

Summary of Contents

Volume 1

PART I. INFORMATION, DEFINITIONS AND CONCEPTS

Chapter 1. Introduction

Appendix 1A. International Agreements

Appendix 1A.1. Paris Convention for the Protection of Industrial Property

Appendix 1A.2. Agreement on Trade-related Aspects of Intellectual Property Rights 1994

Appendix 1A.3. Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks

Appendix 1A.4. Singapore Treaty on the Law of Trademarks

Appendix 1A.5. Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks

Appendix 1A.6. North American Free Trade Agreement — Selected Sections

Appendix 1A.7. Canada-European Union Comprehensive Economic and Trade Agreement (CETA) — Chapter 20 (Intellectual Property)

Appendix 1A.8. Comprehensive and Progressive Agreement for Trans-Pacific Partnership (CPTPP) — Chapter 18 (Intellectual Property)

Appendix 1B. International Regulations and Instructions

Appendix 1B.1. Regulations Under the Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks

Appendix 1B.2. Administrative Instructions for the Application of the Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks

Appendix 1B.3. Canadian Intellectual Property Office — Vienna Classification Schema

Appendix 1B.4. Vienna Classification

Appendix 1B.5. — Release of the Vienna Classification Assistant

Appendix 1C. Contracting Parties

- Appendix 1C.1. Contracting Parties to the Paris Convention — Status at October 19, 2023
- Appendix 1C.2. Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks
- Appendix 1C.3. Contracting Parties Singapore Treaty
- Appendix 1C.4. Contracting Parties Nice Agreement
- Appendix 1D. Canada Implementation Acts**
- Appendix 1D.1. North American Free Trade Agreement Implementation Act
- Appendix 1D.2. Canada-European Union Comprehensive Economic and Trade Agreement Implementation Act Selected sections
- Appendix 1E. CIPO Materials**
- Appendix 1E.1. Trademarks Office Home Page
- Appendix 1E.2. Canadian Intellectual Property Office Trade-marks Wares and Services Manual
- Appendix 1E.3. Canadian Trademarks database
- Appendix 1E.4. Canadian Vienna Codes
- Appendix 1F. Practice Notices**
- Appendix 1F.1. Practice Notice — Canada Accedes to the Latest Text of the Paris Convention
- Appendix 1F.2. Procedures at Time of Filing
- Appendix 1F.3. Vienna Classification now in Use for Canadian Trade-marks
- Appendix 1F.4. Archived
- Appendix 1F.5. Changes Regarding Practice Notices
- Appendix 1F.6. Reformatted and Revised Wares and Services Manual
- Appendix 1F.7. Practice Notice—Electronic Register and Documents
- Chapter 2. Definition and Selection of a Trademark
 - Appendix 2A. Corporations name granting
- Appendix 2B. Practice Notices**
- Appendix 2B.1. Official Marks pursuant Sub-paragraph 9(1)(n)(iii)
- Appendix 2B.2. Prohibited marks on the Canadian Trade-marks Database
- Appendix 2B.3. Trade-mark Consisting of a Sound
- Appendix 2B.4. Trademark Common Status Descriptors
- Appendix 2B.5. TM5 Common Status Descriptor Icons
- Appendix 2C. Legislative Amendments**

SUMMARY OF CONTENTS

- Appendix 2C.1. Amendments to the Trade-marks Act — Exception for Generic Names for Wines
- Appendix 2C.2. Order and the Regulatory Impact Analysis Statement, Canada Gazette Vol. 138, No. 9 — May 5, 2004

PART II. TRADEMARK APPLICATION PROCESS

- Chapter 3. Preparing an Application or a Request for Publication

- Appendix 3A. Table — Identity of Applicant/Requesting Party

Appendix 3B. Good and Services Manual

- Appendix 3B.1. Goods and Services Manual — User Guide
- Appendix 3B.2. CIPO's Additional Search Options

Appendix 3C. News Releases

- Appendix 3C.1. News Release — Canada Implementing System to Protect Names of Wines and Spirits
- Appendix 3C.2. News Release — Process for the Protection of Geographical Indications for Wines and Spirits in Canada

Appendix 3D. Information Notices

- Appendix 3D.1. Madrid Agreement and Protocol Concerning the International Registration of Marks

