

TRADEMARK AGENT EXAM 2018
PAPER A
Total Marks: 160

QUESTION 1 (4 marks)

Your client has applied to register TURTLES for kneepads for gardening, and has received an Office Action citing the prohibited mark TURTLES in the name of the University of the Middle of Nowhere in northern Alberta. Based on a brief Internet search you discover that TURTLES is associated with the university's chess team.

- a) Cite the two provisions of the *Trade-marks Act* which form the basis on which the Examiner considers the TURTLES mark unregistrable. **(2 marks)**
- b) What action can your client take to try to overcome the objection? **(1 mark)** Cite the relevant provision of the *Trade-marks Act*. **(1 mark)**

QUESTION 2 (12 marks)

Your client, a U.S. company by the name of Honey Bee Sweet Inc., has asked you to prepare and file a Canadian trademark application for its mark HONEY BEE SWEET covering "honey, natural sweeteners, biscuits, plush toys, key chains, mugs and stickers". Honey Bee Sweet Inc. has been using the mark in Canada for honey since January 2, 2017, and its predecessor-in-title, Honey Buzz Ltd., used the mark in Canada for honey from April 2007 until January 2, 2017. Your client holds a U.S. registration for HONEY BEE SWEET, registered in the name of Honey Buzz Ltd. for "honey, natural sweeteners, biscuits, plush toys, key chains, mugs and stickers" and it has used the HONEY BEE SWEET mark in the United States for "honey, mugs and stickers" and in Australia for "biscuits". List the three filing bases for the Canadian application, including the specific information that would need to be included in the application for each filing basis **(8 marks)** and identify the goods to be covered by each filing basis **(4 marks)**.

QUESTION 3 (4 marks)

List the three conditions that must be met for a communication between an agent and a client to be considered privileged in the same way as a communication that is subject to solicitor-client privilege. **(3 marks)** Cite the relevant provision of the *Trade-marks Act* for your answer. **(1 mark)**

QUESTION 4 (4 marks)

True or False? **(1 mark)** A trademark application can be amended after filing to include a priority claim. In one sentence explain why or why not. **(1 mark)** Cite the relevant provision of the *Trade-marks Act* and the relevant authority for your answer. **(2 marks)**

QUESTION 5 (4 marks)

Your client is a multinational corporation named Funzo Corp. that manufactures a wide variety of goods from industrial robots to home electronics and household appliances. The company has numerous wholly owned subsidiaries, including Funzo Robotics Inc., Funzo Electronics Ltd. and Funzo Housewares Ltd. that focus on particular product lines. You regularly file Canadian

trademark applications in the name of each of these subsidiaries, always taking instructions from the same in-house lawyer at Funzo Corp.

About a year ago you filed application no. 1,456,789 on behalf of Funzo Electronics Ltd. for the trademark FUNZO TALK in association with voice recognition software for mobile phones. You recently received an Examiner's report regarding this application in which the Examiner indicates that the mark is not registrable because it is confusing with registration no. TMA987,654 for the trademark FUNZO WASH in association with voice activated washing machines owned by Funzo Housewares Ltd. Your firm is representative for service for registration TMA987,654.

- a) Does this Examiner's report raise a conflict of interest in view of the fact that your firm is representative for service for the cited registration? Yes or No? **(1 mark)** In one sentence explain why or why not. **(1 mark)**
- b) Identify two options for the client to try to overcome this objection. **(2 marks – Only the first two options will be marked)**

QUESTION 6 (2 marks)

A university based in the United States, with no campus in Canada, can obtain the protection of a section 9 mark in Canada. True or False? **(1 mark)** Cite the relevant provision of the *Trade-marks Act* to support your answer. **(1 mark)**

QUESTION 7 (3 marks)

Your client would like to file a Canadian trademark application for KAUGUMMI for chewing gum, plush toys, and children's multiple activity toys. KAUGUMMI is German for "bubble gum". The mark is not yet in use anywhere. Assuming there are no confusingly similar marks on the Canadian Trademarks Database, briefly state whether the trademark is registrable? **(2 marks)** Cite the relevant provision of the *Trade-marks Act*. **(1 mark)**

QUESTION 8 (2 marks)

An application for registration of a trademark has been filed with goods and services grouped according to Nice Classification. The Examiner is of the view that the goods and services have been incorrectly classified. Other than the incorrect classification, there are no substantive or technical issues with the application. In one sentence, explain what the Examiner will do. **(1 mark)** Cite the relevant authority for your answer. **(1 mark)**

QUESTION 9 (3 marks)

Your client has an existing Canadian registration for the trademark HAPPYBOUCHE for lipstick in the name of HappyBouche Ltd. doing business as HappyBouche Co. Your client then instructs you to file for HAPPYBOUCHE ETCETERA for foundation makeup, blush, and mascara in the name of HappyBouche Ltd. trading as HappyBouche. Assuming there are no other technical or substantive issues in connection with the application for HAPPYBOUCHE ETCETERA, what will the Examiner do with these two marks? **(2 marks)** Cite the relevant provision of the *Trade-marks Act*. **(1 mark)**

QUESTION 10 (1 mark)

What is the only factor to be considered when assessing whether an applied for mark so nearly resembles as to be likely to be mistaken for an official mark? **(1 mark)**

QUESTION 11 (6 marks)

Which of the following two trademark applications, A or B, both covering the same goods, has the earlier entitlement date at the examination stage, and for which goods? **(2 marks)** Briefly explain your answer. **(2 marks)** Cite the relevant authority and/or the relevant section of the *Trade-marks Act*. **(2 marks)**

Application A (No. 1,636,212)

Filed March 5, 2018, based on:

- Proposed use in Canada for: (1) “Clothing namely t-shirts, sweaters, pants, dresses”;
- Use in Canada since February 26, 2002 for: (2) “computer software, namely database software, word processing software”; and
- Section 16(2) of the *Trade-marks Act* based on use in the United States and corresponding United States Application No. 86/736,677 filed June 27, 2017 for: (1) “Clothing namely t-shirts, sweaters, pants, dresses”.

Application B (No. 1,645,363)

Filed March 15, 2018:

- claiming Convention priority based on United States Application No. 86/794,767 filed October 5, 2017 for: (1) “Clothing namely t-shirts, sweaters, pants, dresses”; and
- based on proposed use in Canada for: (1) “Clothing namely t-shirts, sweaters, pants, dresses”; (2) “computer software, namely database software, word processing software”.

QUESTION 12 (2 marks)

You are reviewing an Examiner’s report issued in connection with a client’s application. Your firm is listed as agent and representative for service for one of the marks alleged by the Examiner to be confusingly similar to the client’s mark. You are of the opinion that the marks are clearly so dissimilar that there is absolutely no possibility of a likelihood of confusion and that the Examiner obviously raised this mark in error. Can you comment on the impact the identified mark will have on the registrability of the subject mark? Yes or No. **(1 mark)**. Provide a brief explanation in support of your answer. **(1 mark)**

QUESTION 13 (5 marks)

Your client, Musical Alarms Inc., is seeking to register a five-note sound as their trademark. Musical Alarms Inc. advises that the five-note sound is distinct to their alarm system and is used to distinguish their goods, namely car alarms, from the car alarms of other traders.

List four specific requirements that must be included in an application for the registration of a sound mark. **(4 marks)** Cite the relevant authority for your answer. **(1 mark)**

QUESTION 14 (1 mark)

What is the leading case outlining the requirements for the defined standard in an application for registration of a certification mark? **(1 mark)**

QUESTION 15 (2 marks)

True or False. The fee for recording a change of name that results from a merger of two companies is \$100. **(1 mark)** Cite the relevant authority for your answer. **(1 mark)**

QUESTION 16 (3 marks)

Play Time Inc., an innovative Canadian toy company, has developed a new proprietary and inventive colour changing, scented, all natural toy modelling dough for children. Play Time Inc. decided to name its modelling dough DOUGH TIME as a unique play on the company name. Play Time Inc. has also developed a unique packaging for its toy modelling dough that also functions as a mold to create shapes. Play Time Inc. is preparing to introduce its DOUGH TIME modelling dough at an upcoming toy industry trade show in January 2019. Play Time Inc. is concerned that its competitors will try to copy its new toy modelling dough formula, which uses only plant-based ingredients, is scented, and changes colour when it is manipulated by a child as they play with the dough.

In addition to a trademark application for the word mark DOUGH TIME, list three other types of intellectual property protection that Play Time Inc. may wish to consider for its new product? **(3 marks)**

QUESTION 17 (5 marks)

Your client, Mary Jones, has asked you to file an application to register the mark JONES WOOD PRODUCTS for figurines, kitchen cabinets, and boxes, all of the aforementioned made of wood. From the examination/Trademarks Office perspective, is the mark inherently registrable? Yes or No? **(1 mark)** Briefly explain why or why not. **(2 marks)** Cite the two relevant provisions of the *Trade-marks Act*. **(2 marks)**

QUESTION 18 (6 marks)

List six examples of what the Trademarks Office might consider exceptional circumstances justifying an extension of time beyond the twelve-month period from the initial date of the examiner's report. **(6 marks)**

QUESTION 19 (8 marks)

Match the case name with the applicable legal principle. You have been provided with more legal principles than cases. Only one case should be paired with one principle. If you provide multiple principles for a case, only the first legal principle given will be marked. **(1 mark for each correct answer for a maximum of 8 marks)**

Case Name	Principle
A. <i>Marineland Inc. v. Marine Wonderland and Animal Park</i>	1. In assessing the likelihood of confusion between trademarks,

Case Name	Principle
<p><i>Ltd.</i> (1974), 16 C.P.R. (2d) 97 (FC).</p> <p>Trademark: MARINELAND</p>	<p>Examiners must consider the possibility of confusion between those marks in either or both of Canada's official languages.</p>
<p>B. <i>British Drug Houses Ltd. v. Battle Pharmaceuticals</i> (1944), 4 C.P.R. 48 (Ex. Ct.).</p> <p>Trademark: MULTIVIMS</p>	<p>2. In Section 12(1)(b) of the <i>Trade-marks Act</i>, the word "clearly" is not used in the sense of "accurately", but of "easy to understand... evident, plain".</p>
<p>C. <i>Standard Coil Products (Canada) Ltd. v. Standard Radio Corp.</i> (1971), 1 C.P.R. (2d) 155 (FC).</p> <p>Trademark: STANDARD</p>	<p>3. In assessing whether a trademark is a geographic name, examiners may have regard to the names of continents, countries, provinces, states, regions, cities, neighbourhoods, and streets.</p>
<p>D. <i>Thorold Concrete Products Ltd. v. Registrar of Trade Marks</i> (1961), 37 C.P.R. 166 (Ex. Ct.).</p> <p>Trademark: THOR-O-MIX</p>	<p>4. Use in Canada in association with services requires that services advertised in Canada must be performed in Canada or be available to be performed in Canada.</p>
<p>E. <i>Scott Paper Co. v. Beghin-Say S.A.</i> (1985), 5 C.P.R. (3d) 225 (FC).</p> <p>Trademark: MOLTONE</p>	<p>5. Just because a particular combination of words does not appear in any dictionary does not mean that the mark is not clearly descriptive or deceptively misdescriptive. Where each portion of the mark has a well-known meaning in French or English, the resultant combination may be contrary to Section 12(1)(b) of the <i>Trade-marks Act</i>.</p>
<p>F. <i>Big Sisters Assn. of Ontario v. Big Brothers of Canada</i> (1997), 75 C.P.R. (3d) 177 (FC).</p> <p>Trademark: BIG BROTHERS AND SISTERS OF CANADA</p>	<p>6. During examination, the Registrar will not consider dates of first use or making known as relevant considerations under Section 37(1)(c) of the <i>Trade-marks Act</i>.</p>
<p>G. <i>Oshawa Group Ltd. v. Registrar of Trade Marks</i> (1980), 46 C.P.R. (2d) 145 (FC).</p> <p>Trademarks: HYPER-VALUE and HYPER-FORMIDABLE</p>	<p>7. Where a trademark contains both elements that fall within the definition of a distinguishing guise and elements that do not fall within the definition of a distinguishing guise, the provisions of the <i>Trade-marks Act</i> concerning distinguishing guises are still considered to apply.</p>
<p>H. <i>Lum v. Dr. Coby Cragg Inc.</i> (2015), 134 C.P.R. (4th) 409</p>	<p>8. The two-part test to evaluate public authority status for official marks is</p>

Case Name	Principle
(FCA). Trademark: OCEAN PARK	made up of the following elements: <ul style="list-style-type: none"> • A significant degree of control must be exercised by the appropriate government over the activities of the body; and • The activities of the body must benefit the public.
	9. The onus on a person contending that a trademark which is descriptive or laudatory of their goods has come to actually distinguish those goods is a heavy one.
	10. In assessing confusion, it is not the correct approach to lay the two marks side by side and make a careful comparison with a view to observing the differences between them. They should be considered from the perspective of a person who has only a general recollection of the earlier mark and then sees the later mark by itself.
	11. Resemblance between an official mark and a trademark is not to be determined based on a “straight comparison” between the marks.

QUESTION 20 (2 marks)

Briefly explain what CETA is. (2 marks)

QUESTION 21 (4 marks)

In the initial Examiner’s report dated November 15, 2017, the Examiner requested a certified copy of the corresponding United States registration to complete the claim to Section 16(2) of the *Trade-marks Act*. The response to the Examiner’s report was initially due May 15, 2018. However, your client advised that the United States application would still be pending by the deadline. An initial extension of time was requested and granted until November 15, 2018. Your client has now advised that the corresponding U.S. application will not have issued to registration by the extended response deadline.

Can your client obtain a further extension of time to respond to the Examiner’s report and, if so, how long? (2 marks) Briefly explain your answer (1 mark) and cite the relevant authority. (1 mark)

QUESTION 22 (2 marks)

Your client’s trademark application has been allowed and the deadline for paying the registration fee is Monday, July 1, 2018. On the morning of Tuesday, July 2, 2018, you receive

instructions to pay the registration fee. Is it too late to pay the registration fee? Yes or No. **(1 mark)** Cite the relevant provision of the *Trade-marks Act* in support of your answer. **(1 mark)**

QUESTION 23 (2 marks)

True or False. Correspondence delivered through Canada Post's Xpresspost™ service to CIPO on a day on which CIPO is open for business is deemed to be delivered on the day indicated on the mailing receipt provided by Canada Post. **(1 mark)** Cite the relevant provision of the *Trade-marks Regulations* in support of your answer. **(1 mark)**

QUESTION 24 (10 marks)

- a) On October 17, 2018, you filed an application on behalf of a Canadian applicant for the registration of a trademark based on the applicant's proposed use of the mark in Canada. It is now November 17, 2018, and the applicant informs you that they had begun using the mark in Canada at least a year ago. Briefly explain what actions you would recommend to the applicant **(3 marks)** and why you recommend such actions. **(2 marks)** Cite the relevant provision of the *Trade-marks Regulations* in support of your answer **(1 mark)**.
- b) On October 17, 2018, you filed an application for the registration of a trademark based on your client's proposed use of the mark in Canada. A few weeks after filing the application you discover that an application for the registration of a confusingly similar mark was filed by a third party on October 10, 2018. This application was also filed on the basis of the applicant's proposed use of the mark in Canada. Your client, a company whose head office is in Paris, France, informs you that it has a corresponding European Union Trade Mark (EUTM) application and has used the mark in France for several years. The corresponding EUTM application was filed September 1, 2018, and is your client's only other application for this particular mark. Briefly explain what actions you would recommend to your client. **(2 marks)** Cite the relevant provisions of the *Trade-marks Act* for your answer. **(2 marks)**

QUESTION 25 (5 marks)

List four items that must be provided to the Registrar to obtain a filing date for an application to register a trademark comprising the design of a dog based on proposed use in Canada. **(4 marks)** Cite the relevant provision of the *Trade-marks Regulations* in support of your answer. **(1 mark)**

QUESTION 26 (3 marks)

Assuming the mark is in use somewhere in the world, can a Canadian trademark application be filed based on use and registration abroad, based on an application or registration applied for or registered in the following?

- a) Benelux. Yes or No? **(1 mark)**
- b) World Intellectual Property Office (WIPO). Yes or No? **(1 mark)**
- c) European Union Intellectual Property Office (EUIPO). Yes or No? **(1 mark)**

QUESTION 27 (3 marks)

Your client, Betty's Fresh Fruit & Veggies Inc., would like to file an application for the trademark POSTAL PRODUCTS. Betty's Fruit & Veggies Inc. advises that they are currently using the mark in Canada and have done so since April 20, 2002 for the following services: "Retail sale of fresh fruits and vegetables".

Putting aside any consideration of confusion, what is the most likely objection that the Trademarks Office will raise in connection with this mark? **(1 mark)** Briefly explain your answer. **(1 mark)** Cite the relevant provision of the *Trade-marks Act*. **(1 mark)**

QUESTION 28 (19 marks)

On March 5, 2018, you filed an application for the registration of the mark PESCE on behalf of Marco Pesce Fashion Corp., the company created by Marco Pesce, an up and coming Italian fashion designer. The application is based on use of the mark in Canada in association with clothing, jewellery and perfumes, since at least as early as January 2013, as well as use and registration in Italy for these same goods.

The application has been examined and the Examiner has issued the following Office Action:

Your Firm
227 Main Street
Ottawa, Ontario K2E 2P6
Attention: Mr. Agent

November 5, 2018
Your File
42685-0125
Our File
1899504

Re: Trademark: PESCE
Applicant: Marco Pesce Fashion Corp.

This Examiner's report concerns the above-identified application. To avoid abandonment proceedings, a proper response must be received by this office by **May 5, 2019**. All correspondence respecting this application must indicate the file number.

The mark which is the subject of this application is considered to falsely suggest a connection to a living individual, namely the Italian fashion designer, Marco Pesce, the adoption of which is prohibited by paragraph 9(1)(k) of the *Trade-marks Act*. Therefore, in view of the provisions of paragraph 12(1)(e) of the *Act* this mark does not appear to be registrable.

In addition to the foregoing, the mark which is the subject of this application is considered to be primarily merely the surname of an individual who is living or who has died within the preceding thirty years. In this respect, please note that a search on Canada411.ca has yielded 156 search results for the surname PESCE. In view of the provisions of paragraph 12(1)(a) of the *Trade-marks Act*, this mark does not appear to be registrable.

Any comments you may wish to submit will receive consideration.

If the applicant has any specific questions in respect of this office action, please contact the assigned examiner.

Yours truly,

Anita Charles
Examination Section

- a) List the best option for responding to the objection to the registration of the mark pursuant to Sections 9(1)(k) and 12(1)(e) of the *Trade-marks Act*. **(1 mark)**
- b) List three available options for responding to the surname objection pursuant to Section 12(1)(a) of the *Trade-marks Act*. **(3 marks)** Note that only the first three answers given will be marked. Cite relevant provisions of the *Trade-marks Act* in support of your answer. **(2 marks)**
- c) You are now in receipt of a signed consent from Marco Pesce to Marco Pesce Fashion Corp. authorizing the latter's use and registration of the mark PESCE in association with clothing, jewellery and perfumes. Your research reveals that PESCE is the Italian word for "fish" and that 5% of the Canadian population (1.8 Million people) speak Italian.

