

2020 TRADEMARK AGENT QUALIFYING EXAMINATION
PART A
TOTAL MARKS: 148

QUESTION 1 (2 marks)

True or False. You have been asked by It's Mine Now, Inc. to record an assignment against a Canadian trademark application for a mark they have recently acquired from You Can Have It, Ltd. The request for recordal of the assignment cannot be filed by you, as agent for It's Mine Now, Inc., but must instead be filed by You Can Have It, Ltd. (as the listed applicant of the mark) or its agent. **(1 mark)** Cite the relevant provision of the *Trademarks Act* in support of your answer. **(1 mark)**

QUESTION 2 (6 marks)

List the three requirements for goods or services recited in a trademark application to be accepted. **(3 marks)** Cite the relevant provisions of the *Trademarks Act* and *Trademarks Regulations*. **(3 marks)**

QUESTION 3 (2 marks)

True or False. **(1 mark)** Goods or services must be stated in ordinary commercial terms in order for a trademark application to receive a filing date. Cite the relevant provision of the *Trademarks Act*. **(1 mark)**

QUESTION 4 (3 marks)

Your client, Gums N' Peonies, Inc., has been using the mark GUMS N' PEONIES in Canada for more than a decade for gum made from herbal and floral extracts, although they have never applied to register the mark. Your client recently became aware of a newly-filed application for the mark GUMS N' DAISIES filed by a competitor, 1234567 Ontario, Inc., for "chewing gum". They have asked you to monitor the application to let them know if and when it is advertised for opposition. In the meantime, they have asked you to send a Notification of Third Party Rights to the Trademarks Office. What do you advise Gums N' Peonies, Inc. with respect to availability of the Notification of Third Party Rights option and why? **(2 marks)** Cite the relevant authority. **(1 mark)**

QUESTION 5 (29 marks)



Your client, Thompson Orthopaedics Inc., is interested in applying to register the trademark RAPTORFIX for use in association with surgical fixation devices for use in repairing bone fractures. The mark has not yet been used in Canada but has been used in the United Kingdom since 2017. Prior to filing an application to register the RAPTORFIX mark, your client has asked you to conduct a full availability search and to provide your opinion on the availability of the mark for registration and use. You arrange for an external firm specialized in trademark searches to compile the search data and receive a voluminous report to analyze and comment on.

The first part of the search report includes a selection of trademarks from the Canadian Trademarks Register.

- a) For each of the marks identified by the Register portion of the search, and set out below:
- Indicate “yes” or “no” whether the mark is likely to pose an obstacle to registration of the RAPTORFIX mark for the goods of interest. **(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. **(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.

| No. | TRADEMARK | STATUS and APP./REG. NO. and DATE | GOODS/SERVICES | OWNER |
|-----|------------------|--------------------------------------------------|-------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------|
| 1. | RAPTOR | Advertised App. 1998724 App. 2018-04-23 | Cl. 10: Surgical gauze, surgical gauze sponges or swabs, absorbent cotton wool, gauze bandages and bandage rolls, orthopaedic braces, surgical lint, adhesive plaster and first aid kits. | Raptor Medical Inc., 2045 Midland Avenue Scarborough Ontario, M1P 3E2 |
| 2. | I ONLY RAPTORIZE | Registered Reg. TMA964,271 Reg. 2018-01-12 | Cl. 10: Surgical instruments for use in orthopaedic knee replacement. | Osteo Health GmbH, Lindenstrasse 10 6340 Baar Switzerland |

| No. | TRADEMARK | STATUS and APP./REG. NO. and DATE | GOODS/SERVICES | OWNER |
|-----|-----------------------------------------------------------------------------------------------------------------|---------------------------------------------------------------------------|---------------------------------------------------------------------------------------------------------------------------------|------------------------------------------------------------------------------------|
| 3. | RAPTOR FIXATOR | Expunged (Section 45) Reg. TMA489,237 Reg. 2009-08-17 | Cl. 10: Medical instruments and devices, namely, external fixators; medical instruments for cutting tissue; bone plates. | Fixator Technology LLC, 6325 Falls of Durham Road Raleigh NC 27615 U.S.A. |
| 4. | <i>CAPTOR</i> <i>FIXER</i>  | Filed App 2001967 App 2019-10-10 | Cl. 11: Apparatus for sterilizing dental instruments. | Bacteria Captor Ltd., 1875 Leslie Street, Toronto M3B2M5 |
| 5. | OVORAPTOR | Registered Reg. TMA734,955 Reg. 2004-03-26 | Cl. 44: Fertility clinics. | Ovoraptor Fertility Inc., 1919 Maple Blvd, Edmonton, Alberta, T5A0B5 |
| 6. |  | Registered Reg. TMA622,798 Reg. 2010-11-08 | Cl. 10: Adhesive bandages, medical adhesive tape for first aid purposes. | FW First Aid Corporation, 68 Jonspin Road Wilmington, MA 01887 U.S.A. |
| 7. | RAPTOR-FIX | Advertised App 945633 App 2007-06-04 | Cl. 1-45: Environmental conservation program for birds of prey. | Her Majesty the Queen, as represented by the Minister of the Environment |
| 8. | OSTEORAPTOR | Registered Reg. TMA454,233 Reg. 2008-09-02 | Cl. 10: Bone anchors for use in orthopaedic surgery. | Thompson Orthopaedics Inc. 101 Hessle Road Hull HU3 2BN UNITED KINGDOM |
| 9. | VULTURE FIX | Registered Reg. TMA843,744 Reg. 2015-05-24 | Cl. 10: Surgical instruments; surgical suture anchors; medical probes. | VFix Stiftung & Co. KG, Stiftsbergstrasse 12, 74172 Neckarsulm GERMANY |

The second part of the search report includes a selection of Canadian business names and trade names.

b) Your attention is drawn to the following trade name:

Business name: Raptor-Fixer Medical Inc.
Address: 121 Bowser Avenue, North Vancouver, BC V7P 3H1
Chief Executive: Paul Summerville
Line of Business: Medical and surgical devices and instruments
Year Started: 2019

Preliminary Internet searching reveals that Canadians can purchase various surgical instruments featuring the trademark Raptor-Fixer™ from Raptor-Fixer Medical Inc.'s website.

- i)** Yes or No. Does this trade name constitute a potential obstacle to the registration of your client's mark? **(1 mark)** Explain your answer. **(3 marks)**
- ii)** Yes or No. If your client decides to use its trademark RAPTORFIX without registering it, does this trade name constitute a potential obstacle to the use of your client's mark in Canada? **(1 mark)** Explain your answer. **(3 marks)**

The third part of the search report includes Internet searches for the term RAPTORFIX.

c) By clicking on one of the results identified through the Internet searches, you are directed to the website of an Australian company named Raptor Pty Ltd., which sells RAPTOR branded surgical braces used by patients with knee replacements. To purchase these goods, the website lists the contact information of several sales representatives in different parts of the world. There is no specific contact for Canada but there is one listed for "North America".

Does this information have an impact on the availability of your client's mark in Canada? **(1 mark)** Explain your answer. **(2 marks)**

QUESTION 6 (2 marks)

Your client, Haute Couture, Inc., holds a registration for the trademark GLAMOURAMA, covering "cosmetics" in Class 3, and "magazines" in Class 16. Your client has been approached by Fashion Icon, Ltd. to see whether they would be willing to transfer rights in the GLAMOURAMA mark and the corresponding trademark registration to Fashion Icon, Ltd., but only with respect to "magazines". Yes or No., can Haute Couture, Inc. transfer its rights for the mark in the registration for some, but not all, of the covered goods? **(1 mark)** Cite the relevant provision of the *Trademarks Regulations* in support of your answer. **(1 mark)**

QUESTION 7 (2 marks)

- a) You are contacted by the French IP firm Cabinet Rossignol, which has recently filed an International trademark application designating Canada on behalf of its client Champagne Pinard. Your firm already manages several of Champagne Pinard's Canadian trademarks, but you were not involved in this International application. Cabinet Rossignol, as the applicant's representative before the International Bureau of the World Intellectual Property Organization (WIPO), just received a "courtesy letter" from CIPO and is puzzled as to the content of this letter. In one sentence, explain what CIPO's courtesy letter is about. (1 mark)
- b) If no action is taken on this letter, who will receive CIPO's first Examiner's report? (1 mark)

QUESTION 8 (5 marks)

- a) With respect to International applications filed in accordance with the Madrid Protocol, what is the time limit for CIPO to send the International Bureau a notification of provisional refusal? (1 mark)
- b) What are the Registrar's obligations if it fails to notify the International Bureau of a provisional refusal within the prescribed timeframe? (3 marks) Cite the relevant provision of the *Trademarks Regulations*. (1 mark)

QUESTION 9 (1 mark)

What is the official fee to file an application to amend the register under subsection 41(1) of the *Trademarks Act* to extend the statement of goods or services in respect of which a trademark is registered, to cover two (2) additional classes of goods or services? (1 mark)

QUESTION 10 (22 marks)

For each of the following trademarks, advise whether the mark is registrable or not registrable for the associated goods or services, and provide the most significant reason in support of your answer. (1 mark for each trademark) Cite the relevant provision or provisions of the *Trademarks Act* in support of your reason. (1 mark for each provision) **Please ignore any confusion issues and do not assume acquired distinctiveness.**

- 1) MELANZANE for use in association with "preserved vegetables" (MELANZANE is Italian for "eggplant"). (2 marks)
- 2) SAMBUCA for use in association with "carbonated soft drinks". (2 marks)
- 3) DO NOT BEND for use in association with "envelopes". (3 marks)

- 4) JIM'S VALENCIA ORANGES for use in association with "fresh fruit". **(3 marks)**
- 5) JONES MACDONALD & SONS for use in association with "luggage". **(2 marks)**
- 6) GENEVA CROSS for use in association with "insurance services". **(3 marks)**
- 7) NO. 1 FAN for use in association with "furnace blowers". **(2 marks)**
- 8) PARLIAMENT HILL for use in association with "tax preparation services". **(3 marks)**
- 9) LEONARD COHEN for use in association with "sandwiches". **(2 marks)**

QUESTION 11 (2 marks)

True or False. **(1 mark)** An application may be filed for the registration of more than one trademark. Cite the relevant provision of the *Trademarks Regulations*. **(1 mark)**

QUESTION 12 (6 marks)

What must an application for a sound mark contain? **(3 marks)** Cite the relevant provisions of the *Trademarks Act* and the *Trademarks Regulations*. **(3 marks)**

QUESTION 13 (3 marks)

You have filed an International trademark application based on an existing Canadian registration. CIPO has certified the application and sent it to WIPO. However, WIPO has issued a notification of irregularities. List the three groups of irregularities that can be raised by WIPO to the applicant or its international representative. **(3 marks)** **Only the first three groups listed will be considered.**

QUESTION 14 (2 marks)

True or False. A trademark application may be filed and registered in the name of two individuals. **(1 mark)** Cite the relevant provision of the *Trademarks Act*. **(1 mark)**

QUESTION 15 (7 marks)

CIPO issued a first Examiner's report on May 27, 2020. A response is due by November 27, 2020. According to the *Trademarks Examination Manual*, how many six-month extensions of time can an applicant expect to obtain if the following explanations are provided as exceptional

circumstances, justifying such extensions? Respond by indicating either **A**, **B** or **C** for each scenario (1 mark each):

Answer choice:

A: None, CIPO does not consider this reason to be an exceptional circumstance.

B: One six-month extension of time, a different exceptional circumstance would need to be given to obtain further extensions.

C: One six-month extension of time, but the same exceptional circumstance could be given to justify the grant of further extensions if the situation persists.

Scenarios:

- 1) Your client's business was temporarily shut down because of the COVID-19 pandemic and, as a result, you have not been able to obtain instructions from them. (1 mark)
- 2) The Examiner has raised a confusion objection with a registered trademark. Your firm has initiated an expungement proceeding against the cited registration pursuant to Section 45 of the Act, but the proceeding is still pending. (1 mark)
- 3) Your client needs more time to consider the objection raised pursuant to paragraph 30(2)(a) of the Act and file a proper response. (1 mark)
- 4) Your client needs more time to consider the objection raised pursuant to paragraph 12(1)(d) of the Act and to file a proper response. (1 mark)
- 5) Your client needs more time to consider the objection raised pursuant to paragraph 12(1)(b) of the Act and compile evidence to claim acquired distinctiveness. (1 mark)
- 6) Your firm has just been appointed as trademark agent in this file and you require more time to become familiar with the file. (1 mark)
- 7) Your client is actively negotiating a consent from the owner of a trademark cited as confusing under paragraph 12(1)(d) of the Act and needs more time to finalize an agreement. (1 mark)

QUESTION 16 (2 marks)

In addition to the particulars of the defined standard, what else must be included in an application for the registration of a certification mark that is specific to certification marks and not to other types of marks? (1 mark) Cite the relevant provision of the *Trademarks Act*. (1 mark)

QUESTION 17 (8 marks)

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

| Case Name | Principle |
|------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------|
| <p>A. <i>Deputy Attorney-General of Canada v. Biggs Laboratories (Canada) Limited</i> (1964), 42 C.P.R. 129</p> <p>Trademark: SHAMMI</p> | <p>1. I must wholeheartedly accept the proposition that it is the duty of the Registrar (and it is my hope that he will always fearlessly exercise it) to consider not merely the general taste of the time, but also the susceptibility of persons, by no means few in number, who still may be regarded as old fashioned and, if he is not of the opinion that the feelings or susceptibilities of such people will be offended, he will properly consider refusal of the registration.</p> |
| <p>B. <i>Leaf Confections Ltd. v. Maple Leaf Gardens Ltd.</i> (1986), 12 C.P.R. (3d) 511 (FC); aff'd (1988), 19 C.P.R. (3d) 331 (FCA)</p> <p>Trademark: LEAF and Design</p> | <p>2. If a mark falsely suggests a connection with a living individual, the mark cannot be registered.</p> |
| <p>C. <i>Jack Black L.L.C. v. The Attorney General of Canada</i>, 2014 FC 664</p> <p>Trademark: JACK BLACK</p> | <p>3. Simply because a product description is comprehensible and adequately identifies the product does not mean that it is a description customarily used in the trade to refer to the product.</p> |
| <p>D. <i>Compulife Software Inc. v. Compuoffice Software Inc.</i>, 2001 FCT 559 (CanLII)</p> <p>Trademarks: COMPUOFFICE and ACROSS THE BOARD</p> | <p>4. An article advertised for sale as containing certain components which, in truth, it does not have, surely must be considered as deceptively misleading to the purchasing public.</p> |
| <p>E. <i>La Marquise Footwear Inc. Re.</i> (1946), 64 R.P.C. 27</p> <p>Trademark: OOMPHIES</p> | <p>5. It remains for me to assess the probative value of such evidence. In so doing I am conscious that the onus on a person contending that a trade mark which is descriptive or laudatory of his wares has come to actually distinguish those wares is a heavy one and that onus is increased by the adoption of a word which lacks inherent distinctiveness.</p> |

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| <p>F. <i>Decra-Loc Canada Ltd. v. Pave Tech, Inc.</i>, 1995 CanLII 10261 (CA TMOB)</p> <p>Trademark: PAVE EDGE</p> | <p>6. All relevant evidence which tends to establish non-distinctiveness may be considered. In other words, the opponent may rely on television broadcasts, website articles, etc. to establish that the opponent's... mark acquired a reputation in Canada.</p> |
| <p>G. <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>7. Nevertheless, it is clear in considering the elements of s-s. 6(5) of the Trade Marks Act..., each element need not be interpreted as having equal weight. A particular case might justify greater significance being given to one criterion over others. As previously stated, I find the respondent's mark and design to be a strong one, well-known throughout Canada. In such cases the courts have held that the distinction between the wares and the nature of the trade of the two competing marks becomes less important.</p> |
| <p>H. <i>Carson v. Reynolds</i> (1980), 49 C.P.R. (2nd) 57 (FC)</p> <p>Trademarks: HERE'S JOHNNY</p> | <p>8. A statement of goods or services is considered to be in ordinary commercial terms where research discloses that the goods and services are set out as they are customarily referred to in the trade, where similar language and scope has been commonly used by others in the same industry to describe the applicant's goods or services.</p> |
| | <p>9. For the purposes of Section 9(1)(k) of the <i>Trademarks Act</i>, the living individual must have a significant public reputation in Canada at the time the application was filed.</p> |
| | <p>10. I must say that at present we live in what is commonly called a "permissive age" where previously accepted moral standards are undergoing change. The difficulty is to determine what are the acceptable standards today and what</p> |

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| | would still be considered immoral, scandalous, or obscene by some people by no means few in number. |
| | 11. Marks are inherently distinctive when nothing about them refers the consumer to a multitude of sources. |

QUESTION 18 (2 marks)

An IP portfolio management firm has asked you to file an assignment and subsequent name change against 130 marks in the name of Big Top, Ltd. Several different trademark agents have been handling these applications to date, and you have been informed that, but for this specific project, your firm is not to take over carriage of the prosecution of these marks. Yes or No, can you appoint yourself agent just for the purpose of recording this assignment and name change? (1 mark) Cite the relevant authority. (1 mark)

QUESTION 19 (5 marks)

A pharmaceutical company, Better Than The Generics, Inc., has asked you to conduct a full pharmaceutical trademark search for the trademark BRYZUNTI for pharmaceutical preparations, and to provide an opinion regarding availability of the mark for use and registration in Canada. You order the search from a third-party search firm, and on reviewing the results, you discover a pending application, for which your firm is listed as agent, for REZUNTI for “inhaled pharmaceutical preparations for the treatment of respiratory diseases and disorders”, filed by BTTG Group, Inc. This is the only –ZUNTI suffix mark identified by the search. Describe, in point form, the steps you would take to handle this situation. (5 marks)

QUESTION 20 (2 marks)

Name a deadline for which an applicant cannot request an extension of time pursuant to Section 47 of the *Trademarks Act*. (1 mark) Cite the relevant provision of the *Trademarks Act*. (1 mark)

QUESTION 21 (2 marks)

True or False. (1 mark) The particulars of the defined standard of a certification mark need not be set out in their entirety in the trademark application. Cite the relevant authority. (1 mark)

QUESTION 22 (22 MARKS)

Your client, The Fresh People, Inc., has applied to register the trademark ALPINE FRESH in association with “personal products such as shower gels” in Class 3, and “hand-held shower heads” in Class 11. You have received the first Examiner’s Report in connection with this application (see below).

