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Trade-Mark registration process

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"Gems" from the Trade- Marks Journal

LA ROULOTTE À T'IGA

In association with:
"Retail grocery stores".

Reg. No.: 522,665

Owner: IGA CANADA LIMITED

Trade-mark examination by CIPO: Important Shift in Practice Rules

You have just filed an application to register the mark *Andromeda* in connection with a clothing line, based on use since June 2000. Your client was in a hurry because he has just discovered that a competitor filed, 3 months ago, an application to register the mark *Andro Medae*, also in connection with clothing, but based on proposed use. You are thinking that the assigned trade-mark Examiner will intervene and refuse the competitor's proposed mark in favour of your client's because of confusion and your client's prior use. And until recently, you would have been right. But not any longer.

The new rule is that, the Examiner will allow the proposed mark, notwithstanding your prior right. To defend your client's position you will be forced to file an opposition and establish your entitlement. In other words, your right is the same, it's just that the Examination Board won't step in for you. So, the competitor's mark will be allowed, and if you fail to monitor its progress and file for opposition within 60 days, the competitor will secure registration.

The Case

This change in practice has come about pursuant to the Federal Court of Appeal decision of *P.G. c. Effigi Inc.* (2005) F.C.A. 172, rendered on May 10th 2005. The Court determined that section 37 of the Trade-marks Act, and specifically section 37(1)c), does not allow the Registrar to discriminate between pending applications on the grounds of an earlier date of use or making known. According to the Court, if the legislator had meant the Registrar to take this into account he would have expressed it clearly.

The Trade-marks Office has changed its practice rule to reflect this finding. From now on, trade-mark applications will always be examined in chronological order of their filing date or convention priority date. No longer can an applicant expect to be given preference over another earlier filed application on the basis of an earlier alleged date of use.

The Consequence

As for our client and his *Andromeda* mark, he will have to monitor the competing application carefully in order to eventually oppose it. He will soon receive a notice of refusal from the Registrar of Trade-marks. He will then

have to request countless extensions of time to respond to the notice of refusal until the opposition is settled, after which, assuming he succeeds, will file written arguments to support his application.

Before the change in office policy, the situation would have been reversed, and the competing mark would have been forced to take the offensive and oppose, hoping that our client's evidence was insufficient.

Conclusion

Unlike many other countries where the filing date is the only date to consider, prior use of a mark is still a very relevant in establishing entitlement in Canada. However, because of the new practice rule, the race to obtaining an early filing date is more important than ever.

The information in this bulletin does not constitute a legal opinion. IPC Intellectual Property Centre is a Division of C.R.A.C. Ltd.
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