Draft a response to the Office Action, addressing all the issues raised by the Examiner.
(A total of 6 marks will be given, including 1 mark for the clarity of the response)

- d) The Examiner has rejected your arguments and has maintained the objection to the registration of the mark pursuant to Section 12(1)(a) of the *Trade-marks Act*. You recommend making a claim to the benefit of Section 12(2) of the Act. In point form, list the most important information and/or documents you will require to prepare an affidavit in support of the claim. **(7 marks)**

QUESTION 29 (2 marks)

Identify the two most important differences between an affidavit in support of a claim of acquired distinctiveness under Section 12(2) of the *Trade-marks Act* and an affidavit in support of a claim of distinctive character under Section 14 of the *Trade-marks Act*. **(2 marks)**

QUESTION 30 (12 marks)

Your client is interested in filing a Canadian application for the trademark HAPPY WAY. The mark is not yet in use in Canada, and will be filed on the basis of proposed use in Canada under Section 16(3) of the *Trade-marks Act* for the following goods and services:

Goods:

- apples;
- juice;
- jam;
- cider;
- t-shirts; and
- mugs;

Services:

- retail sale of apples, juice, jam, cider, t-shirts, and mugs; and

- brewery services.

Your client has asked you to arrange for a search of the Trademarks Register before filing an application to register the HAPPY WAY trademark for the goods and services of interest.

For each of the marks identified by the search, and set out below:

- Indicate whether the mark is likely to pose an obstacle to registration of the HAPPY WAY mark with a “yes” or “no” answer. **(1 mark each)** **Note: “yes” means the mark is likely to pose an obstacle to registration, and “no” means the mark is not likely to pose an obstacle to registration;** and
- Briefly (point form is acceptable) provide a valid explanation to support your opinion. **(1 mark each)** Please formulate your opinions from an examination/Trademarks Office perspective, not from an opposition perspective.

Note: No marks will be given for a “yes” or “no” answer unless a valid supporting explanation is given.

TRADEMARK	REG. / APPL'N NO.	GOODS / SERVICES
(a) CHEERFUL STREET	TMA761,982	(1) Clothing, namely sweaters, t-shirts, pants and skirts; (2) jewelry; (3) smartphones, lap tops, operating software; (4) fresh fruits and vegetables; (5) live plants, namely fruit trees (6) handbags, suitcases; (6) glassware, cups, mugs, vases. (1) Department store services and an online department store; (2) computer programming services for others; (3) operating a gardening centre.
(b) HAPPY WEIGH	TMA778,349	(1) Retail sale of books in the field of nutrition; (2) catering services.
(c) HAPIE WAIE	1,854,633 (filed May 20, 2018)	(1) fruit and vegetable juice, fruit and vegetable sauces; (2) mixed alcoholic beverages containing fruits; (3) promotional items namely mugs and t-shirts. (1) retail and online sale of the above goods; (2) operating a website featuring information on mixed drink recipes.
(d) WAY HAPPY	TMA623,555	(1) Clothing, namely sweaters, t-shirts, pants and skirts; (2) fresh fruits and vegetables; (3) glassware, cups, mugs, vases. (1) Retail sale of foods; (2) operating a gardening centre.
(e) FINDING A HAPPIER WAY TO TRAVEL	TMA655,875	(1) promotional items, namely t-shirts, jams, bottled water and travel mugs.

TRADEMARK	REG. / APPL'N NO.	GOODS / SERVICES
		(1) Travel agent services; (2) operating a website about travelling.
(f) ☺ Way	TMA787,487	(1) Clothing, namely sweaters, t-shirts, pants and skirts; (2) cider; (3) fresh fruits and vegetables; jams and fruit jellies; (4) glassware, cups, mugs, vases. (1) Sale of alcoholic beverages; (2) retail services, namely sale of clothing, fresh fruits and vegetables; jams and fruit jellies; glassware, cups, mugs, vases.

QUESTION 31 (10 marks)

The search firm that conducted the search for the HAPPY WAY trademark has come back to you and advised that the two marks, below, were inadvertently omitted from the search report.

For each of the marks identified below:

- Indicate whether the mark is likely to pose an obstacle to registration of the HAPPY WAY mark with a “yes” or “no” answer. **(1 mark each)** **Note: “yes” means the mark is likely to pose an obstacle to registration, and “no” means the mark is not likely to pose an obstacle to registration;**
- Briefly (point form is acceptable) provide a valid explanation to support your opinion, including an explanation of the meaning and impact of the letters preceding the registration numbers; **(2 marks each)**
- Cite the relevant provision(s) of the *Trade-marks Act*. **(2 marks each)**

Note: No marks will be given for a “yes” or “no” answer unless a valid supporting explanation is given.

TRADEMARK	REG. / APPL'N NO.	GOODS / SERVICES
(a) HAPPY WAY	PBRA2255	Apples.
(b) Happy Way	NFLD04,423	(1) alcoholic beverages; clothing; food (1) Sale of alcoholic beverages; sale of clothing

QUESTION 32 (8 marks)

- Your client informs you that it has purchased a portion of the intellectual property assets of a third party, including some of its trademark registrations. In point form, list the requirements for recording the transfer of ownership against the trademark registrations. **(3 marks)** State the relevant provisions of the *Trade-marks Act* and *Trade-marks Regulations* in support of your answer. **(3 marks)**

- b) Prior to filing a request to record the assignment, you discover that one of the marks listed in the assignment document is associated with a mark that is not listed in the assignment document. Will the Registrar record the assignment? Yes or No. **(1 mark)**
Cite the relevant provision of the *Trade-marks Act* in support of your answer. **(1 mark)**

QUESTION 33 (1 mark)

On July 27, 2018, you filed an application on behalf of your client, claiming priority based on an earlier filed application, which your client informed you was filed on March 7, 2018. Your client informs you on October 11, 2018 that the earlier filed application was actually filed on March 2, 2018 and not March 7, 2018. The application has not yet been examined. Can the application be amended to correct the error? Yes or No? **(1 mark)**

END

TRADEMARK AGENT EXAM 2018
PAPER A
Total Marks: 160

QUESTION 1 (4 marks)

Your client has applied to register TURTLES for kneepads for gardening, and has received an Office Action citing the prohibited mark TURTLES in the name of the University of the Middle of Nowhere in northern Alberta. Based on a brief Internet search TURTLES is associated with the university's chess team.

- a) Cite the two provisions of the *Trade-marks Act* which form the basis on which the Examiner considers the TURTLES mark unregistrable. **(2 marks)**

Answer:

- Sections 12(1)(e) **(1 mark)** and 9(1)(n)(ii) **(1 mark)** of the *Trade-marks Act*.

- b) What action can your client take to try to overcome the objection? **(1 mark)** Cite the relevant provision of the *Trade-marks Act*. **(1 mark)**

Answer:

- Seek consent from the university to registration and use of the TURTLES trademark. **(1 mark)**
- Section 9(2) of the *Trade-marks Act*. **(1 mark)**

QUESTION 2 (12 marks)

Your client, a U.S. company by the name of Honey Bee Sweet Inc., has asked you to prepare and file a Canadian trademark application for its mark HONEY BEE SWEET covering "honey, natural sweeteners, biscuits, plush toys, key chains, mugs and stickers". Honey Bee Sweet Inc. has been using the mark in Canada for honey since January 2, 2017, and its predecessor-in-title, Honey Buzz Ltd., used the mark in Canada for honey from April 2007 until January 2, 2017. Your client holds a U.S. registration for HONEY BEE SWEET, registered in the name of Honey Buzz Ltd. for "honey, natural sweeteners, biscuits, plush toys, key chains, mugs and stickers" and it has used the HONEY BEE SWEET mark in the United States for "honey, mugs and stickers" and in Australia for "biscuits". List the three filing bases for the Canadian application, including the specific information that would need to be included in the application for each filing basis **(8 marks)** and identify the goods to be covered by each filing basis **(4 marks)**.

Answer:

- Use in Canada since at least as early as April 2007 by the applicant or the applicant's predecessor-in-title, Honey Buzz Ltd. **(3 marks)** for "honey". **(1 mark)**
- Proposed use in Canada **(1 mark)** for "natural sweeteners, biscuits, plush toys, key chains, mugs and stickers". **(1 mark)**
- Registration and use in the U.S. by the applicant's predecessor-in-title, Honey Buzz Ltd. **(2 marks)** for "honey, mugs and stickers". **(1 mark)**
- Registration in the U.S. and use in Australia by the applicant's predecessor-in-title, Honey Buzz Ltd. **(2 marks)** for "biscuits". **(1 mark)**

QUESTION 3 (4 marks)

List the three conditions that must be met for a communication to be considered privileged in the same way as a communication that is subject to solicitor-client privilege. **(3 marks)** Cite the relevant provision of the *Trade-marks Act* for your answer. **(1 mark)**

Answer:

- The communication is between an individual whose name is included on the list of trade-mark agents and that individual's client. **(1 mark)**
- The communication is intended to be confidential. **(1 mark)**
- The communication 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). **(1 mark)**
- Section 51.13(1) *Trade-marks Act*. **(1 mark)**

QUESTION 4 (4 marks)

True or False? **(1 mark)** A trademark application can be amended after filing to include a priority claim. In one sentence explain why or why not. **(1 mark)** Cite the relevant provision of the *Trade-marks Act* and the relevant authority for your answer. **(2 marks)**

Answer:

- True. **(1 mark)**
 - The application can be amended to include a claim of priority, provided the amendment is made within the six-month period following the filing of the earliest filed application. **(1 mark)**
 - Section 34 of the *Trade-marks Act*. **(1 mark)** Trademarks Examination Manual Section II.7.3.3 OR Practice Notice dated September 2, 2010, "Priority Claims". **(1 mark)**
- [Note: Date and title of Practice Notice and/or particular section of the Examination Manual not required to receive the mark.]**

QUESTION 5 (4 marks)

Your client is a multinational corporation named Funzo Corp. that manufactures a wide variety of goods from industrial robots to home electronics and household appliances. The company has numerous wholly owned subsidiaries, including Funzo Robotics Inc., Funzo Electronics Ltd. and Funzo Housewares Ltd. that focus on particular product lines. You regularly file Canadian trademark applications in the name of each of these subsidiaries, always taking instructions from the same in-house lawyer at Funzo Corp.

About a year ago you filed application no. 1,456,789 on behalf of Funzo Electronics Ltd. for the trademark FUNZO TALK in association with voice recognition software for mobile phones. You recently received an Examiner's report regarding this application in which the Examiner indicates that the mark is not registrable because it is confusing with registration no. TMA987,654 for the trademark FUNZO WASH in association with voice activated washing machines owned by Funzo Housewares Ltd. Your firm is representative for service for registration TMA987,654.

- a) Does this Examiner's report raise a conflict of interest in view of the fact that your firm is representative for service for the cited registration? Yes or No? **(1 mark)** In one sentence explain why or why not. **(1 mark)**

Answer:

- No. **(1 mark)**
- No conflict of interest because you are taking instructions for both companies from the same instructing principal OR no conflict of interest because the parties have common ownership and are not adverse in interest. **(1 mark)**

- b) Identify two options for the client to try to overcome this objection. **(2 marks – Only the first two options will be marked)**

Answer: [Note: any of the below to a maximum of 2 marks.]

- Assign application no. 1,456,789 to Funzo Housewares Ltd. **(1 mark)**
- Assign registration no. TMA987,654 to Funzo Electronics Ltd. **(1 mark)**
- Assign both application no. 1,456,789 and TMA987,654 to Funzo Corp. **(1 mark)**

QUESTION 6 (2 marks)

A university based in the United States, with no campus in Canada, can obtain the protection of a section 9 mark in Canada. True or False? **(1 mark)** Cite the relevant provision of the *Trade-marks Act* to support your answer. **(1 mark)**

Answer:

- True. **(1 mark)**
- Section 9(1)(n)(ii) of the *Trade-marks Act*. **(1 mark)**

QUESTION 7 (3 marks)

Your client would like to file a Canadian trademark application for KAUGUMMI for chewing gum, plush toys, and children's multiple activity toys. KAUGUMMI is German for "bubble gum". The mark is not yet in use anywhere. Assuming there are no confusingly similar marks on the Canadian Trademarks Database, briefly state whether the trademark is registrable? **(2 marks)** Cite the relevant provision of the *Trade-marks Act*. **(1 mark)**

Answer:

- The mark is not registrable for "chewing gum" because it is the name of the goods in German **(1 mark)**, but the mark is registrable for "plush toys, and children's multiple activity toys". **(1 mark)**
- Section 12(1)(c) of the *Trade-marks Act*. **(1 mark)**

QUESTION 8 (2 marks)

An application for registration of a trademark has been filed with goods and services grouped according to Nice Classification. The Examiner is of the view that the goods and services have

been incorrectly classified. Other than the incorrect classification, there are no substantive or technical issues with the application. In one sentence, explain what the Examiner will do. **(1 mark)** Cite the relevant authority for your answer. **(1 mark)**

Answer:

- The Examiner will approve the application for advertisement, without indication of Nice classes. **(1 mark)**
- Trademarks Examination Manual Section II.6.4.3. **(1 mark)** [**Note: Particular section of the Examination Manual not required to receive the mark.**]

QUESTION 9 (3 marks)

Your client has an existing Canadian registration for the trademark HAPPYBOUCHE for lipstick in the name of HappyBouche Ltd. doing business as HappyBouche Co. Your client then instructs you to file for HAPPYBOUCHE ETCETERA for foundation makeup, blush, and mascara in the name of HappyBouche Ltd. trading as HappyBouche. Assuming there are no other technical or substantive issues in connection with the application for HAPPYBOUCHE ETCETERA, what will the Examiner do with these two marks? **(2 marks)** Cite the relevant provision of the *Trade-marks Act*. **(1 mark)**

Answer:

- The Examiner will approve the application for advertisement **(1 mark)**, and will associate the marks. **(1 mark)**
- Section 15 of the *Trade-marks Act*. **(1 mark)**

QUESTION 10 (1 mark)

What is the only factor to be considered when assessing whether an applied for mark so nearly resembles as to be likely to be mistaken for an official mark? **(1 mark)**

Answer:

- The resemblance between the marks. **(1 mark)**

QUESTION 11 (6 marks)

Which of the following two trademark applications, A or B, both covering the same goods, has the earlier entitlement date at the examination stage, and for which goods? **(2 marks)** Briefly explain your answer. **(2 marks)** Cite the relevant authority and/or the relevant section of the *Trade-marks Act*. **(2 marks)**

Application A (No. 1,636,212)

Filed March 5, 2018, based on:

- Proposed use in Canada for: (1) "Clothing namely t-shirts, sweaters, pants, dresses";
- Use in Canada since February 26, 2002 for: (2) "computer software, namely database software, word processing software"; and

- Section 16(2) of the *Trade-marks Act* based on use in the United States and corresponding United States Application No. 86/736,677 filed June 27, 2017 for: (1) “Clothing namely t-shirts, sweaters, pants, dresses”.

Application B (No. 1,645,363)

Filed March 15, 2018:

- claiming Convention priority based on United States Application No. 86/794,767 filed October 5, 2017 for: (1) “Clothing namely t-shirts, sweaters, pants, dresses”; and
- based on proposed use in Canada for: (1) “Clothing namely t-shirts, sweaters, pants, dresses”; (2) “computer software, namely database software, word processing software”.

Answer:

- Application A has the earlier entitlement date for goods (2) **OR** for “computer software, namely database software, word processing software”. **(1 mark)**
- Application B has the earlier entitlement date for goods (1) **OR** for “clothing namely t-shirts, sweaters, pants, dresses”. **(1 mark)**
- Application A is entitled to advance to approval over Application B for goods (2) because Application A has an earlier filing date of March 5, 2018, compared to the filing date of March 15, 2018 for Application B. **(1 mark)**
- Trademarks Examination Manual Section III.6.1 **OR** Practice Notice dated May 19, 2005, “Entitlement – Confusing Marks” **OR** *Attorney General of Canada v. Effigi Inc.* (2005), 41 C.P.R. (4th) 1 (FCA). **(1 mark)** [**Note: Date and title of Practice Notice and/or specific section of the Examination Manual not required to receive the mark.**]
- Application B is entitled to advance to approval over Application A for goods (1) because the priority filing date of October 5, 2017 is before the application filing date for Application A, namely March 5, 2018. **(1 mark)**
- Section 34 of the *Trade-marks Act*. **(1 mark)**

QUESTION 12 (2 marks)

You are reviewing an Examiner’s report issued in connection with a client’s application. Your firm is listed as agent and representative for service for one of the marks alleged by the Examiner to be confusingly similar to the client’s mark. You are of the opinion that the marks are clearly so dissimilar that there is absolutely no possibility of a likelihood of confusion and that the Examiner obviously raised this mark in error. Can you comment on the impact the identified mark will have on the registrability of the subject mark? Yes or No. **(1 mark)**. Provide a brief explanation in support of your answer. **(1 mark)**

Answer:

- No. **(1 mark)**
- Commenting on the registrability of the mark in view of the confusingly similar located mark would be a conflict of interest. **(1 mark)**.

QUESTION 13 (5 marks)

Your client, Musical Alarms Inc., is seeking to register a five-note sound as their trademark. Musical Alarms Inc. advises that the five-note sound is distinct to their alarm system and is used to distinguish their goods, namely car alarms, from the car alarms of other traders.

List four specific requirements that must be included in an application for the registration of a sound mark. **(4 marks)** Cite the relevant authority for your answer. **(1 mark)**

Answer:

- an application for registration of a sound should:
 - a) state that the application is for registration of a sound mark; **(1 mark)**
 - b) contain a drawing that graphically represents the sound; **(1 mark)**
 - c) contain a description of the sound; **(1 mark)** and
 - d) contain an electronic recording of the sound. **(1 mark)**
- Trademarks Examination Manual Section IV.4 **OR** Practice Notice dated March 28, 2012, "Trademark consisting of a sound". **(1 mark)**

[Note: Date and title of Practice Notice and/or specific section of the Examination Manual not required to receive the mark.]

QUESTION 14 (1 mark)

What is the leading case outlining the requirements for the defined standard in an application for registration of a certification mark? **(1 mark)**

Answer:

- *Molson Breweries v. Labatt Brewing* (1996), 69 C.P.R. (3d) 274 (TMOB) **OR** Kokanee case. **(1 mark)**

[Note: the specific citation is not required to receive the mark.]