14 jul/Jul 2020
Votre référence Your File
TM EXAM 2020
Notre référence Our File
30021554
Numéro EI IR Number

BEST TRADEMARK FIRM
OTTAWA, ONTARIO

Attention: Candidate

RE: Trademark: ALPINE FRESH
Applicant: The Fresh People, Inc.

This examiner's report concerns the above identified application. To avoid abandonment proceedings, a proper response must be received by this office by January 14, 2021. All correspondence respecting this application must indicate the file number.

As this application was filed prior to, and not advertised as of, June 17, 2019 it has been examined under the provisions of the amended *Trademarks Act* and the new *Trademarks Regulations*.

The trademark is considered to be clearly descriptive or deceptively misdescriptive of the character or quality of the associated goods: personal products such as shower gels. Specifically, the trademark clearly describes that the “shower gels” are scented like, or have the fragrance of, alpine plants and leave the user clean and invigorated. In that regard, the *Merriam-Webster Dictionary* defines “FRESH” as “new” or “clean” and “full of or renewed in vigor” and “ALPINE” as a “a plant native to alpine or boreal regions”. The Examiner’s research also discloses that “ALPINE” is in common use in association with regard to fragrances and “FRESH” is in common use in association with personal care products.

Alternatively, if the goods at issue do not have this feature, trait, characteristic, or quality, the trademark is considered to be deceptively misdescriptive.

Therefore, in view of the provisions of paragraph 12(1)(b) of the *Trademarks Act*, the trademark does not appear registrable in association with the goods “personal products such as shower gels”.

The word "character" means a feature, trait or characteristic of the goods and services. The test of whether a trademark is clearly descriptive considers the immediate first impression of the average Canadian user, purchaser, or consumer of the associated goods and services.

One of the most important purposes of paragraph 12(1)(b) of the *Trademarks Act* 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 since this would give them an unfair advantage over competitors in the same trade.

Pursuant to paragraph 37(1)(d) of the *Trademarks Act*, it appears that the trademark is not distinctive in association with shower gels. In particular, trademarks for which an objection is raised under paragraph 12(1)(b) of the *Act* are considered not inherently distinctive. Therefore, pursuant to paragraph 32(1)(b) of the *Act*, the applicant may wish to furnish the Registrar with evidence establishing that the trademark was distinctive at the filing date of the application for its registration. Alternatively, the applicant may wish to provide, in writing, information which would persuade the Registrar to withdraw the objection that the trademark is not, on a preliminary view, inherently distinctive. Please note that pursuant to subsection 32(2) of the *Act*, the Registrar shall, having regard to the evidence adduced, restrict the registration to the goods or services in association with which, and to the defined territorial area in Canada in which, the trademark is shown to be distinctive.

The applicant's written comments with respect to these matters are invited.

In addition, pursuant to paragraph 30(2)(a) of the *Trademarks Act*, an application for the registration of a trademark must contain a statement in ordinary commercial terms of the associated goods and services. Furthermore, section 29 of the *Trademarks Regulations* requires that the statement must describe each of those goods or services in a manner that identifies a specific good or service.

It is considered that the following goods are not in specific and ordinary commercial terms: "personal products such as shower gels".

The applicant's grouping of the goods according to the classes of the Nice Classification will be reassessed once the queried goods have been redefined.

The applicant is required to file an amended application, using the e-service on the CIPO website at www.cipo.gc.ca, by fax at 819-953-2476 or by mail at the following address:

Registrar of Trademarks
Place du Portage I
50 Victoria Street, room C-114
Gatineau, QC K1A 0C9

If the applicant has any specific questions in respect of this Office action, please contact the assigned examiner. Please note that for general inquiries, including assistance with filing of the revised application, queries about the status of an application or receipt of correspondence, you may contact our Client Service Centre toll free at 1-866-997-1936.

Any comments you may wish to submit in writing will receive consideration.

Yours truly,

Ms. Trademark Examiner
Examination Section
819-000-000
fax: 819-953-2476

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- a) With regard to the objection based on paragraph 30(2)(a), what would your recommendation to the client be for amending this term? **(1 mark)**
 - b) Draft a reporting letter to your client, setting out their options for response to the substantive objections. If there are several options for responding to the Examiner's report, list all possible options and explain how you would respond to the report and what information you will need from your client to do so. **(21 marks)**

QUESTION 23 (4 MARKS)

Yes or No. Would each of the following marks be recognized as a prohibited mark under Section 9 of the *Trademarks Act*? **(1 mark each)**

- a) **TAX BUDDY** for the name of a tax return software developed by the Government of Canada for use by the Canada Revenue Agency. The software is not yet available to Canadian consumers, but the mark was mentioned in internal communications between employees of the Canada Revenue Agency such as e-mails and memoranda. **(1 mark)**
- b) **PARIS JE T'AIME** for services promoting tourism in Paris, France. This mark has been used in Canada for 5 years by the French State represented by the Ministry of Tourism. The mark can be seen on various travel websites and on billboards located in Toronto, Montreal and Vancouver. **(1 mark)**
- c) **UNIVERSITY OF CAMBRIDGE** for online education services offered in Canada since 2010 by the University of Cambridge in England. **(1 mark)**
- d) **LOTTO BINGO** for lottery services adopted and used since 2019 by the Ontario Lottery and Gaming Corporation. Research shows that the Registrar has already given public notice of adoption and use of the official mark LOTTO BINGO (No. 934,299) to the Western Canada Lottery Corporation. **(1 mark)**

QUESTION 24 (2 MARKS)

True or False. (1 mark) A trademark agent that does not reside in Canada may represent an applicant in any business before the Office of the Registrar of Trademarks. Cite the relevant provision of the *Trademarks Regulations*. (1 mark)

QUESTION 25 (3 MARKS)

Your client is on a tight budget and has requested filing of the trademark ATTITUDE for t-shirts, pants and skirts. Before filing the application, you conduct a quick search for the identical mark on the Canadian register and note that the US company Attitude Wear Inc. owns a registered trademark for ATTITUDE WEAR in association with various clothing items, footwear and handbags. You are about to pick up the phone to inform your client of this potential obstacle when you note that your client had specifically instructed you not to conduct preliminary searches before filing the application since your client does not have the budget for such searches. What should you do? (1 mark) Briefly explain your reasoning. (2 marks)

QUESTION 26 (2 MARKS)

You have a new client who has come to you in a panic. They received an Examiner's Report from CIPO months ago, specifying a response deadline of October 30, 2020. They completely forgot about the Examiner's Report, just discovering it this week under a pile of papers. Needless to say, they have missed the response deadline, and have come to you to see if there is anything they can do to save the application. Yes or No. (1 mark) Is it too late to save the application from abandonment? Cite the relevant provision of the *Trademarks Act*. (1 mark)

2020 TRADEMARK AGENT QUALIFYING EXAMINATION
PART A
TOTAL MARKS: 148

QUESTION 1 (2 marks)

True or False. You have been asked by It's Mine Now, Inc. to record an assignment against a Canadian trademark application for a mark they have recently acquired from You Can Have It, Ltd. The request for recordal of the assignment cannot be filed by you, as agent for It's Mine Now, Inc., but must instead be filed by You Can Have It, Ltd. (as the listed applicant of the mark) or its agent. (1 mark) Cite the relevant provision of the *Trademarks Act* in support of your answer. (1 mark)

Answer:

- False. (1 mark)
- Subsection 48(3) of the *Trademarks Act*. (1 mark)

QUESTION 2 (6 marks)

List the three requirements for goods or services recited in a trademark application to be accepted. (3 marks) Cite the relevant provisions of the *Trademarks Act* and *Trademarks Regulations*. (3 marks)

Answer:

- Must describe each of the goods or services in a manner that identifies a **specific** good or service. (1 mark)
- Must be described in **ordinary commercial terms**. (1 mark)
- Must be grouped according to the classes of the Nice Classification. (1 mark)
- Section 29 of the *Trademarks Regulations*. (1 mark)
- Paragraph 30(2)(a) of the *Trademarks Act*. (1 mark)
- Subsection 30(3) of the *Trademarks Act*. (1 mark)

QUESTION 3 (2 marks)

True or False. (1 mark) Goods or services must be stated in ordinary commercial terms in order for a trademark application to receive a filing date. Cite the relevant provision of the *Trademarks Act*. (1 mark)

Answer:

- False. (1 mark)
- Paragraph 33(1)(e) of the *Trademarks Act*. (1 mark)

QUESTION 4 (3 marks)

Your client, Gums N' Peonies, Inc., has been using the mark GUMS N' PEONIES in Canada for more than a decade for gum made from herbal and floral extracts, although they have never applied to register the mark. Your client recently became aware of a newly-filed application for the mark GUMS N' DAISIES filed by a competitor, 1234567 Ontario, Inc., for "chewing gum". They have asked you to monitor the application to let them know if and when it is advertised for opposition. In the meantime, they have asked you to send a Notification of Third Party Rights to the Trademarks Office. What do you advise Gums N' Peonies, Inc. with respect to availability of the Notification of Third Party Rights option and why? (2 marks) Cite the relevant authority. (1 mark)

Answer:

- Notification of Third Party Rights is not an option in this case. (1 mark)
- Notification of Third Party Rights can only be used in cases where the third party holds a trademark registration or an earlier-filed trademark application **OR** Gums N' Peonies, Inc. does not hold a registration or a pending application for the GUMS N' PEONIES mark **OR** evidence of prior use will not be accepted or considered. (1 mark)
- Trademark Examination Manual Section 6.10 **OR** Practice Notice dated June 17, 2019, "Notification of Third Party Rights". (1 mark) **[Note: Date and title of Practice Notice and/or specific section of the Examination Manual not required to receive the mark.]**

QUESTION 5 (29 marks)



Your client, Thompson Orthopaedics Inc., is interested in applying to register the trademark RAPTORFIX for use in association with surgical fixation devices for use in repairing bone fractures. The mark has not yet been used in Canada but has been used in the United Kingdom since 2017. Prior to filing an application to register the RAPTORFIX mark, your client has asked you to conduct a full availability search and to provide your opinion on the availability of the mark for registration and use. You arrange for an external firm specialized in trademark searches to compile the search data and receive a voluminous report to analyze and comment on.

The first part of the search report includes a selection of trademarks from the Canadian Trademarks Register.

- a) For each of the marks identified by the Register portion of the search, and set out below:
- i. Indicate "yes" or "no" whether the mark is likely to pose an obstacle to registration of the RAPTORFIX mark for the goods of interest. (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. (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.

| No. | TRADEMARK | STATUS and APP./REG. NO. and DATE | GOODS/SERVICES | OWNER |
|-----|-------------------------------------------------------------------------------------------------------------------|---------------------------------------------------------------------------|--------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------|---------------------------------------------------------------------------|
| 1. | RAPTOR | Advertised App. 1998724 App. 2018-04-23 | Cl. 10: Surgical gauze, surgical gauze sponges or swabs, absorbent cotton wool, gauze bandages and bandage rolls, orthopaedic braces, surgical lint, adhesive plaster and first aid kits. | Raptor Medical Inc., 2045 Midland Avenue Scarborough Ontario, M1P 3E2 |
| 2. | I ONLY RAPTORIZE | Registered Reg. TMA964,271 Reg. 2018-01-12 | Cl. 10: Surgical instruments for use in orthopaedic knee replacement. | Osteo Health GmbH, Lindenstrasse 10 6340 Baar Switzerland |
| 3. | RAPTOR FIXATOR | Expunged (Section 45) Reg. TMA489,237 Reg. 2009-08-17 | Cl. 10: Medical instruments and devices, namely, external fixators; medical instruments for cutting tissue; bone plates. | Fixator Technology LLC, 6325 Falls of Durham Road Raleigh NC 27615 U.S.A. |
| 4. | <i>CAPTOR</i> <i>FIXER</i>  | Filed App 2001967 App 2019-10-10 | Cl. 11: Apparatus for sterilizing dental instruments. | Bacteria Captor Ltd., 1875 Leslie Street, Toronto M3B2M5 |
| 5. | OVORAPTOR | Registered Reg. TMA734,955 Reg. 2004-03-26 | Cl. 44: Fertility clinics. | Ovoraptor Fertility Inc., 1919 Maple Blvd, Edmonton, Alberta, T5A0B5 |
| 6. |  | Registered Reg. TMA622,798 Reg. 2010-11-08 | Cl. 10: Adhesive bandages, medical adhesive tape for first aid purposes. | FW First Aid Corporation, 68 Jonspin Road Wilmington, MA 01887 U.S.A. |

| No. | TRADEMARK | STATUS and APP./REG. NO. and DATE | GOODS/SERVICES | OWNER |
|-----|-------------|--------------------------------------------------|------------------------------------------------------------------------|---------------------------------------------------------------------------------|
| 7. | RAPTOR-FIX | Advertised App 945633 App 2007-06-04 | Cl. 1-45: Environmental conservation program for birds of prey. | Her Majesty the Queen, as represented by the Minister of the Environment |
| 8. | OSTEORAPTOR | Registered Reg. TMA454,233 Reg. 2008-09-02 | Cl. 10: Bone anchors for use in orthopaedic surgery. | Thompson Orthopaedics Inc. 101 Hessle Road Hull HU3 2BN UNITED KINGDOM |
| 9. | VULTURE FIX | Registered Reg. TMA843,744 Reg. 2015-05-24 | Cl. 10: Surgical instruments; surgical suture anchors; medical probes. | VFix Stiftung & Co. KG, Stiftsbergstrasse 12, 74172 Neckarsulm GERMANY |

Answer: [Note: Even if Yes/No answer is incorrect, mark may still be given if candidate provides valid supporting explanation. No mark will be given if candidate's justification is limited to the difference of classes without any reference to the goods or services.]

| No. | TRADEMARK | ANSWER |
|-----|-------------------------------------------------------------------------------------|---------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------|
| 1. | RAPTOR | Answer: <ul style="list-style-type: none"> - Yes. (1 mark) - Client's mark contains this mark in its entirety OR the Mark is identical to the first word in the client's mark OR the Mark is identical to the only distinctive word in the client's mark OR the goods are similar/overlapping OR the channels of trade are similar. (1 mark) |
| 2. | I ONLY RAPTORIZE | Answer: <ul style="list-style-type: none"> - No. (1 mark) - Marks differ in appearance, sound and connotation/ideas suggested. (1 mark) [Note: only one of the terms "appearance", "sound", "connotation" or "ideas suggested" is required to receive the mark.] |
| 3. | RAPTOR FIXATOR | Answer: <ul style="list-style-type: none"> - No. (1 mark) - Registration expunged for non-use. (1 mark) |
| 4. |  | Answer: <ul style="list-style-type: none"> - No. (1 mark) - Marks differ significantly in appearance, sound and connotation/ideas suggested OR the goods are different OR the channels of trade would be different. (1 mark) [Note: only |

| | | |
|----|-----------------------------------------------------------------------------------|------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------|
| | | one of the terms “appearance”, “sound”, “connotation” or “ideas suggested” is required to receive the mark.] |
| 5. | OVORAPTOR | Answer: <ul style="list-style-type: none"> - No. (1 mark) - Marks differ significantly in appearance, sound and connotation/ideas suggested OR the goods and services are different OR the channels of trade would be different. (1 mark) [Note: only one of the terms “appearance”, “sound”, “connotation” or “ideas suggested” is required to receive the mark.] |
| 6. |  | Answer: <ul style="list-style-type: none"> - No. (1 mark) - Marks differ significantly in appearance, sound and connotation/ideas suggested OR the goods are different OR the channels of trade would be different. (1 mark) [Note: only one of the terms “appearance”, “sound”, “connotation” or “ideas suggested” is required to receive the mark.] |
| 7. | RAPTOR-FIX | Answer: <ul style="list-style-type: none"> - Yes. (1 mark) - Mark consists of the official mark OR Mark is so nearly resembling as to be likely to be mistaken for the official mark (1 mark) |
| 8. | OSTEORAPTOR | Answer: <ul style="list-style-type: none"> - No. (1 mark) - Marks are owned by same entity OR the owner is the client. (1 mark) |
| 9. | VULTURE FIX | Answer: <ul style="list-style-type: none"> - Yes. (1 mark) - Marks are similar in connotation/ideas suggested OR the goods are nearly identical. (1 mark) |

The second part of the search report includes a selection of Canadian business names and trade names.

b) Your attention is drawn to the following trade name:

Business name: Raptor-Fixer Medical Inc.
 Address: 121 Bowser Avenue, North Vancouver, BC V7P 3H1
 Chief Executive: Paul Summerville
 Line of Business: Medical and surgical devices and instruments
 Year Started: 2019

Preliminary Internet searching reveals that Canadians can purchase various surgical instruments featuring the trademark Raptor-Fixer™ from Raptor-Fixer Medical Inc.'s website.

