March 15, 2010

Ms. Alison Bunting  
Canadian Intellectual Property Office  
50 Victoria Street  
Place du Portage II  
Gatineau, Quebec K1A 0C9  
Canada

Dear Ms. Bunting:

The International Trademark Association (INTA) appreciates the opportunity to respond to the Canadian Intellectual Property Office’s (CIPO) consultation related to the proposal to amend Canada’s Trade-marks Act. INTA is a not-for-profit membership association of more than 5,600 trademark owners and professionals, from more than 190 countries, dedicated to the support and advancement of trademarks and related intellectual property as elements of fair and effective commerce.

For many years, INTA has worked closely with the World Intellectual Property Organization to move closer to harmonization of trademark law and practices and, in particular, the harmonization of formalities of national offices, resulting in the Singapore Treaty and the promotion of the Madrid System for registration of international trademarks, among other initiatives. INTA has also worked with national offices around the world on issues regarding adherence to the Madrid Protocol and the Singapore Treaty and the vigorous protection of non-traditional marks. As a strong supporter of the Madrid Protocol, the Singapore Treaty and the Nice Agreement, INTA encourages Canada to harmonize its laws and become more fully integrated with the international trademark community by adhering to each of these initiatives.

This submission was prepared by INTA with the assistance of its Legislation and Regulation, Non-Traditional Marks and Trademark Office Practices Committees as well as members of INTA’s policy staff. Should you require further information or wish to invite INTA’s oral testimony, please contact INTA staff liaison, Mark Neighbors at mneighbors@inta.org.

Sincerely,

Heather Steinmeyer  
President

Enclosures:  
Comments on CIPO’s consultative paper “Aligning Canada’s Trade-marks Regime with Modern Business Practices”  
INTA Trademark Examination Guidelines
SUBMISSION BY THE
INTERNATIONAL TRADEMARK ASSOCIATION
IN RESPONSE TO THE
CANADIAN INTELLECTUAL PROPERTY OFFICE’S CONSULTATION PAPER
“ALIGNING CANADA’S TRADE-MARKS REGIME WITH MODERN BUSINESS
PRACTICES”

March 15, 2010

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Acknowledgements

This submission was prepared with the assistance of the following INTA committees:

Trademark Office Practices Committee – Asia-Pacific/Canada TMO Relations Subcommittee

Legislation & Regulation Committee – Asia-Pacific/Canada Subcommittee

Non-Traditional Marks Committee – North America Subcommittee
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A. INTRODUCTION

I. About INTA

The International Trademark Association (“INTA”) is a not-for-profit membership association of more than 5,600 trademark owners and professionals, from more than 190 countries, founded in 1878 and dedicated to the support and advancement of trademarks and related intellectual property as elements of fair and effective national and international commerce. INTA members share a common interest in the protection and development of trademarks and trademark law and rely on INTA to represent and help further their trademark interests in government affairs, and to help promote those interests throughout the international trademark community. INTA’s diverse membership includes, but is not limited to, start-up organizations, major multinational corporations, intellectual property and general practice law firms, service firms, trademark consultants and academic institutions. INTA currently has 172 member firms and corporations in Canada.

For many years, INTA has worked closely with the World Intellectual Property Organization (“WIPO”) to move closer to harmonization of trademark law and practices and, in particular, the harmonization of formalities of national offices, resulting in the Trademark Law Treaty 1994 (“TLT”), as well as increasingly widespread adoption of the Madrid System for registration of international trademarks, among other initiatives. INTA has advised national trademark offices around the world on issues regarding adherence to the Madrid Protocol, the Nice Agreement, and the TLT, and, more recently, the revisions to the TLT adopted in 2006 as the Singapore Treaty on the Law of Trademarks.

B. COMMENTS

Further to the notice from Lisa Power, Director Trade-marks Branch of CIPO on December 15, 2009 requesting comment on CIPO’s consultation document titled Aligning Canada’s Trade-marks Regime With Modern Business Practices, we thank CIPO for allowing INTA the opportunity to respond.