QUESTION 15 (2 marks)

True or False. The fee for recording a change of name that results from a merger of two companies is \$100. **(1 mark)** Cite the relevant authority for your answer. **(1 mark)**

Answer:

- False. **(1 mark)** There is no fee payable.
- Practice Notice *Transfers and/or Change of Name*. **(1 mark)** **[Note: Title of practice notice not required to receive the mark.]**

QUESTION 16 (3 marks)

Play Time Inc., an innovative Canadian toy company, has developed a new proprietary and inventive colour changing, scented, all natural toy modelling dough for children. Play Time Inc. decided to name its modelling dough DOUGH TIME as a unique play on the company name. Play Time Inc. has also developed a unique packaging for its toy modelling dough that also

functions as a mold to create shapes. Play Time Inc. is preparing to introduce its DOUGH TIME modelling dough at an upcoming toy industry trade show in January 2019. Play Time Inc. is concerned that its competitors will try to copy its new toy modelling dough formula, which uses only plant-based ingredients, is scented, and changes colour when it is manipulated by a child as they play with the dough.

In addition to a trademark application for the word mark DOUGH TIME, list three other types of intellectual property protection that Play Time Inc. may wish to consider for its new product? **(3 marks)**

Answer: [Note: any of the below to a maximum of 3 marks.]

- Patent for the formulation of the toy modelling dough. **(1 mark)**
- Industrial design for the molds. **(1 mark)**
- Distinguishing guise for the packaging. **(1 mark)**
- Trade secret OR contractual protection OR no-disclosure agreement for the formulation. **(1 mark)**
- Trademark for the scent once the changes to the *Trade-marks Act* are implemented. **(1 mark)**

QUESTION 17 (5 marks)

Your client, Mary Jones, has asked you to file an application to register the mark JONES WOOD PRODUCTS for figurines, kitchen cabinets, and boxes, all of the aforementioned made of wood. From the examination/Trademarks Office perspective, is the mark inherently registrable? Yes or No? **(1 mark)** Briefly explain why or why not. **(2 marks)** Cite the two relevant provisions of the *Trade-marks Act*. **(2 marks)**

Answer:

- Yes. **(1 mark)**
- The mark is a combination of a word that is primarily merely a surname ("JONES") and a phrase that is clearly descriptive of a character or quality of the associated goods ("WOOD PRODUCTS") **OR** The mark as a whole is neither primarily merely a surname nor is it clearly descriptive of a character or quality of the associated goods. **(2 marks)**
- Sections 12(1)(a) and 12(1)(b) of the *Trade-marks Act*. **(2 marks)**

QUESTION 18 (6 marks)

List six examples of what the Trademarks Office might consider exceptional circumstances justifying an extension of time beyond the twelve-month period from the initial date of the examiner's report. **(6 marks)**

Answer: [Note: any of the below to a maximum of 6 marks.]

- Recent change in trademark agent. **(1 mark)**
- Circumstances beyond the control of the person concerned. **(1 mark)**
- If there has been a very recent assignment of the trademark. **(1 mark)**
- The foreign application has not yet issued to registration. **(1 mark)**
- If the cited co-pending and confusing mark is: possibly going to be abandoned within the next two months **OR** is subject of opposition proceedings initiated by the applicant. **(1 mark)**

mark)

- If the cited registered mark is subject to a Section 45 proceeding initiated by the applicant. (1 mark)
- If the applicant is negotiating for consent from the holder of an official mark. (1 mark)

QUESTION 19 (8 marks)

Match the case name with the applicable legal principle. You have been provided with more legal principles than cases. Only one case should be paired with one principle. If you provide multiple principles for a case, only the first legal principle given will be marked. (1 mark for each correct answer for a maximum of 8 marks)

Case Name	Principle
A. <i>Marineland Inc. v. Marine Wonderland and Animal Park Ltd. (1974), 16 C.P.R. (2d) 97 (FC).</i> Trademark: MARINELAND	1. In assessing the likelihood of confusion between trademarks, Examiners must consider the possibility of confusion between those marks in either or both of Canada's official languages.
B. <i>British Drug Houses Ltd. v. Battle Pharmaceuticals (1944), 4 C.P.R. 48 (Ex. Ct.).</i> Trademark: MULTIVIMS	2. In Section 12(1)(b) of the <i>Trade-marks Act</i> , the word "clearly" is not used in the sense of "accurately", but of "easy to understand... evident, plain".
C. <i>Standard Coil Products (Canada) Ltd. v. Standard Radio Corp. (1971), 1 C.P.R. (2d) 155 (FC).</i> Trademark: STANDARD	3. In assessing whether a trademark is a geographic name, examiners may have regard to the names of continents, countries, provinces, states, regions, cities, neighbourhoods, and streets.
D. <i>Thorold Concrete Products Ltd. v. Registrar of Trade Marks (1961), 37 C.P.R. 166 (Ex. Ct.).</i> Trademark: THOR-O-MIX	4. Use in Canada in association with services requires that services advertised in Canada must be performed in Canada or be available to be performed in Canada.
E. <i>Scott Paper Co. v. Beghin-Say S.A. (1985), 5 C.P.R. (3d) 225 (FC).</i> Trademark: MOLTONE	5. Just because a particular combination of words does not appear in any dictionary does not mean that the mark is not clearly descriptive or deceptively misdescriptive. Where each portion of the mark has a well-known meaning in French or English, the resultant combination may be contrary to Section 12(1)(b) of the <i>Trade-marks Act</i> .
F. <i>Big Sisters Assn. of Ontario v.</i>	6. During examination, the Registrar will

Case Name	Principle
<p><i>Big Brothers of Canada</i> (1997), 75 C.P.R. (3d) 177 (FC).</p> <p>Trademark: BIG BROTHERS AND SISTERS OF CANADA</p>	not consider dates of first use or making known as relevant considerations under Section 37(1)(c) of the <i>Trade-marks Act</i> .
<p>G. <i>Oshawa Group Ltd. v. Registrar of Trade Marks</i> (1980), 46 C.P.R. (2d) 145 (FC).</p> <p>Trademarks: HYPER-VALUE and HYPER-FORMIDABLE</p>	7. Where a trademark contains both elements that fall within the definition of a distinguishing guise and elements that do not fall within the definition of a distinguishing guise, the provisions of the <i>Trade-marks Act</i> concerning distinguishing guises are still considered to apply.
<p>H. <i>Lum v. Dr. Coby Cragg Inc.</i> (2015), 134 C.P.R. (4th) 409 (FCA).</p> <p>Trademark: OCEAN PARK</p>	8. The two-part test to evaluate public authority status for official marks is made up of the following elements: <ul style="list-style-type: none"> • A significant degree of control must be exercised by the appropriate government over the activities of the body; and • The activities of the body must benefit the public.
	9. The onus on a person contending that a trademark which is descriptive or laudatory of their goods has come to actually distinguish those goods is a heavy one.
	10. In assessing confusion, it is not the correct approach to lay the two marks side by side and make a careful comparison with a view to observing the differences between them. They should be considered from the perspective of a person who has only a general recollection of the earlier mark and then sees the later mark by itself.
	11. Resemblance between an official mark and a trademark is not to be determined based on a “straight comparison” between the marks.

Answer:

A-4 (1 mark)

B-10 (1 mark)

C-9 (1 mark)

D-2 (1 mark)

E-1 (1 mark)

F-11 (1 mark)
G-5 (1 mark)
H-3 (1 mark)

QUESTION 20 (2 marks)

Briefly explain what CETA is. (2 marks)

Answer:

- CETA (Comprehensive Economic and Trade Agreement) is a trade agreement (1 mark) between Canada and the European Union. (1 mark) **[Note: identifying what CETA stands for is not required to receive the mark.]**

QUESTION 21 (4 marks)

In the initial Examiner's report dated November 15, 2017, the Examiner requested a certified copy of the corresponding United States registration to complete the claim to Section 16(2) of the *Trade-marks Act*. The response to the Examiner's report was initially due May 15, 2018. However, your client advised that the United States application would still be pending by the deadline. An initial extension of time was requested and granted until November 15, 2018. Your client has now advised that the corresponding U.S. application will not have issued to registration by the extended response deadline.

Can your client obtain a further extension of time to respond to the Examiner's report and, if so, how long? (2 marks) Briefly explain your answer (1 mark) and cite the relevant authority. (1 mark)

Answer:

- Yes (1 mark) the client can obtain a further six-month extension of time to respond to the Examiner's report. (1 mark)
- Where the foreign registration on which the Canadian application is based has not yet issued, that constitutes an exceptional circumstance justifying a further extension of time. (1 mark)
- Trademark Examination Manual Section V.14 OR Practice Notice dated March 11, 2010, "Extensions of Time in Examination". (1 mark)

[Note: Date and title of Practice Notice and/or specific section of the Examination Manual not required to receive the mark.]

QUESTION 22 (2 marks)

Your client's trademark application has been allowed and the deadline for paying the registration fee is Monday, July 1, 2018. On the morning of Tuesday, July 2, 2018, you receive instructions to pay the registration fee. Is it too late to pay the registration fee? Yes or No. (1 mark) Cite the relevant provision of the *Trade-marks Act* in support of your answer. (1 mark)

Answer:

- No. **(1 mark)** July 1, 2018 is a holiday and CIPO is closed for business. The deadline would automatically extend to the next day that CIPO is open for business.
- Section 66(1) of the *Trade-marks Act*. **(1 mark)**

QUESTION 23 (2 marks)

True or False. Correspondence delivered through Canada Post's Xpresspost™ service to CIPO on a day on which CIPO is open for business is deemed to be delivered on the day indicated on the mailing receipt provided by Canada Post. **(1 mark)** Cite the relevant provision of the *Trade-marks Regulations* in support of your answer. **(1 mark)**

Answer:

- True. **(1 mark)**
- Section 3(4)(a) *Trade-marks Regulations*. **(1 mark)**

QUESTION 24 (10 marks)

- a) On October 17, 2018, you file an application on behalf of a Canadian applicant for the registration of a trademark based on the applicant's proposed use of the mark in Canada. It is now November 17, 2018, and the applicant informs you that they had begun using the mark in Canada at least a year ago. Briefly explain what actions you would recommend to the applicant **(3 marks)** and why you recommend such actions. **(2 marks)** Cite the relevant provision of the *Trade-marks Regulations* in support of your answer **(1 mark)**.

Answer:

Recommended Actions:

- Check to see if any confusingly similar marks have been filed in the period since the application was filed. **(1 mark)**
- File a fresh application. **(1 mark)**
- Maintain current application for at least another six months. **(1 mark)**

Reasons for Actions:

- Proposed use basis is invalid. **(1 mark)**
- Application cannot be amended to change the basis from one not alleging use of the trademark in Canada prior to filing the application to one alleging such use. **(1 mark)**

Relevant provision:

- Section 31(d) *Trade-marks Regulations*. **(1 mark)**

- b) On October 17, 2018, you file an application for the registration of a trademark based on your client's proposed use of the mark in Canada. A few weeks after filing the application you discover that an application for the registration of a confusingly similar mark was filed by a third party on October 10, 2018. This application was also filed on the basis of the applicant's proposed use of the mark in Canada. Your client, a company whose head office is in Paris, France, informs you that it has a corresponding European Union

Trade Mark application (EUTM) and has used the mark in France for several years. The corresponding EUTM application was filed September 1, 2018, and is your client's only other application for this particular mark. Briefly explain what actions you would recommend to the applicant. **(2 marks)** Cite the relevant provisions of the *Trade-marks Act* for your answer. **(2 marks)**

Answer:

- Amend the application to include a filing basis that relies on the eventual registration of the corresponding EUTM application and use of the mark in France. **(1 mark)** *[Note: must have reference to both use in France and EUTM application to receive the mark.]*
- Include a claim of priority from the corresponding EUTM application. **(1 mark)**
- Section 16(2) of the *Trade-marks Act*. **(1 mark)**
- Section 34(1) of the *Trade-marks Act*. **(1 mark)**

QUESTION 25 (5 marks)

List four items that must be provided to the Registrar to obtain a filing date for an application to register a trademark comprising the design of a dog based on proposed use in Canada. **(4 marks)** Cite the relevant provision of the *Trade-marks Regulations* in support of your answer. **(1 mark)**

Answer:

- Name and address of the applicant. **(1 mark)** *[Note: Must have both name and address to receive the mark.]*
- Goods and/or services. **(1 mark)**
- The application fee. **(1 mark)**
- A drawing of the trademark. **(1 mark)**
- Section 25 of the *Trade-marks Regulations*. **(1 mark)**

QUESTION 26 (3 marks)

Assuming the mark is in use somewhere in the world, can a Canadian trademark application be filed based on use and registration abroad, based on an application or registration applied for or registered in the following?

- a) Benelux. Yes or No? **(1 mark)**
- b) World Intellectual Property Office (WIPO). Yes or No? **(1 mark)**
- c) European Union Intellectual Property Office (EUIPO). Yes or No? **(1 mark)**

Answer:

- a) Yes. **(1 mark)**
- b) Yes. **(1 mark)**
- c) Yes. **(1 mark)**

QUESTION 27 (3 marks)

Your client, Betty's Fresh Fruit & Veggies Inc., would like to file an application for the trademark POSTAL PRODUCTS. Betty's Fruit & Veggies Inc. advises that they are currently using the mark in Canada and have done so since April 20, 2002 for the following services: "Retail sale of fresh fruits and vegetables".

Putting aside any consideration of confusion, what is the most likely objection that the Trademarks Office will raise in connection with this mark? **(1 mark)** Briefly explain your answer. **(1 mark)** Cite the relevant provision of the *Trade-marks Act*. **(1 mark)**

Answer:

- The applicant cannot be satisfied that it is entitled to use the POSTAL PRODUCTS trademark in Canada. **(1 mark)**
- Where the mark includes the words POST OFFICE or similar words, such use is prohibited by section 58 of the *Canada Post Corporation Act* **(1 mark)**
- Section 30(i) of the *Trade-marks Act* **(1 mark)**

[Note: Specific section of the Canada Post Corporation Act not required to receive the mark, nor is the full title of the Act (Canada Post Act, or some reasonable variation, would suffice to receive the mark).]

QUESTION 28 (19 marks)

On March 5, 2018, you filed an application for the registration of the mark PESCE on behalf of Marco Pesce Fashion Corp., the company created by Marco Pesce, an up and coming Italian fashion designer. The application is based on use of the mark in Canada in association with clothing, jewellery and perfumes, since at least as early as January 2013, as well as use and registration in Italy for these same goods.

The application has been examined and the Examiner has issued the following Office Action:

Your Firm
227 Main Street
Ottawa, Ontario K2E 2P6
Attention: Mr. Agent

November 5, 2018
Your File
42685-0125
Our File
1899504

Re: Trademark: PESCE
Applicant: Marco Pesce Fashion Corp.

This Examiner's report concerns the above-identified application. To avoid abandonment proceedings, a proper response must be received by this office by **May 5, 2019**. All correspondence respecting this application must indicate the file number.

The mark which is the subject of this application is considered to falsely suggest a connection to a living individual, namely the Italian fashion designer, Marco Pesce, the adoption of which is prohibited by paragraph 9(1)(k) of the *Trade-marks Act*. Therefore, in view of the provisions of paragraph 12(1)(e) of the *Act* this mark does not appear to be registrable.

In addition to the foregoing, the mark which is the subject of this application is considered to be primarily merely the surname of an individual who is living or who has died within the preceding thirty years. In this respect, please note that a search on Canada411.ca has yielded 156 search results for the surname PESCE. In view of the provisions of paragraph 12(1)(a) of the *Trade-marks Act*, this mark does not appear to be registrable.

Any comments you may wish to submit will receive consideration.

If the applicant has any specific questions in respect of this office action, please contact the assigned examiner.

Yours truly,

Anita Charles
Examination Section

- a) List the best option for responding to the objection to the registration of the mark pursuant to Sections 9(1)(k) and 12(1)(e) of the *Trade-marks Act*. **(1 mark)**

Answer:

- Obtain written consent from Marco Pesce to use and registration of the mark by Marco Pesce Fashion Corp. **(1 mark)**

- b) List three available options for responding to the surname objection pursuant to Section 12(1)(a) of the *Trade-marks Act*. **(3 marks)** Note that only the first three answers given will be marked. Cite relevant provisions of the *Trade-marks Act* in support of your answer. **(2 marks)**

Answer:

- Argument – mark is not primarily merely a surname **OR** Section 12(1)(a) of the *Trade-marks Act*. **(1 mark)**
- Provide evidence that the mark has acquired distinctiveness **OR** secondary meaning throughout Canada. **(1 mark)**
- Provide evidence that mark is not without distinctive character in Canada. **(1 mark)**
- Section 12(2) of the *Trade-marks Act*. **(1 mark)**
- Section 14 of the *Trade-marks Act*. **(1 mark)**

- c) You are now in receipt of a signed consent from Marco Pesce to Marco Pesce Fashion Corp. authorizing the latter's use and registration of the mark PESCE in association with clothing, jewellery and perfumes. Your research reveals that PESCE is the Italian word for "fish" and that 5% of the Canadian population (1.8 Million people) speak Italian.

Draft a response to the Office Action, addressing all the issues raised by the Examiner.
(A total of 6 marks will be given, including 1 mark for the clarity of the response)

Answer:

- Refer to consent pursuant to Section 9(2) of the *Trade-marks Act* and attach copy of consent from Marco Pesce. **(1 mark)**
- Argue that PESCE not merely a surname **(1 mark)** and provide evidence of meaning of mark in Italian (e.g., printout of Italian-English dictionary). **(1 mark)**
- Argue that primary significance of PESCE is not that of a surname **(1 mark)** given low number of people with the surname PESCE **AND** the significant number of persons in Canada that speak Italian. **(1 mark)**
- Clarity **(1 mark)**

- d) The Examiner has rejected your arguments and has maintained the objection to the registration of the mark pursuant to Section 12(1)(a) of the *Trade-marks Act*. You recommend making a claim to the benefit of Section 12(2) of the Act. In point form, list the most important information and/or documents you will require to prepare an affidavit in support of the claim. **(7 marks)**

Answer:

- The full name and title of the person swearing/affirming the affidavit. **(1 mark)**
- Specimens of the mark as used in association with the goods. **(1 mark)**
- Sales figures for sales of the goods bearing the mark over the relevant period, broken down by Canadian province and by year. **(2 marks)**
- Samples of advertising of the mark in Canada. **(1 mark)**
- Expenditures for advertising of the mark in Canada over the relevant period, broken down by Canadian province and by year. **(2 marks)**

QUESTION 29 (2 marks)

Identify the two most important differences between an affidavit in support of a claim of acquired distinctiveness under Section 12(2) of the *Trade-marks Act* and an affidavit in support of a claim of distinctive character under Section 14 of the *Trade-marks Act*. **(2 marks)**

Answer:

- Section 12(2) affidavit must show mark is distinctive throughout Canada (sales figures and advertising expenditures broken down by Canadian province). **(1 mark)**
- Relevant period for Section 12(2) affidavit is up to the filing date of the application. **(1 mark)**

QUESTION 30 (12 marks)

Your client is interested in filing a Canadian application for the trademark HAPPY WAY. The mark is not yet in use in Canada, and will be filed on the basis of proposed use in Canada under Section 16(3) of the *Trade-marks Act* for the following goods and services:

Goods:

- apples;
- juice;

- jam;
- cider;
- t-shirts; and
- mugs;

Services:

- retail sale of apples, juice, jam, cider, t-shirts, and mugs; and
- brewery services.