- i) Yes or No. Does this trade name constitute a potential obstacle to the registration of your client's mark? (1 mark) Explain your answer. (3 marks)

Answer:

- Yes. (1 mark)
- The trade name is very similar in appearance, sound and connotation/ideas suggested to the client's mark (1 mark) and the activities of the business are identical/very similar to your client's activities (1 mark). Raptor-Fixer Medical Inc. could oppose the registration of your client's mark based on prior use in Canada of its trade name and/or of the trademark Raptor-Fixer (1 mark). **[Note: only one of the terms "appearance", "sound", "connotation" or "ideas suggested" is required to receive the mark.]**

- ii) Yes or No. If your client decides to use its trademark RAPTORFIX without registering it, does this trade name constitute a potential obstacle to the use of your client's mark in Canada? (1 mark) Explain your answer. (3 marks)

Answer:

- Yes. (1 mark)
- The trade name is very similar to the client's mark in appearance, sound and connotation/ideas suggested (1 mark) and the activities of the business are identical/very similar to your client's activities (1 mark). Raptor-Fixer Medical Inc. could take legal action **OR** could commence an action for passing-off against your client's trademark use based on its prior use of the trademark Raptor-Fixer (1 mark). **[Note: only one of the terms "appearance", "sound", "connotation" or "ideas suggested" is required to receive the mark.]**

The third part of the search report includes Internet searches for the term RAPTORFIX.

- c) By clicking on one of the results identified through the Internet searches, you are directed to the website of an Australian company named Raptor Pty Ltd., which sells RAPTOR branded surgical braces used by patients with knee replacements. To purchase these goods, the website lists the contact information of several sales representatives in different parts of the world. There is no specific contact for Canada but there is one listed for "North America".

Does this information have an impact on the availability of your client's mark in Canada? (1 mark) Explain your answer. (2 marks)

Answer:

- further investigation would be required to determine whether this impacts availability of the client's mark in Canada. (1 mark)
- If the products are sold in Canada (1 mark), Raptor Pty Ltd. could oppose the registration of your client's mark **OR** take legal action **OR** could commence an action for passing-off against your client's mark based on its prior use of the trademark RAPTOR for similar goods (1 mark).

OR

- if the products are not sold in Canada **OR** if the products do not have a reputation in Canada (1 mark), Raptor Pty Ltd. and its RAPTOR branded products likely would not impact availability of the client's mark in Canada (1 mark).

QUESTION 6 (2 marks)

Your client, Haute Couture, Inc., holds a registration for the trademark GLAMOURAMA, covering “cosmetics” in Class 3, and “magazines” in Class 16. Your client has been approached by Fashion Icon, Ltd. to see whether they would be willing to transfer rights in the GLAMOURAMA mark and the corresponding trademark registration to Fashion Icon, Ltd., but only with respect to “magazines”. Yes or No., can Haute Couture, Inc. transfer its rights for the mark in the registration for some, but not all, of the covered goods? (1 mark) Cite the relevant provision of the *Trademarks Regulations* in support of your answer. (1 mark)

Answer:

- Yes. (1 mark)
- Section 66 of the *Trademarks Regulations*. (1 mark)

QUESTION 7 (2 marks)

- a) You are contacted by the French IP firm Cabinet Rossignol, which has recently filed an International trademark application designating Canada on behalf of its client Champagne Pinard. Your firm already manages several of Champagne Pinard's Canadian trademarks, but you were not involved in this International application. Cabinet Rossignol, as the applicant's representative before the International Bureau of the World Intellectual Property Organization (WIPO), just received a “courtesy letter” from CIPO and is puzzled as to the content of this letter. In one sentence, explain what CIPO's courtesy letter is about. (1 mark)

Answer:

This letter is intended to inform the applicant's international representative that, unless it appoints a registered Canadian trademark agent to manage the Canadian designation of the International application, all future correspondence from CIPO will be sent directly to the applicant. (1 mark)

- b) If no action is taken on this letter, who will receive CIPO's first Examiner's report? (1 mark)

Answer:

The applicant **OR** Champagne Pinard. (1 mark)

QUESTION 8 (5 marks)

- a) With respect to International applications filed in accordance with the Madrid Protocol, what is the time limit for CIPO to send the International Bureau a notification of provisional refusal? **(1 mark)**

Answer:

18 months. **(1 mark)**

- b) What are the Registrar's obligations if it fails to notify the International Bureau of a provisional refusal within the prescribed timeframe? **(3 marks)** Cite the relevant provision of the *Trademarks Regulations*. **(1 mark)**

Answer:

The Registrar must register the trademark in the name of the applicant **(1 mark)**, issue a certificate of its registration **(1 mark)** and send a statement to the International Bureau that protection is granted to the trademark **(1 mark)**. Subsection 132(1) of the *Trademarks Regulations*. **(1 mark)**

QUESTION 9 (1 mark)

What is the official fee to file an application to amend the register under subsection 41(1) of the *Trademarks Act* to extend the statement of goods or services in respect of which a trademark is registered, to cover two (2) additional classes of goods or services? **(1 mark)**

Answer:

- \$530. **(1 mark)**

QUESTION 10 (22 marks)

For each of the following trademarks, advise whether the mark is registrable or not registrable for the associated goods or services, and provide the most significant reason in support of your answer. **(1 mark for each trademark)** Cite the relevant provision or provisions of the *Trademarks Act* in support of your reason. **(1 mark for each provision)** **Please ignore any confusion issues and do not assume acquired distinctiveness.**

- 1) MELANZANE for use in association with "preserved vegetables" (MELANZANE is Italian for "eggplant"). **(2 marks)**
- 2) SAMBUCA for use in association with "carbonated soft drinks". **(2 marks)**
- 3) DO NOT BEND for use in association with "envelopes". **(3 marks)**
- 4) JIM'S VALENCIA ORANGES for use in association with "fresh fruit". **(3 marks)**

- 5) JONES MACDONALD & SONS for use in association with “luggage”. **(2 marks)**
- 6) GENEVA CROSS for use in association with “insurance services”. **(3 marks)**
- 7) NO. 1 FAN for use in association with “furnace blowers”. **(2 marks)**
- 8) PARLIAMENT HILL for use in association with “tax preparation services”. **(3 marks)**
- 9) LEONARD COHEN for use in association with “sandwiches”. **(2 marks)**

Answer:

1. NOT REGISTRABLE – since the goods could include eggplant, the trademark is the name of the goods in another language. **(1 mark)** Paragraph 12(1)(c) of the *Trademarks Act*. **(1 mark)**
2. NOT REGISTRABLE – the trademark deceptively misdescribes the character of the goods since Sambuca is an alcoholic beverage and the goods are non-alcoholic. **(1 mark)** Paragraph 12(1)(b) of the *Trademarks Act*. **(1 mark)**
3. NOT REGISTRABLE – the trademark is not distinctive since it is merely providing general information about the goods. **(1 mark)** Paragraph 32(1)(b) of the *Trademarks Act* **(1 mark)** and paragraph 37(1)(d) of the *Trademarks Act*. **(1 mark)**
4. REGISTRABLE – the portion JIM’S of the trademark has some inherent distinctiveness, which renders the trademark registrable **(1 mark)** OR the trademark is not in whole or in part a protected geographical indication **(1 mark)**. Paragraph 12(1)(h.1) of the *Trademarks Act* **(1 mark)** since VALENCIA ORANGES is listed in subsection 11.18 (4.1) **[with or without subsection (a)]** of the *Trademarks Act* as a common name for an agricultural product **(1 mark)**.
5. REGISTRABLE – the addition of “& SONS” renders the trademark neither a name nor a surname OR the trademark is composed of two surnames. **(1 mark)** Paragraph 12(1)(a) of the *Trademarks Act*. **(1 mark)**
6. NOT REGISTRABLE – the trademark is a prohibited mark. **(1 mark)** Paragraph 9(1)(f) of the *Trademarks Act* **(1 mark)** and paragraph 12(1)(e) of the *Trademarks Act* **(1 mark)**.
7. NOT REGISTRABLE – the trademark clearly describes the character and quality of the goods, i.e., that the goods are fans of superior quality. **(1 mark)** Paragraph 12(1)(b) of the *Trademarks Act*. **(1 mark)**
8. NOT REGISTRABLE – the trademark is likely to lead to the belief that the goods or services in association with which it is used have received, or are produced, sold or performed under governmental patronage, approval or authority. **(1 mark)** Paragraph 9(1)(d) of the *Trademarks Act* **(1 mark)** and paragraph 12(1)(e) of the *Trademarks Act* **(1 mark)**.
9. NOT REGISTRABLE – the trademark is the name of an individual who has died within the preceding thirty years. **(1 mark)** Paragraph 12(1)(a) of the *Trademarks Act*. **(1 mark)**

QUESTION 11 (2 marks)

True or False. (1 mark) An application may be filed for the registration of more than one trademark. Cite the relevant provision of the *Trademarks Regulations*. (1 mark)

Answer:

- False. (1 mark)
- Section 27 of the *Trademarks Regulations*. (1 mark)

QUESTION 12 (6 marks)

What must an application for a sound mark contain? (3 marks) Cite the relevant provisions of the *Trademarks Act* and the *Trademarks Regulations*. (3 marks)

Answer:

- statement that the trademark consists in whole or in part of a sound. (1 mark)
- a clear and concise description of the trademark. (1 mark)
- recording **OR** MP3 **OR** 10 MB file of the sound. (1 mark)
- paragraph 31(e) of the *Trademarks Regulations*. (1 mark)
- paragraph 30(f) of the *Trademarks Regulations*. (1 mark)
- paragraph 30(2)(c) of the *Trademarks Act*. (1 mark)

QUESTION 13 (3 marks)

You have filed an International trademark application based on an existing Canadian registration. CIPO has certified the application and sent it to WIPO. However, WIPO has issued a notification of irregularities. List the three groups of irregularities that can be raised by WIPO to the applicant or its international representative. (3 marks) **Only the first three groups listed will be considered.**

Answer:

- Irregularities concerning the fees (Rule 11 of the *Common Regulations*). (1 mark)
- Irregularities concerning the classification of goods and services (Rule 12 of the *Common Regulations*). (1 mark)
- Irregularities concerning the wording **OR** specification **OR** indication of the goods and services (Rule 13 of the *Common Regulations*). (1 mark)

Note to markers: specific identification of the rule of the *Regulations under the Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks* is not required to award the mark.

QUESTION 14 (2 marks)

True or False. A trademark application may be filed and registered in the name of two individuals. (1 mark) Cite the relevant provision of the *Trademarks Act*. (1 mark)

Answer:

- True. (1 mark)
- Section 2.1 of the *Trademarks Act*. (1 mark)

QUESTION 15 (7 marks)

CIPO issued a first Examiner's report on May 27, 2020. A response is due by November 27, 2020. According to the *Trademarks Examination Manual*, how many six-month extensions of time can an applicant expect to obtain if the following explanations are provided as exceptional circumstances, justifying such extensions? Respond by indicating either **A**, **B** or **C** for each scenario (1 mark each):

Answer choice:

- A:** None, CIPO does not consider this reason to be an exceptional circumstance.
- B:** One six-month extension of time, a different exceptional circumstance would need to be given to obtain further extensions.
- C:** One six-month extension of time, but the same exceptional circumstance could be given to justify the grant of further extensions if the situation persists.

Scenarios:

- 1) Your client's business was temporarily shut down because of the COVID-19 pandemic and, as a result, you have not been able to obtain instructions from them. (1 mark)
- 2) The Examiner has raised a confusion objection with a registered trademark. Your firm has initiated an expungement proceeding against the cited registration pursuant to Section 45 of the Act, but the proceeding is still pending. (1 mark)
- 3) Your client needs more time to consider the objection raised pursuant to paragraph 30(2)(a) of the Act and file a proper response. (1 mark)
- 4) Your client needs more time to consider the objection raised pursuant to paragraph 12(1)(d) of the Act and to file a proper response. (1 mark)
- 5) Your client needs more time to consider the objection raised pursuant to paragraph 12(1)(b) of the Act and compile evidence to claim acquired distinctiveness. (1 mark)
- 6) Your firm has just been appointed as trademark agent in this file and you require more time to become familiar with the file. (1 mark)
- 7) Your client is actively negotiating a consent from the owner of a trademark cited as confusing under paragraph 12(1)(d) of the Act and needs more time to finalize an agreement. (1 mark)

Answer:

- 1) C (1 mark)
- 2) C (1 mark)
- 3) A (1 mark)
- 4) B (1 mark)
- 5) B (1 mark)
- 6) B (1 mark)
- 7) A (1 mark)

QUESTION 16 (2 marks)

In addition to the particulars of the defined standard, what else must be included in an application for the registration of a certification mark that is specific to certification marks and not to other types of marks? (1 mark) Cite the relevant provision of the *Trademarks Act*. (1 mark)

Answer:

- A statement that the applicant is not engaged in the manufacture, sale, leasing or hiring of goods or performance of services such as those in association with which the certification mark is used or proposed to be used. (1 mark)
- Paragraph 30(2)(b) of the *Trademarks Act*. (1 mark)

QUESTION 17 (8 marks)