Throughout this paper, reference to the Canadian Trade-marks Act is abbreviated to TMA and reference to the Canadian Trade-marks Regulations is abbreviated to the TMR.

I. The Singapore Treaty

The objective of the Singapore Treaty, which was adopted in 2006, is to provide international harmonization of administrative trademark registration procedures. Although the Singapore Treaty is built upon the TLT, they are separate treaties and may be ratified or adhered to independently. There are currently 19 contracting parties to the Singapore Treaty (Australia, Bulgaria, Denmark, Estonia, France, Kyrgyzstan, Latvia, Liechtenstein, Mali, Poland, Republic of Moldova, Romania, Russian Federation, Singapore, Slovakia, Spain, Switzerland, Ukraine, and the United States of America). There are another 40 countries which have signed, but have yet to accede to the Singapore Treaty.
Like the TLT, the Singapore Treaty requires that members provide for multi-class applications and registrations, and for the use of the Nice Classification system.

INTA is a strong supporter of the Singapore Treaty. The myriad of requirements and formalities of more than 200 trademark jurisdictions around the world impose tremendous costs in time and money for trademark owners. The registration procedures in some countries are so onerous that they actually become an impediment to the protection of an owner’s trademarks. Simplification and standardization, an aim of the Singapore Treaty, will help alleviate the hurdles a Canadian trademark owner must deal with when filing applications in other countries.

In our opinion, the Singapore Treaty will streamline and harmonize trademark office procedures, thus enabling trademark owners and practitioners to focus on protection and defense of marks and reducing (if not eliminating) unnecessary and time-consuming paperwork. Of equal importance, the Singapore Treaty also reduces costs. This is especially critical for small and medium-sized business owners who are working on limited budgets and have few resources.

With respect to the specific questions posed by CIPO in the consultation document, INTA has the following comments:

(1) **In what ways would trade-mark owners be expected to benefit from Canada adopting the standards of the Singapore Treaty?**

Trademark owners should expect to benefit from standardized procedures which should have the effect of making Canada’s registration system more user friendly and efficient, thus reducing compliance expenses for trademark owners. Among the benefits are the ability to divide applications, correct filing/registration errors, and to dispense with the requirement to file a certified copy of a foreign registration. Also, relief measures with respect to missed time limits are an important benefit to trademark owners.

Changing the term of registration and renewal from 15 years to 10 years is likely to be a benefit to trademark owners as it should clear the Register of marks that are not in use sooner than under the current system.

Accession to the Treaty would likely result in Canada widening the types of marks that can be registered, which would assist owners of non-traditional trademarks. Although there is no obligation under the Singapore Treaty to provide for the registration of non-traditional marks (“NTMs”), the treaty is also applicable to NTMs such as holograms, three-dimensional marks, color, position and movement marks, and also non-visible marks such as sound, olfactory, taste and touch marks.

(2) **In what circumstances might it not be in Canada’s best interests to do so?**

Adherence to the Singapore Treaty requires adherence to the *Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks* (“Nice Classification”). Although INTA is a strong supporter of the Nice Classification, and strongly supports and encourages Canada to adopt the Nice Classification, (see our comments in Part III, The Madrid Protocol, below), Canada’s adoption of the Nice Classification will likely
result in some short term costs and inconvenience for trademark owners not familiar with the Nice Classification system.

The term change from 15 to 10 years, will result in some extra costs for registrants, but these costs will be offset by improvements in the clearance of new marks. If CIPO elects to implement all or part of the Singapore Treaty, INTA would be pleased to offer additional comments on issues such as filing grounds (particularly as they relate to use requirements) and the implementation of the Nice Classification.

(3) What would be the economic impact of adopting the standards of the Singapore Treaty?

