on payment of the prescribed fee, furnish a copy certified by the Registrar of any entry in the register or lists, or of any of those applications, requests or documents.

R.S., 1985, c. T-13, s. 29; 1993, c. 15, s. 63; 1994, c. 47, s. 197; 2014, c. 32, s. 28.

#### **Destruction of records**

**29.1** Despite subsection 29(1), the Registrar may destroy

- (a) an application for the registration of a trade-mark that is refused and any document relating to the application, at any time after six years after the day on which the application is refused or, if an appeal is taken, on which final judgment in the appeal upholding the refusal is given;
- (b) an application for the registration of a trade-mark that is abandoned and any document relating to the application, at any time after six years after the day on which the application is abandoned;
- (c) a document relating to an expunged registration of a trade-mark, at any time after six years after the day on which the registration is expunged;



**(d)** a request under paragraph 9(1)(n) and any document relating to it, at any time after six years after

**(i)** the day on which the request is abandoned,

**(ii)** the day on which the request is refused or, if an appeal is taken, on which final judgment in the appeal upholding the refusal is given, or

**(iii)** the day on which a court declares that the badge, crest, emblem or mark in question is invalid or, if an appeal is taken, on which final judgment in the appeal upholding the declaration is given;

**(e)** a document relating to objection proceedings under section 11.13 with respect to a geographical indication that is removed from the list of geographical indications under subsection 11.12(4), at any time after six years after the day on which it is removed; and

**(f)** a document relating to objection proceedings under section 11.13 with respect to which a decision is made that the indication is not a geographical indication, at any time after six years after the day on which the decision is made or, if an appeal is taken, on which final judgment in the appeal upholding the decision is given.

2014, c. 32, s. 28.

## **Applications for Registration of Trade-marks**

### **Contents of application**

**30** An applicant for the registration of a trade-mark shall file with the Registrar an application containing

**(a)** a statement in ordinary commercial terms of the specific goods or services in association with which the mark has been or is proposed to be used;

**(b)** in the case of a trade-mark that has been used in Canada, the date from which the applicant or his named predecessors in title, if any, have so used the trade-mark in association with each of the general classes of goods or services described in the application;

**(c)** in the case of a trade-mark that has not been used in Canada but is made known in Canada, the name of a country of the Union in which it has been used by the applicant or his named predecessors in title, if any, and the date from and the manner in which the applicant or named predecessors in title have made it known in Canada in association with each of the general classes of goods or services described in the application;

**(d)** in the case of a trade-mark that is the subject in or for another country of the Union of a registration or an application for registration by the applicant or the applicant's named predecessor in title on which the applicant bases the applicant's right to registration, particulars of the application or registration and, if the trade-mark has neither been used in Canada nor made known in Canada, the name of a country in which the trade-mark has been used by the applicant or the applicant's named predecessor in title, if any, in association with each of the general classes of goods or services described in the application;

**(e)** in the case of a proposed trade-mark, a statement that the applicant, by itself or through a licensee, or by itself and through a licensee, intends to use the trade-mark in Canada;

**(f)** in the case of a certification mark, particulars of the defined standard that the use of the mark is intended to indicate and a statement that the applicant 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;

**(g)** the address of the applicant's principal office or place of business in Canada, if any, and if the applicant has no office or place of business in Canada, the address of his principal office or place of business abroad and the name and address in Canada of a person or firm to whom any notice in respect of the application or registration may be sent, and on whom service of any proceedings in respect of the application or registration may be given or served with the same effect as if they had been given to or served on the applicant or registrant himself;

**(h)** unless the application is for the registration only of a word or words not depicted in a special form, a drawing of the trade-mark and such number of accurate representations of the trade-mark as may be prescribed; and

**(i)** a statement that the applicant is satisfied that he is entitled to use the trade-mark in Canada in association with the goods or services described in the application.

R.S., 1985, c. T-13, s. 30; 1993, c. 15, s. 64; 1994, c. 47, s. 198; 2014, c. 32, s. 53.

### **Applications based on registration abroad**

**31 (1)** An applicant whose right to registration of a trade-mark is based on a registration of the trade-mark in another country of the Union shall, before the date of advertisement of his application in accordance with section 37, furnish a copy of the registration certified by the office in which it was made, together with a

translation thereof into English or French if it is in any other language, and such other evidence as the Registrar may require to establish fully his right to registration under this Act.

#### **Evidence required in certain cases**

**(2)** An applicant whose trade-mark has been duly registered in his country of origin and who claims that the trade-mark is registrable under paragraph 14(1)(b) shall furnish such evidence as the Registrar may require by way of affidavit or statutory declaration establishing the circumstances on which he relies, including the length of time during which the trade-mark has been used in any country.

R.S., c. T-10, s. 30.

#### **Further information in certain cases**

**32 (1)** An applicant who claims that his trade-mark is registrable under subsection 12(2) or section 13 shall furnish the Registrar with evidence by way of affidavit or statutory declaration establishing the extent to which and the time during which the trade-mark has been used in Canada and with any other evidence that the Registrar may require in support of the claim.

#### **Registration to be restricted**

**(2)** The Registrar shall, having regard to the evidence adduced, restrict the registration to the goods or services in association with which the trade-mark is shown to have been so used as to have become distinctive and to the defined territorial area in Canada in which the trade-mark is shown to have become distinctive.

R.S., 1985, c. T-13, s. 32; 2014, c. 32, ss. 53, 56(F).

#### **Applications by trade unions, etc.**

**33** Every trade union or commercial association that applies for the registration of a trade-mark may be required to furnish satisfactory evidence that its existence is not contrary to the laws of the country in which its headquarters are situated.

R.S., c. T-10, s. 32.

#### **Date of application abroad deemed date of application in Canada**

**34 (1)** When an application for the registration of a trade-mark has been made in or for any country of the Union other than Canada and an application is subsequently made in Canada for the registration for use in association with the same kind of goods or services of the same or substantially the same trade-mark by the same applicant or the applicant's successor in title, the date of filing of the application in or for the other country is deemed to be the date of filing of the

application in Canada, and the applicant is entitled to priority in Canada accordingly notwithstanding any intervening use in Canada or making known in Canada or any intervening application or registration if

**(a)** the application in Canada, including or accompanied by a declaration setting out the date on which and the country of the Union in or for which the earliest application was filed for the registration of the same or substantially the same trade-mark for use in association with the same kind of goods or services, is filed within a period of six months after that date, which period shall not be extended;

**(b)** the applicant or, if the applicant is a transferee, the applicant's predecessor in title by whom any earlier application was filed in or for any country of the Union was at the date of the application a citizen or national of or domiciled in that country or had therein a real and effective industrial or commercial establishment; and

**(c)** the applicant furnishes, in accordance with any request under subsections (2) and (3), evidence necessary to establish fully the applicant's right to priority.

#### **Evidence requests**

**(2)** The Registrar may request the evidence before the day on which the application is allowed pursuant to section 39.

#### **How and when evidence must be furnished**

**(3)** The Registrar may specify in the request the manner in which the evidence must be furnished and the period within which it must be furnished.

R.S., 1985, c. T-13, s. 34; 1992, c. 1, s. 133; 1993, c. 15, s. 65; 1994, c. 47, s. 199; 2014, c. 32, s. 53.

#### **Disclaimer**

**35** The Registrar may require an applicant for registration of a trade-mark to disclaim the right to the exclusive use apart from the trade-mark of such portion of the trade-mark as is not independently registrable, but the disclaimer does not prejudice or affect the applicant's rights then existing or thereafter arising in the disclaimed matter, nor does the disclaimer prejudice or affect the applicant's right to registration on a subsequent application if the disclaimed matter has then become distinctive of the applicant's goods or services.

R.S., 1985, c. T-13, s. 35; 2014, c. 32, s. 53.

#### **Abandonment**

**36** Where, in the opinion of the Registrar, an applicant is in default in the prosecution of an application filed under this Act or any Act relating to trade-marks in force prior to July 1, 1954, the Registrar may, after giving notice to the applicant of the default, treat the application as abandoned unless the default is remedied within the time specified in the notice.

R.S., c. T-10, s. 35.

#### **When applications to be refused**

**37 (1)** The Registrar shall refuse an application for the registration of a trade-mark if he is satisfied that

- (a) the application does not conform to the requirements of section 30,
- (b) the trade-mark is not registrable, or
- (c) the applicant is not the person entitled to registration of the trade-mark because it is confusing with another trade-mark for the registration of which an application is pending,

and where the Registrar is not so satisfied, he shall cause the application to be advertised in the manner prescribed.

#### **Notice to applicant**

**(2)** 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.

#### **Doubtful cases**

**(3)** Where the Registrar, by reason of a registered trade-mark, is in doubt whether the trade-mark claimed in the application is registrable, he shall, by registered letter, notify the owner of the registered trade-mark of the advertisement of the application.

R.S., c. T-10, s. 36.

#### **Statement of opposition**

**38 (1)** Within two months after the advertisement of an application for the registration of a trade-mark, any person may, on payment of the prescribed fee, file a statement of opposition with the Registrar.

#### **Grounds**

**(2)** A statement of opposition may be based on any of the following grounds:

- (a) that the application does not conform to the requirements of section 30;

- (b) that the trade-mark is not registrable;
- (c) that the applicant is not the person entitled to registration of the trade-mark; or
- (d) that the trade-mark is not distinctive.

### **Content**

(3) A statement of opposition shall set out

- (a) the grounds of opposition in sufficient detail to enable the applicant to reply thereto; and
- (b) the address of the opponent's principal office or place of business in Canada, if any, and if the opponent has no office or place of business in Canada, the address of his principal office or place of business abroad and the name and address in Canada of a person or firm on whom service of any document in respect of the opposition may be made with the same effect as if it had been served on the opponent himself.

### **Frivolous opposition**

(4) If the Registrar considers that the opposition does not raise a substantial issue for decision, he shall reject it and shall give notice of his decision to the opponent.

### **Substantial issue**

(5) If the Registrar considers that the opposition raises a substantial issue for decision, he shall forward a copy of the statement of opposition to the applicant.

### **Counter statement**

(6) The applicant shall file a counter statement with the Registrar and serve a copy on the opponent in the prescribed manner and within the prescribed time after a copy of the statement of opposition has been served on the applicant.

### **Evidence and hearing**

(7) Both the opponent and the applicant shall be given an opportunity, in the prescribed manner, to submit evidence and to make representations to the Registrar unless

- (a) the opposition is withdrawn or deemed under subsection (7.1) to have been withdrawn; or
- (b) the application is abandoned or deemed under subsection (7.2) to have been abandoned.

### **Withdrawal of opposition**

**(7.1)** The opposition shall be deemed to have been withdrawn if, in the prescribed circumstances, the opponent does not submit either evidence under subsection (7) or a statement that the opponent does not wish to submit evidence.

#### **Abandonment of application**

**(7.2)** The application shall be deemed to have been abandoned if the applicant does not file and serve a counter statement within the time referred to in subsection (6) or if, in the prescribed circumstances, the applicant does not submit either evidence under subsection (7) or a statement that the applicant does not wish to submit evidence.

#### **Decision**

**(8)** After considering the evidence and representations of the opponent and the applicant, the Registrar shall refuse the application or reject the opposition and notify the parties of the decision and the reasons for the decision.

R.S., 1985, c. T-13, s. 38; 1992, c. 1, s. 134; 1993, c. 15, s. 66.

#### **When application to be allowed**

**39 (1)** When an application for the registration of a trade-mark either has not been opposed and the time for the filing of a statement of opposition has expired or it has been opposed and the opposition has been decided in favour of the applicant, the Registrar shall allow the application or, if an appeal is taken, shall act in accordance with the final judgment given in the appeal.

#### **No extension of time**

**(2)** Subject to subsection (3), the Registrar shall not extend the time for filing a statement of opposition with respect to any application that has been allowed.

#### **Exception**

**(3)** Where the Registrar has allowed an application without considering a previously filed request for an extension of time to file a statement of opposition, the Registrar may withdraw the application from allowance at any time before issuing a certificate of registration and, in accordance with section 47, extend the time for filing a statement of opposition.

R.S., 1985, c. T-13, s. 39; 1993, c. 15, s. 67.

## **Registration of Trade-marks**

### **Registration of trade-marks**

**40 (1)** When an application for registration of a trade-mark, other than a proposed trade-mark, is allowed, the Registrar shall register the trade-mark and issue a certificate of its registration.

#### **Proposed trade-mark**

**(2)** When an application for registration of a proposed trade-mark is allowed, the Registrar shall give notice to the applicant accordingly and shall register the trade-mark and issue a certificate of registration on receipt of a declaration that the use of the trade-mark in Canada, in association with the goods or services specified in the application, has been commenced by

**(a)** the applicant;

**(b)** the applicant's successor in title; or

**(c)** an entity that is licensed by or with the authority of the applicant to use the trade-mark, if the applicant has direct or indirect control of the character or quality of the goods or services.

#### **Abandonment of application**

**(3)** An application for registration of a proposed trade-mark shall be deemed to be abandoned if the Registrar has not received the declaration referred to in subsection (2) before the later of

**(a)** six months after the notice by the Registrar referred to in subsection (2), and

**(b)** three years after the date of filing of the application in Canada.

#### **Form and effect**

**(4)** Registration of a trade-mark shall be made in the name of the applicant therefor or his transferee, and the day on which registration is made shall be entered on the register, and the registration takes effect on that day.

#### **Section 34 does not apply**

**(5)** For the purposes of subsection (3), section 34 does not apply in determining when an application for registration is filed.

R.S., 1985, c. T-13, s. 40; 1993, c. 15, s. 68, c. 44, s. 231; 1999, c. 31, s. 210(F); 2014, c. 32, ss. 37(F), 53(E).

## **Amendment of the Register**

### **Amendments to register**



**41 (1)** The Registrar may, on application by the registered owner of a trade-mark made in the prescribed manner, make any of the following amendments to the register:

(a) correct any error or enter any change in the name, address or description of the registered owner or of his representative for service in Canada;

(b) cancel the registration of the trade-mark;

(c) amend the statement of the goods or services in respect of which the trade-mark is registered;

(d) amend the particulars of the defined standard that the use of a certification mark is intended to indicate; or

(e) enter a disclaimer that does not in any way extend the rights given by the existing registration of the trade-mark.

### **Conditions**

**(2)** An application to extend the statement of goods or services in respect of which a trade-mark is registered has the effect of an application for registration of the trade-mark in respect of the goods or services specified in the application for amendment.

R.S., 1985, c. T-13, s. 41; 2014, c. 32, s. 53.

### **Representative for service**

**42 (1)** The registered owner of a trade-mark who has no office or place of business in Canada shall name another representative for service in place of the latest recorded representative or supply a new and correct address of the latest recorded representative on notice from the Registrar that the latest recorded representative has died or that a letter addressed to him at the latest recorded address and sent by ordinary mail has been returned undelivered.

### **Change of address**

**(2)** When, after the dispatch of the notice referred to in subsection (1) by the Registrar, no new nomination is made or no new and correct address is supplied by the registered owner within three months, the Registrar or the Federal Court may dispose of any proceedings under this Act without requiring service on the registered owner of any process therein.

R.S., c. T-10, s. 41; R.S., c. 10(2nd Supp.), s. 64.

### **Additional representations**

**43** The registered owner of any trade-mark shall furnish such additional representations thereof as the Registrar may by notice demand and, if he fails to comply with that notice, the Registrar may by a further notice, fix a reasonable time after which, if the representations are not furnished, he may expunge the registration of the trade-mark.

R.S., c. T-10, s. 42.

#### **Notice for information**

**44 (1)** The Registrar may at any time, and shall at the request of any person who pays the prescribed fee, by notice in writing require the registered owner of any trade-mark that was on the register on July 1, 1954 to furnish him within three months from the date of the notice with the information that would be required on an application for the registration of the trade-mark made at the date of the notice.

#### **Amendments to register**

**(2)** The Registrar may amend the registration of the trade-mark in accordance with the information furnished to him under subsection (1).

#### **Failure to give information**

**(3)** Where the information required by subsection (1) is not furnished, the Registrar shall by a further notice fix a reasonable time after which, if the information is not furnished, he may expunge the registration of the trade-mark.

R.S., c. T-10, s. 43.

#### **Registrar may request evidence of user**

**45 (1)** The Registrar may at any time and, at the written request made after three years from the date of the registration of a trade-mark by any person who pays the prescribed fee shall, unless the Registrar sees good reason to the contrary, give notice to the registered owner of the trade-mark requiring the registered owner to furnish within three months an affidavit or a statutory declaration showing, with respect to each of the goods or services specified in the registration, whether the trade-mark was in use in Canada at any time during the three year period immediately preceding the date of the notice and, if not, the date when it was last so in use and the reason for the absence of such use since that date.

#### **Form of evidence**

**(2)** The Registrar shall not receive any evidence other than the affidavit or statutory declaration, but may hear representations made by or on behalf of the registered owner of the trade-mark or by or on behalf of the person at whose request the notice was given.

### **Effect of non-use**

**(3)** Where, by reason of the evidence furnished to the Registrar or the failure to furnish any evidence, it appears to the Registrar that a trade-mark, either with respect to all of the goods or services specified in the registration or with respect to any of those goods or services, was not used in Canada at any time during the three year period immediately preceding the date of the notice and that the absence of use has not been due to special circumstances that excuse the absence of use, the registration of the trade-mark is liable to be expunged or amended accordingly.

### **Notice to owner**

**(4)** When the Registrar reaches a decision whether or not the registration of a trade-mark ought to be expunged or amended, he shall give notice of his decision with the reasons therefor to the registered owner of the trade-mark and to the person at whose request the notice referred to in subsection (1) was given.

### **Action by Registrar**

**(5)** The Registrar shall act in accordance with his decision if no appeal therefrom is taken within the time limited by this Act or, if an appeal is taken, shall act in accordance with the final judgment given in the appeal.

R.S., 1985, c. T-13, s. 45; 1993, c. 44, s. 232; 1994, c. 47, s. 200; 2014, c. 32, s. 53.

## **Renewal of Registrations**

### **Renewal**

**46 (1)** The registration of a trade-mark that is on the register by virtue of this Act is subject to renewal within a period of fifteen years from the day of the registration or last renewal.

### **Notice to renew**

**(2)** If the registration of a trade-mark has been on the register without renewal for the period specified in subsection (1), the Registrar shall send a notice to the registered owner and to the registered owner's representative for service, if any, stating that if within six months after the date of the notice the prescribed renewal fee is not paid, the registration will be expunged.

### **Failure to renew**

**(3)** If within the period of six months specified in the notice, which period shall not be extended, the prescribed renewal fee is not paid, the Registrar shall expunge the registration.

### **Effective date of renewal**

**(4)** When the prescribed fee for a renewal of any trade-mark registration under this section is paid within the time limited for the payment thereof, the renewal takes effect as of the day next following the expiration of the period specified in subsection (1).

R.S., 1985, c. T-13, s. 46; 1992, c. 1, s. 135.

## **Extensions of Time**

### **Extensions of time**

**47 (1)** If, in any case, the Registrar is satisfied that the circumstances justify an extension of the time fixed by this Act or prescribed by the regulations for the doing of any act, he may, except as in this Act otherwise provided, extend the time after such notice to other persons and on such terms as he may direct.

### **Conditions**

**(2)** An extension applied for after the expiration of the time fixed for the doing of an act or the time extended by the Registrar under subsection (1) shall not be granted unless the prescribed fee is paid and the Registrar is satisfied that the failure to do the act or apply for the extension within that time or the extended time was not reasonably avoidable.

R.S., c. T-10, s. 46.

## **Transfer**

### **Trade-mark transferable**

**48 (1)** A trade-mark, whether registered or unregistered, is transferable, and deemed always to have been transferable, either in connection with or separately from the goodwill of the business and in respect of either all or some of the goods or services in association with which it has been used.

### **Where two or more persons interested**

**(2)** Nothing in subsection (1) prevents a trade-mark from being held not to be distinctive if as a result of a transfer thereof there subsisted rights in two or more persons to the use of confusing trade-marks and the rights were exercised by those persons.

### **Registration of transfer**

**(3)** The Registrar shall register the transfer of any registered trade-mark on being furnished with evidence satisfactory to him of the transfer and the information that would be required by paragraph 30(g) in an application by the transferee to register the trade-mark.

R.S., 1985, c. T-13, s. 48; 2014, c. 32, s. 53.

## **Change of Purpose in Use of Mark**

### **Change of purpose**

**49** If a mark is used by a person as a trade-mark for any of the purposes or in any of the manners mentioned in the definition “certification mark” or “trade-mark” in section 2, it shall not be held invalid merely on the ground that the person or a predecessor in title uses it or has used it for any other of those purposes or in any other of those manners.

R.S., c. T-10, s. 48.