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

| Case Name | Principle |
|------------------------------------------------------------------------------------------------------------------------------------------|------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------|
| <p>A. <i>Deputy Attorney-General of Canada v. Biggs Laboratories (Canada) Limited</i> (1964), 42 C.P.R. 129</p> <p>Trademark: SHAMMI</p> | <p>1. I must wholeheartedly accept the proposition that it is the duty of the Registrar (and it is my hope that he will always fearlessly exercise it) to consider not merely the general taste of the time, but also the susceptibility of persons, by no means few in number, who still may be regarded as old fashioned and, if he is not of the opinion that the feelings or susceptibilities of such people will be</p> |

| | |
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| | offended, he will properly consider refusal of the registration. |
| <p>B. <i>Leaf Confections Ltd. v. Maple Leaf Gardens Ltd.</i> (1986), 12 C.P.R. (3d) 511 (FC); aff'd (1988), 19 C.P.R. (3d) 331 (FCA)</p> <p>Trademark: LEAF and Design</p> | 2. If a mark falsely suggests a connection with a living individual, the mark cannot be registered. |
| <p>C. <i>Jack Black L.L.C. v. The Attorney General of Canada</i>, 2014 FC 664</p> <p>Trademark: JACK BLACK</p> | 3. Simply because a product description is comprehensible and adequately identifies the product does not mean that it is a description customarily used in the trade to refer to the product. |
| <p>D. <i>Compulife Software Inc. v. Compuoffice Software Inc.</i>, 2001 FCT 559 (CanLII)</p> <p>Trademarks: COMPUOFFICE and ACROSS THE BOARD</p> | 4. An article advertised for sale as containing certain components which, in truth, it does not have, surely must be considered as deceptively misleading to the purchasing public. |
| <p>E. <i>La Marquise Footwear Inc. Re.</i> (1946), 64 R.P.C. 27</p> <p>Trademark: OOMPHIES</p> | 5. It remains for me to assess the probative value of such evidence. In so doing I am conscious that the onus on a person contending that a trade mark which is descriptive or laudatory of his wares has come to actually distinguish those wares is a heavy one and that onus is increased by the adoption of a word which lacks inherent distinctiveness. |
| <p>F. <i>Decra-Loc Canada Ltd. v. Pave Tech, Inc.</i>, 1995 CanLII 10261 (CA TMOB)</p> <p>Trademark: PAVE EDGE</p> | 6. All relevant evidence which tends to establish non-distinctiveness may be considered. In other words, the opponent may rely on television broadcasts, website articles, etc. to establish that the opponent's... mark acquired a reputation in Canada. |
| <p>G. <i>Standard Coil Products (Canada) Ltd. v. Standard Radio Corp.</i> (1971), 1 C.P.R. (2d) 155 (FC)</p> <p>Trademark: STANDARD</p> | 7. Nevertheless, it is clear in considering the elements of s-s. 6(5) of the Trade Marks Act..., each element need not be interpreted as having equal weight. A particular case might justify greater |

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| | significance being given to one criterion over others. As previously stated, I find the respondent's mark and design to be a strong one, well-known throughout Canada. In such cases the courts have held that the distinction between the wares and the nature of the trade of the two competing marks becomes less important. |
| H. Carson v. Reynolds (1980), 49 C.P.R. (2 nd) 57 (FC) Trademarks: HERE'S JOHNNY | 8. A statement of goods or services is considered to be in ordinary commercial terms where research discloses that the goods and services are set out as they are customarily referred to in the trade, where similar language and scope has been commonly used by others in the same industry to describe the applicant's goods or services. |
| | 9. For the purposes of Section 9(1)(k) of the <i>Trademarks Act</i> , the living individual must have a significant public reputation in Canada at the time the application was filed. |
| | 10. I must say that at present we live in what is commonly called a "permissive age" where previously accepted moral standards are undergoing change. The difficulty is to determine what are the acceptable standards today and what would still be considered immoral, scandalous, or obscene by some people by no means few in number. |
| | 11. Marks are inherently distinctive when nothing about them refers the consumer to a multitude of sources. |

Answer:

A-4 (1 mark)

B-7 (1 mark)

C-9 (1 mark)

D-11 (1 mark)
E-1 (1 mark)
F-3 (1 mark)
G-5 (1 mark)
H-2 (1 mark)

QUESTION 18 (2 marks)

An IP portfolio management firm has asked you to file an assignment and subsequent name change against 130 marks in the name of Big Top, Ltd. Several different trademark agents have been handling these applications to date, and you have been informed that, but for this specific project, your firm is not to take over carriage of the prosecution of these marks. Yes or No, can you appoint yourself agent just for the purpose of recording this assignment and name change? (1 mark) Cite the relevant authority. (1 mark)

Answer:

- Yes. (1 mark)
- Practice Notice dated June 17, 2019, "Temporary Appointment of Trademark Agent or Associate Trademark Agent". (1 mark) **[Note: Date and title of Practice Notice not required to receive the mark.]**

QUESTION 19 (5 marks)

A pharmaceutical company, Better Than The Generics, Inc., has asked you to conduct a full pharmaceutical trademark search for the trademark BRYZUNTI for pharmaceutical preparations, and to provide an opinion regarding availability of the mark for use and registration in Canada. You order the search from a third-party search firm, and on reviewing the results, you discover a pending application, for which your firm is listed as agent, for REZUNTI for "inhaled pharmaceutical preparations for the treatment of respiratory diseases and disorders", filed by BTTG Group, Inc. This is the only -ZUNTI suffix mark identified by the search. Describe, in point form, the steps you would take to handle this situation. (5 marks)

Answer:

- Advise Better Than The Generics, Inc. that your firm is agent for this mark before proceeding further. (1 mark)
- Inquire as to whether BTTG Group, Inc. is a related company. (1 mark)
- If the client advises that Better Than The Generics, Inc. and BTTG Group, Inc. are related, proceed with providing the opinion. (1 mark)
- If the client advises that Better Than The Generics, Inc. and BTTG Group, Inc. are not related, advise the client that you have a conflict and cannot comment on the impact of the REZUNTI mark on availability of the BREZYNTI mark for use and registration. (1 mark)
- Offer to provide the client with the name of another agent who may be able to assist. (1 mark)

QUESTION 20 (2 marks)

Name a deadline for which an applicant cannot request an extension of time pursuant to Section 47 of the *Trademarks Act*. (1 mark) Cite the relevant provision of the *Trademarks Act*. (1 mark)

Answer [Note: any of the five combinations below is acceptable.]:

- Deadline to provide the Registrar with all the items necessary to grant a filing date to an application. (1 mark) Subsection 33(2) of the *Trademarks Act*. (1 mark)

OR

- Deadline to claim priority of an application filed abroad. (1 mark) Subsection 34(5) of the *Trademarks Act*. (1 mark)

OR

- Deadline to renew a registration after the expiration of the Notice of Renewal. (1 mark) Subsection 46(5) of the *Trademarks Act*. (1 mark)

OR

- Deadline to appeal a decision of the Registrar. (1 mark) Section 56 of the *Trademarks Act*. (1 mark)

OR

- Deadline to file a transformation application. (1 mark) Subsection 147(1) **OR** Subsection 147(6) of the *Trademarks Regulations*. (1 mark)

QUESTION 21 (2 marks)

True or False. (1 mark) The particulars of the defined standard of a certification mark need not be set out in their entirety in the trademark application. Cite the relevant authority. (1 mark)

Answer:

- True. (1 mark)

- *Trademarks Examination Manual* **OR** the KOKANEE decision **OR** *Molson Breweries v. Labatt Brewing* (1996), 69 C.P.R. (3d) 274. (1 mark)

QUESTION 22 (22 MARKS)

Your client, The Fresh People, Inc., has applied to register the trademark ALPINE FRESH in association with “personal products such as shower gels” in Class 3, and “hand-held shower heads” in Class 11. You have received the first Examiner’s Report in connection with this application (see below).

BEST TRADEMARK FIRM
OTTAWA, ONTARIO

Attention: Candidate

RE: Trademark: ALPINE FRESH
Applicant: The Fresh People, Inc.

This examiner's report concerns the above identified application. To avoid abandonment proceedings, a proper response must be received by this office by January 14, 2021. All correspondence respecting this application must indicate the file number.

As this application was filed prior to, and not advertised as of, June 17, 2019 it has been examined under the provisions of the amended *Trademarks Act* and the new *Trademarks Regulations*.

The trademark is considered to be clearly descriptive or deceptively misdescriptive of the character or quality of the associated goods: personal products such as shower gels. Specifically, the trademark clearly describes that the "shower gels" are scented like, or have the fragrance of, alpine plants and leave the user clean and invigorated. In that regard, the *Merriam-Webster Dictionary* defines "FRESH" as "new" or "clean" and "full of or renewed in vigor" and "ALPINE" as a "a plant native to alpine or boreal regions". The Examiner's research also discloses that "ALPINE" is in common use in association with regard to fragrances and "FRESH" is in common use in association with personal care products.

Alternatively, if the goods at issue do not have this feature, trait, characteristic, or quality, the trademark is considered to be deceptively misdescriptive.

Therefore, in view of the provisions of paragraph 12(1)(b) of the *Trademarks Act*, the trademark does not appear registrable in association with the goods "personal products such as shower gels".

The word "character" means a feature, trait or characteristic of the goods and services. The test of whether a trademark is clearly descriptive considers the immediate first impression of the average Canadian user, purchaser, or consumer of the associated goods and services.

One of the most important purposes of paragraph 12(1)(b) of the *Trademarks Act* 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 since this would give them an unfair advantage over competitors in the same trade.

Pursuant to paragraph 37(1)(d) of the *Trademarks Act*, it appears that the trademark is not distinctive in association with shower gels. In particular, trademarks for which an objection is raised under paragraph 12(1)(b) of the *Act* are considered not inherently distinctive. Therefore, pursuant to paragraph 32(1)(b) of the *Act*, the applicant may wish to furnish the Registrar with

evidence establishing that the trademark was distinctive at the filing date of the application for its registration. Alternatively, the applicant may wish to provide, in writing, information which would persuade the Registrar to withdraw the objection that the trademark is not, on a preliminary view, inherently distinctive. Please note that pursuant to subsection 32(2) of the *Act*, the Registrar shall, having regard to the evidence adduced, restrict the registration to the goods or services in association with which, and to the defined territorial area in Canada in which, the trademark is shown to be distinctive.

The applicant's written comments with respect to these matters are invited.

In addition, pursuant to paragraph 30(2)(a) of the *Trademarks Act*, an application for the registration of a trademark must contain a statement in ordinary commercial terms of the associated goods and services. Furthermore, section 29 of the *Trademarks Regulations* requires that the statement must describe each of those goods or services in a manner that identifies a specific good or service.

It is considered that the following goods are not in specific and ordinary commercial terms: "personal products such as shower gels".

The applicant's grouping of the goods according to the classes of the Nice Classification will be reassessed once the queried goods have been redefined.

The applicant is required to file an amended application, using the e-service on the CIPO website at www.cipo.ic.gc.ca, by fax at 819-953-2476 or by mail at the following address:

Registrar of Trademarks
Place du Portage I
50 Victoria Street, room C-114
Gatineau, QC K1A 0C9

If the applicant has any specific questions in respect of this Office action, please contact the assigned examiner. Please note that for general inquiries, including assistance with filing of the revised application, queries about the status of an application or receipt of correspondence, you may contact our Client Service Centre toll free at 1-866-997-1936.

Any comments you may wish to submit in writing will receive consideration.

Yours truly,

Ms. Trademark Examiner
Examination Section
819-000-000
fax: 819-953-2476

-
- a) With regard to the objection based on paragraph 30(2)(a), what would your recommendation to the client be for amending this term? (1 mark)

Answer:

- With regard to the requested respecification of “personal products such as shower gels”, replace “such as” with “namely” **OR** delete “personal products such as”. (1 mark)

- b) Draft a reporting letter to your client, setting out their options for response to the substantive objections. If there are several options for responding to the Examiner’s report, list all possible options and explain how you would respond to the report and what information you will need from your client to do so. (21 marks)

Answer:

- Delete the Class 3 goods **OR** limit the application to Class 11. (1 mark)
- File a divisional application for the goods in Class 3. (1 mark)
- Argue against the 12(1)(b) and 37(1)(d) objections **OR** argue against the descriptiveness and non-distinctiveness objections. (1 mark)
- Possible arguments could include (1 mark per valid argument up to a maximum of 5 marks):
 - ALPINE does not refer to a specific plant or scent.
 - ALPINE is merely suggestive of how the goods could smell.
 - FRESH is not clearly descriptive of the character or quality of the goods and merely suggests the idea of “clean”.
 - The mark does not describe a material or intrinsic component of the goods.
 - No other trader is deprived of essential language required to describe its goods.
 - The combination of the words ALPINE and FRESH is unique and distinctive and thus registrable.
 - *[Note to markers: any other valid argument will earn 1 mark up to a maximum of 5 marks]*
- Ask client if the mark has been used in Canada prior to the application filing date (1 mark) and discuss the possibility of filing evidence of acquired distinctiveness under subsection 12(3) and 32(1)(b) of the Act (1 mark).
- The following information and documents will be necessary to file evidence of acquired distinctiveness:
 - Name and title **OR** position of the person signing the affidavit (2 marks).
 - Particulars of the applicant’s company. (1 mark)
 - Date of first use of the mark in Canada. (1 mark)
 - Sales figures of the goods in Canada for the past 5 years or so (1 mark) broken down by province (1 mark).
 - Amounts spent in advertising the goods of the mark in Canada for the past 5 years or so (1 mark), broken down by province (1 mark) and by media or type of advertising (1 mark).

- Provide specimens *[or any word that suggests specimens]* of the trademark as used in Canada in relation to the goods. (1 mark)
- Provide samples of advertising materials used in Canada in relation to the goods. (1 mark)

QUESTION 23 (4 MARKS)

Yes or No. Would each of the following marks be recognized as a prohibited mark under Section 9 of the *Trademarks Act*? (1 mark each)

- a) **TAX BUDDY** for the name of a tax return software developed by the Government of Canada for use by the Canada Revenue Agency. The software is not yet available to Canadian consumers, but the mark was mentioned in internal communications between employees of the Canada Revenue Agency such as e-mails and memoranda. (1 mark)
- b) **PARIS JE T'AIME** for services promoting tourism in Paris, France. This mark has been used in Canada for 5 years by the French State represented by the Ministry of Tourism. The mark can be seen on various travel websites and on billboards located in Toronto, Montreal and Vancouver. (1 mark)
- c) **UNIVERSITY OF CAMBRIDGE** for online education services offered in Canada since 2010 by the University of Cambridge in England. (1 mark)
- d) **LOTTO BINGO** for lottery services adopted and used since 2019 by the Ontario Lottery and Gaming Corporation. Research shows that the Registrar has already given public notice of adoption and use of the official mark LOTTO BINGO (No. 934,299) to the Western Canada Lottery Corporation. (1 mark)

Answer:

- a) No (1 mark)
- b) No (1 mark)
- c) Yes (1 mark)
- d) Yes (1 mark)

QUESTION 24 (2 MARKS)

True or False. (1 mark) A trademark agent that does not reside in Canada may represent an applicant in any business before the Office of the Registrar of Trademarks. Cite the relevant provision of the *Trademarks Regulations*. (1 mark)

Answer:

False (1 mark)

QUESTION 25 (3 MARKS)

Your client is on a tight budget and has requested filing of the trademark ATTITUDE for t-shirts, pants and skirts. Before filing the application, you conduct a quick search for the identical mark on the Canadian register and note that the US company Attitude Wear Inc. owns a registered trademark for ATTITUDE WEAR in association with various clothing items, footwear and handbags. You are about to pick up the phone to inform your client of this potential obstacle when you note that your client had specifically instructed you not to conduct preliminary searches before filing the application since your client does not have the budget for such searches. What should you do? (1 mark) Briefly explain your reasoning. (2 marks)

Answer:

You should nevertheless inform your client of this potential obstacle. (1 mark) This information may affect the interest of your client **OR** would impact your client's decision to file the trademark. (1 mark) Since your client's budget is limited, not informing him of this obstacle would incur additional costs (reporting and responding to Examiner's report, refiling another trademark, etc.). (1 mark)

QUESTION 26 (2 MARKS)

You have a new client who has come to you in a panic. They received an Examiner's Report from CIPO months ago, specifying a response deadline of October 30, 2020. They completely forgot about the Examiner's Report, just discovering it this week under a pile of papers. Needless to say, they have missed the response deadline, and have come to you to see if there is anything they can do to save the application. Yes or No. (1 mark) Is it too late to save the application from abandonment? Cite the relevant provision of the *Trademarks Act*. (1 mark)

Answer:

No. (1 mark)

Section 36 of the *Trademarks Act*. (1 mark)

TRADEMARK AGENT EXAM 2020
PART B
TOTAL MARKS: 150

Question 1 (8 marks)

On behalf of your client, your firm requested the issuance of a Section 45 Notice against the registration for the trademark MORE SMORES (Reg. No. TMA987,654) owned by Lap of Luxury Inc. and covering the goods *Backpacks; Hiking boots and hiking shoes; Flashlights* and the services *Operation of a service for the organisation of camping trips, namely, the booking of camp sites and the provision and delivery of camping supplies, namely, tents, sleeping bags, cooking gear and food.*

Two months later, you received the following affidavit from the registrant's agents:

IN THE CANADIAN TRADEMARKS OFFICE

In the Matter of S. 45 Proceedings Regarding Registration No. TMA987,654 for the trademark MORE SMORES owned by Lap of Luxury Inc.

