

TRADEMARK AGENT EXAM 2021
PART A
TOTAL MARKS: 150

Question 1 (3 marks)

You filed an application on behalf of ABC Inc. In the Examiner's Report, the Examiner raised an objection based on confusion pursuant to Section 12(1)(d) of the *Trademarks Act*, citing Registration No. TMA999,999 owned by PJQ Inc. You noticed that your colleague in another office is listed as the agent for Registration No. TMA999,999. You just joined your firm a month ago and have never talked to this colleague. You have also never reviewed your firm's file for Registration No. TMA999,999. Yes or No. Assume that ABC Inc. and PJQ Inc. are independent parties, can you assist your client with submitting arguments that the two marks are not confusing? **(1 mark)** Explain your answer **(1 mark)** and cite the relevant authority. **(1mark)**

Question 2 (6 marks)

On behalf of your client, Holy Cow Inc., you have filed a Canadian basic application for the mark HOLY COW in association with ice cream on November 10, 2021. Holy Cow Inc. is now considering international expansion.

(a) Assume that "dessert" is an acceptable term in the European Union. Can Holy Cow Inc. file an application for international registration designating the European Union covering "dessert"? **(1 Mark)** Cite the relevant provision of the *Trademarks Act or Regulations* in support of your answer. **(1 mark)**

(b) You are working from home and your home internet was down. Can you file an application for international registration in paper form through registered mail? **(1 mark)** Cite the relevant provision of the *Trademarks Act or Regulations* in support of your answer. **(1 mark)**

(c) Holy Cow Inc. is interested in filing an application in Taiwan directly (not through the Madrid Protocol). Assuming that today is January 3, 2022, can Holy Cow Inc. file an application in Taiwan claiming priority based on the Canadian application? **(1 mark)** Explain your answer in one sentence **(1 mark)**

Question 3 (3 marks)

Your client, Tambourine Inc., has a prior registration for BREAK NICE covering "*toys, namely action figures, clothing, shoes, guitars*" that was issued on July 31, 2006. The registration was renewed on July 31, 2021. The Registrar has issued a notice under section 44.1 of the *Trademarks Act*.

a) Yes or No. Does Tambourine Inc. have to remit a prescribed fee for requesting an extension of time to respond to the section 44.1? **(1 mark)**

b) True or False. Tambourine Inc. can appeal a decision of the Registrar as to the relevant classes in this registration that it disputes to the Federal Court of Canada. **(1 mark)** Cite the relevant provision of the *Trademarks Act*. **(1 mark)**

Question 4 (3 marks)

True or False. An application for a certification mark may be converted to an application for a regular trademark by deleting the statement referred to in paragraph 31(h) of the *Trademarks Regulations* prior to the application being advertised. (1 mark) Cite the relevant provision of the *Trademarks Regulations* (1 mark) and the relevant authority (1 mark).

Question 5 (3 marks)

True or False. The name of the applicant is required in order for a trademark application to receive a filing date. (1 mark) Cite the relevant provisions of the *Trademarks Act* (1 mark) and *Trademarks Regulations*. (1 mark)

Question 6 (2 marks)

Your client is Powerful Superheroes Inc. and you communicate with its in-house counsel, Mr. Starky, regarding its Canadian and foreign trademark portfolio. You read a news article yesterday about a rumoured takeover of Powerful Superheroes Inc. by The Black Order Corp. Today, you have received an email from Mr. Glaive, an attorney for The Black Order Corp., advising that The Black Order Corp. has acquired Powerful Superheroes Inc. and will be managing its trademark portfolio. Mr. Glaive has asked you to provide him with a list of Powerful Superheroes Inc.'s trademarks and a copy of all your communications with Mr. Starky. No one from Powerful Superheroes Inc. is copied on this email. Briefly explain how you should respond to Mr. Glaive's request (1 mark) and why (1 mark).

Question 7 (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)

<p>A. <i>Canadian Council of Professional Engineers v. APA-The Engineered Wood Assn.</i> (2000), 7 C.P.R. (4th) 239 (F.C.T.D.)</p> <p>Trademark: APA - THE ENGINEERED WOOD ASSOCIATION and THE ENGINEERED WOOD ASSOCIATION</p>	<p>1. 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>B. <i>Gerhard Horn Investments Ltd. v. Registrar of Trade Marks</i> (1983), 73 C.P.R. (2d) 23</p> <p>Trademark: MARCO PECCI</p>	<p>2. The onus on a person contending that a trademark which is descriptive or laudatory of its goods has come to actually distinguish those goods is a heavy one and that onus is increased by the</p>

	adoption of a word which lacks inherent distinctiveness.
<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. Marks are inherently distinctive when nothing about them refers the consumer to a multitude of sources.
<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. Previously accepted moral standards are undergoing change and the difficulty is to determine what are the acceptable standards today and what would still be considered immoral, scandalous, or obscene by a good portion of people.
<p>E. <i>Advance Magazine Publishers Inc. v. Masco Building Products Corp.</i> (1999), 86 C.P.R. (3d) 207</p> <p>Trademark: VOGUE</p>	5. Examiners must determine whether there is a likelihood of confusion with either English or French speaking consumers as well as whether the average bilingual consumer would likely be confused. If there is a likelihood of confusion amongst any of these linguistic groups there is a likelihood of confusion.
<p>F. <i>Molson Breweries v. Labatt Brewing</i> (1996), 69 C.P.R. (3d) 274 at 283 (T.M.O.B)</p> <p>Trademark: KOKANEE & Design</p>	6. All relevant evidence which tends to establish non-distinctiveness may be considered. A party may rely on television broadcasts, website articles, and so on to establish that a party'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. If a mark consists of a name or surname of a living individual or an individual that has died in the last thirty years, the mark cannot be registered. It is not enough that the trademark may be thought of by the public to be a name or surname. That thought only becomes material when it is established by evidence that there is a living person of the name or surname in question.
<p>H. <i>Choice Hotels International Inc. v. Hotels Confortel Inc.</i> (1996), 67 C.P.R. (3rd) 340 (FC)</p> <p>Trademarks: CONFORTEL</p>	8. Examiners will only consider the resemblance between a trademark and a prohibited mark. The goods and/or services associated with the trademark and the channels of trade are not relevant when assessing the registrability of a mark in view of the existence of a similar official mark.

	9. The use of a well-known mark by a party in association with goods and/or services unrelated to those associated with the well-known mark could result in a likelihood of confusion in the mind of the average consumer. It is the duty of the applicant to select a name with care so as to avoid any confusion and the appearance that it intended to jump on the bandwagon of an already famous mark.
	10. An article advertised for sale as containing certain components which, in truth, it does not have, is considered as deceptively misleading to the purchasing public.
	11. An applicant must furnish a meaningful “defined standard” in respect of an application to register a certification mark. Easy access to the defined standard which a certification mark symbolizes is in the public interest. Reference to the titles of published documents where the defined standard may be found can suffice.

Question 8 (2 marks)

True or False. A notification of third-party rights must provide the Registrar with written arguments or evidence of prior use. (1 mark) Cite the relevant authority (1 mark)

Question 9 (22 marks)

For each of the following trademarks, please indicate whether the trademark is REGISTRABLE or NOT REGISTRABLE and provide the most significant reason in support of your answer (1 mark each). Please cite the most relevant provision of section 12 of the *Trademarks Act*. (1 mark each) **Please ignore any confusion issues and do not assume acquired distinctiveness.**

- a) PERIL LIMB PICKS in association with “fire protective clothing”
- b) JOHNSON, TREMBLAY in association with “cosmetics”
- c) COLD CHAMPAGNE in association with “Ontario wine”
- d) PERFECT PAIR for use in association with “fruit juice”
- e) GOVERNOR GENERAL PRIZE for use in association with “books”
- f) JENNIFER LOPEZ STYLE for use in association with “rental of clothing”
- g) A ROW OF RED CROSSES for use in association “blood collection services”
- h) RONALD REAGAN for use in association with “jelly beans”
- i) BEST OF ESPAÑA for use in association “wines”
- j) UNITED STATES GOVERNMENT for use in association with “restaurant services”
- k) SUPERIOR SCHNAPPS for use in association with “peach juice”

Question 10 (3 marks)

Your client, LOVE YOURSELF INC., is using the mark CMHP & Design covering the following goods and services:

Class 25: t-shirts, shirts, hats and caps

Class 41: educational services in the field of mental health

CMHP stands for “Certified Mental Health Professionals”. LOVE YOURSELF INC. is planning to sell the above goods and services directly to its students.

Yes or No. Assuming that the circumstances will remain the same from now until the mark is registered, would Love Yourself Inc. be able to register a certification mark for CMHP & Design? **(1 mark)** Please explain your answer **(1 mark)** and cite the relevant provision of the *Trademarks Act*. **(1 mark)**

Question 11 (1 mark)

Your client, a Korean administrative authority, has asked you about protecting the mark “Korean Purple Ginseng” in Canada for the goods “Ginseng”. The client indicated that the mark Korean Purple Ginseng shows that the Ginseng have certain qualities, characteristics or a reputation that are attributable to Korea, the place in which it is produced. The client indicated that the mark has not been used in Canada and they are not interested in seeking certification mark protection. What is the most likely type of protection to be successful for this mark under the *Trademarks Act*? **(1 marks)**

Question 12 (1 mark)

True or False. The Registrar will grant an extension of time if the applicant can demonstrate that it was not yet possible to file a proper response to an examiner's report due to the exceptional circumstance that the applicant has filed with WIPO a request for the limitation or the cancellation of some of the goods or services, in respect of Canada, of the international registration on which the Protocol application is based that would overcome an objection once CIPO is notified. **(1 mark)**

Question 13 (5 marks)

You filed a Canadian trademark application on behalf of your client, Best BFF, Inc. for the mark BEST BFF for use in association with “social networking services”. Your client has asked you about foreign applications. After discussing the potential risks and benefits of the Madrid Protocol, your client decided that they would like to file a trademark application directly in the U.S. Your client is cost conscious and asked if you can avoid using a U.S. agent.

- a) Can you file the U.S. application and list yourself as the agent for Best BFF, Inc.? **(1 mark)** Please explain your answer **(1 mark)**

- b) Best BFF, Inc. has developed a proprietary software program to match its users at an incredible success rate. This program has not yet been published or disclosed publicly. Other than those set out in the *Trademarks Act*, what three types of intellectual property protection would most likely be available to protect the software? **(3 marks)**

Question 14 (1 mark)

Your direct European client owns an International Registration in WIPO designating Canada. Your European client has not informed you of this and you are not aware of the IP application although you represent the client's trademark portfolio in Canada. CIPO has issued an Examiner's first report on the IR filing. Who will receive the report?

Question 15 (2 marks)

True or False. An application may be filed for the registration of a hologram showing different images in colour. **(1 mark)** Cite the relevant provisions of the Trademarks Regulations. **(1 mark)**

Question 16 (2 marks)

You have assisted your client, Take It Easy, Inc. with filing Application No. 3,000,000 for the mark EASYPEASY. Take It Easy, Inc. has a number of subsidiaries, including Take It Easy Ontario Inc., Take It Easy Quebec Inc., and Take It Easy USA Corp. You know that general counsel for Take It Easy, Inc. manages all intellectual property matters for its subsidiaries.

You have recently received an Examiner's Report, citing Registration No. TMA123,789 for EASYPEASIE owned by Take It Easy USA Corp. Your firm is agent of record for Registration No. TMA123,789.

Yes or No. Does this Examiner's Report raise a conflict of interest given that your firm is agent of record for both Application No. 3,000,000 and Registration No. TMA123,789? **(1 mark)**
Explain your answer in one sentence. **(1 mark)**

Question 17 (4 marks)

J&L Inc. is a company focusing on selling headphones. On June 2020, an employee of J&L Inc. created a logo and by way of an employment agreement, the employee has assigned all intellectual property rights of this logo to J&L Inc.

J&L Inc. publicly displayed the logo at a conference in July 2020. Unfortunately, J&L Inc. did not instruct you to file a Canadian application for this logo and the logo has not yet been in use in association with J&L Inc.'s headphones in Canada.

J&L Inc. has now found a competitor, Q&P Ltd. using a design mark that is identical to J&L Inc.'s logo in association with headphones. Investigations into the use of the design mark by Q&P Ltd. indicate that Q&P Ltd. commenced use of the mark in or around March 2021.

(a) Yes or No. Does your client own any intellectual property rights that it could enforce against this competitor? **(1 mark)** Explain your answer in one sentence. **(1 mark)**

(b) J&L Inc. would like to allow its distributor, Headset Perfect Corp., to help with advertising J&L Inc.'s products by allowing customers to download the headphone's specification sheets on Headset Perfect Corp.'s website. The specification sheets are created by J&L Inc. and display J&L Inc.'s trademarks. Is a license from J&L Inc. to Headset Perfect Corp required? **(1 mark)** Explain your answer in one sentence. **(1 mark)**

Question 18 (3 marks)

Your client, Q Square, is an entertainment company that provides subscription services for TV shows and movies. You have filed a number of standard character marks and design marks for Q Square. While reviewing Q Square's services on its website, you notice that at the beginning of each movie or TV show, Q Square plays a particular jingle accompanied by a distinctive animation on a particular red-black background.

Other than standard character marks and design marks that you have applied to register as trademarks, what are three other most relevant types of trademarks that you can apply to register on behalf of Q Square? **(3 marks – NOTE: only the first three answers given will be marked)**

Question 19 (2 marks)

You received a Statement of Grant of Protection dated February 22, 2022 from CIPO in respect of a Protocol application in Canada. The corresponding International Registration was registered on July 23, 2021.

(a) When is the next renewal deadline? **(1 mark)**


(b) True or false. A request to renew the Canadian Protocol registration should be filed with the Canadian Intellectual Property Office. **(1 mark)**

Question 20 (29 marks)

Your client, London Airlines, Inc., is interested in applying to register the trademark LONDON AIRSUITE for use in association with goods and services identified as "software related to baggage handling and passenger luggage" and "a lounge/bar suite for executive members and airline staff". The mark has not yet been used in Canada but has been used in the United Kingdom, specifically London Heathrow Airport. Prior to filing an application to register the LONDON AIRSUITE mark, your client has asked you to conduct a full availability search and to provide your opinion on the prospects of use and registration of the proposed trademark LONDON AIRSUITE in Canada.

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

- a) Yes or No. For each of the trademarks identified in the Register search set out below, identify whether the trademark is likely to pose an obstacle to the registration of the trademark LONDON AIRSUITE for the goods and services of interest to your client. **(1 mark each)** [NOTE: A “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.]. Please also provide an explanation from the point of view of the Registrar to support your answer in (a) above (point form is acceptable). **(1 mark each)**. [NOTE: No marks will be given for a “yes” or “no” answer unless a valid supporting explanation is given] **(Total 20 marks)**

No.	Trademark	App./Reg. No. (Status)	Owner	Goods/Services
1.	LONDON AIR	1935028 (Filed)	Trade Clothing Brand Ltd.	Software for retail sale of clothing, bags and luggage
2.	LONDON FOG	2084969 (Filed)	Icon DE Holdings LLC	Luggage scales; combination locks; adapter plugs; power adapters; travel adapters for outlets and power chargers; power banks; retractable cables; luggage; underseat bags; duffle bags; backpacks; tote bags; luggage inserts, namely, packing cubes; shoe bags for travel; luggage tags; straps for luggage; belts for luggage; pouches of textile; drawstring pouches
3.	LONDON HEALTH SCIENCES CENTRE	927021 (Advertised)	London Health Sciences Centre	Official Mark
4.	londonair.ca	924536 (Advertised)	The Corporation of the City of London	Official Mark
5.	 THE PARK HOTEL LONDON AN ALL SUITE HOTEL	1962071 (Filed)	Pall Mall Hotel GP Ltd., in its capacity as general partner of Pall Mall Hotel LP	(1) Administrative hotel management; business management of hotels (2) Hotel services; restaurant, catering, bar, bistro and lounge services; provision of general purpose facilities for meetings, conferences and exhibitions; provision of banquet and social function facilities for special occasions; reservation services for hotel accommodations

No.	Trademark	App./Reg. No. (Status)	Owner	Goods/Services
6.	THE LONDON BULL	TMA917470 (Registered)	Browns Social House Ltd.	Restaurant and bar services; franchising services, namely, offering technical assistance in the establishment and operation of restaurants and bars.
7.	AirSuite	1760036 (Abandoned)	Airsuite Inc.	<p>(1) Computer software for use in managing and controlling flight schedules, pilot duty times, regulatory compliance, inventories and accounts and weight and balance of aircrafts.</p> <p>(2) Computer software for use in operations management of aircrafts.</p> <p>(3) Computer software for use in managing and controlling air services, air safety, flight data, flight management, and operations management for flights and aircrafts.</p> <p>(4) Computer software for use in managing and controlling air services, air safety, flight data, flight management, and operations management for aircrafts and flights for use with mobile devices and cloud-based computing.</p>
8.	SUITEAIR	1934758 (Filed)	Transoft Solutions Inc.	Software application for two or three-dimensional simulation and modeling for use in design, planning, development and analysis of air traffic control, use of airspace, runway control and sequencing, airside ground traffic movements, airport operations and capacity, and airport passenger behaviour & terminal processes
9.	AIRPORT	TMA582225 (Registered)	Apple Inc.	Computer hardware and computer peripherals having chips that support wireless technology to provide communication between multiple computers and between computers and local and global computer networks, computer software to enable wireless communications using the hardware and peripherals, and instruction manuals sold as a unit therewith but not including any such goods by or relating to airports.