## **Licences**

### **Licence to use trade-mark**

**50 (1)** For the purposes of this Act, if an entity is licensed by or with the authority of the owner of a trade-mark to use the trade-mark in a country and the owner has, under the licence, direct or indirect control of the character or quality of the goods or services, then the use, advertisement or display of the trade-mark in that country as or in a trade-mark, trade-name or otherwise by that entity has, and is deemed always to have had, the same effect as such a use, advertisement or display of the trade-mark in that country by the owner.

### **Idem**

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

### **Owner may be required to take proceedings**

**(3)** Subject to any agreement subsisting between an owner of a trade-mark and a licensee of the trade-mark, the licensee may call on the owner to take proceedings for infringement thereof, and, if the owner refuses or neglects to do

so within two months after being so called on, the licensee may institute proceedings for infringement in the licensee's own name as if the licensee were the owner, making the owner a defendant.

R.S., 1985, c. T-13, s. 50; 1993, c. 15, s. 69; 1999, c. 31, s. 211(F); 2014, c. 32, s. 53.

### **Use of trade-mark by related companies**

**51 (1)** Where a company and the owner of a trade-mark that is used in Canada by that owner in association with a pharmaceutical preparation are related companies, the use by the company of the trade-mark, or a trade-mark confusing therewith, in association with a pharmaceutical preparation that at the time of that use or at any time thereafter,

(a) is acquired by a person directly or indirectly from the company, and

(b) is sold, distributed or advertised for sale in Canada in a package bearing the name of the company and the name of that person as the distributor thereof,

has the same effect, for all purposes of this Act, as a use of the trade-mark or the confusing trade-mark, as the case may be, by that owner.

### **Where difference in composition**

**(2)** Subsection (1) does not apply to any use of a trade-mark or a confusing trade-mark by a company referred to in that subsection in association with a pharmaceutical preparation after such time, if any, as that pharmaceutical preparation is declared by the Minister of Health, by notice published in the *Canada Gazette*, to be sufficiently different in its composition from the pharmaceutical preparation in association with which the trade-mark is used in Canada by the owner referred to in subsection (1) as to be likely to result in a hazard to health.

### **Definition of *pharmaceutical preparation***

**(3)** In this section, ***pharmaceutical preparation*** includes

(a) any substance or mixture of substances manufactured, sold or represented for use in

(i) the diagnosis, treatment, mitigation or prevention of a disease, disorder or abnormal physical state, or the symptoms thereof, in humans or animals, or

(ii) restoring, correcting or modifying organic functions in humans or animals, and

(b) any substance to be used in the preparation or production of any

substance or mixture of substances described in paragraph (a),  
but does not include any such substance or mixture of substances that is the same or substantially the same as a substance or mixture of substances that is a proprietary medicine within the meaning from time to time assigned to that expression by regulations made pursuant to the *Food and Drugs Act*.

R.S., 1985, c. T-13, s. 51; 1996, c. 8, s. 32.

## Offences and Punishment

### Sale, etc., of goods

**51.01 (1)** Every person commits an offence who sells or offers for sale, or distributes on a commercial scale, any goods in association with a trade-mark, if that sale or distribution is or would be contrary to section 19 or 20 and the person knows that

- (a) the trade-mark is identical to, or cannot be distinguished in its essential aspects from, a trade-mark registered for such goods; and
- (b) the owner of that registered trade-mark has not consented to the sale, offering for sale, or distribution of the goods in association with the trade-mark.
- (c) [*Deleted*]

### Manufacture, etc., of goods

**(2)** Every person commits an offence who manufactures, causes to be manufactured, possesses, imports, exports or attempts to export any goods, for the purpose of their sale or of their distribution on a commercial scale, if that sale or distribution would be contrary to section 19 or 20 and the person knows that

- (a) the goods bear a trade-mark that is identical to, or that cannot be distinguished in its essential aspects from, a trade-mark registered for such goods; and
- (b) the owner of that registered trade-mark has not consented to having the goods bear the trade-mark.
- (c) [*Deleted*]

### Services

**(3)** Every person commits an offence who sells or advertises services in association with a trade-mark, if that sale or advertisement is contrary to section 19 or 20 and the person knows that

- (a) the trade-mark is identical to, or cannot be distinguished in its essential

aspects from, a registered trade-mark registered for such services; and

**(b)** the owner of the registered trade-mark has not consented to the sale or advertisement in association with the trade-mark.

**(c)** *[Deleted]*

### **Labels or packaging**

**(4)** Every person commits an offence who manufactures, causes to be manufactured, possesses, imports, exports or attempts to export any label or packaging, in any form, for the purpose of its sale or of its distribution on a commercial scale or for the purpose of the sale, distribution on a commercial scale or advertisement of goods or services in association with it, if that sale, distribution or advertisement would be contrary to section 19 or 20 and the person knows that

**(a)** the label or packaging bears a trade-mark that is identical to, or that cannot be distinguished in its essential aspects from, a registered trade-mark;

**(b)** the label or packaging is intended to be associated with goods or services for which that registered trade-mark is registered; and

**(c)** the owner of that registered trade-mark has not consented to having the label or packaging bear the trade-mark.

**(d)** *[Deleted]*

### **Trafficking in labels or packaging**

**(5)** Every person commits an offence who sells or offers for sale, or distributes on a commercial scale, any label or packaging, in any form, if the sale, distribution or advertisement of goods or services in association with the label or packaging would be contrary to section 19 or 20 and the person knows that

**(a)** the label or packaging bears a trade-mark that is identical to, or that cannot be distinguished in its essential aspects from, a registered trade-mark;

**(b)** the label or packaging is intended to be associated with goods or services for which that registered trade-mark is registered;

**(c)** the owner of that registered trade-mark has not consented to having the label or packaging bear the trademark.

### **Registration of trade-mark**

**(5.1)** In a prosecution for an offence under any of subsections (1) to (5), it is not necessary for the prosecutor to prove that the accused knew that the trade-mark was registered.



## **Punishment**

**(6)** Every person who commits an offence under any of subsections (1) to (5) is liable

**(a)** on conviction on indictment, to a fine of not more than \$1,000,000 or to imprisonment for a term of not more than five years or to both; or

**(b)** on summary conviction, to a fine of not more than \$25,000 or to imprisonment for a term of not more than six months or to both.

## **Limitation Period**

**(7)** Proceedings by way of summary conviction for an offence under this section may be instituted no later than two years after the day on which the subject-matter of the proceedings arose.

## **Disposition order**

**(8)** The court before which any proceedings for an offence under this section are taken may, on a finding of guilt, order that any goods, labels, or packaging in respect of which the offence was committed, any advertising materials relating to those goods and any equipment used to manufacture those goods, labels or packaging be destroyed or otherwise disposed of.

## **Notice**

**(9)** Before making an order for the destruction or other disposition of equipment under subsection (8), the court shall require that notice be given to the owner of the equipment and to any other person who, in the opinion of the court, appears to have a right or interest in the equipment, unless the court is of the opinion that the interests of justice do not require that the notice be given.

2014, c. 32, s. 42.

# **Importation and Exportation**

## **Interpretation**

### **Definitions**

**51.02** The following definitions apply in sections 51.03 to 51.12.

**customs officer** has the meaning assigned by the definition *officer* in subsection 2(1) of the *Customs Act*. (*agent des douanes*)

**Minister** means the Minister of Public Safety and Emergency Preparedness. (*ministre*)

**owner**, with respect to a protected geographical indication identifying a wine or spirit or agricultural product or food, means the responsible authority, as defined in section 11.11, for the wine or spirit or agricultural product or food identified by the indication. (*propriétaire*)

**protected mark** means a registered trade-mark or a protected geographical indication. (*marque protégée*)

**relevant protected mark** means

(a) a trade-mark registered for goods that is identical to, or cannot be distinguished in its essential aspects from, a trade-mark on such goods, including their labels or packaging, that are detained by a customs officer; or

(b) a protected geographical indication identifying, as the case may be, a wine or spirit, or an agricultural product or food of a category set out in the schedule, that is identical to, or cannot be distinguished in its essential aspects from, an indication on such a wine or spirit or such an agricultural product or food, or on their labels or packaging, that is detained by a customs officer. (*marque protégée en cause*)

**working day** means a day other than a Saturday or a holiday. (*jour ouvrable*)

2014, c. 32, s. 43; 2017, c. 6, s. 70.

## Prohibition

### No importation or exportation

**51.03 (1)** Goods shall not be imported or exported if the goods or their labels or packaging bear — without the consent of the owner of a registered trade-mark for such goods — a trade-mark that is identical to, or that cannot be distinguished in its essential aspects from, that registered trade-mark.

### Exception

(2) Subsection (1) does not apply if

(a) the trade-mark was applied with the consent of the owner of the trade-mark in the country where it was applied;

(b) the sale or distribution of the goods or, in the case where the trade-mark is on the goods' labels or packaging, of the goods in association with the labels or packaging would not be contrary to this Act;

(c) the goods are imported or exported by an individual in their possession or baggage and the circumstances, including the number of goods, indicate that the goods are intended only for their personal use; or

(d) the goods, while being shipped from one place outside Canada to another, are in customs transit control or customs transshipment control in Canada.

### **Wine or spirits**

(2.1) Wine or spirits shall not be imported or exported if they, or their labels or packaging, bear a protected geographical indication and the wine or spirits

(a) do not originate in the territory indicated by the indication; or

(b) do originate in the territory indicated by the indication but were not produced or manufactured in accordance with the law applicable to that territory.

### **Agricultural products or food**

(2.2) An agricultural product or food of a category set out in the schedule shall not be imported or exported if it, or its label or packaging, bears a protected geographical indication and the agricultural product or food

(a) does not originate in the territory indicated by the indication; or

(b) does originate in the territory indicated by the indication, but was not produced or manufactured in accordance with the law applicable to that territory.

### **Exception**

(2.3) Subsections (2.1) and (2.2) do not apply if

(a) the sale or distribution of the wine or spirit or the agricultural product or food — or, if the label or packaging of that wine, spirit or agricultural product or food bears a protected geographical indication and the sale or distribution of that wine, spirit or agricultural product or food in association with that label or packaging — would not be contrary to this Act;

(b) the wine or spirit or the agricultural product or food is imported or exported by an individual in their possession or baggage and the circumstances, including the number of such goods, indicate that they are intended only for the individual's personal use; or

(c) the wine or spirit or the agricultural product or food, while being shipped from one place outside Canada to another, is in customs transit control or customs transshipment control in Canada.

### **Restriction**

(3) The contravention of subsection (1), (2.1) or (2.2) does not give rise to a remedy under section 53.2.

## Request for Assistance

### Request for assistance

**51.04 (1)** The owner of a protected mark may file with the Minister, in the form and manner specified by the Minister, a request for assistance in pursuing remedies under this Act with respect to goods imported or exported in contravention of section 51.03.

### Information in request

**(2)** The request for assistance shall include the name and address in Canada of the owner of the protected mark and any other information that is required by the Minister, including information about the trade-mark and the goods for which it is registered or, in the case of a geographical indication, the goods identified by the indication.

### Validity period

**(3)** A request for assistance is valid for a period of two years beginning on the day on which it is accepted by the Minister. The Minister may, at the request of the owner of the protected mark, extend the period for two years, and may do so more than once.

### Security

**(4)** The Minister may, as a condition of accepting a request for assistance or of extending a request's period of validity, require that the owner of the protected mark furnish security, in an amount and form fixed by the Minister, for the payment of an amount for which the owner of the protected mark becomes liable under section 51.09.

### Update

**(5)** The owner of the protected mark shall inform the Minister in writing, as soon as feasible, of any changes to

**(a)** the validity of the protected mark that is the subject of the request for assistance;

**(b)** the ownership of the protected mark; or

**(c)** the goods for which the trade-mark is registered or, in the case of a geographical indication, the goods identified by the indication.

# Measures Relating to Detained Goods

## Provision of information by customs officer

**51.05** A customs officer who is detaining goods under section 101 of the *Customs Act* may, in the officer's discretion, to obtain information about whether the importation or exportation of the goods is prohibited under section 51.03, provide the owner of a relevant protected mark with a sample of the goods and with any information about the goods that the customs officer reasonably believes does not directly or indirectly identify any person.

2014, c. 32, s. 43; 2017, c. 6, s. 78.

## Provision of information to pursue remedy

**51.06 (1)** A customs officer who is detaining goods under section 101 of the *Customs Act* and who has reasonable grounds to suspect that the importation or exportation of the goods is prohibited under section 51.03 may, in the officer's discretion, if the Minister has accepted a request for assistance with respect to a relevant protected mark filed by its owner, provide that owner with a sample of the goods and with information about the goods that could assist them in pursuing a remedy under this Act, such as

- (a) a description of the goods and their characteristics;
- (b) the name and address of their owner, importer, exporter and consignee and of the person who made them;
- (c) their quantity;
- (d) the countries in which they were made and through which they passed in transit; and
- (e) the day on which they were imported, if applicable.

## Detention

**(2)** Subject to subsection (3), the customs officer shall not detain, for the purpose of enforcing section 51.03, the goods for more than 10 working days — or, if the goods are perishable, for more than five days — after the day on which the customs officer first sends or makes available a sample or information to the owner under subsection (1). At the request of the owner made while the goods are detained for the purpose of enforcing section 51.03, the customs officer may, having regard to the circumstances, detain non-perishable goods for one additional period of not more than 10 working days.

## Notice of proceedings

**(3)** If, before the goods are no longer detained for the purpose of enforcing of section 51.03, the owner of a relevant protected mark has provided the Minister, in the manner specified by the Minister, with a copy of a document filed with a court commencing proceedings to obtain a remedy under this Act with respect to the detained goods, the customs officer shall continue to detain them until the Minister is informed in writing that

- (a)** the proceedings are finally disposed of, settled or abandoned;
- (b)** a court directs that the goods are no longer to be detained for the purpose of the proceedings; or
- (c)** the owner of the mark consents to the goods no longer being so detained.

#### **Continued detention**

**(4)** The occurrence of any of the events referred to in paragraphs (3)(a) to (c) does not preclude a customs officer from continuing to detain the goods under the *Customs Act* for a purpose other than with respect to the proceedings.

2014, c. 32, s. 43; 2017, c. 6, ss. 73(F), 78, 79(E).

#### **Restriction on information use — section 51.05**

**51.07 (1)** A person who receives a sample or information that is provided under section 51.05 shall not use the information, or information that is derived from the sample, for any purpose other than to give information to the customs officer about whether the importation or exportation of the goods is prohibited under section 51.03.

#### **Restriction on information use — subsection 51.06(1)**

**(2)** A person who receives a sample or information that is provided under subsection 51.06(1) shall not use the information, or information that is derived from the sample, for any purpose other than to pursue remedies under this Act.

#### **For greater certainty**

**(3)** For greater certainty, subsection (2) does not prevent the confidential communication of information about the goods for the purpose of reaching an out-of-court settlement.

2014, c. 32, s. 43.

#### **Inspection**

**51.08** After a sample or information has been provided under subsection 51.06 (1), a customs officer may, in the officer's discretion, give the owner, importer, exporter and consignee of the detained goods and the owner of the relevant protected mark an opportunity to inspect the goods.

2014, c. 32, s. 43; 2017, c. 6, s. 78.

### **Liability for charges**

**51.09 (1)** The owner of a relevant protected mark who has received a sample or information under subsection 51.06(1) is liable to Her Majesty in right of Canada for the storage and handling charges for the detained goods — and, if applicable, for the charges for destroying them — for the period beginning on the day after the day on which a customs officer first sends or makes available a sample or information to that owner under that subsection and ending on the first day on which one of the following occurs:

- (a) the goods are no longer detained for the purpose of enforcing section 51.03 or, if subsection 51.06(3) applies, for the purpose of the proceedings referred to in that subsection;
- (b) the Minister receives written notification in which the owner of the mark states that the importation or exportation of the goods does not, with respect to the owner's relevant protected mark, contravene section 51.03;
- (c) the Minister receives written notification in which the owner of the mark states that they will not, while the goods are detained for the purpose of enforcing section 51.03, commence proceedings to obtain a remedy under this Act with respect to them.

### **Exception — paragraph (1)(a)**

(2) Despite paragraph (1)(a), if the goods are forfeited under subsection 39(1) of the *Customs Act* and the Minister did not, before the end of the detention of the goods for the purpose of enforcing section 51.03, receive a copy of a document filed with a court commencing proceedings to obtain a remedy under this Act with respect to the detained goods or the written notification referred to in paragraph (1)(b) or (c), the period ends on the day on which the goods are forfeited.

### **Exception — paragraph (1)(c)**

(3) Despite paragraph (1)(c), if the goods are forfeited under subsection 39(1) of the *Customs Act* after the Minister has received the written notification referred to in that paragraph, the period ends on the day on which the goods are forfeited.

### **Joint and several or solidary liability**

**(4)** The owner and the importer or exporter of goods that are forfeited in the circumstances set out in subsection (2) or (3) are jointly and severally, or solidarily, liable to the owner of the relevant protected mark for all the charges under subsection (1) paid by the owner of the relevant protected mark with respect to the period

**(a)** in the circumstances referred to in subsection (2), beginning on the day on which the goods are no longer detained for the purpose of enforcing section 51.03 and ending on the day on which the goods are forfeited; and

**(b)** in the circumstances referred to in subsection (3), beginning on the day on which the Minister receives the written notification referred to in paragraph (1) (c) and ending on the day on which the goods are forfeited.

### **Exception**

**(5)** Subsections (1) to (3) do not apply if

**(a)** the detention of the goods for the purpose of enforcing section 51.03 ends before the expiry of 10 working days — or, if the goods are perishable, before the expiry of five days — after the day on which the customs officer first sends or makes available a sample or information to the owner of the mark under subsection 51.06(1); and

**(b)** the Minister has not, by the end of the detention, received a copy of a document filed with a court commencing proceedings to obtain a remedy under this Act with respect to the detained goods or the written notification referred to in paragraph (1)(b) or (c).

2014, c. 32, s. 43; 2017, c. 6, ss. 78, 79(E).

## **No Liability**

### **No liability**

**51.1** Neither Her Majesty nor a customs officer is liable for any loss or damage suffered in relation to the enforcement or application of sections 51.03 to 51.06 and 51.08 because of

**(a)** the detention of goods, except if the detention contravenes subsection 51.06(2);

**(b)** the failure to detain goods; or

**(c)** the release or cessation of detention of any detained goods, except if the release or cessation contravenes subsection 51.06(3).

2014, c. 32, s. 43.



# Powers of Court Relating to Detained Goods

## Application to court

**51.11 (1)** In the course of proceedings referred to in subsection 51.06(3), the court may, on the application of the Minister or a party to the proceedings,

(a) impose conditions on the storage or detention of the goods that are the subject of the proceedings; or

(b) direct that the goods are no longer to be detained for the purpose of the proceedings, on any conditions that the court may impose, if their owner, importer, exporter or consignee furnishes security in an amount fixed by the court.

## Minister's consent

(2) If a party applies to have the detained goods stored in a place other than a bonded warehouse or a sufferance warehouse, as those terms are defined in subsection 2(1) of the *Customs Act*, the Minister must consent to the storage of the goods in that place before a condition to that effect is imposed under subsection (1).

## Customs Act

(3) The court may impose a condition described in subsection (2) despite section 31 of the *Customs Act*.

## Continued detention

(4) A direction under paragraph (1)(b) that the goods are no longer to be detained for the purpose of the proceedings does not preclude a customs officer from continuing to detain the goods under the *Customs Act* for another purpose.

## Security

(5) In the course of proceedings referred to in subsection 51.06(3), the court may, on the application of the Minister or a party to the proceedings, require the owner of the relevant protected mark to furnish security, in an amount fixed by the court,

(a) to cover duties, as defined in subsection 2(1) of the *Customs Act*, storage and handling charges, and any other amount that may become chargeable against the goods; and

(b) to answer any damages that may by reason of the detention be sustained by the owner, importer, exporter or consignee of the goods.

## **Damages against trade-mark owner**

**51.12** A court may award damages against the owner of a relevant protected mark who commenced proceedings referred to in subsection 51.06(3) to the owner, importer, exporter or consignee of the goods who is a party to the proceedings for losses, costs or prejudice suffered as a result of the detention of goods if the proceedings are dismissed or discontinued.

2014, c. 32, s. 43; 2017, c. 6, s. 78.

# **Trade-mark Agents**

## **Privileged communication**

**51.13 (1)** A communication that meets the following conditions is privileged in the same way as a communication that is subject to solicitor-client privilege or, in civil law, to professional secrecy of advocates and notaries and no person shall be required to disclose, or give testimony on, the communication in a civil, criminal or administrative action or proceeding:

(a) it is between an individual whose name is included on the list of trade-mark agents and that individual's client;

(b) it is intended to be confidential; and

(c) it is made for the purpose of seeking or giving advice with respect to any matter relating to the protection of a trade-mark, geographical indication or mark referred to in paragraph 9(1)(e), (i), (i.1), (i.3), (n) or (n.1).

## **Waiver**

(2) Subsection (1) does not apply if the client expressly or implicitly waives the privilege.

