

**TRADEMARK AGENT EXAM 2022**  
**PART A**  
**TOTAL MARKS: 150**

Underlined words must be provided in candidate response to get the mark, as noted.

**Question 1 (21marks)**

For each of the following trademarks, advise whether the mark is registrable or not registrable for the associated goods or services (**1 mark**) and why (**1 mark**). Cite the provision or provisions of the relevant legislation regarding trademarks in support of your reason and any authority to complete your response. (**1 mark for each provision and each authority, if any**). Please ignore any confusion issues and do not assume acquired distinctiveness.

- a. (Q1) WILDLIFE SAMBUCA in association with “spirits” (**4 marks**)
- b. (Q2) QUICK CONNECT in association with “electrical connectors for cable” (**3 marks**)
- c. (Q3) SPIRIT IN MOTION in association with “hairdressing salons” (**3 marks**)
- d. (Q4) RC.MP. in association with “bike computers” (**4 marks**)
- e. (Q5) UNITED NATIONS in association with “t-shirts” (**4 marks**)
- f. (Q6) SMITH PICARD in association with “insurances services” (**3 marks**)

**Answer:**

WILDLIFE SAMBUCA in association with “spirits”	<b>4 marks</b> Registrable ( <b>1 mark</b> ) SAMBUCA is a common name for spirits but as a whole WILDLIFE SAMBUCA is not clearly descriptive of spirits ( <b>1 mark</b> ) Section 12 (1)b) and Section 11.18 (4)d) ( <b>2 marks</b> )
QUICK CONNECT in association with “electrical connectors for cable”	<b>3 marks</b> Not Registrable ( <b>1 mark</b> ) Clearly <u>descriptive</u> of the character of the goods: electrical connectors connect quickly ( <b>1 mark</b> ) or Deceptively mis-descriptive. ( <b>Note: including the term “Descriptive” is enough to get the mark</b> ) 12(1)b) ( <b>1 mark</b> )
SPIRIT IN MOTION in association with “hairdressing salons”	<b>3 marks</b> Not registrable ( <b>1 mark</b> ) schedule 1 Olympic and Paralympic Marks Act, ( <b>1 mark</b> ) 12(1) (i) ( <b>1 mark</b> )
RC.MP. in association with “bike computers”	<b>4 marks</b> Not registrable ( <b>1 mark</b> ) Prohibited trademark ( <b>1 mark</b> )

	Section 12 (1) (e) and Section 9(1)(O) (2 marks)
UNITED NATIONS in association with "t-shirts"	4 marks Not Registrable (1 mark) prohibited mark (1 mark) 12(1) e) and 9 (1)m) (2 marks)
SMITH PICARD in association with "insurances services"	3 marks Registrable (1 mark) The trademark is composed of two surnames (1 mark) 12(1)a) not primarily a family name or PN (1 mark)

### Question 2 (2 marks)

A trademark agent has given a trademark availability opinion for the registration of the trademark "Power Bread" in Canada in association with "bread". She filed the application, and it is now registered. The trademark agent is however not the present agent for the file.

A few years later after the trademark is registered, the trademark agent is approached by another person indicating that they are also in the bread making business and would like to register THE POWER IS IN THE BREAD in association with "bakery services".

(Q7) Assuming that there is a conflict of interest, explain why the trademark agent cannot act in this scenario. (2 marks)

**Answer:** There is a substantial risk that the agent's loyalty to or representation of that person would be materially and adversely affected by the agent's own interest or the agent's duties to a former client.

**Note:** the exact wording is not required to get full marks (2 marks); no partial marks will be awarded (either 0 or 2 marks)

### Question 3 (13 marks)

One of your long-standing clients, WE RIDE TOGETHER Inc., operates in the sport industry and they specialize in clothing for professional motorcyclists. WE RIDE TOGETHER Inc. is a Canadian company, based in Toronto (Ontario), with several stores in the United States, in the United Kingdom and in the European Union. The client has been working for several years with vendors located in Bangkok (Thailand).

Your client just developed a new lightweight protective jacket with an innovative ventilation system. This new product will be launched during the upcoming motorcycle racing championship in Riyadh (Kingdom of Saudi Arabia), as the client has a sponsorship agreement with one of the racing teams. The race will take place in 2 months and the new product has not been publicly released yet.

The new product will be branded WE FAST and it will show a small graphic on the back. This unique artwork was created by an artist employed by an advertising agency to celebrate the event. The client is planning to advertise and sell the new jacket in their stores internationally and it will be worn by the riders in Riyadh during the event.

Your client just realized that they may not have protected their IP rights properly before the launch and contacts you for an urgent meeting.

Before the meeting, you reviewed your client's trademark portfolio and noticed that WE RIDE TOGETHER Inc. has owned WE FAST trademark registration in Canada since 2014. This registration covers "clothing, namely, jackets" and "motorcycle garments, namely, jacket to protect against injury".

- a. (Q8) In regards to the word mark WE FAST, list trademark filing strategies based on the jurisdictions. Briefly explain the steps you would need to take and list the applications to file and the particulars of each application. **(9 marks)**

**Answer:**

- No need to file a new Canadian trademark application with CIPO OR can rely on the Canadian registration **(1 mark)** Classify the goods of the existing Canadian registration in accordance with the Nice Classification in order to file an International trademark application **(1 mark)**
- File an International/Protocol/Madrid trademark application **(1 mark)** designating the United States, the United Kingdom, the European Union and Thailand **(1 mark – all jurisdictions must be listed)** for the goods claimed in the Canada registration ("clothing, namely, jackets" and "motorcycle garments, namely, jacket to protect against injury") **(1 mark)** relying on existing Canadian registration as basic registration **(1 mark)**
- In alternative to the International trademark and without the reclassification of the Canadian registration **(1 mark)**, file trademark applications in the United States, the United Kingdom, the European Union and Thailand directly with local trademark offices **(1 mark)**
- File a trademark application in the Kingdom of Saudi Arabia with the local Trademark Office **(1 mark)**. The Kingdom of Saudi Arabia is not a member of the Madrid System.

- b. (Q9) List which of these applications for the word mark will be filed claiming priority **(1 mark)**

**Answer: None, based on the Canadian registration. (1 mark)**

- c. (Q10) In accordance with the Nice Classification, identify the class(es) of goods claimed in the existing Canadian registration **(1 mark)**

**Answer:**

"clothing, namely, jackets" class 25

"motorcycle garments, namely, jacket to protect against injury" class 9

**(1 mark will only be awarded for a complete answer addressing both classes.)**

- d. (Q11) Based on the information available, list at least two other types of IP protection that may be available for filing by your client in Canada under any other federal statutory provisions (other than the Trademark Act) and indicate for each type of protection what IP right is protectable **(2 marks)**

**Answer:**

Copyright application for the artwork **(1 mark)** OR  
 Patent application for the innovative ventilation system **(1 mark)** OR  
 Industrial design application for clothing or ventilation system **(1 mark)**

**Question 4 (25 marks)**

A new client, Gold Plum Inc., reaches out to you as they are interested in filing a new trademark application in Canada for ZENITH in association with essential oils, specifically lavender essential oils for personal and domestic use. They have been selling their ZENITH lavender essential oils in the US since 2017. They have been using lavender grown in Ontario (CANADA) and their manufacturing plant is located in Ohio (USA).

Prior to filing the application in Canada, your client agrees to conduct a full availability search and you send the trademark search request to your external service provider immediately. You receive the data results below and you assess whether the ZENITH mark is available for your client in Canada.


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

- a. (Q12) For each of the marks identified in the chart below
- i. Indicate “yes” or “no” whether the mark is likely to pose an obstacle to registration of the ZENITH mark for “lavender essential oils” **(1 mark each)**  
**Note: “yes” means the mark is likely to pose an obstacle to registration, and “no” means the mark is not likely to pose an obstacle to registration; and**
  - ii. Provide in point form one valid explanation to support your opinion **(1 mark each)**  
**Note: Formulate your opinions from a Trademark Office/Examination perspective – not from an opposition perspective.**

**(Total 20 marks)**

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


No.	Trademark	Status and Appl/Reg. No and Date	Goods & Services	Owner
1.	ZEN-MYTH LAVANDER	Advertised App: 1976285 App: 2019-09-06	Class 3: Body Lotions;	Beauty Zen LLC 268 Horner Str. Ottawa, K1A 0A2, Ontario
2.	ZENITH	Registered Reg: TMA498,852	Class 1: Tanning oils for animal skins;	MOO Group S.P.A.

		Reg:2012-03-08		Viale Abruzzi 4, Milano, 20030, Italia
3		Filed Appl: 1978453 Appl: 2021-04-18	Class 5: flaxseed oil dietary supplement; medicated massage oils;	Miitaco Inc. 259 West 2 <sup>nd</sup> Ave, Edmonton, T5A0B9, Alberta
4	Z ZENITH	Abandoned Reg: TMA321,698 Reg: 1999-08-09	Class 3: Essential oils and diffusers	ZEN Inc. 650 Market Str. Philadelphia, PA 19103 U.S.A.
5	ZENITH CALM	Filed Appl: 1956234 Appl: 2020-05-19	Class 4: aromatherapy fragrance candles; Class 21: electric aromatherapy oil diffusers	CALM PLS LLC 6 Challenger Rd. Ridgedfield Park NJ 07660 U.S.A.
6	ZEN IT	Registered Reg: TMA867,417 Reg: 2013-07-09	Class 25: Clothing, namely, T-Shirts; hats; socks;	Robert Molliere 8 Woodward Ave, Detroit MI 48226 U.S.A.
7	XENITH	Registered Reg: TMA1,082,365 Reg: 2018-04-29	Class 35: sales agency services featuring essential oils for perfumery Class 40: custom blending of essential oils for aromatherapy use	XENITH Inc. 245 Pinnacle Drive Wilmington DE 19803 U.S.A.
8	ZENITH OF LIFE	Registered Reg: TMA785,318 Reg: 2012-12-12	Class 3: Fragrances for personal use	ChaoLin Mey Unit 901, No 17, ZhongGhe Str., Beijing, 100176 China
9.	SENITE	Registered Reg: TMA852,364 Reg: 2014-07-22	Class 29: lavender oil for culinary purposes	BBYOU LLC. 78 Pauline Ave, Toronto, M6H 0B1, Ontario
10.	ZENITH	Advertised Appl: 0925587 Adv.: 2019-09-03	Classes 1-45	Royal Astronomical Society of Canada 265 Hella West, Vancouver, Y5V 0C1, British Columbia

Answer:

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

No.	Trademark	Answer
1.	ZEN-MYTH LAVANDER	<ul style="list-style-type: none"> <li>No (1 mark)</li> <li>Marks differs in appearance, sound and idea suggested (1 mark) [Note: one of the terms "appearance,</li> </ul>