CIPO is in the best position to assess the cost to the Canadian government of implementing changes required at the Trademarks Branch and what additional fees might result from adopting the Singapore Treaty or certain aspects thereof. INTA does not believe the costs would be prohibitive, however, and as indicated, is confident that adherence to the international agreements discussed herein would provide significant long-term benefits.

II. The Madrid Protocol

The Madrid Agreement concerning the International Registration of Marks (the “Madrid Agreement”) and the Protocol relating to the Madrid Agreement (the “Madrid Protocol”) constitute the “Madrid System” administered by WIPO, providing for the international registration of trademarks. Any country that is a party to the Paris Convention (such as Canada) may join the Madrid Agreement or the Madrid Protocol or both. The Madrid Protocol was adopted in 1989 and entered into force on December 1, 1995. Under the Madrid Protocol an application for international registration can be based on a pending trademark application filed in the country of origin. Applications for international registration are administered by WIPO’s International Bureau ("IB"). As of December 2009, 84 countries belonged to the Madrid System, comprising 81 countries that are party to the Madrid Protocol, and 56 countries that are party to the Madrid Agreement. (The only three countries that are party to the Madrid Agreement and not also to the Madrid Protocol are Algeria, Kazakhstan and Tajikistan).

The Madrid System is a tremendously important tool for trademark owners seeking international protection and INTA strongly supports Canada’s accession to the Madrid Protocol. Canada’s adherence to the Madrid Protocol would broaden participation in the current system for the international registration of trademarks, a desirable goal in today’s global trade environment. If Canada adheres to the Protocol, a trademark owner based in Canada would be able to gain protection for its trademark in as many Protocol countries as desired by filing a single application at the Canadian Intellectual Property Office in a single language – English, French or Spanish – upon payment of a single set of fees. The resulting registration yields one registration certificate, with a single number and a single renewal date covering multiple jurisdictions. Without such a centralized system, a Canadian company can protect its mark only by filing through the different registration schemes in each of the countries or regions where its products or services might be sold.
INTA recognizes that Canada’s adherence to the Madrid Protocol would entail administrative changes within the Trade-marks Branch of CIPO, and INTA offers to consult with CIPO in areas in which CIPO may require assistance. INTA also recognizes that adherence to the Madrid Protocol would require Canada to make, or consider making, some substantive changes to the current Canadian trademark regime, perhaps most notably with respect to classification, the concept of use as a condition of registration and term.

Classification

An international application must contain a list of goods and services for which protection is sought, classified in accordance with the Nice Classification, and INTA also strongly supports Canada’s adoption of the Nice Classification. INTA believes that it is not beneficial for a major industrialized jurisdiction like Canada to maintain a different system than that used by other industrialized nations, and in particular its major trading partners. The adoption of the Nice Classification would be beneficial both to Canadian companies which intend to apply for international trademark applications, as well as foreign applicants seeking to protect their marks in Canada. Additionally, the use of Nice Classification would facilitate searching and clearance procedures for trademark owners when considering Canadian spending strategies. The concern that adoption of the Nice Classification system will increase fees and discourage smaller trademark owners, especially smaller Canadian trademark owners, from seeking protection in Canada may be attenuated if CIPO chooses a fee structure, for example a flat fee covering several classes, to minimize the impact of adopting the Nice system. Moreover, the availability of the Madrid System may actually increase the international application filings by less sophisticated, smaller companies, who before the adoption of the Madrid System, were not able to avail themselves of such a simple international registration process.

Use

Although INTA understands that there is nothing in the Madrid Protocol that would require Canada to abandon its pre-registration use requirement, the impact of such a system upon foreign applicants using the Madrid System to file in Canada would be detrimental and contrary to the aim of international harmonization and facilitation for protection. If Canada were to issue a provisional refusal in respect of every international application that did not comply with pre-registration use requirements, it would result in a substantial burden on the TMO and undoubtedly create a backlog of applications and impede foreign applicants from obtaining protection in Canada that they would otherwise be able to obtain in other contracting countries. Given that the concept of use is the foundation upon which Canadian trademark law is built, it would appear appropriate that any registrant who has obtained a registration in Canada should be required within some reasonable duration post-registration to declare that the trademark has been used in Canada in order to maintain the registration.