## **Exceptions**

(3) Exceptions to solicitor-client privilege or, in civil law, to professional secrecy of advocates and notaries apply to a communication that meets the conditions set out in paragraphs (1)(a) to (c).

## **Trade-mark agents — country other than Canada**

(4) A communication between an individual who is authorized to act as a trade-mark agent under the law of a country other than Canada and that individual's client that is privileged under the law of that other country and that would be privileged under subsection (1) had it been made between an individual whose

name is included on the list of trade-mark agents and that individual's client is deemed to be a communication that meets the conditions set out in paragraphs (1)(a) to (c).

#### **Individual acting on behalf of trade-mark agent or client**

**(5)** For the purposes of this section, an individual whose name is included on the list of trade-mark agents or an individual who is authorized to act as a trade-mark agent under the law of a country other than Canada includes an individual acting on their behalf and a client includes an individual acting on the client's behalf.

#### **Application**

**(6)** This section applies to communications that are made before the day on which this section comes into force if they are still confidential on that day and to communications that are made after that day. However, this section does not apply in respect of an action or proceeding commenced before that day.

2015, c. 36, s. 66.

## **Legal Proceedings**

### **Definitions**

**52** In sections 53 to 53.3,

***court*** means the Federal Court or the superior court of a province; (*tribunal*)

***duties*** has the same meaning as in the *Customs Act*; (*droits*)

***Minister*** means the Minister of Public Safety and Emergency Preparedness. (*ministre*)

***release*** [Repealed, 2014, c. 32, s. 44]

R.S., 1985, c. T-13, s. 52; 1993, c. 44, s. 234; 2005, c. 38, ss. 142, 145; 2014, c. 32, s. 44.

### **Proceedings for interim custody**

**53 (1)** Where a court is satisfied, on application of any interested person, that any registered trade-mark, any trade-mark that is confusing with a registered trade-mark or any trade-name has been applied to any goods that have been imported into Canada or are about to be distributed in Canada in such a manner that the distribution of the goods would be contrary to this Act, or that any indication of a place of origin has been unlawfully applied to any goods, the court may make an

order for the interim custody of the goods, pending a final determination of the legality of their importation or distribution in an action commenced within such time as is prescribed by the order.

### **Security**

**(2)** Before making an order under subsection (1), the court may require the applicant to furnish security, in an amount fixed by the court, to answer any damages that may by reason of the order be sustained by the owner, importer or consignee of the goods and for any amount that may become chargeable against the goods while they remain in custody under the order.

### **Lien for charges**

**(3)** Where, by the judgment in any action under this section finally determining the legality of the importation or distribution of the goods, their importation or distribution is forbidden, either absolutely or on condition, any lien for charges against them that arose prior to the date of an order made under this section has effect only so far as may be consistent with the due execution of the judgment.

### **Prohibition of imports**

**(4)** Where in any action under this section the court finds that the importation is or the distribution would be contrary to this Act, it may make an order prohibiting the future importation of goods to which the trade-mark, trade-name or indication of origin has been applied.

### **How application made**

**(5)** An application referred to in subsection (1) may be made in an action or otherwise, and either on notice or *ex parte*.

### **Limitation**

**(6)** No proceedings may be taken under subsection (1) for the interim custody of goods by the Minister if proceedings for the detention of the goods by the Minister may be taken under section 53.1.

R.S., 1985, c. T-13, s. 53; 1993, c. 44, s. 234; 2014, c. 32, s. 53; 2018, c. 23, s. 17.

### **Proceedings for detention by Minister**

**53.1 (1)** Where a court is satisfied, on application by the owner of a registered trade-mark, that any goods to which the registered trade-mark or a trade-mark that is confusing with the registered trade-mark has been applied are about to be imported into Canada or have been imported into Canada but have not yet been released, and that the distribution of the goods in Canada would be contrary to this Act, the court may make an order

(a) directing the Minister to take reasonable measures, on the basis of information reasonably required by the Minister and provided by the applicant, to detain the goods;

(b) directing the Minister to notify the applicant and the owner or importer of the goods, forthwith after detaining them, of the detention and the reasons therefor; and

(c) providing for such other matters as the court considers appropriate.

#### **How application made**

(2) An application referred to in subsection (1) may be made in an action or otherwise, and either on notice or *ex parte*, except that it must always be made on notice to the Minister.

#### **Court may require security**

(3) Before making an order under subsection (1), the court may require the applicant to furnish security, in an amount fixed by the court,

(a) to cover duties, storage and handling charges, and any other amount that may become chargeable against the goods; and

(b) to answer any damages that may by reason of the order be sustained by the owner, importer or consignee of the goods.

#### **Application for directions**

(4) The Minister may apply to the court for directions in implementing an order made under subsection (1).

#### **Minister may allow inspection**

(5) The Minister may give the applicant or the importer of the detained goods an opportunity to inspect them for the purpose of substantiating or refuting, as the case may be, the applicant's claim.

#### **Where applicant fails to commence an action**

(6) Unless an order made under subsection (1) provides otherwise, the Minister shall, subject to the *Customs Act* and to any other Act of Parliament that prohibits, controls or regulates the importation or exportation of goods, release the goods without further notice to the applicant if, two weeks after the applicant has been notified under paragraph (1)(b), the Minister has not been notified that an action has been commenced for a final determination by the court of the legality of the importation or distribution of the goods.

#### **Where court finds in plaintiff's favour**

**(7)** Where, in an action commenced under this section, the court finds that the importation is or the distribution would be contrary to this Act, the court may make any order that it considers appropriate in the circumstances, including an order that the goods be destroyed or exported, or that they be delivered up to the plaintiff as the plaintiff's property absolutely.

1993, c. 44, s. 234; 2014, c. 32, s. 53; 2018, c. 23, s. 18.

### **Power of court to grant relief**

**53.2 (1)** If a court is satisfied, on application of any interested person, that any act has been done contrary to this Act, the court may make any order that it considers appropriate in the circumstances, including an order providing for relief by way of injunction and the recovery of damages or profits, for punitive damages and for the destruction or other disposition of any offending goods, packaging, labels and advertising material and of any equipment used to produce the goods, packaging, labels or advertising material.

### **Notice to interested persons**

**(2)** Before making an order for destruction or other disposition, the court shall direct that notice be given to any person who has an interest or right in the item to be destroyed or otherwise disposed of, unless the court is of the opinion that the interests of justice do not require that notice be given.

1993, c. 44, s. 234; 2014, c. 32, s. 45.

### **Unaltered state — exportation, sale or distribution**

**53.3 (1)** A court is not permitted, in any proceeding under section 53.1 or 53.2, to make an order under that section requiring or permitting the goods to be exported, sold or distributed in an unaltered state, except in a manner that does not affect the legitimate interests of the owner of the registered trade-mark or except in exceptional circumstances, if the court finds that

**(a)** goods bearing the registered trade-mark have been imported into Canada in such a manner that the distribution of the goods in Canada would be contrary to this Act; and

**(b)** the registered trade-mark has, without the consent of the owner, been applied to those goods with the intent of counterfeiting or imitating the trade-mark, or of deceiving the public and inducing them to believe that the goods were made with the consent of the owner.

### **Removal of trade-mark**

**(2)** Subsection (1) also applies with respect to goods for which the only alteration is the removal of the trade-mark.

1993, c. 44, s. 234; 2014, c. 32, s. 45.

### **Evidence**

**54 (1)** Evidence of any document in the official custody of the Registrar or of any extract therefrom may be given by the production of a copy thereof purporting to be certified to be true by the Registrar.

### **Idem**

**(2)** A copy of any entry in the register purporting to be certified to be true by the Registrar is evidence of the facts set out therein.

### **Idem**

**(3)** A copy of the record of the registration of a trade-mark purporting to be certified to be true by the Registrar is evidence of the facts set out therein and that the person named therein as owner is the registered owner of the trade-mark for the purposes and within the territorial area therein defined.

### **Idem**

**(4)** A copy of any entry made or documents filed under the authority of any Act in force before July 1, 1954 relating to trade-marks, certified under the authority of that Act, is admissible in evidence and has the same probative force as a copy certified by the Registrar under this Act as provided in this section.

R.S., c. T-10, s. 54.

### **Jurisdiction of Federal Court**

**55** The Federal Court has jurisdiction to entertain any action or proceeding, other than a proceeding under section 51.01, for the enforcement of any of the provisions of this Act or of any right or remedy conferred or defined by this Act.

R.S., 1985, c. T-13, s. 55; 2014, c. 32, s. 46.

### **Appeal**

**56 (1)** An appeal lies to the Federal Court from any decision of the Registrar under this Act within two months from the date on which notice of the decision was dispatched by the Registrar or within such further time as the Court may allow, either before or after the expiration of the two months.

### **Procedure**

**(2)** An appeal under subsection (1) shall be made by way of notice of appeal filed with the Registrar and in the Federal Court.

### **Notice to owner**

**(3)** The appellant shall, within the time limited or allowed by subsection (1), send a copy of the notice by registered mail to the registered owner of any trade-mark that has been referred to by the Registrar in the decision complained of and to every other person who was entitled to notice of the decision.

#### **Public notice**

**(4)** The Federal Court may direct that public notice of the hearing of an appeal under subsection (1) and of the matters at issue therein be given in such manner as it deems proper.

#### **Additional evidence**

**(5)** On an appeal under subsection (1), evidence in addition to that adduced before the Registrar may be adduced and the Federal Court may exercise any discretion vested in the Registrar.

R.S., c. T-10, s. 56; R.S., c. 10(2nd Supp.), s. 64.

#### **Exclusive jurisdiction of Federal Court**

**57 (1)** The Federal Court has exclusive original jurisdiction, on the application of the Registrar or of any person interested, to order that any entry in the register be struck out or amended on the ground that at the date of the application the entry as it appears on the register does not accurately express or define the existing rights of the person appearing to be the registered owner of the mark.

#### **Restriction**

**(2)** No person is entitled to institute under this section any proceeding calling into question any decision given by the Registrar of which that person had express notice and from which he had a right to appeal.

R.S., c. T-10, s. 57; R.S., c. 10(2nd Supp.), s. 64.

#### **How proceedings instituted**

**58** An application under section 57 shall be made either by the filing of an originating notice of motion, by counter-claim in an action for the infringement of the trade-mark, or by statement of claim in an action claiming additional relief under this Act.

R.S., c. T-10, s. 58.

#### **Notice to set out grounds**

**59 (1)** Where an appeal is taken under section 56 by the filing of a notice of appeal, or an application is made under section 57 by the filing of an originating notice of motion, the notice shall set out full particulars of the grounds on which relief is sought.



## **Reply**

**(2)** Any person on whom a copy of the notice described in subsection (1) has been served and who intends to contest the appeal or application, as the case may be, shall file and serve within the prescribed time or such further time as the court may allow a reply setting out full particulars of the grounds on which he relies.

## **Hearing**

**(3)** The proceedings on an appeal or application shall be heard and determined summarily on evidence adduced by affidavit unless the court otherwise directs, in which event it may order that any procedure permitted by its rules and practice be made available to the parties, including the introduction of oral evidence generally or in respect of one or more issues specified in the order.

R.S., c. T-10, s. 59.

## **Registrar to transmit documents**

**60 (1)** Subject to subsection (2), when any appeal or application has been made to the Federal Court under any of the provisions of this Act, the Registrar shall, at the request of any of the parties to the proceedings and on the payment of the prescribed fee, transmit to the Court all documents on file in the Registrar's office relating to the matters in question in those proceedings, or copies of those documents certified by the Registrar.

## **Register of registered users**

**(2)** The transmission of documents on which entries in the register required to be kept under paragraph 26(1)(b) are based is subject to the provisions of subsection 50(6) of the *Trade-marks Act*, as it read immediately before section 69 of the *Intellectual Property Law Improvement Act* came into force.

R.S., 1985, c. T-13, s. 60; 1993, c. 44, s. 238.

## **Judgments**

**61** An officer of the Registry of the Federal Court shall file with the Registrar a certified copy of every judgment or order made by the Federal Court, the Federal Court of Appeal or the Supreme Court of Canada relating to any trade-mark on the register or to any protected geographical indication.

R.S., 1985, c. T-13, s. 61; 2002, c. 8, s. 177; 2017, c. 6, s. 74.

# **General**

## **Administration**

**62** This Act shall be administered by the Minister of Industry.

R.S., 1985, c. T-13, s. 62; 1992, c. 1, s. 145(F); 1995, c. 1, s. 62.

### **Registrar**

**63 (1)** There shall be a Registrar of Trade-marks, who shall be the Commissioner of Patents appointed under subsection 4(1) of the *Patent Act*. The Registrar shall be responsible to the Deputy Minister of Industry.

### **Acting registrar**

**(2)** When the Registrar is absent or unable to act or when the office of Registrar is vacant, his powers shall be exercised and his duties and functions performed in the capacity of acting registrar by such other officer as may be designated by the Minister of Industry.

### **Assistants**

**(3)** The Registrar may, after consultation with the Minister, delegate to any person he deems qualified any of his powers, duties and functions under this Act, except the power to delegate under this subsection.

### **Appeal**

**(4)** Any decision under this Act of a person authorized to make the decision pursuant to subsection (3) may be appealed in the like manner and subject to the like conditions as a decision of the Registrar under this Act.

R.S., 1985, c. T-13, s. 63; 1992, c. 1, s. 145(F); 1995, c. 1, s. 62; 2014, c. 20, s. 370.

### **Publication of registrations**

**64** The Registrar shall cause to be published periodically particulars of the registrations made and extended from time to time under this Act, and shall in such publication give particulars of any rulings made by him that are intended to serve as precedents for the determination of similar questions thereafter arising.

R.S., c. T-10, s. 64.

### **Regulations**

**65** The Governor in Council may make regulations for carrying into effect the purposes and provisions of this Act and, in particular, may make regulations with respect to the following matters:

- (a)** the form of the register and of the indexes to be maintained pursuant to this Act, and of the entries to be made therein;
- (b)** the form of applications to the Registrar;

**(c)** the registration of transfers, licences, disclaimers, judgments or other documents relating to any trade-mark;

**(c.1)** the maintenance of the list of trade-mark agents and the entry and removal of the names of persons and firms on the list, including the qualifications that must be met and the conditions that must be fulfilled to have a name entered on the list and to maintain the name on the list;

**(d)** the form and contents of certificates of registration;

**(d.1)** the procedure by and form in which an application may be made to the Minister, as defined in section 11.11, requesting the Minister to publish a statement referred to in subsection 11.12(2);

**(e)** the payment of fees to the Registrar and the amount thereof;

**(f)** the provision of documents, information or fees to the Registrar under this Act, including the time at which they are deemed to be received by the Registrar; and

**(g)** communications between the Registrar and any other person.

R.S., 1985, c. T-13, s. 65; 1993, c. 15, s. 70; 1994, c. 47, s. 201; 2014, c. 32, s. 50; 2018, c. 27, s. 262.

## **Regulations**

### **65.2** The Governor in Council may make regulations

**(a)** respecting the list to be kept under subsection 11.12(1), including information relating to the listed geographical indications and translations to be included on the list; and

**(b)** respecting proceedings under section 11.13, including documents relating to those proceedings.

2017, c. 6, s. 75.

## **Time period extended**

**66 (1)** If a time period fixed under this Act for doing anything ends on a prescribed day or a day that is designated by the Registrar, that time period is extended to the next day that is not a prescribed day or a designated day.

## **Power to designate day**

**(2)** The Registrar may, on account of unforeseen circumstances and if the Registrar is satisfied that it is in the public interest to do so, designate any day for the purposes of subsection (1). If a day is designated, the Registrar shall inform the public of that fact on the website of the Canadian Intellectual Property Office.

## Newfoundland

### Registration of trade-mark before April 1, 1949

**67 (1)** The registration of a trade-mark under the laws of Newfoundland before April 1, 1949 has the same force and effect in the Province of Newfoundland as if Newfoundland had not become part of Canada, and all rights and privileges acquired under or by virtue of those laws may continue to be exercised or enjoyed in the Province of Newfoundland as if Newfoundland had not become part of Canada.

### Applications for trade-marks pending April 1, 1949

**(2)** The laws of Newfoundland as they existed immediately before April 1, 1949 continue to apply in respect of applications for the registration of trade-marks under the laws of Newfoundland pending at that time and any trade-marks registered under those applications shall, for the purposes of this section, be deemed to have been registered under the laws of Newfoundland before April 1, 1949.

1993, c. 15, s. 71.

### Use of trade-mark or trade-name before April 1, 1949

**68** For the purposes of this Act, the use or making known of a trade-mark or the use of a trade-name in Newfoundland before April 1, 1949 shall not be deemed to be a use or making known of such trade-mark or a use of such trade-name in Canada before that date.

1993, c. 15, s. 71.

## Transitional Provisions

### Use of the indication “Beaufort”

**68.1 (1)** During the period that begins on the day on which this subsection comes into force and ends on the fifth anniversary of that day, section 11.15 does not apply to the use, in connection with a business, of the indication “Beaufort”, or any translation of it in any language, by a person if they or their predecessor in title used the indication or the translation in relation to any business or commercial activity in respect of an agricultural product or food of the category of cheeses, as set out in the schedule, for less than 10 years before October 18, 2013.

### **Use of the indication “Nürnberger Bratwürste”**

(2) During the period that begins on the day on which this subsection comes into force and ends on the fifth anniversary of that day, section 11.15 does not apply to the use, in connection with a business, of the indication “Nürnberger Bratwürste”, or any translation of it in any language, by a person if they or their predecessor in title used the indication or the translation in relation to any business or commercial activity in respect of an agricultural product or food of the category of fresh, frozen and processed meats, as set out in the schedule, for less than five years before October 18, 2013.

### **Use of the indication “Jambon de Bayonne”**

(3) During the period that begins on the day on which this subsection comes into force and ends on the fifth anniversary of that day, section 11.15 does not apply to the use, in connection with a business, of the indication “Jambon de Bayonne”, or any translation of it in any language, by a person if they or their predecessor in title used the indication or the translation in relation to any business or commercial activity in respect of an agricultural product or food of the category of dry-cured meats, as set out in the schedule, for less than 10 years before October 18, 2013.

### **Restriction**

(4) For the purposes of subsections 68.1(1) to (3), no person is a predecessor in title if they only transferred the right to use the indication or the translation, or both.

2017, c. 6, s. 76.

### **Disclosure of documents**

**69** The disclosure of documents — on which entries in the register to be kept under paragraph 26(1)(b), as it read immediately before the day on which subsection 27(1) of the *Combating Counterfeit Products Act* comes into force, are based — is subject to subsection 50(6), as it read on June 8, 1993.

1993, c. 15, s. 71; 2014, c. 20, ss. 358.1, 367.

## **SCHEDULE**

**(Section 2, subsection 11.11(1), paragraphs 11.12(3)(b.1) and (3.1)(c) and 11.15(1)(a), (2)(a) and (3)(a), subsections 11.17(3) and (4), paragraph 11.17(5) (a), subsections 11.17(6) and (7), section 11.24, paragraphs 12(1)(h.1) and 51.02(b) and subsections 51.03(2.2) and 68.1(1) to (3))**

## **Categories of Agricultural Products or Food**

Item	Categories <sup>2</sup>
1	Fresh, frozen and processed meats: products falling under Chapter 2 or heading 16.01 or 16.02
2	Dry-cured meats: dry-cured meats products falling under Chapter 2 or heading 16.01 or 16.02
3	Fresh, frozen and processed fish products: products falling under Chapter 3 or heading 16.03, 16.04 or 16.05
4	Butter: products falling under heading 04.05
5	Cheeses: products falling under heading 04.06
6	Fresh and processed vegetable products: products falling under Chapter 7 and products containing vegetables falling under Chapter 20
7	Fresh and processed fruits and nuts: products falling under Chapter 8 and products containing fruits or nuts falling under Chapter 20
8	Spices: products falling under Chapter 9
9	Cereals: products falling under Chapter 10
10	Products of the milling industry: products falling under Chapter 11
11	Oilseeds: products falling under Chapter 12
12	Hops: products falling under heading 12.10
13	Ginseng: ginseng products falling under heading 12.11 or 13.02
14	Beverages from plant extracts: products falling under Heading 13.02
15	Oils and animal fats: products falling under Chapter 15
16	Confectionery and baked products: products falling under heading 17.04, 18.06, 19.04 or 19.05
17	Sugars and syrups: products falling under heading 17.02
18	Pasta: products falling under heading 19.02
19	Table and processed olives: products falling under heading 20.01 or 20.05
20	Mustard paste: products falling under sub-heading 2103.30
21	Beer: products falling under heading 22.03

Item	Categories*
22	Vinegar: products falling under heading 22.09
23	Essential oils: products falling under heading 33.01
24	Natural gums and resins – chewing gum: products falling under heading 17.04

\*All references in this schedule to chapters and headings are references to the chapters and headings of the Harmonized Commodity Description and Coding System as it read on October 30, 2016.

2017, c. 6, s. 77.