Your client has asked you to arrange for a search of the Trademarks Register before filing an application to register the HAPPY WAY trademark for the goods and services of interest.

For each of the marks identified by the search, and set out below:

- Indicate whether the mark is likely to pose an obstacle to registration of the HAPPY WAY mark with a “yes” or “no” answer. **(1 mark each)** **Note: “yes” means the mark is likely to pose an obstacle to registration, and “no” means the mark is not likely to pose an obstacle to registration;** and
- Briefly (point form is acceptable) provide a valid explanation to support your opinion. **(1 mark each)** Please formulate your opinions from an examination/Trademarks Office perspective, not from an opposition perspective.

Note: No marks will be given for a “yes” or “no” answer unless a valid supporting explanation is given.

TRADEMARK	REG. / APPL'N NO.	GOODS / SERVICES
(a) CHEERFUL STREET	TMA761,982	(1) Clothing, namely sweaters, t-shirts, pants and skirts; (2) jewelry; (3) smartphones, lap tops, operating software; (4) fresh fruits and vegetables; (5) live plants, namely fruit trees (6) handbags, suitcases; (6) glassware, cups, mugs, vases. (1) Department store services and an online department store; (2) computer programming services for others; (3) operating a gardening centre.
(b) HAPPY WEIGH	TMA778,349	(1) Retail sale of books in the field of nutrition; (2) catering services.
(c) HAPIE WAIE	1,854,633 (filed May 20, 2018)	(1) fruit and vegetable juice, fruit and vegetable sauces; (2) mixed alcoholic beverages containing fruits; (3) promotional items namely mugs and t-shirts. (1) retail and online sale of the above goods; (2) operating a website featuring information on mixed drink recipes.
(d) WAY HAPPY	TMA623,555	(1) Clothing, namely sweaters, t-shirts, pants and

TRADEMARK	REG. / APPL'N NO.	GOODS / SERVICES
		skirts; (2) fresh fruits and vegetables; (3) glassware, cups, mugs, vases. (1) Retail sale of foods; (2) operating a gardening centre.
(e) FINDING A HAPPIER WAY TO TRAVEL	TMA655,875	(1) promotional items, namely t-shirts, jams, bottled water and travel mugs. (1) Travel agent services; (2) operating a website about travelling.
(f) ☺ Way	TMA787,487	(1) Clothing, namely sweaters, t-shirts, pants and skirts; (2) cider; (3) fresh fruits and vegetables; jams and fruit jellies; (4) glassware, cups, mugs, vases. (1) Sale of alcoholic beverages; (2) retail services, namely sale of clothing, fresh fruits and vegetables; jams and fruit jellies; glassware, cups, mugs, vases.

Answer: (Note: Even if Yes/No answer is incorrect, marks may still be given if candidate provides valid supporting explanation)

Trademark	REG. / APPL'N NO.	GOODS / SERVICES
(a) CHEERFUL STREET	TMA761,982	(1) Clothing, namely sweaters, t-shirts, pants and skirts; (2) jewelry; (3) smartphones, lap tops, operating software; (4) fresh fruits and vegetables; (5) live plants, namely fruit trees (6) handbags, suitcases; (6) glassware, cups, mugs, vases. (1) Department store services and an online department store; (2) computer programming services for others; (3) operating a gardening centre.
Answer: - No. (1 mark) - Marks differ in appearance, sound and ideas suggested. (1 mark) [Note: only one of the terms “appearance”, “sound” or “ideas suggested/connotation” is required to receive the mark.]		
(b) HAPPY WEIGH	TMA778,349	(1) Retail sale of books in the field of nutrition; (2) catering services.
Answer: - No. (1 mark) - Services covered by this mark differ from the goods and services covered by the HAPPY WAY mark. (1 mark)		
(c) HAPIE WAIE	1,854,633 (filed)	(1) fruit and vegetable juice, fruit and vegetable

Trademark	REG. / APPL'N NO.	GOODS / SERVICES
	May 20, 2018)	<p>sauces; (2) mixed alcoholic beverages containing fruits; (3) promotional items namely mugs and t-shirts.</p> <p>(1) retail and online sale of the above goods; (2) operating a website featuring information on mixed drink recipes.</p>
Answer: <ul style="list-style-type: none"> - Yes. (1 mark) - Marks are very similar, visually, phonetically and in ideas suggested OR the goods and services are identical and/or overlapping. (1 mark) [Note: only one of the terms “appearance”, “sound” or “ideas suggested/connotation” is required to receive the mark.] 		
(d) WAY HAPPY	TMA623,555	<p>(1) Clothing, namely sweaters, t-shirts, pants and skirts; (2) fresh fruits and vegetables; (3) glassware, cups, mugs, vases.</p> <p>(1) Retail sale of foods; (2) operating a gardening centre.</p>
Answer: <ul style="list-style-type: none"> - No. (1 mark) - Marks differ in ideas suggested. (1 mark) 		
(e) FINDING A HAPPIER WAY TO TRAVEL	TMA655,875	<p>(1) promotional items, namely t-shirts, jams, bottled water and travel mugs.</p> <p>(1) Travel agent services; (2) operating a website about travelling.</p>
Answer: <ul style="list-style-type: none"> - No. (1 mark) - Marks differ in appearance, sound and ideas suggested. (1 mark) [Note: only one of the terms “appearance”, “sound” or “ideas suggested/connotation” is required to receive the mark.] 		
(f) ☺ Way	TMA787,487	<p>(1) Clothing, namely sweaters, t-shirts, pants and skirts; (2) cider; (3) fresh fruits and vegetables; jams and fruit jellies; (4) glassware, cups, mugs, vases.</p> <p>(1) Sale of alcoholic beverages; (2) retail services, namely sale of clothing, fresh fruits and vegetables; jams and fruit jellies; glassware, cups, mugs, vases.</p>
Answer: <ul style="list-style-type: none"> - Yes. (1 mark) - Marks are very similar in ideas suggested OR the goods and services are either identical or overlap (1 mark) 		

QUESTION 31 (10 marks)

The search firm that conducted the search for the HAPPY WAY trademark has come back to you and advised that the two marks, below, were inadvertently omitted from the search report.

For each of the marks identified below:

- i. Indicate whether the mark is likely to pose an obstacle to registration of the HAPPY WAY mark with a “yes” or “no” answer. **(1 mark each)** **Note: “yes” means the mark is likely to pose an obstacle to registration, and “no” means the mark is not likely to pose an obstacle to registration;**
- ii. Briefly (point form is acceptable) provide a valid explanation to support your opinion, including an explanation of the meaning and impact of the letters preceding the registration numbers; **(2 marks each)**
- iii. Cite the relevant provision(s) of the *Trade-marks Act*. **(2 marks each)**

Note: No marks will be given for a “yes” or “no” answer unless a valid supporting explanation is given.

TRADEMARK	REG. / APPL'N NO.	GOODS / SERVICES
(a) HAPPY WAY	PBRA2255	Apples.
(b) Happy Way	NFLD04,423	(1) alcoholic beverages; clothing; food (1) Sale of alcoholic beverages; sale of clothing

Answer: (Note: Even if Yes/No answer is incorrect, marks may still be given if candidate provides valid supporting explanation)

TRADEMARK	REG. / APPL'N NO.	GOODS / SERVICES
(a) HAPPY WAY	PBRA2255	Apples.
Answer: <ul style="list-style-type: none"> - Yes. (1 mark) - Marks are identical and both cover the same agricultural product, namely apples, so cannot adopt or use the mark for apples. (1 mark) - PBRA stands for <i>Plant Breeders' Rights Act</i>. (1 mark) - Sections 12(1)(f) and 10.1 of the <i>Trade-marks Act</i>. (2 marks) 		
(b) Happy Way	NFLD04,423	(1) alcoholic beverages; clothing; food (1) Sale of alcoholic beverages; sale of clothing
Answer: <ul style="list-style-type: none"> - Yes (1 mark) - Marks are identical OR goods and services overlap (1 mark) - NFLD stands for Newfoundland – as a result of confusion with this mark, the resulting registration will be territorially limited to exclude Newfoundland (1 mark) - Sections 12(1)(d) and 67 of the <i>Trade-marks Act</i> (2 marks) 		

QUESTION 32 (8 marks)

- a) Your client informs you that it has purchased a portion of the intellectual property assets of a third party, including some of its trademark registrations. In point form, list the requirements for recording the transfer of ownership against the trademark registrations. **(3 marks)** State the relevant provisions of the *Trade-marks Act* and *Trade-marks Regulations* in support of your answer. **(3 marks)**

Answer:

- The prescribed fee **OR** \$100 per mark. **(1 mark)**
- The name and mailing address in Canada of the assignee (**OR** if no address in Canada, the name and mailing address of a representative for service in Canada). **(1 mark)** [**Note: must have both name and address to receive the mark**]
- Evidence that the marks have been transferred. **(1 mark)**
- Section 48(3) of the *Trade-marks Act*. **(1 mark)**
- Section 30(g) of the *Trade-marks Act*. **(1 mark)**
- Rule 48 of the *Trade-marks Regulations*. **(1 mark)**

- b) Prior to filing a request to record the assignment, you discover that one of the marks listed in the assignment document is associated with a mark that is not listed in the assignment document. Will the Registrar record the assignment? Yes or No. **(1 mark)** Cite the relevant provision of the *Trade-marks Act* in support of your answer. **(1 mark)**

Answer:

- No. **(1 mark)**
- Section 15(3) of the *Trade-marks Act*. **(1 mark)**

QUESTION 33 (1 mark)

On July 27, 2018, you filed an application on behalf of your client, claiming priority based on an earlier filed application, which your client informed you was filed on March 7, 2018. Your client informs you on October 11, 2018 that the earlier filed application was actually filed on March 2, 2018 and not March 7, 2018. The application has not yet been examined. Can the application be amended to correct the error? **(1 mark)**

Answer:

- No. **(1 mark)**

TRADEMARK AGENT EXAM 2018
PAPER B
Total Marks: 150

QUESTION 1 (7 marks)

Your client owns registration No. TMA123,321 for the trademark MONDO in association with “cooking pots”. Last week, your client received a section 45 Notice from the Registrar in respect of this registration.

Your client advises that it is not currently using its MONDO mark, and that it:

- stopped selling MONDO cooking pots about 10 years ago after receiving numerous customer complaints regarding the quality of the product. Apparently, there was a problem with the ceramic used to make the pots causing them to crack.
- was able to identify the cause of the cracking defect, and that it would be possible to fix, but that to do so would be extremely costly.
- after realizing it would be very expensive to repair the cooking pots marketed under the MONDO mark, then shifted its focus over to its TERRA line of cooking pots, which are instead made of cast iron, especially since consumers seem to prefer cast iron pots anyway.

1(a). Identify the three criteria that the Board will consider in assessing whether the registrant has demonstrated special circumstances justifying the absence of use **(3 marks)**.

1(b). Based on the facts provided, is it likely that the registrant will be able to demonstrate special circumstances justifying the absence of use – Yes or No? **(1 mark)**. Applying the facts, explain your position relating to each of the three criteria that the Board will consider **(3 marks)**.

QUESTION 2 (13 marks)

On behalf of your client, you have requested the issuance of a section 45 notice against registration No. TMA123,456 for the trademark BLUE ZEBRA owned by Urban Jungle Products Inc. The mark is registered in association with the following goods:

Goods:

- (1) Sunscreen
- (2) Shampoo, namely shampoo and dry shampoo
- (3) Hair conditioner

The section 45 Notice was issued against Urban Jungle Products Inc’s trademark on January 5, 2018 and the following affidavit was filed in response to this Notice:

AFFIDAVIT OF CHRISTINE ROBERTS

I, Christine Roberts, of the City of Edmonton, Alberta, hereby make oath and say as follows:

1. I am the president and director of Urban Jungle Products Inc (Urban Jungle or My Company), and have held this position since I founded Urban Jungle in March 2009. Based on the foregoing,

I have personal knowledge of the matters set forth except where stated to be based on information and belief.

2. Urban Jungle owns registration No. TMA123,456 for the trademark BLUE ZEBRA (the Mark) in association with sunscreen; shampoo, namely shampoo and dry shampoo, and hair conditioners (collectively the Goods).
3. I have been advised by counsel that on January 5, 2018, the Canadian Intellectual Property Office issued a Section 45 Notice against the registration for the Mark requiring evidence showing use of the Mark in Canada with the Goods between the period of January 5, 2015 and January 5, 2018 (the Relevant Period).
4. Urban Jungle is a manufacturer of skin and hair care preparations. In the normal course of trade, My Company has sold during the Relevant Period, and continues to sell its BLUE ZEBRA brand skin and hair preparations to the Tundra Company (Tundra), a well-known national retailer, for resale to consumers in Canada.
5. Attached as Exhibit A is a photograph of a tube of sunscreen bearing the trademark BLUE ZEBRA, which is representative of the way the Mark has appeared on product packaging during the Relevant Period. Attached as Exhibit B is a representative sample of an invoice dated March 8, 2016 for the sale of BLUE ZEBRA sunscreen to Tundra.
6. Attached as Exhibit C is a photograph of a can of dry shampoo bearing the trademark BLUE--ZEBRA, which is representative of the way the Mark has appeared on product packaging during the Relevant Period.
7. Attached as Exhibit D is a photograph of the current packaging for hair conditioner sold in association with the trademark BLUE ZEBRA by Urban Jungle. Attached as Exhibit E are representative invoices of recent invoices from the last two months issued by Urban Jungle to Tundra.
8. The annual gross sales of BLUE ZEBRA Goods in Canada for each of the years 2015 to 2018 has exceeded \$250,000 CAD. Approximately 60% of these annual sales can be attributed to skin care products; the remainder can be attributed to dry shampoo.

In accordance with the questions below, for each of the goods listed in the registration, provide your client with an opinion on whether the registration will be maintained or expunged for those goods and explain why. Base your opinion solely on the evidence provided and the relevant principles of law. Case law only needs to be cited where specifically requested.

2(a). For the goods (1), namely “sunscreen”, advise whether the registration will be maintained or expunged **(1 mark)**. Give one reason to support your opinion **(1 mark)**.

2(b). For the goods (2), in accordance with the questions below, advise if the registration will be maintained or expunged for “shampoo, namely shampoo and dry shampoo”. In particular, consider that the trademark displayed on the can of dry shampoo in Exhibit C is “BLUE--ZEBRA” rather than BLUE ZEBRA:

- i. Will the registration be maintained or expunged for “shampoo, namely shampoo”? **(1 mark)** Explain why **(1 mark)**.
- ii. Will the registration be maintained or expunged for “shampoo, namely dry shampoo”? **(1 mark)** In your answer, identify the test that applies to situations where the mark as used in the marketplace differs from the mark as registered **(1 mark)**, identify the components of the test **(3 marks)**, cite one relevant case **(1 mark)**, and apply the test **(1 mark)**.

2(c). For the goods (3), namely, “hair conditioner”, advise if the registration will be maintained or expunged **(1 mark)**. Give a reason to support your opinion **(1 mark)**.

QUESTION 3 (13 marks)

On September 5, 2018 a statement of opposition was filed by Abragio Inc (Abragio), owner of trademark registration No. TMA382,493 for ABRAGIO, against application No. 1,829,493 for the trademark ADAGIO, the particulars of which are below:

Applicant: Adagio Ltd
 Filing date: March 8, 2017
 Date of advertisement: July 5, 2018
 Goods: (1) pizza, breadsticks, garlic bread, tomato sauce
 (2) pasta
 Services: restaurant services
 Claims: proposed use with the Goods (1) and Services; use in Canada since September 29, 2012 with the Goods (2); use and registration in the United States in association with the Services;

Each ground of opposition below is deficient in one or more ways. For each ground of opposition, identify 1) the deficiency/deficiencies **(1 mark per deficiency)** and 2) how to remedy the deficiency/deficiencies **(1 mark per remedy)**

3(a). The application does not comply with sections 38(2)(a) and 30(a) of the *Trade-marks Act* (the Act) because various goods are not defined in ordinary commercial terms. **(2 marks)**

3(b). The application does not comply with sections 38(2)(a) and 30(d) of the Act because the Mark is not registered in the United States with the Services or the Mark was not used in the United States with the Services. **(2 marks)**

3(c). The application does not comply with sections 38(2)(a) and 30(e) of the Act in that the applicant did not intend to use the Mark in association with the Goods (1) and Services because the applicant was aware, or ought to have been aware, of the opponent’s trade-mark ABRAGIO which is well-known in Canada due to the extensive and prior use in Canada in association with Italian food, including pizza. **(2 marks)**

3(d). The application does not comply with sections 38(2)(b) and 12(1)(d) of the Act because it is confusing with Abragio’s registration No. TMA384,295 for the trademark ABRAGIO; Abragio’s

registration for the trademark ABRAGIO EXPRESS; and Abragio's applications for the trademark ABRAGIO NORTH, both covering pizza. **(4 marks)**

3(e). The application does not comply with sections 38(2)(c) and 16(3)(a) of the Act because, at the date of filing of the application for the Mark it was confusing with the trademark ABBRUZO previously used by BBY Inc. in association with restaurant services. **(2 marks)** In identifying the deficiency, cite the specific section of the *Trade-marks Act* that is the basis for your answer. **(1 mark)**

QUESTION 4 – TRUE OR FALSE (5 marks)

Identify whether the statements below are true or false.

- a) In section 45 proceedings, the sole form through which evidence may be submitted is by affidavit. **(1 mark)**
- b) In a section 45 proceeding, the Requesting Party has four months in which to file its evidence after the registered owner has filed its evidence in response to a section 45 notice. **(1 mark)**
- c) Evidence in section 45 proceedings may not be filed with the Registrar by facsimile. **(1 mark)**
- d) Where new evidence is filed on appeal of a decision in a section 45 proceeding, the requesting party may cross-examine on this evidence. **(1 mark)**
- e) The maximum benchmark extension of time for the registered owner to file evidence in a section 45 proceeding is 3 months. **(1 mark)**

QUESTION 5 (4 marks)

Your client is interested in registering the trademark JOIE for use in association with “cookies, doughnuts, pies” and has asked you to conduct a trademark search to assess the availability of the mark for registration.

Your search disclosed the following trademark registration as a potential obstacle to registration of your client's proposed trademark:

Trademark: JOIE

Registration No.: TMA876,543

Goods:

- (1) Cookies and cupcakes;
- (2) Doughnuts

Claims:

- (1) Use in Canada since March 2002
- (2) Use in Canada since September 2015

The registration issued in respect of the goods (1) on April 3, 2005, and the registration was amended to add the goods (2) on January 11, 2017.