Appendix 3E. Practice Notices

- Appendix 3E.1. Three-Dimensional Marks
- Appendix 3E.2. Certification Marks — Compliance with Paragraph 30(f)
- Appendix 3E.3. Compliance with Paragraph 30(h) — Marks in a Special Form
- Appendix 3E.4. Compliance with Paragraph 30(a) of the Trade-marks Act — Pharmaceuticals
- Appendix 3E.5. Priority Claims
- Appendix 3E.6. Compliance with Paragraph 30(a) — Wine and Beer
- Appendix 3E.7. Persons
- Appendix 3E.8. Standard Characters
- Appendix 3E.9. Describing Colour
- Appendix 3E.10. Subsection 16(2) Claims — New Administrative Policy
- Appendix 3E.11. Nice Classification
- Appendix 3E.12. Standard Character Trademarks

- Appendix 3E.13. Non-traditional Trademarks
- Appendix 3F. Forms and Instructions**
- Appendix 3F.1. Request for Protection of a Geographical Indication for an Agricultural Product or Food
- Appendix 3F.2. Sample Form for Request for Protection of a Geographical Indication for an Agricultural Product or Food
- Appendix 3F.3. Request for Protection of a Geographical Indication for a Wine or Spirit
- Appendix 3F.4. Sample Form for Request for Protection of a Geographical Indication for a Wine or Spirit
- Appendix 3F.5. Process to Request that a Geographical Indication be Entered on Canada’s List of Geographical Indications
- Appendix 3F.6. Exclusionary Wording in Statements of Goods or Services
- Chapter 4. Correspondence and Filing Procedures
- Appendix 4A. Practice Notices**
- Appendix 4A.1. Correspondence Procedures
- Appendix 4A.2. Archived — Corrections
- Appendix 4A.3. Archived — Improving Data Quality — Trade-mark Applications
- Appendix 4A.4. Official Notice: Payment of Fees
- Appendix 4A.5. Identifying an Application
- Appendix 4A.6. List of Trademark Agents & Register of Patent Agents — FAQs
- Appendix 4A.7. Temporary Appointment of Agent or Associate Agent for One Communication
- Appendix 4A.8. Fee Payment Practice of the Canadian Intellectual Property Office (CIPO)
- Appendix 4A.9. Fee Payment: General Authorization to Charge a Deficiency
- Appendix 4A.10. Amendment with respect to Filing Notices
- Appendix 4A.11. Appeals of the Registrar’s Decisions: Service and Filing of Documents, Stays and Judgments
- Appendix 4A.12. Extensions of Time Due to Force Majeure for Priority and Renewal
- Appendix 4A.13. Fee Waivers and Refunds
- Appendix 4A.14. “Notification of Third Party Rights”
- Appendix 4A.15. Application fees

SUMMARY OF CONTENTS

Appendix 4A.16. Program Annex — Remission of a Portion of a Fee

Appendix 4B. Other CIPO Information

Appendix 4B.1. Methods of Payment Accepted

Appendix 4B.2. Fee Form

Appendix 4B.3. Application to Open a Deposit Account

Appendix 4B.4. Make the Switch to Electronic Trademark
Correspondence

Chapter 5. Application Processing: Steps and Timing

Appendix 5A. Trademarks Examination Manual

Appendix 5B. IP Roadmap — Your Path to Trademark
Registration

Appendix 5C. Practice Notices

Appendix 5C.1. Extensions of Time in Examination and to Respond
to a Section 44.1 Notice

Appendix 5C.2. Discontinuance of Courtesy Letters for Co-pending
Confusing Trade-marks

Appendix 5C.3. Divisional Applications and the Merger of
Registrations

Appendix 5C.4. Withdrawal of Advertisement of a Trademark
Application

Appendix 5C.5. Measures to Improve Timelines in Examination

Appendix 5C.6. Requests for Expedited Examination

PART III. EXAMINATION OBJECTIONS/OFFICE ACTIONS

Chapter 6. Amendments to Applications or Requests for
Publication

Appendix 6A. Practice Notices

Appendix 6A.1. Practice Notice — Amendments to Trade-mark
Applications Requested Prior to Examination