No.	Trademark	Answer
		<b>“sound” or “idea suggested” is required to receive the mark]</b>
2.	ZENITH	<ul style="list-style-type: none"> <li>• No (1 mark)</li> <li>• The goods are different <b>OR</b> the channels of trade would be different (1 mark)</li> </ul>
3		<ul style="list-style-type: none"> <li>• Yes (1 mark)</li> <li>• The Client’s mark is identical to the word element of this mark <b>OR</b> The goods are similar <b>OR</b> The channels of trade are similar (1 mark)</li> </ul>
4	Z ZENITH	<ul style="list-style-type: none"> <li>• No (1 mark)</li> <li>• Mark has been abandoned (1 mark)</li> </ul>
5	ZENITH CALM	<ul style="list-style-type: none"> <li>• Yes (1 mark)</li> <li>• The Client’s mark is identical to the first word in this mark <b>OR</b> This mark contains the Client’s mark in its entirety <b>OR</b> the goods are similar/overlapping <b>OR</b> the channels of trade are similar (1 mark)</li> </ul>
6	ZEN IT	<ul style="list-style-type: none"> <li>• No (1 mark)</li> <li>• Marks differ in appearance and connotations/idea suggested <b>OR</b> the goods are different <b>OR</b> the channels of trade would be different (1 mark)</li> </ul>
7	XENITH	<ul style="list-style-type: none"> <li>• Yes (1 mark)</li> <li>• Marks are phonetically similar <b>OR</b> goods and services are similar (1 mark)</li> </ul>
8	ZENITH OF LIFE	<ul style="list-style-type: none"> <li>• Yes (1 mark)</li> <li>• The Client’s mark is identical to the first word of this Mark <b>OR</b> This mark contains the Client’s mark in its entirety <b>OR</b> goods are similar/overlapping <b>OR</b> The channels of trade are similar (1 mark)</li> </ul>
9.	SENITE	<ul style="list-style-type: none"> <li>• No (1 mark)</li> <li>• Marks differ in appearance, sound and idea suggested (<b>NOTE: If candidate includes appearance, sound or idea the mark will be awarded</b>) <b>OR</b> goods are sufficiently dissimilar <b>OR</b> The channels of trade would be different (1 mark).</li> </ul>
10.	ZENITH	<ul style="list-style-type: none"> <li>• Yes (1 mark)</li> <li>• The Client’s mark consists of the Official Mark or so nearly reassembles as to be likely mistaken for the Official Mark (1 mark) [<b>Note: the term “Official Mark” is required to receive the mark]</b></li> </ul>

The second part of the search report includes Internet searches for the term ZENITH. Your attention is immediately drawn on the following Web Result:

Web Results	TM	Page Title	URL
WEB 1	<u>Zenith Kit</u>	Zenith Kit – Diffuser & Relaxing Blend...	<a href="https://www.bonbon.com/us/product/zenith-kit">https://www.bonbon.com/us/product/zenith-kit</a>

During the first meeting, your client mentioned that Bon Bon SARL is a French company, and it is your client's biggest competitor. By quickly reviewing the "NEW PRODUCTS" section on the Bon Bon SARL's website, you find their ZENITH KIT, composed of an electric essential oil diffuser and its compatible liquid blend. Their website clearly states that online sale and shipment are within the U.S. only, the currency is USD and their online store locator does not show any Canadian locations.

Based on the information available from the Bon Bon SARL's website:

- b. (Q13) Indicate "yes" or "no" whether this additional information has an impact on the availability of your client's mark in Canada **(1 mark)**

**Answer: No (1 mark)**

- c. (Q14) Provide an explanation to support your opinion in b. **(2 marks)**

**Answer:**  
Bon Bon Sarl has not commenced the use of the trademark ZENITH KIT in Canada **OR**  
Bon Bon Sarl does not have any prior common law rights in Canada **(1 mark)**.  
Therefore, they cannot rely on any prior rights to oppose your client's application **OR**  
they cannot commence any passing-off against your client **(1 mark)**

- d. (Q15) List any additional recommendation you would provide to your client concerning further due diligence steps to be taken with respect to Canada before filing a Canadian application **(1 mark)** Explain your answer **(1 mark)** **[NOTE: No mark will be given if candidates refer to any action in the U.S.]**

**Answer:** Further investigation required **(1 mark)** to confirm that the ZENITH KIT cannot be purchased in Canada **OR** to confirm that the ZENITH mark has not been used in Canada by Bon Bon SARL **(1 mark)**  
**(Note: No marks would be awarded for an answer to check whether an application has been filed by Bon Bon SARL, as a search has already been done.)**

### Question 5 (15 marks)

You have filed an application for the registration of the mark "1000Watt" on behalf of your Canadian client, MI Ltd., on January 2, 2019, for:

A computer-aided ranking system ranking the difference between the actual amounts of energy loss in buildings in comparison with the standard amount under various building codes

Providing energy consulting services for bench marking energy loss in buildings

Your client is a high-tech consulting firm in green technology active only in Ontario and has developed a computer program and provides the services which use that program in Ontario. At the time of the filing, no Nice Class was specified for the goods and services.

A few weeks before receiving an Office Action your client mentioned that they have used the mark in Canada in association with the goods and services prior to the filing date.

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

02 Dec, 2021  
Your File No:  
Our File No:

Your Firm  
Address

Re: Trademark: 1000Watt  
Applicant: MI Ltd.

This examiner's report concerns the above identified application. To avoid abandonment proceedings, a proper response must be received by this office by June 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 to be clearly descriptive or deceptively misdescriptive of the character or quality of the associated goods and services. Specifically, the trademark clearly describes that the applicant's goods and services pertain to the measurement of 1000 watt which is defined as a unit of energy.

Alternatively, if the goods and services 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.

Also, it appears that the trademark is not distinctive.

The Registrar's preliminary view is that the trademark is not inherently distinctive. In particular, the mark is considered to be, when sounded, clearly descriptive or deceptively misdescriptive of the character or quality of the associated goods and services. Trademarks possess some inherent distinctiveness when nothing about them refers the consumer to a multitude of sources when assessed in relation to the associated goods or services. Where a trademark may refer to many sources, it is considered to have no inherent distinctiveness. Other traders should be able, in the ordinary course of their businesses, to use the same trademark in association with the same goods or services.

Pursuant to paragraph 32(1) 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.

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

Finally, pursuant to paragraph 30(2) 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 underlined goods or services are not in specific and ordinary commercial terms:

A computer-aided ranking system, ranking the difference between the actual amounts of energy loss in buildings in comparison with the standard amount under various building codes

Providing energy consulting services for bench marking energy loss in buildings.

Applications filed prior to, and not advertised as of, June 17, 2019, must, pursuant to subsection 30(3) of the Trademarks Act, group the goods and services according to the classes of the Nice Classification, each group being preceded by the number of the class of Nice Classification to which that group of goods or services belongs and presented in the order of the classes of the Nice Classification.

Any comments you may wish to submit will receive consideration.

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

Yours truly,  
Joseph Smith  
Examination Section

- a. (Q16) If the trademark is not distinctive, please cite other section(s) of the Trademark Act which the examiner can rely on to raise further objection? **(2 marks)**

**Answer: Section 37 (1) (d) (1 mark) and 32 (1) (b) (1 mark)**

- b. (Q17) Draft a reporting letter to your client in point form, setting out all the options to properly respond to all the objections. For each option, explain how you would respond to the report, and what information you will need from your client to do so. **(13 marks)**

**Answer:**  
**Argue against descriptiveness or non-distinctiveness (1 mark)**

**Watt is a measurement unit but 1000Watt is simply a coined word;**

**OR**

**1000Watt is not descriptive of the character of the goods and services as the number 1000 being added makes the mark distinct.**

OR

The combination of the number 1000 and watt is unique and distinctive and thus registrable. **(1 mark)**

Discuss with the Client the possibility of filing evidence of acquired distinctiveness under subsection 12(3) and 32(1)(b) of the Trademarks Act. **(1 mark)**

The following information and documents will be necessary to file evidence of acquired distinctiveness:

- Name and title or position of the person signing the affidavit
- Particulars of the applicant's company
- Date of first use of the mark in Canada for goods and service
- Annual sales figures of the software and service in Canada; sale information has to be broken down by provinces/territories
- Annual amounts spent in advertising the goods and service of the mark in Canada, broken down by province/territories and by media or type of advertising
- Provide specimens [or any word that suggests specimens] of the trademark as used in Canada in relation to the goods and services;
- Provide samples of advertising materials used in Canada in relation to the goods and service

**(1 mark each, up to a maximum of 6 marks)**

#### **Description of Goods and Services**

Classify and revise the description of goods and services as follows:

- Class 9 Computer software ranking the difference between the actual amounts of energy loss in residential, commercial and industrial buildings in comparison with the standard amount under various building codes **(1 mark for classification and 1 mark for revising description)**.
- Class 42 Providing energy consulting services for bench marking energy loss to residential, commercial and industrial buildings **(1 mark for classification and 1 mark for revising description; Note: candidate must list a type of building to get the mark for the reclassification)**

#### **Question 6 (10 marks)**

Active Inc. filed a trademark application without an agent. Details of the application are set out below:

Application No.: 323,456,789  
Mark: ACTIVE!23  
Goods: Class 25: t-shirts and bags  
Filing date: March 1, 2020  
Filing fee paid: \$336.60  
Formalized: March 8, 2020

On November 30, 2022, Ms. Smith, CEO of Active Inc. contacts you and says that she thinks her mark has now gone abandoned because she missed the deadline to respond to an

Examiner's Report by November 1, 2022. She forgot about this application until she got another letter from the Trademarks Office dated November 15, 2022.

The Examiner's Report raises an objection with respect to the description of goods "bags". Ms. Smith advises you that they sell backpacks displaying ACTIVE!23.

- a. (Q18) What is the current status of this application? (1 mark)

**Answer:**  
Application is in default (1 mark)

- b. (Q19) What would you recommend Ms. Smith do to address the objection with respect to bags? (2 marks)

**Answer:** Further specify "bags" to "bags, namely, backpacks" (1 mark for mentioning amendment; mark will not be awarded for deleting "bags"); reclassify bags under class 18 and pay the additional class fees (1 mark, answer must contain reclassify bags under class 18 and pay additional fees to get full marks, no partial marks awarded).

- c. (Q20) Ms. Smith also found out that her company owns a design mark registration, which was registered on March 1, 1997. Her records showed that her company paid for the last renewal fee on January 3, 2012. When is the next renewal deadline? (1 mark)

**Answer:** March 1, 2027 (1 mark)  
(would not accept answer based on the grace period)

- d. (Q21) Active Inc. also owns a pending application for the mark DE-NAMIC for use in association with "sweaters, cell phone cases and bottled water". Active Inc. has two directors, Ms. Smith and Mr. Cole. A few months later, Ms. Smith advises you that she and Mr. Cole have decided to go separate ways and they have verbally agreed to the general terms. As part of the arrangement, Mr. Cole will incorporate a new company named Energetic Corp. Active Inc. will continue to own the DE-NAMIC mark for sweaters, while Mr. Cole will own the DE-NAMIC mark with respect to cell phone cases and bottled water. What would the parties need to do to put this arrangement in effect with respect to the DE-NAMIC mark? (4 marks)

**Answer:**  
**Scenario 1:**  
Active Inc. and Energetic Corp. will need to sign an assignment (1 mark). The assignment will partially assign DE-NAMIC with respect "cell phone cases and bottled water" to Energetic Corp. (1 mark). Either Active Inc. or Energetic Corp. will file request at the Canadian Intellectual Property Office to record the partial assignment (1 mark).  
**Scenario 2:**  
File a divisional application (1 mark) for cell phone case and bottled water OR sweaters (1 mark). File request at the Canadian Intellectual Property Office to record the assignment (1 mark).