In your review, you notice that a section 45 notice had previously been issued against the registration in respect of the goods (1) (cookies and cupcakes), and the Registrar issued a decision maintaining the registration on September 27, 2012.

Your client wants to know if this registration is vulnerable to summary cancellation for non-use. Specifically, assuming there is no evidence of use of mark:

5(a). For the goods (1) (cookies and cupcakes), is TMA876,543 vulnerable to summary cancellation for non-use? **(1 mark)** Give one reason to support your opinion **(1 mark)**

5(b). For the goods (2) (doughnuts), is TMA876,543 vulnerable to summary cancellation for non-use? **(1 mark)** Give one reason to support your opinion **(1 mark)**

QUESTION 6 (8 marks)

Your client is a surfboard manufacturer located in Tofino, British Columbia. Founded in 2008, your client has grown steadily over the last decade to become very popular across Canada and sells surfboards under its well-known brand SURF GURU through its brick and mortar stores in Tofino, Vancouver, Calgary, and Toronto. The client also sells its SURF GURU surfboards, through its company website, to consumers in major cities across Canada, including Montreal, Quebec City, and Halifax.

The client has filed an application for the trademark SURF GURU, which has just been advertised in the *Trademarks Journal*.

It has come to the client's attention that a new surfboard manufacturer called Zen Inc. has just started up business, opening up a store in the Montreal area offering for sale and selling surfboards in association with the identical trademark SURF GURU. Your client is very concerned that consumers will confuse this mark with its SURF GURU brand and wants to stop Zen Inc.

6(a). Your client wants you to bring an action for trademark infringement against Zen Inc. without delay. Is this possible? **(1 mark)** Explain why or why not **(1 mark)**.

6(b). Your client also wants to know if, at this time, it would be possible to bring an action for depreciation of goodwill of the client's SURF GURU trademark? **(1 mark)** Explain why or why not. **(1 mark)**

6(c). What valid cause of action can the client bring against Zen Inc. and what elements must the client demonstrate in order to succeed in that cause of action? **(4 marks)**

QUESTION 7 (21 marks)

Your client is a company based in Norway that manufactures industrial water pumps for use in the off-shore oil and gas industry. It does not own any trademark registrations or applications in Canada, but has been selling its water pumps under the trademark VIKING in Canada since 2014. Your client contacts you to ask your advice regarding the trademark application set out below, since the client is considering opposing this application.

Application No.: 1,234,567

Trademark: VIKING

Applicant name/address:

Nomanda, Inc.

1 Bay Street, Toronto, Ontario

Goods:

- (1) Cross-cut saw blades; blades for hand saws; computer software to operate industrial saws.
- (2) Oil well pumping machines.

Services:

- (1) Forestry management; forestry management consulting services.
- (2) Off-shore oil pumping and extraction.

Claims:

Use in Canada since at least as early as 2010 on goods (1) and services (1).

Proposed use on goods (2) and services (2).

Filing date: July 16, 2016

Advertisement date: October 25, 2018

After conducting some preliminary online research, it appears that Nomanda Inc. has been using the trademark VIKING in association with goods (1) and services (1) in Canada since the date claimed in the application, but has not yet started using the mark in association with goods (2) and services (2). Also, your client indicates that Nomanda, while very active in the forestry sector, has not taken any steps under *The Canada Petroleum Resources Act* to acquire the requisite approval from the Federal Government to engage in off-shore oil drilling activities.

7(a). December 25, 2018 is a Tuesday. What is the latest date on which you can file a Statement of Opposition or request an extension of time? **(1 mark)** In one sentence, explain the reason you identified that date **(1 mark)**.

7(b). What is the duration of the longest single extension of time which is available to your client at this stage? **(1 mark)** What are the requirements to obtain that extension of time? **(2 marks)**

7(c). Identify the four best grounds of opposition for your client to assert against this application **(4 marks)**. Cite the two relevant provisions of the *Trade-marks Act* to support each of those grounds of opposition. **(8 marks)**

7(d). Your client decides to obtain an extension of time to oppose the application and would like you to contact the Applicant to determine if an amicable resolution of the matter might be possible. Identify four possible coexistence terms that would assist your client in preserving any trademark rights it has or might want to obtain in Canada. **(4 marks – Only the first four answers will be marked)**

QUESTION 8 (7 marks)

Your client, a national chain of brew pubs, owns trademark registration no. TMA678,910 for the trademark SANDCASTLE in association with beer. This trademark was registered on November 18, 2010 and your client has been using the mark continuously since September 2010. In your regular watch search for this client, the following trademark application is identified:

Application No.: 1,987,654

Trademark: SANDCASTLE BREW

Applicant name/address:

Windy Beach Brewing Co.

188 Sandy Way, Parksville, British Columbia

Goods: Alcoholic beverages, namely, beer and cider.

Claims: Use of the mark in Canada since at least as early as 2008.

Filing date: August 15, 2017

Advertisement date: November 1, 2018

After hiring an investigator to acquire more facts, you discover that Windy Beach Brewing Co. is a small craft brewing operation in Parksville, British Columbia, which appears to have been using the trademark SANDCASTLE BREW since 2008 in association with beer and cider as claimed in the application. Windy Beach Brewing Co. is a very small business that does not have a website and is only selling its product in the local area at farmer's markets and local restaurants.

When you advise the client about this application, your client indicates that it was not, and never had been, aware of this small business in Parksville when the client adopted the trademark SANDCASTLE.

8(a). If the client decides to oppose application no. 1,987,654, can it rely on its registration TMA678,910 as a ground of opposition? **(1 mark)** If the client were to rely on this registration, what are the two relevant provisions of the *Trade-marks Act* to support that ground of opposition? **(2 marks)**

8(b). Assuming all of the facts in the above question are true, is the client's registration TMA678,910 vulnerable to invalidation based on Windy Beach Brewing Co.'s use of its mark SANDCASTLE BREW? **(1 mark)** Explain why or why not **(2 marks)** with reference to the relevant provisions of the *Trade-marks Act* **(1 mark)**.

QUESTION 9 (10 marks)

Your client is a running shoe manufacturer that is presently opposing the following trademark application by its main competitor:

Application No.: 1,789,101

Trademark: MAXIMALIST

Applicant name/address:

Green Mountain Footwear, Inc.

1 Cherry Street, Burlington, Vermont

Goods: Running shoes

Claims: Use of the mark in Canada since at least as early as February 20, 2016.

Filing date: March 15, 2016.

Advertisement date: March 4, 2017.

Your client's Statement of Opposition is based solely on the grounds that the trademark applied for is not registrable because it is clearly descriptive of the goods and is not distinctive of the applicant because the mark is clearly descriptive.

The Applicant's Rule 42 evidence includes an affidavit from the Applicant's CEO, which includes sales records which suggest that the first shipments of the goods bearing the trademark MAXIMALIST arrived in Canada and were received by customers on February 27, 2016.

9(a). In view of the Applicant's evidence, what additional ground of opposition could the client seek to rely upon? **(1 mark)** What are the relevant provisions of the *Trade-marks Act* that support that ground? **(2 marks)**

9(b). Is the client likely to be permitted to amend its Statement of Opposition at this stage to include this additional ground of opposition – Yes or No? **(1 mark)** Briefly explain why or why not, with reference to the relevant factors that will be considered by the Board and citing the relevant provision of the *Trade-marks Regulations*. **(6 marks)**

QUESTION 10 (8 marks)

10.(a) Similar to the context of a legal action, objections made during cross-examination of an affiant can, as of right, be ruled upon during the course of an opposition (i.e. prior to the argument stage) as to whether certain questions asked in cross-examination should be answered or whether answers given are adequate. True or false? **(1 mark)** Briefly support your answer with an explanation. **(2 marks)**

10.(b) In the context of a cross-examination, the agent representing the applicant requests that accounting records for the last ten years be provided for the product sold under the trademark that is the basis for the opponent's grounds of opposition relating to confusion. In light of the fact that the affidavit already includes a statement to the effect that "*global sales figures for the opponent's goods over the last ten years exceed \$5,000,000*", and that the request is particularly onerous, should you object to the request in the interest of your client (to keep costs low for example) – Yes or No **(1 mark)**? Provide a brief explanation supporting your answer to best serve your client's interests **(4 marks)**.

QUESTION 11 (5 marks)

It's 3PM on a Friday afternoon before a long weekend and you get an e-mail from a regular client, which you immediately read. The e-mail is to the following effect:

- A directly competitive product has just come out under the trademark X (a photograph of the product bearing the mark is attached to the e-mail);
- The client owns the registered trademark Y and it appears on its products (a photograph is also provided);
- The client wants to know if there is a risk of confusion and if any action can be taken against the owner of the trademark X.

A preliminary review suggests there is a very good likelihood that confusion can be proven (although a more complete factual background could change your very preliminary opinion). But before you respond to the client to give your assessment, you want to make sure that the owner of trademark X is not, perchance, a client of your firm.

Since your client did not provide you with the name of the owner of trademark X, you can't immediately refer the verification to the appropriate person at your firm. So you decide to check out the trademark database to see if that could help you to identify an owner.

You quickly find out that an application for the trademark X was recently published in the *Trademarks Journal* and that the opposition deadline expired two weeks ago. You scroll down the result page and you see that your firm is actually prosecuting the application, although you never heard of that particular client. What do you do? **(2 marks)** Briefly indicate why **(3 marks)**.

QUESTION 12 **(2 marks)**

Your client has filed an application for the trademark ROAD AWARE in association with computer software for automated driving. You receive an Examiner's report which cites the following official mark:

Application No.: 987,654

Mark: ROAD AWARE

Owner: Alberta Ministry of Transportation

Filed: September 23, 1991

Advertised: November 30, 1991

After conducting some online research, you determine that the official mark ROAD AWARE was used by the Alberta Ministry of Transportation in the 1990's as part of a public service campaign to encourage safe driving, but has not been used since 1998.

What would be the most cost-effective way to try to overcome the Examiner's objection? **(1 mark)**

What is the relevant provision of the *Trade-marks Act* on which you would rely? **(1 mark)**

QUESTION 13 **(4 marks)**

Your client operates a small charter fishing business in Halifax, Nova Scotia in association with the trademark FISH FOCUS. It recently rebranded to this name and began using the trademark on October

30, 2018, but has not yet filed an application to register the mark. Yesterday, your client received a cease and desist letter from Crown Corp., a large crown corporation which operates under the oversight of the Federal Government. In its cease and desist letter, Crown Corp. relies on the following official mark.

Application No.: 912,345

Mark: FISH FOCUS

Owner: Crown Corp.

Filed: October 1, 2018

Advertised: November 12, 2018

13(a). What are the requirements to qualify as a “public authority” for the purposes of the *Trade-marks Act*? **(2 marks)**

13(b). Assuming that Crown Corp. qualifies as a “public authority” under the *Trade-marks Act*, in one sentence, explain your client’s strongest argument for continuing to use its trademark despite Crown Corp.’s complaint, with reference to the relevant provision of the *Trade-marks Act*. **(2 marks)**

QUESTION 14 (38 marks)

A partner at your firm calls you to his office. He explains to you that he has an oral hearing before the Trademarks Opposition Board next week, but is unable to attend as he decided to make a last minute trip to Vegas with his old law school buddies.

He gives you the file and asks that you attend the hearing at CIPO in his stead, his assistant having already changed the flight tickets to Ottawa to your name. He’s flying out later that day and will not have time to discuss the matter any further. He leaves you with the following words as he picks up his ringing phone: *“It’s a fairly simple matter, shouldn’t be a problem, just rely on my written arguments. I briefly read the applicant’s written arguments and I think I saw a few errors. Just point those out to the Hearing Officer and you’ll do just fine. Good luck!”*

You review the file and it can be summarised as follows:

- Your firm represents the opponent, Steve Jimson (an individual) who is the owner of registration No. TMA456,789 for the trademark BAGEL BAGEL in association with “restaurant services”;
- The applied for trademark is DOUBLE BAGEL, which was filed on January 13, 2017 on the basis of proposed use in association with the goods “bagels”;
- The statement of opposition raises the following grounds:
 - The applied for mark is not registrable as it is clearly descriptive or deceptively misdescriptive of the character of the goods, contrary to section 12(1)(b) of the *Trade-marks Act* (“TMA”);

- The applied for mark is not registrable as it is likely to be confusing with the opponent's trademark BAGEL BAGEL, registered in association with "restaurant services" (TMA456,789), contrary to section 12(1)(d) TMA; and
- The applicant is not the person entitled to the registration of the applied for mark as it is likely to be confusing with the opponent's trademark BAGEL BAGEL, which was used by the opponent or its licensee in association with restaurant services and bagels (sold as takeout) since 2008, contrary to section 16(3)(a) TMA;
- Mr. Jimson, the opponent, filed an affidavit to the following effect (for the sake of this question, do not presume any other fact, consider only those strictly indicated below):
 - He lives in Saskatoon, Saskatchewan;
 - He is a shareholder of Bagel Bagel & Son Inc., which owns a restaurant called BAGEL BAGEL in Regina, Saskatchewan, which opened in 2008 and which is actually run by his son, Robert;
 - Since 2008, BAGEL BAGEL has also been selling takeout bagels in small bags, the English side of which is shown below (representative invoices from Bagel Bagel & Son Inc. are also provided):



- BAGEL BAGEL has only one location, in Regina, but business has been very good, and Mr. Jimson plans on opening up other restaurants across the country, notably in Montreal where his daughter lives;
- The applicant's evidence is even briefer:
 - It owns a well- and long-established bakery in Montreal, Le Pâtissier au Bon Bedon, which is particularly known for its extra-large baked goods;
 - It started selling extra-large bagels in packs of six in grocery stores under the trademark DOUBLE BAGEL in June 2017 (a few invoices and a sample bag are attached as supporting evidence, which you can assume to validly show trademark use);
- There were no cross-examinations;
- The opponent's written arguments are very short and essentially state that the opponent has clearly met its evidential burden, notably by showing prior use of BAGEL BAGEL in association with bagels and the trademarks, BAGEL BAGEL and DOUBLE BAGEL, are essentially synonymous; the risk of confusion is obvious. Furthermore, DOUBLE BAGEL is descriptive of extra-large bagels; and
- The applicant's written arguments are reproduced in length further below.

14(a) (32 marks) The applicant's written arguments contain 8 clearly erroneous statements. Identify each erroneous statement (**2 marks for each correctly identified**) and provide a short explanation as to why each statement is erroneous (**2 marks for each correct explanation**). Only the first eight answers will be corrected. No marks will be given for identifying and debating a statement that may only be arguably erroneous.

The applicant's written arguments are as follows:

Applicant's Written Arguments

1. In light of the opposition by Mr. Steve Jimson and in view of the evidence filed, the applicant makes the following submission in support of its position that the opposition should be rejected and the application issue to allowance.
2. The applicant has applied to register the trademark DOUBLE BAGEL in association with the goods "bagels". The application is being opposed on the basis of allegations that the trademark is descriptive or deceptively misdescriptive (12(1)(b) of the *Trade-marks Act*; hereinafter "**TMA**") and confusingly similar with a registered trademark (12(1)(d) TMA) and/or a trademark that was previously used by the opponent (16(3)(a) TMA). The undersigned will first address the general issues of material dates and burden of proof before arguing more specifically the descriptive/misdescriptive ground and confusion grounds.

Material Dates

3. The material time to assess whether a mark is descriptive or deceptively misdescriptive in contravention of section 12(1)(b) TMA is the date of filing of the application (see *Fiesta*

Barbecues Ltd. v. General Housewares Corp., (2003), 28 CPR (4th) 60 (FC) at para. 26). As for the assessment of confusion, given that the application is based on proposed use, the material time is the date of filing of the application, namely January 13, 2017 (see section 16(1)(a) TMA).

Burden of Proof

4. Before assessing the grounds of opposition, it is necessary to review (i) the initial evidential burden on the opponent to support the allegations in the statement of opposition and (ii) the legal onus on the applicant to prove its case. With respect to (i) above, there is in accordance with the usual rules of evidence, an evidential burden on the opponent to prove the facts inherent in its allegations pleaded in the statement of opposition (see *Kirkbi AG v. Ritvik Holdings Inc.*, [2005] 3 S.C.R. 302 (SCC) at para. 8 – i.e. the LEGO case). The presence of an evidential burden on the opponent with respect to a particular issue means that in order for the issue to be considered at all, there must be sufficient evidence from which it could reasonably be concluded that the facts alleged to support that issue exist. With respect to (ii) above, the legal onus is on the applicant to show that the application does not contravene the provisions of the TMA as alleged by the opponent in the statement of opposition - for those allegations for which the opponent has met its evidential burden.

Arguments re Descriptiveness

5. The test for section 12(1)(b) TMA is one of first or immediate impression, considered from the perspective of the average consumer of the goods or services. The meaning of a trademark must be considered in the context of the goods and services; “character” in section 12(1)(b) TMA means a feature, trait or characteristic of the product and “clearly” does not mean the description has to be precise but must be “easy to understand, self-evident or plain” (see *Drackett Co. of Canada Ltd. v. American Home Products Corp.* (1968) 55 CPR 29 at 34 (Ex. Ct.)). For a mark to be clearly descriptive within the meaning of section 12(1)(b) TMA, a mark must be so apt for normal description of the goods or services that a monopoly on the use of it should not be acquired (see *Clarkson Gordon v. Registrar of Trademarks* (1985) 5 CPR (3d) 252 at 256 (FCTD)).
6. Further, to determine whether a trademark is registrable under s. 12(1)(b) TMA, the Registrar must not only consider the evidence but also apply common sense (see: *Neptune S.A. v. Attorney General of Canada* (2003) 29 CPR (4th) 497 (FCTD)). One of the most important purposes of section 12(1)(b) TMA is to protect the right of all traders to use apt descriptive language. The courts have recognized that descriptive words are the property of all and cannot be appropriated by one person for their exclusive use (see: *General Motors Corp. v. Bellows* (1949), 10 CPR 101 (SCC) at pp. 112-113).
7. Although the opponent did not file any evidence whatsoever regarding the meaning of the expression “double bagel”, the applicant is cognizant that the Registrar is entitled to take judicial notice of dictionary definitions, which therefore need not be filed by way of affidavit (see *Envirodrive Inc. v. 836442 Canada Inc.* 2005 ABQB 446, cited in *Yahoo! Inc v audible.ca inc.*, 2009 CanLII 90353 (TMOB)). As such, the applicant will not attempt to argue that the opponent has not met its initial evidentiary burden for this particular ground.
8. This being said, the applicant submits that the trademark DOUBLE BAGEL is merely suggestive and not descriptive, analogous to the trademark KOLD ONE for beer, which has been

determined of being only suggestive and not descriptive in the famous Federal Court of Appeal decision *Registrar of Trade Marks v. Provenzano* (1978), 40 C.P.R.(2d) 288. Indeed, the adjective “double”, when applied to bagels is not in any way descriptive of the intrinsic character or quality of the product. The size or number of bagels purchased is unrelated to the character or quality of the bagel itself. Accordingly, the word “double” as used in this mark refers only to the condition for which the bagels may or may be purchased and makes the trademark as a whole, when adopting a common sense approach, not clearly descriptive or deceptively misdescriptive.