No.	Trademark	App./Reg. No. (Status)	Owner	Goods/Services
10.	SmartSuite	1983096 (Filed)	Brock Solutions Inc.	Integration of computer systems for engineering programs in the fields of robotics, control systems, process automation systems, computer systems and electrical systems; Installation of computer software, for automation and systems integration, services in the fields of robotics, control systems, computer systems, process automation systems and electrical systems.

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

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

Trade name: AirSuite Inc.

Address: 4328 Main Street Vancouver, BC V5V 3P9

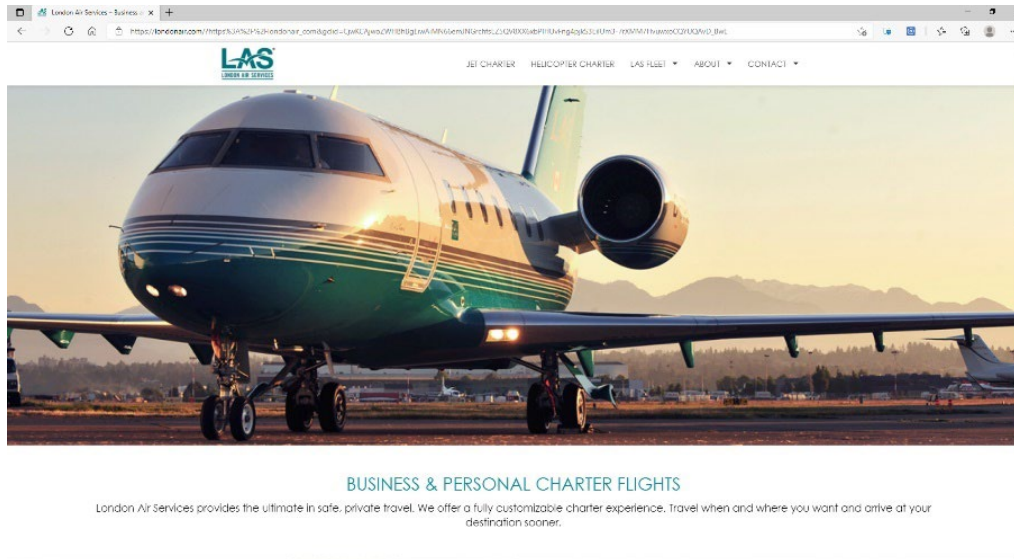
Line of business: Flight management software

Incorporated: July 1, 2015

Note: Preliminary searching reveals that AirSuite Inc. was purchased by Aerospace Canada but continues to operate as AirSuite.

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

c) The third part of the search report contains Internet search for the terms LONDON, AIR and SUITE. Many of the websites located are "parked" websites and no information is available. However, the websites for www.londonair.com is available to view. The home page of this website indicates the following information:



By clicking on the website www.londonair.com, you found that they provide lounge access to its customers. In the “Contact Us” page, you found a 1-800 number. Yes or No. Does www.londonair.com have an impact on the availability of your client’s mark in Canada? (1 mark)
Explain your answer. (4 marks)

Question 21 (2 marks)

You are asked to record a security agreement on behalf of a lending corporation against 5 trademark registrations and 2 pending trademarks standing in the name of Horizontal Software, Inc. Your firm acts for the lending corporation and you are not the agent of record of the trademarks.

Yes or No. Can you record the security agreement on behalf of the lending corporation? (1 mark)
Cite the relevant provision of the *Trademarks Regulations* in support of your answer. (1 mark)

Question 22 (2 marks)

What are the two conditions that a person must meet to be entitled to file an Application for International Registration governed exclusively by the Madrid Protocol? (2 marks)

Question 23 (3 marks)

Please answer the following questions as Yes or No

- (a) Your client, while under the employment of the Minister of the Environment, was an inventor of certain software. The software is no longer used by the Government. Your client has started his own company and has acquired the rights to the software he invented along with the rights to the prohibited mark SPAM which was granted and advertised under Official Number 903,854 in the name of the Minister of the Environment. Your client would like to have the official mark transferred to his new company. Could the prohibited mark be assigned? (1 mark)

- (b) Your client's application has received an objection to registration under Section 12(1)(e) of the *Trademarks Act* based on a prohibited mark. Can this objection be overcome by providing written consent from the owner of the prohibited mark? (1 mark)
- (c) Western Canada Lottery Corporation, a public authority, wishes to file a request that the Registrar give public notice of the adoption and use of SPRING CHICKS. Would the mark be recognized as a prohibited mark under Section 9? (1 mark)

Question 24 (2 marks)

You are contacted by the University of Tweet to file for UOFT as a prohibited mark which has been used in Canada for over 10 years on its website, on clothing items, and for university services. Do you require proof that the University of Tweet is a public authority in Canada? (1 mark) Cite the relevant section of the Act. (1 mark)

Question 25 (1 mark)

Your client, ABC Corp., is applying to register the mark PARK OUT for "grocery store services". PARK IN has been registered by Gastonic Station, Inc. for "diesel, petrol and natural gas" in Class 4, and "convenience store services" in Class 35. Yes or No. Can you record the transfer of PARK IN to your client as agent for ABC Corp.? (1 mark)

Question 26 (3 marks)

An applicant has applied to register the mark FLORA THE BUNNY for "stuffed animals" in Class 28 on November 10, 2020.

- (a) Name a circumstance where the applicant would be granted expedited examination? (1 mark)
- (b) Yes or No. Can a request for expedited examination be filed online? (1 mark)
- (c) Yes or No. Is there a prescribed fee associated with requesting expedited examination? (1 mark)

Question 27 (22 marks)

Your client, Promise Mode Inc., has applied to register the trademark BRYLLYANTE KUT in association with "precious gems, diamonds, jewellery" in Class 14, and "clothing, t-shirts" in Class 27. The application was filed on April 27, 2019. The first Examiner's Report in connection with this application was issued on November 2, 2021 (see below).

Freedom Trademark Law Firm LLC
Toronto, Ontario

Attention: Candidate

RE: Trademark: BRYLLYANTE KUT
App. No.: 2,960,413
Applicant: Promise Mode Inc.

This examiner's report concerns the above identified application. To avoid abandonment proceedings, a proper response must be received by this office by May 2, 2022. 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 clearly descriptive or deceptively misdescriptive of the character or quality of the associated goods: "precious gems, diamonds, jewellery". Specifically, the trademark clearly describes that these goods are made of precious stones shaped in brilliant cut. In that regard, the *Collins Dictionary* defines "BRILLIANT CUT" as "a cut intended to enhance the brilliance of a gem with the least possible sacrifice of weight and characterized by a form resembling two pyramids set base to base". The Examiner's research also discloses that the phrase "BRILLIANT CUT" is in common use in association with regard to jewellery and gemstones.

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 "precious gems, diamonds and jewellery" in Class 14.

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 respect to "precious gems, diamonds and jewellery". 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 is also not the person entitled to register the above in view of the prior pending application for the trademark BRILLIANTIA & Circle Design (application no. 3,010,701) in respect of "hair accessories" in Class 26 filed on June 16, 2019 with a

priority date of March 1, 2019 by Bold Chrono Ltd. The application was filed based on proposed use.

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

Lastly, 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 term is not specified sufficiently: "clothing".

The applicant's grouping of these goods according to the classes of the Nice Classification appears to be incorrect.

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) Yes or No. Promise Mode Inc. needs more time to consider how it wishes to respond to the Examiner's report. Can Promise Mode Inc. obtain a six-month extension of time on that basis? **(1 mark)** Explain your answer **(1 mark)** and provide the relevant authority **(1 mark)**

(b) With regard to the objection based on paragraph 30(2)(a), what would your recommendations to the client be for amending the goods? **(1 mark)**

(c) True or False. In re-classifying the goods, Promise Mode Inc. would need to remit additional prescribed fees to the Registrar **(1 mark)**

(d) 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. **(17 marks)**

Question 28 (6 marks)

You have been approached by BeCool Cream Inc. to represent them in preparing an agreement to licence their trademark BECOOL in North America to Brill Skin Ltd., an existing client for whom you act as a trademark agent in Canada.

- (a) Yes or No. You must record the licence with the Registrar. **(1 mark)**
- (b) In what two instances can you act for BeCool Cream Inc. based on the CPATA Code of Professional Conduct? **(2 marks)**.
- (c) You found a mistake in the license agreement. Assuming you can record the license agreement with the Registrar, would an Examiner raise an objection with respect to your request to record the license agreement? **(1 mark)** Cite the relevant authority for your answer. **(1 mark)**
- (d) Assuming the license agreement is no longer in effect after a few years, is there a prescribed fee associated to request the removal of the license agreement from the records of the Registrar? **(1 mark)**

Question 29 (2 marks)

True or False. A holder of an International Registration that has designated Canada can transform its Protocol Application to a national application if it files a request with the Registrar within six months after the International Registration is noted as cancelled on the International Register **(1 mark)**

True or False. There is a prescribed fee that the holder of the International Registration must remit when requesting the transformation of the Protocol Application to a national application in Canada. **(1 mark)**

Question 30 (2 marks)

The assignment you filed on behalf of your U.S. Associate has been rejected by the Registrar since the assignor of the trademark in Canada is Zipcode Inc. whereas the name of the assignor on the worldwide assignment is listed as Zipcode Ltd. The Registrar has issued a notice advising of the deficiency. What is the deadline for responding to the Registrar's notice? **(1 marks)** Cite the relevant authority **(1 mark)**

TRADEMARK AGENT EXAM 2021
PART A
TOTAL MARKS: 150

If two answers are provided and one is correct, the second will not result in a loss of marks if it is true and does not contradict the correct answer with the exception of the answers in question 9 (Q22).

Question 1 (3 marks)

You filed an application on behalf of ABC Inc. In the Examiner's Report, the Examiner raised an objection based on confusion pursuant to Section 12(1)(d) of the *Trademarks Act*, citing Registration No. TMA999,999 owned by PJQ Inc. You noticed that your colleague in another office is listed as the agent for Registration No. TMA999,999. You just joined your firm a month ago and have never talked to this colleague. You have also never reviewed your firm's file for Registration No. TMA999,999. (Q1) Yes or No. Assume that ABC Inc. and PJQ Inc. are independent parties, can you assist your client with submitting arguments that the two marks are not confusing? **(1 mark)** (Q2) Explain your answer **(1 mark)** and cite the relevant authority. **(1mark)**

Answer:

- (Q1) No. (1 mark)
- (Q2) Your firm has a duty to the owner of Registration No. TMA999,999 and your firm is in a conflict of interest position to make the arguments. (1 mark)
- Code of professional conduct for the College of Patent Agents and Trademark Agents OR Rules of professional conduct of provincial law societies. (1 mark)

Question 2 (6 marks)

On behalf of your client, Holy Cow Inc., you have filed a Canadian basic application for the mark HOLY COW in association with ice cream on November 10, 2021. Holy Cow Inc. is now considering international expansion.

(a) (Q3) Assume that "dessert" is an acceptable term in the European Union. Can Holy Cow Inc. file an application for international registration designating the European Union covering "dessert"? **(1 Mark)** (Q4) Cite the relevant provision of the *Trademarks Act or Regulations* in support of your answer. **(1 mark)**

Answer:

(Q3) No. **(1 mark)**. (Q4) Rule 99(g) of the *Trademark Regulations* **(1 mark)**

(b) You are working from home and your home internet was down. (Q5) Can you file an application for international registration in paper form through registered mail? **(1 mark)** (Q6) Cite the relevant provision of the *Trademarks Act or Regulations* in support of your answer. **(1 mark)**

Answer:

(Q5) No. (1 mark). (Q6) Rule 99(3) of the *Trademark Regulations* (1 mark) Rule 10(5)(a) would not be accepted as an answer.

(c) Holy Cow Inc. is interested in filing an application in Taiwan directly (not through the Madrid Protocol). (Q7) Assuming that today is January 3, 2022, can Holy Cow Inc. file an application in Taiwan claiming priority based on the Canadian application? (1 mark) (Q8) Explain your answer in one sentence (1 mark)

Answer:

(Q7) No. (1 mark). (Q8) Taiwan is not part of the Paris Convention. (1 mark)

Question 3 (3 marks)

Your client, Tambourine Inc., has a prior registration for BREAK NICE covering “toys, namely action figures, clothing, shoes, guitars” that was issued on July 31, 2006. The registration was renewed on July 31, 2021. The Registrar has issued a notice under section 44.1 of the *Trademarks Act*.

a) (Q9) Yes or No. Does Tambourine Inc. have to remit a prescribed fee for requesting an extension of time to respond to the section 44.1? (1 mark)

Answer:

(a) (Q9) Yes (1 mark)

b) (Q10) True or False. Tambourine Inc. can appeal a decision of the Registrar as to the relevant classes in this registration that it disputes to the Federal Court of Canada. (1 mark) (Q11) Cite the relevant provision of the *Trademarks Act*. (1 mark)

Answer:

(Q10) (b) False (1 mark), (Q11) Section 44.1(4) of the *Trademarks Act* (1 mark)

Question 4 (3 marks)

(Q12) True or False. An application for a certification mark may be converted to an application for a regular trademark by deleting the statement referred to in paragraph 31(h) of the *Trademarks Regulations* prior to the application being advertised. (1 mark) (Q13) Cite the relevant provision of the *Trademarks Regulations* (1 mark) and (Q14) the relevant authority (1 mark).

Answer:

- (Q12) True. (1 mark)
- (Q13) Paragraph 35(2)(f) of the *Trademarks Regulations*. (1 mark) Marks would not be awarded for citing only paragraph 35 or paragraph 35(2). The specific subsection must be provided.
- (Q14) Section 2.8.6 of the *Trademarks Examination Manual* OR *Mister Transmission* decision OR *Mister Transmission (International) Ltd. v. Registrar of Trade Marks* (1978), 42 C.P.R. (2d) 123. (1 mark) [NOTE: specific section of the *Examination Manual* not required to receive the mark.]

Question 5 (3 marks)

(Q15) True or False. The name of the applicant is required in order for a trademark application to receive a filing date. (1 mark) (Q16) Cite the relevant provisions of the *Trademarks Act* (1 mark) and (Q17) *Trademarks Regulations*. (1 mark)

Answer:

- (Q15) False. (1 mark)
- (Q16) Paragraph 33(1)(b) of the *Trademarks Act*. (1 mark)
- (Q17) Paragraph 31(a) of the *Trademarks Regulations*. (1 mark)

Question 6 (2 marks)

(Q18) Your client is Powerful Superheroes Inc. and you communicate with its in-house counsel, Mr. Starky, regarding its Canadian and foreign trademark portfolio. You read a news article yesterday about a rumoured takeover of Powerful Superheroes Inc. by The Black Order Corp. Today, you have received an email from Mr. Glaive, an attorney for The Black Order Corp., advising that The Black Order Corp. has acquired Powerful Superheroes Inc. and will be managing its trademark portfolio. Mr. Glaive has asked you to provide him with a list of Powerful Superheroes Inc.'s trademarks and a copy of all your communications with Mr. Starky. No one from Powerful Superheroes Inc. is copied on this email. Briefly explain how you should respond to Mr. Glaive's request (1 mark) and why (1 mark).