Pay the prescribed fee. (1 mark) (for both scenarios)

- e. (Q22) Ms. Smith is negotiating with SuperMart, Inc., one of the largest supermarkets in the country, to distribute the ACTIVE!23 t-shirts. SuperMart, Inc. is requesting Ms. Smith to sign an agreement which includes a provision that would grant a license to SuperMart, Inc. to use the mark ACTIVE!23 on t-shirts. Is it necessary for Ms. Smith to sign the agreement? (1 mark) Explain your answer (1 mark)

Answer: No (1 mark), a license is not required for a distributor (1 mark)

### Question 7 (12 marks)

(Q23) Draft a response to the Office Action (point form is accepted). For the purpose of this exam, analyse the situation considering that **each objection is isolated from the other and should be addressed separately**. Only arguments in favour of the registrability of the trademark will be considered.

You have filed an application for the registration of the trademark

FESTIVAL TORONTO LAUGHS

with the following particulars:

Filing Date: July 30, 2019

Services

Class 41: Entertainment in the form of live comedy shows.

You received the following Office Action:

20 juin/June 2022

Your reference

1000-01

Notre reference Our File

2001234

Numéro EI IR Number

RE: Trademark: FESTIVAL TORONTO LAUGHS

Application no.: 2001234

This examiner's report concerns the above-identified application. To avoid abandonment proceedings, a proper response must be received by this office by **December 20, 2022**. All correspondence respecting this application must indicate the file number.

In view of paragraph 12(1)(d) of the *Trademarks Act*, the trademark which is the subject of this application does not appear to be registrable since it is confusing with registered trademark FESTIVAL JUST FOR LAUGHS, No. TMA310,555. The services are identical.

The use of a trademark causes confusion with another trademark if the use of both trademarks in the same area would be likely to lead to the inference that the goods and services associated with those trademarks are manufactured, sold, leased, hired or performed by the same person, whether or not the goods or services are of the same general class.

The Registrar must consider all the surrounding circumstances including those stated in subsection 6(5) of the *Act*.

Furthermore, please confirm that the services emanate from TORONTO since research shows that TORONTO is a geographic name. The Office considers services to originate from a geographic location if they are performed, provided or offered there.

If the services do not emanate from Toronto, then the trademark as a whole deceptively misdescribes the place of origin of the associated services since the average Canadian consumer or dealer would be misled into the belief that the associated services originate from Toronto and therefore the trademark is unregistrable pursuant to paragraph 12(1)(b) of the *Act*.

Furthermore, the trademark is considered to be clearly descriptive or deceptively misdescriptive of the character or quality of the associated services. Specifically, the use of the trademark "FESTIVAL TORONTO LAUGHS" clearly describes that the service is a "festival of comedy shows intended to make people laugh in Toronto". Alternatively, if the services 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 *Act*, the trademark does not appear registrable.

Moreover, pursuant to paragraph 32(1) of the *Act*, this trademark is not inherently distinctive.

The Registrar's preliminary view is that the trademark is not inherently distinctive as trademarks which do not appear registrable pursuant to paragraph 12(1)(b) of the *Act* are considered not inherently distinctive. As such, the consumer would not be able to distinguish the source of the applicant's services from those of a competitor since the applied-for trademark is merely descriptive of a "festival of comedy shows intended to make people laugh in Toronto".

Therefore, pursuant to paragraph 37(1)(d) of the Trademarks Act, this trademark is not registrable.

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

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After a conference call with your client, you have the confirmation that the services are rendered in Toronto. The client also confirmed that the first FESTIVAL TORONTO LAUGHS was launched in 1995 and during the pandemic period, the festival broadcast via the Internet direct presentation of live comedy shows from Toronto theaters and accessible online with the purchase of tickets while FESTIVAL JUST FOR LAUGHS started in 1990.

You have done a search on the trademarks Register and you identified the following trademarks that are registered in association with identical or similar services to the cited trademark. None of them are owned by your client or the owner of the cited trademark.

FESTIVAL LAUGH LOUNGE TMA 1074854

LAUGHTER IS THE BEST MEDICINE TMA848240

LAUGHS LINES & design TMA672729

LAUGH FOREVER TMA1003313

THE LAUGH SHOP TMA749845

LAUGH IT UP TMA712401

FESTIVAL WE LAUGH TMA923036

BIG LAUGHS TMA668339

MAKE US LAUGH TMA965004

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**Answer:**

**Objection of confusion 12(1)(d)**

- **Inherent distinctiveness (6)5(a) and how it has been known (total 2 marks)**

The candidate must give 2 arguments (**1 mark per argument**) among the following:

Except for the geographic location (*not necessary to get the mark*) both marks are made of ordinary dictionary words OR common to comedy shows OR commonly used in the trade. (**Note – key words are NOT required to get the marks, if the candidate describes the correct concept, then the mark will be granted**)

The range of protection is limited when trademarks are made of ordinary dictionary words OR common to a particular trade

Both trademarks are very suggestive of the services

Small differences are enough to distinguish one trademark from the other

- **Length of time the trademarks have been in use (6)5(b) (total 2 marks)**

Both trademarks have been in use for a long time 1990 vs 1995 **AND** confusion would be unlikely to occur (**2 marks**)

**Candidate must mention the long time use by both parties and provide an explanation to support that there is no confusion to get the full 2 marks. 1 mark will not be awarded.**

- **The degree of resemblance between the trademarks including in appearance or sound or in the ideas suggested by them (6)5(e) (total 2 marks)**

Citing that the ideas suggested by both marks are not the same is not sufficient to obtain any marks

FESTIVAL JUST FOR LAUGHS suggests a festival where nothing must be taken seriously **AND**

while FESTIVAL TORONTO LAUGHS suggests people laughing in Toronto OR the people in the city of Toronto laugh **(2 marks)**

**Candidate must explain the differences in the ideas suggested by the two trademarks to get the full 2 marks. 1 mark will not be awarded**

- **Other considerations (total 2 marks)**

At least 9 other registered trademarks with the word LAUGHS or similar wording are coexisting on the trademark Register and 2 of them start with the word FESTIVAL **(1 mark)**

Ordinary consumers are used to see the word LAUGHS or very similar wording in association with comedy shows **(1 mark)**

**Note: 1 mark will given for providing comments on the number of third-party marks with LAUGHS/FESTIVAL; 1 mark will be given for commenting on the third-party marks are registered in association with the same or similar goods as the cited mark; no marks will be given for simply mentioning co-existence or state of the register without an explanation.**

**Objection based on geographical location (total 2 marks)**

The services are offered in Toronto **(1 mark)**

In whole, the trademark is not clearly descriptive of the origin of the services **(1 mark).**

**Objection against the registration of the trademark pursuant to Section 12(1)b) of the Trademarks Act on the clearly descriptive of the trademark (total 1 mark)**

- Even if FESTIVAL and TORONTO are clearly descriptive, on first impression, the average consumer would not think that a city is laughing **(1 mark)**

**Candidate must provide a reasonable argument to get 1 mark.**

**Objection that the trademark is not inherently distinctive (total 1 mark)**

- Since the trademark is not clearly descriptive, it has some degree of distinctiveness  
OR
- No trader will be stopped to use FESTIVAL and TORONTO. Traders can use other expressions instead of "laughs"

**(1 mark)**

**Marks will be awarded for the content, not the organization of the answer.**

**Question 8 (10 marks)**

(Q24) 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 10 marks)**

Case	Legal Principle
<p><b>A. Mitel Corporation v. Registrar of Trade Marks</b> (1984), 79 C.P.R. (2d) 202</p> <p>Trademark: SUPERSET</p>	<p>1. A proper interpretation of the term “place of origin” should be interpreted to refer to any geographical designation.</p>
<p><b>B. Choice Hotels International Inc. v. Hotels Confortel Inc.</b> (1996), 67 C.P.R. (3rd) 340 (FC)</p> <p>Trademarks: CONFORTEL</p>	<p>2. A trademark comprising two words which are primarily merely surnames separated by any indicia, other than a hyphen, such as the word “and” or by an ampersand, oblique sign, asterisk, comma and so on, is not contrary to paragraph 12(1)(a). In such a case, the trademark as a whole cannot be said to be primarily merely the surname of an individual.</p>
<p><b>C. Kirkbi AG v. Ritvik Holdings Inc.</b>, [2005] 3 S.C.R. 302, 2005 SCC 65</p> <p>Trademark: LEGO indicia</p>	<p>3. When considering descriptiveness, regard must also be given as to whether the trademark is grammatically correct.</p>
<p><b>D. Miller Thomson LLP v. Hilton Worldwide Holding LLP</b>, 2020 FCA 134</p> <p>Mark: WALDORF ASTORIA</p>	<p>4. Trademarks which laud the merits or superiority of the goods or services, are clearly descriptive of their quality and are not registrable.</p>
<p><b>E. Lubrication Engineers, Inc. v. Canadian Council of Professional Engineers</b> (1992), 41 C.P.R. (3d) 243</p> <p>Trademark: Lubrication Engineers</p>	<p>5. A trademark does not contravene paragraph 12(1)(b) of the Act if it merely suggests the character or quality of the associated goods or services.</p>
<p><b>F. Deputy Attorney-General of Canada v. Jantzen of Canada Limited</b> [1964] 46 C.P.R. 66</p> <p>Trademark: WATERWOOL</p>	<p>6. A professional designation cannot serve as a valid certification mark.</p>



Case	Legal Principle
<p><b>G. Nia Wine Group Co., Ltd. v North 42 Degrees Estate Winery Inc.</b>, 2022 FC 241</p> <p>Trademark: NORTH 42 DEGREES</p>	<p>7. A trademark must not mislead the public by ascribing a character or quality to goods or services that they do not possess. However, a trademark is not deceptively misdescriptive if ordinary dealers in or purchasers of the goods would perceive the mark as an indirect reference to the quality of the goods.</p>
<p><b>H. Lake Ontario Cement Ltd. v. Registrar of Trade Marks</b> (1976), 31 C.P.R. (2d) 103</p> <p>Trademark: PREMIER</p>	<p>8. As long as some consumers, purchasers or members of the public in Canada receive a material benefit from the activity in issue, it will amount to the performance of the services in Canada.</p>
<p><b>I. Hidden Bench Vineyards &amp; Winery Inc. v. Locust Lane Estate Winery Corp.</b>, 2021 FC 156</p> <p>Trademark: LOCUS LANE</p>	<p>9. An objection under paragraph 12(1)(a) may be raised even if the trademark includes embellishments to the lettering of the name or surname.</p>
<p><b>J. Davidoff Comercio E Industria Ltda v. Davidoff Extension S.A.</b> (1989), 24 C.P.R. (3d) 230</p> <p>Trademark: DAVIDOFF Design</p>	<p>10. In assessing functionality, the issue is whether the trademark's features are primarily designed to perform a function and whether registration would grant a trader a monopoly on their functional features.</p>
	<p>11. 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>12. Where one must prove that a descriptive word has acquired a secondary meaning so as to make it distinctive of a party's goods or services, the onus is a heavy one.</p>
	<p>13. If it is considered that the prospective consumer, when faced with the trademark would immediately, as a matter of first impression, conclude that the goods or services are produced by a professional from that designation, the trademark will be found to be clearly descriptive or deceptively misdescriptive of the persons employed in the production of the goods and services and unregistrable based on Section 12(1)(b).</p>

Case	Legal Principle
	14. 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.