## RELATED PROVISIONS

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### — 1992, c. 1, s. 135(2)

#### Transitional

**135 (2)** Where a notice was sent under subsection 46(2) of the said Act before the coming into force of subsection (1), the renewal of the registration of the trade-mark shall be dealt with and disposed of as if subsection (1) had not come into force.

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### — 2017, c. 6, s. 114

#### Definition of Act

**114** In sections 115 and 116, **Act** means the *Trade-marks Act*.

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### — 2017, c. 6, s. 115

#### Indications in Schedule

**115 (1)** Despite subsection 11.12(2) and section 11.13 of the Act, the *Registrar*, as defined in section 2 of the Act, must, as soon as feasible after this section comes into force, enter the indications set out in Schedule 6 to this Act on the list of geographical indications kept under subsection 11.12(1) of the Act.

#### Deemed entered on list

**(2)** Those indications and all translations of those indications are deemed to have been entered on the list on the day on which this section comes into force.

### For greater certainty

(3) For greater certainty, the Registrar is not required to enter those translations on the list.

### Geographical indications

(4) Each of those indications, to the extent that it remains on the list, is deemed to be a *geographical indication* as defined in section 2 of the Act.

### Acquired rights

(5) For the purpose of subsection 11.2(3) of the Act, the reference to “the day on which a statement by the Minister is published under subsection 11.12(2) or (2.1)” is to be read, with respect to those indications, as a reference to “the day on which this section comes into force”.

### Indication “Feta”

(6) For the purpose of section 11.22 of the Act, the indication “Feta” is deemed to be listed in Part A of Annex 20-A, as amended from time to time, of Chapter Twenty of the Comprehensive Economic and Trade Agreement between Canada and the European Union and its Member States, done at Brussels on October 30, 2016, to the extent that the indication “Φέτα” (Feta) remains listed in that Part A of Annex 20-A of that Agreement.

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— 2017, c. 6, Sch. 6

## SCHEDULE 6

### (Subsection 115(1))

## Indications

	Column 1	Column 2	Column 3	Column 4
				Originating Territory (Territory, Region or Locality) (for information purposes only)
Item	Indication	Transliteration (for information purposes only)	Category of Agricultural Product or Food	
1	České pivo		Beer	Czech Republic
2	Žatecký Chmel		Hops	Czech Republic
3	Hopfen aus der Hallertau		Hops	Germany



	Column 1	Column 2	Column 3	Column 4
Item	Indication	Transliteration (for information purposes only)	Category of Agricultural Product or Food	Originating Territory (Territory, Region or Locality) (for information purposes only)
4	Nürnbergger Bratwürste		Fresh, frozen and processed meats	Germany
5	Nürnbergger Rostbratwürste		Fresh, frozen and processed meats	Germany
6	Schwarzwälder Schinken		Fresh, frozen and processed meats	Germany
7	Aachener Printen		Confectionery and baked products	Germany
8	Nürnbergger Lebkuchen		Confectionery and baked products	Germany
9	Lübecker Marzipan		Confectionery and baked products	Germany
10	Bremer Klaben		Confectionery and baked products	Germany
11	Hessischer Handkäse		Cheeses	Germany
12	Hessischer Handkäs		Cheeses	Germany
13	Tettlinger Hopfen		Hops	Germany
14	Spreewälder Gurken		Fresh and processed vegetable products	Germany
15	Danablu		Cheeses	Denmark
16	Ελιά Καλαμάτας	Elia Kalamatas	Table and processed olives	Greece
17	Μαστίχα Χίου	Masticha Chiou	Natural gums and resins - chewing gum	Greece
18	Φέτα	Feta	Cheeses	Greece
19	Feta		Cheeses	Greece
20	Ελαιόλαδο Καλαμάτας	Elaiolado Kalamata	Oils and animal fats	Greece
21	Ελαιόλαδο Κολυμβάρι Χανίων Κρήτης	Elaiolado Kolymvari Chanion Kritis	Oils and animal fats	Greece

	Column 1	Column 2	Column 3	Column 4
Item	Indication	Transliteration (for information purposes only)	Category of Agricultural Product or Food	Originating Territory (Territory, Region or Locality) (for information purposes only)
22	Ελαιόλαδο Σητείας Λασιθίου Κρήτης	Elaiolado Sitia Lasithiou Kritis	Oils and animal fats	Greece
23	Ελαιόλαδο Λακωνία	Elaiolado Lakonia	Oils and animal fats	Greece
24	Κρόκος Κοζάνης	Krokos Kozanis	Spices	Greece
25	Κεφαλογραβιέρα	Kefalograviera	Cheeses	Greece
26	Γραβιέρα Κρήτης	Graviera Kritis	Cheeses	Greece
27	Γραβιέρα Νάξου	Graviera Naxou	Cheeses	Greece
28	Μανούρι	Manouri	Cheeses	Greece
29	Κασέρι	Kasseri	Cheeses	Greece
30	Φασόλια Γίγαντες Ελέφαντες Καστοριάς	Fassolia Gigantes Elefantas Kastorias	Fresh and processed vegetable products	Greece
31	Φασόλια Γίγαντες Ελέφαντες Πρεσπών Φλώρινας	Fassolia Gigantes Elefantas Prespon Florinas	Fresh and processed vegetable products	Greece
32	Κονσερβολιά Αμφίσσης	Konservolia Amfissis	Table and processed olives	Greece
33	Λουκούμι Γεροσκήπου	Loukoumi Geroskipou	Confectionery and baked products	Cyprus
34	Baena		Oils and animal fats	Spain
35	Sierra Mágina		Oils and animal fats	Spain
36	Aceite del Baix Ebre-Montsía		Oils and animal fats	Spain
37	Oli del Baix Ebre- Montsía		Oils and animal fats	Spain
38	Aceite del Bajo Aragón		Oils and animal fats	Spain
39	Antequera		Oils and animal fats	Spain
40	Priego de Córdoba		Oils and animal fats	Spain
41	Sierra de Cádiz		Oils and animal fats	Spain
42	Sierra de Segura		Oils and animal fats	Spain
43	Sierra de Cazorla		Oils and animal fats	Spain

	Column 1	Column 2	Column 3	Column 4
Item	Indication	Transliteration (for information purposes only)	Category of Agricultural Product or Food	Originating Territory (Territory, Region or Locality) (for information purposes only)
44	Siurana		Oils and animal fats	Spain
45	Aceite de Terra Alta		Oils and animal fats	Spain
46	Oli de Terra Alta		Oils and animal fats	Spain
47	Les Garrigues		Oils and animal fats	Spain
48	Estepa		Oils and animal fats	Spain
49	Guijuelo		Fresh, frozen and processed meats	Spain
50	Jamón de Huelva		Fresh, frozen and processed meats	Spain
51	Jamón de Teruel		Fresh, frozen and processed meats	Spain
52	Salchichón de Vic		Fresh, frozen and processed meats	Spain
53	Llonganissa de Vic		Fresh, frozen and processed meats	Spain
54	Mahón-Menorca		Cheeses	Spain
55	Queso Manchego		Cheeses	Spain
56	Cítricos Valencianos		Fresh and processed fruits and nuts	Spain
57	Cítrics Valencians		Fresh and processed fruits and nuts	Spain
58	Jijona		Confectionery and baked products	Spain
59	Turrón de Alicante		Confectionery and baked products	Spain
60	Azafrán de la Mancha		Spices	Spain
61	Comté		Cheeses	France
62	Reblochon		Cheeses	France
63	Reblochon de Savoie		Cheeses	France
64	Roquefort		Cheeses	France

	Column 1	Column 2	Column 3	Column 4
Item	Indication	Transliteration (for information purposes only)	Category of Agricultural Product or Food	Originating Territory (Territory, Region or Locality) (for information purposes only)
65	Camembert de Normandie		Cheeses	France
66	Brie de Meaux		Cheeses	France
67	Emmental de Savoie		Cheeses	France
68	Pruneaux d'Agen		Fresh and processed fruits and nuts	France
69	Pruneaux d'Agen mi-cuits		Fresh and processed fruits and nuts	France
70	Huîtres de Marennes-Oléron		Fresh, frozen and processed fish products	France
71	Canards à foie gras du Sud-Ouest: Chalosse		Fresh, frozen and processed meats	France
72	Canards à foie gras du Sud-Ouest: Gascogne		Fresh, frozen and processed meats	France
73	Canards à foie gras du Sud-Ouest: Gers		Fresh, frozen and processed meats	France
74	Canards à foie gras du Sud-Ouest: Landes		Fresh, frozen and processed meats	France
75	Canards à foie gras du Sud-Ouest: Périgord		Fresh, frozen and processed meats	France
76	Canards à foie gras du Sud-Ouest: Quercy		Fresh, frozen and processed meats	France
77	Jambon de Bayonne		Dry-cured meats	France
78	Huile d'olive de Haute-Provence		Oils and animal fats	France

	Column 1	Column 2	Column 3	Column 4
Item	Indication	Transliteration (for information purposes only)	Category of Agricultural Product or Food	Originating Territory (Territory, Region or Locality) (for information purposes only)
79	Huile essentielle de lavande de Haute-Provence		Essential oils	France
80	Morbier		Cheeses	France
81	Epoisses		Cheeses	France
82	Beaufort		Cheeses	France
83	Maroilles		Cheeses	France
84	Marolles		Cheeses	France
85	Munster		Cheeses	France
86	Munster Géromé		Cheeses	France
87	Fourme d'Ambert		Cheeses	France
88	Abondance		Cheeses	France
89	Bleu d'Auvergne		Cheeses	France
90	Livarot		Cheeses	France
91	Cantal		Cheeses	France
92	Fourme de Cantal		Cheeses	France
93	Cantalet		Cheeses	France
94	Petit Cantal		Cheeses	France
95	Tomme de Savoie		Cheeses	France
96	Pont-L'Evêque		Cheeses	France
97	Neufchâtel		Cheeses	France
98	Chabichou du Poitou		Cheeses	France
99	Crottin de Chavignol		Cheeses	France
100	Saint-Nectaire		Cheeses	France
101	Piment d'Espelette		Spices	France
102	Lentille verte du Puy		Fresh and processed vegetable products	France
103	Aceto balsamico Tradizionale di Modena		Vinegar	Italy

	Column 1	Column 2	Column 3	Column 4
Item	Indication	Transliteration (for information purposes only)	Category of Agricultural Product or Food	Originating Territory (Territory, Region or Locality) (for information purposes only)
104	Aceto balsamico di Modena		Vinegar	Italy
105	Cotechino Modena		Fresh, frozen and processed meats	Italy
106	Zampone Modena		Fresh, frozen and processed meats	Italy
107	Bresaola della Valtellina		Fresh, frozen and processed meats	Italy
108	Mortadella Bologna		Fresh, frozen and processed meats	Italy
109	Prosciutto di Parma		Dry-cured meats	Italy
110	Prosciutto di S. Daniele		Dry-cured meats	Italy
111	Prosciutto Toscano		Dry-cured meats	Italy
112	Prosciutto di Modena		Dry-cured meats	Italy
113	Provolone Valpadana		Cheeses	Italy
114	Taleggio		Cheeses	Italy
115	Asiago		Cheeses	Italy
116	Fontina		Cheeses	Italy
117	Gorgonzola		Cheeses	Italy
118	Grana Padano		Cheeses	Italy
119	Mozzarella di Bufala Campana		Cheeses	Italy
120	Parmigiano Reggiano		Cheeses	Italy
121	Pecorino Romano		Cheeses	Italy
122	Pecorino Sardo		Cheeses	Italy
123	Pecorino Toscano		Cheeses	Italy
124	Arancia Rossa di Sicilia		Fresh and processed fruits and nuts	Italy

	Column 1	Column 2	Column 3	Column 4
Item	Indication	Transliteration (for information purposes only)	Category of Agricultural Product or Food	Originating Territory (Territory, Region or Locality) (for information purposes only)
125	Cappero di Pantelleria		Fresh and processed fruits and nuts	Italy
126	Kiwi Latina		Fresh and processed fruits and nuts	Italy
127	Lenticchia di Castelluccio di Norcia		Fresh and processed vegetable products	Italy
128	Mela Alto Adige		Fresh and processed fruits and nuts	Italy
129	Südtiroler Apfel		Fresh and processed fruits and nuts	Italy
130	Pesca e nettarina di Romagna		Fresh and processed fruits and nuts	Italy
131	Pomodoro di Pachino		Fresh and processed vegetable products	Italy
132	Radicchio Rosso di Treviso		Fresh and processed vegetable products	Italy
133	Ricciarelli di Siena		Confectionery and baked products	Italy
134	Riso Nano Vialone Veronese		Cereals	Italy
135	Speck Alto Adige		Fresh, frozen and processed meats	Italy
136	Südtiroler Markenspeck		Fresh, frozen and processed meats	Italy
137	Südtiroler Speck		Fresh, frozen and processed meats	Italy
138	Veneto Valpolicella		Oils and animal fats	Italy
139	Veneto Euganei e Berici		Oils and animal fats	Italy
140	Veneto del Grappa		Oils and animal fats	Italy
141	Culatello di Zibello		Fresh, frozen and processed meats	Italy

	Column 1	Column 2	Column 3	Column 4
Item	Indication	Transliteration (for information purposes only)	Category of Agricultural Product or Food	Originating Territory (Territory, Region or Locality) (for information purposes only)
142	Garda		Fresh, frozen and processed meats	Italy
143	Lardo di Colonnata		Fresh, frozen and processed meats	Italy
144	Szegedi téliszalámi		Fresh, frozen and processed meats	Hungary
145	Szegedi szalámi		Fresh, frozen and processed meats	Hungary
146	Tiroler Speck		Fresh, frozen and processed meats	Austria
147	Steirischer Kren		Fresh and processed vegetable products	Austria
148	Steirisches Kürbiskernöl		Oilseeds	Austria
149	Queijo S. Jorge		Cheeses	Portugal
150	Azeite de Moura		Oils and animal fats	Portugal
151	Azeites de Trás-os-Montes		Oils and animal fats	Portugal
152	Azeite do Alentejo Interior		Oils and animal fats	Portugal
153	Azeites da Beira Interior		Oils and animal fats	Portugal
154	Azeites do Norte Alentejano		Oils and animal fats	Portugal
155	Azeites do Ribatejo		Oils and animal fats	Portugal
156	Pêra Rocha do Oeste		Fresh and processed fruits and nuts	Portugal
157	Ameixa d'Elvas		Fresh and processed fruits and nuts	Portugal
158	Ananás dos Açores / S. Miguel		Fresh and processed fruits and nuts	Portugal
159	Chouriça de carne de Vinhais		Fresh, frozen and processed meats	Portugal



Item	Column 1 Indication	Column 2 Transliteration (for information purposes only)	Column 3 Category of Agricultural Product or Food	Column 4 Originating Territory (Territory, Region or Locality) (for information purposes only)
160	Linguiça de Vinhais		Fresh, frozen and processed meats	Portugal
161	Chouriço de Portalegre		Fresh, frozen and processed meats	Portugal
162	Presunto de Barrancos		Fresh, frozen and processed meats	Portugal
163	Queijo Serra da Estrela		Cheeses	Portugal
164	Queijos da Beira Baixa		Cheeses	Portugal
165	Queijo de Castelo Branco		Cheeses	Portugal
166	Queijo Amarelo da Beira Baixa		Cheeses	Portugal
167	Queijo Picante da Beira Baixa		Cheeses	Portugal
168	Salpicão de Vinhais		Fresh, frozen and processed meats	Portugal
169	Gouda Holland		Cheeses	Netherlands
170	Edam Holland		Cheeses	Netherlands
171	Kalix Ljörom		Fresh, frozen and processed fish products	Sweden
172	Magiun de prune Topoloveni		Fresh and processed fruits and nuts	Romania

— 2017, c. 6, s. 116

#### Additional indications

**116 (1)** On the publication of a statement by the *Minister*, as defined in section 11.11 of the Act, that a geographical indication has been added to Part A of Annex 20-A, as amended from time to time, of Chapter Twenty of the Comprehensive Economic and Trade Agreement between Canada and the European Union and its Member States,

done at Brussels on October 30, 2016, the *Registrar*, as defined in section 2 of the Act, must, despite subsection 11.12(2) and section 11.13 of the Act, enter the indication on the list kept under subsection 11.12(1) of the Act.

#### **Information in statement**

(2) The Minister's statement must set out the information described in paragraphs 11.12(3)(b) to (d) and (f) of the Act in respect of the indication.

#### **Deemed entered on list**

(3) The indication and all translations of the indication are deemed to have been entered on the list on the date on which the indication is added to Part A of Annex 20-A of Chapter Twenty of that Agreement.

#### **For greater certainty**

(4) For greater certainty, the Registrar is not required to enter those translations on the list.

#### **Geographical indication**

(5) The indication, to the extent that it remains on the list, is deemed to be a *geographical indication* as defined in section 2 of the Act.

#### **Acquired rights**

(6) For the purpose of subsection 11.2(3) of the Act, the reference to "the day on which a statement by the Minister is published under subsection 11.12(2) or (2.1)" is to be read, with respect to the indication, as a reference to "the date on which the indication is added to Part A of Annex 20-A, as amended from time to time, of Chapter Twenty of the Comprehensive Economic and Trade Agreement between Canada and the European Union and its Member States, done at Brussels on October 30, 2016".

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### **— 2017, c. 6, s. 132**

#### **Korean indications**

**132 (1)** Despite subsection 11.12(2) and section 11.13 of the *Trade-marks Act*, the *Registrar*, as defined in section 2 of that Act, must, as soon as practicable after this subsection comes into force, enter all of the following indications on the list of geographical indications kept under subsection 11.12(1) of that Act:

(a) GoryeoHongsam;

(b) GoryeoBaeksam;

(c) GoryeoSusam;

- (d) IcheonSsal;
- (e) ginseng rouge de Corée;
- (f) ginseng blanc de Corée;
- (g) ginseng frais de Corée;
- (h) riz Icheon;
- (i) Korean Red Ginseng;
- (j) Korean White Ginseng;
- (k) Korean Fresh Ginseng;
- (l) Icheon Rice.

#### **Deemed entry on list**

(2) The indications and all translations of those indications are deemed to have been entered on the list on the day on which this section comes into force.

#### **For greater certainty**

(3) For greater certainty, the Registrar is not required to enter those translations on the list.

#### **Geographical indications**

(4) Each of those indications, to the extent that it remains on the list, is deemed to be a *geographical indication* as defined in section 2 of that Act.

#### **Acquired rights — Canada–Korea**

(5) For the purpose of subsection 11.2(3) of that Act, the reference to “the day on which a statement by the Minister is published under subsection 11.12(2) or (2.1)” is to be read, with respect to the indication listed in section 11.23, as a reference to “January 1, 2015”.

## **AMENDMENTS NOT IN FORCE**

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— 2014, c. 20, s. 317

**317 The long title of the English version of the *Trade-marks Act* is replaced by the following:**

An Act relating to trademarks and unfair competition

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— 2014, c. 20, s. 318

**318 Section 1 of the English version of the Act is replaced by the following:**

**Short title**

1 This Act may be cited as the *Trademarks Act*.

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— 2014, c. 20, ss. 319(1), (2)

**319 (1) The definition *distinguishing guise* in section 2 of the Act is repealed.**

**(2) The definitions *proposed trade-mark* and *representative for service* in section 2 of the Act are repealed.**

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— 2014, c. 20, ss. 319(4), (5)

**319 (4) The definitions *certification mark* and *trade-mark* in section 2 of the Act are replaced by the following:**

***certification mark*** means 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;  
(*marque de certification*)

***trademark*** means

- (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; (*marque de commerce*)

**(5) Section 2 of the Act is amended by adding the following in alphabetical order:**

**Nice Classification** means the classification established by the Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks, signed at Nice on June 15, 1957, including any amendments, modifications and revisions made from time to time to which Canada is a party; (*classification de Nice*)

**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; (*signe*)

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— 2014, c. 20, s. 320

**320 The Act is amended by adding the following after section 2:**

**Reference to *person***

**2.1** Unless the context requires otherwise, a reference to ***person*** in this Act, in relation to a trademark, includes 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.

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— 2014, c. 20, s. 321

**321 (1) Subsections 6(2) to (4) of the Act are replaced by the following:**

**Confusion — trademark with other trademark**

**(2)** 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.

**Confusion — trademark with trade name**

**(3)** The use of a trademark causes confusion with a trade name if the use of both the trademark and trade name in the same area would be likely to lead to the inference that the goods or services associated with the trademark and those associated with the business carried on under the trade name 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.

**Confusion — trade name with trademark**

**(4)** The use of a trade name causes confusion with a trademark if the use of both the trade name and trademark in the same area would be likely to lead to the inference that the goods or services associated with the business carried on under the trade name and those associated with the trademark 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.

**(2) Paragraph 6(5)(e) of the Act is replaced by the following:**

**(e)** the degree of resemblance between the trademarks or trade names, including in appearance or sound or in the ideas suggested by them.