Answer:

- (Q18) Confirm with your existing client (Mr. Starky at Powerful Superheroes Inc.) that you are to provide the information requested to Mr. Glaive (1 mark)
- Powerful Superheroes Inc. is your client and you owe a duty of confidentiality to your client OR you must have instructions from your client before divulging confidential information to a third-party. (1 mark)

Question 7 (8 marks)

(Q19) 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)**

<p>A. <i>Canadian Council of Professional Engineers v. APA-The Engineered Wood Assn.</i> (2000), 7 C.P.R. (4th) 239 (F.C.T.D.)</p> <p>Trademark: APA - THE ENGINEERED WOOD ASSOCIATION and THE ENGINEERED WOOD ASSOCIATION</p>	<p>1. 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>B. <i>Gerhard Horn Investments Ltd. v. Registrar of Trade Marks</i> (1983), 73 C.P.R. (2d) 23</p> <p>Trademark: MARCO PECCI</p>	<p>2. The onus on a person contending that a trademark which is descriptive or laudatory of its goods has come to actually distinguish those goods is a heavy one and that onus is increased by the adoption of a word which lacks inherent distinctiveness.</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. Marks are inherently distinctive when nothing about them refers the consumer to a multitude of sources.</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. Previously accepted moral standards are undergoing change and the difficulty is to determine what are the acceptable standards today and what would still be considered immoral, scandalous, or obscene by a good portion of people.</p>
<p>E. <i>Advance Magazine Publishers Inc. v. Masco Building Products Corp.</i> (1999), 86 C.P.R. (3d) 207</p> <p>Trademark: VOGUE</p>	<p>5. Examiners must determine whether there is a likelihood of confusion with either English or French speaking consumers as well as whether the average bilingual consumer would likely be confused. If there is a likelihood of confusion amongst any of these linguistic groups there is a likelihood of confusion.</p>

<p>F. <i>Molson Breweries v. Labatt Brewing</i> (1996), 69 C.P.R. (3d) 274 at 283 (T.M.O.B)</p> <p>Trademark: KOKANEE & Design</p>	<p>6. All relevant evidence which tends to establish non-distinctiveness may be considered. A party may rely on television broadcasts, website articles, and so on to establish that a party'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. If a mark consists of a name or surname of a living individual or an individual that has died in the last thirty years, the mark cannot be registered. It is not enough that the trademark may be thought of by the public to be a name or surname. That thought only becomes material when it is established by evidence that there is a living person of the name or surname in question.</p>
<p>H. <i>Choice Hotels International Inc. v. Hotels Confortel Inc.</i> (1996), 67 C.P.R. (3rd) 340 (FC)</p> <p>Trademarks: CONFORTEL</p>	<p>8. Examiners will only consider the resemblance between a trademark and a prohibited mark. The goods and/or services associated with the trademark and the channels of trade are not relevant when assessing the registrability of a mark in view of the existence of a similar official mark.</p>
	<p>9. The use of a well-known mark by a party in association with goods and/or services unrelated to those associated with the well-known mark could result in a likelihood of confusion in the mind of the average consumer. It is the duty of the applicant to select a name with care so as to avoid any confusion and the appearance that it intended to jump on the bandwagon of an already famous mark.</p>
	<p>10. An article advertised for sale as containing certain components which, in truth, it does not have, is considered as deceptively misleading to the purchasing public.</p>
	<p>11. An applicant must furnish a meaningful "defined standard" in respect of an application to register a certification mark. Easy access to the defined standard which a certification mark symbolizes is in the public interest. Reference to the titles of published documents where the defined standard may be found can suffice.</p>

Answer: (Q19)

A – 8
B – 7
C – 1
D – 3
E – 9
F – 11
G – 2
H – 5

Question 8 (2 marks)

(Q20) True or False. A notification of third-party rights must provide the Registrar with written arguments or evidence of prior use. (1 mark) (Q21) Cite the relevant authority (1 mark)

Answer:

- (Q20) False. (1 mark)
- (Q21) Section 6.10 of the *Trademark Examination Manual* OR Practice Notice dated June 17, 2019, "Notification of Third Party Rights". (1 mark) **[Note: specific section of the Examination Manual or date and title of Practice Notice not required to receive the mark.]**

Question 9 (22 marks)

(Q22) For each of the following trademarks, please indicate whether the trademark is REGISTRABLE or NOT REGISTRABLE and provide the most significant reason in support of your answer (1 mark each). Please cite the most relevant provision of section 12 of the *Trademarks Act*. (1 mark each) **Please ignore any confusion issues and do not assume acquired distinctiveness.**

- PERIL LIMB PICKS in association with "fire protective clothing"
- JOHNSON, TREMBLAY in association with "cosmetics"
- COLD CHAMPAGNE in association with "Ontario wine"
- PERFECT PAIR for use in association with "fruit juice"
- GOVERNOR GENERAL PRIZE for use in association with "books"
- JENNIFER LOPEZ STYLE for use in association with "rental of clothing"
- A ROW OF RED CROSSES for use in association "blood collection services"
- RONALD REAGAN for use in association with "jelly beans"
- BEST OF ESPAÑA for use in association "wines"
- UNITED STATES GOVERNMENT for use in association with "restaurant services"
- SUPERIOR SCHNAPPS for use in association with "peach juice"

Answer: (Q22)

- NOT REGISTRABLE – when sounded, the trademark so nearly resembles as to be likely to be mistaken for PARALYMPICS, a mark the adoption of which is prohibited by subsection 3(1) of the *Olympic and Paralympic Marks Act* (1 mark) Paragraph 12(1)(i) of the *Trademarks Act*. (1 mark)

- b) REGISTRABLE – the trademark is comprised of surnames separated by a comma and therefore the trademark as a whole is not a name or surname. (1 mark) Paragraph 12(1)(a) of the *Trademarks Act*. (1 mark)
- c) NOT REGISTRABLE – if indicated that the mark is deceptively misdescriptive; the trademark is in a protected geographical indication identifying a wine and the trademark is to be registered in association with a wine not originating in the territory indicated by the geographical indication (1 mark) Paragraph 12(1)(g) or 12(1)(b) of the *Trademarks Act* (1 mark)
- d) NOT REGISTRABLE – the trademark as a whole, when sounded, clearly describes that the applicant's "fruit juice" encompasses pear juice of excellent quality. (1 mark) Paragraph 12(1)(b) of the *Trademarks Act*. (1 mark)
- e) NOT REGISTRABLE – the trademark is likely to lead to the belief that the applicant's books have received, or are produced or sold under governmental patronage, approval or authority. (1 mark) Paragraph 12(1)(e) of the *Trademarks Act*. (1 mark)
- f) NOT REGISTRABLE – the trademark falsely suggests a connection with a living individual. (1 mark) Paragraph 12(1)(e) of the *Trademarks Act*. (1 mark)
- g) REGISTRABLE – the trademark does not consist of, nor so nearly resembles as to be likely to be mistaken for RED CROSS pursuant to paragraph 9(1)(f) of the *Trademarks Act* (1 mark) Paragraph 12(1)(e) of the *Trademarks Act*. (1 mark)
- h) 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)
- i) REGISTRABLE – the word ESPAÑA is Spanish, therefore the trademark is not clearly descriptive in English or French (1 mark) Paragraph 12(1)(b) of the *Trademarks Act*. (1 mark)
- j) REGISTRABLE – the trademark is not likely to lead to the belief that the applicant's "restaurant services" have received, or are produced, sold or performed under governmental patronage, approval or authority pursuant to paragraph 9(1)(d) of the *Trademarks Act* since that paragraph does not apply to foreign governments (1 mark) Paragraph 12(1)(e) of the *Trademarks Act*. (1 mark)
- k) NOT REGISTRABLE – the trademark deceptively misdescribes the character of the "peach juice" since "schnapps" is type of alcoholic beverage and the goods are non-alcoholic. (1 mark) Paragraph 12(1)(b) of the *Trademarks Act*. (1 mark)

Question 10 (3 marks)

Your client, LOVE YOURSELF INC., is using the mark CMHP & Design covering the following goods and services:

Class 25: t-shirts, shirts, hats and caps

Class 41: educational services in the field of mental health

CMHP stands for "Certified Mental Health Professionals". LOVE YOURSELF INC. is planning to sell the above goods and services directly to its students.

(Q23) Yes or No. Assuming that the circumstances will remain the same from now until the mark is registered, would Love Yourself Inc. be able to register a certification mark for CMHP & Design? **(1 mark)** (Q24) Please explain your answer **(1 mark)** and (Q25) cite the relevant provision of the *Trademarks Act*. **(1 mark)**

Answer:

- (Q23) No **(1 mark)**
- (Q24) A certification mark may be adopted and registered only by a person who is not engaged in the manufacture, sale, leasing or hiring of goods or the performance of services. LOVE YOURSELF INC. is selling the goods and providing the services itself. **(1 mark)**
- (Q25) Subsection 23(1) of the *Trademarks Act*. **(1 mark)** OR paragraph 30(2)(b)

Question 11 (1 mark)

Your client, a Korean administrative authority, has asked you about protecting the mark “Korean Purple Ginseng” in Canada for the goods “Ginseng”. The client indicated that the mark Korean Purple Ginseng shows that the Ginseng have certain qualities, characteristics or a reputation that are attributable to Korea, the place in which it is produced. The client indicated that the mark has not been used in Canada and they are not interested in seeking certification mark protection. (Q26) What is the most likely type of protection to be successful for this mark under the *Trademarks Act*? **(1 marks)**

Answer:

(Q26) Geographical indication **(1 mark)** No mark would not be awarded for citing Section 11.23 of the TMA.

Question 12 (1 mark)

(Q27) True or False. The Registrar will grant an extension of time if the applicant can demonstrate that it was not yet possible to file a proper response to an examiner's report due to the exceptional circumstance that the applicant has filed with WIPO a request for the limitation or the cancellation of some of the goods or services, in respect of Canada, of the international registration on which the Protocol application is based that would overcome an objection once CIPO is notified. **(1 mark)**

Answer:

(Q27) True. **(1 mark)**

Question 13 (5 marks)

You filed a Canadian trademark application on behalf of your client, Best BFF, Inc. for the mark BEST BFF for use in association with “social networking services”. Your client has asked you

about foreign applications. After discussing the potential risks and benefits of the Madrid Protocol, your client decided that they would like to file a trademark application directly in the U.S. Your client is cost conscious and asked if you can avoid using a U.S. agent.

- a) (Q28) Can you file the U.S. application and list yourself as the agent for Best BFF, Inc.? (1 mark) (Q29) Please explain your answer (1 mark)

Answer:

- (Q28) No. (1 mark)
- (Q29) As a Canadian agent, you are not qualified to file an application directly in the U.S. (1 mark)

- b) (Q30) Best BFF, Inc. has developed a proprietary software program to match its users at an incredible success rate. This program has not yet been published or disclosed publicly. Other than those set out in the *Trademarks Act*, what three types of intellectual property protection would most likely be available to protect the software? (3 marks)

Answer: (Q30)

- Copyright (1 mark) for the source code of the software
- Patent protection (1 mark)
- Best BFF, Inc. may protect the software as a trade secret (1 mark)

Question 14 (1 mark)

(Q31) Your direct European client owns an International Registration in WIPO designating Canada. Your European client has not informed you of this and you are not aware of the IP application although you represent the client's trademark portfolio in Canada. CIPO has issued an Examiner's first report on the IR filing. Who will receive the report?

Answer:

(Q31) The European client will receive the report directly from CIPO. It is acceptable, if in addition, the candidate mentions the Canadian agent receives the report if they are recorded as the agent. (1 mark)

Question 15 (2 marks)

(Q32) True or False. An application may be filed for the registration of a hologram showing different images in colour. (1 mark) (Q33) Cite the relevant provisions of the Trademarks Regulations. (1 mark)

Answer:

- (Q32) True (1 mark)

- (Q33) Section 30(a), 30(d), 31(e) and (f) of the Regulations **(1 mark for naming one of the subsections)**

Question 16 (2 marks)

You have assisted your client, Take It Easy, Inc. with filing Application No. 3,000,000 for the mark EASYPEASY. Take It Easy, Inc. has a number of subsidiaries, including Take It Easy Ontario Inc., Take It Easy Quebec Inc., and Take It Easy USA Corp. You know that general counsel for Take It Easy, Inc. manages all intellectual property matters for its subsidiaries.

You have recently received an Examiner's Report, citing Registration No. TMA123,789 for EASYPEASIE owned by Take It Easy USA Corp. Your firm is agent of record for Registration No. TMA123,789.

(Q34) Yes or No. Does this Examiner's Report raise a conflict of interest given that your firm is agent of record for both Application No. 3,000,000 and Registration No. TMA123,789? **(1 mark)**

(Q35) Explain your answer in one sentence. **(1 mark)**

Answer:

- (Q34) No **(1 mark)**
- (Q35) No conflict of interest because you are taking instructions from both companies from the same instructing principal OR because the parties have common ownership OR the parties are not adverse in interest **(1 mark)**

Question 17 (4 marks)

J&L Inc. is a company focusing on selling headphones. On June 2020, an employee of J&L Inc. created a logo and by way of an employment agreement, the employee has assigned all intellectual property rights of this logo to J&L Inc.

J&L Inc. publicly displayed the logo at a conference in July 2020. Unfortunately, J&L Inc. did not instruct you to file a Canadian application for this logo and the logo has not yet been in use in association with J&L Inc.'s headphones in Canada.

J&L Inc. has now found a competitor, Q&P Ltd. using a design mark that is identical to J&L Inc.'s logo in association with headphones. Investigations into the use of the design mark by Q&P Ltd. indicate that Q&P Ltd. commenced use of the mark in or around March 2021.

(a) (Q36) Yes or No. Does your client own any intellectual property rights that it could enforce against this competitor? **(1 mark)** (Q37) Explain your answer in one sentence. **(1 mark)**

Answer:

(Q36) Yes (1 mark). (Q37) Your client owns the copyright of the design mark (1 mark)

(b) J&L Inc. would like to allow its distributor, Headset Perfect Corp., to help with advertising J&L Inc.'s products by allowing customers to download the headphone's specification sheets on Headset Perfect Corp.'s website. The specification sheets are created by J&L Inc. and display J&L Inc.'s trademarks. (Q38) Is a license from J&L Inc. to Headset Perfect Corp required? **(1 mark)** (Q39) Explain your answer in one sentence. **(1 mark)**

Answer:

(Q38) No **(1 mark)**. (Q39) A license is not required for a distributor OR the distributor is not a licensee **(1 mark)**

Question 18 (3 marks)

Your client, Q Square, is an entertainment company that provides subscription services for TV shows and movies. You have filed a number of standard character marks and design marks for Q Square. While reviewing Q Square's services on its website, you notice that at the beginning of each movie or TV show, Q Square plays a particular jingle accompanied by a distinctive animation on a particular red-black background.

(Q40) Other than standard character marks and design marks that you have applied to register as trademarks, what are three other most relevant types of trademarks that you can apply to register on behalf of Q Square? **(3 marks – NOTE: only the first three answers given will be marked)**

Answer: (Q40)

Any 3 of (i) Sound mark (ii) Motion mark (iii) Colour per se (iv) combination of sound/motion/colour **(1 mark for each type, up to a total of 3 marks)** colour on its own is acceptable

Question 19 (2 marks)

You received a Statement of Grant of Protection dated February 22, 2022 from CIPO in respect of a Protocol application in Canada. The corresponding International Registration was registered on July 23, 2021.

(a) (Q41) When is the next renewal deadline? **(1 mark)**

Answer:

(Q41) July 23, 2031. **(1 mark)**

(b) (Q42) True or false. A request to renew the Canadian Protocol registration should be filed with the Canadian Intellectual Property Office. **(1 mark)**

Answer:

(Q42) False – Renewal for a Protocol Registration should be filed with the World Intellectual Property Office (WIPO). **(1 mark)**


Question 20 (29 marks)

Your client, London Airlines, Inc., is interested in applying to register the trademark LONDON AIRSUITE for use in association with goods and services identified as “software related to baggage handling and passenger luggage” and “a lounge/bar suite for executive members and airline staff”. The mark has not yet been used in Canada but has been used in the United Kingdom, specifically London Heathrow Airport. Prior to filing an application to register the LONDON AIRSUITE mark, your client has asked you to conduct a full availability search and to provide your opinion on the prospects of use and registration of the proposed trademark LONDON AIRSUITE in Canada.

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

- a) (Q43) Yes or No. For each of the trademarks identified in the Register search set out below, identify whether the trademark is likely to pose an obstacle to the registration of the trademark LONDON AIRSUITE for the goods and services of interest to your client. **(1 mark each)** [NOTE: A “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.]. Please also provide an explanation from the point of view of the Registrar to support your answer in (a) above (point form is acceptable). **(1 mark each)**. [NOTE: No marks will be given for a “yes” or “no” answer unless a valid supporting explanation is given] **(Total 20 marks)**


No.	Trademark	App./Reg. No. (Status)	Owner	Goods/Services
1.	LONDON AIR	1935028 (Filed)	Trade Clothing Brand Ltd.	Software for retail sale of clothing, bags and luggage
2.	LONDON FOG	2084969 (Filed)	Icon DE Holdings LLC	Luggage scales; combination locks; adapter plugs; power adapters; travel adapters for outlets and power chargers; power banks; retractable cables; luggage; underseat bags; duffle bags; backpacks; tote bags; luggage inserts, namely, packing cubes; shoe bags for travel; luggage tags; straps for luggage; belts for luggage; pouches of textile; drawstring pouches

3.	LONDON HEALTH SCIENCES CENTRE	927021 (Advertised)	London Health Sciences Centre	Official Mark
4.	londonair.ca	924536 (Advertised)	The Corporation of the City of London	Official Mark
5.	 THE PARK HOTEL "LONDON" AN ALL SUITE HOTEL	1962071 (Filed)	Pall Mall Hotel GP Ltd., in its capacity as general partner of Pall Mall Hotel LP	(1) Administrative hotel management; business management of hotels (2) Hotel services; restaurant, catering, bar, bistro and lounge services; provision of general purpose facilities for meetings, conferences and exhibitions; provision of banquet and social function facilities for special occasions; reservation services for hotel accommodations
6.	THE LONDON BULL	TMA917470 (Registered)	Browns Social House Ltd.	Restaurant and bar services; franchising services, namely, offering technical assistance in the establishment and operation of restaurants and bars.
7.	AirSuite	1760036 (Abandoned)	Airsuite Inc.	(1) Computer software for use in managing and controlling flight schedules, pilot duty times, regulatory compliance, inventories and accounts and weight and balance of aircrafts. (2) Computer software for use in operations management of aircrafts. (3) Computer software for use in managing and controlling air services, air safety, flight data, flight management, and operations management for flights and aircrafts. (4) Computer software for use in managing and controlling air services, air safety, flight data, flight management, and operations management for aircrafts and flights for use with mobile devices and cloud-based computing.
8.	SUITEAIR	1934758	Transoft Solutions Inc.	Software application for two or three-dimensional simulation and modeling for use in design, planning, development and

		(Filed)		analysis of air traffic control, use of airspace, runway control and sequencing, airside ground traffic movements, airport operations and capacity, and airport passenger behaviour & terminal processes
9.	AIRPORT	TMA582225 (Registered)	Apple Inc.	Computer hardware and computer peripherals having chips that support wireless technology to provide communication between multiple computers and between computers and local and global computer networks, computer software to enable wireless communications using the hardware and peripherals, and instruction manuals sold as a unit therewith but not including any such goods by or relating to airports.
10.	SmartSuite	1983096 (Filed)	Brock Solutions Inc.	Integration of computer systems for engineering programs in the fields of robotics, control systems, process automation systems, computer systems and electrical systems; Installation of computer software, for automation and systems integration, services in the fields of robotics, control systems, computer systems, process automation systems and electrical systems.