Chapter 7. Formality and Subject Matter Objections/Examiner's
Reports

Appendix 7A. Practice Notices

Appendix 7A.1. Form of Evidence in Examination

Volume 2

**PART III. EXAMINATION OBJECTIONS/OFFICE ACTIONS
(CONTINUED)**

Chapter 8. Objections Related to Personal Names, Surnames
and Signatures

Appendix 8A. Practice Notices

- Appendix 8A.1. Name or Surname—Paragraph 12(1)(a) of the *Trademarks Act*
- Chapter 9. Objections Related to “Descriptiveness” and “Misdescriptiveness”

Appendix 9A. Practice Notices

- Appendix 9A.1. Descriptiveness and Terms Such as .com, .ca, .fr, .uk & .us
- Appendix 9A.2. Paragraph 12(1)(b): “Sounded” Test Applied to Composite Marks Which Include Words That Are the Dominant Feature of the Mark
- Appendix 9A.3. Professional Designations and their initials — Paragraph 12 (1)(b) of the Trade-marks Act, published October 26, 2010
- Appendix 9A.4. Descriptiveness and abbreviations, acronyms or initials, published October 26, 2010
- Appendix 9A.5. Place of Origin — Paragraph 12(1)(b) of the *Trade-marks Act*
- Chapter 10. Objections Based on the Likelihood of Confusion
 - Appendix 10A. List of Geographical Indications
 - Appendix 10B. List of Cases Respecting Confusing Trademarks
 - Appendix 10C. List of Cases Respecting Non-Confusing Trademarks
- Chapter 11. Official Marks and Other Prohibited Marks
 - Appendix 11A. Request for Public Notice of an Official Mark Adopted and Used in Canada by a Public Authority

PART IV. ASSIGNMENT AND SECURITY INTERESTS

- Chapter 12. Assignments/Transfers and Security Interests
 - Appendix 12A. Assignment of Intellectual Property Agreement

Appendix 12B. Practice Notices

- Appendix 12B.1. Security Agreements
- Appendix 12B.2. Transfers and Change of Name
- Appendix 12B.3. No Time Limit to Respond to Correspondence from the Trademarks Office with Respect to Transfers
- Appendix 12B.4. License Agreements

SUMMARY OF CONTENTS

PART V. POST-ADVERTISEMENT MATTERS

Chapter 13. Registration Issuance

Appendix 13A. Practice Notices

Appendix 13A.1. Partial Declaration of Use — Wares/Services

Appendix 13A.2. Removal of Claims of Registration

PART VI. POST-REGISTRATION MATTERS

Chapter 14. Renewals and Voluntary Amendments to
Registration

Appendix 14A. Practice Notices

Appendix 14A.1. Changes Related to Section 45 [now Section 46]
Procedures

Appendix 14A.2. Changes Related to Transfers and Amendments

Appendix 14A.3. Cancellation

Appendix 14A.4. Form 6

Appendix 14A.5. Renewals

Appendix 14A.6. Correcting Obvious Errors on a Registration

Chapter 15. Introduction to Opposition Practice

Appendix 15A. Table — Material dates for assessing
Grounds of Opposition

Appendix 15B. Table — Deadlines for Stages and
Extensions of time in Opposition
Proceedings

Appendix 15C. *[Reserved]*

Appendix 15D. Practice and Procedure in Opposition
Proceedings — Case Law Digests

**Appendix 15E. Trademarks Opposition Board Practice Notices and
Other Communications**

Appendix 15E.1. Procedure Before the Trade-marks Opposition
Board as of October 1, 2007

Appendix 15E.1.50. Practice in Trade-mark Opposition Proceedings

Appendix 15E.2. Frequently Asked Questions — The New Practice
Notice in Opposition in effect as of March 31,
2009

Appendix 15E.3. Email communications of hearing correspondence

Appendix 15E.4. Trademarks Opposition Board Practice Notice —
Practice in Objection Proceedings under section
11.13 of the Trademarks Act in Appendices to
Chapter 15 (Introduction to Opposition Practice)

Appendix 15E.5. FAQ on opposition proceedings—The opponent

- Appendix 15E.5.50. FAQ on opposition proceedings—The applicant
- Appendix 15E.6. Opposition to Protocol applications and section 45 cancellation proceedings against Protocol registrations
- Appendix 15E.7. Practice in trademark opposition proceedings
- Appendix 15E.8. Practice Notice — Electronic evidence in opposition and section 45 proceedings
- Appendix 15E.9. Practice Notice — Divisional Applications in Opposition
- Appendix 15E.10. Practice Notice — the Amendment and Deletion of Use, Proposed Use, and Use and Registration Abroad Claims