**Answer:**

A - 4

B - 14

C - 10

D - 8

E - 13

F - 5

G - 1

H - 7

I - 12

J - 9

**Question 9 (2 marks)**

You are assisting Mr. Brown with preparing an affidavit in support of a claim of acquired distinctiveness. Mr. Brown has had a number of other unrelated, unexpected expenses for his business recently and is suddenly looking to reduce costs anywhere he can. Mr. Brown has asked you to provide him with a sample affidavit that was successful in the past.

You do not have time and cannot incur more costs to prepare a sample affidavit for Mr. Brown. However, you recalled that two years ago, you prepared and filed an affidavit for another client, Ms. Jones and Ms. Jones' trademark application has proceeded to registration. Ms. Jones is still your client.

- a. (Q25) Yes/No: Are you allowed to send a copy of Ms. Jones' sworn affidavit to Mr. Brown? (1 mark)

**Answer: Yes**

- b. (Q26) Why or why not (1 mark)

**(1 mark) Ms. Jones' affidavit is part of the public record (1 mark).**

**Question 10 (8 marks)**

- a. (Q27) TRUE OR FALSE. If services are expunged from a Canadian basic registration six years following the filing of an international registration, CIPO must communicate to WIPO the changes. (Q28) Explain your answer. **(2 marks)**

**Answer:**  
**FALSE (1 mark)**  
**Why: The dependency period is 5 years (1 mark)**

- b. (Q29) TRUE OR FALSE. The first registration term in Canada may be for a shorter period of time than the international registration term. (Q30) Explain your answer. **(2 marks)**

**Answer:**  
**TRUE (1 mark)**  
**Why: Since the international term is 10 years, the Canadian registration period will be dependant of the term remaining when the Protocol application is registered in Canada. (1 mark)**

- c. (Q31) TRUE OR FALSE. The Canadian Trademarks Office must record a license agreement when notified by WIPO of the recording of a license in the International Register. (Q32) Explain your answer. **(2 marks)**

**Answer:**  
**FALSE (1 mark)**  
**WHY: The recording has no effect in Canada OR CIPO will not record the license agreement unless the owner makes the request directly with CIPO. (1 mark)**

- d. (Q33) TRUE OR FALSE. The change of name of the holder of the International Registration must be communicated to WIPO. **(1 mark)**

**Answer:**  
**TRUE (1 mark)**

- e. (Q34) TRUE OR FALSE. CIPO will send a courtesy copy of the Total Provisional Refusal to the applicant or their Canadian trademark agent if one has been appointed. **(1 mark)**

**Answer:**  
**TRUE (1 mark)**

### **Question 11 (2 marks)**

(Q35) A complaint is made regarding the actions of a trademark agent. As part of the investigation, what information may be provided by the Investigations Committee to the complainant and what information may not be conveyed? **Partial marks will not be awarded for this question.**

**Answer: All information about the investigation except privileged information may be conveyed to the complainant. (2 marks) No partial marks will be awarded (i.e. 0 or 2 marks).**

### Question 12 (2 marks)

A client is interested in using the mark “CSS”, which stands for Corporate Sustainability Standard. They are using this brand to promote that all of its products follow a specific standard to promote sustainability.

- a. (Q36) Yes or No: Would you recommend this client to file a certification mark? **(1 mark)**

**Answer: No. (1 mark)**

- b. (Q37) Why or why not? **(1 mark)**

**Answer:**

A certification mark may be registered only by a person who is not engaged in the manufacture, sale, leasing or hiring of goods or the performance of services such as those in association with which the certification mark is used or proposed to be used OR Section 23(1) of the Act OR Section 30(2)(b) of the Act **(1 mark)**

### Question 13 (2 marks)

Trademark Agent A shares an office space with Trademark Agents B and C. Trademark Agent A represented for several years Milestone Inc. Last year, the company decided to switch agent, appointing a law firm to represent them with CIPO.

While Trademark Agent A is having a coffee break in the dining area of the shared office with Agent B and Agent C, the TV news announces that Milestone Inc. has been involved in major trademark litigation. Trademark Agent A immediately recognizes an old trademark he/she filed in Canada on the company's behalf and starts commenting on this matter with Agent B and Agent C sharing some confidential background details relevant to the case.

- a. (Q38) Yes or No: Does the duty of confidentiality apply even if Trademark Agent A does not represent Milestone Inc. anymore and his/her information is accurate **(1 mark)**?

**Answer: YES (1 mark)**

- b. (Q39) Provide one reason in support of your answer **(1 mark)**

**Answer: The duty of confidentiality survives the Trademark Agent's representation (1 mark)**

### Question 14 (3 marks)

(Q40) A client came up with an essential oil product which has a unique strawberry scent that is not yet sold in the market. The scent is so special that it has the effect of soothing one's mind. Would you recommend the client to file a trademark application for the scent now? **(1 mark)** Provide 2 reasons. Only the first 2 reasons will be marked. **(2 marks)**

**Answer: Would not recommend filing (1 mark). The scent is functional (1 mark). Evidence is required to show that the mark is distinctive at the filing date. There is no use as of the filing date (1 mark).**

### Question 15 (2 marks)

(Q41) A trademark agent is also a member of the Law Society of Ontario (“LSO”). A situation has arisen where the LSO’s Rules of Professional Conduct are in conflict with the Code of Professional Conduct for Patent Agents and Trademark Agents Regulations. Which of the following statements outlines the correct approach in such a situation? (Partial marks will not be awarded):

- a. In this case, the Code of Professional Conduct for Patent Agents and Trademark Agents Regulations does not apply and the licensee is to follow the LSO’s Rules of Professional Conduct;
- b. In this case, the Code of Professional Conduct for Patent Agents and Trademark Agents Regulations applies and the licensee is not to follow the LSO’s Rules of Professional Conduct;
- c. Both the Code of Professional Conduct for Patent Agents and Trademark Agents Regulations and the LSO’s Rules of Professional Conduct apply and the licensee has to abide by both;
- d. In this case, a ruling by the College is required.

**Answer: (a)**  
**(2 marks)**  
**(no partial marks will be awarded)**

### Question 16 (7 marks)

You are the agent for Application No. 4,111,111 owned by YYY Inc. for the mark E-BIKES for use in association with “bicycles”. This application was filed on July 2, 2019. You have received an Examiner’s Report, in which the Examiner has raised the following objections:

- i. That the mark is confusing with Registration No. TMA333333 for the mark EBYKES for use with “bicycles” owned by A1A Inc.
- ii. That the mark consists of or is so nearly resembling as to be likely mistaken for the official mark E-BIKES, owned by the Royal Canadian Mounted Police (“RCMP”).
- iii. That the mark E-BIKES is clearly descriptive of the goods and not inherently distinctive, as the mark describes that the goods are electric bicycles.

After you have reported the Examiner’s Report to YYY Inc., your client advised as follows:  
“Dear Agent,

We are disappointed to hear that it will be challenging to overcome the objections. E-BIKES is an important brand for YYY Inc. We have been selling millions of these units since we launched the product in August 2019, with annual sales exceeding \$500,000 from August-December 2019, \$2 million in January-December 2020 and \$4 million in January-December 2021. Lots of celebrities and social media influencers are endorsing our product. We can provide more detailed sales and advertising information if it is helpful.

We are also good friends with A1A Inc. and some of our customers work at the RCMP. We can try to see if these two organizations would sign a document allowing us to register the E-BIKES

mark. Also, we don't see the EBYKES as confusing with E-BIKES and we haven't seen A1A Inc.'s EBYKES products in the market for about 2 years.

Would any of the above information be helpful?

Best regards,

Johnny  
Owner of YYY Inc.”

(Q42) Based on the information provided by Johnny, prepare an email response to Johnny. [Point form is accepted.]

**Answer:**

Consent by the RCMP would be sufficient to overcome the objection based on the official mark owned by the RCMP (1 mark)

Consent from A1A Inc. is likely insufficient to overcome the confusion objection based on the mark owned by A1A Inc. (1 mark) It is not recommended to file a section 45 proceeding given that EBYKES may still be in use in the last 3 years (1 mark). YYY Inc. can wait and initiate a section 45 proceeding to try to expunge Registration No. TMA333333 in a year OR YYY Inc. can conduct further investigation into use of EBYKES by A1A Inc. OR purchase Registration No. TMA333333 from A1A Inc. (1 mark).

YYY Inc. cannot claim acquired distinctiveness as use started after the relevant date (filing date) (1 marks). YYY Inc. may re-file a new application (1 mark), and file evidence in the future to try to claim acquired distinctiveness (1 mark).

**Question 17 (2 marks)**

XYZ Inc. filed the following Canadian application on February 4, 2022:

Owner: XYZ Inc.  
Application No. 3,000,000  
Address: As Sahafah, Olaya St. 6531, 3059 Riyadh 13321 Saudi Arabia  
Mark: GuGi  
Goods: Shoes

Your contact, a foreign associate, advises that GuGi-branded shoes are extremely popular in Canada and that XYZ Inc. opened its own retail store in Ontario on March 4, 2022 to deal with the increased demand. On March 25, 2022, the foreign associate asked you the following question:

- a. (Q43) Yes or No: Can XYZ Inc. file a Madrid Protocol application designating the US and the European Union based on its Canadian application? (1 mark)

**Answer:**

Yes (1 mark),

- b. (Q44) Explain your answer (1 Mark).

**Answer:**

Every application for international registration file through Canada must include a statement that the applicant is a national, domicile, or has a real and effective industrial or commercial establishment in Canada. A retail store is considered a real and effective industrial or commercial establishment. (1 mark)

**Question 18 (2 marks)**

Jason is practicing as a corporate lawyer. Jason told you before that he is not a trademark agent because the trademark agent exam is too hard for him. He called you one day and asked you the following question:

“Remember I am helping a client to sell its assets, including a Canadian trademark registration, to a third-party? I have asked you to review the assignment for me before so I am confident that the assignment document is fine. Now, the client has signed the assignment document. Can I file a request with the Trademarks Office myself to record the assignment on behalf of my client?”

- a. (Q45) Yes or No: Can Jason record the assignment in this scenario? (1 mark)

**Answer:**

Yes (1 mark)

- b. (Q46) Explain why. (1 mark).

**Answer:** The registered owner can be represented by another person authorized by them, whether or not that person is a trademark agent, to make a request or provide evidence of a transfer OR Rule 25(4) of Regulations (1 mark)

**Question 19 (1 mark)**

**(Q47) True or False:** You are the agent of record for an application for a design mark incorporating the TM symbol. You have advised the Examiner over the phone that the TM symbol can be removed. You must still file a revised application to remove the TM symbol.