9. In any event, there is a fundamental flaw in the opponent’s allegation that DOUBLE BAGEL is descriptive. The opponent is the owner of the trademark BAGEL BAGEL, which is registered and therefore not clearly descriptive. Therefore, if BAGEL BAGEL is deemed not to be descriptive or deceptively misdescriptive, then it automatically goes to prove that DOUBLE BAGEL can also be deemed not being to be descriptive or deceptively misdescriptive. What is good for the goose is good for the gander.
10. For the above reasons, the applicant respectfully requests that the opponent’s ground of opposition under section 12(1)(b) be dismissed.

Arguments re Confusion under 12(1)(d) TMA

11. An opponent’s initial evidential burden is met with respect to a section 12(1)(d) TMA ground of opposition if the registration relied upon in the statement of opposition is in good standing as of the date of the decision. The Opponent has failed to file any evidence of the existence of any registration or regarding the status of its standing and the ground of opposition based on section 12(1)(d) should therefore automatically be dismissed (see *Quaker Oats of Canada Ltd/La Compagnie Quaker Oats du Canada Ltée v Menu Foods Ltd* (1986), 11 CPR (3d) 410 (TMOB)).

Arguments re Confusion under 16(3)(a) TMA

12. The opponent’s affidavit shows that the trademark BAGEL BAGEL is in fact used by Bagel Bagel & Son Inc., a company only partially owned by Mr. Steve Jimson. That fact alone is insufficient to establish the existence of a licence within the meaning of section 50 TMA, especially since the affidavit is unclear whether Mr. Jimson is the controlling shareholder or merely a minority shareholder with no actual control over the activities of the company.
13. There must be evidence that the opponent controls the use of its trade marks by its subsidiary and takes steps to ensure the character and quality of the services provided (see *MCI Communications Corp. v. MCI Multinet Communications Inc.* (1995), 61 C.P.R. (3d) 245 (TMOB)).
14. The fact that Mr. Jimson has no control over the restaurant services allegedly offered by the company under the trademark BAGEL BAGEL is moreover made highly probable by the fact that Mr. Jimson resides in Saskatoon while the restaurant is in Regina (i.e. about 250 km away) and where Mr. Jimson specifically states that the restaurant is “actually run by his son, Robert”.
15. Since there is no evidence whatsoever of a licence between the opponent and the entity purportedly using the mark, the use of the trademark BAGEL BAGEL does not enure to the opponent, who has therefore failed to show any use of the trademark that forms the basis of its ground of opposition under section 16(3)(a). The opponent has thus failed to meet its initial evidential burden and this ground should therefore be dismissed.

16. In the unlikely event that the Registrar did conclude that there is a valid licence, the opponent's trademark and the applied for trademark are not confusing for the reasons more particularly set out below.
 17. The test to be applied is a matter of first impression in the mind of a casual consumer somewhat in a hurry who sees the latter mark, at a time when he or she has no more than an imperfect recollection of the prior trademarks, and does not pause to give the matter any detailed consideration or scrutiny, nor to examine closely the similarities and differences between the marks (see *Veuve Clicquot Ponsardin v. Boutiques Cliquot Ltée*, [2006] 1 S.C.R. 824, at para. 20 (SCC)).
 18. In applying the test for confusion, the Registrar must have regard only to the circumstances specifically enumerated in section 6(5) TMA, namely: (a) the inherent distinctiveness of the trade-marks and the extent to which they have become known; (b) the length of time each has 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 in appearance or sound or in the ideas suggested by them. These enumerated factors need not be attributed equal weight (see *Mattel, Inc v 3894207 Canada Inc*, 49 CPR (4th) 321 (SCC)).
 19. Regarding the first part of criterion (a), the trademarks at issue both have low inherent distinctiveness and this therefore does not favour any party.
 20. As for the second part of criterion (a) and for criterion (b), at the date of filing of the Applicant's trade-mark, the Opponent did not sell its product in the same geographic market as the Applicant (i.e. Montreal or anywhere in all of eastern Canada for that matter). Therefore, as concluded by the Federal Court of Appeal in *Masterpiece Inc. v. Alavida Lifestyles Inc.*, [2010] 4 FCR 243 (FCA) at para. 22, the Board therefore need not consider the Opponent's plans for expansion after that date and the mark BAGEL BAGEL cannot be deemed to have been known or used at the relevant time for the purpose of evaluating confusion. These criteria therefore also do not favour the opponent.
 21. The applicant concedes that criteria (c) and (d) favour the opponent.
 22. However, it is criterion (e) (i.e. degree of resemblance) that is often likely to have the greatest effect on the confusion analysis as pointed out by the Supreme Court in *Masterpiece*.
 23. It has been held that the first portion of a trademark is often the most relevant for the purpose of distinction. In the present matter, the first portion of each mark is clearly different (BAGEL vs. DOUBLE). Given that the second portion of the parties' marks (BAGEL) is somewhat descriptive of the nature or character of the parties' goods or services, the first portion is sufficient to distinguish one from another. Furthermore, the ideas suggested by the marks cannot be more different as the word "double" can simply not be considered to convey any idea remotely related to "bagel".
 24. In light of the above, it is also respectfully requested that the Registrar dismiss the opponent's argument based on confusion and allow the application to proceed to registration.
- 14(b).** After having reviewed the file, you feel very uncomfortable arguing the matter before the TMOB as you have only two and a half years of experience of doing trademark availability searches and

preparing trademark applications and have actually been a trademark agent for less than six months. You would therefore prefer that the partner who gave you this file argue the matter before the TMOB.

Provided that you obtain the applicant's consent in light of the circumstances, is the Board likely to grant a postponement of the hearing – Yes or No? **(1 mark)** Briefly explain **(1 mark)** and indicate the authority supporting your answer **(1 mark)**.

14(c). Presuming that no postponement was requested, what should you do? Briefly explain **(2 marks)** and indicate the authority supporting your answer **(1 mark)**.

QUESTION 15 (5 marks)

Match the case name with the applicable legal principle. You have been provided with more legal principles than cases. Only one case should be paired with one principle. If you provide multiple principles for a case, only the first legal principle given will be marked.

Case	Principle
a. <i>Venngo Inc. v. Concierge Connection Inc.</i> , 2017 FCA 96. Trademark: PERKOPOLIS	1. The degree of resemblance, although the last factor listed in s. 6(5), is the statutory factor that is often likely to have the greatest effect on the confusion analysis.
b. <i>Veuve Clicquot Ponsardin c. Boutiques Cliquot Ltée</i> , 2006 SCC 23. Trademark: VEUVE CLICQUOT	2. If a trademark is a geographic name that refers to the actual place of origin of the goods or services with which the trademark is associated, it is clearly descriptive of place of origin within the meaning of paragraph 12(1)(b) of the Act, and is therefore not registrable.
c. <i>MC Imports Inc. v. AFOD Ltd.</i> , 2016 FCA 60. Trademark: LINGAYEN	3. Although evidence of actual confusion may be an important factor in the analysis of whether there is a likelihood of confusion, it is not dispositive.
d. <i>Mattel U.S.A. Inc. v. 3894207 Canada Inc.</i> , 2006 SCC 22. Trademark: BARBIE	4. When buying a car or a refrigerator, more care will naturally be taken than when buying a doll or a mid-priced meal.
e. <i>Masterpiece Inc. v. Alavida Lifestyles Inc.</i> , 2011 SCC 27. Trademark: MASTERPIECE	5. Undoubtedly, the fame of a trademark is a circumstance of great importance because of the hold of famous marks on the public mind.
	6. Inferences about the state of the marketplace can only be drawn from state of the register evidence where large numbers of relevant registrations are located.
	7. There is nothing to prevent two registered trade-marks from being used at the same time.

END

TRADEMARK AGENT EXAM 2018
PAPER B
Total Marks: 150

QUESTION 1 (7 marks)

Your client owns registration No. TMA123,321 for the trademark MONDO in association with “cooking pots”. Last week, your client received a section 45 Notice from the Registrar in respect of this registration.

Your client advises that it is not currently using its MONDO mark, and that it:

- stopped selling MONDO cooking pots about 10 years ago after receiving numerous customer complaints regarding the quality of the product. Apparently, there was a problem with the ceramic used to make the pots causing them to crack.
- was able to identify the cause of the cracking defect, and that it would be possible to fix, but that to do so would be extremely costly.
- after realizing it would be very expensive to repair the cooking pots marketed under the MONDO mark, then shifted its focus over to its TERRA line of cooking pots, which are instead made of cast iron, especially since consumers seem to prefer cast iron pots anyway.

1(a). Identify the three criteria that the Board will consider in assessing whether the registrant has demonstrated special circumstances justifying the absence of use **(3 marks)**.

Answer:

The criteria are:

- a) The length of time during which the trademark has not been used **(1 mark)**;
- b) Whether the reasons for the absence of use were due to circumstances beyond the control of the registered owner; and **(1 mark)**
- c) Whether there exists a serious intention to resume use of the trademark shortly **(1 mark)**.

1(b). Based on the facts provided, is it likely that the registrant will be able to demonstrate special circumstances justifying the absence of use – Yes or No? **(1 mark)**. Applying the facts, explain your position relating to each of the three criteria that the Board will consider **(3 marks)**.

Answer:

No, it is not likely the Registrar will find that there are special circumstances **(1 mark)**

Explain:

- a) The length of time not in use is significant (10 years) **(1 mark)**
- b) the reason for the absence of use was not beyond the control of the owner – the problem with the goods had been identified and could be fixed, but from the facts, it appears the owner chose not to do the fix. **(1 mark)**
- c) the facts indicate that there is no serious intention to resume use shortly, because the owner shifted its focus to another product line instead of taking steps to address the issues with the cooking pots sold under the MONDO mark because consumers preferred other products anyway. **(1 mark)**

QUESTION 2 (13 marks)

On behalf of your client, you have requested the issuance of a section 45 notice against registration No. TMA123,456 for the trademark BLUE ZEBRA owned by Urban Jungle Products Inc. The mark is registered in association with the following goods:

Goods:

- (1) Sunscreen
- (2) Shampoo, namely shampoo and dry shampoo
- (3) Hair conditioner

The section 45 Notice was issued against Urban Jungle Products Inc's trademark on January 5, 2018 and the following affidavit was filed in response to this Notice:

AFFIDAVIT OF CHRISTINE ROBERTS

I, Christine Roberts, of the City of Edmonton, Alberta, hereby make oath and say as follows:

1. I am the president and director of Urban Jungle Products Inc (Urban Jungle or My Company), and have held this position since I founded Urban Jungle in March 2009. Based on the foregoing, I have personal knowledge of the matters set forth except where stated to be based on information and belief.
2. Urban Jungle owns registration No. TMA123,456 for the trademark BLUE ZEBRA (the Mark) in association with sunscreen; shampoo, namely shampoo and dry shampoo, and hair conditioners (collectively the Goods).
3. I have been advised by counsel that on January 5, 2018, the Canadian Intellectual Property Office issued a Section 45 Notice against the registration for the Mark requiring evidence showing use of the Mark in Canada with the Goods between the period of January 5, 2015 and January 5, 2018 (the Relevant Period).
4. Urban Jungle is a manufacturer of skin and hair care preparations. In the normal course of trade, My Company has sold during the Relevant Period, and continues to sell its BLUE ZEBRA brand skin and hair preparations to the Tundra Company (Tundra), a well-known national retailer, for resale to consumers in Canada.
5. Attached as Exhibit A is a photograph of a tube of sunscreen bearing the trademark BLUE ZEBRA, which is representative of the way the Mark has appeared on product packaging during the Relevant Period. Attached as Exhibit B is a representative sample of an invoice dated March 8, 2016 for the sale of BLUE ZEBRA sunscreen to Tundra.
6. Attached as Exhibit C is a photograph of a can of dry shampoo bearing the trademark BLUE--ZEBRA, which is representative of the way the Mark has appeared on product packaging during the Relevant Period.
7. Attached as Exhibit D is a photograph of the current packaging for hair conditioner sold in association with the trademark BLUE ZEBRA by Urban Jungle. Attached as Exhibit E are

representative invoices of recent invoices from the last two months issued by Urban Jungle to Tundra.

8. The annual gross sales of BLUE ZEBRA Goods in Canada for each of the years 2015 to 2018 has exceeded \$250,000 CAD. Approximately 60% of these annual sales can be attributed to skin care products; the remainder can be attributed to dry shampoo.

In accordance with the questions below, for each of the goods listed in the registration, provide your client with an opinion on whether the registration will be maintained or expunged for those goods and explain why. Base your opinion solely on the evidence provided and the relevant principles of law. Case law only needs to be cited where specifically requested.

- 2(a).** For the goods (1), namely “sunscreen”, advise whether the registration will be maintained or expunged **(1 mark)**. Give one reason to support your opinion **(1 mark)**.

Answer:

Registration for sunscreen will be maintained. **(1 mark)**

Reason: there is evidence of use OR of sales and a specimen bearing the Mark during the Relevant Period. **(1 mark)**

- 2(b).** For the goods (2), in accordance with the questions below, advise if the registration will be maintained or expunged for “shampoo, namely shampoo and dry shampoo”. In particular, consider that the trademark displayed on the can of dry shampoo in Exhibit C is “BLUE--ZEBRA” rather than BLUE ZEBRA:

- i. Will the registration be maintained or expunged for “shampoo, namely shampoo”? **(1 mark)** Explain why **(1 mark)**.

Answer:

Registration for “shampoo, namely shampoo” will be expunged. **(1 mark)**

Reason: no evidence of sales or specimens during the Relevant Period. **(1 mark)**

- ii. Will the registration be maintained or expunged for “shampoo, namely dry shampoo”? **(1 mark)** In your answer, identify the test that applies to situations where the mark as used in the marketplace differs from the mark as registered **(1 mark)**, identify the components of the test **(3 marks)**, cite one relevant case **(1 mark)**, and apply the test **(1 mark)**.

Answer:

Registration for “shampoo, namely dry shampoo” will be maintained. **(1 mark)**

The test is the deviation test **(1 mark)**; whether the mark as used is sufficiently close (OR minor variation OR language to that effect) to the mark as registered so as to sustain registration **(1 mark)**, by comparing the two marks and determining whether the differences are so unimportant OR key/main elements are the same **(1 mark)** that an unaware purchaser would be likely to infer that both trademarks, in spite of their differences, identify the goods as having the same origin **(1 mark)**.

Caselaw: *Registrar of Trade Marks v. Cie Internationale pour l’Informatique CII Honeywell Bull.* **(1 mark - no need for complete citation to receive the mark)** Would also accept *Promafil*

Canada Ltée v Munsingwear Inc (1992), 44 CPR (3d) 59 (FCA) (1 mark for applying the test in a way that makes sense)

2(c). For the goods (3), namely, “hair conditioner”, advise if the registration will be maintained or expunged (1 mark). Give a reason to support your opinion (1 mark).

Answer

Registration will be expunged. (1 mark)

Reason: representative samples and sales/invoices are outside the Relevant Period OR no evidence showing use during the Relevant Period. (1 mark)

QUESTION 3 (13 marks)

On September 5, 2018 a statement of opposition was filed by Abragio Inc (Abragio), owner of trademark registration No. TMA382,493 for ABRAGIO, against application No. 1,829,493 for the trademark ADAGIO, the particulars of which are below:

Applicant: Adagio Ltd

Filing date: March 8, 2017

Date of advertisement: July 5, 2018

Goods: (1) pizza, breadsticks, garlic bread, tomato sauce
(2) pasta

Services: restaurant services

Claims: proposed use with the Goods (1) and Services; use in Canada since September 29, 2012 with the Goods (2); use and registration in the United States in association with the Services;

Each ground of opposition below is deficient in one or more ways. For each ground of opposition, identify 1) the deficiency/deficiencies (1 mark per deficiency) and 2) how to remedy the deficiency/deficiencies (1 mark per remedy)

3(a). The application does not comply with sections 38(2)(a) and 30(a) of the *Trade-marks Act* (the Act) because various goods are not defined in ordinary commercial terms. (2 marks)

Answer:

Deficiency: can't reference 'various' goods OR must specify which goods. (1 mark)

Remedy: need to list the specific goods. (1 mark)

3(b). The application does not comply with sections 38(2)(a) and 30(d) of the Act because the Mark is not registered in the United States with the Services or the Mark was not used in the United States with the Services. (2 marks)

Answer:

Deficiency: unclear from the pleading whether the ground of opposition alleges the Mark is not registered in the US or alleges the Mark was not used in the US. (1 mark)

Remedy: need to specify which or both the opponent is relying on. (1 mark)

3(c). The application does not comply with sections 38(2)(a) and 30(e) of the Act in that the applicant did not intend to use the Mark in association with the Goods (1) and Services because the applicant was aware, or ought to have been aware, of the opponent's trade-mark ABRAGIO which is well-known in Canada due to the extensive and prior use in Canada in association with Italian food, including pizza. **(2 marks)**

Answer:

Deficiency: applicant's knowledge of the opponent's mark does not support a section 30(e) ground of opposition. **(1 mark)**

Remedy: the opponent needs to provide another reason why the applicant could not properly make the required statement of intent to use. **(1 mark)**

3(d). The application does not comply with sections 38(2)(b) and 12(1)(d) of the Act because it is confusing with Abragio's registration No. TMA384,295 for the trademark ABRAGIO; Abragio's registration for the trademark ABRAGIO EXPRESS; and Abragio's applications for the trademark ABRAGIO NORTH, both covering pizza. **(4 marks)**

Answer:

Deficiency 1: the registration No for ABRAGIO EXPRESS is missing. **(1 mark)**

Deficiency 2: the opponent can't rely on a pending application, only registered marks. **(1 mark)**

Deficiency 3, because of a typographical error in the exam, the following answer was also accepted: the registration number for the trademark ABRAGIO is incorrect. **(1 mark)**

Remedy 1: provide the registration No. for the trademark ABRAGIO EXPRESS **(1 mark)**

Remedy 2: the opponent can't rely on pending applications, only registrations, so must remove reference to the pending apps **(1 mark)**

Remedy 3: indicate the proper registration number **(1 mark)**

3(e). The application does not comply with sections 38(2)(c) and 16(3)(a) of the Act because, at the date of filing of the application for the Mark it was confusing with the trademark ABBRUZO previously used by BBY Inc. in association with restaurant services. **(2 marks)** In identifying the deficiency, cite the specific section of the *Trade-marks Act* that is the basis for your answer. **(1 mark)**

Answer

Deficiency: the opponent cannot rely on the use of a mark by any person other than itself **(1 mark)** per restriction in section 17(1) of the Act **(1 mark)**.

