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FOX ON CANADIAN LAW OF TRADEMARKS AND UNFAIR COMPETITION

Gill

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Fox on the Canadian Law of Trademarks and Unfair Competition, 4th edition remains the authoritative text for trademark lawyers and agents in Canada. It provides intellectual property law practitioners with the most comprehensive coverage of trademark issues available today.

This release features the addition of the November 2023 version of the Regulations under the Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks in Appendix B. Trademarks Act. This release also features updates to the Trademarks Regulations – Amended by SOR/2023-114 in Appendix C. Trademarks Regulations. This release also features updates to Appendix G. Trademark Practice Notices including updated versions of Practice in Trademark Opposition, and Practice in Section 45 Proceedings. This release also features updates to Appendix PS. Procedural Summaries including updates to I. Trademarks Opposition Proceedings – Summary of Procedure, and to II. Section 45 Proceedings under the Trademarks Act – Summary of Procedure, both of which include changes which became effective on December 1, 2023.

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Highlights

Regulations under the Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks - The World Intellectual Property Office has introduced amendments to the regulations which govern the Madrid Protocol which come into effect in November 2023 that clarify the response deadlines for provisional refusals and introduce a two month minimum time limit to respond to a provisional refusal. When a provisional refusal is issued by a country designated in an International Application, WIPO will clearly indicate the relevant response period in their cover letter sent to the owner of the International Application accompanying the refusal. Details of the response period will be also published online in the WIPO Gazette. An exception to this may occur when electronic transmission of the refusal to the trademark owner fails and the response period is calculated from when the owner receives the refusal. In this event, WIPO will send the notification of provisional refusal via registered mail without the response period being indicated. There will be a new minimum period of 2 months or 60 days for the owner of an International Application to respond to a provisional refusal. Countries which are party to the Madrid Protocol will have until February 1, 2025 to implement the minimum response requirement, though this can be extended upon request by a country with no ultimate deadline. Where a provisional refusal is based on the citation of prior rights and/or an opposition against the designation, the local IP Office of the country concerned is obliged to provide the address of the owner of the prior rights or the opponent, and/or their representative, where possible, although countries will now be exempt from this requirement where this is not possible. Where the IP Office of a country does not indicate the start and end dates for responding to a provisional refusal, the refusal will not be accepted. WIPO will notify both the local IP Office concerned and the owner of the International Application. The local IP Office will be given a two-month period by which to amend the refusal in order to retain the original refusal date. Alternatively, the local IP Office may issue a new corrected refusal. The same will apply to notifications of provisional refusals that do not abide by the minimum time limit for response from February 1, 2025.

Trademarks Opposition Proceedings – Summary of Procedure – Cross-Examination - Cross Examination Orders – Effects on Applicant’s Evidence - The Registrar will now only grant an extension of time of two months to the applicant to file evidence, and if cross-examination is not completed within time, the two-month extension will automatically reduce to one month. The Registrar will only grant an extension of time of one month from the completion of cross-examination to file and serve reply evidence, which is applicable regardless of whether the opponent completes the cross-examination or not.

Section 45 Proceedings under the Trademarks Act – Summary of Procedure – Extension of Time – Exceptional Circumstances - Requests for an extension beyond the benchmark period in section 45 proceedings should be clearly marked “Exceptional circumstances/extension request”, and the requesting party must include the following information: the length of the delay sought; and sufficient details as to the timeline and steps planned to meet the proposed extended deadline. A new practice in both section 45 proceeding and in trademark opposition proceedings will include a new basis upon which a party can request an exceptional circumstances extension. An exceptional circumstances exception may be granted if the party is able to demonstrate a consistent overall pattern of reasonable effort, promptness, and diligence in its efforts to meet an upcoming deadline. The requesting party must provide the following information: an explanation as to why it will not be possible to meet the upcoming deadline at issue; and, the actions taken prior to the upcoming deadline to meet it.

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