**Answer: True (1 mark)**

**Question 20 (3 marks)**

You are preparing an official mark application. You have prepared an application consisting of:  
(i) a cover letter setting out the official mark of interest, the Applicant's name and address, and  
(ii) a memo explaining why the Applicant is a public authority by demonstrating that a significant degree of control is exercised by the government over the activities of the Applicant and that the activities of the Applicant offers a benefit to the public.

- a. (Q48) Assuming that the Applicant is considered a public authority, does this application satisfy the requirements for giving public notice under paragraphs 9(1)(n)(iii) of the *Trademarks Act*? **(1 mark)**

**Answer:**  
**No (1 mark)**

- b. (Q49) Why or why not? **(2 marks)**

**Answer: Need to provide Evidence of adoption and use of an official mark (1 mark) and pay the prescribed fee (1 mark)**

### Question 21 (4 marks)

123456 Inc. filed the following Canadian application on February 14, 2022:

Application No. 3,000,000  
Mark: VALENTINE'S MAGIC  
Goods: Class 9: Computer video games, not including games of chance  
Class 25: Casual clothing, including t-shirts  
Class 29: Eggs and cheese, not including butter

- a. (Q50) Explain if you expect the Examiner to raise an objection to the above description of goods **(2 marks)**

**Answer:**  
**1 mark for recognizing that objection will be raised to Class 29 goods only. No marks will be awarded if any other goods are identified as problematic.**

**Reason: The limitation of goods is not acceptable as it excludes goods that would not normally fall within the scope of the broader statement. (1 mark)**

- b. (Q51) The owner of 123456 Inc. advised you that there are lots of counterfeit products being sold at an online marketplace and they need to obtain a registration as soon as possible to combat the counterfeit activities. What are their options to register the mark faster? **(2 marks)**

**Answer:**  
**File a request for expedited examination (1 mark)**  
**File a revised application to amend the goods to acceptable terms in the Goods and Services Manual. (1 mark)**

### Question 22 (2 marks)

(Q52) A client approaches you for a consultation prior to launching its products. The client manufactures small household furniture which can be assembled by the consumer. The products are packaged in three small boxes of red, blue and white and are placed in a bigger green box.



The client has come up with a unique way of putting the red, blue and white boxes in the bigger green box which would allow the customer to only open three boxes in the following order: red, blue, then white.

What kind of protection can you get under the *Trademarks Act*? Only the first two responses will be considered.

**Answer:**

- Colour protection
- Mode of packaging of goods
- 3d shape

**1 mark each up to a maximum of 2 marks**

**TRADEMARK AGENT EXAM 2022**  
**PART B**  
**TOTAL MARKS: 150**

**Question 1 (5 marks)**

(Q1) Your client's Registration No. TMA657,890 for the mark CANADA'S GUARD is the subject of a Section 45 proceeding. The evidence filed in support of registration No. TMA657,890 shows use of the mark as CARGUARD (CANADA) and CARGUARD.

What test would apply to this situation? (1 mark)

What are the three criteria for this test? (3 marks)

Cite one landmark case in which that test is set out (1 mark).

**Answer:**

The Deviation Test or the Dominant Impression Test (1 mark).

- whether the mark as used is sufficiently close OR minor variation OR language to that effect (1 mark)
- when comparing the marks, the differences are sufficiently unimportant OR key/main elements are the same (1 mark)
- that an ordinary consumer would be likely to infer that the trademarks identify the goods/services as having the same origin (1 mark)

Relevant cases: RTM v. Cie Internationale pour l'informatique CII Honeywell Bull (or Honeywell Bull case); Promafil Canada Ltee. v. Munsingwear Inc. (or Penguin case); Nightingale Interloc Ltd. v. Prodesign Ltd. (or Nightingale case) (1 mark)

**Question 2 (23 marks)**

Provide or select the best answer to the following questions.

- a. (Q2) List the necessary elements of a passing-off action involving a trademark. (3 marks)

**Answer:**

Goodwill or reputation in the trademark; (1 mark)  
Deception of the public due to misrepresentation by the Defendant/Respondent; (1 mark) and  
Actual or potential damage to the Plaintiff/Applicant. (1 mark)

- b. (Q3) **True or False.** You can only bring a passing off action in the Federal Court (1 mark)

**Answer:**  
False

- c. (Q4) In addition to an action, what is another type of proceeding that you can use when your client is claiming trademark infringement. (1 mark) Cite the relevant provision of the *Trademarks Act*. (1 mark)

**Answer:**  
Application  
Section 55 of the *Trademarks Act*

- d. (Q5) Which Court or Courts has/have the jurisdiction to order that any entry in the register be struck out or amended (2 marks) Cite the relevant provision of the *Trademarks Act*. (1 mark)

**Answer:**  
Federal Court  
Section 57(1) of the *Trademarks Act*

- e. (Q6) When asking questions in a cross-examination, what form should the questions ideally take - open-ended questions or closed-ended questions? (1 mark) Explain why. (1 mark)

**Answer:**  
Closed-ended questions (1 mark) because open-ended questions provide the affiant with the opportunity of completing **OR** improving its evidence. (1 mark)

- f. (Q7) Briefly describe the two *bona fide* use exceptions to trademark infringement of a registered trademark (2 marks) Cite the relevant provision of the *Trademarks Act*. (1 mark)

**Answer:**  
Any *bona fide* use of his or her personal name as a trade name (1 mark) any *bona fide* use, other than as a trademark, of the geographical name of his or her place of business or of any accurate description of the character or quality of his or her goods or services. (1 mark)  
Section 20(1.1) of the *Trademarks Act* (1 mark)

- g. (Q8) Identify the length of time (1 mark) and after what point in time (1 mark) for which no trademark registration shall be expunged or amended or held invalid on the ground of the previous use or making known unless it is established that the person who adopted the registered trademark in Canada did so with knowledge of that previous use or making known. Cite the relevant provision of the *Trademarks Act*. (1 mark)

**Answer:**

5 years **(1 mark)** from the date of registration of a trademark or from July 1, 1954, whichever is the later [Note candidate only needs to state - from the date of registration of a trademark ] **(1 mark)**  
Section 17(2) of the *Trademarks Act* **(1 mark)**

- h. **(Q9) True or False:** Depreciation of goodwill in the *Trademarks Act*, like statutory passing-off does not require a registered trademark as an element of the cause of action. **(1 mark)** (Q10) Cite the relevant provision of the *Trademarks Act*. **(1 mark)**

**Answer:**  
False **(1 mark)**  
Section 22(1) of the *Trademarks Act* **(1 mark)**

- i. (Q11) What is hearsay? **(1 mark)**

**Answer:**  
A statement written or oral that is made out of court (or outside of Trademark Opposition/S. 45 proceedings) that is being presented in Court to prove the truth of that statement. Acceptable response: "on behalf of someone else" [Note candidate only needs to state – that statement is made out of Court or out of Trademark Opposition/S. 45 proceedings but not both] **(1 mark)**

- j. **(Q12) Yes or No:** Is hearsay evidence generally admissible in trademark opposition proceedings? **(1 mark)**

**Answer:**  
No

- k. (Q13) What are the two conditions that need to be met for hearsay exceptions? **(1 mark for each condition; Total 2 marks)**

**Answer:**  
Necessity and reliability

### Question 3 (10 marks)

On behalf of your client, your firm has requested the issuance of a Section 45 Notice against the registration for the trademark SAT 'N KNIT (TMA765,234) owned by The Knittery Inc. and covering the following goods and services:

Goods:

Knitting yarn

Knitting tools, namely, knitting needles and stitch markers

Knitting patterns

Yarn storage containers and project bags

Services:

Retail store services in the field of knitting yarns and knitting

Providing knitting classes

Organizing and moderating online discussions groups and demonstrations on the subject of knitting

Operation of a café

Design services, namely, offering design services focused on selecting home paint colours

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

**IN THE CANADIAN TRADEMARKS OFFICE**

**In the Matter of a S. 45 Proceeding Regarding Registration No. TMA765,234 for the trademark SAT 'N KNIT owned by The Knittery Inc.**

I, Pearl Buttons, of Burlington, Ontario, hereby MAKE OATH AND SAY AS FOLLOWS:

1. I am the president of The Knittery Inc. (hereinafter "my Business" or "the Registrant") and the owner/operator of the store SAT 'N KNIT ("my Store") which opened in October 2015. In that capacity, I am familiar with the use of the trademark SAT 'N KNIT and have personal knowledge and maintain records of and/or have access to, corporate records relating to the matters to which I hereinafter depose.
2. The Knittery Inc. was incorporated under the laws of Canada on March 17, 2015.
3. The Knittery Inc. owns Canadian Registration No. TMA765,234 (the "Registration") for SAT 'N KNIT (the "Trademark") covering the following goods and services:

Goods:

Knitting yarn

Knitting tools, namely, knitting needles and stitch markers

Knitting patterns

Yarn storage containers and project bags

Services:

Retail store services in the field of knitting yarns and knitting

Providing knitting classes

Organizing and moderating online discussions groups and demonstrations on the subject of knitting

Operation of a café

Design services, namely, offering design services focused on selecting home paint colours

(the “Goods and Services”)

4. Section 45 proceedings have been commenced against the Registration. The S. 45 Notice is dated August 11, 2022 and, in response to the Notice, use of the Trademark must be shown between August 11, 2019 and August 11, 2022 (the “Relevant Period”).
5. My Business has sold the Goods and Services in Canada since The Knittery Inc. was founded and especially since my store SAT ‘N KNIT opened in Burlington, Ontario on March 17, 2015.
6. During the pandemic, I have at times had to close my store but I have continued to sell the Goods online, with customers collecting their purchases “curb-side”. All classes have moved online and our online discussion groups have continued, and in fact grown, during the pandemic.
7. The Trademark appears on the outside signage of my Store, as well as on the website at [www.satnknit.ca](http://www.satnknit.ca). The Trademark appears on paper bags and on invoices that are given to customers who purchase the Goods and on the label and/or packaging for some of the products that are sold at my Store.
8. Now produced, shown to me and enclosed as a bundle as **Exhibit A** are representative invoices showing sales to Canadians over the past three years. The Trademark appears on each of these invoices, which were given to customers after they made a purchase at my Store. In particular, the invoices at Exhibit A show the sale of knitting yarn, knitting needles and knitting patterns and there are 5 invoices for each of those goods showing sales for each of the one-year periods of the Relevant Period.
9. In each of 2020, 2021 and 2022, my Business gave away 50 project bags on which the Trademark appears. My daughter created the artwork for these bags, with a different design being featured each year, but with the Trademark appearing prominently on the bag in every case. These bags were given out to my students when classes were held at the store and, during the pandemic, have been used to package purchases from customers who pick up their orders curbside. I find that these bags really get around and are a wonderful way to have my Trademark seen by knitters and thus promote my Business.
10. Now produced, shown to me and enclosed as **Exhibit B** to this my Affidavit is a photograph of one of those bags.
11. When the pandemic began, in March 2020, I was forced to close the café which I had, until then, operated from inside my Store.
12. Now produced, shown to me, and enclosed as **Exhibit C** to this my Affidavit are representative invoices showing sales of coffee, pastries and the like from August 2019 to March 2020. I have not yet re-opened the café but intend to do so in the fall of 2022, unless a new variant causes further havoc and uncertainty. For now, it does not make sense for me to stock and staff this service and, in fact, I prefer to not encourage my customers to linger indoor in the store unnecessarily.
13. In terms of the design services, those have been offered by one of my friends, Ms. Ruby Brown. She is a designer by trade and we figured that, when choosing yarn colours,

people might be inclined to turn their minds to their homes and the colours used therein. I had thought that this could be a line of work that would engage me, but the knitting side of the business has kept me busy and I have let Ruby handle the design side without any real oversight on my part. I did want her services to be offered under the auspices of my Business however so the materials that she uses, when servicing my customers, show the Trademark.