Remedy: opponent can rely on and reference the use of its own mark OR delete this ground. **(1 mark)**

QUESTION 4 – TRUE OR FALSE (5 marks)

Identify whether the statements below are true or false.

- a) In section 45 proceedings, the sole form through which evidence may be submitted is by affidavit. **(1 mark)**

- b) In a section 45 proceeding, the Requesting Party has four months in which to file its evidence after the registered owner has filed its evidence in response to a section 45 notice. **(1 mark)**
- c) Evidence in section 45 proceedings may not be filed with the Registrar by facsimile. **(1 mark)**
- d) Where new evidence is filed on appeal of a decision in a section 45 proceeding, the requesting party may cross-examine on this evidence. **(1 mark)**
- e) The maximum benchmark extension of time for the registered owner to file evidence in a section 45 proceeding is 3 months. **(1 mark)**

Answer:

- (a) False
- (b) False
- (c) True
- (d) True
- (e) False

QUESTION 5 (4 marks)

Your client is interested in registering the trademark JOIE for use in association with “cookies, doughnuts, pies” and has asked you to conduct a trademark search to assess the availability of the mark for registration.

Your search disclosed the following trademark registration as a potential obstacle to registration of your client’s proposed trademark:

Trademark: JOIE

Registration No.: TMA876,543

Goods:

- (1) Cookies and cupcakes;
- (2) Doughnuts

Claims:

- (1) Use in Canada since March 2002
- (2) Use in Canada since September 2015

The registration issued in respect of the goods (1) on April 3, 2005, and the registration was amended to add the goods (2) on January 11, 2017.

In your review, you notice that a section 45 notice had previously been issued against the registration in respect of the goods (1) (cookies and cupcakes), and the Registrar issued a decision maintaining the registration on September 27, 2012.

Your client wants to know if this registration is vulnerable to summary cancellation for non-use. Specifically, assuming there is no evidence of use of mark:

5(a). For the goods (1) (cookies and cupcakes), is TMA876,543 vulnerable to summary cancellation for non-use? **(1 mark)** Give one reason to support your opinion **(1 mark)**

Answer

Yes, the registration is vulnerable to summary cancellation. **(1 mark)**

Reason: a request (should it be initiated) would be outside of 3 years of the date of the previous Section 45 Notice. **(1 mark)**

5(b). For the goods (2) (doughnuts), is TMA876,543 vulnerable to summary cancellation for non-use? **(1 mark)** Give one reason to support your opinion **(1 mark)**

Answer

No, the registration is not vulnerable to summary cancellation. **(1 mark)**

Reason: the Registrar considers that the 3 year period applies from the date of the amendment, which in this case is January 11, 2017. **(1 mark)**

QUESTION 6 (8 marks)

Your client is a surfboard manufacturer located in Tofino, British Columbia. Founded in 2008, your client has grown steadily over the last decade to become very popular across Canada and sells surfboards under its well-known brand SURF GURU through its brick and mortar stores in Tofino, Vancouver, Calgary, and Toronto. The client also sells its SURF GURU surfboards, through its company website, to consumers in major cities across Canada, including Montreal, Quebec City, and Halifax.

The client has filed an application for the trademark SURF GURU, which has just been advertised in the *Trademarks Journal*.

It has come to the client's attention that a new surfboard manufacturer called Zen Inc. has just started up business, opening up a store in the Montreal area offering for sale and selling surfboards in association with the identical trademark SURF GURU. Your client is very concerned that consumers will confuse this mark with its SURF GURU brand and wants to stop Zen Inc.

6(a). Your client wants you to bring an action for trademark infringement against Zen Inc. without delay. Is this possible? **(1 mark)** Explain why or why not **(1 mark)**.

Answer

Not possible. **(1 mark)**

The client's application has not yet issued to registration and you need a registration to be able to rely on ss 19, 20 of the *Trade-marks Act*. **(1 mark)**

6(b). Your client also wants to know if, at this time, it would be possible to bring an action for depreciation of goodwill of the client's SURF GURU trademark? **(1 mark)** Explain why or why not. **(1 mark)**

Answer:

Not possible. **(1 mark)**

The client's application has not yet issued to registration and you need a registered mark to be able to rely on s 22 of the *Trade-marks Act*. **(1 mark)**

6(c). What valid cause of action can the client bring against Zen Inc. and what elements must the client demonstrate in order to succeed in that cause of action? **(4 marks)**

Answer:

Action for passing off **(1 mark)**

Plaintiff must establish:

- 1) Goodwill or reputation in the trademark; **(1 mark)**
- 2) Deception of the public due to misrepresentation by the Defendant **(1 mark)**, and;
- 3) Actual or potential damage to the plaintiff **(1 mark)**

QUESTION 7 **(21 marks)**

Your client is a company based in Norway that manufactures industrial water pumps for use in the off-shore oil and gas industry. It does not own any trademark registrations or applications in Canada, but has been selling its water pumps under the trademark VIKING in Canada since 2014. Your client contacts you to ask your advice regarding the trademark application set out below, since the client is considering opposing this application.

Application No.: 1,234,567

Trademark: VIKING

Applicant name/address:

Nomanda, Inc.

1 Bay Street, Toronto, Ontario

Goods:

- (1) Cross-cut saw blades; blades for hand saws; computer software to operate industrial saws.
- (2) Oil well pumping machines.

Services:

- (1) Forestry management; forestry management consulting services.
- (2) Off-shore oil pumping and extraction.

Claims:

Use in Canada since at least as early as 2010 on goods (1) and services (1).

Proposed use on goods (2) and services (2).

Filing date: July 16, 2016

Advertisement date: October 25, 2018

After conducting some preliminary online research, it appears that Nomanda Inc. has been using the trademark VIKING in association with goods (1) and services (1) in Canada since the date claimed in the application, but has not yet started using the mark in association with goods (2) and services (2). Also, your client indicates that Nomanda, while very active in the forestry sector, has not taken any steps under *The Canada Petroleum Resources Act* to acquire the requisite approval from the Federal Government to engage in off-shore oil drilling activities.

7(a). December 25, 2018 is a Tuesday. What is the latest date on which you can file a Statement of Opposition or request an extension of time? **(1 mark)** In one sentence, explain the reason you identified that date **(1 mark)**.

Answer:

December 27, 2018. **(1 mark)**

Candidate must recognize that Christmas Day and Boxing Day are treated as *dies non*, allowing filing as late as December 27, 2018. **(1 mark)**

7(b). What is the duration of the longest single extension of time which is available to your client at this stage? **(1 mark)** What are the requirements to obtain that extension of time? **(2 marks)**

Answer:

9 months **(1 mark)**. Consent of Applicant **(1 mark)** and payment of the requisite fee **(1 mark)**.

7(c). Identify the four best grounds of opposition for your client to assert against this application **(4 marks)**. Cite the two relevant provisions of the *Trade-marks Act* to support each of those grounds of opposition. **(8 marks)**

Answer:

Pursuant to section 38(2)(c) **(1 mark)** and section 16(3)(a) **(1 mark)** of the *Trade-marks Act*, the Applicant is not the person entitled to registration of the trademark in association with goods (2) and services (2) in view of the client's prior use of its trademark in association with water pumps for the off-shore oil and gas industry **(1 mark)**.

Pursuant to section 38(2)(d) **(1 mark)** and s. 2 **(1 mark)** of the *Trade-marks Act*, the mark is not distinctive in association with goods (2) and services (2), in view of the client's prior use of its trademark in association with water pumps for the off-shore oil and gas industry **(1 mark)**.

Pursuant to section 38(2)(a) **(1 mark)**, the application does not comply with section 30(i) **(1 mark)** of the *Trade-marks Act* because the applicant could not have been satisfied that it was entitled to use the mark

in association with services (2) because such use would not be compliant with *The Canada Petroleum Resources Act* (1 mark).

Pursuant to section 38(2)(a) **(1 mark)**, the application does not comply with section 30(e) **(1 mark)** of the *Trade-marks Act* because the applicant did not intend to use the mark in association with goods (2) and services (2) **(1 mark)**.

7(d). Your client decides to obtain an extension of time to oppose the application and would like you to contact the Applicant to determine if an amicable resolution of the matter might be possible. Identify four possible coexistence terms that would assist your client in preserving any trademark rights it has or might want to obtain in Canada. **(4 marks – Only the first four answers will be marked)**

Answer: (any of the following to a maximum of 4 marks)

Applicant deletes goods (2) and services (2) from application. **(1 mark)**

Applicant agrees not to use the mark in association with goods (2) and services (2). **(1 mark)**

Applicant agrees to consent to client applying to register VIKING in association with water pumps for use in the off-shore oil and gas industry. **(1 mark)**

Client agrees to withdraw opposition and not contest Applicant's use of mark on goods (1) and services (1). **(1 mark)**

Applicant partially assigns application in respect of goods (2) and services (2) to client. **(1 mark)**

Merge both companies **(1 mark)**

QUESTION 8 (7 marks)

Your client, a national chain of brew pubs, owns trademark registration no. TMA678,910 for the trademark SANDCASTLE in association with beer. This trademark was registered on November 18, 2010 and your client has been using the mark continuously since September 2010. In your regular watch search for this client, the following trademark application is identified:

Application No.: 1,987,654

Trademark: SANDCASTLE BREW

Applicant name/address:

Windy Beach Brewing Co.

188 Sandy Way, Parksville, British Columbia

Goods: Alcoholic beverages, namely, beer and cider.

Claims: Use of the mark in Canada since at least as early as 2008.

Filing date: August 15, 2017

Advertisement date: November 1, 2018

After hiring an investigator to acquire more facts, you discover that Windy Beach Brewing Co. is a small craft brewing operation in Parksville, British Columbia, which appears to have been using the trademark SANDCASTLE BREW since 2008 in association with beer and cider as claimed in the application. Windy Beach Brewing Co. is a very small business that does not have a website and is only selling its product in the local area at farmer's markets and local restaurants.

When you advise the client about this application, your client indicates that it was not, and never had been, aware of this small business in Parksville when the client adopted the trademark SANDCASTLE.

8(a). If the client decides to oppose application no. 1,987,654, can it rely on its registration TMA678,910 as a ground of opposition? **(1 mark)** If the client were to rely on this registration, what are the two relevant provisions of the *Trade-marks Act* to support that ground of opposition? **(2 marks)**

Answer:

Yes **(1 mark)**. Section 38(2)(b) **(1 mark)** and section 12(1)(d) of the *Trade-marks Act* **(1 mark)**.

8(b). Assuming all of the facts in the above question are true, is the client's registration TMA678,910 vulnerable to invalidation based on Windy Beach Brewing Co.'s use of its mark SANDCASTLE BREW? **(1 mark)** Explain why or why not **(2 marks)** with reference to the relevant provisions of the *Trade-marks Act* **(1 mark)**.

Answer:

No **(1 mark)**. Client's registration is incontestable **(1 mark)** and client did not have knowledge of the previous use of the mark SANDCASTLE BREW by Windy Beach Brewing Co. when it adopted the mark SANDCASTLE **(1 mark)**. Section 17(2) of *Trade-marks Act* **(1 mark)**.

QUESTION 9 (10 marks)

Your client is a running shoe manufacturer that is presently opposing the following trademark application by its main competitor:

Application No.: 1,789,101

Trademark: MAXIMALIST

Applicant name/address:

Green Mountain Footwear, Inc.

1 Cherry Street, Burlington, Vermont

Goods: Running shoes

Claims: Use of the mark in Canada since at least as early as February 20, 2016.

Filing date: March 15, 2016.

Advertisement date: March 4, 2017.

Your client's Statement of Opposition is based solely on the grounds that the trademark applied for is not registrable because it is clearly descriptive of the goods and is not distinctive of the applicant because the mark is clearly descriptive.

The Applicant's Rule 42 evidence includes an affidavit from the Applicant's CEO, which includes sales records which suggest that the first shipments of the goods bearing the trademark MAXIMALIST arrived in Canada and were received by customers on February 27, 2016.

9(a). In view of the Applicant's evidence, what additional ground of opposition could the client seek to rely upon? **(1 mark)** What are the relevant provisions of the *Trade-marks Act* that support that ground? **(2 marks)**

Answer:

Applicant has not used the trademark in Canada since the date claimed in the application **(1 mark)**.
Section 38(2)(a) **(1 mark)** and Section 30(b) **(1 mark)**.

9(b). Is the client likely to be permitted to amend its Statement of Opposition at this stage to include this additional ground of opposition – Yes or No? **(1 mark)** Briefly explain why or why not, with reference to the relevant factors that will be considered by the Board and citing the relevant provision of the *Trade-marks Regulations*. **(6 marks)**

Answer:

Yes **(1 mark)**.

Candidate must reference Rule 40 of the *Trade-marks Regulations* **(1 mark)**, each the four relevant factors below **(4 marks)**, and an additional point is given for applying the factors in a way that makes sense **(1 mark)**:

1. the stage the opposition proceeding has reached;
2. why the amendment was not made or the evidence not filed earlier;
3. the importance of the amendment or the evidence; and
4. the prejudice which will be suffered by the other (or either) party.

QUESTION 10 (8 marks)

10.(a) Similar to the context of a legal action, objections made during cross-examination of an affiant can, as of right, be ruled upon during the course of an opposition (i.e. prior to the argument stage) as to whether certain questions asked in cross-examination should be answered or whether answers given are adequate. True or false? **(1 mark)** Briefly support your answer with an explanation. **(2 marks)**

Answer:

False. **(1 mark)** The Registrar does not have authority **(1 mark)** to make interlocutory rulings on questions asked on cross-examination **(1 mark)**

10.(b) In the context of a cross-examination, the agent representing the applicant requests that accounting records for the last ten years be provided for the product sold under the trademark that is the basis for the opponent's grounds of opposition relating to confusion. In light of the fact that the affidavit already includes a statement to the effect that "*global sales figures for the opponent's goods over the last ten years exceed \$5,000,000*", and that the request is particularly onerous, should you object to the request in the interest of your client (to keep costs low for example) – Yes or No **(1 mark)**? Provide a brief explanation supporting your answer to best serve your client's interests **(4 marks)**.

Answer:

No. **(1 mark)** The request is clearly related to a statement in the affidavit **(1 mark)** that is relevant to the issue of confusion. **(1 mark)** Failing to provide an answer can result in negative inferences being drawn **(1 mark)** or in the affidavit being ignored at the decision stage **(1 mark)**.

QUESTION 11 (5 marks)

It's 3PM on a Friday afternoon before a long weekend and you get an e-mail from a regular client, which you immediately read. The e-mail is to the following effect:

- A directly competitive product has just come out under the trademark X (a photograph of the product bearing the mark is attached to the e-mail);
- The client owns the registered trademark Y and it appears on its products (a photograph is also provided);
- The client wants to know if there is a risk of confusion and if any action can be taken against the owner of the trademark X.

A preliminary review suggests there is a very good likelihood that confusion can be proven (although a more complete factual background could change your very preliminary opinion). But before you respond to the client to give your assessment, you want to make sure that the owner of trademark X is not, perchance, a client of your firm.

Since your client did not provide you with the name of the owner of trademark X, you can't immediately refer the verification to the appropriate person at your firm. So you decide to check out the trademark database to see if that could help you to identify an owner.

You quickly find out that an application for the trademark X was recently published in the *Trademarks Journal* and that the opposition deadline expired two weeks ago. You scroll down the result page and you see that your firm is actually prosecuting the application, although you never heard of that particular client. What do you do? (2 marks) Briefly indicate why (3 marks).

Answer:

You refer your client to an agent at another firm (1 mark) as soon as possible/immediately (1 mark). There is a clear conflict of interest (1 mark) and any further delay reduces client Y's chances of being able to obtain a retroactive extension of time to oppose (1 mark), which could additionally expose your firm to professional liability (1 mark).

QUESTION 12 (2 marks)

Your client has filed an application for the trademark ROAD AWARE in association with computer software for automated driving. You receive an Examiner's report which cites the following official mark:

Application No.: 987,654

Mark: ROAD AWARE

Owner: Alberta Ministry of Transportation

Filed: September 23, 1991

Advertised: November 30, 1991

After conducting some online research, you determine that the official mark ROAD AWARE was used by the Alberta Ministry of Transportation in the 1990's as part of a public service campaign to encourage safe driving, but has not been used since 1998.

What would be the most cost-effective way to try to overcome the Examiner's objection? (1 mark)

What is the relevant provision of the *Trade-marks Act* on which you would rely? (1 mark)

Answer:

Seek the written consent of the Alberta Ministry of Transportation to the registration of the client's trademark. (1 mark)

Section 9(2)(a) of the *Trade-marks Act*. (1 mark)

QUESTION 13 (4 marks)

Your client operates a small charter fishing business in Halifax, Nova Scotia in association with the trademark FISH FOCUS. It recently rebranded to this name and began using the trademark on October 30, 2018, but has not yet filed an application to register the mark. Yesterday, your client received a cease and desist letter from Crown Corp., a large crown corporation which operates under the oversight of the Federal Government. In its cease and desist letter, Crown Corp. relies on the following official mark.

Application No.: 912,345

Mark: FISH FOCUS

Owner: Crown Corp.

Filed: October 1, 2018

Advertised: November 12, 2018

13(a). What are the requirements to qualify as a “public authority” for the purposes of the *Trade-marks Act*? **(2 marks)**

Answer:

- a significant degree of control must be exercised by the appropriate government over the activities of the body; **(1 mark)** and
- the activities of the body must benefit the public. **(1 mark)**

13(b). Assuming that Crown Corp. qualifies as a “public authority” under the *Trade-marks Act*, in one sentence, explain your client’s strongest argument for continuing to use its trademark despite Crown Corp.’s complaint, with reference to the relevant provision of the *Trade-marks Act*. **(2 marks)**

Answer:

Client commenced using the trademark before the Registrar gave public notice of Official Mark No. 912,345. **(1 mark)**

Section 9(1)(n) of the *Trade-marks Act*. **(1 mark)**

QUESTION 14 (38 marks)

A partner at your firm calls you to his office. He explains to you that he has an oral hearing before the Trademarks Opposition Board next week, but is unable to attend as he decided to make a last minute trip to Vegas with his old law school buddies.