AFFIDAVIT OF GREGORY ROVER

I, Gregory Rover, of Ottawa, Ontario, hereby make oath and say as follows:

- 1. I am the president and sole shareholder of Lap of Luxury Inc. (at times referred to as “**my Company**”) and have held this position since my Company was founded in 2012. In that capacity, I am familiar with the use of the trademark MORE SMORES. I therefore have personal knowledge of, and maintain records of and/or have access to corporate records relating to the matters which I hereinafter depose.*
- 2. Lap of Luxury Inc. was incorporated under the laws of Canada on February 14, 2012.*
- 3. Lap of Luxury Inc. owns Canadian trademark registration TMA987,654 (the “**Registration**”) for MORE SMORES (the “**Mark**”) covering the following goods and services:*

Goods: *Backpacks; Hiking boots and hiking shoes; Flashlights (the “**Goods**”)*

Services: *Operation of a service for the organisation of camping trips, namely, the booking of camp sites and the provision and delivery of camping supplies, namely, tents, sleeping bags, cooking gear and food (the “**Services**”)*

- 4. Section 45 proceedings have been commenced in respect of the Registration. The section 45 notice is dated September 12, 2020 and, in response thereto, use of the Mark must be shown between September 12, 2017 and September 12, 2020 (the “**Relevant Period**”).*

5. *My Company has sold the Goods and the Services in Canada since February 2012 when my Company was founded.*
6. *The Goods are sold through a variety of retail store establishments in Canada, including MEC, Sail, Sporting Life, and L'Equipeur.*
7. *In the past 5 years, my Company has sold a total of over 6,000 backpacks. And in each of those 5 years, my Company has sold at least 500 pairs of hiking boots and hiking shoes.*
8. *Labels or tags bearing the Mark are usually affixed to the Goods when they are offered for sale in Canada. Attached hereto as **Exhibit A** is a sample label showing the Mark on a backpack. This label is representative of how the Mark has appeared on backpacks sold in Canada during the Relevant Period. [For the sake of the question, assume that the exhibit shows exactly what is stated.]*
9. *For footwear, the Mark will also appear on the box in which the shoes or boots are sold. Attached hereto as **Exhibit B** is a photograph showing the Mark on a shoebox. This box is representative of all boxes that have been received by consumers who purchased my Company's footwear during the Relevant Period, as evidenced by the sample invoices for shoes and boots issued during the Relevant Period attached hereto as **Exhibit C**. [For the sake of the question, assume that the exhibits show exactly what is stated.]*
10. *For flashlights, the Mark is engraved on the product itself. Attached hereto as **Exhibit D** is a photograph showing the Mark on a flashlight. The manner in which the Mark appears on the flashlight shown in this photograph is representative of the manner in which the Mark has appeared on flashlights sold by my Company during the Relevant Period. [For the sake of the question, assume that the exhibit shows exactly what is stated.]*
11. *My Company often provides a flashlight bearing the Mark to persons who purchase a significant amount of my Company's services. During the Relevant Period, my Company gave out at least 5,000 flashlights to those persons, or to retailers that promote the Services to consumers.*
12. *The Services are advertised at those retail establishments, and online, and sold directly to individual consumers or to groups looking to organise a camping trip in Canada.*
13. *Attached hereto as a bundle as **Exhibit E** are copies of flyers that were used in the springs/summers of 2017 and 2018 to advertise the Services. [For the sake of the question, assume that the exhibit shows exactly what is stated.]*
14. *Total annual sales of the Goods in Canada for the past five years have been in excess of \$900,000, and total annual sales of the Services in Canada for the past five years have been in excess of \$25,000.*
15. *The facts and information contained in this affidavit are true and correct to the best of my knowledge.*

[signature and date reference/line, with Commissioner] November 5, 2020

For each of the goods and services associated with the Registration, advise your client as to whether the registration will be maintained or expunged (**1 mark**) and give one valid reason to support your answer (**1 mark**). **[total of 8 marks]**

Question 2 (12 marks)

You represent the opponent in a trademark opposition proceeding. A few weeks after the filing of the opponent's evidence in chief, your client provides you with important new evidence that was not previously available. This evidence would strongly assist your client's position in the proceeding. The applicant has not yet filed its evidence and your affiant is set to be cross-examined next month. On behalf of your client, you need to prepare a request to the Registrar seeking leave to submit additional evidence.

- a. In deciding whether to grant the opponent's request for leave to submit additional evidence, what test will the Registrar apply? (**1 mark**) Cite the relevant provision(s) of the *Trademarks Regulations*. (**1 mark**)
- b. Draft a request seeking leave to submit additional evidence by citing the appropriate criteria that will be considered by the Registrar and applying them to the fact scenario. Clarity and structure will also be marked. (**10 marks**)

Question 3 (32 marks)

You have just received the following e-mail from the managing partner of your firm:

From: Robert Robertson
Sent: November 24, 2020 2:13 PM
To: Trademark Agent
Cc: Administrative assistant
Subject: FWD: Am I in trouble?

Hi Junior!

Congratulations on passing your trademark agent exams, we're all proud of you (I flunked them twice and gave up!). Now you can work on becoming a partner in a law firm, without even being a lawyer!

Listen, I have a file for you, see below. The client is pretty stressed out, so please get back to him ASAP. Copy me on your response.

Thanks,

Bob

Robert Robertson, Q.C.
Lawyer, Managing Partner
Robertson & Robertson LLP
100 Spring Garden Road
Halifax NS B3J 1A1

----- Original Message -----

From: Donald McDonald
Sent: November 24, 2020 2:11 PM
To: Robert Robertson
Cc: Steve Stevens
Subject: Am I in trouble?

Hey Bob!

I need your quick help.

You remember my RÖKKEN RØL beer and soda project I talked to you about last summer when I bumped into you in the Canadian Tire parking lot? Well, things are starting off pretty good: I'm about to receive my first cases of beer (IPA, Pilsner and stout) and soda (cola and root beer) from my suppliers and I already have three local restaurants as clients who are eager to start selling RÖKKEN RØL. I'm about to sign a couple more restaurants here and across the bridge over in Dartmouth, and I'm hoping to have a dozen restaurants and bars selling my new beer and soda in time for the holiday season...well, that is if I'm not getting myself in trouble for doing so.

Steve's brother (Steve is my marketing guy) lives out in Vancouver and, while videoconferencing Steve, he said that there's a restaurant chain out in BC called "Musicland" that sells a house brand wine called "Rock n' Roll" (a house beer called "Heavy Metal", milkshakes called "Doo-wops", anyway, you get the concept).

Steve said this could be a problem. He checked it out and found they even have a trademark registration for ROCK 'N' ROLL (the details are attached). I know there are a lot of "rock n' rolls" out there, even in the beverages business, so I thought I'd be OK with an original spelling. But I'm really worried. I can't afford being sued, but then again, I already have over \$200k invested in this, so I can't really go back either.

Am I in trouble or am I worrying too much for nothing?

Please get back to me ASAP as I have a board meeting tonight and this is on the top of the agenda.

Keep on rökken røllin!

Don

Donald McDonald, CEO
Multi Beverages Inc.
200 South Street
Halifax NS B3J 2B2

The following was attached to the e-mail:



ROCK N' ROLL & DESIGN — 1234567



Application number
1234567

Registration number
TMA454545

Type(s)
Design

Category
Trademark

CIPO status
REGISTERED

Filed
1994-03-04

Registered
1996-02-23

Registration Date **Expiry**
2026-02-23

Current owner
MUSICLAND,
LIMITED
ONE GRANVILLE
STREET
VANCOUVER,
BC
V6Z1A1

Index headings

ROCK N' ROLL
ROCK AND ROLL

Vienna information (Code & Description)

24.17.10 Musical symbols
A Treble clefs with notes and stave or with
24.17.13 stave alone

Goods

(1) Wines.

Classification data

Disclaimer

The classification data is provided for information and searching purposes only. CIPO does not warrant the accuracy of the classes assigned to the trademark. This data has no legal value of any kind.

33 - Wines and spirits

Claims

Declaration of Use filed December 06, 1995

- a) What's the first thing you must do before actually starting to work on the requested opinion? **(1 mark)**
- b) Write a detailed formal opinion to the client on the issue of confusion between RÖKKEN RØL and the cited mark ROCK N' ROLL & Design. Address all the relevant criteria, marks will also be awarded for grammatical form and coherence. **(18 marks)**
- c) What additional information would have been relevant to help you in your analysis? List three (only the first three answers will be marked). **(3 marks)**
- d) Notwithstanding your opinion at question b) above, what recommendations could you give the client in order to reduce the risk of confusion? List two (only the first two answers will be marked). **(2 marks)**
- e) Notwithstanding any opinion you may have given the client, the latter has decided to pursue the RÖKKEN RØL project. One month later, the client sends you a copy of a demand letter he just received from Musicland, Limited's lawyers and which alleges trademark infringement and passing-off and threatens to initiate an action before the Federal Court. Can you, as a non-lawyer trademark agent, provide an opinion to the client on the merits of the demand letter and the possible outcome of threatened judicial litigation? Yes or no? **(1 mark)** Why? **(1 mark)**
- f) On the basis of the facts at your disposal, would Musicland, Limited have good grounds for an action on the basis of passing-off? Yes or no? **(1 mark)** Why? **(2 marks)**
- g) A few weeks later, you run into the client at a restaurant and he invites you over to his table for a quick RÖKKEN RØL beer (while sitting two meters apart). The client then tells you "a secret": his company had actually sold wine under the trademark RÖKKEN RØL before moving on to beer and soda. The client didn't want to tell Mr. Robertson at the time for fear of making an admission of trademark infringement, but now understands that had he told Mr. Robertson so, that information would have been subject to the solicitor-client privilege. As such, the client is now more open to sharing this information with you. Could you nevertheless be subpoenaed to disclose this information in a trademark infringement action initiated by Musicland, Limited against your client? Yes or no. **(1 mark)** State why **(1 mark)** and provide the authority supporting your answer **(1 mark)**.

Question 4 (14 marks)

The following questions all relate to section 45 proceedings. For each question, indicate whether the statement is true or false **(1 mark per question)** and provide one reason to explain and/or justify your answer, such as a provision of the Act, the Regulations or a Practice Notice and, if none apply, then a statement in your own words **(1 mark per question)** **[total of 14 marks]**

- a. If a requesting party decides to discontinue the S. 45 proceedings, once initiated, that party can do so without contacting the registrant.
- b. The loss of a key employee will likely be accepted as a reason justifying the absence of use of a registered mark, such that the registration will be maintained.
- c. The use of the registered mark by the registrant's licensee, during the relevant period, can be used to support the registration.
- d. The requesting party can probe and test the evidence filed by the registrant by cross-examining its affiant(s).
- e. If the registrant cannot show sales of the goods in Canada during the relevant period, its registration can be maintained if the registrant shows that the mark appeared in association with the goods when they were exported outside Canada.
- f. Evidence in S. 45 proceedings must be served by registered mail.
- g. When a request is filed asking the Registrar to commence section 45 proceedings, the registrant or its recorded trademark agent must be copied on that request.

Question 5 (6 marks)

Your client is Jenny Cooke. Jenny has personally operated a pet grooming business under the name "Belles and Whiskers" from her basement in Sarnia, Ontario, since February 2018. At the time the business opened, she was the sole proprietor of the business. In January 2019, following the advice of her accountant, Jenny incorporated the company B&W Inc., which henceforth legally operated the business, but in practice nothing has changed.

In January 2020, Jenny noted a recently filed application for BELLS AND WHISTLES for *pet grooming services* and she plans to oppose it. In support of her opposition, she will want to rely on her past use of the mark and its continued use by B&W Inc.

- a. Can Jenny rely on the use of the mark by B&W Inc.? (1 mark) How/Why can the opposition rely on the use by B&W Inc.? (3 marks) Identify the statutory authority that applies. (1 mark)
- b. In the context of the previous question, give Jenny one piece of advice to improve her position. (1 mark)

Question 6 (3 marks)

Identify three circumstances where the Registrar may refuse to issue a section 45 notice; only the first three answers will be marked. (3 marks)

Question 7 (31 marks)

Your client, Largoi Inc. (“**Largoi**”), is a Tofino, British Columbia based company specialising in the manufacture and sale of luxury, west coast inspired clothing, lifestyle and décor items in association with the trademark and trade name LARGOI, as well as the trademark LARGOI Design, depicted below.



Since opening its first brick and mortar store in Tofino in 1999, Largoi now operates stores in five locations across British Columbia, including three in Vancouver, and enjoys a strong reputation in the province. In 2012, Largoi began selling its products, including candles, candle holders, essential oils for personal use, house slippers, sweaters, raincoats, bathrobes, and pet beds, in Eastern Canada through the Montreal based company LuxeGroove Inc. (“**LuxeGroove**”). However, following bitter business discussions at the expiration of the distribution contract last year (August 2019), Largoi decided not to renew the agreement. Rather, Largoi decided to maintain its growing foothold in the Eastern Canadian market by focusing on its burgeoning online platform at www.largoi.com.


Through its website, which went live in November 2018, Largoi has been successfully selling, across Canada, many of its goods, including candles, candle holders, essential oils for personal use, house slippers, sweaters, raincoats, bathrobes, and pet beds. All of Largoi’s products bear the word mark and trade name LARGOI and/or the LARGOI Design mark. Both the LARGOI word mark and the LARGOI Design mark, as well as the LARGOI trade name, prominently appear on the website, including at the time that consumers place orders for the goods.

Largoi indicates that it has secured a Canadian copyright registration for LARGOI Design. However, it does not currently own any pending trademark applications or registrations in Canada for the LARGOI word or design trademarks.

Just before the close of business on Friday, November 20, 2020, Largoi contacts you to advise that it has just become aware of two recently advertised applications for the trademarks LARGOI LUXE, and LARGOI LUXE Design, the particulars of which have been advertised in Vol 88 No. 1234 of the *Trademarks Journal* dated 2020-09-30, and are set out below:

| | |
|--------------------------|------------------------|
| Application No 1,888,888 | Filing Date 2019-07-30 |
| Applicant: | Goods: |

| | |
|---------------------------------------------------------------------|---------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------|
| LuxeGroove Inc. 703 Rue Principale Montreal QUEBEC H3G 2T7 | Class 03: (1) Essential oils for personal use Class 04: (2) Candles |
| Trademark: LARGOI LUXE Trademark Type Word | Class 18: (3) Pet accessories Class 21: (4) Candle holders Class 24: (5) Blankets Class 25: (6) House slippers, pajamas, bathrobes, ponchos, sweaters, raincoats |

| | |
|---------------------------------------------------------------------------------------------------------------------------------------|-------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------|
| Application No 1,888,889 | Filing Date 2019-07-30 |
| Applicant: LuxeGroove Inc. 703 Rue Principale Montreal QUEBEC H3G 2T7 | Goods: Class 03: (1) Essential oils for personal use Class 04: (2) Candles Class 18: (3) Pet accessories Class 21: (4) Candle holders Class 24: (5) Blankets Class 25: (6) House slippers, pajamas, bathrobes, ponchos, sweaters, raincoats |
| Trademark:  Trademark Type Design | |

Your client is very concerned about these applications filed by its former distributor. Your client advises you that among the terms of its distribution agreement with LuxeGroove was an acknowledgement of ownership of the trademarks LARGOI and LARGOI DESIGN by Largoi Inc., and an undertaking by LuxeGroove never to use or apply for any trademarks comprised of or including the element LARGOI in Canada. Your client instructs you to take immediate steps to stop LuxeGroove from securing registration of these trademarks.