14. Now produced, shown to me and enclosed as a bundle as **Exhibit D** to this my Affidavit are sample invoices on which the Trademark appears and that were given out by Ruby to people who used the design consultation services.
15. Finally, regarding the knitting classes and online demonstrations and discussion groups, I use those mainly in order to promote my business. However, to encourage attendance for persons who do show an interest, I ask for a small payment which I then pass on to a different charity ever quarter.
16. Now produced, shown to me and enclosed as **Exhibit E** to this my Affidavit are materials from my website, from each of 2019, 2020 and 2021, that feature the Trademark and that advertise both the knitting classes and the discussion groups. For reasons of confidentiality, the roster of persons who have attended have been blocked out.
17. The facts and information contained in this affidavit are true and correct to the best of my knowledge.

**[signature of Pearl Buttons, before a Commissioner], October 31, 2022**

(Q14) For each of the Goods and Services listed below, advise your client as to whether the registration will be maintained or expunged [**1 mark**] and give the reason why [**1 mark**] (**total of 10 marks**):

1. Knitting yarn
2. Project bags
3. Operation of a café
4. Design services, namely, offering design services focused on selecting home paint colours
5. Providing knitting classes

**Answer:**

1. Knitting yarn: Expunged. The affidavit includes invoices showing sales of these goods during the Relevant Period but does not include labels or other packaging materials showing the use of the Trademark.
2. Project Bags: Expunged. The affidavit does not state nor show that the goods were sold and the fact that goods showing the Trademark were given away, even if to promote the business, does not count as trademark "use" with goods.
3. Operation of a café: Maintained. The affidavit shows sales of those services during the Relevant Period. OR Trademark appears on signage
4. Design services, namely, offering design services focused on selecting home paint colours: Expunged. The affidavit seems to indicate that the Trademark is used under

license in association with those services, but there is no discussion showing that the Registrant controls the character and quality of the services that are offered.

5. Providing knitting classes: Maintained.

The affidavit shows invoices bearing the Trademark that were generated and paid by participants and thus shows the sale of the services during the Relevant Period.

OR

Because of paragraph 16 of the affidavit, the services were advertised during the Relevant Period and that would count as use.

(Either answer will be acceptable)

**Question 4 (1 mark)**

(Q15) Can an agent advertise their fees? (1 mark) Yes or No

**Answer:**

Yes

**Question 5 (20 marks)**

Your client, Liquefactum Inc. (“Liquefactum”), is a Canadian energy drink manufacturer located in Calgary, Alberta. Liquefactum was incorporated on January 12, 2007. Liquefactum sells its energy drinks, graphic t-shirts, and energy bars through its e-commerce store located at the domain liquefactumtodrink.ca and through authorized distributors under contract. Liquefactum uses the trademark and trade name LIQUEFACTUM and holds one (1) trademark registration in Canada as set out below:

<b>Registration number:</b>	TMA2305487
<b>Applicant:</b>	Liquefactum Inc.
<b>Type(s):</b>	Word
<b>Filed:</b>	April 3, 2007
<b>Registered:</b>	June 10, 2010
<b>Trademark:</b>	LIQUEFACTUM
	<b>Goods</b> (Nice class & Statement)  25 (1) Graphic t-shirts

Liquefactum uses the following trademark LIQUEFACTUM Design:






Liquefactum has used the trademark and trade name LIQUEFACTUM, as well as the LIQUEFACTUM Design, in association with energy drinks, graphic t-shirts, and energy bars since at least as early as Liquefactum's incorporation date.

It is now 4:00pm on Friday, September 23, 2022, and your client's in-house counsel, from whom you normally receive instructions, contacts you about two (2) trademark applications that appeared on an earlier Liquefactum monthly trademark watch. The applications have been filed by Alpha Delta Inc., the particulars of which have been advertised in Vol. 69 No. 3535 of the *Trademarks Journal* dated July 27, 2022, and are set out below:

<b>Application number:</b>	2,220,245
<b>Applicant:</b>	Alpha Inc.
<b>Address of applicant:</b>	123 Main Street Suite 100 Ottawa, Ontario Canada A1B 1A1
<b>Type(s):</b>	Word
<b>Filed:</b>	May 28, 2020
<b>Trademark:</b>	LIQUEFACTUM
	<b>Goods</b> (Nice class & Statement)
	30 (1) Energy bars
	32 (2) Tonic water and energy drinks

<b>Application number:</b>	2,220,254
<b>Applicant:</b>	Alpha Delta Inc.
<b>Address of applicant:</b>	123 Main Street Suite 100 Ottawa, Ontario Canada A1B 1A1
<b>Type(s):</b>	Design
<b>Filed:</b>	May 28, 2020
<b>Trademark:</b>	
	<b>Goods</b> (Nice class & Statement)
	30 (1) Energy bars
	32 (2) Tonic water and energy drinks
	34 (3) Vaping pens for smoking purposes

Your client also informs you that the word “liquefactum” means liquefied when translated to English from Latin. Your client also informs you that Alpha Delta Inc.’s vaping pens with model number 5367885 are contrary to Section 7.2 of the Federal *Tobacco and Vaping Products Act*, and Alpha Delta Inc. is not authorized to manufacture or sell those specific vaping pens.

Your client instructs you to take immediate steps to stop Alpha Delta Inc. from securing registration of the 2,220,245 and 2,220,254 applications. You take immediate steps to begin preparing statements of opposition.

- a) (Q16) Based on the facts provided, identify the four (4) strongest grounds of opposition in regard to the LIQUEFACTUM trademark application (application number 2,220,245) that you consider to have the greatest chance of succeeding at opposition and resulting in the refusal of the application in its entirety. Cite the relevant provisions of the *Trademarks Act* and, if applicable, the *Trademarks Regulations* (1 mark per citation). Point form is acceptable and there is no need to reference material dates. State the ground and the facts from the fact pattern which support each ground.

**(18 marks total: two grounds are worth 10 marks total and two grounds are worth 8 marks total)**

**Answer:**

- Point form is okay
- No need to reference material dates or Section 16(3) of the TMA

**1. (4 marks)**

38(2)(a) (1 mark)

The application does not conform to the requirements of subsection 30(2) (or 30(2)(d)) (1 mark), and R31(a) (1 mark)

in that the application as filed did not contain the applicant's name (or correctly identify the applicant) (1 mark)

**2. (5 marks)**

38(2)(c) (1 mark) and 16(1)(a) TMA (1 mark)

The Applicant is not the person entitled to registration of the trademark (or LIQUEFACTUM) because it was confusing with the Opponent's trademark LIQUEFACTUM (1 mark) Not all underlined wording is required; however, must indicate the applicant is not the person entitled to registration of the trademark

which the Opponent has previously used in Canada (1 mark)

in association with energy drinks and energy bars (1 mark)

**3. (5 marks)**

38(2)(c) (1 mark) and 16(1)(c) TMA (1 mark)

The Applicant is not the person entitled to registration of the trademark (or LIQUEFACTUM) because it was confusing with the Opponent's trade name LIQUEFACTUM (1 mark)

which the Opponent has previously used in Canada (1 mark) Not all underlined wording is required; however, must indicate the applicant is not the person entitled to registration of the trademark

in association with its business of selling of energy drinks and energy bars (would also accept just a list of the goods similar to the 38(2)(c)/16(1)(a) ground above) (1 mark)

**4. (4 marks)**

38(2)(d) (1 mark) and s2 TMA (1 mark)

The trademark (or LIQUEFACTUM) is not distinctive (1 mark) in that it does not actually distinguish and is not adapted to distinguish the Applicant's goods from the goods (or listing the goods "energy drinks and energy bars") of the Opponent having regard to the Opponent's previous use of the trademark LIQUEFACTUM (1 mark)

- b) (Q17) The below ground of opposition in regard to the LIQUEFACTUM Design application (application number 2,220,254) could be deficient and may not result in the refusal of the application in its entirety. Identify the deficiency (1 mark) and provide the reason as to why the ground may not be a strong ground of opposition leading to the refusal of the application in its entirety (1 mark). Assume that the below ground of opposition is the correct ground of opposition to include in a statement of opposition for the application.

*Pursuant to section 38(2)(f) of the Trademarks Act, the Applicant was not entitled to use the LIQUEFACTUM Design mark in Canada in association with the goods, at the filing date of the application in Canada, since it is contrary to Section 7.2 of the Federal Tobacco and Vaping Products Act.*

**Answer:**  
(2 marks)

**Deficiency:** "the goods" – should be specifically vaping pens for smoking purposes (1 mark)  
**Why:** the ground can only apply to the specific goods (vaping pens for smoking purposes), and thus, would not lead to the refusal of the application in its entirety (1 mark)

#### Question 6 (4 marks)

Your client is a start up that offers you stock in their private company in lieu of payment of your firm's fees and disbursements. (4 marks)

- a. (Q18) **Yes or No:** Can you accept stock in their private company in lieu of payment of your firm's fees and disbursements? (1 mark)

**Answer:**  
No

- b. (Q19) Briefly explain (1 mark for each reason, Total 2 marks)

**Answer:**  
It is a conflict of interest (1 mark).  
You cannot have a financial interest in your client's affairs (1 mark) or an agent, an associate, a firm partner or a family member having a personal financial interest in a client's affairs or in a matter in which the agent is requested to act for a client such as a partnership interest in a joint business venture with a client (1 mark)

c. (Q20) Cite the relevant authority (1 mark)

**Answer:**  
Code of Professional Conduct / Rules of Ethics

### Question 7 (20 marks)

You are a Trainee Supervisor to a Trademark Agent in Training (a Class 3 Licensee). As part of a training exercise, you provide the following affidavit to the Trademark Agent in Training. You provide the Trademark Agent in Training with the following information:

- the affidavit was served by the Opponent in a trademark opposition proceeding;
- the Opponent is a corporation duly incorporated under the laws of the State of Delaware in the United States of America;
- you represent the Applicant, 123 Ontario Inc., which is an Ontario corporation;
- the application for the trademark CADDLE was filed on January 9, 2019
- the Statement of Opposition was filed October 1, 2020
- the affidavit represents the Opponent's Rule 50(1) evidence;
- the only grounds of opposition brought by the Opponent are related to confusion under section 38(2)(c) and 16(1)(a) of the *Trademarks Act*, as well as non-distinctiveness under section 38(2)(d) and section 2 of the *Trademarks Act*; and
- focus on the deficiencies in the affidavit which are located as follows:
  - one (1) in each of paragraphs 5, 6, 8, 9, 10, and 11
  - one (1) in paragraph 7 when combined with Exhibit A
  - two (2) in the jurat/signature block, and
  - one (1) in Exhibit A.