INTA notes that Section 45 TMA is recognized as an ideal cancellation provision, and explicit reference to this Canadian legislation is made in the INTA Model Law Guidelines commentary regarding model procedures for cancellation. However, INTA notes that Canada’s Section 45 summary expungement procedure and invalidity proceedings pursuant
to Section 18 TMA require third parties to initiate the mechanism to clear suspect registrations from the Register.

INTA supports the view that post-registration proof of use should be required to maintain a registration. INTA notes that the U.S. law may provide a useful model for Canada upon which to base such a regime, namely requiring that the registrant demonstrate that the registered mark remains in use: 1) within one year preceding the expiration of the sixth year after registration; 2) within one year before the first renewal; and 3) within one year preceding each subsequent renewal of the registration.

Term

Under the Madrid System, an international registration is effective for 10 years and may be renewed for further periods of 10 years on payment of the prescribed fees. Given that Canada’s initial and renewal terms are for periods of 15 years, INTA supports amending s.46 of the TMA to provide for an initial and renewal term of 10 years even if Canada decides not to adhere to the Singapore Treaty. If Canada adheres to the Madrid Protocol, INTA believes that it would not be tenable for Canada to have a domestic registration term of 15 years and an international registration term of 10 years.

INTA notes that one of the features of the Canadian trademark system that foreign trademark owners find attractive is the comparatively low official fees charged by the TMO. INTA recognizes that some official fee adjustments may be necessary if Canada joins Madrid. However, INTA encourages CIPO to maintain reasonable fee structures.

Although Canada’s accession to the to the Madrid Protocol would entail legislative and regulatory amendments to Canada’s Trade-marks Act and Trade-marks Regulations, and may require administrative changes within the Canadian Intellectual Property Office, INTA believes that those changes can be accomplished at reasonable cost and that the benefits to Canadians will outweigh those costs.

With respect to the specific questions posed by CIPO in the consultation document, INTA has the following comments:

(1) **What would the benefits be for Canadian firms in using the Madrid Protocol? Is it likely that Canadian businesses will use it for some international registrations? Who will likely use it more – large or small companies?**

The Madrid Protocol offers meaningful access to international trademark protection for small and medium-sized enterprises (SMEs), while potentially cutting the costs and providing a more streamlined process for Canadian companies of every size. The “one-stop” filing mechanism central to the Madrid Protocol has particular value for SMEs that cannot afford to retain counsel around the world in order to file separate trademark applications in each country in which protection is sought. The Madrid Protocol thus makes an international trademark protection program a viable reality for SMEs, who can leverage their trademark protection budgets through the one-stop filing mechanism. Without the Madrid Protocol, SMEs wishing to offer their
products and services in international markets are often left with an unfortunate choice: avoid overseas markets altogether or leave themselves vulnerable to pirates or opportunists - who may register the owner’s mark in a foreign country and then seek to sell it back to the trademark owner. Unlike Canada, many countries offer no trademark protection at all unless the mark is registered.

Larger Canadian companies also will benefit from adherence to the Madrid Protocol; the “one-stop” approach will greatly ease the ability of major Canadian companies to increase brand awareness and sales, thereby enhancing their competitiveness in overseas markets as they expand their presence in the world economy.

The Madrid Protocol is likely to appeal most to those Canadian businesses whose goods or services have significant export potential in at least four overseas countries. The extent of costs savings of using the Madrid System to extend protection in comparison to direct national filings depends upon the particular jurisdictions involved, since the differential in Madrid System filing fees versus national filing fees varies from jurisdiction to jurisdiction. For example, while a Canadian firm trading solely in Canada and the United States without prospect of further foreign expansion would not find the Madrid System cost-effective, a Canadian firm exporting its wares to the United States, Europe, Japan, and China will find the Madrid System quite cost effective, particularly at the filing stage and to those Canadian firms sourcing manufactured products overseas, for example in China, for sale, distribution and licensing in the United States, Europe and Japan.