Answer: (Q43)

No.	Trademark	ANSWER
1.	LONDON AIR	Yes (1 mark) - The marks are similar as LONDON AIR is incorporated entirely in LONDON AIRSUITE and the goods are similar (1 mark)
2.	LONDON FOG	No (1 mark) -The goods are sufficiently dissimilar and the marks differ in appearance, sound and ideas suggested (1 mark)
3.	LONDON HEALTH SCIENCES CENTRE	No (1 mark) -the client's mark does not so nearly resemble as to be likely to be mistaken for the official mark (1 mark) Need to reference official mark or test for official mark
4.	londonair.ca	Yes (1 mark)

		-The client's mark consists of the Official Mark or so nearly resembles as to be likely mistaken for the official mark (1 mark)
5.		No (1 mark) -marks differ significantly in appearance, sound and ideas suggested (1 mark)
6.	THE LONDON BULL	No (1 mark) - Since LONDON is a geographical name, the distinguishing portions are AIRSUITE and BULL, and therefore confusion is unlikely. (1 mark)
7.	AirSuite	No (1 mark) -the application is abandoned (1 mark)
8.	SUITEAIR	Yes (1 mark) -the client's mark is phonetically similar and the goods and channels of trade overlap (1 mark)
9.	AIRPORT	No (1 mark) -the goods are sufficiently dissimilar and the marks differ in appearance, sound and ideas suggested (1 mark)
10.	SmartSuite	No (1 mark) -the services are sufficiently dissimilar and the marks differ in appearance, sound and ideas suggested (1 mark)

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

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

Trade name: AirSuite Inc.

Address: 4328 Main Street Vancouver, BC V5V 3P9

Line of business: Flight management software

Incorporated: July 1, 2015

Note: Preliminary searching reveals that AirSuite Inc. was purchased by Aerospace Canada but continues to operate as AirSuite.

(Q44) Yes or No. Does the above trade name constitute a potential obstacle to the registration of your client's mark? (1 mark) (Q45) Explain your answer. (3 marks)

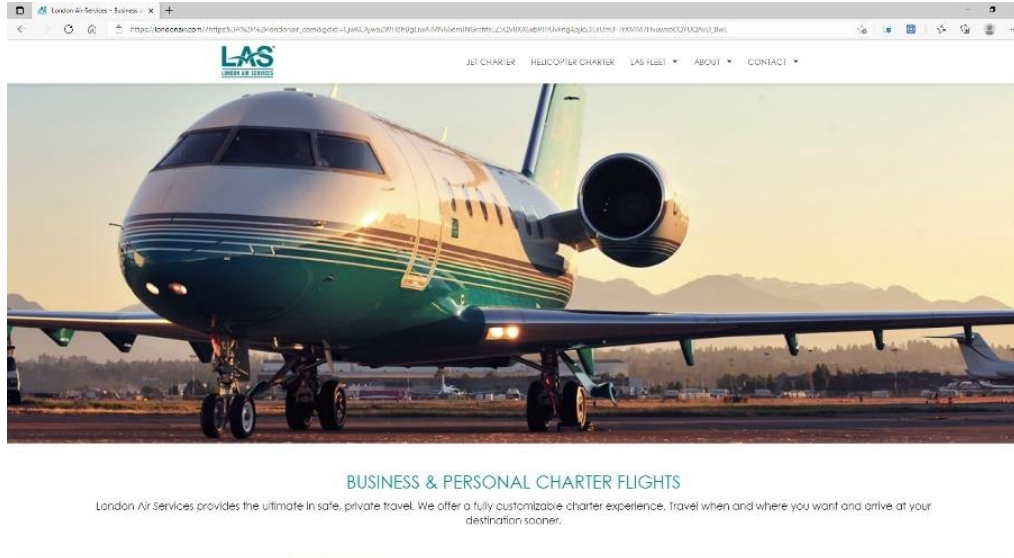
Answer:

(Q44) Yes (1 mark).

(Q45) The trade name Airsuite Inc. is similar in appearance, sound and ideas suggested to the client's mark LONDON AIRSUITE (1 mark) and there is overlap in the goods (1 mark). AirSuite Inc. could oppose the registration of the client's proposed mark based on

prior use in Canada of its trade name and/or trademark even though the trademark application identified in (a) is abandoned (1 mark)

c) The third part of the search report contains Internet search for the terms LONDON, AIR and SUITE. Many of the websites located are “parked” websites and no information is available. However, the websites for www.londonair.com is available to view. The home page of this website indicates the following information:



By clicking on the website www.londonair.com, you found that they provide lounge access to its customers. In the “Contact Us” page, you found a 1-800 number. (Q46) Yes or No. Does www.londonair.com have an impact on the availability of your client’s mark in Canada? (1 mark) (Q47) Explain your answer. (4 marks)

Answer:

www.londonair.com (Q46) (YES (1 mark) (Q47) Further investigation into the use of the services in Canada should be conducted (1 mark). If the services are used in Canada, the owner of www.londonair.com could oppose registration of the proposed LONDON AIRSUITE trademark (1 mark) or take legal action against your client based on common law rights (1 mark) and a passing off action (1 mark).

Question 21 (2 marks)

You are asked to record a security agreement on behalf of a lending corporation against 5 trademark registrations and 2 pending trademarks standing in the name of Horizontal Software, Inc. Your firm acts for the lending corporation and you are not the agent of record of the trademarks.

(Q48) Yes or No. Can you record the security agreement on behalf of the lending corporation? (1 mark) (Q49) Cite the relevant provision of the *Trademarks Regulations* in support of your answer. (1 mark)

Answer:

(Q48) Yes **(1 mark)** – (Q49) Subsection 22(1) of the *Trademarks Regulations* **(1 mark)**.

Question 22 (2 marks)

(Q50) What are the two conditions that a person must meet to be entitled to file an Application for International Registration governed exclusively by the Madrid Protocol? **(2 marks)**

Answer: (Q50)

- the person is a national of or is domiciled in Canada or has a real and effective industrial or commercial establishment in Canada; **(1 mark)** and
- the person is the applicant of a previously filed Canadian application or basic application or the registered owner of a Canadian registration. **(1 mark)**

Question 23 (3 marks)

Please answer the following questions as Yes or No

- (a) (Q51) Your client, while under the employment of the Minister of the Environment, was an inventor of certain software. The software is no longer used by the Government. Your client has started his own company and has acquired the rights to the software he invented along with the rights to the prohibited mark SPAM which was granted and advertised under Official Number 903,854 in the name of the Minister of the Environment. Your client would like to have the official mark transferred to his new company. Could the prohibited mark be assigned? **(1 mark)**

Answer:

(Q51) No

- (b) (Q52) Your client's application has received an objection to registration under Section 12(1)(e) of the *Trademarks Act* based on a prohibited mark. Can this objection be overcome by providing written consent from the owner of the prohibited mark? **(1 mark)**

Answer:

(Q52) Yes

- (c) (Q53) Western Canada Lottery Corporation, a public authority, wishes to file a request that the Registrar give public notice of the adoption and use of SPRING CHICKS. Would the mark be recognized as a prohibited mark under Section 9? **(1 mark)**

Answer:

(Q53) Yes

Question 24 (2 marks)

You are contacted by the University of Tweet to file for UOFT as a prohibited mark which has been used in Canada for over 10 years on its website, on clothing items, and for university services. (Q54) Do you require proof that the University of Tweet is a public authority in Canada? (1 mark) (Q55) Cite the relevant section of the Act. (1 mark)

Answer:

- (Q54) No
- (Q55) 9(1)(n)(ii)

Question 25 (1 mark)

Your client, ABC Corp., is applying to register the mark PARK OUT for “grocery store services” PARK IN has been registered by Gastonic Station, Inc. for “diesel, petrol and natural gas” in Class 4, and “convenience store services” in Class 35. (Q56) Yes or No. Can you record the transfer of PARK IN to your client as agent for ABC Corp.? (1 mark)

Answer:

(Q56) Yes

Question 26 (3 marks)

An applicant has applied to register the mark FLORA THE BUNNY for “stuffed animals” in Class 28 on November 10, 2020.

- (a) (Q57) Name a circumstance where the applicant would be granted expedited examination? (1 mark)

Answer: (Q57)

- See Practice Notice entitled: Requests for expedited examination
 - A court action is expected or underway in Canada with respect to the applicant's trademark in association with the goods or services listed in the application;
 - The applicant is in the process of combating counterfeit products at the Canadian border with respect to the applicant's trademark in association with the goods or services listed in the application;
 - The applicant requires registration of its trademark in order to protect its intellectual property rights from being severely disadvantaged on online marketplaces; or
 - The applicant requires registration of its trademark in order to preserve its claim to priority within a defined deadline and following a request by a foreign intellectual property office. Note that in such cases the request will need to be attached to the affidavit or statutory declaration. (max 1 mark) 1

- (b) (Q58) Yes or No. Can a request for expedited examination be filed online? (1 mark)

Answer:
(Q58) No

- (c) (Q59) Yes or No. Is there a prescribed fee associated with requesting expedited examination? (1 mark)

Answer:
(Q59) No

Question 27 (22 marks)

Your client, Promise Mode Inc., has applied to register the trademark BRYLLYANTE KUT in association with “precious gems, diamonds, jewellery” in Class 14, and “clothing, t-shirts” in Class 27. The application was filed on April 27, 2019. The first Examiner’s Report in connection with this application was issued on November 2, 2021 (see below).

Freedom Trademark Law Firm LLC
Toronto, Ontario

Attention: Candidate

RE: Trademark: BRYLLYANTE KUT
App. No.: 2,960,413
Applicant: Promise Mode Inc.

This examiner's report concerns the above identified application. To avoid abandonment proceedings, a proper response must be received by this office by May 2, 2022. 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 clearly descriptive or deceptively misdescriptive of the character or quality of the associated goods: “precious gems, diamonds, jewellery”. Specifically, the trademark clearly describes that these goods are made of precious stones shaped in brilliant cut. In that regard, the *Collins Dictionary* defines “BRILLIANT CUT” as “a cut intended to enhance the brilliance of a gem with the least possible sacrifice of weight and characterized by a form resembling two pyramids set base to base”. The Examiner’s research also discloses that the phrase “BRILLIANT CUT” is in common use in association with regard to jewellery and gemstones.

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 “precious gems, diamonds and jewellery” in Class 14.

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 respect to "precious gems, diamonds and jewellery". 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 is also not the person entitled to register the above in view of the prior pending application for the trademark BRILLIANTIA & Circle Design (application no. 3,010,701) in respect of "hair accessories" in Class 26 filed on June 16, 2019 with a priority date of March 1, 2019 by Bold Chrono Ltd. The application was filed based on proposed use.

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

Lastly, 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 term is not specified sufficiently: "clothing".

The applicant's grouping of these goods according to the classes of the Nice Classification appears to be incorrect.

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) (Q60) Yes or No. Promise Mode Inc. needs more time to consider how it wishes to respond to the Examiner's report. Can Promise Mode Inc. obtain a six-month extension of time on that basis? **(1 mark)** (Q61) Explain your answer **(1 mark)** and provide the relevant authority **(1 mark)**

Answer:

(Q60) Yes. **(1 mark)** (Q61) The nature of the objections raised – sections 12, 32, 16 or 37(1)(b),(c) or (d) – allow for the applicant to request a first extension of time. **(1 mark)** Practice Notice entitled “Extensions of time in Examination and to respond to a section 44.1 notice” last updated July 19, 2021 **(1 mark)** (date and title not necessary to get the mark).

(b) (Q62) With regard to the objection based on paragraph 30(2)(a), what would your recommendations to the client be for amending the goods? **(1 mark)**

Answer:

(Q62) Amend to “clothing, namely t-shirts” or further describe the term “clothing” to include specific items of clothing or type of clothing or delete the term “clothing”. **(1 mark for stating either option).**

(c) (Q63) True or False. In re-classifying the goods, Promise Mode Inc. would need to remit additional prescribed fees to the Registrar **(1 mark)**

Answer:

(Q63) False – there would be no additional prescribed fee in correcting Class 27 to Class 25 **(1 mark).**

(d) (Q64) 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. (17 marks)

Answer: (Q64)

Substantive objections:

- 12(1)(b) and 37(1)(d):
 - Delete Class 14 goods OR limit the application to Class 25 (1 mark)
 - File a divisional application for Class 25 goods and secure registration for Class 25 goods. (1 mark) or “File a divisional application for Class 14 goods and proceed with the application for Class 25 goods”
 - Argue against this objection with or without filing the divisional application based on: (4 marks)
 - Neither BRYLLYANTE or KUT have a dictionary meaning; coined terms
 - On first impression, the average consumer would not think that the trademark was describing the shape, material or intrinsic characteristic of the goods.
 - The combination of the two invented elements is unique and distinctive and thus registrable. The term BRYLLYANTE is at best suggestive of the brightness of the goods.
 - No other trader is deprived of essential language required to describe its goods.(Note: any other valid argument will earn 1 mark up to a maximum of 4 marks)
 - File affidavit evidence of acquired distinctiveness if there has been significant use of the mark in Canada under section 12(3) of the Act (1 mark)
 - Inquire about the date of first use in Canada (1 mark)
 - Use should go back ideally for at least 5 years or use should be sufficiently (1 mark) extensive in part or throughout Canada (1 mark)
 - Inquire where in Canada use of the mark has occurred and possible geographic limitation if the mark has not been used throughout Canada (1 mark)
 - Explain definition of “use” of the mark with goods in Canada (1 mark)
 - Provide samples of use and advertising materials of the mark in association of the goods. (1 mark)
 - Requirement to demonstrate sales figures and advertising expenses in each province in Canada (1 mark)
- 16(1)(b) (3 marks, 1 mark for each point below)
 - Argue against the objection – the marks are not confusing given the lack of resemblance, difference in the nature of the goods, channels of trade
 - Review state of the register to see if the word BRILLIANT is common to the trade.
 - Check if the mark has been advertised for opposition – possible opposition if Promise Mode has used the subject mark prior to the priority deadline.

Question 28 (6 marks)

You have been approached by BeCool Cream Inc. to represent them in preparing an agreement to licence their trademark BECOOL in North America to Brill Skin Ltd., an existing client for whom you act as a trademark agent in Canada.

- (a) (Q65) Yes or No. You must record the licence with the Registrar. **(1 mark)**

Answer:

(Q65) No. (1 mark)

- (b) (Q66) In what two instances can you act for BeCool Cream Inc. based on the CPATA Code of Professional Conduct? **(2 marks)**.

Answer:

(Q66) Consent (or waiver) from the clients (1 mark), no material adverse effect upon the representation of or loyalty to the other client. (1 mark) (see Section 2(1) of the Code)

- (c) You found a mistake in the license agreement. (Q67) Assuming you can record the license agreement with the Registrar, would an Examiner raise an objection with respect to your request to record the license agreement? **(1 mark)** (Q68) Cite the relevant authority for your answer. **(1 mark)**

Answer:

(Q67) No (1 mark) (Q68) Practice Notice dated October 28, 2020 entitled "License Agreements" (1 mark) [note: date and title of practice notice not required to receive mark.]

- (d) (Q69) Assuming the license agreement is no longer in effect after a few years, is there a prescribed fee associated to request the removal of the license agreement from the records of the Registrar? **(1 mark)**

Answer:

(Q69) No (1 mark)

Question 29 (2 marks)

(Q70) True or False. A holder of an International Registration that has designated Canada can transform its Protocol Application to a national application if it files a request with the Registrar within six months after the International Registration is noted as cancelled on the International Register **(1 mark)** (Q71) True or False. There is a prescribed fee that the holder of the International Registration must remit when requesting the transformation of the Protocol Application to a national application in Canada. **(1 mark)**

Answer:

- **(Q70) False (1 mark)**
- **(Q71) False (1 mark)**

Question 30 (2 marks)

(Q72) The assignment you filed on behalf of your U.S. Associate has been rejected by the Registrar since the assignor of the trademark in Canada is Zipcode Inc. whereas the name of the assignor on the worldwide assignment is listed as Zipcode Ltd. The Registrar has issued a notice advising of the deficiency. What is the deadline for responding to the Registrar's notice? **(2 marks)**
Cite the relevant authority **(1 mark)**

Answer: (Q72)

- None – There is no time limit to respond to correspondence issued by the Office identifying deficiencies in requests to record the transfer of an application for the registration of a trademark or to register the transfer of a registered trademark. **(2 marks - should be 1 mark)**
- Practice Notice **(1 mark)** the TEM is not acceptable

This question is a total of 2 marks

TRADEMARK AGENT EXAM 2021
PART B
TOTAL MARKS: 150

Question 1 (28 marks)

On behalf of your client, your firm requested the issuance of a Section 45 Notice against the registration for the trademark MOVIN' ON UP (Registration No. TMA987,432) owned by Allan Robinson Inc. and covering the following goods and services:

Goods:

Downloadable software used to plan a residential move;
Packing supplies, namely, moving boxes, wrapping paper and clear adhesive tape;
Luggage tags;
Articles of clothing, namely, t-shirts, sweatshirts and shorts.