(Q21) You instruct the Trademark Agent in Training to identify the **ten (10) clear deficiencies or weaknesses in the affidavit below**. In anticipation of the Trademark Agent in Training providing answers, you create an answer guide. Identify the deficiency or weakness in association with the above-mentioned locations in the affidavit (1 mark per deficiency) and provide a brief explanation why the deficiency or weakness is problematic (1 mark per explanation).

The deficiencies or weaknesses to be identified can be substantive to the issues at hand or technical in nature. Assume that all exhibits were properly included in the affidavit. Only the first ten (10) answers will be marked.

**TO:** Registrar of Trademarks

**IN THE MATTER** of an Opposition by 456 Delaware Inc. to Canadian Trademark Application No. 2,219,254 for the alleged trademark CADDLE filed by 123 Ontario Inc., and advertised in the August 4, 2020 issue of the *Trademarks Journal*.

**AFFIDAVIT**

I, Janice Derek, of the City of Toronto, in the Province of Ontario, do SOLEMNLY AFFIRM THAT:

1. I am a director of 456 Delaware Inc. (hereinafter referred to as the “**Opponent**”), and as such, have knowledge of the matters contained in this affidavit.
2. The Opponent is a corporation incorporated under the laws of the State of Delaware in the United States of America on or about May 5, 2010.
3. In my capacity as a director, I have full access to the books and records of my company, which records I believe to be accurate, and I have consulted such books and records for the purpose of preparing and affirming this affidavit.
4. The Opponent has been selling plastic storage bins in association with the word CATTLE in the United States of America since February 5, 2015.
5. The Opponent sells plastic storage bins in association with the word CATTLE in Canada through a Canadian company, For Cattle Inc., which manufactures its own plastic storage bins independently.
6. The President of For Cattle Inc., Jimmy Derek, indicated to me on May 5, 2022, that CATTLE appears at the bottom of all plastic storage bins in Canada, as well as on labels affixed to the plastic storage bins.
7. Now shown to me and attached as Exhibit “A” is a label with the CATTLE mark printed in all capitals and which is representative of labels regularly affixed to the plastic storage bins when sold by For Cattle Inc.

8. Pursuant to Section 4 of the *Trademarks Act*, the Opponent has been using the trademark CATTLE in association with plastic storage bins in Canada as defined therein.
  
9. The pronunciation of the Opponent's trademark creates confusion, since the pronunciation of CATTLE is similar to the pronunciation of the applied for mark CADDLE.
  
10. The Opponent began selling CATTLE branded storage containers to various retailers on March 1, 2021. Now shown to me and attached as Exhibit "B" is an invoice dated May 20, 2022 which is representative of invoices from the period of March 1, 2021 to March 1, 2022 for the sale of plastic storage containers in association with the CATTLE mark.
  
11. The sales figures for storage containers sold in Canada and the US under the mark CADDELLE and other marks, including CATTLE, in association with various goods in Canada for the years from 2015 to 2022 are as follows:

Year	Amount in Canadian Dollars
2015	\$576,050.00
2016	\$625,003.20
2017	\$704,353.50
2018	\$340,020.50
2019	\$443,450.09
2020	\$4,530.00
2021	\$380,232.23
2022	\$400,000.00

12. I make this affidavit in support of the Opposition and for no other improper purpose.

SOLEMNLY AFFIRMED before me at )  
 the City of Toronto in the province of )  
 Ontario, on October 25, 2022. )  
 )  
 )  
 )  
 )

) Janice Derek

\_\_\_\_\_  
 A Commissioner for Taking Affidavits,  
 etc.  
 (My commission does not expire)

\_\_\_\_\_  
 654 Delaware Inc.

Name: Jonathan Dowel

This is Exhibit "A"  
to the Affidavit of Janice Derek  
Affirmed before me on October 25, 2022

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A Commissioner for Taking Affidavits, etc.  
(My commission does not expire)

# CATTLE

**Answer:**

1. Paragraph 5:

**Deficiency:** There is no evidence/explanation of control over the character or quality of the goods (or the Canadian company manufactures without control over character and quality by 456 Delaware Inc). (1 mark) Or no mention of licensing

**Explanation:** Control over the character or quality of the goods is required so that use by a licensee can be deemed to be use by the trademark owner (or control is required for use to enure/accrue to the benefit of a trademark owner). (1 mark)

2. Paragraph 6:

**Deficiency:** Information from Jimmy Derek is hearsay. (1 mark)

**Explanation:** Hearsay is [generally] not admissible (or inadmissible). (1 mark)

3. Paragraph 7:

**Deficiency:** Exhibit A label does not show any public notice of use of the mark as a licensed use nor the identity of the owner. (1 mark)

**Explanation:** There is no deemed control pursuant to 50(2) TMA. (1 mark)

4. Paragraph 8:

**Deficiency:** Providing an opinion on a question of law (or an issue to be determined by the Registrar). (1 mark)

**Explanation:** The determination of use (or a questions of law) rests with the Registrar. (1 mark)

5. Paragraph 9:

**Deficiency:** Providing an opinion on a question of law (or an issue to be determined by the Registrar). (1 mark)

**Explanation:** The determination of confusion (or a questions of law) rests with the Registrar. (1 mark)

6. Paragraph 10:

**Deficiency:** Evidence provided is after the material date to assess distinctiveness and entitlement (1 mark)

**Explanation:** Evidence provided after the material date for assessing the relevant grounds of opposition (distinctiveness and entitlement) may be afforded little [if any] weight (1 mark)

7. Paragraph 11:

**Deficiency:** Sales figures related to different trademarks in multiple jurisdictions. (1 mark)

**Explanation:** Unclear as to the sales of CATTLE containers. (1 mark)

8. Jurat/signature block

**Deficiency:** Not signed by commissioner. (1 mark)

**Explanation:** Defective; could be inadmissible. (1 mark)

9. Jurat/signature block

**Deficiency:** Name differs 654 Delaware Inc. is wrong also not a person - OR Janice Derek/affiant/deponent should be signing OR no signature by Janice Derek/affiant/deponent. (1 mark)

**Explanation:** Raises doubt as to whether the affidavit was reviewed by Janice Derek/affiant (or properly sworn). (1 mark)

10. Exhibit A:

**Deficiency:** Exhibit not signed by commissioner/notary. (1 mark)

**Explanation:** Defective; could be inadmissible. (1 mark)

### Question 8 (4 marks)

You represent the Opponent in an opposition proceeding. Your client is generally slow to pay the invoices rendered by your firm. One week before the due date for the opponent's evidence your client advises that they do not have the promised funds to pay for the evidence which has already taken a substantial amount of time to prepare and will take a substantial amount of time to finalize before service and filing. It is not possible obtain any further extensions of time and the client would like you to continue to represent them. (4 marks)

- a. (Q22) **Yes or No:** Can you immediately withdraw from representing your client? (1 mark)

**Answer:**

No

- b. (Q23) Briefly explain (1 mark for each reason, Total 2 marks)

**Answer:**



You can only withdraw on reasonable notice (1 mark) and in a manner that does not cause prejudice to your client, which is likely not possible 1 week before the deadline (1 mark)

- c. (Q24) Cite the relevant authority (1 mark)

**Answer:**  
Code of Professional Conduct / Rules of ethics

### Question 9 (6 marks)

True or False

- a. (Q25) Evidence submitted to the Registrar electronically is deemed to have been submitted on the date and local time on which it is received by the Registrar in Gatineau, QC . (1 mark)
- b. (Q26) The service of evidence can be effected electronically, even if the party being served has not provided their consent. (1 mark)
- c. (Q27) Section 45 Cancellation Proceedings against a Protocol registration will follow the same process as a Section 45 proceeding against a domestic registration with the exception of an additional step. (1 mark)
- d. (Q28) In Section 45 proceedings against related registrations (i.e. those that involve the submitting and serving of identical materials in concurrent proceedings with the same parties), parties are permitted to reference more than one trademark registration in their correspondence pertaining to the provision of evidence, written representations and hearing requests. (1 mark)
- e. (Q29) Where a registration has been amended to extend the statement of goods or services under section 41(1)(c) of the Act, the Registrar considers that the three-year period for such goods/services applies from the date of registration of the amendment. In Section 45 proceedings, a registered owner is still required to furnish evidence of use in respect of goods or services that have been listed in a registration for less than three years. (1 mark)
- f. (Q30) Upon written request, the Registrar can order cross-examination on an affidavit or statutory declaration furnished as evidence in Section 45 proceeding. (1 mark)

**Answer:**  
a. True  
b. False  
c. True  
d. True  
e. False  
f. False

### Question 10 (2 marks)

(Q31) What are two risks associated when a client sends a demand letter where they are asserting rights in respect of their trademark which is registered in Canada? (2 marks; only the first two identified risks will be marked)

Answer:

**Risks: (2 marks)**

Sending a demand letter could (1 mark for each point below; 2 marks total):

1. alert the other party who may have prior rights, and thus risk to your client's position;
2. risk of invalidation / expungement; or
3. risk of litigation.

### Question 11 (1 mark)

(Q32) Identify one factor that must be present for an agent to advertise their fees? (1 mark)

Answer

(only 1 of the items below needs to be provided)

- the advertising is reasonably precise as to the services offered for each fee quoted;
- the advertisement states whether other amounts, such as disbursements and taxes, will be added to the fees; and
- the agent strictly adheres to the advertised fees in all applicable respects.

### Question 12 (10 marks)

You represent the opponent, ABC Can Inc., in a trademark opposition proceeding relating to the trademark ABC used in association with t-shirts. Two (2) weeks after filing the opponent's statement of opposition, your client provides you with the following information in an email correspondence, which is confirmed by a phone call:

*Hello,*

*I know we already filed the statement of opposition on October 6, 2022, but new information was just provided to me from our director of licensing who just returned from a leave of absence. Apparently, the applicant, 987 Canada Inc. was one of our non-exclusive distributors under contract from April 26, 2016 to April 26, 2022. The applicant indicated that they were terminating the non-exclusive distribution agreement due to "outrageous fees."*

*Our non-exclusive distributor agreements all contain provisions acknowledging ABC Can Inc.'s rights to the trademark ABC, as well as a restriction preventing the distributor from filing for a trademark for ABC in association with any goods/services in North America.*

*Is this information relevant for the purpose of our statement of opposition, or should it just be brought up when filing our evidence?*

(Q33) You discuss the bad faith ground available with your client and your client instructs you to ask for leave to amend the statement of opposition. Draft a request seeking leave to amend the statement of opposition. In your request, include all four (4) circumstances the Registrar will consider (**4 marks**) and justify why each circumstance justifies your client's request for leave (**4 marks**). Your request can be in point form, however, you will need to provide an opening and closing statement (**2 marks**).