You immediately begin preparing statements of opposition.

a) The grounds of opposition to be applied are those set out under the *Trademarks Act*, RSC 1985 c. T-13, as amended on June 17, 2019. Is this because the filing dates of the applications fall after June 17, 2019, because the dates of advertisement for the applications fall after June 17, 2019, or because the statements of opposition will be filed after June 17, 2019? Cite the relevant section of the *Trademarks Act* supporting your answer **(2 marks)**.

b) Based on the information available, identify the four strongest grounds of opposition against application No. 1,888,888 for the word trademark LARGOI LUXE by citing the relevant provisions of the *Trademarks Act*. Specifically, identify those four grounds that you consider to have the greatest chance of succeeding at opposition and resulting in the refusal of the application in its entirety. For each ground alleged, state the fact(s) justifying your selection. Only the first four grounds will be marked. General clarity of the answer will also be marked. **(18 marks)**

c) The grounds of opposition set out in the pleadings in respect of the opposition to the LARGOI LUXE DESIGN application will be substantively identical to the grounds set out in the opposition to the LARGOI LUXE word mark. However, there is one additional ground of opposition that may be pleaded in the opposition to the LARGOI LUXE DESIGN application. Identify this additional ground of opposition. In doing so, cite the relevant provision of the *Trademarks Act* **(1 mark)** and state the facts justifying your selection **(2 marks)**.

d) You complete and finalise the statements of opposition and leave them with your administrative support staff for filing with the Trademarks Office with instructions that the documents are time sensitive so must be timely filed. What is the initial deadline to file the statements of opposition? In your answer, provide the specific date **(1 mark)** and cite the relevant statutory provision **(1 mark)**.

e) A week after the filing deadline has passed, it comes to your attention that the statements of opposition were not timely filed and that they still need to be submitted. There were a number of factors that led up to this: in the days leading up to the filing deadline, your firm was in the process of transitioning over to a new docketing system and these cases were inadvertently missed. While your administrative support staff keeps a secondary docketing system, the paralegal responsible for these files became unexpectedly ill and was out of the office on the deadline.

You immediately prepare requests for retroactive extensions of time to file the statements of opposition. What should be included in and accompany your request for each case? Where possible, provide specific information in your answer. **(4 marks)**

f) Are you required to copy the applicant on your request for a retroactive extension of time? Yes or no? **(1 mark)**. Cite the relevant regulatory provision **(1 mark)**.

Question 8 (5 marks)

In the context of a section 45 proceeding, the registration at issue is for the trademark CHUMHUM. The evidence filed in support of the registration shows use of the mark CHUM HUM, CHUM-HUM and CHUM/HUM. What test would apply to this situation? **(1 mark)** What are the three criteria for this test? **(3 marks)** Cite one landmark case in which that test is set out. **(1 mark)**

Question 9 (27 marks)

a) You represent the Applicant in a trademark opposition proceeding. You have been served with the affidavit below from the agent for the Opponent. This affidavit forms the entirety of the opponent's Rule 50(1) evidence. The Affidavit has two exhibits but only one (Exhibit A) is reproduced in its entirety in the context of this question; assume that Exhibit B was properly included.

An issue in this opposition proceeding is confusion between the Applicant's trademark CLOUD CLOTHING in respect of athletic clothing and the Opponent's trademark CLOUD COATS in respect of winter coats.

Identify ten clear deficiencies in the affidavit below and point out where in the affidavit they are found **(1 mark per deficiency identified)** and provide a brief explanation why the deficiency is problematic **(1 mark per explanation)**. The deficiencies to be identified can be substantive to the issues at hand or technical in nature. Only the first ten answers will be marked. (total **20 marks**)

IN THE CANADIAN INTELLECTUAL PROPERTY OFFICE

*IN THE MATTER OF an Opposition by 1234 Canada Inc. (the “**Opponent**”) to Application No. 1,888,881 for the trademark “CLOUD CLOTHING” filed by ABCD Ontario Inc. (the “**Applicant**”) and advertised in the February 5, 2020 issue of the Trademarks Journal.*

AFFIDAVIT OF ROBERTA JONES

I, ROBERTA JONES, of the City of Winnipeg, Province of Manitoba, Canada, MAKE OATH AND SAY:

- 1. I am the Director of Marketing and an officer of 1234 Canada Inc. (“**my company**”), a position which I have held since 2003. I am authorised by my company to make this affidavit in support of this opposition.*
- 2. 1234 Canada Inc. developed and owns patented technology for synthetic insulation used in winter coats. 1234 Canada Inc.’s Canadian patent CA 2,000,000 for this technology expires in 2029 (“**Patented Technology**”). 1234 Canada Inc. licenses this Patented Technology to various outerwear manufactures inside and outside of Canada. This popular Patented Technology is used in 17 different coat brands sold by 28 different retailers across Canada.*
- 3. In addition to the licence for this Patented Technology, 1234 Canada Inc. has a licence with one outerwear retailer in Canada, namely, THE HARBOUR, for use of the trademark CLOUD COATS in association with winter coats for arctic expeditions using Patented Technology. 1234 Canada Inc. has a registered the trademark CLOUD COATS as word mark in the United States of America.*
- 4. THE HARBOUR, with its head office in Toronto, has 88 retail locations in 8 provinces in Canada including British Columbia, Ontario and Prince Edward Island according to the Canadian president of the THE HARBOUR, Susan Hébert. THE HARBOUR sells branded CLOUD COATS in most of those locations pursuant to a licence agreement with my company since at least as early as 2010. The suggested retail price of the coat is \$650 plus applicable taxes. This price is generally adopted by THE HARBOUR retail stores across Canada.*
- 5. Now shown to me and attached as **Exhibit “A”** is the hangtag that THE HARBOUR generally uses for the coats that it sells under the CLOUD COATS trademark at most of its locations across Canada. On the back of the hang tag is the bar code, price, care instructions, components of the coat in accordance with the Textile Labelling Act, and where this particular coat was manufactured. This is the only marking of CLOUD COATS on any coats using the Patented Technology.*

6. In certain locations of *THE HARBOUR* in British Columbia where the coats with the Patented Technology are in high demand, rather than use branded hangtags, there is a sign with the trademark in a prominent position in the storefront window. Below is a representative depiction of the sign.



7. Now shown to me and attached as **Exhibit “B”** to this affidavit is a bundle of typical invoices that were issued by an outer wear manufacturer to head office of *THE HARBOUR* for the sale of coats in Canada. In this exhibit the manufacturer is in Fall River Idaho, USA.

The representative text that includes reference to items sold is replicated exactly below.

| <i>Item No.</i> | <i>SKU#</i> | <i>Description of item</i> | <i>No.</i> | <i>Cost per Unit</i> | <i>Total</i> |
|-----------------|-------------|----------------------------|------------|----------------------|--------------|
| 1. | #23kde3 | Coats – CC | 56 | 157.00 | \$8792.00 |

8. I have been advised by our accounting department, information that I have access to by virtue of my position at my company, the revenues generated by my company for the licence to use the trademark CLOUD COATS by THE HARBOUR associated with the trademark in Canada in each of the years since 2010 have been approximately \$500,000.
9. In reviewing all of the licence agreements of my company since 2010 in respect of the trademark CLOUD COATS with THE HARBOUR and data provided by THE HARBOUR in accordance with the licence, which is limited to the number of coats sold, there were approximately 3,500,000 coats sold across Canada since 2010.

SWORN BEFORE ME at the City of)
Winnipeg, in the Province of Manitoba)
this 17th day of July, 2020)

)
)
)
)

(s) Roberta Jones
FRANK SMITH

(s) William Alvin Tremblay)

A Commissioner for taking Affidavits, etc.
WILLIAM ALVIN TREMBLAY
A commissioner for Oaths
in and for Manitoba
My commission expires June
12, 2020
Appointee No. 2349392

This is Exhibit "A"
to the Affidavit of Roberta Jones sworn before me on July 17, 2020

Commissioner for Taking Affidavits / Notary Public
(or as may be)



- b) If the opponent would like to include hearsay evidence in its affidavit, list the two characteristics of evidence that provide an exception to the rule against the admissibility of hearsay evidence. **(2 marks)**
- c) True or False. If the opponent would like to include a copy of a trademark registration as part of its evidence in these opposition proceedings it must do so by adding it to an affidavit or statutory declaration. Cite the relevant provision of the *Trademarks Regulations*. **(2 marks)**
- d) What is your client's burden of proof in these opposition proceedings? Legal or evidential. **(1 mark)**
- e) True or False. The opponent must file evidence in this trademark opposition proceeding for the opposition to proceed to the next step. **(1 mark)** Cite the relevant provision of the *Trademarks Regulations*. **(1 mark)**

Question 10 (6 marks)

You represent the owner of a registered trademark that has assigned a trademark to a new owner. As part of the assignment agreement it is your responsibility to advise CIPO of the change in ownership.

- a. Identify the information you must provide CIPO to record the transfer and provide the authorities for your answer, if any. **(5 marks)**
- b. What additional item must you provide to CIPO, if any, if you represent a transferee that is seeking to record the transfer? **(1 mark)**

Question 11 (6 marks)

As a new trademark agent, you just leased your first office at an amazing coworking space called THEYWORK. On your first day at your new office you learned that a trademark agent two doors down from you has been suspended as a result of disciplinary hearings.

- a. What step do you need to take, if any. **(1 mark)** Provide the authority for your answer. **(1 mark)**.
- b. The suspended agent has asked you to help file responses to office actions for its client that the suspended agent will prepare for you. Should you file these responses? **(1 mark)** Provide the authority for your answer. **(1 mark)**.
- c. Does it make a difference if the suspended agent is not billing his client for the work? **(1 mark)** Provide the authority for your answer. **(1 mark)**

TRADEMARK AGENT EXAM 2020

PAPER B

TOTAL MARKS: 150

Question 1 (8 marks)

On behalf of your client, your firm requested the issuance of a Section 45 Notice against the registration for the trademark MORE SMORES (Reg. No. TMA987,654) owned by Lap of Luxury Inc. and covering the goods *Backpacks; Hiking boots and hiking shoes; Flashlights* and the services *Operation of a service for the organisation of camping trips, namely, the booking of camp sites and the provision and delivery of camping supplies, namely, tents, sleeping bags, cooking gear and food.*

Two months later, you received the following affidavit from the registrant's agents:

IN THE CANADIAN TRADEMARKS OFFICE

In the Matter of S. 45 Proceedings Regarding Registration No. TMA987,654 for the trademark MORE SMORES owned by Lap of Luxury Inc.

AFFIDAVIT OF GREGORY ROVER

I, Gregory Rover, of Ottawa, Ontario, hereby make oath and say as follows:

- 1. I am the president and sole shareholder of Lap of Luxury Inc. (at times referred to as “**my Company**”) and have held this position since my Company was founded in 2012. In that capacity, I am familiar with the use of the trademark MORE SMORES. I therefore have personal knowledge of, and maintain records of and/or have access to corporate records relating to the matters which I hereinafter depose.*
- 2. Lap of Luxury Inc. was incorporated under the laws of Canada on February 14, 2012.*
- 3. Lap of Luxury Inc. owns Canadian trademark registration TMA987,654 (the “**Registration**”) for MORE SMORES (the “**Mark**”) covering the following goods and services:*

*Goods: Backpacks; Hiking boots and hiking shoes; Flashlights (the “**Goods**”)*

*Services: Operation of a service for the organisation of camping trips, namely, the booking of camp sites and the provision and delivery of camping supplies, namely, tents, sleeping bags, cooking gear and food (the “**Services**”)*

- 4. Section 45 proceedings have been commenced in respect of the Registration. The section 45 notice is dated September 12, 2020 and, in response thereto, use of the Mark must be shown between September 12, 2017 and September 12, 2020 (the “**Relevant Period**”).*

5. *My Company has sold the Goods and the Services in Canada since February 2012 when my Company was founded.*
6. *The Goods are sold through a variety of retail store establishments in Canada, including MEC, Sail, Sporting Life, and L'Equipeur.*
7. *In the past 5 years, my Company has sold a total of over 6,000 backpacks. And in each of those 5 years, my Company has sold at least 500 pairs of hiking boots and hiking shoes.*
8. *Labels or tags bearing the Mark are usually affixed to the Goods when they are offered for sale in Canada. Attached hereto as **Exhibit A** is a sample label showing the Mark on a backpack. This label is representative of how the Mark has appeared on backpacks sold in Canada during the Relevant Period. [For the sake of the question, assume that the exhibit shows exactly what is stated.]*
9. *For footwear, the Mark will also appear on the box in which the shoes or boots are sold. Attached hereto as **Exhibit B** is a photograph showing the Mark on a shoebox. This box is representative of all boxes that have been received by consumers who purchased my Company's footwear during the Relevant Period, as evidenced by the sample invoices for shoes and boots issued during the Relevant Period attached hereto as **Exhibit C**. [For the sake of the question, assume that the exhibits show exactly what is stated.]*
10. *For flashlights, the Mark is engraved on the product itself. Attached hereto as **Exhibit D** is a photograph showing the Mark on a flashlight. The manner in which the Mark appears on the flashlight shown in this photograph is representative of the manner in which the Mark has appeared on flashlights sold by my Company during the Relevant Period. [For the sake of the question, assume that the exhibit shows exactly what is stated.]*
11. *My Company often provides a flashlight bearing the Mark to persons who purchase a significant amount of my Company's services. During the Relevant Period, my Company gave out at least 5,000 flashlights to those persons, or to retailers that promote the Services to consumers.*
12. *The Services are advertised at those retail establishments, and online, and sold directly to individual consumers or to groups looking to organise a camping trip in Canada.*
13. *Attached hereto as a bundle as **Exhibit E** are copies of flyers that were used in the springs/summers of 2017 and 2018 to advertise the Services. [For the sake of the question, assume that the exhibit shows exactly what is stated.]*
14. *Total annual sales of the Goods in Canada for the past five years have been in excess of \$900,000, and total annual sales of the Services in Canada for the past five years have been in excess of \$25,000.*
15. *The facts and information contained in this affidavit are true and correct to the best of my knowledge.*

[signature and date reference/line, with Commissioner] November 5, 2020

For each of the goods and services associated with the Registration, advise your client as to whether the registration will be maintained or expunged (**1 mark**) and give one valid reason to support your answer (**1 mark**). **[total of 8 marks]**

Answer:

Backpacks: Backpacks will be expunged from the registration. (**1 mark**) Although the Relevant Period fits inside the five-year period identified in the affidavit (November 5, 2015 to November 5, 2020 (when the affidavit was signed)), the affidavit remains ambiguous and could mean that all bags were sold before September 12, 2017 or after September 12, 2020. (**1 mark**)

Hiking shoes and hiking boots: Hiking shoes and hiking boots will be maintained. (**1 mark**) The affidavit is clear that hiking shoes and hiking boots bearing the Mark were sold in boxes bearing the Mark during the Relevant Period. (**1 mark**)

Flashlights: Flashlights will be expunged. (**1 mark**) The free distribution of flashlights to persons who bought the Registrant's services is not considered use in the normal course of trade **OR** the free distribution of flashlights as part of the Registrant's promotional activities is not considered use in the normal course of trade. (**1 mark**)

The operation of a service for the organisation of camping trips: The Services will be maintained. (**1 mark**) The affidavit is clear that the Services were offered during the Relevant Period and the fact that the Mark appears on an advertisement for the Services will count as use of the Mark. (**1 mark**)

Question 2 (12 marks)

You represent the opponent in a trademark opposition proceeding. A few weeks after the filing of the opponent's evidence in chief, your client provides you with important new evidence that was not previously available. This evidence would strongly assist your client's position in the proceeding. The applicant has not yet filed its evidence and your affiant is set to be cross-examined next month. On behalf of your client, you need to prepare a request to the Registrar seeking leave to submit additional evidence.

- a. In deciding whether to grant the opponent's request for leave to submit additional evidence, what test will the Registrar apply? (**1 mark**) Cite the relevant provision(s) of the *Trademarks Regulations*. (**1 mark**)

Answer:

If it is in the interests of justice having regard to the all the surrounding circumstances. (**1 mark**) Subsection 55(2) of the *Trademarks Regulations*. (**1 mark**)

- b. Draft a request seeking leave to submit additional evidence by citing the appropriate criteria that will be considered by the Registrar and applying them to the fact scenario. Clarity and structure will also be marked. **(10 marks)**

Answer:

1. General formulation explaining the purpose of the letter, e.g. "The Opponent hereby requests leave to submit additional evidence...". **(1 mark)**
2. The stage the opposition proceeding has reached. **(1 mark)** The opposition is still in an early stage, the applicant has not yet filed its evidence. **(1 mark)**
3. Why the amendment was not made or the evidence not submitted earlier. **(1 mark)** The evidence was not previously available. **(1 mark)**
4. The importance of the evidence. **(1 mark)** The evidence is relevant to the opponent's case. **(1 mark)**
5. The prejudice which will be suffered by either party. **(1 mark)** The applicant will not be prejudiced as it can still respond to the evidence and cross-examine the affiant on the new evidence. **(1 mark)**
6. Clarity and good structure. **(1 mark)**

Question 3 (32 marks)

You have just received the following e-mail from the managing partner of your firm:

From: Robert Robertson
Sent: November 24, 2020 2:13 PM
To: Trademark Agent
Cc: Administrative assistant
Subject: FWD: Am I in trouble?