Services:

Residential moving services;
Providing online discussion forums pertaining to the organisation of a residential move and downsizing;
Real estate services;
Organizing meet ups allowing newcomers to an area to meet one another and to engage in cultural, sports and leisure activities; and
Online marketing services.

Two months later, you received the following affidavit from the Registrant's agent:

IN THE CANADIAN TRADEMARKS OFFICE

In the Matter of S. 45 Proceedings Regarding Registration No. TMA987,432 for the trademark MOVIN' ON UP owned by Allan Robinson Inc.

I, Allan Robinson, of the City of Halifax, Nova Scotia, hereby MAKE OATH AND SAY AS FOLLOWS:

- 1. I am the President of Movin' On Up Inc. (hereinafter "**my Company**" or "**the Registrant**") and have held this position since my Company was founded in 2013. In that capacity, I am familiar with the use of the trademark MOVIN' ON UP. I therefore have personal knowledge of, and maintain records of and/or have access to, corporate records relating to the matters to which I hereinafter depose.*
- 2. Movin' On Up Inc. was incorporated under the laws of Canada on February 14, 2013.*

3. Movin' On Up Inc. owns Canadian trademarks registration TMA987,432 ("**the Registration**") for MOVIN' ON UP ("**the Trademark**") covering the following goods and services:

Goods:

Downloadable software used to plan a residential move;

Packing supplies, namely, moving boxes, wrapping paper and clear adhesive tape;

Luggage tags;

Articles of clothing, namely, t-shirts, sweatshirts and shorts. ("**the Goods**")

Services:

Residential moving services;

Providing online discussion forums pertaining to the organisation of a residential move and downsizing;

Real estate services;

Organizing meet ups allowing newcomers to an area to meet one another and to engage in cultural, sports and leisure activities;

Online marketing services. ("**the Services**")

4. Section 45 proceedings have been commenced in respect of the Registration. The Section 45 notice is dated September 12, 2021 and, in response thereto, use of the Trademark must be shown between September 12, 2018 and September 12, 2021 ("**the Relevant Period**").

5. My Company has advertised, offered and sold the Goods and Services in Canada since February 14, 2013 when my Company was founded.

6. Originally, the Goods and Services were mainly sold in Halifax and the neighbouring areas. More recently, however, the Goods and Services have been sold in Quebec and Ontario and now British Columbia.

7. My Company currently owns a fleet of ten (10) moving trucks and employs seventy-five (75) people, including movers and office workers.

8. The Trademark is regularly used and seen by Canadians as follows.

9. The Trademark appears on the side of my Company's trucks and on the outside of its head office located in downtown Halifax.

10. Now produced, shown to me and enclosed as **Exhibits A-1 and A-2** is a photo of a moving truck, used for residential moves, on which appears the Trademark and a photo of the signage at my Company's head office on which appears the Trademark.

11. Now produced, shown to me and enclosed as a bundle as **Exhibit B** are representative samples of invoices for moving services provided to Canadians over the past three years, from September 1, 2018 to September 1, 2021. The Trademark appears on each of those invoices and those invoices were given to customers of my Company to whom moving services were sold during the Relevant Period.

12. The Trademark also appears on t-shirts and sweatshirts that are worn by the employees of my Company. Now produced, shown to me and enclosed as **Exhibit C** is a photo of two of my employees, taken in December 2020, on which the Trademark appears. The photo also shows those employees wearing a face mask on which the Trademark appears.

13. In each of 2018, 2019 and 2020, my Company gave away over 500 luggage tags as promotional items to its customers. The Trademark appears prominently on those tags. Now produced, shown to me and attached as **Exhibit D** is a photograph of one of those luggage tags. The colour scheme and font size in which the Trademark has appeared on those tags have changed over the years, but the Trademark has at all times appeared prominently on one face of the tag.

14. My Company also sells its own line of branded moving supplies, including boxes, paper and tape. The Trademark appears in association with those goods, on the boxes themselves, on the clear cellophane wrapping for the tape or on the ribbon tie used to hold bundles of paper together. Now produced, shown to me and attached as **Exhibit E** are photographs showing these various materials on which the Trademark appears. These photographs were taken in August 2021 and are representative of materials used during the Relevant Period in association with those goods. The records of my Company show that at least 1000 boxes were sold in the past 5 years. And in each of those 5 years, 750 rolls of tape and 250 bundles of paper were sold from my Company's head office in Halifax.

15. Between September 12, 2018 and September 12, 2021, my Company sold over 800 downloads to Canadian users of its residential move planning software. The words ROBINSON ALLAN MOVIN' ON UP! appear on the start-up screen. In particular, the words ROBINSON ALLAN always appear in a different colour and much smaller size than the words MOVIN' ON UP. Each consumer was charged \$0.99 to download a copy of this software. Now produced, shown to me and attached as **Exhibit F** are screenshots of the Apple store and Google Play store showing the page from which users can purchase and download the software and records showing the aggregate number of downloads by Canadians of copies of the software from each of those stores on a monthly basis for the period from September 2018 to September 2021.

16. As part of my Company's sale of moving services and move planning software, my Company offers a forum on its website, at www.movinonup.ca, where people can discuss their experiences with a move, share tips and tricks, trade goods and services amongst themselves. Access to the forum is provided free of charge. Now produced, shown to me and enclosed as **Exhibit G** is a printout dated December 18, 2019 showing a series of posts by users on the website. These posts are representative of other posts featured on the site during the course of the Relevant Period. Most if not all of the posts show clearly that the person in question is located in Canada and the Trademark is featured on the website (my Company's website) on which the forum is offered.

17. Starting in late 2019, my Company entered into an arrangement with Ms. Jane Sellers of Toronto to operate a real estate agency in Toronto called MOVIN' ON UP!. The idea is to help people in Ontario find second homes, retirement homes and the like in the province of Nova Scotia. The agency opened on January

2, 2020 and has been operating continuously since then. It has generated upwards of \$100,000 in commissions for Ms. Sellers since it first began operating. Now produced, shown to me and attached as a bundle as **Exhibit H** are copies of business cards and flyers on which the Trademark appears, along with agreements signed by Canadians with Ms. Sellers regarding her representation and on which the Trademark also appears. These representative agreements are dated between January 2, 2020 and September 15, 2021. I am pleased that my Company is able to provide these services, to attract new people to the province of Nova Scotia. But real estate is not within the area of expertise of my Company and I have taken a rather “hands off” approach to the manner in which those services are carried out.

18. My Company has, however, taken a more “hands on” approach to helping customers get to know one another by providing meet ups at which people can get together and engage in activities of mutual interest. Because many of my customers spend their winter in Florida, and it is often there that they are looking to meet new people, these meet ups have been organised in Florida, with the first meet up having taken place in March 2019, and then each month thereafter, though not taking place from June to August of every year. Now produced, shown to me and attached as **Exhibit I** is an advertisement that appeared in at least five different magazines that circulate in Canada and are directed at seniors. This advertisement features the trademark MOVIN’ ON UP!, with the tag line, AND MEETIN’ ON UP! Further enclosed as part of Exhibit H is the cover page for each of the five publications in which this advertisement appeared, showing a publication date between September 12, 2019 and September 12, 2021.

19. Finally, my Company has, over the years, created a small marketing division which is devoted to looking at new ways to offer our residential moving services. This division regularly conducts online surveys on which the Trademark is featured. In fact, a survey was conducted in February 2020. In the course of that survey, over 250 customers viewed the survey page, on which the Trademark does appear. Now produced, shown to me and attached as **Exhibit J** are copies of the web pages featured on my Company’s website during the month of February 2020, and a list of expenses, other than staff salaries, that were incurred to allow my Company to run this survey.

20. 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, 2021

For each of the Goods and Services, advise your client as to whether the registration will be maintained or expunged **(1 mark)** and give reasons to support your answer **[total of 28 marks]**

- Downloadable software used to plan a residential move **(1 mark + 3 marks for reasons)**
- Packing supplies, namely, moving boxes, wrapping paper and clear adhesive tape **(1 mark + 3 marks for reasons)**
- Luggage tags **(1 mark + 2 marks for reasons)**
- Articles of clothing, namely, t-shirts, sweatshirts and shorts **(1 mark + 2 marks for reasons)**
- Residential moving services **(1 mark + 3 marks for reasons)**
- Providing online discussion forum pertaining to the organisation of a residential move and downsizing **(1 mark + 2 marks for reasons)**

- Real estate services **(1 mark + 2 marks for reasons)**
- Organizing meet ups allowing newcomers to an area to meet one another and to engage in cultural, sports and leisure activities **(1 mark + 1 mark for reason)**
- Online marketing services **(1 mark + 1 mark for reasons)**

Question 2 (12 Marks)

- a) You have received payment in advance from a client for filing a trademark application including the government fee. You have filed the trademark application and reported it to the client.

Are you now able to use the funds to directly pay other expenses of your firm?
Yes or No **(1 Mark)**

Briefly explain your answer above **(1 Mark)**

- b) You have been provided an estimate by a private investigator of \$1,500 plus HST for collecting evidence relevant to opposition proceeding in which represent the opponent.

Are you permitted to list the private investigator's estimate as a disbursement on your next invoice to the client? Yes or No **(1 Mark)**

Briefly explain your answer above: **(1 Mark)**

- c) Your new practice is rapidly expanding, and you need additional help to meet your clients' obligations. You do not have time to hire another employee and will have a trademark agent at another firm assist you with some of your files. Assume that the other agent does not have a conflict. List the two (2) requirements for you to share the fees received from your clients with the other agent? **(2 Marks)**
- d) List the requirements that you need to meet as trademark agent if you require payment before commencing work for a client **(3 Marks)**
- e) True or False – A trademark agent may enter into a contingency fee arrangement with a client. **(1 Mark)**
- f) When can you undertake work on a matter as a trademark agent or continue work on a matter even if you do not feel you are competent to handle it? **(2 Marks)**

Question 3 (20 marks)

Your client is a manufacturer of motorboats that has well-known luxury editions referred to as "K Boats" in the marketplace. K Boats have an excellent reputation and are considered an aspirational purchase among motorboat enthusiasts. These luxury editions have several models, namely, K100, K200 and K300 (the model numbers) and each boat of these luxury edition boats has a prominent K & Design logo on the hull that is visible when the boat is in the water in addition to the model numbers. Your client has registered trademarks for K100, K200 and K300 and the K & Design logo. Recently your client became aware of another boat manufacturer that is not known for production of luxury boats that is advertising in Canada a luxury line of motorboats that it is marketing as "THE K". These boats have a unique hull design. Your client is concerned of the potential impact of THE K on its business including the

fact that a non-luxury boat manufacturer has a “K” brand in association with luxury boats. There is no evidence at this time that THE K is being manufactured or sold in Canada. **(20 Marks)**

Question 3 a)

- A. Your client would like to initiate an action for passing off in respect of its “K Boats” brand. Identify the test for statutory passing off pursuant to 7(b) of the *Trademarks Act* **(4 Marks)**
- B. How is the test for statutory passing off different from the common law test of passing off? **(2 Marks)**

Question 3 b)

- A. True or False – Your client should also pursue an action for infringement of its “K Boats” brand **(1 Mark)**
- B. Briefly explain your answer in 3 b) A. **(2 Marks)**

Question 3 c)

- A. True or False - Your client should also pursue an action for depreciation of good will of its “K Boats” brand **(1 Mark)**
- B. Briefly explain your answer in A. **(2 Marks)**

Question 3 d)

- A. Where there is a registered trademark such as K100, what is the advantage of pursuing infringement versus passing off – only the first two points will be marked? **(4 marks)**

Question 3 e)

- A. True or False – As THE K is a good i.e. a boat (as opposed to a service) it is not possible to bring an action for trademark infringement. **(1 Mark)**
- B. Briefly explain your answer in A. **(2 Marks)**
- C. True or False – A registered trademark based on the shape of a hull design of a boat can protect the utilitarian feature embodied in the trademark. **(1 Mark)**

Question 4 (49 marks)

A number of trademark opposition files, previously handled by Firm ABC, have recently been transferred to your firm. You are to assume carriage of some of these files, including a potential opposition by FFR Company Inc. to application No. 1,234,567 (the Application) for the trademark FFRTW (the Mark). You act for the opponent. The Application was filed on June 10, 2019 and was advertised in the *Trademarks Journal* dated June 25, 2021.

In reviewing the file history, you note that the initial deadline to file a statement of opposition was August 25, 2021. However, the prospective opponent, identified as FFR Co. Ltd., was granted an extension of time corresponding to the maximum under the benchmark. FFR Co. Ltd. is a wholly owned subsidiary of FFR Company Inc.

A conflict check has been conducted and no conflicts were identified.

Question 4 a): The extension of time to file the statement of opposition was requested by and granted to FFR Co. Ltd. However, FFR Company Inc. is the owner of the trademarks that are alleged to be confusing with the Mark. Is it still possible for FFR Company Inc. to be made a party to the opposition proceeding? Yes / No **[1 mark]**. Explain why/why not and cite the relevant authority **[2 marks]** **(Total: 3 marks)**

Question 4 b): Based on the information provided, what is the current deadline to file a statement of opposition in this proceeding? Provide a specific date **[1 mark]**. For the purposes of calculating this deadline, assume that December 25, 2021 falls on a Saturday. Explain how you calculated this date **[4 marks]**. Cite the relevant section of the *Trademarks Act* **[1 mark]**. **(Total: 6 marks)**

Question 4 c): In reviewing the file, you note that a draft statement of opposition has been prepared and placed on the file. The grounds of opposition as set out in the draft are reproduced below.

DRAFT STATEMENT OF OPPOSITION

To: The Registrar of Trademarks

IN THE MATTER OF an opposition by FFR Company Inc. to application No. 1,234,567 for the trademark FFRTW in the name of 16954 Canada Inc. dba Furry Friends Rule the World.

1. FFR Company Inc. (the Opponent), the full post office address of whose principal mailing address is 9998 Main Street, Ottawa, Ontario, K2Z 5T2, gives notice of opposition to the proposed registration by 16954 Canada Inc. dba Furry Friends Rule the World (the Applicant), of the trademark FFRTW (the Mark).
2. Application No. 1,234,567 (the Application) for the Mark was filed on June 10, 2019, and was advertised in the June 25, 2021 issue of the *Trademarks Journal*. The Application is based on use in Canada since January 2018 in association with the following goods and services:

Goods	Services
Nice Class 20: pet beds Nice Class 28: pet toys Nice Class 31: pet foods, POPSICLES for pets, edible pet treats	Nice Class 43: pet boarding services, pet day care services

3. All references to sections and subsections below are references to sections and subsections of the *Trademarks Act*, RSC 1985, c T-13 as amended by the *Economic Action Plan 2014 Act, No. 1* on June 17, 2019, subject to the exceptions set out in Section 69.1.
4. The Opponent is the owner of a number of registrations, in word and design format, for the trademarks FURRY FRIENDS ROCK and FFR (the FFR trademarks) in association with the goods “pet leashes, pet collars” and the services “dog walking services”. In particular, the opponent owns registration No. TMA897,665 for the word trademark FFR in association with these goods and services; this registration issued on September 15, 2017. The Opponent has been using its FFR trademarks in Canada since at least as early 2010. The Opponent also licenses use of its FFR trademarks in Canada to FFR Co. Ltd.

5. The grounds of opposition are set out as follows:

- a. Contrary to sections 38(2)(a) and 30(a) of the Act, the Application does not contain a statement in ordinary commercial terms of various of the goods or services in association with which the Mark is used.
- b. Contrary to sections 38(2)(b) and 12(1)(d) of the Act, the Mark is not registrable because it is confusing with the Opponent's registered trademark No. TMA897,665 for the trademark FFR.
- c. Contrary to section 38(2)(a.1) of the Act, the Application was filed in bad faith.
- d. The Application does not comply with section 38(2)(a.1) of the Act because the Mark is nearly identical to the Opponent's FFR trademark previously used in Canada by the Opponent, such that at the date of filing of the Application, the Applicant must have been aware of the Opponent's prior use of its trademark.
- e. Contrary to sections 38(2)(c) and 16(3)(a) of the Act, the Mark was confusing with the Opponent's trademarks FFR and FURRY FRIENDS ROCK which had been previously used in Canada by the Opponent in association with pet leashes, pet collars, and dog walking services, and which had not been abandoned at the date of advertisement of the Application.
- f. Contrary to sections 38(2)(c) and 16(1) of the Act, the Applicant is not entitled to registration of the Mark as it is confusing with the trademark FRIENDS FUR EVER previously used in Canada by Friendly Pets Inc., another competitor in the pet industry, and which had not been abandoned at the date of advertisement of the Application.
- g. Contrary to section 38(2)(c) and 16(1)(b) of the Act, the Mark is confusing with Application No. 1,111,567 for the trademark FFR previously filed in Canada by the Opponent, and which issued to registration under No. TMA897,665.
- h. Contrary to section 38(2)(c) and 16(1)(c) of the Act, the Mark is confusing with the Opponent's trade name FFR that the Opponent previously used in Canada in association with a business providing the above-referenced pet products and services.
- i. Contrary to section 38(2)(d) of the Act, the Mark is not distinctive because it is confusing with the trademarks of the Opponent and numerous other parties, including but not limited to Friendly Pets Inc.
- j. Contrary to section 38(2)(e) of the Act, at the date of filing of the Application, the Applicant was not using and did not propose to use the Mark in Canada in association with the listed goods and services. Specifically, any alleged use of the Mark by the Applicant does not constitute use pursuant to section 4 of the Act.
- k. Contrary to section 38(2)(f) of the Act, at the date of filing of the Application, the Applicant was not entitled to use the Mark because as it was in contravention of the applicable Federal animal legislation in Canada.