In addition to the costs savings in initial filing fees, there are costs savings at other stages in the lifespan of the registration. Consider a Canadian firm with ten trademark registrations in ten countries needing to make an amendment to the registration, e.g. a simple change of address. Although such a process may presently cost the Canadian firm thousands of dollars to effect the changes to the portfolio, under the Protocol, only one amendment application needs to be filed with the International Bureau at a cost of 150 Swiss francs, or less than CDN $150.

Canadians’ comfort level in use of the Madrid System would likely be a gradual but steady process, as Canada trademark practitioners gain hands-on familiarity with the international registration process as it affects their clients’ trademark interests at home and abroad. Ultimately, it would be the trademark owner’s option, aided by trademark counsel’s strategic guidance, to choose on a case-by-case basis whether to file direct national and regional applications, or to take advantage of the alternative filing mode of the Madrid System.

(2) What would be the disadvantages of Canadian firms in using the Madrid Protocol?

If Canada were to accede to the Madrid Protocol, Canadian firms would have a choice whether or not to use the Madrid System of international registration, or to continue to use the national or regional direct filing approach. Presently Canadian firms have no such choice and must rely solely on the latter approach, unless the Canadian firm has a real and effective industrial or commercial establishment in a country which is party to the Madrid Protocol.
Because the Madrid System provides applicants from member counties with such a choice, INTA is of the view that there would be no disadvantage to Canadian firms in using the Madrid Protocol. Canadian firms who are educated to the relative advantages (e.g. significant reduction in transaction costs) and disadvantages (e.g. dependence on basic mark for five years and the possibility of central attack) of using the Madrid System versus the direct filing approach will be able to use a cost/benefit approach to determine which makes sense on a case by case basis.

At present, the TMA requires that an applicant’s identification of wares and services be described in “ordinary commercial terms.” Accordingly, because the Madrid System requires that the international registration be identical to the home-country basic registration, Canadian applicants may in some situations find that they are able to obtain broader coverage by filing nationally or regionally. However, the potential cost savings of Madrid where the trademark owner wishes to file in multiple jurisdictions is such that a narrower identification based on the Canadian basic application may be a desirable trade-off. Although membership to Madrid may encourage Canada to relax the current Canadian requirements for specificity in the identification of wares and services, in the event that Canada does not so relax these requirements, trademark owners would still have the option to file national applications in each foreign jurisdiction in which protection was sought with broader descriptions in each country that would allow it.

(3) How would foreign firms benefit from using the Madrid Protocol to protect their trade-marks in Canada?

The benefits of the Madrid Protocol to member countries are reciprocal. For example, Canada’s accession to the Madrid Protocol, coupled with the European Community’s 2004 accession, would create the option for European firms to use their Community Trade Marks as the basis for international applications and registrations extending protection to Canada.

Canada’s joining the Madrid Protocol would enrich and diversify the brand offerings to Canadian consumers, as increasing numbers of overseas brand owners establish their Canadian trademark presence via the Madrid System. Many foreign firms from countries which have adhered to the Madrid Protocol do not file nationally in Canada simply because Canada is not a country which can be designated through the international filing system. If Canada becomes a member of the Madrid Protocol, such foreign firms would be encouraged to designate Canada, thereby leading to an increase in registrations, and, accordingly, increased certainty during the trademark clearance process for both Canadian firms and foreign firms.

(4) Are there overall economic benefits to Canada in using the Madrid Protocol?

Trade Relationships

Canada’s accession to the Madrid Protocol would significantly broaden participation in the system of international registration of trademarks that has expanded so rapidly since the mid-1990’s. This is in keeping with a modern and efficient trademarks regime that can help to enhance a country’s overall competitiveness and is consonant with CIPO’s stated commitment to improving the intellectual property administrative framework with a specific focus on responsiveness to new business practices and improved international standards. At present Canada is among a few countries that are significant players in global trade but which are not
members of the Madrid System. Canada’s accession would enhance access for Canadian business to foreign markets through alignment of Canada’s laws with those of its largest trading partners.