Hi Junior!

Congratulations on passing your trademark agent exams, we're all proud of you (I flunked them twice and gave up!). Now you can work on becoming a partner in a law firm, without even being a lawyer!

Listen, I have a file for you, see below. The client is pretty stressed out, so please get back to him ASAP. Copy me on your response.

Thanks,

Bob

Robert Robertson, Q.C.
Lawyer, Managing Partner
Robertson & Robertson LLP
100 Spring Garden Road
Halifax NS B3J 1A1

----- Original Message -----

From: Donald McDonald
Sent: November 24, 2020 2:11 PM
To: Robert Robertson
Cc: Steve Stevens
Subject: Am I in trouble?

Hey Bob!

I need your quick help.

You remember my RÖKKEN RØL beer and soda project I talked to you about last summer when I bumped into you in the Canadian Tire parking lot? Well, things are starting off pretty good: I'm about to receive my first cases of beer (IPA, Pilsner and stout) and soda (cola and root beer) from my suppliers and I already have three local restaurants as clients who are eager to start selling RÖKKEN RØL. I'm about to sign a couple more restaurants here and across the bridge over in Dartmouth, and I'm hoping to have a dozen restaurants and bars selling my new beer and soda in time for the holiday season...well, that is if I'm not getting myself in trouble for doing so.

Steve's brother (Steve is my marketing guy) lives out in Vancouver and, while videoconferencing Steve, he said that there's a restaurant chain out in BC called "Musicland" that sells a house brand wine called "Rock n' Roll" (a house beer called "Heavy Metal", milkshakes called "Doo-wops", anyway, you get the concept).

Steve said this could be a problem. He checked it out and found they even have a trademark registration for ROCK 'N' ROLL (the details are attached). I know there are a lot of "rock n' rolls" out there, even in the beverages business, so I thought I'd be OK with an original spelling. But I'm really worried. I can't afford being sued, but then again, I already have over \$200k invested in this, so I can't really go back either.

Am I in trouble or am I worrying too much for nothing?

Please get back to me ASAP as I have a board meeting tonight and this is on the top of the agenda.

Keep on rökken røllin!

Don

Donald McDonald, CEO

Multi Beverages Inc.
200 South Street
Halifax NS B3J 2B2

The following was attached to the e-mail:



Government
of Canada

Gouvernement
du Canada

ROCK N' ROLL & DESIGN — 1234567



Application number
1234567

Registration number
TMA454545

Type(s)
Design

Category
Trademark

CIPO status
REGISTERED

Filed
1994-03-04

Registered
1996-02-23

Registration Date **Expiry**
2026-02-23

Current owner
MUSICLAND,
LIMITED
ONE GRANVILLE
STREET
VANCOUVER,
BC
V6Z1A1

Index headings

ROCK N' ROLL
ROCK AND ROLL

Vienna information (Code & Description)

24.17.10 Musical symbols
A Treble clefs with notes and stave or with
24.17.13 stave alone

Goods

(1) Wines.

Classification data

Disclaimer

The classification data is provided for information and searching purposes only. CIPO does not warrant the accuracy of the classes assigned to the trademark. This data has no legal value of any kind.

33 - Wines and spirits

Claims

Declaration of Use filed December 06, 1995

a) What's the first thing you must do before actually starting to work on the requested opinion? **(1 mark)**

Answer:

Conduct a conflict check OR advise the client that you must clear conflicts before proceeding with the mandate. **(1 mark)**

b) Write a detailed formal opinion to the client on the issue of confusion between RÖKKEN RØL and the cited mark ROCK N' ROLL & Design. Address all the relevant criteria, marks will also be awarded for grammatical form and coherence. **(18 marks)**

Answer elements:

1. Citing section 6 (or subsection 6(5)) TMA as the basis of the confusion analysis **(1 mark)** and citing section 20 TMA as the legal basis for the infringement analysis **(1 mark)** (no mark for section 19 because the marks are not identical, no mark for section 22 as the question solely relates to infringement)
2. The proposed trademark and the cited trademark have the same degree of inherent distinctiveness OR (because this is somewhat suggestive) the candidate can argue that one is slightly more distinctive than the other. **(1 mark)** The cited mark has design elements and the proposed trademark is an original way of writing an existing phrase **(1 mark)**
3. The cited mark has become more known OR has been used to a greater extent **(1 mark)**
4. The cited mark has been used for a longer period of time **(1 mark)**
5. The nature of the goods are different **(1 mark)** but there is a certain similarity between the goods at issue as they are all (alcoholic) beverages **(1 mark)**.
6. The channels of trade are the same **(1 mark)**
7. The marks differ somewhat in appearance **(1 mark)**
8. The marks are similar in sound **(1 mark)**
9. The marks are similar in the ideas suggested by them (rock and roll music) **(1 mark)** but RÖKKEN RØL evokes Scandinavia/Denmark/Iceland/Vikings/Norwegian death metal/a foreign language/etc. **(1 mark)**
10. As a surrounding circumstance, we can consider that "rock n' roll" (and/or "rock and roll") is a commonly used expression and is likely used as a trademark or as part of a trademark by several merchants **(1 mark)**
11. Concluding that there is a potential or possible risk of confusion OR that the answer is not clear cut OR that we're in a grey area OR any language that shows that the candidate

understands that there is no definite answer, but a risk exists **(1 mark)** (i.e. no mark for an answer that concludes clear existence or absence of confusion)

12. Noting that the likelihood of confusion is greater for beer OR lower with soda **(1 mark)**

13. Proper sentence structure and grammar **(1 mark)**

14. Using a professional style and language (as opposed to familiar/friendly) with proper greetings and salutations **(1 mark)**

c) What additional information would have been relevant to help you in your analysis? List three (only the first three answers will be marked). **(3 marks)**

Answer:

- The amount of sales of wine under ROCK N' ROLL & Design **(1 mark)**
- The amount of promotional/marketing expenses for ROCK N' ROLL & Design wines **(1 mark)**
- The state of the register for ROCK N' ROLL or ROCK AND ROLL **(1 mark)**
- The results of a common law trademark search for ROCK N' ROLL or ROCK AND ROLL/marketplace evidence **(1 mark)**
- Whether ROCK N' ROLL & Design wines are also sold at retail **(1 mark)**
- Whether ROCK N' ROLL & Design wines are also sold in other provinces/outside BC **(1 mark)**
- Whether the trademark ROCK N' ROLL (or ROCK AND ROLL) coexists for the goods in question in a foreign market **(1 mark)**
- Whether the cited mark is used as registered **(1 mark)**
- Any other relevant factor to the issue of confusion in this context that does not appear in the fact scenario **(1 mark)**

d) Notwithstanding your opinion at question b) above, what recommendations could you give the client in order to reduce the risk of confusion? List two (only the first two answers will be marked). **(2 marks)**

Answer:

- Adding a word to the proposed trademark **(1 mark)**

- Incorporating distinctive graphic elements that are different from those of the cited trademark **(1 mark)**
- Limit the use of the proposed trademark to soda OR avoid using the proposed mark with beer **(1 mark)**
- Any other relevant factor to the issue of confusion in this context that reduces the likelihood of a conclusion of confusion and that does not appear in the fact scenario **(1 mark)**

e) Notwithstanding any opinion you may have given the client, the latter has decided to pursue the RÖKKEN RØL project. One month later, the client sends you a copy of a demand letter he just received from Musicland, Limited's lawyers and which alleges trademark infringement and passing-off and threatens to initiate an action before the Federal Court. Can you, as a non-lawyer trademark agent, provide an opinion to the client on the merits of the demand letter and the possible outcome of threatened judicial litigation? Yes or no? **(1 mark)** Why? **(1 mark)**

Answer:

No. **(1 mark)** Only lawyers/members of a provincial bar are entitled to provide legal opinions on litigation. **(1 mark)**

f) On the basis of the facts at your disposal, would Musicland, Limited have good grounds for an action on the basis of passing-off? Yes or no? **(1 mark)** Why? **(2 marks)**

Answer:

No. **(1 mark)** The goodwill associated with the mark is limited to British Columbia **(1 mark)** while the client's RÖKKEN RØL trademark is only to be used in Nova Scotia/in or near Halifax **(1 mark)** OR the goodwill associated with Musicland's ROCK N' ROLL & Design trademark does not geographically extend **(1 mark)** to where the client's mark is to be used **(1 mark)**

g) A few weeks later, you run into the client at a restaurant and he invites you over to his table for a quick RÖKKEN RØL beer (while sitting two meters apart). The client then tells you "a secret": his company had actually sold wine under the trademark RÖKKEN RØL before moving on to beer and soda. The client didn't want to tell Mr. Robertson at the time for fear of making an admission of trademark infringement, but now understands that had he told Mr. Robertson so, that information would have been subject to the solicitor-client privilege. As such, the client is now more open to sharing this information with you. Could you nevertheless be subpoenaed to disclose this information in a trademark infringement action initiated by Musicland, Limited against your client? Yes or no. **(1 mark)** State why **(1 mark)** and provide the authority supporting your answer **(1 mark)**.

Answer:

Yes. **(1 mark)** The information was not provided for the purpose of seeking or giving advice with respect to any matter relating to the protection of a trademark. **(1 mark)** Paragraph 51.13(1)(c) TMA **(1 mark)**

Question 4 (14 marks)

The following questions all relate to section 45 proceedings. For each question, indicate whether the statement is true or false (**1 mark** per question) and provide one reason to explain and/or justify your answer, such as a provision of the Act, the Regulations or a Practice Notice and, if none apply, then a statement in your own words (**1 mark** per question) [**total of 14 marks**]

- a. If a requesting party decides to discontinue the S. 45 proceedings, once initiated, that party can do so without contacting the registrant.

Answer:

False. **(1 mark)** The Practice Notice requires that request for discontinuance be signed by or on behalf of both parties. **(1 mark)**

- b. The loss of a key employee will likely be accepted as a reason justifying the absence of use of a registered mark, such that the registration will be maintained.

Answer:

False. **(1 mark)** Even if the loss of the employee is beyond the control of the registrant, it likely cannot justify non-use of the mark for three years [one point awarded if mention of “beyond the control of the registrant” and/or “justify non-use for three years”]. **(1 mark)**

- c. The use of the registered mark by the registrant’s licensee, during the relevant period, can be used to support the registration.

Answer:

True. **(1 mark)** Section 50 TMA (or subsection 50(1)). **(1 mark)**

- d. The requesting party can probe and test the evidence filed by the registrant by cross-examining its affiant(s).

Answer:

False. **(1 mark)** There is no statutory or regulatory provision (under either the TMA or the TMR) allowing for cross-examination in the context of S. 45 proceedings OR Practice Notice. **(1 mark)**

- e. If the registrant cannot show sales of the goods in Canada during the relevant period, its registration can be maintained if the registrant shows that the mark appeared in association with the goods when they were exported outside Canada.

Answer:

True. (1 mark) 4(3) TMA. (1 mark)

- f. Evidence in S. 45 proceedings must be served by registered mail.

Answer:

False. (1 mark) Section 71 TMR (1 mark)

- g. When a request is filed asking the Registrar to commence section 45 proceedings, the registrant or its recorded trademark agent must be copied on that request.

Answer:

False. (1 mark) Section 69 TMR. (1 mark)

Question 5 (6 marks)

Your client is Jenny Cooke. Jenny has personally operated a pet grooming business under the name “Belles and Whiskers” from her basement in Sarnia, Ontario, since February 2018. At the time the business opened, she was the sole proprietor of the business. In January 2019, following the advice of her accountant, Jenny incorporated the company B&W Inc., which henceforth legally operated the business, but in practice nothing has changed.

In January 2020, Jenny noted a recently filed application for BELLS AND WHISTLES for *pet grooming services* and she plans to oppose it. In support of her opposition, she will want to rely on her past use of the mark and its continued use by B&W Inc.

- a. Can Jenny rely on the use of the mark by B&W Inc.? (1 mark) How/Why can the opposition rely on the use by B&W Inc.? (3 marks) Identify the statutory authority that applies. (1 mark)

Answer:

Yes. (1 mark) There is an implied/tacit licence (or anything suggesting the existence of a licence) (1 mark) from Jenny to B&W Inc. (1 mark) because Jenny controls the character and quality of the services offered by B&W Inc. in association with the mark. (1 mark) Subsection 50(1) of the *Trademarks Act*. (1 mark)

- b. In the context of the previous question, give Jenny one piece of advice to improve her position. (1 mark)

Answer:

Put in place a formal written licence (1 mark) OR indicate on signage/website/promotional materials that the trademark BELLES AND WHISTLES is used under licence from Jenny Cooke (1 mark).

Question 6 (3 marks)

Identify three circumstances where the Registrar may refuse to issue a section 45 notice; only the first three answers will be marked. (3 marks)

Answer:

- The requesting party has failed to pay the prescribed fee;
- The registration issued less than 3 years prior;
- The registration is already the subject of a section 45 proceeding pending before the Registrar or on appeal before the Federal Court of Canada;
- The request is within 3 years of a previous S. 45 notice that lead to a final decision under S. 45 of the Act;
- The registration is a Newfoundland registration predating April 1st, 1949;
- The Registrar considers that the request is frivolous or vexatious.

Question 7 (31 marks)

Your client, Largoi Inc. (“**Largoi**”), is a Tofino, British Columbia based company specialising in the manufacture and sale of luxury, west coast inspired clothing, lifestyle and décor items in association with the trademark and trade name LARGOI, as well as the trademark LARGOI Design, depicted below.




Since opening its first brick and mortar store in Tofino in 1999, Largoi now operates stores in five locations across British Columbia, including three in Vancouver, and enjoys a strong reputation in the province. In 2012, Largoi began selling its products, including candles, candle holders, essential oils for personal use, house slippers, sweaters, raincoats, bathrobes, and pet beds, in Eastern Canada through the Montreal based company LuxeGroove Inc. (“**LuxeGroove**”). However, following bitter business discussions at the expiration of the distribution contract last year (August 2019), Largoi decided not to renew the agreement. Rather, Largoi decided to maintain its growing foothold in the Eastern Canadian market by focusing on its burgeoning online platform at www.largoi.com.

Through its website, which went live in November 2018, Largoi has been successfully selling, across Canada, many of its goods, including candles, candle holders, essential oils for personal use, house slippers, sweaters, raincoats, bathrobes, and pet beds. All of Largoi’s products bear the word mark and trade name LARGOI and/or the LARGOI Design mark. Both the LARGOI word mark and the LARGOI Design mark, as well as the LARGOI trade name, prominently appear on the website, including at the time that consumers place orders for the goods.

Largoi indicates that it has secured a Canadian copyright registration for LARGOI Design. However, it does not currently own any pending trademark applications or registrations in Canada for the LARGOI word or design trademarks.

Just before the close of business on Friday, November 20, 2020, Largoi contacts you to advise that it has just become aware of two recently advertised applications for the trademarks LARGOI LUXE, and LARGOI LUXE Design, the particulars of which have been advertised in Vol 88 No. 1234 of the *Trademarks Journal* dated 2020-09-30, and are set out below:

| | |
|---------------------------------------------------------------------------------------|----------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------|
| Application No 1,888,888 | Filing Date 2019-07-30 |
| Applicant: LuxeGroove Inc. 703 Rue Principale Montreal QUEBEC H3G 2T7 | Goods: Class 03: (1) Essential oils for personal use Class 04: (2) Candles Class 18: (3) Pet accessories Class 21: (4) Candle holders Class 24: (5) Blankets Class 25: (6) House slippers, pajamas, bathrobes, ponchos, sweaters, raincoats |
| Trademark: LARGOI LUXE Trademark Type Word | |

| | |
|-------------------------------------------------------------------------------------------------------------------------------------|-------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------|
| Application No 1,888,889 | Filing Date 2019-07-30 |
| Applicant: LuxeGroove Inc. 703 Rue Principale Montreal QUEBEC H3G 2T7 | Goods: Class 03: (1) Essential oils for personal use Class 04: (2) Candles Class 18: (3) Pet accessories Class 21: (4) Candle holders Class 24: (5) Blankets Class 25: (6) House slippers, pajamas, bathrobes, ponchos, sweaters, raincoats |
| Trademark:  Trademark Type Design | |

Your client is very concerned about these applications filed by its former distributor. Your client advises you that among the terms of its distribution agreement with LuxeGroove was an acknowledgement of ownership of the trademarks LARGOI and LARGOI DESIGN by Largoi Inc., and an undertaking by LuxeGroove never to use or apply for any trademarks comprised of or including the element LARGOI in Canada. Your client instructs you to take immediate steps to stop LuxeGroove from securing registration of these trademarks.