List the errors/issues appearing in the above grounds of opposition. Only the first 10 answers will be considered **(1 mark for each error/issue identified, to a maximum of 10)**. For each

error/issue you identify, explain what is wrong/why it is problematic **(1 mark each)**. **(Total: 20 marks)**

Question 4 d): Provide a detailed analysis on the issue of confusion between the Applicant's mark FFRTW and the Opponent's mark FFR assuming the information provided in the question is true. Address all the relevant criteria, 1 mark will also be awarded for grammatical form and coherence. **(Total: 12 marks – 11 marks for applying the test including the authority for the test – 1 mark for grammatical form and coherence)**

Question 4 e): When alleging a ground of opposition based on making known or prior use of a confusing trademark by which date must the opponent establish non abandonment of the allegedly confusing mark? **(1 Mark)**

Question 4 f): What is the material date for the ground of opposition alleging non-distinctiveness? **(1 Mark)**

Question 4 g): Provide three (3) examples of the types of evidence in an affidavit or statutory declaration that can be used to establish the use of **FFR** in association with **dog walking services**. This question is not directed to material dates. **(6 marks)**

Question 5 (6 marks)

(1 mark each) In a trademark opposition proceeding:

- a. An opponent may request an interlocutory ruling to strike portions of an applicant's counter statement (T/F)
- b. When considering the likelihood of confusion between two trademarks in an opposition proceeding, one of the surrounding circumstances to be considered in the analysis is whether the goods/services of the parties share the same Nice Classification (T/F)
- c. An applicant seeking the benchmark extension of time to complete cross-examination must, in its request, submit to the Registrar 1) the length of the extension being requested, 2) confirmation of consent from the other side, and 3) the prescribed fee of \$125 (T/F)
- d. In an opposition proceeding, it is not possible to obtain any extension of time to request a hearing. (T/F)
- e. The Registrar of Trademarks has the discretion to take judicial notice of third party trademark registrations reflecting the state of the Register raised by a party in its written representations, even if notice of these registrations was not previously raised in its evidence (T/F)
- f. In an opposition to a Protocol application, an opponent may not amend the statement of opposition to include a section 12(1)(d) ground unless the corresponding application was referenced in the statement of opposition. (T/F)

Question 6 (3 marks)

You receive a call from a new client. He tells you that he filed his trademark application by himself without prior consultation with a trademark agent. The Trademarks Office objects to the registration of the mark MORDU because it resembles a prohibited mark MORDU owned by the Canadian Broadcasting Corporation (hereinafter CBC). The client informs you that he called the law department of Canadian Broadcasting Corporation to get a consent to the registration of his mark, but it was refused. The prohibited mark has been published for more than 10 years. The client did not find use of the prohibited mark by CBC. The client saw on the CIPO website that a mark not used in the last 3 years can be expunged by way of s. 45 proceeding. He asks you to start such a proceeding.

Question 6 a): Can you file a s. 45 proceeding against a prohibited mark? Yes or No (1 mark)

Question 6 b): Explain your response together with the relevant provision (2 marks)

Question 7 (5 marks)

You represent an opponent in a trademark opposition proceeding. A few months after making representations at a hearing, you receive a decision from the Registrar of Trademarks rejecting the opposition. Your client is disappointed and is interested in appealing the decision.

Question 7 a): How long does your client have to appeal the decision of the Registrar? (1 mark) Cite the relevant section of the Act (1 mark).

Question 7 b): Your client instructs you to move forward with the preparation and filing of a notice of appeal of the Registrar's decision with the Federal Court. If you do not name the Registrar as a respondent in the notice of appeal, do you need to file the notice of appeal with the Registrar? (1 mark) Cite the relevant section of the Act (1 mark)

Question 7 c): What is the name of the Supreme Court of Canada decision which modifies the standard of review applicable to administrative decisions in Canada, including decisions of the Trademark Opposition Board? (1 mark)

Question 8 (4 marks)

On behalf of your client, you filed a s. 45 request against the trademark AVENGERS AGE OF ULTRON, TMA1056308 in association with "computer video games" and owned by Marvel Character, Inc.

You received the following affidavit:

IN THE MATTER OF s. 45 proceedings against Canadian trademark registration number TMA1056308, standing in the name of Marvel Character, Inc. for the trademark AVENGERS AGE OF ULTRON

AFFIDAVIT OF Jennifer Jones

I, Jennifer Jones, of the city of Montreal, Quebec, MAKE OATH AND SAY AS FOLLOWS:

1. I am a trademark searcher employed by the firm Trademarks Forever, agents for the Registrant, herein, a position I have held since 1998. I make this Affidavit on behalf of and with the permission of the Registrant, Marvel Character, Inc. (hereinafter "the Registrant") in support of its above noted trademark registration.

2. On September 6, 2021, in order to obtain information about the use of the Registrant's trademark, I conducted Internet searches using the Google search engines located at www.google.ca and www.google.com by entering the terms "AVENGERS AGE OF ULTRON" in the search fields (hereinafter "Google searches"). The Google Searches revealed in excess of 30,000 "hits". Now shown to me and marked as Exhibit "A" to this my affidavit are copies of the first pages of the search results from the Google searches.

3. Now shown to me and marked as Exhibit B to this affidavit are copies of web pages which were downloaded and printed on September 6, 2021 from certain websites which I personally visited from among those listed in the results of the Google Searches. There are reviews posted during the Relevant Period.

4. On September 6, 2021, I conducted searches of the Registrant's website located at www.marvel.com by entering the terms "AVENGERS AGE OF ULTRON" (hereinafter "Marvel Searches"). The Marvel Searches revealed the Registrant's goods in association with AVENGERS AGE OF ULTRON, software expansion packs and trading cards. Information on how to download the Registrant's AVENGERS AGE OF ULTRON is available on the Registrant's website. Now shown to me and marked as Exhibit "C" to this my affidavit are copies of printouts from the Marvel Searches.

5. The Registrant informed me that the goods have been sold under the mark AVENGERS AGE OF ULTRON during the Relevant Period;

The affidavit is sworn, and Jennifer Jones' signature is on the affidavit.

Question 8 a): What are your arguments to claim that the content of this affidavit is hearsay? (2 marks)

Question 8 b): What are the 2 conditions for hearsay exceptions? (2 marks)

Question 9 (7 marks)

Your client Awesome Canada inc. owns registration No. TMA111,111 for the trademark AWESOME in association with "computer sleeves". Yesterday, your client received a section 45 Notice from the Registrar in respect of this registration. Your client sends you a picture of the packaging and you note it is the name Toomuch Canada Inc. and not the name of the registrant that is printed on it. Your client informs you there is no written license of use of this mark.

Question 9 a): What information is missing on the packaging for public notification of the licence? (2 marks)

Question 9 b): In the absence of a written licence, identify the 2 other methods by which registered owner of trademarks can demonstrate the required control to benefit from the provision of section 50(1) of the Trademarks Act (2 marks).

Question 9 c): Can the licensee sign an affidavit to evidence use of the mark? Yes or No (1 mark) Explain why (2 marks).

Question 10 (16 marks)

The following questions all relate to Section 45 proceedings. For each question:

1) indicate whether the statement is TRUE or FALSE (**1 mark**) and 2) provide one reason to explain or justify your answer such a provision of the Act, the Regulations or a Practice Notice, and if none apply, then a statement in your own words (**1 mark**). (**Total:16 marks**)

- a) On an appeal of a S. 45 proceeding, the Federal Court must grant leave to authorize additional evidence to that adduced before the Registrar?
- b) A S. 45 notice can be issued for all or only some of the goods and services.
- c) A person that corresponds with the Registrar in respect of a proceeding under S. 45 must clearly indicate that the correspondence relates to that proceeding.
- d) The Registrar will send a notice informing a party of the deadline to file a request for hearing.
- e) When filing an affidavit or statutory declaration through electronic submitted evidence in S. 45 proceedings, the file name should contain the full name of affiant or declarant and the date sworn.
- f) The 3-year period for the goods and services where a registration has been amended to extend the statement of goods and services under s. 41(1)(c) is the same as for the other goods and services listed in the registration.
- g) Use shown in respect of one product is sufficient to show use in respect of other products in the same class.
- h) The absence of an indication that a statement is made under oath or statutory declaration is sufficient to render the evidence inadmissible.

TRADEMARK AGENT EXAM 2021
PART B
TOTAL MARKS: 150

Question 1 (28 marks)

On behalf of your client, your firm requested the issuance of a Section 45 Notice against the registration for the trademark MOVIN' ON UP (Registration No. TMA987,432) owned by Allan Robinson Inc. and covering the following goods and services:

Goods:

Downloadable software used to plan a residential move;
Packing supplies, namely, moving boxes, wrapping paper and clear adhesive tape;
Luggage tags;
Articles of clothing, namely, t-shirts, sweatshirts and shorts.

Services:

Residential moving services;
Providing online discussion forums pertaining to the organisation of a residential move and downsizing;
Real estate services;
Organizing meet ups allowing newcomers to an area to meet one another and to engage in cultural, sports and leisure activities; and
Online marketing services.

Two months later, you received the following affidavit from the Registrant's agent:

IN THE CANADIAN TRADEMARKS OFFICE

In the Matter of S. 45 Proceedings Regarding Registration No. TMA987,432 for the trademark MOVIN' ON UP owned by Allan Robinson Inc.

I, Allan Robinson, of the City of Halifax, Nova Scotia, hereby MAKE OATH AND SAY AS FOLLOWS:

- 1. I am the President of Movin' On Up Inc. (hereinafter "**my Company**" or "**the Registrant**") and have held this position since my Company was founded in 2013. In that capacity, I am familiar with the use of the trademark MOVIN' ON UP. I therefore have personal knowledge of, and maintain records of and/or have access to, corporate records relating to the matters to which I hereinafter depose.*
- 2. Movin' On Up Inc. was incorporated under the laws of Canada on February 14, 2013.*

3. Movin' On Up Inc. owns Canadian trademarks registration TMA987,432 ("**the Registration**") for MOVIN' ON UP ("**the Trademark**") covering the following goods and services:

Goods:

Downloadable software used to plan a residential move;

Packing supplies, namely, moving boxes, wrapping paper and clear adhesive tape;

Luggage tags;

Articles of clothing, namely, t-shirts, sweatshirts and shorts. ("**the Goods**")

Services:

Residential moving services;

Providing online discussion forums pertaining to the organisation of a residential move and downsizing;

Real estate services;

Organizing meet ups allowing newcomers to an area to meet one another and to engage in cultural, sports and leisure activities;

Online marketing services. ("**the Services**")

4. Section 45 proceedings have been commenced in respect of the Registration. The Section 45 notice is dated September 12, 2021 and, in response thereto, use of the Trademark must be shown between September 12, 2018 and September 12, 2021 ("**the Relevant Period**").

5. My Company has advertised, offered and sold the Goods and Services in Canada since February 14, 2013 when my Company was founded.

6. Originally, the Goods and Services were mainly sold in Halifax and the neighbouring areas. More recently, however, the Goods and Services have been sold in Quebec and Ontario and now British Columbia.

7. My Company currently owns a fleet of ten (10) moving trucks and employs seventy-five (75) people, including movers and office workers.

8. The Trademark is regularly used and seen by Canadians as follows.

9. The Trademark appears on the side of my Company's trucks and on the outside of its head office located in downtown Halifax.

10. Now produced, shown to me and enclosed as **Exhibits A-1 and A-2** is a photo of a moving truck, used for residential moves, on which appears the Trademark and a photo of the signage at my Company's head office on which appears the Trademark.

11. Now produced, shown to me and enclosed as a bundle as **Exhibit B** are representative samples of invoices for moving services provided to Canadians over the past three years, from September 1, 2018 to September 1, 2021. The Trademark appears on each of those invoices and those invoices were given to customers of my Company to whom moving services were sold during the Relevant Period.

12. The Trademark also appears on t-shirts and sweatshirts that are worn by the employees of my Company. Now produced, shown to me and enclosed as **Exhibit C** is a photo of two of my employees, taken in December 2020, on which the Trademark appears. The photo also shows those employees wearing a face mask on which the Trademark appears.

13. In each of 2018, 2019 and 2020, my Company gave away over 500 luggage tags as promotional items to its customers. The Trademark appears prominently on those tags. Now produced, shown to me and attached as **Exhibit D** is a photograph of one of those luggage tags. The colour scheme and font size in which the Trademark has appeared on those tags have changed over the years, but the Trademark has at all times appeared prominently on one face of the tag.

14. My Company also sells its own line of branded moving supplies, including boxes, paper and tape. The Trademark appears in association with those goods, on the boxes themselves, on the clear cellophane wrapping for the tape or on the ribbon tie used to hold bundles of paper together. Now produced, shown to me and attached as **Exhibit E** are photographs showing these various materials on which the Trademark appears. These photographs were taken in August 2021 and are representative of materials used during the Relevant Period in association with those goods. The records of my Company show that at least 1000 boxes were sold in the past 5 years. And in each of those 5 years, 750 rolls of tape and 250 bundles of paper were sold from my Company's head office in Halifax.

15. Between September 12, 2018 and September 12, 2021, my Company sold over 800 downloads to Canadian users of its residential move planning software. The words ROBINSON ALLAN MOVIN' ON UP! appear on the start-up screen. In particular, the words ROBINSON ALLAN always appear in a different colour and much smaller size than the words MOVIN' ON UP. Each consumer was charged \$0.99 to download a copy of this software. Now produced, shown to me and attached as **Exhibit F** are screenshots of the Apple store and Google Play store showing the page from which users can purchase and download the software and records showing the aggregate number of downloads by Canadians of copies of the software from each of those stores on a monthly basis for the period from September 2018 to September 2021.

16. As part of my Company's sale of moving services and move planning software, my Company offers a forum on its website, at www.movinonup.ca, where people can discuss their experiences with a move, share tips and tricks, trade goods and services amongst themselves. Access to the forum is provided free of charge. Now produced, shown to me and enclosed as **Exhibit G** is a printout dated December 18, 2019 showing a series of posts by users on the website. These posts are representative of other posts featured on the site during the course of the Relevant Period. Most if not all of the posts show clearly that the person in question is located in Canada and the Trademark is featured on the website (my Company's website) on which the forum is offered.

17. Starting in late 2019, my Company entered into an arrangement with Ms. Jane Sellers of Toronto to operate a real estate agency in Toronto called MOVIN' ON UP!. The idea is to help people in Ontario find second homes, retirement homes and the like in the province of Nova Scotia. The agency opened on January

2, 2020 and has been operating continuously since then. It has generated upwards of \$100,000 in commissions for Ms. Sellers since it first began operating. Now produced, shown to me and attached as a bundle as **Exhibit H** are copies of business cards and flyers on which the Trademark appears, along with agreements signed by Canadians with Ms. Sellers regarding her representation and on which the Trademark also appears. These representative agreements are dated between January 2, 2020 and September 15, 2021. I am pleased that my Company is able to provide these services, to attract new people to the province of Nova Scotia. But real estate is not within the area of expertise of my Company and I have taken a rather “hands off” approach to the manner in which those services are carried out.

18. My Company has, however, taken a more “hands on” approach to helping customers get to know one another by providing meet ups at which people can get together and engage in activities of mutual interest. Because many of my customers spend their winter in Florida, and it is often there that they are looking to meet new people, these meet ups have been organised in Florida, with the first meet up having taken place in March 2019, and then each month thereafter, though not taking place from June to August of every year. Now produced, shown to me and attached as **Exhibit I** is an advertisement that appeared in at least five different magazines that circulate in Canada and are directed at seniors. This advertisement features the trademark MOVIN’ ON UP!, with the tag line, AND MEETIN’ ON UP! Further enclosed as part of Exhibit H is the cover page for each of the five publications in which this advertisement appeared, showing a publication date between September 12, 2019 and September 12, 2021.

19. Finally, my Company has, over the years, created a small marketing division which is devoted to looking at new ways to offer our residential moving services. This division regularly conducts online surveys on which the Trademark is featured. In fact, a survey was conducted in February 2020. In the course of that survey, over 250 customers viewed the survey page, on which the Trademark does appear. Now produced, shown to me and attached as **Exhibit J** are copies of the web pages featured on my Company’s website during the month of February 2020, and a list of expenses, other than staff salaries, that were incurred to allow my Company to run this survey.