International trademark treaties are related to trading relationships, and Canada’s adherence to the Madrid Protocol should enhance existing international economic relationships and facilitate new ones. Most of Canada’s largest trading partners (both import and export) are members of the Madrid Protocol. The United States, by far Canada’s most significant trading partner (and vice versa), joined the Madrid Protocol in 2003. In 2004, the European Community also joined the Madrid Protocol system, thus providing the possibility to use Community Trade Marks as a basis for international trademark applications and for Community Trade Marks to be applied for via the international route. Based on Industry Canada trade statistics for 2008, Canada’s top 10 export markets accounted for 90% of total exports from Canada, and the top 10 import markets accounted for 81.6% of total imports to Canada. All but one of Canada’s top 10 export markets and all but two of Canada’s top 10 import markets are members of the Madrid Protocol. Algeria, which accounted for 1.4% of imports in 2008 (ranked 7 of 10), is a member of the Madrid Agreement, but not the Madrid Protocol. Mexico, which accounted for 1.2% of exports (5 of 10) and 4.1% (3 of 10) of imports in 2008 is the only country on either list of Canada’s top 10 trading markets that is not a member of the Madrid System.

Healthy Canadian Firms, Healthy Canadian Economy

Government officials worldwide are increasingly recognizing the importance of promoting and supporting brands as this provides direct stimulus to a country’s economy. For example, on February 23, 2010 David Lammy, the United Kingdom’s Minister for Higher Education and Intellectual Property, stated: “A key component seeing us into better times will be how we support brands and encourage them for the future.” Accordingly, providing Canadian firms with choices that will assist with the enhanced protection of Canadian brands positively contributes to the Canadian economy.

As noted in the CIPO consultation document, “Canada is the only developed country not party to [the Madrid Protocol].” Canada’s joining the Madrid Protocol would offer to Canadian firms an important alternative to consider when seeking trademark protection internationally, an alternative which offers the possibility of significant reductions in filing and transaction costs associated with the international protection of Canadian trademarks. The Protocol provides Canadian firms with the ability to contain costs and increase their brand recognition and sales of Canadian goods in foreign markets, both of which assist in strengthening Canada’s economy through increased investment and jobs. At the same time, by allowing enhanced opportunities for foreign applicants to seek protection of their trademarks in Canada, it may lead to an increase in healthy competition within the Canadian market, which would tend to be a benefit for Canadian consumers which in turn would presumably benefit to the Canadian economy.

Presently, the only way in which a Canadian firm can partake in the benefits of the Madrid System is to set up an offshore legal entity in a Madrid member country or to file applications for registration of its marks through a foreign affiliate in a Madrid member country. In both cases, the Canadian firm is required to expend resources outside of Canada which could otherwise be expended within Canada, and thus contribute to the Canadian economy.
III. Non-Traditional Trademarks

In 1954, when Canada last implemented a major overhaul to its trademarks legislation, it changed the definition of “trade-mark” to specifically extend protection to marks used in association with services. Prior to that time, there existed no common law or statutory right to a trademark in association with services. The rationale limiting trademark protection to marks used in association with goods stemmed from the historical requirement that the mark be physically attached to the product. “The justification for trade-mark protection never quite caught up with the concept of using trade-marks in association with the activities of commerce as contrasted with their use in physical relation thereto.” Recognizing the growing importance of the service sector to the economy and since service marks had gained statutory protection in the United States in 1946, Canada became one of the first countries to specifically legislate their recognition and protection.

Not surprisingly, the economy and market dynamics have continued to evolve and develop since 1954. In particular, many companies in Canada and internationally now create and utilize “non-traditional” marks to distinguish the source of their goods and services. The more common types of non-traditional marks include sound marks, scent/smell marks, moving image marks such as holograms, and color marks. Many of Canada’s major trading partners, including the United States, now recognize the function and importance of non-traditional marks and allow for their registration.