You immediately begin preparing statements of opposition.

a) The grounds of opposition to be applied are those set out under the *Trademarks Act*, RSC 1985 c. T-13, as amended on June 17, 2019. Is this because the filing dates of the applications fall after June 17, 2019, because the dates of advertisement for the applications fall after June 17, 2019, or because the statements of opposition will be filed after June 17, 2019? Cite the relevant section of the *Trademarks Act* supporting your answer (**2 marks**).

Answer:

- Because the dates of advertisement fall after June 17, 2019 (**1 mark**)
- Section 70 of the TMA (**1 mark**)

b) Based on the information available, identify the four strongest grounds of opposition against application No. 1,888,888 for the word trademark LARGOI LUXE by citing the relevant provisions of the *Trademarks Act*. Specifically, identify those four grounds that you consider to have the greatest chance of succeeding at opposition and resulting in the refusal of the application in its entirety. For each ground alleged, state the fact(s) justifying your selection. Only the first four grounds will be marked. General clarity of the answer will also be marked. **(18 marks)**

Answer:

- 38(2)(c) **(1 mark)** and 16(1)(a) **(1 mark)** The applicant is not the person entitled to registration of the mark because it is confusing with the opponent's trademarks LARGOI **(1 mark)**, which it had previously used in Canada **(1 mark)** in association with the goods "candles, candle holders, essential oils for personal use, house slippers, sweaters, raincoats, bathrobes, and pet beds" (goods must be listed completely at least once) **(1 mark)**.
- 38(2)(c) **(1 mark)** and 16(1)(c) **(1 mark)** The applicant is not the person entitled to registration of the mark because it is confusing with the opponent's trade name LARGOI **(1 mark)** which it had previously used in Canada **(1 mark)** in association with the sale of lifestyle items and décor (would also accept some wording along the lines of the sale of the listed goods) **(1 mark)**
- 38(2)(d) **(1 mark)** and 2 **(1 mark)** The trademark is not distinctive because it is confusing with the opponent's previously used trademarks LARGOI **(1 mark)** in association with the goods "candles, candle holders, essential oils for personal use, house slippers, sweaters, raincoats, bathrobes, and pet beds" **(1 mark)**.
- 38(2)(f) OR 38(2)(a.1) **(1 mark)** The applicant is not entitled to use the mark OR is acting in bad faith because to do so would be unlawful **(1 mark)** as it violates the terms of the distribution agreement between LuxeGroove and Largoi **(1 mark)**.

Plus 1 mark for clarity in setting out the grounds of opposition.

c) The grounds of opposition set out in the pleadings in respect of the opposition to the LARGOI LUXE DESIGN application will be substantively identical to the grounds set out in the opposition to the LARGOI LUXE word mark. However, there is one additional ground of opposition that may be pleaded in the opposition to the LARGOI LUXE DESIGN application. Identify this additional ground of opposition. In doing so, cite the relevant provision of the *Trademarks Act* **(1 mark)** and state the facts justifying your selection **(2 marks)**.

Answer:

38(2)(f) (1 mark) Applicant not entitled to use the application because such use would violate Largoi's copyright in the LARGOI Design (1 mark), contrary to the *Copyright Act*. (1 mark)

In the alternative, would also accept:

38(2)(a.1) (1 mark) Application filed in bad faith (1 mark) and providing reason, which includes reference to contravening the *Copyright Act* (1 mark)

d) You complete and finalise the statements of opposition and leave them with your administrative support staff for filing with the Trademarks Office with instructions that the documents are time sensitive so must be timely filed. What is the initial deadline to file the statements of opposition? In your answer, provide the specific date (1 mark) and cite the relevant statutory provision (1 mark).

Answer:

November 30, 2020 (two months from the date of advertisement). (1 mark)

Subsection 38(1) of the TMA. (1 mark)

e) A week after the filing deadline has passed, it comes to your attention that the statements of opposition were not timely filed and that they still need to be submitted. There were a number of factors that led up to this: in the days leading up to the filing deadline, your firm was in the process of transitioning over to a new docketing system and these cases were inadvertently missed. While your administrative support staff keeps a secondary docketing system, the paralegal responsible for these files became unexpectedly ill and was out of the office on the deadline.

You immediately prepare requests for retroactive extensions of time to file the statements of opposition. What should be included in and accompany your request for each case? Where possible, provide specific information in your answer. (4 marks)

Answer:

- Indicate that the failure to meet the deadline was "not reasonably avoidable" (1 mark)
- Provide the reason (summary of the factors set out in the fact pattern or reference to an administrative error is sufficient) (1 mark)
- Need to include the prescribed fee/\$125 fee (1 mark)
- Need to submit the statement of opposition (1 mark)

f) Are you required to copy the applicant on your request for a retroactive extension of time? Yes or no? (1 mark). Cite the relevant regulatory provision (1 mark).

Answer:

- No (1 mark)
- Section 44 of the TM Regulations (1 mark)

Question 8 (5 marks)

In the context of a section 45 proceeding, the registration at issue is for the trademark CHUMHUM. The evidence filed in support of the registration shows use of the mark CHUM HUM, CHUM-HUM and CHUM/HUM. What test would apply to this situation? (1 mark) What are the three criteria for this test? (3 marks) Cite one landmark case in which that test is set out. (1 mark)

Answer:

The Deviation Test OR the Dominant Impression Test (1 mark). The test is whether the mark as used is sufficiently close (1 mark) to the mark as registered such that, when comparing the two, the differences are sufficiently unimportant (1 mark) that an unaware purchaser/ordinary consumer would be likely to infer that both trademarks identify goods or services having the same origin (1 mark). *Registrar of Trade Marks v. Cie Internationale pour l'Informatique CII Honeywell Bull* (OR the *CII Honeywell Bull* case) OR *Promafil Canada Ltee v. Munsingwear Inc.* OR the *Promafil/ Munsingwear/Corpulent vs skinny penguin* case OR *Nightingale Interlooc Ltd. v. Prodesign Ltd.* (OR the *Nightingale* case) (1 mark)

Question 9 (27 marks)

a) You represent the Applicant in a trademark opposition proceeding. You have been served with the affidavit below from the agent for the Opponent. This affidavit forms the entirety of the opponent's Rule 50(1) evidence. The Affidavit has two exhibits but only one (Exhibit A) is reproduced in its entirety in the context of this question; assume that Exhibit B was properly included.

An issue in this opposition proceeding is confusion between the Applicant's trademark CLOUD CLOTHING in respect of athletic clothing and the Opponent's trademark CLOUD COATS in respect of winter coats.

Identify ten clear deficiencies in the affidavit below and point out where in the affidavit they are found (1 mark per deficiency identified) and provide a brief explanation why the deficiency is problematic (1 mark per explanation). The deficiencies to be identified can be substantive to

the issues at hand or technical in nature. Only the first ten answers will be marked. (total **20 marks**)

IN THE CANADIAN INTELLECTUAL PROPERTY OFFICE

*IN THE MATTER OF an Opposition by 1234 Canada Inc. (the “**Opponent**”) to Application No. 1,888,881 for the trademark “CLOUD CLOTHING” filed by ABCD Ontario Inc. (the “**Applicant**”) and advertised in the February 5, 2020 issue of the Trademarks Journal.*

AFFIDAVIT OF ROBERTA JONES

I, ROBERTA JONES, of the City of Winnipeg, Province of Manitoba, Canada, MAKE OATH AND SAY:

- 1. I am the Director of Marketing and an officer of 1234 Canada Inc. (“**my company**”), a position which I have held since 2003. I am authorised by my company to make this affidavit in support of this opposition.*
- 2. 1234 Canada Inc. developed and owns patented technology for synthetic insulation used in winter coats. 1234 Canada Inc.’s Canadian patent CA 2,000,000 for this technology expires in 2029 (“**Patented Technology**”). 1234 Canada Inc. licenses this Patented Technology to various outerwear manufactures inside and outside of Canada. This popular Patented Technology is used in 17 different coat brands sold by 28 different retailers across Canada.*
- 3. In addition to the licence for this Patented Technology, 1234 Canada Inc. has a licence with one outerwear retailer in Canada, namely, THE HARBOUR, for use of the trademark CLOUD COATS in association with winter coats for arctic expeditions using Patented Technology. 1234 Canada Inc. has a registered the trademark CLOUD COATS as word mark in the United States of America.*
- 4. THE HARBOUR, with its head office in Toronto, has 88 retail locations in 8 provinces in Canada including British Columbia, Ontario and Prince Edward Island according to the Canadian president of the THE HARBOUR, Susan Hébert. THE HARBOUR sells branded CLOUD COATS in most of those locations pursuant to a licence agreement with my company since at least as early as 2010. The suggested retail price of the coat is \$650 plus applicable taxes. This price is generally adopted by THE HARBOUR retail stores across Canada.*
- 5. Now shown to me and attached as **Exhibit “A”** is the hangtag that THE HARBOUR generally uses for the coats that it sells under the CLOUD COATS trademark at most of its locations across Canada. On the back of the hang tag is the bar code, price, care instructions, components of the coat in accordance with the Textile Labelling Act, and where this particular coat was manufactured. This is the only marking of CLOUD COATS on any coats using the Patented Technology.*

6. In certain locations of THE HARBOUR in British Columbia where the coats with the Patented Technology are in high demand, rather than use branded hangtags, there is a sign with the trademark in a prominent position in the storefront window. Below is a representative depiction of the sign.



7. Now shown to me and attached as **Exhibit "B"** to this affidavit is a bundle of typical invoices that were issued by an outer wear manufacturer to head office of THE HARBOUR for the sale of coats in Canada. In this exhibit the manufacturer is in Fall River Idaho, USA.

The representative text that includes reference to items sold is replicated exactly below.

| Item No. | SKU# | Description of item | No. | Cost per Unit | Total |
|----------|---------|---------------------|-----|---------------|-----------|
| 1. | #23kde3 | Coats – CC | 56 | 157.00 | \$8792.00 |

8. I have been advised by our accounting department, information that I have access to by virtue of my position at my company, the revenues generated by my company for the licence to use the trademark CLOUD COATS by THE HARBOUR associated with the trademark in Canada in each of the years since 2010 have been approximately \$500,000.
9. In reviewing all of the licence agreements of my company since 2010 in respect of the trademark CLOUD COATS with THE HARBOUR and data provided by THE HARBOUR in accordance with the licence, which is limited to the number of coats sold, there were approximately 3,500,000 coats sold across Canada since 2010.

SWORN BEFORE ME at the City of)
Winnipeg, in the Province of Manitoba)
this 17th day of July, 2020)

)
)
)
)
)
(s) Roberta Jones
FRANK SMITH

(s) William Alvin Tremblay)
A Commissioner for taking Affidavits, etc.
WILLIAM ALVIN TREMBLAY
A commissioner for Oaths
in and for Manitoba
My commission expires June
12, 2020
Appointee No. 2349392

This is Exhibit "A"
to the Affidavit of Roberta Jones sworn before me on July 17, 2020

Commissioner for Taking Affidavits / Notary Public
(or as may be)



Answers

1. Paragraph 2 – The patented technology is “popular”. (1 mark) This is an opinion statement that is not admissible by a fact witness. (1 mark)
2. Paragraph 3 and/or 4 – There is no evidence/explanation of control over the character and quality of the goods. (1 mark) Control is required so that use of a trademark by a licensee can be deemed to be use of the trademark by the owner pursuant to section 50 TMA (1 mark) OR The allegation that there is a licence (1 mark) is a question of law. (1 mark)
3. Paragraph 4 – All information provided by Susan Hébert is hearsay. (1 mark) Hearsay is (generally) not admissible. (1 mark)
4. Paragraph 5 and/or Exhibit A – Does not indicate that the hangtag references the existence of a licence OR Exhibit A does not list the trademark owner on the hangtag. (1 mark) There is no deemed control pursuant to subsection 50(2) of the *Trademarks Act*. (1 mark)
5. Paragraph 6 – The use of the trademark on a sign (1 mark) is arguably not use of the trademark in association with the goods. (1 mark)
6. Paragraph 7 – The affidavit does not provide a basis for Roberta Jones’ knowledge of the truth of the contents of the invoice. (1 mark) The evidence must be in the personal knowledge of the affiant or qualify for an exception to the hearsay rule. (1 mark)
7. Paragraph 7 – Does not indicate that the coats are those to be sold under the CLOUD COATS trademark. (1 mark) This raises a doubt on the total sales alleged. (1 mark)
8. The signature line has the wrong name of the affiant - it should be Roberta Jones rather than Frank Smith. (1 mark) Raises doubt as to whether the affidavit was carefully reviewed by the affiant. (1 mark)
9. Paragraph 7/the invoice in Exhibit 2 – Does not indicate the date that the coats were allegedly sold marked with CLOUD COATS or intended to be marked with CLOUD COATS. (1 mark) Date of first use/length of time the mark was used is doubtful. (1 mark)
10. Paragraph 9 – The number of coats sold under licence is doubtful. (1 mark) The evidence is unclear whether all coats are sold under the trademark (par. 5, hangtag “generally” used; par. 6, no hangtag, sign in window) OR the low amount of revenue compared to the amount of coats allegedly sold (about \$0,15 per coat) OR it is unlikely that 10% of all Canadians would own a \$650 winter coat for arctic expeditions. (1 mark)
11. Exhibit A – The exhibit page was not signed. (1 mark) The signature on the exhibit page is important to establish that the purported exhibit was part of the sworn evidence OR the exhibit will not form part of the evidence. (1 mark)

12. Signature block – The Commission of the Commissioner has expired. (1 mark) The affidavit is not duly commissioned and will likely be inadmissible as a whole. (1 mark)

b) If the opponent would like to include hearsay evidence in its affidavit, list the two characteristics of evidence that provide an exception to the rule against the admissibility of hearsay evidence. (2 marks)

Answer:

Necessity (1 mark) Reliability (1 mark)

c) True or False. If the opponent would like to include a copy of a trademark registration as part of its evidence in these opposition proceedings it must do so by adding it to an affidavit or statutory declaration. Cite the relevant provision of the *Trademarks Regulations*. (2 marks)

Answer:

False (1 mark) Section 49 of the *Trademarks Regulations* (1 mark)

d) What is your client's burden of proof in these opposition proceedings? Legal or evidential. (1 mark)

Answer:

Legal (1 mark)

e) True or False. The opponent must file evidence in this trademark opposition proceeding for the opposition to proceed to the next step. (1 mark) Cite the relevant provision of the *Trademarks Regulations*. (1 mark)

Answer:

False (may file a statement that the applicant does not wish to submit evidence) (1 mark)
Section 50(3) of the *Trademark Regulations* (1 mark)

Question 10 (6 marks)

You represent the owner of a registered trademark that has assigned a trademark to a new owner. As part of the assignment agreement it is your responsibility to advise CIPO of the change in ownership.

a. Identify the information you must provide CIPO to record the transfer and provide the authorities for your answer, if any. (5 marks)

Answer:

- The prescribed fee OR \$100 (1 mark) Section 64 of the Trademark Regulations or Item 12 of the Schedule of the Trademark Regulations (1 mark)
- The transferee's name (1 mark) and postal address. (1 mark) Section 65 of the Trademark Regulations or Practice Notice. (1 mark)

- b. What additional item must you provide to CIPO, if any, if you represent a transferee that is seeking to record the transfer? (1 mark)

Answer:

Evidence satisfactory to the Registrar of Trademarks of the transfer OR an assignment document. (1 mark)

Question 11 (6 marks)

As a new trademark agent, you just leased your first office at an amazing coworking space called THEYWORK. On your first day at your new office you learned that a trademark agent two doors down from you has been suspended as a result of disciplinary hearings.

- a. What step do you need to take, if any. (1 mark) Provide the authority for your answer. (1 mark).

Answer:

You should seek the express approval of the Institute through Council to occupy the office space with the suspended trademark agent. (1 mark) IPIC Code of Ethics (1 mark)

- b. The suspended agent has asked you to help file responses to office actions for its client that the suspended agent will prepare for you. Should you file these responses? (1 mark) Provide the authority for your answer. (1 mark).

Answer:

No. (1 mark) IPIC Code of Ethics. (1 mark)

- c. Does it make a difference if the suspended agent is not billing his client for the work? (1 mark) Provide the authority for your answer. (1 mark)

Answer:

No. (1 mark) IPIC Code of Ethics. (1 mark)