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— 2014, c. 20, s. 322

**322** The heading before section 7 of the Act is replaced by the following:

## **Unfair Competition and Prohibited Signs**

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— 2014, c. 20, s. 323

**323 (1) Paragraph 9(1)(d) of the French version of the Act is replaced by the following:**

**d)** un mot ou symbole susceptible de porter à croire que les produits ou services en liaison avec lesquels il est employé ont reçu l'approbation royale, vice-royale ou gouvernementale, ou que leur production, leur vente ou leur exécution a lieu sous le patronage ou sur l'autorité royale, vice-royale ou gouvernementale;

1994, c. 47, s. 191(2)

**(2) Paragraph 9(1)(i.3) of the Act is replaced by the following:**

**(i.3)** any armorial bearing, flag or other emblem, or the name or any abbreviation of the name, of an international intergovernmental organization, if the armorial bearing, flag, emblem, name or abbreviation is on a list communicated under article 6<sup>ter</sup> of the Convention or pursuant to the obligations under the Agreement on Trade-related Aspects of Intellectual Property Rights set out in Annex 1C to the WTO Agreement stemming from that article, and the Registrar gives public notice of the communication;

1993, c. 15, s. 58(4)

**(3) Paragraph 9(2)(b)(ii) is replaced by the following:**

(ii) an armorial bearing, flag, emblem, name or abbreviation mentioned in paragraph (1)(i.3), unless the use of the mark is likely to mislead the public as to a connection between the user and the organization.

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— 2014, c. 20, s. 324

**324 Section 10 of the Act is replaced by the following:**

**Further prohibitions**

**10** If any sign or combination of signs has by ordinary and *bona fide* commercial usage become recognized in Canada as designating the kind, quality, quantity, destination, value, place of origin or date of production of any goods or services, no person shall adopt it as a trademark in association with the goods or services or others of the same general class or use it in a way likely to mislead, nor shall any person so adopt or so use any sign or combination of signs so nearly resembling that sign or combination as to be likely to be mistaken for it.

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— 2014, c. 20, s. 325

**325 Section 11 of the Act is replaced by the following:**

**Further prohibitions**

**11** No person shall use in connection with a business, as a trademark or otherwise, any sign or combination of signs adopted contrary to section 9 or 10.

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— 2014, c. 20, s. 326, as amended by 2018, c. 27, s. 231

**326 (1) The portion of subsection 12(1) of the Act before paragraph (a) is replaced by the following:**

**When trademark registrable**

**12 (1)** Subject to subsection (2), a trademark is registrable if it is not

1993, c. 15, s. 59(F)

**(2) Paragraph 12(1)(b) of the French version of the Act is replaced by the following:**

**b)** qu'elle soit sous forme graphique, écrite ou sonore, elle donne une description claire ou donne une description fautive et trompeuse, en langue française ou anglaise, de la nature ou de la qualité des produits ou services en liaison avec

lesquels elle est employée, ou en liaison avec lesquels on projette de l'employer, ou des conditions de leur production, ou des personnes qui les produisent, ou de leur lieu d'origine;

**(3) Paragraph 12(1)(e) of the Act is replaced by the following:**

(e) a sign or combination of signs whose adoption is prohibited by section 9 or 10;

**(4) Subsection 12(2) of the Act is replaced by the following:**

**Utilitarian function**

(2) A trademark is not registrable if, in relation to the goods or services in association with which it is used or proposed to be used, its features are dictated primarily by a utilitarian function.

**Registrable if distinctive**

(3) A trademark that is not registrable by reason of paragraph (1)(a) or (b) is registrable if it is distinctive at the filing date of an application for its registration, determined without taking into account subsection 34(1), having regard to all the circumstances of the case including the length of time during which it has been used.

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— 2014, c. 20, s. 327

**327 Section 13 of the Act is repealed.**

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— 2014, c. 20, s. 328

1994, c. 47, s. 194

**328 Sections 14 and 15 of the Act are replaced by the following:**

**Registration of confusing trademarks**

15 Despite section 12, confusing trademarks are registrable if the applicant is the owner of all of the confusing trademarks.

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— 2014, c. 20, s. 329

**329 The heading before section 16 of the French version of the Act is replaced by the following:**

**Personnes ayant droit à l'enregistrement d'une  
marque de commerce**



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— 2014, c. 20, s. 330

**330 (1) The portion of subsection 16(1) of the Act before paragraph (a) is replaced by the following:**

**Entitlement to registration**

**16 (1)** Any applicant who has filed an application in accordance with subsection 30(2) for the registration of a registrable trademark is entitled, subject to section 38, to secure its registration in respect of the goods or services specified in the application, unless at the filing date of the application or the date of first use of the trademark in Canada, whichever is earlier, it was confusing with

1994, c. 47, s. 195

**(2) Subsections 16(2) to (5) of the Act are replaced by the following:**

**Pending application**

**(2)** The right of an applicant to secure registration of a registrable trademark is not affected by the previous filing of an application for registration of a confusing trademark by another person, unless the application for registration of the confusing trademark was pending on the day on which the applicant's application is advertised under subsection 37(1).

**Previous use or making known**

**(3)** The right of an applicant to secure registration of a registrable trademark is not affected by the previous use or making known of a confusing trademark or trade name by another person, if the confusing trademark or trade name was abandoned on the day on which the applicant's application is advertised under subsection 37(1).

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— 2014, c. 20, s. 331

**331 The Act is amended by adding the following after section 18:**

**Not to limit art or industry**

**18.1** The registration of a trademark may be expunged by the Federal Court on the application of any person interested if the Court decides that the registration is likely to unreasonably limit the development of any art or industry.

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— 2014, c. 20, s. 333

**333 Subsection 21(1) of the English version of the Act is replaced by the following:**

### **Concurrent use of confusing marks**

**21 (1)** If, in any proceedings respecting a registered trademark the registration of which is entitled to the protection of subsection 17(2), it is made to appear to the Federal Court that one of the parties to the proceedings, other than the registered owner of the trademark, had in good faith used a confusing trademark or trade name in Canada before the filing date of the application for that registration, and the Court considers that it is not contrary to the public interest that the continued use of the confusing trademark or trade name should be permitted in a defined territorial area concurrently with the use of the registered trademark, the Court may, subject to any terms that it considers just, order that the other party may continue to use the confusing trademark or trade name within that area with an adequate specified distinction from the registered trademark.

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— 2014, c. 20, s. 334

**334 (1) Subsections 23(1) to (3) of the Act are replaced by the following:**

#### **Registration of certification marks**

**23 (1)** A certification mark may be adopted and 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.

#### **Licence**

**(2)** The owner of a certification mark may license others to use it in association with goods or services that meet the defined standard, and the use of the certification mark accordingly is deemed to be use by the owner.

#### **Unauthorized use**

**(3)** The owner of a registered certification mark may prevent its use by unlicensed persons or in association with any goods or services in respect of which it is registered but to which the licence does not extend.

**(2) Subsection 23(4) of the English version of the Act is replaced by the following:**

#### **Action by unincorporated body**

**(4)** If the owner of a registered certification mark is an unincorporated body, any action or proceeding to prevent unauthorized use of the certification mark may be brought by any member of that body on behalf of themselves and all other members.

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— 2014, c. 20, s. 335

**335 Section 24 of the French version of the Act is replaced by the following:**

**Enregistrement d'une marque de commerce créant de la confusion avec la marque de certification**

**24** Avec le consentement du propriétaire d'une marque de certification, une marque de commerce créant de la confusion avec la marque de certification peut, si elle présente une différence caractéristique, être déposée par toute autre personne en vue d'indiquer que les produits en liaison avec lesquels elle est employée ont été fabriqués, vendus, donnés à bail ou loués, et que les services en liaison avec lesquels elle est employée ont été exécutés par elle comme étant une des personnes ayant droit d'employer la marque de certification, mais l'enregistrement de cette marque de commerce est radié par le registraire sur le retrait du consentement du propriétaire de la marque de certification, ou sur annulation de l'enregistrement de la marque de certification.

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— 2014, c. 20, s. 336

**336 Section 25 of the Act is replaced by the following:**

**Descriptive certification mark**

**25** A certification mark that is descriptive of the place of origin of goods or services, and not confusing with any registered trademark, is registrable if the applicant is the administrative authority of a country, state, province or municipality that includes or forms part of the area indicated by the certification mark, or is a commercial association that has an office or representative in that area, but the owner of any certification mark registered under this section shall permit its use in association with any goods or services produced or performed in the area of which it is descriptive.

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— 2014, c. 20, s. 337

**337 Subsection 26(2) of the Act is amended by striking out “and” at the end of paragraph (e) and by adding the following after that paragraph:**

(e.1) the names of the goods or services in respect of which the trademark is registered, grouped 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; and

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— 2014, c. 20, s. 338

**338 Section 28 of the Act is replaced by the following:**

**List of trademark agents**

**28** There shall be kept under the supervision of the Registrar a list of trademark agents, which shall include the names of all persons and firms entitled to represent applicants and others, including the registered owner of a trademark and parties to the proceedings under sections 38 and 45, in all business before the Office of the Registrar of Trademarks.

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**— 2014, c. 20, s. 339, as amended by 2018, c. 27, s. 232**

1993, c. 15, s. 64; 1994, c. 47, s. 198

**339 Sections 30 to 33 of the Act are replaced by the following:**

**Requirements for application**

**30 (1)** A person may file with the Registrar an application for the registration of a trademark in respect of goods or services if they are using or propose to use, and are entitled to use, the trademark in Canada in association with those goods or services.

**Contents of application**

**(2)** The application shall contain

**(a)** a statement in ordinary commercial terms of the goods or services in association with which the trademark is used or proposed to be used;

**(b)** in the case of a certification mark, particulars of the defined standard that the use of the certification mark is intended to indicate and a statement that the applicant 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;

**(c)** a representation or description, or both, that permits the trademark to be clearly defined and that complies with any prescribed requirements; and

**(d)** any prescribed information or statement.

**Nice Classification**

**(3)** The goods or services referred to in paragraph (2)(a) are to be grouped 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.

**Disagreement**

**(4)** Any question arising as to the class within which any goods or services are to be grouped shall be determined by the Registrar, whose determination is not subject to appeal.

### **Standard characters**

**31** An applicant who seeks to register a trademark that consists only of letters, numerals, punctuation marks, diacritics or typographical symbols, or of any combination of them, without limiting the trademark to any particular font, size or colour shall

- (a)** file a representation under paragraph 30(2)(c) that consists only of characters for which the Registrar has adopted standard characters;
- (b)** include in their application a statement to the effect that they wish the trademark to be registered in standard characters; and
- (c)** comply with any prescribed requirements.

### **Further evidence in certain cases**

**32 (1)** 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, determined without taking into account subsection 34(1), if any of the following apply:

- (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,
  - (vii)** any other prescribed sign.

### **Registration to be restricted**

(2) The Registrar shall, having regard to the evidence adduced, restrict the registration to the goods or services in association with which, and to the defined territorial area in Canada in which, the trademark is shown to be distinctive.

### **Filing date**

**33 (1)** The filing date of an application for the registration of a trademark in Canada is the day on which the Registrar has received all of the following:

- (a) an explicit or implicit indication that the registration of the trademark is sought;
- (b) information allowing the identity of the applicant to be established;
- (c) information allowing the Registrar to contact the applicant;
- (d) a representation or description of the trademark;
- (e) a list of the goods or services for which registration of the trademark is sought;
- (f) any prescribed fees.

### **Outstanding items**

(2) The Registrar shall notify the applicant whose application does not contain all the items set out in subsection (1) of the items that are outstanding and require that the applicant submit them within two months of the date of the notice. Despite section 47, that period cannot be extended.

### **Application deemed never filed**

(3) If the Registrar does not receive the outstanding items within those two months, the application is deemed never to have been filed. However, any fees paid in respect of the application shall not be refunded to the applicant.

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### **— 2014, c. 20, s. 340**

1994, c. 47, s. 199

### **340 (1) Subsection 34(1) of the Act is replaced by the following:**

#### **Date of application abroad deemed date of application in Canada**

**34 (1)** Despite subsection 33(1), when an applicant files an application for the registration of a trademark in Canada after the applicant or the applicant's predecessor in title has applied, in or for any country of the Union other than Canada, for the registration of the same or substantially the same trademark in association with the same kind of goods or services, the filing date of the application in or for the other

country is deemed to be the filing date of the application in Canada and the applicant is entitled to priority in Canada accordingly despite any intervening use in Canada or making known in Canada or any intervening application or registration, if

(a) the filing date of the application in Canada is within a period of six months after the date on which the earliest application was filed in or for any country of the Union for the registration of the same or substantially the same trademark in association with the same kind of goods or services;

(b) the applicant files a request for priority in the prescribed time and manner and informs the Registrar of the filing date and country or office of filing of the application on which the request is based;

(c) the applicant, at the filing date of the application in Canada, 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; and

(d) the applicant furnishes, in accordance with any request under subsections (2) and (3), evidence necessary to fully establish the applicant's right to priority.

**(2) Subsection 34(2) is replaced by the following:**

**Evidence requests**

(2) The Registrar may request the evidence before the day on which the trademark is registered under section 40.

**(3) Section 34 of the Act is amended by adding the following after subsection (3):**

**Withdrawal of request**

(4) An applicant may, in the prescribed time and manner, withdraw a request for priority.

**Extension**

(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.

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— 2014, c. 20, s. 341

**341 Section 36 of the Act is replaced by the following:**

**Abandonment**

**36** If, in the opinion of the Registrar, an applicant is in default in the prosecution of an application filed under this Act, the Registrar may, after giving notice to the applicant of the default, treat the application as abandoned unless the default is remedied within the prescribed time.

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— 2014, c. 20, s. 342

**342 (1) Paragraph 37(1)(a) of the Act is replaced by the following:**

(a) the application does not conform to the requirements of subsection 30(2);

**(2) Subsection 37(1) of the Act is amended by striking out “or” at the end of paragraph (b), by adding “or” at the end of paragraph (c) and by replacing the portion after paragraph (c) with the following:**

(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.

**(3) Section 37 of the Act is amended by adding the following after subsection (3):**

**Withdrawal of advertisement**

**(4)** If, after the application has been advertised but before the trademark is registered, the Registrar is satisfied that the application should not have been advertised or was incorrectly advertised and the Registrar considers it reasonable to do so, the Registrar may withdraw the advertisement. If the Registrar withdraws the advertisement, the application is deemed never to have been advertised.

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— 2014, c. 20, s. 343, as amended by 2018, c. 27, s. 233

**343 (1) Paragraph 38(2)(a) of the Act is replaced by the following:**

(a) that the application does not conform to the requirements of subsection 30(2), without taking into account if it meets the requirement in subsection 30(3);

**(2) Subsection 38(2) of the Act is amended by striking out “or” at the end of paragraph (c) and by adding the following after paragraph (d):**

(e) that, at the filing date of the application in Canada, determined without taking into account subsection 34(1), the applicant was not using and did not propose to use the trademark in Canada in association with the goods or services specified in the application; or



(f) that, at the filing date of the application in Canada, determined without taking into account subsection 34(1), the applicant was not entitled to use the trademark in Canada in association with those goods or services.

1993, c. 15, s. 66(2)

**(3) Subsections 38(6) to (8) of the Act are replaced by the following:**

**Power to strike**

(6) At the applicant's request, the Registrar may — at any time before the day on which the applicant files a counter statement — strike all or part of the statement of opposition if the statement or part of it

(a) is not based on any of the grounds set out in subsection (2); or

(b) does not set out a ground of opposition in sufficient detail to enable the applicant to reply to it.

**Counter statement**

(7) The applicant shall file a counter statement with the Registrar and serve a copy on the opponent in the prescribed manner and within the prescribed time after a copy of the statement of opposition has been forwarded to the applicant. The counter statement need only state that the applicant intends to respond to the opposition.

**Evidence and hearing**

(8) Both the opponent and the applicant shall be given an opportunity, in the prescribed manner and within the prescribed time, to submit evidence and to make representations to the Registrar unless

(a) the opposition is withdrawn or deemed under subsection (10) to have been withdrawn; or

(b) the application is abandoned or deemed under subsection (11) to have been abandoned.

**Service**

(9) The opponent and the applicant shall, in the prescribed manner and within the prescribed time, serve on each other any evidence and written representations that they submit to the Registrar.

**Deemed withdrawal of opposition**

(10) The opposition is deemed to have been withdrawn if, in the prescribed circumstances, the opponent does not submit and serve either evidence under subsection (8) or a statement that the opponent does not wish to submit evidence.

**Deemed abandonment of application**

**(11)** The application is deemed to have been abandoned if the applicant does not file and serve a counter statement within the time referred to in subsection (7) or if, in the prescribed circumstances, the applicant does not submit and serve either evidence under subsection (8) or a statement that the applicant does not wish to submit evidence.

### **Decision**

**(12)** After considering the evidence and representations of the opponent and the applicant, the Registrar shall refuse the application, reject the opposition, or refuse the application with respect to one or more of the goods or services specified in it and reject the opposition with respect to the others. He or she shall notify the parties of the decision and the reasons for it.

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— **2014, c. 20, s. 344, as amended by 2018, c. 27, s. 234**

1993, c. 15, s. 67

**344 Section 39 of the Act is replaced by the following:**

### **Divisional application**

**39 (1)** After having filed an application for the registration of a trademark, an applicant may limit the original 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 in association with any other goods or services that were

**(a)** within the scope of the original application on its filing date, determined without taking into account subsection 34(1); and

**(b)** within the scope of the original application on the day on which the divisional application is filed, if the divisional application is filed on or after the day on which the original application is advertised under subsection 37(1).

### **Identification**

**(2)** A divisional application shall indicate that it is a divisional application and shall, in the prescribed manner, identify the corresponding original application.

### **Separate application**

**(3)** A divisional application is a separate application, including with respect to the payment of any fees.

### **Filing date**

**(4)** A divisional application's filing date is deemed to be the original application's filing date.

## **Division of divisional application**

**(5)** A divisional application may itself be divided under subsection (1), in which case this section applies as if that divisional application were an original application.

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### **— 2014, c. 20, s. 345**

1993, c. 15, s. 68, c. 44, ss. 231(2) and (3); 1999, c. 31, s. 210(F)

### **345 Section 40 of the Act is replaced by the following:**

#### **Registration of trademarks**

**40** When an application for the registration of a trademark either has not been opposed and the time for the filing of a statement of opposition has expired, or has been opposed and the opposition has been decided in favour of the applicant, the Registrar shall register the trademark in the name of the applicant and issue a certificate of its registration or, if an appeal is taken, shall act in accordance with the final judgment given in the appeal.

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### **— 2014, c. 20, s. 346**

### **346 (1) The portion of subsection 41(1) of the Act before paragraph (b) is replaced by the following:**

#### **Amendments to register**

**41 (1)** The Registrar may, on application by the registered owner of a trademark made in the prescribed manner and on payment of the prescribed fee, make any of the following amendments to the register:

(a) correct any error or enter any change in the name, address or description of the registered owner;

**(2) Subsection 41(1) of the Act is amended by striking out “or” at the end of paragraph (d), by adding “or” at the end of paragraph (e) and by adding the following after paragraph (e):**

(f) subject to the regulations, merge registrations of the trademark that stem, under section 39, from the same original application.

**(3) Section 41 of the Act is amended by adding the following after subsection (2):**

**Obvious error**

**(3)** The Registrar may, within six months after an entry in the register is made, correct any error in the entry that is obvious from the documents relating to the registered trademark in question that are, at the time that the entry is made, on file in the Registrar's office.

#### **Removal of registration**

**(4)** The Registrar may, within three months after the registration of a trademark, remove the registration from the register if the Registrar registered the trademark without considering a previously filed request for an extension of time to file a statement of opposition.

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— 2014, c. 20, s. 347

**347 Section 42 of the Act is repealed.**

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— 2014, c. 20, s. 348

**348 The Act is amended by adding the following after section 44:**

#### **Registrar may require amendment**

**44.1 (1)** The Registrar may give notice to the registered owner of a trademark requiring the owner to furnish the Registrar, in the prescribed time and manner, with a statement of the goods or services in respect of which the trademark is registered, in which those goods or services are grouped in the manner described in subsection 30(3).

#### **Amendments to register**

**(2)** The Registrar may amend the register in accordance with the statement furnished under subsection (1).

#### **Failure to furnish statement**

**(3)** If the statement required by subsection (1) is not furnished, the Registrar shall by a further notice fix a reasonable time after which, if the statement is not furnished, the Registrar may expunge the registration of the trademark or refuse to renew it.

#### **Disagreement**

**(4)** Any question arising as to the class within which any goods or services are to be grouped shall be determined by the Registrar, whose determination is not subject to appeal.