The Singapore Treaty on the Law of Trademarks, which is also being examined by CIPO as part of this process, explicitly recognizes the registrability of non-traditional marks and seeks to harmonize the administrative procedures for trademark registration including the processes for non-traditional trademarks. While Canada has allowed for the registrability of color marks through the development and issuance of Practice Directions, the registrability of other non-traditional marks is recognized as more problematic without legislative and regulatory changes. As Canada did in 1954 when it recognized the growing importance of service marks, so too, should it address the growing importance of non-traditional marks to the market, consumers and the international community.

INTA supports the Singapore Treaty and the registration of non-traditional marks that are visually perceptible, or capable of being depicted or described by written notation, diagrams or other sufficiently certain visual means, as long as these non-traditional marks are sufficiently distinctive and function as an indicator of source. INTA recognizes that color marks are already registrable in Canada. INTA supports any necessary legislative and regulatory amendments that may be necessary to allow for the registration, where appropriate, of other non-traditional marks such as sounds, smells, and moving images such as holograms and animations.

1. Registrability of Non-Traditional Marks

INTA recommends that non-traditional marks should be entitled to registrability on the same basis as traditional marks, and likewise, inherently functional, clearly descriptive or deceptively misdescriptive non-traditional marks would be denied registration on the same basis as

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traditional marks. As with words and symbols, the required distinctiveness can be inherent or acquired through use. The requirements and process for review of NTMs differs depending on the jurisdiction. INTA can provide information about how jurisdictions review process and examine NTMs if CIPO is interested in this information.

2. Representation of the Mark

In order to effect an adequate assessment of the substantive and procedural requirements for registration, a mark must be sufficiently identifiable and capable of documentation in a reasonably accessible format. For example, the United States Patent and Trademark Office (USPTO), in reviewing the registrability of sound marks, has recognized that flexibility is required “to keep up with the ever-changing ramifications brought about by the changing technology that accompanies the growth of a nation and creates goods, services and concepts unheard of in the past ...”2 While graphical representation is arguably the most accessible format, non-visual perceptible formats should also be considered. In light of current technological advances and capabilities, computer software or programs can be incorporated into the examination system to allow review of audio and video records incorporating still and moving images, three dimensional marks and sound. Below are some suggested means of representing certain more commonly recognized and accepted non-traditional marks.

(a) Color

In permitting the application and registration of color marks, CIPO already requires a drawing along with a written description of the mark explaining the color(s) and where they appear. CIPO may wish to consider requiring a more precise way of visually representing the color(s) through use of an internationally accepted commercial color code system, such as Pantone®, which is now required in the EU following the Libertel decision.3 In contrast, in the United States, designation of a color code is optional, but not mandatory.

(b) Sound

Sound marks can be represented through a combination of means, including the use of musical notation or written descriptions of the sounds or notes comprising the marks, visually represented staff music specimens, computer generated full frequency plots or audio recordings such as digital music files (MP3 files),4 compact disks or cassette tapes.

The audio recording of the sound mark could be made available electronically via the Trademarks Office database. For example, the USPTO utilizes a special mark drawing code with the notation “for situations for which no drawing is possible, such as sound.” This drawing code and a written description of the sound required to be provided by the applicant,5 are searchable terms in the USPTO database. A similar system could be utilized in Canada. The

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3 In Libertel Groep BV v. Benelux Merkenbureau (case c-104/01), the European Court of Justice (ECJ) ruled that merely reproducing the colour in question on paper does not satisfy the requirements that graphic representation of a colour mark be clear, precise, self-contained, easily accessible, intelligible, durable and objective, whereas using an internationally recognized colour code does.
4 For example, New Zealand permits a sound file containing the sound in .mp3 format, not exceeding 1MB, and not allowing loops and streaming. Further, if the musical instrument used to produce the sound forms part of the mark, this should be stated.
5 U.S. TMEP, §807.09.
Community Trademark (CTM) and other jurisdictions also accept musical notation.\(^6\)