He gives you the file and asks that you attend the hearing at CIPO in his stead, his assistant having already changed the flight tickets to Ottawa to your name. He's flying out later that day and will not have time to discuss the matter any further. He leaves you with the following words as he picks up his ringing phone: *"It's a fairly simple matter, shouldn't be a problem, just rely on my written arguments. I briefly read the applicant's written arguments and I think I saw a few errors. Just point those out to the Hearing Officer and you'll do just fine. Good luck!"*

You review the file and it can be summarised as follows:

- Your firm represents the opponent, Steve Jimson (an individual) who is the owner of registration No. TMA456,789 for the trademark BAGEL BAGEL in association with "restaurant services";
- The applied for trademark is DOUBLE BAGEL, which was filed on January 13, 2017 on the basis of proposed use in association with the goods "bagels";
- The statement of opposition raises the following grounds:
 - The applied for mark is not registrable as it is clearly descriptive or deceptively misdescriptive of the character of the goods, contrary to section 12(1)(b) of the *Trade-marks Act* ("TMA");
 - The applied for mark is not registrable as it is likely to be confusing with the opponent's trademark BAGEL BAGEL, registered in association with "restaurant services" (TMA456,789), contrary to section 12(1)(d) TMA; and
 - The applicant is not the person entitled to the registration of the applied for mark as it is likely to be confusing with the opponent's trademark BAGEL BAGEL, which was used by the opponent or its licensee in association with restaurant services and bagels (sold as takeout) since 2008, contrary to section 16(3)(a) TMA;
- Mr. Jimson, the opponent, filed an affidavit to the following effect (for the sake of this question, do not presume any other fact, consider only those strictly indicated below):
 - He lives in Saskatoon, Saskatchewan;
 - He is a shareholder of Bagel Bagel & Son Inc., which owns a restaurant called BAGEL BAGEL in Regina, Saskatchewan, which opened in 2008 and which is actually run by his son, Robert;
 - Since 2008, BAGEL BAGEL has also been selling takeout bagels in small bags, the English side of which is shown below (representative invoices from Bagel Bagel & Son Inc. are also provided):



- BAGEL BAGEL has only one location, in Regina, but business has been very good, and Mr. Jimson plans on opening up other restaurants across the country, notably in Montreal where his daughter lives;
- The applicant's evidence is even briefer:
 - It owns a well- and long-established bakery in Montreal, Le Pâtissier au Bon Bedon, which is particularly known for its extra-large baked goods;
 - It started selling extra-large bagels in packs of six in grocery stores under the trademark DOUBLE BAGEL in June 2017 (a few invoices and a sample bag are attached as supporting evidence, which you can assume to validly show trademark use);
- There were no cross-examinations;
- The opponent's written arguments are very short and essentially state that the opponent has clearly met its evidential burden, notably by showing prior use of BAGEL BAGEL in association with bagels and the trademarks, BAGEL BAGEL and DOUBLE BAGEL, are essentially synonymous; the risk of confusion is obvious. Furthermore, DOUBLE BAGEL is descriptive of extra-large bagels; and
- The applicant's written arguments are reproduced in length further below.

14(a) (32 marks) The applicant's written arguments contain 8 clearly erroneous statements. Identify each erroneous statement (**2 marks for each correctly identified**) and provide a short explanation as to why each statement is erroneous (**2 marks for each correct explanation**). Only the first eight answers will be corrected. No marks will be given for identifying and debating a statement that may only be arguably erroneous.

The applicant's written arguments are as follows:

Applicant's Written Arguments

1. In light of the opposition by Mr. Steve Jimson and in view of the evidence filed, the applicant makes the following submission in support of its position that the opposition should be rejected and the application issue to allowance.
2. The applicant has applied to register the trademark DOUBLE BAGEL in association with the goods "bagels". The application is being opposed on the basis of allegations that the trademark is descriptive or deceptively misdescriptive (12(1)(b) of the *Trade-marks Act*; hereinafter "**TMA**") and confusingly similar with a registered trademark (12(1)(d) TMA) and/or a trademark that was previously used by the opponent (16(3)(a) TMA). The undersigned will first address the general issues of material dates and burden of proof before arguing more specifically the descriptive/misdescriptive ground and confusion grounds.

Material Dates

3. The material time to assess whether a mark is descriptive or deceptively misdescriptive in contravention of section 12(1)(b) TMA is the date of filing of the application (see *Fiesta Barbecues Ltd. v. General Housewares Corp.*, (2003), 28 CPR (4th) 60 (FC) at para. 26). As for the assessment of confusion, given that the application is based on proposed use, the material time is the date of filing of the application, namely January 13, 2017 (see section 16(1)(a) TMA).

Burden of Proof

4. Before assessing the grounds of opposition, it is necessary to review (i) the initial evidential burden on the opponent to support the allegations in the statement of opposition and (ii) the legal onus on the applicant to prove its case. With respect to (i) above, there is in accordance with the usual rules of evidence, an evidential burden on the opponent to prove the facts inherent in its allegations pleaded in the statement of opposition (see *Kirkbi AG v. Ritvik Holdings Inc.*, [2005] 3 S.C.R. 302 (SCC) at para. 8 – i.e. the LEGO case). The presence of an evidential burden on the opponent with respect to a particular issue means that in order for the issue to be considered at all, there must be sufficient evidence from which it could reasonably be concluded that the facts alleged to support that issue exist. With respect to (ii) above, the legal onus is on the applicant to show that the application does not contravene the provisions of the TMA as alleged by the opponent in the statement of opposition - for those allegations for which the opponent has met its evidential burden.

Arguments re Descriptiveness

5. The test for section 12(1)(b) TMA is one of first or immediate impression, considered from the perspective of the average consumer of the goods or services. The meaning of a trademark must

be considered in the context of the goods and services; “character” in section 12(1)(b) TMA means a feature, trait or characteristic of the product and “clearly” does not mean the description has to be precise but must be “easy to understand, self-evident or plain” (see *Drackett Co. of Canada Ltd. v. American Home Products Corp.* (1968) 55 CPR 29 at 34 (Ex. Ct.)). For a mark to be clearly descriptive within the meaning of section 12(1)(b) TMA, a mark must be so apt for normal description of the goods or services that a monopoly on the use of it should not be acquired (see *Clarkson Gordon v. Registrar of Trademarks* (1985) 5 CPR (3d) 252 at 256 (FCTD)).

6. Further, to determine whether a trademark is registrable under s. 12(1)(b) TMA, the Registrar must not only consider the evidence but also apply common sense (see: *Neptune S.A. v. Attorney General of Canada* (2003) 29 CPR (4th) 497 (FCTD)). One of the most important purposes of section 12(1)(b) TMA is to protect the right of all traders to use apt descriptive language. The courts have recognized that descriptive words are the property of all and cannot be appropriated by one person for their exclusive use (see: *General Motors Corp. v. Bellows* (1949), 10 CPR 101 (SCC) at pp. 112-113).
7. Although the opponent did not file any evidence whatsoever regarding the meaning of the expression “double bagel”, the applicant is cognizant that the Registrar is entitled to take judicial notice of dictionary definitions, which therefore need not be filed by way of affidavit (see *Envirodrive Inc. v. 836442 Canada Inc.* 2005 ABQB 446, cited in *Yahoo! Inc v audible.ca inc.*, 2009 CanLII 90353 (TMOB)). As such, the applicant will not attempt to argue that the opponent has not met its initial evidentiary burden for this particular ground.
8. This being said, the applicant submits that the trademark DOUBLE BAGEL is merely suggestive and not descriptive, analogous to the trademark KOLD ONE for beer, which has been determined of being only suggestive and not descriptive in the famous Federal Court of Appeal decision *Registrar of Trade Marks v. Provenzano* (1978), 40 C.P.R.(2d) 288. Indeed, the adjective “double”, when applied to bagels is not in any way descriptive of the intrinsic character or quality of the product. The size or number of bagels purchased is unrelated to the character or quality of the bagel itself. Accordingly, the word “double” as used in this mark refers only to the condition for which the bagels may or may be purchased and makes the trademark as a whole, when adopting a common sense approach, not clearly descriptive or deceptively misdescriptive.
9. In any event, there is a fundamental flaw in the opponent’s allegation that DOUBLE BAGEL is descriptive. The opponent is the owner of the trademark BAGEL BAGEL, which is registered and therefore not clearly descriptive. Therefore, if BAGEL BAGEL is deemed not to be descriptive or deceptively misdescriptive, then it automatically goes to prove that DOUBLE BAGEL can also be deemed not being descriptive or deceptively misdescriptive.
10. For the above reasons, the applicant respectfully requests that the opponent’s ground of opposition under section 12(1)(b) be dismissed.

Arguments re Confusion under 12(1)(d) TMA

11. An opponent’s initial evidential burden is met with respect to a section 12(1)(d) TMA ground of opposition if the registration relied upon in the statement of opposition is in good standing as of the date of the decision. The Opponent has failed to file any evidence of the existence of any registration or regarding the status of its standing and the ground of opposition based on

section 12(1)(d) should therefore automatically be dismissed (see *Quaker Oats of Canada Ltd/La Compagnie Quaker Oats du Canada Ltée v Menu Foods Ltd* (1986), 11 CPR (3d) 410 (TMOB)).

Arguments re Confusion under 16(3)(a) TMA

12. The opponent's affidavit shows that the trademark BAGEL BAGEL is in fact used by Bagel Bagel & Son Inc., a company only partially owned by Mr. Steve Jimson. That fact alone is insufficient to establish the existence of a licence within the meaning of section 50 TMA, especially since the affidavit is unclear whether Mr. Jimson is the controlling shareholder or merely a minority shareholder with no actual control over the activities of the company.
13. There must be evidence that the opponent controls the use of its trade marks by its subsidiary and takes steps to ensure the character and quality of the services provided (see *MCI Communications Corp. v. MCI Multinet Communications Inc.* (1995), 61 C.P.R. (3d) 245 (TMOB)).
14. The fact that Mr. Jimson has no control over the restaurant services allegedly offered by the company under the trademark BAGEL BAGEL is moreover made highly probable by the fact that Mr. Jimson resides in Saskatoon while the restaurant is in Regina (i.e. about 250 km away) and where Mr. Jimson specifically states that the restaurant is "actually run by his son, Robert".
15. Since there is no evidence whatsoever of a licence between the opponent and the entity purportedly using the mark, the use of the trademark BAGEL BAGEL does not enure to the opponent, who has therefore failed to show any use of the trademark that forms the basis of its ground of opposition under section 16(3)(a). The opponent has thus failed to meet its initial evidential burden and this ground should therefore be dismissed.
16. In the unlikely event that the Registrar did conclude that there is a valid licence, the opponent's trademark and the applied for trademark are not confusing for the reasons more particularly set out below.
17. The test to be applied is a matter of first impression in the mind of a casual consumer somewhat in a hurry who sees the latter mark, at a time when he or she has no more than an imperfect recollection of the prior trademarks, and does not pause to give the matter any detailed consideration or scrutiny, nor to examine closely the similarities and differences between the marks (see *Veuve Clicquot Ponsardin v. Boutiques Cliquot Ltée*, [2006] 1 S.C.R. 824, at para. 20 (SCC)).
18. In applying the test for confusion, the Registrar must have regard only to the circumstances specifically enumerated in section 6(5) TMA, namely: (a) the inherent distinctiveness of the trade-marks and the extent to which they have become known; (b) the length of time each has 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 in appearance or sound or in the ideas suggested by them. These enumerated factors need not be attributed equal weight (see *Mattel, Inc v 3894207 Canada Inc*, 49 CPR (4th) 321 (SCC)).
19. Regarding the first part of criterion (a), the trademarks at issue both have low inherent distinctiveness and this therefore does not favour any party.

20. As for the second part of criterion (a) and for criterion (b), at the date of filing of the Applicant's trade-mark, the Opponent did not sell its product in the same geographic market as the Applicant (i.e. Montreal or anywhere in all of eastern Canada for that matter). Therefore, as concluded by the Federal Court of Appeal in *Masterpiece Inc. v. Alavida Lifestyles Inc.*, [2010] 4 FCR 243 (FCA) at para. 22, the Board therefore need not consider the Opponent's plans for expansion after that date and the mark BAGEL BAGEL cannot be deemed to have been known or used at the relevant time for the purpose of evaluating confusion. These criteria therefore also do not favour the opponent.
21. The applicant concedes that criteria (c) and (d) favour the opponent.
22. However, it is criterion (e) (i.e. degree of resemblance) that is often likely to have the greatest effect on the confusion analysis as pointed out by the Supreme Court in *Masterpiece*.
23. It has been held that the first portion of a trademark is often the most relevant for the purpose of distinction. In the present matter, the first portion of each mark is clearly different (BAGEL vs. DOUBLE). Given that the second portion of the parties' marks (BAGEL) is somewhat descriptive of the nature or character of the parties' goods or services, the first portion is sufficient to distinguish one from another. Furthermore, the ideas suggested by the marks cannot be more different as the word "double" can simply not be considered to convey any idea remotely related to "bagel".
24. In light of the above, it is also respectfully requested that the Registrar dismiss the opponent's argument based on confusion and allow the application to proceed to registration.

Answer

Para 3 - "As for the assessment of confusion, given that the application is based on proposed use, the material time is the date of filing of the application, namely ... (see section 16(1)(a) TMA)." **(2 marks)**. – The opposition is also based on confusion with a registered trademark (12(1)(d) TMA) **(1 mark)**, citing the provision is not necessary), for which the material date is the date of the TMOB's decision **(1 mark)**.

Para 3 – There was a typographical error in referring to section 16(1)(a), the application at issue having been filed on the basis of proposed use, the reference should have been to section 16(3)(a). Either reference is erroneous in the context in light of the fact that the ground discussed was confusion with a registered mark pursuant to section 12(1)(d). Nonetheless, candidates who noted this error were awarded **2 marks**.

Para 4 - The reference to *Kirkbi AG v. Ritvik Holdings Inc.* **(2 marks)**, this case was not an opposition matter OR was a passing-off matter **(1 mark)**. The correct reference *John Labatt Limited v. The Molson Companies Limited*, 30 CPR (3d) 293 at 298 (FCTD) OR simply "a Labbatt / Molson case" **(1 mark)**.

Para 9 - "If BAGEL BAGEL is deemed not to be descriptive or deceptively misdescriptive, then it automatically goes to prove that DOUBLE BAGEL can also not be deemed descriptive or deceptively misdescriptive." **(2 marks)** The mark BAGEL BAGEL may very well not be descriptive for restaurant services **(1 mark)** while the mark DOUBLE BAGEL can very well be descriptive of the goods "bagels" **(1 mark)** OR what is not descriptive for some services **(1 mark)** can nevertheless be descriptive of goods **(1 mark)**.

Para 11 - *"The Opponent has failed to file any evidence of the existence of any registration and the ground of opposition based on section 12(1)(d) should therefore automatically be dismissed."* (2 marks). – The Registrar has the discretion to check the register (and usually uses this discretion) OR the cited reference actually states the contrary or is not an authority for such an affirmation (1 mark) and the ground of opposition must be analysed (1 mark).

Para 15 - *"Since there is no evidence of a licence whatsoever"* (2 marks). The sample bag filed into evidence contains a notice of the fact that the use of the trademark is a licensed and of the identity of the owner (1 mark), it is therefore presumed that the use is licensed by the opponent (1 mark) OR there is a valid notice on the bags pursuant to section 50(2) TMA (2 marks).

Para 18 - *"In applying the test for confusion, the Registrar must have regard only the circumstances specifically enumerated in section 6(5) TMA"* (2 marks). The Registrar must have regard to all the surrounding circumstances (2 marks).

Para 20 - *"The Board therefore need not consider the Opponent's plans for expansion after that date"* OR *"the Board therefore need not consider the Opponent's plans for expansion after that date and the mark BAGEL BAGEL cannot be deemed to have been known or used at the relevant time for the purpose of evaluating confusion"* (2 marks). This principle was overruled (1 mark) on appeal to the Supreme Court (1 mark).

Para 23 - *"The ideas suggested by the marks cannot be more different"*. (2 marks) "Double" and "bagel" may be different (no mark for this actual comment), the fact that both marks contain the word "bagel" already suggests a similar idea (1 mark) and the doubling of the word "bagel" in one mark versus the word "bagel" preceded by "double" actually does suggest the same idea (1 mark) OR the trademarks as a whole (1 mark) suggests a similar idea (1 mark).

14(b). After having reviewed the file, you feel very uncomfortable arguing the matter before the TMOB as you have only two and a half years of experience of doing trademark availability searches and preparing trademark applications and have actually been a trademark agent for less than six months. You would therefore prefer that the partner who gave you this file argue the matter before the TMOB.

Provided that you obtain the applicant's consent in light of the circumstances, is the Board likely to grant a postponement of the hearing – Yes or No? (1 mark) Briefly explain (1 mark) and indicate the authority supporting your answer (1 mark).

Answer:

No OR probably not (1 mark). The Registrar will generally **not** grant any postponements of scheduled hearing dates (1 mark). Practice Notice in Trademark Opposition Proceedings, section X.6 (1 mark; the reference to the actual section title is not necessary to obtain the mark).

14(c). Presuming that no postponement was requested, what should you do? Briefly explain (2 marks) and indicate the authority supporting your answer (1 mark).

Answer:

I should either refer the matter to an agent with established competence in opposition matters OR seek the help of such an experienced agent to help prepare for the hearing (2 marks). *IPIC Code of Ethics* OR any provincial law society code of ethics (1 mark).

QUESTION 15 (5 marks)

Match the case name with the applicable legal principle. You have been provided with more legal principles than cases. Only one case should be paired with one principle. If you provide multiple principles for a case, only the first legal principle given will be marked.

Case	Principle
a. <i>Venngo Inc. v. Concierge Connection Inc.</i> , 2017 FCA 96. Trademark: PERKOPOLIS	1. The degree of resemblance, although the last factor listed in s. 6(5), is the statutory factor that is often likely to have the greatest effect on the confusion analysis.
b. <i>Veuve Clicquot Ponsardin c. Boutiques Cliquot Ltée</i> , 2006 SCC 23. Trademark: VEUVE CLICQUOT	2. If a trademark is a geographic name that refers to the actual place of origin of the goods or services with which the trademark is associated, it is clearly descriptive of place of origin within the meaning of paragraph 12(1)(b) of the Act, and is therefore not registrable.
c. <i>MC Imports Inc. v. AFOD Ltd.</i> , 2016 FCA 60. Trademark: LINGAYEN	3. Although evidence of actual confusion may be an important factor in the analysis of whether there is a likelihood of confusion, it is not dispositive.
d. <i>Mattel U.S.A. Inc. v. 3894207 Canada Inc.</i> , 2006 SCC 22. Trademark: BARBIE	4. When buying a car or a refrigerator, more care will naturally be taken than when buying a doll or a mid-priced meal.
e. <i>Masterpiece Inc. v. Alavida Lifestyles Inc.</i> , 2011 SCC 27. Trademark: MASTERPIECE	5. Undoubtedly, the fame of a trademark is a circumstance of great importance because of the hold of famous marks on the public mind.
	6. Inferences about the state of the marketplace can only be drawn from state of the register evidence where large numbers of relevant registrations are located.
	7. There is nothing to prevent two registered trade-marks from being used at the same time.

Answer:

a. 3

b. 5

c. 2

D. 4

E. 1

END