**Answer:**

1. General formulation explaining the purpose of the letter, eg. "The Opponent hereby requests leave to amend the statement of opposition to add an additional ground..." OR similar wording (**1 mark**)
2. The stage of the opposition proceeding. (**1 mark**) The opposition is still in an early stage/the applicant has not yet filed its counter-statement. (**1 mark**)
3. Why the amendment was not made or the evidence not submitted earlier. (**1 mark**) The evidence supporting the ground was not previously available. (**1 mark**)
4. The importance of the amendment. (**1 mark**) The amendment could effect the outcome of the opponent's case. (**1 mark**)
5. The prejudice which will be suffered by either party. (**1 mark**) The applicant will not be prejudiced as it can still respond to the statement of opposition. (**1 mark**)
6. For the reasons above we respectfully request an amendment to the statement of opposition. (**1 mark**)

**Question 13 (5 marks)**

(Q34) In point form, name the four points of information required to be set out to the Registrar in a request for a Section 45 hearing (**4 marks**). Indicate the relevant Section of the Trademark Regulations (**1 mark**).

**Answer:**

- if the party wishes to make representations by a method other than videoconference, the type of method requested (namely in person or by telephone) and an explanation as to why a method other than videoconferencing is requested (**1 mark**);
- whether the party will make representations in English or French (**1 mark**); and
- whether simultaneous interpretation will be required if the other party to the proceeding makes representations in the other official language (**1 mark**); and,
- as the case may be, any request to have a hearing longer than two and a half hours, as well as the reasons why the party considers this necessary. (**1 mark**).
- Section 74(1) of the Regulations (**1 mark**).

**Question 14 (19 marks)**

An applicant has filed its own trademark application for STOP QUICK for use in association with “pesticides”. The mark has been in use in Canada for the last 6 years and sold exclusively through Home Hardware Stores. The Examiner has cited an existing registration for KWIK STOP under registration No. TMA691,444 for use in association with “powder for use on animals during grooming to stop accidental nail bleeding”. That registration is owned by Kwiker Stopper Inc. of Winnipeg, Manitoba and the registration issued on March 2, 2020 claiming use in Canada since as early as March 1, 2018. The applicant has approached you to take over as agent of record and provide an opinion as to the issue of confusion between STOP QUICK and the cited mark KWIK STOP.

- a. (Q35) Provide the section of the Act dealing with the analysis of confusion between the marks **(1 mark)** and what section(s) would apply if your client wants to take action in court regarding the use of the cited mark **(2 marks)**. Please also identify each of the factors to consider in assessing confusion between the marks **(1 mark per factor for a total of 5)** and apply each factor to the facts of the case **(1 mark per factor)**. (point form answers are sufficient). **(Total 13 marks)**

**Answer:**

Subsection 6(5) of the TMA **(1 mark)**

Sections 7(b) for passing off and infringement **(2 marks)**

Subsection 6(5) of the TMA **(5 marks)**

- **(a)** the inherent distinctiveness of the trademarks or trade names and the extent to which they have become known; **(1 mark)**
- **(b)** the length of time the trademarks or trade names have been in use; **(1 mark)**
- **(c)** the nature of the goods, services or business; **(1 mark)**
- **(d)** the nature of the trade; **(1 mark)** and
- **(e)** the degree of resemblance between the trademarks or trade names, including in appearance or sound or in the ideas suggested by them **(1 mark)**.

Applied facts to section 6(5) factors **(any 5 of the following):**

- both marks have the same degree of inherent distinctiveness **(1 mark)**
- both marks have been used in Canada **(1 mark)**
- STOP QUICK has prior use **(1 mark)**
- the nature of the goods are different (pesticides v. styptic powder) **(1 mark)**
- both goods fall under the same class of goods **(1 mark)**
- the channels of trade differ (sold to different customers) OR potential for overlap in the channels of trade since both products could be sold at the same type of store **(1 mark)**
- although spelled differently, the marks are phonetically similar **(1 mark)**
- the marks are similar in ideas suggested (stop quick for bugs v. kwik stop for bleeding nails) **(1 mark)**

**Note maximum of 13 marks awarded**

- b. (Q36) After receiving the office action, your client had an investigator see what it could find regarding the use of the cited mark. The investigator purchased a package of KWIK STOP powder and you see that the label on the package refers to Deep Death Inc. of

Saskatoon, Saskatchewan. How might this affect your client's position and why? (2 marks)

**Answer:**

Your client might be able to cancel the cited registration (1 mark) if the Registrant, Kwiker Stopper Inc., cannot show that the mark was being used under license by Deep Death Inc. (1 mark)

- c. (Q37) Before your client has had time to respond to the office action and proceed any further in possibly obtaining its registration, it receives a demand letter from Kwiker Stopper Inc. As the owner of a trademark registration, Kwiker Stopper is threatening to commence an action for trademark infringement. What are the advantages for it to proceed in that manner, rather than to bring an action for passing off? (4 marks, i.e. 1 mark for each advantage)

**Answer:**

1. A registration has a presumption of validity.
2. An action for infringement is not limited to any geographical area OR an action for passing off is based on the geographical area where the mark relied on has been used and acquired a reputation (either accepted).
3. Damage does not have to be proven in an action for infringement.
4. In an action for passing off, the plaintiff must prove goodwill/cause of action.

**Question 15 (10 marks)**

(Q38) Match the case name with the most 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 principles for a case, only the first legal principle will be marked.

Case	Principle
A. <i>Dion Neckwear Ltd v Christian Dior SA et al</i> , 2002 FCA 29	1. If ordinary casual consumers somewhat in a hurry are likely to be deceived about the origin of the wares or services, then the statutory test of confusion is met.
B. <i>MC Imports Inc v AFOD Ltd</i> , 2016 FCA 60	2. If a mark was used differently than registered, the issue is, was the mark used in such a way that the mark did not lose its identity and remained recognizable in spite of the difference between the form in which it was registered and the form in which it was used.
C. <i>Promafil Canada Ltd v Munsingwear Inc</i> (1992), 44 CPR (3d) 59 (FCA)	3. A mark must be known to some extent at least to negate the established distinctiveness of another mark, and its reputation in Canada should be substantial, significant or sufficient.

Case	Principle
D. <i>Nissan Canada Inc v BMW Canada Inc</i> , 2007 FCA 255	4. If the wares or services originate in the place referred to by the trade-mark, then the trade-mark is clearly descriptive of place of origin
E. <i>Mattel, Inc v 3894207 Canada Inc</i> , 2006 SCC 22	5. The Registrar in an opposition proceeding must assess confusion on a balance of probabilities.
F. <i>Masterpiece Inc v Alavida Lifestyles Inc</i> , 2011 SCC 27	6. A registration of a word mark entitles the registrant it to use lettering and colours identical to the ones used by an opponent even if the registrant had not used it in that way.
G. <i>Bojangles' International LLC v Bojangles Café Ltd</i> , 2006 FC 657	7. What subsection 45 requires is an affidavit or statutory declaration not merely stating but "showing", that is to say, describing the use being made of the trade mark within the meaning of the definition of "trade mark" in section 2 and of "use" in section 4 of the Act. The subsection makes this plain by requiring the declaration to show with respect to each of the wares and services specified in the registration whether the trade mark is in use in Canada and if not the date when it was last used and the reason for the absence of such use since that date.
H. <i>Pizzaiolo Restaurants Inc v Les Restaurants La Pizzaiolle Inc</i> , 2016 FCA 265	8. A variant of the registered mark will constitute use of the registered mark providing the variant is not substantially different from the registered design.
I. <i>Canada (Registrar of Trade-marks) v Cie Internationale pour l'informatique CII Honeywell Bull, SA</i> (1985), 4 CPR (3d) 523 (FCA)	9. Statutory passing off under section 7(b) does not require a party to demonstrate that there is a trademark within the meaning of section 2 of the Trademarks Act
J. <i>Plough (Canada) Ltd v Aerosol Fillers Inc</i> (1980), 53 CPR (2d) 62 (FCA)	10. A plaintiff must prove possession of a valid and enforceable trade-mark, whether registered or unregistered when establishing statutory passing off.
	11. The location where a mark is used is irrelevant when considering the likelihood of confusion between an applied for or registered trade-mark and a prior unregistered trade-mark or trade-name
	12. The nature of wares or services should have less weight in a confusion analysis because the famous mark more likely will lead to the inference that the source of the two is the same.

**Answer:**

A – 5  
B – 4  
C – 8  
D – 10  
E – 1  
F – 11  
G – 3  
H – 6  
I – 2  
J – 7

**Question 16 (8 marks)**

Your new client, 1,2 Electrify Am Inc., is a US based electrical component manufacturer and holder of Canadian application no. 12345689 for ELECTRIFY AM. Your client manufactures and sells electric cables and wires in the United States of America, but does not hold any trademark registrations. Your client retained you on Friday, October 7, 2022, due to notice of a potential statement of opposition not yet filed by Jaz Electric Inc., another US based electrical component manufacturer. You determine that your client's application was advertised in the *Trademarks Journal* on September 14, 2022.

The sole director of 1,2 Electrify Am Inc., from whom you receive instructions, indicates that the sole owner of 1,2 Electrify Am Inc. is also a one percent (1%) owner of a Canadian company which manufactures and sells ELECTRIFY AM cables in Canada through a verbal consent. ELECTRIFY AM is the only thing stamped on each cable sold in Canada by the Canadian company.

Your client shows you a letter from Jaz Electric Inc., which includes a draft (not yet final) statement of opposition which relies solely on section 38(2)(c) and section 16(1)(a) and claims that Jaz Electric Inc. has used the trademark ELECTRIFY AM in Canada since at least as early as 2005. Your client informs you that the Canadian company has been manufacturing and selling cables in Canada since at least as early as 2001.

- a. (Q39) When is the deadline for Jaz Electric Inc. to file its statement of opposition against application no. 123456789 (1 mark)? Cite the relevant provisions of the *Trademarks Act* (1 mark). (2 marks)

**Answer:**

a) Two months after the advertisement of an application for the registration of a trademark (or November 14, 2022). (1 mark) Section 38(1). (1 mark)

- b. (6 marks) (Q40) **Yes or No:** Will your client be able to rely on the earlier use of the Canadian company? (1 mark)? (Q41) Explain why (3 marks). Cite the relevant provisions of the *Trademarks Act* (1 mark per citation).

**Answer:**

No (1 mark).

Verbal consent is not enough for use to accrue/enure to benefit of client in this case (1 mark).

Ownership of 1% does not imply control over character and quality (1 mark).

Section 50(1) (1 mark).

Stamp does not provide notice of trademark licence (1 mark) under section 50(2) (1 mark).

**Question 17 (2 marks)**

(Q42) What are two risks associated when a client sends a demand letter where they are asserting rights in respect of their trademark which is not registered? (2 marks; only the first two identified risks will be marked)

**Answer:**

**Risks: (2 marks)**

Sending a demand letter could (1 mark for each point below; 2 marks total):

1. alert the other party who may have prior rights, and thus risk to your client's position;
2. potentially cause the other party to file an application for the registration of a trademark prior to your client;
3. alert the other party to your client's newly filed application, which can then be opposed upon advertisement;
4. alert the other party to your client's intention to file an application; or
5. risk of litigation.