20. 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, 2021

(Q1) For each of the Goods and Services, advise your client as to whether the registration will be maintained or expunged **(1 mark)** and give reasons to support your answer **[total of 28 marks]**

- Downloadable software used to plan a residential move **(1 mark + 3 marks for reasons)**
- Packing supplies, namely, moving boxes, wrapping paper and clear adhesive tape **(1 mark + 3 marks for reasons)**
- Luggage tags **(1 mark + 2 marks for reasons)**
- Articles of clothing, namely, t-shirts, sweatshirts and shorts **(1 mark + 2 marks for reasons)**
- Residential moving services **(1 mark + 3 marks for reasons)**

- Providing online discussion forum pertaining to the organisation of a residential move and downsizing **(1 mark + 2 marks for reasons)**
- Real estate services **(1 mark + 2 marks for reasons)**
- Organizing meet ups allowing newcomers to an area to meet one another and to engage in cultural, sports and leisure activities **(1 mark + 1 mark for reason)**
- Online marketing services **(1 mark + 1 mark for reasons)**

Answer: (Q1)

Downloadable software used to plan a residential move (1 mark + 3 marks for reasons):
 Maintained (1). The affidavit is clear that these goods were sold to Canadians during the Relevant Period. (1) The Trademark does appear clearly in association with the goods. (1) The additional words ROBINSON ALLAN appear next to the Trademark but in a different font/smaller size. This allows the Trademark to stand out and to be considered to have been used on its own.

Packing supplies, namely, moving boxes, wrapping paper and clear adhesive tape (1 mark + 3 marks for reasons):

Wrapping paper and tape will be maintained (1). Point awarded for saying Maintained without specifying wrapping paper/tape. It is clear that the Trademark appears in association with those goods and that some of those goods were sold during the Relevant Period (1). Moving boxes will be deleted (1). The affidavit is ambiguous as to when those boxes were sold and it could be that all of them were sold in the two-year period before the start of the Relevant Period (1). Deletion is part of the reasons

Luggage tags (1 mark + 2 marks for reasons):

Deleted (1). The affidavit does not show that those goods were sold (candidate must indicate that there is no use shown in the affidavit) (1) and the fact that the goods were given away (to promote the Registrant's services) does not count as "use" of the mark with those goods (1).

Articles of clothing, namely, t-shirts, sweatshirts and shorts (1 mark + 2 marks for reasons):

Deleted (1). The affidavit does not show that those goods were sold in the normal course of trade (candidate must indicate that there is no use in the affidavit) (1) The employees are not said to have paid to obtain possession of the clothing items shown in the photo (1).-

Residential moving services (1 mark + 3 marks for reasons):

Maintained (1). The affidavit is clear that those services were offered during the Relevant Period candidate must indicate that there is use in the affidavit) (1) and the affidavit shows that the Trademark appeared in the advertising (trucks at headquarter signage) (1) and/or performance (invoices) of those services (1).

Providing online discussion forum pertaining to the organisation of a residential move and downsizing (1 mark + 2 marks for reasons):

Maintained (1). The Trademark appears on the website on which the forum is hosted (1) and the affidavit makes clear that the persons posting are based in Canada (1).

Real estate services (1 mark + 2 marks for reasons):

Deleted (1). The affidavit states that the Trademark is used under license (1), but there is

no discussion making clear that the Registrant controls the character and quality of the services that are offered (1).

Organizing meet ups allowing newcomers to an area to meet one another and to engage in cultural, sports and leisure activities (1 mark + 1 marks for reason):

Deleted (1). The services are advertised in Canada but only performed in the U.S. (1)

Online marketing services (1 mark + 1 mark for reasons):

Deleted (1). These services are only offered internally and not in the normal course of trade (1). stating no use is not sufficient as a reason; mark would be awarded by stating either survey was offered internally or not in the normal course of trade

Question 2 (12 Marks)

- a) You have received payment in advance from a client for filing a trademark application including the government fee. You have filed the trademark application and reported it to the client.

(Q2) Are you now able to use the funds to directly pay other expenses of your firm?
Yes or No **(1 Mark)**

(Q3) Briefly explain your answer above **(1 Mark)**

Answer:

(Q2) No;

(Q3) You may not use the funds held to the credit of a client until you issue an invoice.

Or:

The funds held in trust belong to the client and can only be used to pay the client's invoice for filing the trademark application (or used for whatever else the client directs)

- b) You have been provided an estimate by a private investigator of \$1,500 plus HST for collecting evidence relevant to opposition proceeding in which represent the opponent.

(Q4) Are you permitted to list the private investigator's estimate as a disbursement on your next invoice to the client? Yes or No **(1 Mark)**

(Q5) Briefly explain your answer above: **(1 Mark)**

Answer:

(Q4) No;

(Q5) You may not list a disbursement on an invoice if it has not been paid to the third party (i.e., the private investigator)

- c) Your new practice is rapidly expanding, and you need additional help to meet your clients' obligations. You do not have time to hire another employee and will have a trademark agent at another firm assist you with some of your files. Assume that the other agent does not have a conflict. (Q6) List the two (2) requirements for you to share the fees received from your clients with the other agent? **(2 Marks)**

Answer: (Q6)

The client must consent.

The fees are divided in proportion to the work done and the responsibilities assumed.

Rule is set out below:

6 If the client consents, fees for any matter may be shared by the agent with another agent or a legal counsel who is not a partner or associate in the same firm as the agent if the fees are divided in proportion to the work done and the responsibilities assumed.

- d) (Q7) List the requirements that you need to meet as trademark agent if you require payment before commencing work for a client **(3 Marks)**

Answer: (Q7)

Confirm with the client in writing the amount and purpose of the payment

Confirm in writing the consequences in the delay in making the payment

Confirm in writing the consequence in the delay in the commencement of the work including any possible loss of rights.

- e) (Q8) True or False – A trademark agent may enter into a contingency fee arrangement with a client. **(1 Mark)**

Answer:

(Q8) True

- f) (Q9) When can you undertake work on a matter as a trademark agent or continue work on a matter even if you do not feel you are competent to handle it? **(2 Marks)**

Answer: (Q9)

If you believe that you could become competent to do so without undue delay, risk or expense to the client (1 Mark) and without associating with another agent who is competent to handle the matter (1 Mark).

Question 3 (20 marks)

Your client is a manufacturer of motorboats that has well-known luxury editions referred to as “K Boats” in the marketplace. K Boats have an excellent reputation and are considered an aspirational purchase among motorboat enthusiasts. These luxury editions have several models, namely, K100, K200 and K300 (the model numbers) and each boat of these luxury edition boats has a prominent K & Design logo on the hull that is visible when the boat is in the water in addition to the model numbers. Your client has registered trademarks for K100, K200 and K300 and the K & Design logo. Recently your client became aware of another boat manufacturer that is not known for production of luxury boats that is advertising in Canada a luxury line of motorboats that it is marketing as “THE K”. These boats have a unique hull design. Your client is concerned of the potential impact of THE K on its business including the fact that a non-luxury boat manufacturer has a “K” brand in association with luxury boats. There is no evidence at this time that THE K is being manufactured or sold in Canada. **(20 Marks)**

Question 3 a)

- A. (Q10) Your client would like to initiate an action for passing off in respect of its “K Boats” brand. Identify the test for statutory passing off pursuant to 7(b) of the *Trademarks Act* (4 Marks)

Answer: (Q10)

1. A valid and enforceable trademark, whether registered or unregistered.
2. The existence of goodwill
3. Deception of the public due to a misrepresentation
4. Actual or potential damage to the plaintiff

- B. (Q11) How is the test for statutory passing off different from the common law test of passing off? (2 Marks)

Answer: (Q11)

You do not need a valid and enforceable trademark in common law passing off, whether registered or unregistered. OR Statutory passing off only applies to what is considered a “trademark” under the TMA.

Question 3 b)

- A. (Q12) True or False - Your client should also pursue an action for infringement of its “K Boats” brand (1 Mark)

Answer:

(Q12) True

- B. (Q13) Briefly explain your answer in 3 b) A. (2 Marks)

Answer: (Q13)

You need a registered trademark to pursue an action for infringement (2 marks)

Question 3 c)

- A. (Q14) True or False - Your client should also pursue an action for depreciation of good will of its “K Boats” brand (1 Mark)

Answer:

(Q14) False

- B. (Q15) Briefly explain your answer in A. (2 Marks)

Answer: (Q15)

You need a registered trademark to pursue an action for depreciation of goodwill or

Depreciation of goodwill under s. 22 requires a registered trademark; client does not have a registered trademark in "K Boats"

Question 3 d)

- A. (Q16) Where there is a registered trademark such as K100, what is the advantage of pursuing infringement versus passing off – only the first two points will be marked? (4 marks)

Answer: (Q16)

1. Passing off requires considerable evidence to prove the cause of action OR prove of goodwill.

2. A registered trademark has a presumption of validity

3. Damage does need to be proven in a passing off action

4. Infringement is not geographically limited within Canada or passing off is based on reputation within a geographical area

Question 3 e)

- A. (Q17) True or False – As THE K is a good i.e. a boat (as opposed to a service) it is not possible to bring an action for trademark infringement. (1 Mark)

Answer:

(Q17) False

- B. (Q18) Briefly explain your answer in A. (2 Marks)

Answer: (Q18)

An advertisement that uses a registered trademark, even if the good is not being manufactured or sold can give rise to an action for infringement. or

Trademark infringement does not require "use" of a trademark. Section 20 states that it is trademark infringement to advertise any goods or services in association with a confusing trademark.

- C. (Q19) TRUE of False – A registered trademark based on the shape of a hull design of a boat can protect the utilitarian feature embodied in the trademark. (1 Mark)

Answer:

(Q19) False

Question 4 (49 marks)

A number of trademark opposition files, previously handled by Firm ABC, have recently been transferred to your firm. You are to assume carriage of some of these files, including a potential opposition by FFR Company Inc. to application No. 1,234,567 (the Application) for the trademark FFRTW (the Mark). You act for the opponent. The Application was filed on June 10, 2019 and was advertised in the *Trademarks Journal* dated June 25, 2021.

In reviewing the file history, you note that the initial deadline to file a statement of opposition was August 25, 2021. However, the prospective opponent, identified as FFR Co. Ltd., was granted an extension of time corresponding to the maximum under the benchmark. FFR Co. Ltd. is a wholly owned subsidiary of FFR Company Inc.

A conflict check has been conducted and no conflicts were identified.

Question 4 a): The extension of time to file the statement of opposition was requested by and granted to FFR Co. Ltd. However, FFR Company Inc. is the owner of the trademarks that are alleged to be confusing with the Mark. (Q20) Is it still possible for FFR Company Inc. to be made a party to the opposition proceeding? Yes / No [1 mark]. (Q21) Explain why/why not and cite the relevant authority [2 marks] (Total: 3 marks)

ANSWER:

(Q20) Yes

(Q21) add/name FFR Company Inc. jointly as opponent along with FFR Co. Ltd.

Authority is the Practice Notice.

Question 4 b): (Q22) Based on the information provided, what is the current deadline to file a statement of opposition in this proceeding? Provide a specific date [1 mark]. For the purposes of calculating this deadline, assume that December 25, 2021 falls on a Saturday. Explain how you calculated this date [4 marks]. Cite the relevant section of the *Trademarks Act* [1 mark]. (Total: 6 marks)

Answer: (Q22)

December 29, 2021 [1 mark]

1 mark for noting that the maximum benchmark granted was 4 months long (bringing the date from August 25/21 to December 25/21) need to mention the benchmark extension to get 1 mark

1 mark for noting December 25 is a prescribed day so the deadline would fall on the next day

1 mark for noting December 26 is a prescribed day so the deadline would fall on the next day

1 mark for noting that if December 25 falls on a Saturday or Sunday, then the following Monday and Tuesday are prescribed days, bringing us to a deadline of Wednesday, December 29, 2021.

Section 66(1) of the TMA [1 mark] Answer to TMR would not be accepted as correct

Question 4 c): In reviewing the file, you note that a draft statement of opposition has been prepared and placed on the file. The grounds of opposition as set out in the draft are reproduced below.

DRAFT STATEMENT OF OPPOSITION

To: The Registrar of Trademarks

IN THE MATTER OF an opposition by FFR Company Inc. to application No. 1,234,567 for the trademark FFRTW in the name of 16954 Canada Inc. dba Furry Friends Rule the World.

1. FFR Company Inc. (the Opponent), the full post office address of whose principal mailing address is 9998 Main Street, Ottawa, Ontario, K2Z 5T2, gives notice of opposition to the proposed registration by 16954 Canada Inc. dba Furry Friends Rule the World (the Applicant), of the trademark FFRTW (the Mark).
2. Application No. 1,234,567 (the Application) for the Mark was filed on June 10, 2019, and was advertised in the June 25, 2021 issue of the *Trademarks Journal*. The Application is based on use in Canada since January 2018 in association with the following goods and services:

Goods	Services
Nice Class 20: pet beds Nice Class 28: pet toys Nice Class 31: pet foods, POPSICLES for pets, edible pet treats	Nice Class 43: pet boarding services, pet day care services

3. All references to sections and subsections below are references to sections and subsections of the *Trademarks Act*, RSC 1985, c T-13 as amended by the *Economic Action Plan 2014 Act, No. 1* on June 17, 2019, subject to the exceptions set out in Section 69.1.
4. The Opponent is the owner of a number of registrations, in word and design format, for the trademarks FURRY FRIENDS ROCK and FFR (the FFR trademarks) in association with the goods “pet leashes, pet collars” and the services “dog walking services”. In particular, the opponent owns registration No. TMA897,665 for the word trademark FFR in association with these goods and services; this registration issued on September 15, 2017. The Opponent has been using its FFR trademarks in Canada since at least as early 2010. The Opponent also licenses use of its FFR trademarks in Canada to FFR Co. Ltd.
5. The grounds of opposition are set out as follows:
 - a. Contrary to sections 38(2)(a) and 30(a) of the Act, the Application does not contain a statement in ordinary commercial terms of various of the goods or services in association with which the Mark is used.
 - b. Contrary to sections 38(2)(b) and 12(1)(d) of the Act, the Mark is not registrable because it is confusing with the Opponent’s registered trademark No. TMA897,665 for the trademark FFR.
 - c. Contrary to section 38(2)(a.1) of the Act, the Application was filed in bad faith.

- d. The Application does not comply with section 38(2)(a.1) of the Act because the Mark is nearly identical to the Opponent's FFR trademark previously used in Canada by the Opponent, such that at the date of filing of the Application, the Applicant must have been aware of the Opponent's prior use of its trademark.
- e. Contrary to sections 38(2)(c) and 16(3)(a) of the Act, the Mark was confusing with the Opponent's trademarks FFR and FURRY FRIENDS ROCK which had been previously used in Canada by the Opponent in association with pet leashes, pet collars, and dog walking services, and which had not been abandoned at the date of advertisement of the Application.
- f. Contrary to sections 38(2)(c) and 16(1) of the Act, the Applicant is not entitled to registration of the Mark as it is confusing with the trademark FRIENDS FUR EVER previously used in Canada by Friendly Pets Inc., another competitor in the pet industry, and which had not been abandoned at the date of advertisement of the Application.
- g. Contrary to section 38(2)(c) and 16(1)(b) of the Act, the Mark is confusing with Application No. 1,111,567 for the trademark FFR previously filed in Canada by the Opponent, and which issued to registration under No. TMA897,665.
- h. Contrary to section 38(2)(c) and 16(1)(c) of the Act, the Mark is confusing with the Opponent's trade name FFR that the Opponent previously used in Canada in association with a business providing the above-referenced pet products and services.
- i. Contrary to section 38(2)(d) of the Act, the Mark is not distinctive because it is confusing with the trademarks of the Opponent and numerous other parties, including but not limited to Friendly Pets Inc.
- j. Contrary to section 38(2)(e) of the Act, at the date of filing of the Application, the Applicant was not using and did not propose to use the Mark in Canada in association with the listed goods and services. Specifically, any alleged use of the Mark by the Applicant does not constitute use pursuant to section 4 of the Act.
- k. Contrary to section 38(2)(f) of the Act, at the date of filing of the Application, the Applicant was not entitled to use the Mark because as it was in contravention of the applicable Federal animal legislation in Canada.

(Q23) List the errors/issues appearing in the above grounds of opposition. Only the first 10 answers will be considered **(1 mark for each error/issue identified, to a maximum of 10)**. For each error/issue you identify, explain what is wrong/why it is problematic **(1 mark each)**. **(Total: 20 marks)**

Answer: (Q23)

1. The grounds of opposition are set out as follows:

- a. Contrary to sections 38(2)(a) and 30(a) of the Act, the Application does not contain a statement in ordinary commercial terms of various of the goods or services in association with which the Mark is used.

Issue/error #1: **should not be reference to 30(a).**
 What/why? **should refer instead to section 30(2)(a).**

Issue/error #2: reference to “various of the goods”

What/why? The only good at issue is “Popsicles for pets”. POPSICLE is a registered trademark and so would not be a description in ordinary commercial terms on that basis. OR “Various of the goods” must be further specified.

- b. Contrary to sections 38(2)(b) and 12(1)(d) of the Act, the Mark is not registrable because it is confusing with the Opponent’s registered trademark No. 897,665 for the trademark FFR.
- c. Contrary to section 38(2)(a.1) of the Act, the Application was filed in bad faith.

Issue/error #3: ground as drafted refers only to “bad faith”

What/why? The ground as pleaded does not contain sufficient material facts to enable the Applicant to reply.

- d. The Application does not comply with section 38(2)(a.1) of the Act because the Mark is nearly identical to the Opponent’s FFR trademark previously used in Canada by the opponent, such that at the date of filing of the Application, the Applicant must have been aware of the Opponent’s prior use of its trademark.