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— 2014, c. 20, s. 349

**349 Subsections 45(1) and (2) of the Act are replaced by the following:**

**Registrar may request evidence of use**

**45 (1)** After three years beginning on the day on which a trademark is registered, unless the Registrar sees good reason to the contrary, the Registrar shall, at the written request of any person who pays the prescribed fee — or may, on his or her own initiative — give notice to the registered owner of the trademark requiring the registered owner to furnish within three months an affidavit or a statutory declaration showing, with respect to all the goods or services specified in the registration or to those that may be specified in the notice, whether the trademark was in use in Canada at any time during the three-year period immediately preceding the date of the notice and, if not, the date when it was last so in use and the reason for the absence of such use since that date.

**Form of evidence**

**(2)** The Registrar shall not receive any evidence other than the affidavit or statutory declaration, but may receive representations made in the prescribed manner and within the prescribed time by the registered owner of the trademark or by the person at whose request the notice was given.

**Service**

**(2.1)** The registered owner of the trademark shall, in the prescribed manner and within the prescribed time, serve on the person at whose request the notice was given any evidence that the registered owner submits to the Registrar. Those parties shall, in the prescribed manner and within the prescribed time, serve on each other any written representations that they submit to the Registrar.

**Failure to serve**

**(2.2)** The Registrar is not required to consider any evidence or written representations that was not served in accordance with subsection (2.1).

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**— 2014, c. 20, s. 350**

**350 Section 46 of the Act is replaced by the following:**

**Term**

**46 (1)** Subject to any other provision of this Act, the registration of a trademark is on the register for an initial period of 10 years beginning on the day of the registration and for subsequent renewal periods of 10 years if, for each renewal, the prescribed renewal fee is paid within the prescribed period.

**Notice to renew**

**(2)** If the initial period or a renewal period expires and the prescribed renewal fee has not been paid, the Registrar shall send a notice to the registered owner stating that if the fee is not paid within the prescribed period, the registration will be expunged.

**Failure to renew**

**(3)** If the prescribed renewal fee is not paid within the prescribed period, the Registrar shall expunge the registration. The registration is deemed to have been expunged at the expiry of the initial period or the last renewal period.

**Renewal**

**(4)** If the prescribed renewal fee is paid within the prescribed period, the renewal period begins at the expiry of the initial period or the last renewal period.

**Extension**

**(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.

**Prescribed period**

**(6)** For the purposes of this section, the prescribed period begins at least six months before the expiry of the initial period or the renewal period and ends no earlier than six months after the expiry of that period.

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— 2014, c. 20, s. 351

**351 The Act is amended by adding the following after section 47:**

**Proceeding under section 45**

**47.1 (1)** The Registrar shall grant an extension of any time limit fixed under this Act in the context of a proceeding commenced by the Registrar, on his or her own initiative, under section 45, if the extension is requested after the expiry of the time limit and within two months after its expiry.

**One time extension**

**(2)** No extension under subsection (1) shall be granted more than once.

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— 2014, c. 20, s. 352

**352 Subsection 48(3) of the Act is replaced by the following:**

**Transfer of application**

(3) The Registrar shall, subject to the regulations, record the transfer of an application for the registration of a trademark on the request of the applicant or, on receipt of evidence satisfactory to the Registrar of the transfer, on the request of a transferee of the application.

**Transfer of trademark**

(4) The Registrar shall, subject to the regulations, register the transfer of any registered trademark on the request of the registered owner or, on receipt of evidence satisfactory to the Registrar of the transfer, on the request of a transferee of the trademark.

**Removal of recording or registration**

(5) The Registrar shall remove the recording or the registration of the transfer referred to in subsection (3) or (4) on receipt of evidence satisfactory to the Registrar that the transfer should not have been recorded or registered.

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— 2014, c. 20, s. 353

**353 Section 49 of the Act and the heading before it are replaced by the following:**

## **Change of Purpose in Use of Trademark**

**Change of purpose**

**49** If a sign or combination of signs is used by a person as a trademark for any of the purposes or in any of the manners mentioned in the definition *certification mark* or *trademark* in section 2, no application for the registration of the trademark shall be refused and no registration of the trademark shall be expunged, amended or held invalid merely on the ground that the person or a predecessor in title uses the trademark or has used it for any other of those purposes or in any other of those manners.

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— 2014, c. 20, s. 354

**354 Subsection 57(1) of the Act is replaced by the following:**

**Exclusive jurisdiction of Federal Court**

**57 (1)** The Federal Court has exclusive original jurisdiction, on the application of the Registrar or of any person interested, to order that any entry in the register be struck out or amended on the ground that at the date of the application the entry as it appears on the register does not accurately express or define the existing rights of the person appearing to be the registered owner of the trademark.

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— 2014, c. 20, s. 355

**355 Section 61 of the Act is renumbered as subsection 61(1) and is amended by adding the following:**

**Judgment sent by parties**

**(2)** A person who makes a request to the Registrar relating to a judgment or order made by the Federal Court, the Federal Court of Appeal or the Supreme Court of Canada in a proceeding to which they were a party shall, at the request of the Registrar, send a copy of that judgment or order to the Registrar.

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— 2014, c. 20, s. 356

**356 Section 64 of the Act is replaced by the following:**

**Electronic form and means**

**64 (1)** Subject to the regulations, any document, information or fee that is provided to the Registrar under this Act may be provided in any electronic form, and by any electronic means, that is specified by the Registrar.

**Collection, storage, etc.**

**(2)** Subject to the regulations, the Registrar may use electronic means to create, collect, receive, store, transfer, distribute, publish, certify or otherwise deal with documents or information.

**Definition**

**(3)** In this section, *electronic*, in reference to a form or means, includes optical, magnetic and other similar forms or means.

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— 2014, c. 20, s. 357

**357 Section 65 of the Act is replaced by the following:**

**Regulations**



**65** The Governor in Council may make regulations for carrying into effect the purposes and provisions of this Act and, in particular, may make regulations

(a) respecting the form of the register to be kept under this Act, and of the entries to be made in it;

(b) respecting applications to the Registrar and the processing of those applications;

(c) respecting the manner in which the goods or services referred to in paragraph 30(2)(a) are to be described;

(d) respecting the merger of registrations under paragraph 41(1)(f), including, for the purpose of renewal under section 46, the deemed day of registration or last renewal;

(e) respecting the recording or registration of transfers, licences, disclaimers, judgments or other documents relating to any trademark;

(f) respecting the maintenance of the list of trademark agents and the entry and removal of the names of persons and firms on the list, including the qualifications that must be met and the conditions that must be fulfilled to have a name entered on the list and to maintain the name on the list;

(g) respecting certificates of registration;

(h) respecting the procedure by and form in which an application may be made to the Minister, as defined in section 11.11, requesting the Minister to publish a statement referred to in subsection 11.12(2);

(i) respecting proceedings under sections 38 and 45, including documents relating to those proceedings;

(j) respecting the payment of fees to the Registrar and the amount of those fees;

(k) respecting the provision of documents and information to the Registrar, including the time at which they are deemed to be received by the Registrar;

(l) respecting correspondence between the Registrar and any other person;

(m) respecting the grouping of goods or services according to the classes of the Nice Classification and the numbering of those classes; and

(n) prescribing anything that by this Act is to be prescribed.

## Regulations — Madrid Protocol and Singapore Treaty

**65.1** The Governor in Council may make regulations for carrying into effect

(a) despite anything in this Act, the Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks, adopted at Madrid on June 27, 1989, including any amendments, modifications and revisions made from time to time to which Canada is a party; and

(b) the Singapore Treaty on the Law of Trademarks, done at Singapore on March 27, 2006, including any amendments and revisions made from time to time to which Canada is a party.

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— 2014, c. 20, s. 358.2, as amended by 2014, c. 20, par. 367(88)(b)

**358.2 Section 69 of the Act is repealed.**

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— 2014, c. 20, s. 359, as amended by 2014, c. 20, par. 367(88)(c)

**359 The Act is amended by adding the following after section 69:**

### **Application not advertised**

**69.1** An application for registration in respect of which all of the items set out in subsection 33(1), as enacted by section 339 of the *Economic Action Plan 2014 Act, No. 1*, have been received by the Registrar before the day on which that section 339 comes into force, and that has not been advertised under subsection 37(1) before that day shall be dealt with and disposed of in accordance with

(a) the provisions of this Act other than section 31, subsection 33(1) and section 34, as enacted or amended by the *Economic Action Plan 2014 Act, No. 1*; and

(b) section 34, as it read immediately before the day on which section 339 of the *Economic Action Plan 2014 Act, No. 1* comes into force.

### **Application advertised**

**70 (1)** An application for registration that has been advertised under subsection 37(1) before the day on which section 342 of the *Economic Action Plan 2014 Act, No. 1* comes into force shall be dealt with and disposed of in accordance with

(a) the provisions of this Act as they read immediately before the day on which section 342 of the *Economic Action Plan 2014 Act, No. 1* comes into force, other than subsections 6(2) to (4), sections 28 and 36, subsections 38(6) to (8) and sections 39 and 40; and

(b) the definition **Nice Classification** in section 2, subsections 6(2) to (4), sections 28 and 36, subsections 38(6) to (12), sections 39 and 40 and subsections 48(3) and (5), as enacted by the *Economic Action Plan 2014 Act, No. 1*.

### **Regulations**

(2) For greater certainty, a regulation made under section 65, as enacted by section 357 of the *Economic Action Plan 2014 Act, No. 1*, applies to an application referred to in subsection (1), unless the regulation provides otherwise.

### **Nice Classification**

(3) Despite subsection (1), the Registrar may require an applicant to amend the statement of goods or services contained in an application referred to in subsection (1) so that the goods or services are grouped in the manner described in subsection 30(3), as enacted by section 339 of the *Economic Action Plan 2014 Act, No. 1*.

### **Disagreement**

(4) Any question arising as to the class within which any goods or services are to be grouped shall be determined by the Registrar, whose determination is not subject to appeal.

### **Declaration of use**

71 For greater certainty, an applicant is not required to submit a declaration of use referred to in subsection 40(2), as that subsection read immediately before the day on which section 345 of the *Economic Action Plan 2014 Act, No. 1* comes into force, in order for the Registrar to register the trademark and issue a certificate of registration.

### **Registered trademarks — applications filed before coming into force**

72 Any matter arising on or after the day on which section 345 of the *Economic Action Plan 2014 Act, No. 1* comes into force, in respect of a trademark registered on or after that day on the basis of an application filed before that day, shall be dealt with and disposed of in accordance with the provisions of this Act.

### **Registered trademarks**

73 (1) Subject to subsections (2) to (4), any matter arising on or after the day on which section 345 of the *Economic Action Plan 2014 Act, No. 1* comes into force, in respect of a trademark registered before that day, shall be dealt with and disposed of in accordance with the provisions of this Act.

### **Application of paragraph 26(2)(e.1)**

(2) Paragraph 26(2)(e.1) does not apply to a trademark referred to in subsection (1) unless the register is amended under section 44.1.

## **Amending register**

**(3)** The Registrar may amend the register kept under section 26 to reflect the amendments to this Act that are made by the *Economic Action Plan 2014 Act, No. 1*.

### **Subsection 46(1)**

**(4)** Subsection 46(1), as it read immediately before the day on which section 350 of the *Economic Action Plan 2014 Act, No. 1* comes into force, continues to apply to a registration that is on the register on the day before the day on which that section comes into force until the registration is renewed.

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— 2014, c. 20, s. 360

### **Replacement of “wares”**

**360** The Act is amended by replacing “wares”, wherever it occurs, with “goods”.

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— 2014, c. 20, s. 361

### **Replacement of “trade-mark”**

**361** The English version of the Act is amended by replacing “trade-mark”, “trade-marks”, “Trade-mark” and “Trade-marks” with “trademark”, “trademarks”, “Trademark” and “Trademarks”, respectively.

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— 2014, c. 20, s. 362

### **Replacement of “trade-name”**

**362** The English version of the Act is amended by replacing “trade-name”, wherever it occurs, with “trade name”.

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— 2014, c. 20, s. 366(1)

### **Replacement of “trade-mark” in other Acts**

**366 (1)** Unless the context requires otherwise, “trade-mark”, “trade-marks”, “Trade-mark”, “Trade-marks”, “trade mark” and “trade marks” are replaced by “trademark”, “trademarks”, “Trademark” or “Trademarks”, as the case may be, in the English version of any Act of Parliament, other than this Act and the *Trademarks Act*.

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— 2014, c. 20, ss. 367(1) to (4), (12) to (29), (33) to (35), (38) to (63), (66) to (84), (99), (103), as amended by 2018, c. 27, s. 235

**Bill C-8**

**367 (1) Subsections (2) to (103) apply if Bill C-8, introduced in the 2nd session of the 41st Parliament and entitled the *Combating Counterfeit Products Act* (in this section referred to as the “other Act”), receives royal assent.**

**(2) If subsection 319(1) of this Act comes into force before subsection 7(2) of the other Act, then that subsection 7(2) is repealed.**

**(3) If subsection 7(2) of the other Act comes into force before subsection 319(1) of this Act, then that subsection 319(1) is repealed.**

**(4) If subsection 319(1) of this Act comes into force on the same day as subsection 7(2) of the other Act, then that subsection 319(1) is deemed to have come into force before that subsection 7(2) and subsection (2) applies as a consequence.**

**(12) If subsection 319(5) of this Act comes into force before subsection 7(5) of the other Act, then that subsection 7(5) is repealed.**

**(13) If subsection 7(5) of the other Act comes into force before subsection 319(5) of this Act, then**

**(a) on the day on which that subsection 319(5) comes into force, the definition *proposed certification mark* in section 2 of the *Trademarks Act* is repealed;  
and**

**(b) that subsection 319(5) is replaced by the following:**

**(5) Section 2 of the Act is amended by adding the following in alphabetical order:**

***Nice Classification*** means the classification established by the Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks, signed at Nice on June 15, 1957, including any amendments, modifications and revisions made from time to time to which Canada is a party; (*classification de Nice*)

**(14) If subsection 319(5) of this Act comes into force on the same day as subsection 7(5) of the other Act, then that subsection 319(5) is deemed to have come into force before that subsection 7(5) and subsection (12) applies as a consequence.**

**(15) If subsection 326(4) of this Act comes into force before subsection 15(4) of the other Act, then that subsection 15(4) is repealed.**

**(16) If subsection 15(4) of the other Act comes into force before subsection 326(4) of this Act, then that subsection 326(4) is repealed.**

**(17) If subsection 326(4) of this Act comes into force on the same day as subsection 15(4) of the other Act, then that subsection 326(4) is deemed to have come into force before that subsection 15(4), and subsection (15) applies as a consequence.**

**(18) If section 327 of this Act comes into force before section 16 of the other Act, then that section 16 is repealed.**

**(19) If section 16 of the other Act comes into force before section 327 of this Act, then that section 327 is repealed.**

**(20) If section 327 of this Act comes into force on the same day as section 16 of the other Act, then that section 327 is deemed to have come into force before that section 16 and subsection (18) applies as a consequence.**

**(21) If section 328 of this Act comes into force before section 17 of the other Act, then that section 17 is repealed.**

**(22) If section 328 of this Act comes into force on the same day as section 17 of the other Act, then that section 17 is deemed to have come into force before that section 328.**

**(23) If subsection 330(2) of this Act comes into force before section 18 of the other Act, then that section 18 is repealed.**

**(24) If subsection 330(2) of this Act comes into force on the same day as section 18 of the other Act, then that section 18 is deemed to have come into force before that subsection 330(2).**

**(25) If subsection 330(2) of this Act comes into force before paragraph 55(a) of the other Act, then that paragraph 55(a) is repealed.**

**(26) If subsection 330(2) of this Act comes into force on the same day as paragraph 55(a) of the other Act, then that paragraph 55(a) is deemed to have come into force before that subsection 330(2).**

**(27) If section 331 of this Act comes into force before section 20 of the other Act, then that section 20 is repealed.**

**(28) If section 20 of the other Act comes into force before section 331 of this Act, then that section 331 is replaced by the following:**

**331 The English version of section 18.1 of the Act is replaced by the following:**

**Not to limit art or industry**

**18.1** The registration of a trademark may be expunged by the Federal Court on the application of any person interested if the Court decides that the registration is likely to unreasonably limit the development of any art or industry.

**(29)** If section 331 of this Act comes into force on the same day as section 20 of the other Act, then that section 331 is deemed to have come into force before that section 20 and subsection (27) applies as a consequence.

**(33)** If section 333 of this Act comes into force before paragraph 55(b) of the other Act, then that paragraph 55(b) is repealed.

**(34)** If paragraph 55(b) of the other Act comes into force before section 333 of this Act, then that section 333 is repealed.

**(35)** If section 333 of this Act comes into force on the same day as paragraph 55 (b) of the other Act, then that paragraph 55(b) is deemed to have come into force before that section 333 and subsection (34) applies as a consequence.

**(38)** If section 339 of this Act comes into force before subsection 29(1) of the other Act, then that subsection 29(1) is repealed.

**(39)** If section 339 of this Act comes into force on the same day as subsection 29 (1) of the other Act, then that subsection 29(1) is deemed to have come into force before that section 339.

**(40)** If section 339 of this Act comes into force before subsection 29(2) of the other Act, then that subsection 29(2) is repealed.

**(41)** If section 339 of this Act comes into force on the same day as subsection 29 (2) of the other Act, then that subsection 29(2) is deemed to have come into force before that section 339.

**(42)** If section 339 of this Act comes into force before subsection 29(3) of the other Act, then that subsection 29(3) is repealed.

**(43)** If section 339 of this Act comes into force on the same day as subsection 29 (3) of the other Act, then that subsection 29(3) is deemed to have come into force before that section 339.

**(44)** If section 339 of this Act comes into force before subsection 29(4) of the other Act, then that subsection 29(4) is repealed.

**(45)** If section 339 of this Act comes into force on the same day as subsection 29 (4) of the other Act, then that subsection 29(4) is deemed to have come into force before that section 339.

**(46)** If section 339 of this Act comes into force before section 30 of the other Act, then that section 30 is repealed.

**(47) If section 339 of this Act comes into force on the same day as section 30 of the other Act, then that section 339 is deemed to have come into force before that section 30, and subsection (46) applies as a consequence.**

**(48) If section 339 of this Act comes into force before section 31 of the other Act, then that section 31 is repealed.**

**(49) If section 339 of this Act comes into force on the same day as section 31 of the other Act, then that section 31 is deemed to have come into force before that section 339.**

**(50) If subsection 340(3) of this Act comes into force before subsection 33(2) of the other Act, then that subsection 33(2) is repealed.**

**(51) If subsection 33(2) of the other Act comes into force before subsection 340(3) of this Act, then that subsection 340(3) is replaced by the following:**

**(3) Subsection 34(5) of the French version of the Act is replaced by the following:**

#### **Prolongation**

**(5) Le requérant ne peut demander la prolongation, au titre de l'article 47, de la période de six mois prévue à l'alinéa (1)a) qu'après l'expiration de celle-ci. Le registraire ne peut la prolonger que d'au plus sept jours.**

**(52) If subsection 340(3) of this Act comes into force on the same day as subsection 33(2) of the other Act, then that subsection 340(3) is deemed to have come into force before that subsection 33(2), and subsection (50) applies as a consequence.**

**(53) If subsection 342(2) of this Act comes into force before section 34 of the other Act, then that section 34 is repealed.**

**(54) If section 34 of the other Act comes into force before subsection 342(2) of this Act, then that subsection 342(2) is repealed.**

**(55) If subsection 342(2) of this Act comes into force on the same day as section 34 of the other Act, then that subsection 342(2) is deemed to have come into force before that section 34, and subsection (53) applies as a consequence.**

**(56) If subsection 343(3) of this Act comes into force before section 35 of the other Act, then that section 35 is repealed.**

**(57) If section 35 of the other Act comes into force before subsection 343(3) of this Act, then that subsection 343(3) is repealed.**

**(58) If subsection 343(3) of this Act comes into force on the same day as section 35 of the other Act, then that subsection 343(3) is deemed to have come into force before that section 35 and subsection (56) applies as a consequence.**



**(59) If section 344 of this Act comes into force before section 36 of the other Act, then that section 36 is repealed.**

**(60) If section 36 of the other Act comes into force before section 344 of this Act, then that section 344 is replaced by the following:**

**344 Sections 39 and 39.1 of the Act are replaced by the following:**

**Divisional application**

**39 (1)** After having filed an application for the registration of a trademark, an applicant may limit the original 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 in association with any other goods or services that were

**(a)** within the scope of the original application on its filing date, determined without taking into account subsection 34(1); and

**(b)** within the scope of the original application on the day on which the divisional application is filed, if the divisional application is filed on or after the day on which the original application is advertised under subsection 37(1).

**Identification**

**(2)** A divisional application shall indicate that it is a divisional application and shall, in the prescribed manner, identify the corresponding original application.

**Separate application**

**(3)** A divisional application is a separate application, including with respect to the payment of any fees.

**Filing date**

**(4)** A divisional application's filing date is deemed to be the original application's filing date.

**Division of divisional application**

**(5)** A divisional application may itself be divided under subsection (1), in which case this section applies as if that divisional application were an original application.