PART VII. INTRODUCTION TO TRADEMARKS OPPOSITION BOARD PRACTICE

- Chapter 16. Introduction to Summary Cancellation Practice
 - Appendix 16A. Case Law Digests for Section 45 of the Trademarks Act — Loss of rights — Expungement — Grounds — Proof of use
 - Appendix 16B. Table — Extensions of time in Section 45 Proceedings

Appendix 16C. Practice Notices

- Appendix 16C.1. Practice in section 45 proceedings
- Appendix 16C.2. Navigating the Changes to Opposition and Section 45 Proceedings
- Appendix 16C.3. Practice in Section 45 Proceedings
- Appendix 16C.4. Section 45 Proceedings
- Appendix 16C.5. Section 44 — Proceedings — Explanatory Notes to Rules of Practice

PART VIII. FUNDAMENTALS OF TRADE-MARKS OPPOSITION PRACTICE

- Chapter 17. Trademarks Opposition Board — Overview of an Administrative Tribunal
 - Appendix 17A. Trademarks Opposition Board
 - Appendix 17B. About CIPO

- Chapter 18. Commencement of Opposition Proceedings

Appendix 18A. Practice Notices

- Appendix 18A.1. *[Reserved]*
- Appendix 18A.2. Starting an opposition proceeding and filing a statement of opposition

SUMMARY OF CONTENTS

- Appendix 18A.3. Opposition Deemed Withdrawn, Application Deemed Abandoned
- Chapter 19. Pleadings Practice and Procedure in Opposition Proceedings

Volume 3

Appendices

- Appendix A. Annotated Cross-Reference to *Trade-marks Act* and *Trade-marks Regulations*
- Appendix B. Consultations and Discussions**
- Appendix B1. Trademarks Regulations — Regulatory Impact Analysis Statement
- Appendix B2. Trademarks Regulations — Proposed Regulatory Text
- Appendix C. Trademarks Act and Regulations**
- Appendix C1. Trademarks Act
- Appendix C2. Trademarks Regulation - amended by SOR/2023-114 [To come into force January 1, 2024.]
- Appendix C3. Regulatory Impact Analysis Statement
- Appendix C4. Backgrounder: Canada's new Trademarks Regulations
- Appendix C5. Demystifying the transition Deep Dive of the Transitional Provisions
- Appendix C6. Draft — Guide to Transitional Provisions of Bill C-31
- Appendix D. The Singapore Treaty, the Madrid Protocol and the Nice Agreement, and a Modernized Canadian Trademark Regime — An Overview
- Appendix E. Summary of the Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks (1957)
- Appendix F. Using the Nice Classification in Canada — Questions and Answers
- Appendix G. *[Reserved]*
- Appendix H. NICE Classification—12th Edition, Version 2025
- Appendix I. Summary of the Singapore Treaty on the Law of Trademarks (2006)
- Appendix J. Summary of the Madrid Agreement Concerning the International Registration of Marks (1891) and the Protocol Relating to that Agreement (1989)
- Appendix K. Updates to the trademarks online tools

Appendix L.	Canada Border Services Agency Memorandum D19-4-3 Ottawa, September, 2023, Copyright, Trademarks and Geographical Indications
Appendix M.	Trademarks Guide
Appendix N.	Canada's Modernized Domestic Trademark Regime Explained
Appendix O.	The Madrid Protocol in Canada: A Summary of the General Principles
Appendix P.	International Trademarks under the Madrid Protocol
Appendix P.1.	Guide to the Madrid System International Registration of Marks Under the Madrid Protocol
Appendix Q.	International Trademarks under the Madrid System
Appendix R.	Madrid eFiling
Appendix S.	Trademarks and COVID-19
Appendix T.	Trademark Law Practice — Fees
Appendix PS.	Procedural Summaries
Appendix RL.	Related Legislation
Appendix TC.	Table of Concordance
Appendix WP.	Trade-Mark Law Words and Phrases

Table of Cases

Index