Issue/error #4: alleges an improper ground of opposition

What/why? The facts pleaded (mere awareness) do not constitute bad faith.

- e. Contrary to sections 38(2)(c) and 16(3)(a) of the Act, the Mark was confusing with the Opponent’s trademarks FFR and FURRY FRIENDS ROCK which had been previously used in Canada by the Opponent in association with pet leashes, pet collars, and dog walking services, and which had not been abandoned at the date of advertisement of the Application.

Issue/error #5: incorrect reference to subsection.

What/why? Should be section 16(1)(a)

- f. Contrary to sections 38(2)(c) and 16(1) of the Act, the Applicant is not entitled to registration of the Mark as it is confusing with the trademark FRIENDS FUR EVER previously used in Canada by Friendly Pets Inc., another competitor in the pet industry, and which had not been abandoned at the date of advertisement of the Application.

Issue/error #6: incomplete reference to the section

What/why? Should refer to section 16(1)(a)

Issue/error #7: improper ground of opposition

What/why? An opponent cannot rely on the use of a mark by any person other than itself or its predecessor in title.

- g. Contrary to section 38(2)(c) and 16(1)(b), the Mark is confusing with Application No. 1,111,567 for the trademark FFR previously filed in Canada by the opponent, and which subsequently issued to registration under No. TMA897,665.

Issue/error #8: improper ground of opposition

What/why? Section 16(2) – the Opponent's application was not pending on the date of advertisement of the Application OR mark would be awarded for indicating that a registered mark should not be associated with the s.16(1)(b) ground

h. Contrary to section 38(2)(c) and 16(1)(c) of the Act, the Mark is confusing with the Opponent's trade name FFR that the Opponent previously used in Canada in association with a business providing the above-referenced pet products and services.

i. Contrary to section 38(2)(d) of the Act, the Mark is not distinctive because it is confusing with the trademarks of the Opponent and numerous other parties, including but not limited to Friendly Pets Inc.

Issue/error #9: does not contain sufficient material facts OR vague and ambiguous

What/why? A complete list of the "numerous other parties" is not provided.

j. Contrary to section 38(2)(e) of the Act, at the date of filing of the Application, the Applicant was not using and did not propose to use the Mark in Canada in association with the listed goods and services. Specifically, any alleged use of the Mark by the Applicant does not constitute use pursuant to section 4 of the Act.

k. Contrary to section 38(2)(f) of the Act, at the date of filing of the Application, the Applicant was not entitled to use the Mark because as it was in contravention of the applicable Federal animal legislation in Canada.

Issue/error #10: does not contain sufficient material facts OR vague and ambiguous

What/why? Should identify the specific Federal legislation.

Question 4 d): (Q24) Provide a detailed analysis on the issue of confusion between the Applicant's mark FFRTW and the Opponent's mark FFR assuming the information provided in the question is true. Address all the relevant criteria, 1 mark will also be awarded for grammatical form and coherence. **(Total: 12 marks – 11 marks for applying the test including the authority for the test – 1 mark for grammatical form and coherence)**

Answer: (Q24)

Test – Section 6(5) of the Trademarks Act (1 Mark)

- **(a) the inherent distinctiveness of the trademarks or trade names and the extent to which they have become known;**

Both marks have limited/low inherent distinctiveness (1 mark) as they are abbreviations/letters/initials for the longform of their respective trademarks (1 Mark)
or

Both marks are acronyms (1 mark) and therefore are considered to be inherently weak (1 mark). However, inherently weak marks can acquire distinctiveness through use.

The opponent has used its mark since at least as early as 2010, whereas the applicant has used its mark only since 2018.

- (b) the length of time the trademarks or trade names have been in use;

The Applicant's mark is alleged to be used since 2018 and the Opponent's mark is alleged to be used since 2010 which is an argument to support a finding of confusion in favour of the Opponent **(2 Marks)** OR 2 marks awarded for recognizing that Opponent has extensive/much longer use or mention the dates. Not sufficient to just mention that it is longer.

- (c) the nature of the goods, services or business;

While the goods of the two marks are not identical, both marks are used for goods and services related to pets which is an argument to support a finding of confusion. **(2 marks)** - 1 mark for mentioning that goods/services are similar; 1 mark for indicating that goods/services are related to pets)

- (d) the nature of the trade;

While the goods and services of the two marks are not identical, both marks are used for goods and services where the ultimate consumers are individual pet owners which is an argument to support a finding of confusion. **(2 Marks)** candidate must indicate that the consumers are pet owners, similar target market, or potential customers

- (e) the degree of resemblance between the trademarks or trade names, including in appearance or sound or in the ideas suggested by them.

The opposed mark incorporates the entirety of the cited mark, which is an argument to support a finding of confusion in favour of the opponent. (1 mark) OR
The first two letters of each mark are identical (1 mark) and an abbreviation/acronym for Furry Friends (1 mark) which is an argument to support a finding of confusion as the first part of the mark is the most important OR
Additionally, since the respective marks are acronyms for terms featuring the words "fur" and "friends", they are similar in ideas suggested (1 mark). This factor favours the opponent. **(up to a maximum of 2 Marks for this factor s.6(5)(e))**

Other surrounding circumstances:

The fact that other competitors are using the terms "fur" and "friends" as part of their trademarks, somewhat reduces the likelihood of confusion between the marks because consumers are presumably accustomed to encountering marks featuring these terms and are therefore capable of distinguishing among them and their sources by relying on small differences OR State of the register

(Maximum 1 mark can be awarded for mentioning an additional surrounding circumstance, up to a total of 10 marks for applying the s. 6(5) factors)

1 Mark - grammatical form and coherence

Question 4 e): (Q25) When alleging a ground of opposition based on making known or prior use of a confusing trademark by which date must the opponent establish non abandonment of the allegedly confusing mark? **(1 Mark)**

Answer: (Q25)

The date of advertisement of the applicant's application

Question 4 f): (Q26) What is the material date for the ground of opposition alleging non-distinctiveness? **(1 Mark)**

Answer: (Q26)

Date of the filing of the statement of opposition

Question 4 g): (Q27) Provide three (3) examples of the types of evidence in an affidavit or statutory declaration that can be used to establish the use of **FFR** in association with **dog walking services**. This question is not directed to material dates. **(6 marks)**

Answer: (Q27)

(any similar examples are acceptable):

A photograph of a store front of the opponent with FFR in stylized prominent text and a list of services including dog walking services. **2 marks**

A screen capture of the opponent's website with FFR in prominent stylized text and a list of services including dog walking services. **2 marks**

A photograph of a jacket with FFR in prominent stylized text and a statement in the affidavit that all employees of the opponent wear this type of jacket with the styled text while engaging in dog walking services. or any items of clothing bearing the mark worn by employees while they are carrying out the services. **2 marks**

Any advertising in association with dog walking services – **2 marks**

Sales figures and samples of advertising/or invoices displaying the mark, would be acceptable. Sales figures on its own is not acceptable – **2 marks**

Question 5 (6 marks)

(1 mark each) In a trademark opposition proceeding:

- a. (Q28) An opponent may request an interlocutory ruling to strike portions of an applicant's counter statement (T/F)
- b. (Q29) When considering the likelihood of confusion between two trademarks in an opposition proceeding, one of the surrounding circumstances to be considered in the analysis is whether the goods/services of the parties share the same Nice Classification (T/F)
- c. (Q30) An applicant seeking the benchmark extension of time to complete cross-examination must, in its request, submit to the Registrar 1) the length of the extension being requested, 2) confirmation of consent from the other side, and 3) the prescribed fee of \$125 (T/F)
- d. (Q31) In an opposition proceeding, it is not possible to obtain any extension of time to request a hearing. (T/F)
- e. (Q32) The Registrar of Trademarks has the discretion to take judicial notice of third party trademark registrations reflecting the state of the Register raised by a party in its written representations, even if notice of these registrations was not previously raised in its evidence (T/F)
- f. (Q33) In an opposition to a Protocol application, an opponent may not amend the statement of opposition to include a section 12(1)(d) ground unless the corresponding application was referenced in the statement of opposition. (T/F)

Answers:

- a. (Q28) False
- b. (Q29) False
- c. (Q30) False
- d. (Q31) True
- e. (Q32) False
- f. (Q33) True

Question 6 (3 marks)

You receive a call from a new client. He tells you that he filed his trademark application by himself without prior consultation with a trademark agent. The Trademarks Office objects to the registration of the mark MORDU because it resembles a prohibited mark MORDU owned by the Canadian Broadcasting Corporation (hereinafter CBC). The client informs you that he called the law department of Canadian Broadcasting Corporation to get a consent to the registration of his mark, but it was refused. The prohibited mark has been published for more than 10 years. The client did not find use of the prohibited mark by CBC. The client saw on the CIPO website that a mark not used in the last 3 years can be expunged by way of s. 45 proceeding. He asks you to start such a proceeding.

Question 6 a): (Q34) Can you file a s. 45 proceeding against a prohibited mark? Yes or No **(1 mark)**

Answer:
(Q34) No

Question 6 b): (Q35) Explain your response together with the relevant provision **(2 marks)**

Answer: (Q35)
A section 45 proceeding can only be filed against a registered mark (1 mark) section 45 (1)
OR s. 45 and s. 2 “trademarks”

Question 7 (5 marks)

You represent an opponent in a trademark opposition proceeding. A few months after making representations at a hearing, you receive a decision from the Registrar of Trademarks rejecting the opposition. Your client is disappointed and is interested in appealing the decision.

Question 7 a): (Q36) How long does your client have to appeal the decision of the Registrar? **(1 mark)** Cite the relevant section of the Act **(1 mark)**.

Answer: (Q36)
[2 months from the date on which notice of the decision was dispatched by the Registrar, section 56(1) of the TMA] OR 2 months but not if the answer is inaccurate such as 2 months from the date of the decision

Question 7 b): Your client instructs you to move forward with the preparation and filing of a notice of appeal of the Registrar’s decision with the Federal Court. (Q37) If you do not name the Registrar as a respondent in the notice of appeal, do you need to file the notice of appeal with the Registrar? **(1 mark)** (Q38) Cite the relevant section of the Act **(1 mark)**

Answer:
(Q37) Yes. (Q38) Section 56(2) of the TMA

Question 7 c): (Q39) What is the name of the Supreme Court of Canada decision which modifies the standard of review applicable to administrative decisions in Canada, including decisions of the Trademark Opposition Board? **(1 mark)**

Answer: (Q39)
[Canada (Minister of Citizenship and Immigration) v Vavilov, 2019 SCC 65. Would accept Vavilov instead of full cite]

Question 8 (4 marks)

On behalf of your client, you filed a s. 45 request against the trademark AVENGERS AGE OF ULTRON, TMA1056308 in association with “computer video games” and owned by Marvel Character, Inc.

You received the following affidavit:

IN THE MATTER OF s. 45 proceedings against Canadian trademark registration number TMA1056308, standing in the name of Marvel Character, Inc. for the trademark AVENGERS AGE OF ULTRON

AFFIDAVIT OF Jennifer Jones

I, Jennifer Jones, of the city of Montreal, Quebec, MAKE OATH AND SAY AS FOLLOWS:

1. I am a trademark searcher employed by the firm Trademarks Forever, agents for the Registrant, herein, a position I have held since 1998. I make this Affidavit on behalf of and with the permission of the Registrant, Marvel Character, Inc. (hereinafter “the Registrant”) in support of its above noted trademark registration.
2. On September 6, 2021, in order to obtain information about the use of the Registrant’s trademark, I conducted Internet searches using the Google search engines located at www.google.ca and www.google.com by entering the terms “AVENGERS AGE OF ULTRON” in the search fields (hereinafter “Google searches”). The Google Searches revealed in excess of 30,000 “hits”. Now shown to me and marked as Exhibit “A” to this my affidavit are copies of the first pages of the search results from the Google searches.
3. Now shown to me and marked as Exhibit B to this affidavit are copies of web pages which were downloaded and printed on September 6, 2021 from certain websites which I personally visited from among those listed in the results of the Google Searches. There are reviews posted during the Relevant Period.
4. On September 6, 2021, I conducted searches of the Registrant’s website located at www.marvel.com by entering the terms “AVENGERS AGE OF ULTRON” (hereinafter “Marvel Searches”). The Marvel Searches revealed the Registrant’s goods in association with AVENGERS AGE OF ULTRON, software expansion packs and trading cards. Information on how to download the Registrant’s AVENGERS AGE OF ULTRON is available on the Registrant’s website. Now shown to me and marked as Exhibit “C” to this my affidavit are copies of printouts from the Marvel Searches.
5. The Registrant informed me that the goods have been sold under the mark AVENGER AGE OF ULTRON during the Relevant Period;

The affidavit is sworn, and Jennifer Jones’ signature is on the affidavit.

Question 8 a): (Q40) What are your arguments to claim that the content of this affidavit is hearsay? **(2 marks)**

Answer: (Q40)

(1 mark) Even if Ms. Jones states that she has made her affidavit on behalf and with the owner's permission, Ms. Jones is not in a position to confirm the accuracy of sales of the goods during the Relevant Period; OR stating that Ms. Jones was informed

(1 mark) No reasons were given in the affidavit as to why a person having direct knowledge of sales during the Relevant Period could not have provided such evidence;

Question 8 b): (Q41) What are the 2 conditions for hearsay exceptions? **(2 marks)**

Answer: (Q41)

(1 mark) reliability

(1 mark) necessity

Question 9 (7 marks)

Your client Awesome Canada inc. owns registration No. TMA111,111 for the trademark AWESOME in association with "computer sleeves". Yesterday, your client received a section 45 Notice from the Registrar in respect of this registration. Your client sends you a picture of the packaging and you note it is the name Toomuch Canada Inc. and not the name of the registrant that is printed on it. Your client informs you there is no written license of use of this mark.

Question 9 a): (Q42) What information is missing on the packaging for public notification of the licence? **(2 marks)**

Answer: (Q42) Licensed use (1 mark) and name of the owner (1 mark)

Question 9 b): (Q43) In the absence of a written licence, identify the 2 other methods by which registered owner of trademarks can demonstrate the required control to benefit from the provision of section 50(1) of the Trademarks Act **(2 marks)**.

Answer: (Q43)

(1 mark) clearly swear to the fact the owner exerts the requisite control; (1 mark) provide evidence that demonstrates the owner exerts the requisite control (1 mark);

Question 9 c): (Q44) Can the licensee sign an affidavit to evidence use of the mark? Yes or No **(1 mark)** (Q45) Explain why **(2 marks)**.

Answer:

(Q44) Yes.

(Q45) 1) there is nothing in the Trademarks Act or the case law prohibiting the filing of affidavit from the licensee (1 mark) but the affiant must have personal knowledge of the facts (1 mark)

Question 10 (16 marks)

The following questions all relate to Section 45 proceedings. For each question:

1) indicate whether the statement is TRUE or FALSE **(1 mark)** and 2) provide one reason to explain or justify your answer such a provision of the Act, the Regulations or a Practice Notice, and if none apply, then a statement in your own words **(1 mark)**. **(Total:16 marks)**

- a) (Q46) On an appeal of a S. 45 proceeding, the Federal Court must grant leave to authorize additional evidence to that adduced before the Registrar?
- b) (Q48) A S. 45 notice can be issued for all or only some of the goods and services.
- c) (Q50) A person that corresponds with the Registrar in respect of a proceeding under S. 45 must clearly indicate that the correspondence relates to that proceeding.
- d) (Q52) The Registrar will send a notice informing a party of the deadline to file a request for hearing.
- e) (Q54) When filing an affidavit or statutory declaration through electronic submitted evidence in S. 45 proceedings, the file name should contain the full name of affiant or declarant and the date sworn.
- f) (Q56) The 3-year period for the goods and services where a registration has been amended to extend the statement of goods and services under s. 41(1)(c) is the same as for the other goods and services listed in the registration.
- g) (Q58) Use shown in respect of one product is sufficient to show use in respect of other products in the same class.
- h) (Q60) The absence of an indication that a statement is made under oath or statutory declaration is sufficient to render the evidence inadmissible.

Answer:

- a) (Q46) False (1 mark) (Q47) S. 56(5) Act (1 mark) (amendment not in force);
- b) (Q48) Answer: True (1 mark) (Q49) S. 45(1) Act (1 mark)
- c) (Q50) True (1 mark) (Q51) S. 68 TM Regulations OR Practice Notice of S. 45 (just Practice Notice is not sufficient) (1 mark)
- d) (Q52) False (1 mark) (Q53) reference to S. 74(2) TM Regulations, the party must calculate the date (1 mark)
- e) (Q54) True. (1 mark) (Q55) The Practice notice on electronic evidence in opposition and section 45. (just Practice Notice is not sufficient) (1 mark)
- f) (Q56) False (1 mark) (Q57) reference to S. 41(2) of the Act or reference to the Practice Notice of S. 45 (just Practice Notice is not sufficient) (1 mark).

- g) (Q58) False (1 mark) (Q59) while evidentiary overkill is not required and representative evidence can be furnished in section 45 proceedings, the registered owner must still establish a *prima facie* case of use of the trademark in association with *each* of the goods and services specified in the registration or reference to the Practice Notice of S. 45 (just Practice Notice is not sufficient) (1 mark)
- h) (Q60) True (1 mark) (Q61) S. 45(1) Act states clearly that the registered owner must furnish an affidavit or a statutory declaration (1 mark). Or 45(2)TMA