**(61) If section 344 of this Act comes into force on the same day as section 36 of the other Act, then that section 344 is deemed to have come into force before that section 36 and subsection (59) applies as a consequence.**

**(62) If section 345 of this Act comes into force before subsection 37(1) of the other Act, then that subsection 37(1) is repealed.**

**(63) If section 345 of this Act comes into force on the same day as subsection 37(1) of the other Act, then that subsection 37(1) is deemed to have come into force before that section 345.**

**(66) If section 345 of this Act comes into force before subsection 37(3) of the other Act, then that subsection 37(3) is repealed.**

**(67) If section 345 of this Act comes into force on the same day as subsection 37(3) of the other Act, then that subsection 37(3) is deemed to have come into force before that section 345.**

**(68) If subsection 346(1) of this Act comes into force before subsection 38(1) of the other Act, then that subsection 38(1) is repealed.**

**(69) If subsection 346(1) of this Act comes into force on the same day as subsection 38(1) of the other Act, then that subsection 38(1) is deemed to have come into force before that subsection 346(1).**

**(70) If subsection 346(2) of this Act comes into force before subsection 38(2) of the other Act, then that subsection 38(2) is repealed.**

**(71) If subsection 38(2) of the other Act comes into force before subsection 346(2) of this Act, then that subsection 346(2) is replaced by the following:**

**(2) Paragraph 41(1)(f) of the Act is replaced by the following:**

**(f) subject to the regulations, merge registrations of the trademark that stem, under section 39, from the same original application.**

**(72) If subsection 346(2) of this Act comes into force on the same day as subsection 38(2) of the other Act, then that subsection 346(2) is deemed to have come into force before that subsection 38(2) and subsection (70) applies as a consequence.**

**(73) If subsection 346(3) of this Act comes into force before subsection 38(3) of the other Act, then that subsection 38(3) is repealed.**

**(74) If subsection 38(3) of the other Act comes into force before subsection 346(3) of this Act, then that subsection 346(3) is replaced by the following:**

**(3) Section 41 of the Act is amended by adding the following after subsection (3):**

#### **Removal of registration**

**(4) The Registrar may, within three months after the registration of a trademark, remove the registration from the register if the Registrar registered the trademark without considering a previously filed request for an extension of time to file a statement of opposition.**

**(75) If subsection 346(3) of this Act comes into force on the same day as subsection 38(3) of the other Act, then that subsection 346(3) is deemed to have come into force before that subsection 38(3) and subsection (73) applies as a consequence.**

**(76) If section 349 of this Act comes into force before section 39 of the other Act, then that section 39 is repealed.**

**(77) If section 349 of this Act comes into force on the same day as section 39 of the other Act, then that section 39 is deemed to have come into force before that section 349.**

**(78) If section 352 of this Act comes into force before section 40 of the other Act, then that section 40 is repealed.**

**(79) If section 40 of the other Act comes into force before section 352 of this Act, then that section 352 is replaced by the following:**

**352 Subsections 48(3) and (4) of the Act are replaced by the following:**

**Transfer of application**

**(3)** The Registrar shall, subject to the regulations, record the transfer of an application for the registration of a trademark on the request of the applicant or, on receipt of evidence satisfactory to the Registrar of the transfer, on the request of a transferee of the application.

**Transfer of trademark**

**(4)** The Registrar shall, subject to the regulations, register the transfer of any registered trademark on the request of the registered owner or, on receipt of evidence satisfactory to the Registrar of the transfer, on the request of a transferee of the trademark.

**Removal of recording or registration**

**(5)** The Registrar shall remove the recording or the registration of the transfer referred to in subsection (3) or (4) on receipt of evidence satisfactory to the Registrar that the transfer should not have been recorded or registered.

**(80) If section 352 of this Act comes into force on the same day as section 40 of the other Act, then that section 352 is deemed to have come into force before that section 40 and subsection (78) applies as a consequence.**

**(81) If section 357 of this Act comes into force before subsection 50(1) of the other Act, then that subsection 50(1) is repealed.**

**(82) If section 357 of this Act comes into force on the same day as subsection 50(1) of the other Act, then that subsection 50(1) is deemed to have come into force before that section 357.**

**(83) If section 357 of this Act comes into force before subsection 50(2) of the other Act, then that subsection 50(2) is repealed.**

**(84) If section 357 of this Act comes into force on the same day as subsection 50(2) of the other Act, then that subsection 50(2) is deemed to have come into force before that section 357.**

**(99) On the first day on which both section 359 of this Act and section 28 of the other Act are in force, subsection 70(1) of the *Trademarks Act* is replaced by the following:**

**Application advertised**

**70 (1)** An application for registration that has been advertised under subsection 37(1) before the day on which section 342 of the *Economic Action Plan 2014 Act, No. 1* comes into force shall be dealt with and disposed of in accordance with

**(a)** the provisions of this Act as they read immediately before the day on which section 342 of the *Economic Action Plan 2014 Act, No. 1* comes into force, other than subsections 6(2) to (4), sections 28, 29 and 36, subsections 38(6) to (8) and sections 39 and 40; and

**(b)** the definition *Nice Classification* in section 2, subsections 6(2) to (4), sections 28 to 29.1 and 36, subsections 38(6) to (12), sections 39 and 40 and subsections 48(3) and (5), as enacted by the *Economic Action Plan 2014 Act, No. 1*.

**(103) If section 317 of this Act comes into force before any of the following provisions of the other Act, then any of the following provisions of the other Act that are not in force are repealed:**

**(a) section 8;**

**(b) section 9;**

**(c) section 12;**

**(d) section 13;**

**(e) subsection 15(1);**

**(f) subsection 15(3);**

**(g) subsection 24(1);**

**(h) subsection 24(2);**

**(i) section 32;**

**(j) subsection 33(1);**

**(k) section 41;**

(l) section 47;

(m) section 49.

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— 2014, c. 32, s. 7(2)

**7 (2) The definition *distinguishing guise* in section 2 of the Act is repealed.**

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— 2014, c. 32, s. 7(3), as amended by 2014, c. 20, ss. 367(8), (9)

**7 (3) The definition *distinctive* in section 2 of the Act is replaced by the following:**

***distinctive***, 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; (*distinctive*)

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— 2014, c. 32, s. 7(5)

**7 (5) Section 2 of the Act is amended by adding the following in alphabetical order:**

***proposed certification mark*** means a sign or combination of signs that is 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 have been produced or the services performed,

(c) the class of persons by whom the goods have been produced or the services performed, or

(d) the area within which the goods have been produced or the services performed;  
(*marque de certification projetée*)

***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;  
(*signe*)

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— 2014, c. 32, s. 8

**8 Paragraph 6(5)(e) of the Act is replaced by the following:**

(e) the degree of resemblance between the trade-marks or trade-names, including in appearance or sound or in the ideas suggested by them.

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— 2014, c. 32, s. 9

**9 The heading before section 7 of the Act is replaced by the following:**

## **Unfair Competition and Prohibited Signs**

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— 2014, c. 32, s. 12

**12 Section 10 of the Act is replaced by the following:**

### **Further prohibitions**

**10** If any sign or combination of signs has by ordinary and *bona fide* commercial usage become recognized in Canada as designating the kind, quality, quantity, destination, value, place of origin or date of production of any goods or services, no person shall adopt it as a trade-mark in association with the goods or services or others of the same general class or use it in a way likely to mislead, nor shall any person so adopt or so use any sign or combination of signs so nearly resembling that sign or combination as to be likely to be mistaken for it.

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— 2014, c. 32, s. 13

**13 Section 11 of the Act is replaced by the following:**

### **Further prohibitions**

**11** No person shall use in connection with a business, as a trade-mark or otherwise, any sign or combination of signs adopted contrary to section 9 or 10.

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— 2014, c. 32, s. 15(1)

**15 (1) The portion of subsection 12(1) of the Act before paragraph (a) is replaced by the following:**

**When trademark registrable**

**12 (1)** Subject to subsection (2), a trade-mark is registrable if it is not

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— **2014, c. 32, s. 15(3)**

**15 (3) Paragraph 12(1)(e) of the Act is replaced by the following:**

(e) a sign or combination of signs whose adoption is prohibited by section 9 or 10;

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— **2014, c. 32, s. 15(4), as amended by 2018, c. 27, s. 236**

**15 (4) Subsection 12(2) of the Act is replaced by the following:**

**Utilitarian function**

(2) A trade-mark is not registrable if, in relation to the goods or services in association with which it is used or proposed to be used, its features are dictated primarily by a utilitarian function.

**Registrable if distinctive**

(3) A trade-mark that is not registrable by reason of paragraph (1)(a) or (b) is registrable if it is distinctive at the filing date of an application for its registration, determined without taking into account subsection 34(1), having regard to all the circumstances of the case including the length of time during which it has been used.

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— **2014, c. 32, s. 16**

**16 Section 13 of the Act is repealed.**

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— **2014, c. 32, s. 17**

**17 Section 15 of the Act is replaced by the following:**

**Registration of confusing trade-marks**

**15** Despite sections 12 and 14, confusing trade-marks are registrable if the applicant is the owner of all of the confusing trade-marks.

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— **2014, c. 32, s. 18**

**18** The portion of subsection 16(3) of the Act before paragraph (a) is replaced by the following:

## **Proposed certification marks or trade-marks**

**(3)** Any applicant who has filed an application in accordance with section 30 for registration of a proposed trade-mark or proposed certification mark that is registrable is entitled, subject to sections 38 and 40, to secure its registration in respect of the goods or services specified in the application, unless at the filing date of the application it was confusing with

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— 2014, c. 32, s. 20

## **20 The Act is amended by adding the following after section 18:**

### **Not to limit art or industry**

**18.1** The registration of a trade-mark may be expunged by the Federal Court on the application of any interested person if the Court decides that the registration is likely to unreasonably limit the development of any art or industry.

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— 2014, c. 32, s. 23

## **23 Subsection 22(2) of the Act is replaced by the following:**

### **Action**

**(2)** In any action in respect of a use of a trade-mark contrary to subsection (1), the court may decline to order the recovery of damages or profits and may permit the defendant to continue to sell goods bearing the trade-mark that were in the defendant's possession or under their control at the time notice was given to them that the owner of the registered trade-mark complained of the use of the trade-mark.

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— 2014, c. 32, s. 24

## **24 (1) Subsections 23(1) to (3) of the Act are replaced by the following:**

### **Registration of certification marks**

**23 (1)** A certification mark may be adopted and 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.

### **Licence**



(2) The owner of a certification mark may license others to use it in association with goods or services that meet the defined standard, and the use of the certification mark accordingly is deemed to be use by the owner.

#### **Unauthorized use**

(3) The owner of a registered certification mark may prevent its use by unlicensed persons or in association with any goods or services in respect of which it is registered but to which the licence does not extend.

**(2) Subsection 23(4) of the English version of the Act is replaced by the following:**

#### **Action by unincorporated body**

(4) If the owner of a registered certification mark is an unincorporated body, any action or proceeding to prevent unauthorized use of the certification mark may be brought by any member of that body on behalf of themselves and all other members.

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— 2014, c. 32, s. 29

**29 (1) Paragraph 30(a) of the Act is replaced by the following:**

(a) a statement in ordinary commercial terms of the specific goods or services in association with which the trade-mark has been or is proposed to be used;

**(2) Paragraph 30(f) of the Act is replaced by the following:**

(f) in the case of a certification mark, particulars of the defined standard that the use of the certification mark is intended to indicate and a statement that the applicant 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;

(f.1) in the case of a proposed certification mark, a statement that the applicant intends to license others to use the certification mark in Canada in association with goods or services that meet the defined standard;

**(3) Paragraph 30(h) of the Act is replaced by the following:**

(h) a representation or description, or both, that permits the trade-mark to be clearly defined and that complies with any prescribed requirements;

**(4) Section 30 of the Act is amended by adding “and” at the end of paragraph (i) and by adding the following after that paragraph:**

(j) any prescribed information or statement with respect to the trade-mark.

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— 2014, c. 32, s. 30

**30 The Act is amended by adding the following after section 30:**

**Standard characters**

**30.1** An applicant who seeks to register a trade-mark that consists only of letters, numerals, punctuation marks, diacritics or typographical symbols, or of any combination of them, without limiting the trade-mark to any particular font, size or colour shall

- (a) file a representation under paragraph 30(h) that consists only of characters for which the Registrar has adopted standard characters;
- (b) include in their application a statement to the effect that they wish the trade-mark to be registered in standard characters; and
- (c) comply with any prescribed requirements.

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— 2014, c. 32, s. 31, as amended by 2018, c. 27, s. 237

**31 Sections 31 to 32 of the Act are replaced by the following:**

**Further evidence — registration abroad**

**31** An applicant whose trade-mark has been duly registered in their country of origin and who claims that the trade-mark is registrable under paragraph 14(1)(b) shall furnish any evidence that the Registrar may require establishing the circumstances on which they rely, including the length of time during which the trade-mark has been used in any country.

**Further evidence in certain cases**

**32 (1)** An applicant shall furnish the Registrar with any evidence that the Registrar may require establishing that the trade-mark is distinctive at the filing date of the application for its registration, determined without taking into account subsection 34(1), if any of the following apply:

- (a) the applicant claims that their trade-mark is registrable under subsection 12(3);
- (b) the Registrar's preliminary view is that the trade-mark is not inherently distinctive;
- (c) the trade-mark consists exclusively of a single colour or of a combination of colours without delineated contours;
- (d) the trade-mark consists exclusively or primarily of one or more of the following:

- (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,
- (vii) any other prescribed sign.

#### **Registration to be restricted**

(2) The Registrar shall, having regard to the evidence adduced, restrict the registration to the goods or services in association with which, and to the defined territorial area in Canada in which, the trade-mark is shown to be distinctive.

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— 2014, c. 32, s. 32

#### **32 Section 33 of the Act is replaced by the following:**

##### **Filing date**

**33 (1)** The filing date of an application for the registration of a trade-mark in Canada is the day on which the Registrar has received all of the following:

- (a) an explicit or implicit indication that the registration of the trade-mark is sought;
- (b) information allowing the identity of the applicant to be established;
- (c) information allowing the Registrar to contact the applicant;
- (d) a representation or description of the trade-mark;
- (e) a list of the goods or services for which registration of the trade-mark is sought;
- (f) any prescribed fees.

##### **Outstanding items**

(2) The Registrar shall notify the applicant whose application does not contain all the items set out in subsection (1) of the items that are outstanding and require that the applicant submit them within two months of the date of the notice. Despite section 47, that period cannot be extended.

##### **Application deemed never filed**

(3) If the Registrar does not receive the outstanding items within those two months, the application is deemed never to have been filed. However, any fees paid in respect of the application shall not be refunded to the applicant.

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— 2014, c. 32, s. 33

**33 (1) Subsection 34(1) of the Act is replaced by the following:**

**Date of application abroad deemed date of application in Canada**

**34 (1)** Despite subsection 33(1), when an applicant files an application for the registration of a trade-mark in Canada after the applicant or the applicant's predecessor in title has applied, in or for any country of the Union other than Canada, for the registration of the same or substantially the same trade-mark in association with the same kind of goods or services, the filing date of the application in or for the other country is deemed to be the filing date of the application in Canada and the applicant is entitled to priority in Canada accordingly despite any intervening use in Canada or making known in Canada or any intervening application or registration, if

(a) the filing date of the application in Canada is within a period of six months after the date on which the earliest application was filed in or for any country of the Union for the registration of the same or substantially the same trade-mark in association with the same kind of goods or services;

(b) the applicant files a request for priority in the prescribed time and manner and informs the Registrar of the filing date and country or office of filing of the application on which the request is based;

(c) the applicant, at the filing date of the application in Canada, 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; and

(d) the applicant furnishes, in accordance with any request under subsections (2) and (3), evidence necessary to fully establish the applicant's right to priority.

**(2) Section 34 of the Act is amended by adding the following after subsection (3):**

**Withdrawal of request**

(4) An applicant may, in the prescribed time and manner, withdraw a request for priority.

**Extension**

(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.

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— 2014, c. 32, s. 34

**34 Subsection 37(1) of the Act is amended by striking out “or” at the end of paragraph (b), by adding “or” at the end of paragraph (c) and by replacing the portion after paragraph (c) with the following:**

(d) the trade-mark is not distinctive.

If the Registrar is not so satisfied, the Registrar shall cause the application to be advertised in the prescribed manner.

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— 2014, c. 32, s. 35

**35 Subsections 38(6) to (8) of the Act are replaced by the following:**

**Power to strike**

(6) At the applicant’s request, the Registrar may — at any time before the day on which the applicant files a counter statement — strike all or part of the statement of opposition if the statement or part of it

(a) is not based on any of the grounds set out in subsection (2); or

(b) does not set out a ground of opposition in sufficient detail to enable the applicant to reply to it.

**Counter statement**

(7) The applicant shall file a counter statement with the Registrar and serve a copy on the opponent in the prescribed manner and within the prescribed time after a copy of the statement of opposition has been forwarded to the applicant. The counter statement need only state that the applicant intends to respond to the opposition.

**Evidence and hearing**

(8) Both the opponent and the applicant shall be given an opportunity, in the prescribed manner and within the prescribed time, to submit evidence and to make representations to the Registrar unless

(a) the opposition is withdrawn or deemed under subsection (10) to have been withdrawn; or

(b) the application is abandoned or deemed under subsection (11) to have been abandoned.

**Service**

**(9)** The opponent and the applicant shall, in the prescribed manner and within the prescribed time, serve on each other any evidence and written representations that they submit to the Registrar.

#### **Deemed withdrawal of opposition**

**(10)** The opposition is deemed to have been withdrawn if, in the prescribed circumstances, the opponent does not submit and serve either evidence under subsection (8) or a statement that the opponent does not wish to submit evidence.

#### **Deemed abandonment of application**

**(11)** The application is deemed to have been abandoned if the applicant does not file and serve a counter statement within the time referred to in subsection (7) or if, in the prescribed circumstances, the applicant does not submit and serve either evidence under subsection (8) or a statement that the applicant does not wish to submit evidence.

#### **Decision**

**(12)** After considering the evidence and representations of the opponent and the applicant, the Registrar shall refuse the application, reject the opposition, or refuse the application with respect to one or more of the goods or services specified in it and reject the opposition with respect to the others. He or she shall notify the parties of the decision and the reasons for it.

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— 2014, c. 32, s. 36, as amended by 2018, c. 27, s. 238

### **36 The Act is amended by adding the following after section 39:**

#### **Divisional application**

**39.1 (1)** After having filed an application for the registration of a trade-mark, an applicant may limit the original 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 trade-mark in association with any other goods or services that were

**(a)** within the scope of the original application on its filing date, determined without taking into account subsection 34(1); and

**(b)** within the scope of the original application on the day on which the divisional application is filed, if the divisional application is filed on or after the day on which the original application is advertised under subsection 37(1).

#### **Identification**

**(2)** A divisional application shall indicate that it is a divisional application and shall, in the prescribed manner, identify the corresponding original application.

### **Separate application**

(3) A divisional application is a separate application, including with respect to the payment of any fees.

### **Filing date**

(4) A divisional application's filing date is deemed to be the original application's filing date.

### **Division of divisional application**

(5) A divisional application may itself be divided under subsection (1), in which case this section applies as if that divisional application were an original application.

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— 2014, c. 32, s. 37(1)

**37 (1) Subsection 40(1) of the Act is replaced by the following:**

#### **Registration of trade-marks**

**40 (1)** When an application for the registration of a trade-mark, other than a proposed trade-mark or proposed certification mark, is allowed, the Registrar shall register the trade-mark and issue a certificate of its registration.

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— 2014, c. 32, s. 37(3)

**37 (3) Subsection 40(3) of the Act is replaced by the following:**

#### **Proposed certification mark**

(2.1) When an application for the registration of a proposed certification mark is allowed, the Registrar shall give notice to the applicant accordingly and shall register the certification mark and issue a certificate of registration on receipt of a declaration that the use of the certification mark in Canada, in association with the goods or services specified in the application, has been commenced by an entity that is licensed by or with the authority of the applicant to use the certification mark.

#### **Abandonment of application**

(3) An application for registration referred to in subsection (2) or (2.1) is deemed to be abandoned if the Registrar has not received the declaration before the later of

(a) six months after the date of the Registrar's notice, and

(b) three years after the filing date of the application in Canada.

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— 2014, c. 32, s. 38

**38 (1) The portion of subsection 41(1) of the Act before paragraph (a) is replaced by the following:**

**Amendments to register**

**41 (1)** The Registrar may, on application by the registered owner of a trade-mark made in the prescribed manner and on payment of the prescribed fee, make any of the following amendments to the register:

**(2) Subsection 41(1) of the Act is amended by striking out “or” at the end of paragraph (d), by adding “or” at the end of paragraph (e) and by adding the following after paragraph (e):**

(f) subject to the regulations, merge registrations of the trade-mark that stem, under section 39.1, from the same original application.

**(3) Section 41 of the Act is amended by adding the following after subsection (2):**

**Obvious error**

**(3)** The Registrar may, within six months after an entry in the register is made, correct any error in the entry that is obvious from the documents relating to the registered trade-mark in question that are, at the time that the entry is made, on file in the Registrar’s office.

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— 2014, c. 32, s. 39

**39 Subsection 45(1) of the Act is replaced by the following:**

**Registrar may request evidence of user**

**45 (1)** The Registrar may at any time — and, at the written request made after three years from the date of the registration of a trade-mark by any person who pays the prescribed fee, the Registrar shall, unless he or she sees good reason to the contrary — give notice to the registered owner of the trade-mark requiring the registered owner to furnish within three months an affidavit or a statutory declaration showing, with respect to all the goods or services specified in the registration or to those that the Registrar may specify in the notice, whether the trade-mark was in use in Canada at any time during the three-year period immediately preceding the date of the notice and, if not, the date when it was last so in use and the reason for the absence of such use since that date.

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— 2014, c. 32, s. 40



**40 Section 48 of the Act is amended by adding the following after subsection (3):**

**Removal of registration**

**(4)** The Registrar shall remove the registration of a transfer of a registered trade-mark on being furnished with evidence satisfactory to him or her that the transfer should not have been registered.

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— 2014, c. 32, s. 41

**41 Section 49 of the Act and the heading before it are replaced by the following:**

## **Change of Purpose in Use of Trade-mark**

**Change of purpose**

**49** If a sign or combination of signs is used by a person as a trade-mark for any of the purposes or in any of the manners mentioned in the definition *certification mark* or *trade-mark* in section 2, no application for the registration of the trade-mark shall be refused and no registration of the trade-mark shall be expunged, amended or held invalid merely on the ground that the person or a predecessor in title uses the trade-mark or has used it for any other of those purposes or in any other of those manners.

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— 2014, c. 32, s. 47

**47 Subsection 57(1) of the Act is replaced by the following:**

**Exclusive jurisdiction of Federal Court**

**57 (1)** The Federal Court has exclusive original jurisdiction, on the application of the Registrar or of any person interested, to order that any entry in the register be struck out or amended on the ground that at the date of the application the entry as it appears on the register does not accurately express or define the existing rights of the person appearing to be the registered owner of the trade-mark.

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— 2014, c. 32, s. 48

**48 Section 60 of the Act is replaced by the following:**

**Registrar to transmit documents**

**60** When any appeal or application has been made to the Federal Court under any of the provisions of this Act, the Registrar shall, at the request of any of the parties to the proceedings and on the payment of the prescribed fee, transmit to the Court all documents on file in the Registrar's office relating to the matters in question in those proceedings, or copies of those documents certified by the Registrar.

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— 2014, c. 32, s. 49

**49 Section 64 of the Act is replaced by the following:**

**Electronic form and means**

**64 (1)** Subject to the regulations, any document, information or fee that is provided to the Registrar under this Act may be provided in any electronic form, and by any electronic means, that is specified by the Registrar.

**Collection, storage, etc.**

**(2)** Subject to the regulations, the Registrar may use electronic means to create, collect, receive, store, transfer, distribute, publish, certify or otherwise deal with documents or information.

**Definition**

**(3)** In this section, *electronic*, in reference to a form or means, includes optical, magnetic and other similar forms or means.

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— 2014, c. 32, ss. 50(1), (2)

**50 (1) Paragraphs 65(a) and (b) of the Act are replaced by the following:**

(a) the form of the register to be kept under this Act, and of the entries to be made in it;

(b) applications to the Registrar;

(b.1) the merger of registrations under paragraph 41(1)(f), including, for the purpose of renewal under section 46, the deemed day of registration or last renewal;

**(2) Paragraph 65(d) of the Act is replaced by the following:**

(d) certificates of registration;

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— 2014, c. 32, s. 55

**Replacement of “date of filing”**

**55** The English version of the Act is amended by replacing “date of filing” with “filing date” in the following provisions:

- (a) the portion of subsection 16(2) before paragraph (a); and
  - (b) subsection 21(1).
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— 2014, c. 32, s. 57

**Amending the register**

**57** The Registrar of Trade-marks may amend the register kept under section 26 of the *Trade-marks Act* to reflect the amendments to that Act that are made by this Act.

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— 2015, c. 36, s. 67

**67** Paragraph 65(j) of the Act is replaced by the following:

- (j) respecting the payment of fees to the Registrar, the amount of those fees and the circumstances in which any fees previously paid may be refunded in whole or in part;
  - (j.1) authorizing the Registrar to waive, subject to any prescribed terms and conditions, the payment of a fee if the Registrar is satisfied that the circumstances justify it;
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— 2015, c. 36, s. 69(1)

**69 (1)** Paragraphs 70(1)(a) and (b) of the Act are replaced by the following:

- (a) the provisions of this Act as they read immediately before the day on which section 342 of the *Economic Action Plan 2014 Act, No. 1* comes into force, other than subsections 6(2) to (4), sections 28 and 36, subsections 38(6) to (8) and sections 39, 40 and 66;
  - (b) the definition **Nice Classification** in section 2, subsections 6(2) to (4), sections 28 and 36, subsections 38(6) to (12), sections 39 and 40 and subsections 48(3) and (5), as enacted by the *Economic Action Plan 2014 Act, No. 1*; and
  - (c) section 66, as enacted by the *Economic Action Plan 2015 Act, No. 1*.
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— 2015, c. 36, ss. 70(1), (7)

**70 (1) In this section, *other Act* means the *Economic Action Plan 2014 Act, No. 1*.**

**(7) If subsection 69(1) of this Act comes into force on the day on which subsection 367(99) of the other Act produces its effects, then**

**(a) that subsection 69(1) is deemed never to have come into force and is repealed; and**

**(b) paragraphs 70(1)(a) and (b) of the *Trademarks Act* are replaced by the following:**

**(a)** the provisions of this Act as they read immediately before the day on which section 342 of the *Economic Action Plan 2014 Act, No. 1* comes into force, other than subsections 6(2) to (4), sections 28, 29 and 36, subsections 38(6) to (8) and sections 39, 40 and 66;

**(b)** the definition ***Nice Classification*** in section 2, subsections 6(2) to (4), sections 28 to 29.1 and 36, subsections 38(6) to (12), sections 39 and 40 and subsections 48(3) and (5), as enacted by the *Economic Action Plan 2014 Act, No. 1*; and

**(c)** section 66, as enacted by the *Economic Action Plan 2015 Act, No. 1*.

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**— 2018, c. 27, s. 214**

**214 Paragraph (a) of the definition *pays d'origine* in section 2 of the French version of the *Trade-marks Act* is replaced by the following:**

**a)** Le pays de l'Union où l'auteur d'une demande d'enregistrement d'une marque de commerce avait, à la date de la demande, un établissement industriel ou commercial effectif et sérieux;

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**— 2018, c. 27, s. 215**

**215 Section 9 of the Act is amended by adding the following after subsection (2):**

**For greater certainty**

**(3)** For greater certainty, and despite any public notice of adoption and use given by the Registrar under paragraph (1)(n), subparagraph (1)(n)(iii) does not apply with respect to a badge, crest, emblem or mark if the entity that made the request for the public notice is not a public authority or no longer exists.

**Notice of non-application**

(4) In the circumstances set out in subsection (3), the Registrar may, on his or her own initiative or at the request of a person who pays a prescribed fee, give public notice that subparagraph (1)(n)(iii) does not apply with respect to the badge, crest, emblem or mark.

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— 2018, c. 27, s. 216

**216 The Act is amended by adding the following after section 11:**

**Exception**

**11.01** Despite section 11, a person may use a badge, crest, emblem or mark described in subparagraph 9(1)(n)(iii) if, at the time of use, the entity that made the request for a public notice under paragraph 9(1)(n) with respect to the badge, crest, emblem or mark is not a public authority or no longer exists.

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— 2018, c. 27, s. 217

**217 (1) Section 11.13 of the Act is amended by adding the following after subsection (6.1):**

**Withdrawal of objection**

**(6.2)** If, in the opinion of the Registrar, an objector is in default in the continuation of an objection, the Registrar may, after giving notice to the objector of the default, treat the objection as withdrawn unless the default is remedied within the time specified in the notice.

**(2) Section 11.13 of the Act is amended by adding the following after subsection (8):**

**Costs**

**(9)** Subject to the regulations, the Registrar may, by order, award costs in a proceeding under this section.

**Order of Federal Court**

**(10)** A certified copy of an order made under subsection (9) may be filed in the Federal Court and, on being filed, the order becomes and may be enforced as an order of that Court.

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— 2018, c. 27, s. 219

**219 The Act is amended by adding the following after section 36:**

## **Withdrawal of opposition**

**36.1** If, in the opinion of the Registrar, an opponent is in default in the continuation of an opposition referred to in section 38, the Registrar may, after giving notice to the opponent of the default, treat the opposition as withdrawn unless the default is remedied within the time specified in the notice.

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— 2018, c. 27, s. 220

**220 Subsection 38(2) of the Act is amended by adding the following after paragraph (a):**

(a.1) that the application was filed in bad faith;

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— 2018, c. 27, s. 221

**221 The Act is amended by adding the following after section 38:**

### **Costs**

**38.1 (1)** Subject to the regulations, the Registrar may, by order, award costs in a proceeding under section 38.

### **Order of Federal Court**

**(2)** A certified copy of an order made under subsection (1) may be filed in the Federal Court and, on being filed, the order becomes and may be enforced as an order of that Court.

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— 2018, c. 27, s. 222

**222 Section 45 of the Act is amended by adding the following after subsection (4):**

### **Costs**

**(4.1)** Subject to the regulations, the Registrar may, by order, award costs in a proceeding under this section.

### **Order of Federal Court**

**(4.2)** A certified copy of an order made under subsection (4.1) may be filed in the Federal Court and, on being filed, the order becomes and may be enforced as an order of that Court.

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**223 The Act is amended by adding the following after section 45:**

## **Confidentiality Orders**

### **Request to keep evidence confidential**

**45.1 (1)** A party to a proceeding under section 11.13, 38 or 45 may make a request to the Registrar, in accordance with the regulations, that some or all of the evidence that they intend to submit to the Registrar be kept confidential.

### **Restriction**

**(2)** The Registrar shall not consider a request if the party who makes it submits the evidence to the Registrar before the Registrar either gives notice under subsection (3) or makes an order under subsection (4).

### **Registrar not satisfied**

**(3)** If the Registrar is not satisfied that the evidence should be kept confidential, the Registrar shall notify the party who made the request accordingly.

### **Confidentiality order**

**(4)** If the Registrar is satisfied that the evidence should be kept confidential, he or she may, on any terms that he or she considers appropriate, order that the evidence be kept confidential.

### **Consequences of order**

**(5)** If the Registrar makes an order under subsection (4),

**(a)** the party who made the request may submit the evidence to the Registrar and, if it is submitted, shall serve it on the other party in accordance with the order;

**(b)** subsections 11.13(5.1), 38(9) and 45(2.1) do not apply with respect to the evidence;

**(c)** section 29 does not apply to the evidence; and

**(d)** the Registrar shall take measures to ensure that the evidence is kept confidential when the evidence or a copy of the evidence is transmitted to the Federal Court under section 60.

### **Order of Federal Court**

**(6)** A certified copy of an order made under subsection (4) may be filed in the Federal Court and, on being filed, the order becomes and may be enforced as an order of that Court.

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— 2018, c. 27, s. 224

**224 The Act is amended by adding the following after section 46:**

**Renewal for goods or services**

**46.1** The registration of a trademark may be renewed for any of the goods or services in respect of which the trademark is registered.

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— 2018, c. 27, s. 225

**225 Section 53.2 of the Act is amended by adding the following after subsection (1):**

**Exception**

**(1.1)** If, within a period of three years beginning on the date of registration of a trademark, the owner of the registered trademark makes an application claiming that an act has been done contrary to section 19, 20 or 22, the owner is not entitled to relief unless the trademark was in use in Canada at any time during that period or special circumstances exist that excuse the absence of use in Canada during that period.

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— 2018, c. 27, s. 226

**226 Subsection 56(5) of the Act is replaced by the following:**

**Additional evidence**

**(5)** If, on an appeal under subsection (1), the Federal Court grants leave to adduce evidence in addition to that adduced before the Registrar, the Court may exercise, with respect to that additional evidence, any discretion vested in the Registrar.

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— 2018, c. 27, s. 227

**227 Section 65 of the Act is amended by striking out “and” at the end of paragraph (m) and by replacing paragraph (n) with the following:**

**(n)** respecting the awarding of costs under subsections 11.13(9), 38.1(1) and 45(4.1);

**(o)** respecting requests made under subsection 45.1(1); and

**(p)** prescribing anything that by this Act is to be prescribed.



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— 2018, c. 27, s. 228

**228 The Act is amended by adding the following after section 65.2:**

**Case management**

**65.3 (1)** For greater certainty, the Governor in Council may make regulations under paragraphs 65(i) and 65.2(b) respecting the case management by the Registrar of proceedings referred to in those paragraphs.

**Time or manner**

**(2)** The Governor in Council may make regulations authorizing the Registrar to fix, despite any time or manner that is provided for under this Act with respect to any of the proceedings referred to in subsection (1), the time by which or the manner in which any step in a case-managed proceeding is to be completed and, in that case, the provisions of this Act and the regulations apply with respect to the proceeding with any modifications that the circumstances require.

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— 2018, c. 27, s. 229

**229 The Act is amended by adding the following after section 68.1:**

**Non-application of paragraph 38(2)(a.1)**

**68.2** No person shall oppose an application for registration of a trademark on the ground set out in paragraph 38(2)(a.1) if the application was advertised under subsection 37(1) before the day on which that paragraph comes into force.

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— 2018, c. 27, s. 230

**230 Subsection 70(2) of the Act is replaced by the following:**

**Regulations**

**(2)** For greater certainty, a regulation made under this Act applies to an application referred to in subsection (1), unless the regulation provides otherwise.

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— 2018, c. 27, ss. 239(1), (4)

2015, c. 36

**239 (1)** In this section, *other Act* means the *Economic Action Plan 2015 Act, No. 1*.

**(4) On the first day on which both subsection 70(7) of the other Act has produced its effects and section 215 of this Act is in force, subsection 70(1) of the *Trade-marks Act* is amended by, if necessary, striking out “and” at the end of paragraph (b) and adding “and” at the end of paragraph (c) and by adding the following after paragraph (c):**

**(d) subsections 9(3) and (4), sections 36.1, 38.1 and 45.1, and subsection 56(5), as enacted by the *Budget Implementation Act, 2018, No. 2*.**

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**— 2018, c. 27, ss. 240(1), (4)**

2014, c. 20

**240 (1) In this section, *other Act* means the *Economic Action Plan 2014 Act, No. 1*.**

**(4) If section 357 of the other Act comes into force on the same day as section 227 of this Act, then that section 357 is deemed to have come into force before that section 227.**

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**— 2018, c. 27, s. 255**

**255 Section 28 of the *Trade-marks Act* is repealed.**

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**— 2018, c. 27, s. 256**

**256 (1) Paragraph 29(1)(c) of the Act is repealed.**

**(2) Subsection 29(2) of the Act is replaced by the following:**

**Certified copies**

**(2) The Registrar shall, on request and on payment of the prescribed fee, furnish a copy certified by the Registrar of any entry in the register or list, or of any of those applications, requests or documents.**

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**— 2018, c. 27, s. 257**

**257 (1) Paragraph 51.13(1)(a) of the Act is replaced by the following:**

**(a) it is between a trade-mark agent and their client;**

**(2) Subsections 51.13(4) and (5) of the Act are replaced by the following:**

### **Trade-mark agents — country other than Canada**

(4) A communication between an individual who is authorized to act as the equivalent of a trade-mark agent under the law of a country other than Canada and that individual's client that is privileged under the law of that other country and that would be privileged under subsection (1) had it been made between a trade-mark agent and their client is deemed to be a communication that meets the conditions set out in paragraphs (1)(a) to (c).

### **Individual acting on behalf of trade-mark agent or client**

(5) For the purposes of this section, a trade-mark agent or an individual who is authorized to act as the equivalent of a trade-mark agent under the law of a country other than Canada includes an individual acting on their behalf and a client includes an individual acting on the client's behalf.

(3) **Section 51.13 of the Act is amended by adding the following after subsection (6):**

#### **Definition of *trade-mark agent***

(7) In this section, ***trade-mark agent*** has the same meaning as in section 2 of the *College of Patent Agents and Trade-mark Agents Act*.

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— 2018, c. 27, s. 258(1)

**258 (1) Paragraph 65(c.1) of the Act is repealed.**

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— 2018, c. 27, s. 261

2014, c. 20

**261 (1) In this section, *other Act* means the *Economic Action Plan 2014 Act, No. 1*.**

(2) **If section 255 of this Act comes into force before section 338 of the other Act, then that section 338 is repealed.**

(3) **If section 338 of the other Act comes into force on the same day as section 255 of this Act, then that section 338 is deemed to have come into force before that section 255.**

(4) **If section 357 of the other Act comes into force before subsection 258(1) of this Act, then that subsection 258(1) is replaced by the following:**

**258 (1) Paragraph 65(f) of the Act is repealed.**

(5) If subsection 258(1) of this Act comes into force before section 357 of the other Act, then that section 357 is amended by repealing the paragraph 65(f) that it enacts.

(6) If section 357 of the other Act comes into force on the same day as subsection 258(1) of this Act, then that section 357 is deemed to have come into force before that subsection 258(1) and subsection (4) applies as a consequence.

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— 2018, c. 27, s. 262(1), par. (3)(c)

2014, c. 20 and c. 32

**262 (1) The following definitions apply in this section.**

**first Act** means the *Economic Action Plan 2014 Act, No. 1*. (*première loi*)

**second Act** means the *Combating Counterfeit Products Act*. (*deuxième loi*)

(3) If subsection 50(3) of the second Act comes into force on or before the day on which subsection 258(2) of this Act comes into force and section 357 of the first Act is not in force on that day, then

(c) on the day on which section 357 of the first Act comes into force, paragraph 65(l) of the English version of the *Trade-marks Act* is replaced by the following:

(l) respecting communications between the Registrar and any other person;

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— 2018, c. 27, s. 263

2015, c. 36

**263 (1) In this section, other Act means the *Economic Action Plan 2015 Act, No. 1*.**

(2) If subsection 70(7) of the other Act produces its effects before section 255 of this Act comes into force, then

(a) paragraphs 70(1)(a) and (b) of the *Trade-marks Act* are replaced by the following:

(a) the provisions of this Act as they read immediately before the day on which section 342 of the *Economic Action Plan 2014 Act, No. 1* comes into force, other than subsections 6(2) to (4), sections 28 and 36, subsections 38(6) to (8) and sections 39, 40 and 66;

(b) the definition *Nice Classification* in section 2, subsections 6(2) to (4), sections 28 and 36, subsections 38(6) to (12), sections 39 and 40 and subsections 48(3) and (5), as enacted by the *Economic Action Plan 2014 Act, No. 1*; and

**(b) on the day on which that section 255 comes into force, paragraph 70(1)(b) of the *Trade-marks Act* is replaced by the following:**

(b) the definition *Nice Classification* in section 2, subsections 6(2) to (4), section 36, subsections 38(6) to (12), sections 39 and 40 and subsections 48(3) and (5), as enacted by the *Economic Action Plan 2014 Act, No. 1*;

**(3) If section 255 of this Act comes into force before subsection 70(7) of the other Act produces its effects, then, on the day on which that subsection 70(7) produces its effects, paragraphs 70(1)(a) and (b) of the *Trade-marks Act* are replaced by the following:**

(a) the provisions of this Act as they read immediately before the day on which section 342 of the *Economic Action Plan 2014 Act, No. 1* comes into force, other than subsections 6(2) to (4), section 36, subsections 38(6) to (8) and sections 39, 40 and 66;

(b) the definition *Nice Classification* in section 2, subsections 6(2) to (4), section 36, subsections 38(6) to (12), sections 39 and 40 and subsections 48(3) and (5), as enacted by the *Economic Action Plan 2014 Act, No. 1*;

**(4) If subsection 70(7) of the other Act produces its effects on the same day as section 255 of this Act comes into force, then paragraphs 70(1)(a) and (b) of the *Trade-marks Act* are replaced by the following:**

(a) the provisions of this Act as they read immediately before the day on which section 342 of the *Economic Action Plan 2014 Act, No. 1* comes into force, other than subsections 6(2) to (4), sections 28 and 36, subsections 38(6) to (8) and sections 39, 40 and 66;

(b) the definition *Nice Classification* in section 2, subsections 6(2) to (4), section 36, subsections 38(6) to (12), sections 39 and 40 and subsections 48(3) and (5), as enacted by the *Economic Action Plan 2014 Act, No. 1*;