(c) **Moving Image**

Moving Image marks can be documented through a video or a series of pictures, which when combined, comprise the essential aspects of the motion, animation or hologram, together with a clear and concise written description of the mark and its movement. Media containing the motion, animation or hologram could be filed with the Trademarks Office. This media can also be made available electronically. Many jurisdictions which allow for the registration of moving image marks permit the filing of a certain number of freeze frames in a specified format depicting various points in the movement.

(d) **Smell**

The preferred method to document such marks is a written description of the particular smell. As an example, the USPTO requires that the applicant submit "a detailed written description of the mark that clearly explains the . . . scent . . ."\(^7\)

3. **Legislative Changes**

It is recognized that certain legislative and regulatory changes are necessary to permit the proper application and registration of non-traditional marks in Canada. While the Singapore Treaty provides some specific regulations for some non-traditional marks, the requirements are quite general in nature. It may be of assistance to CIPO when considering legislative amendments dealing with non-traditional marks to consider the legislation and regulations from other countries which share a common historical trademark framework with Canada and who already permit the registration of such marks; for example, Australia and the United States, both of whom are contracting parties to the Singapore Treaty. Additionally, INTA offers the following comments on some potential areas of legislative and regulatory change:

(a) **Definition of “trade-mark”**

Canada’s trademark legislation and jurisprudence, both current and historical, has consistently defined “trade-mark” in a broad manner that can already support the inclusion of non-traditional marks. When consideration is given to the definition of a trademark under the current TMA, it will be perceived that the definition, so far as it relates to the commonly used type of trademark, calls for two characteristics. First, the trademark must be a “mark.” Second, the trademark must be used for the purpose of distinguishing or so as to distinguish the wares or services of one person from those of another. The only innate quality necessarily inherent in a trademark under the TMA is that it must be a “mark.” However, the fact that “mark” is not specifically defined in the TMA may result in unnecessary limitations being placed upon that term. INTA recommends that consideration be given to including a definition of “mark” within the Act which would be broad enough and specific enough to encompass certain non-traditional trademarks. For example, Australia’s Trade Marks Act 1995 contains a definition of “trade-mark” that is similar to that of Canada but which goes further to also define “mark” so as to encompass traditional and

\(^6\) Examples of registered sound marks consisting of a musical notation include CTM nr. 1040955 in the name of Nokia and CTM nr. 1772086 in the name of Yahoo.

\(^7\) 37 C.F.R. §2.52(e); U.S. TMEP, § 807.09.
certain non-traditional marks:

Section 17: A trade mark is a sign used, or intended to be used, to distinguish goods or services dealt with or provided in the course of trade by a person from goods or services so dealt with or provided by any other person.

Section 6: Sign includes the following or any combination of the following, namely, any letter, word, name, signature, numeral, device, brand, heading, label, ticket, aspect of packaging, shape, colour, sound or scent.

It should be noted that when Australia became a contracting party to the Singapore Treaty in 2009, it did not require any amendments to its legislation.

(b) Trademark “use”

The case of Playboy Enterprises Inc. v. Germain (No. 1)\(^8\) has traditionally been interpreted to have held that a verbal description is not use of a trademark and that a mark must be something that can be visually represented in order to constitute “use” of the mark pursuant to section 4 of the TMA. INTA recommends that consideration be given to amending section 4 to specifically delineate what constitutes use of a sound mark as well as, where necessary, other non-traditional marks such as scents/smells. As Canada did in 1954 when it recognized the protection and registrability of service marks and export marks and legislatively defined “use” of such marks for purposes of the TMA, so too could the legislation be specifically amended to define “use” in relation to sound and scent marks.

(c) Functionality

The TMA may be required to be amended in order to ensure that Examiners can effectively object to non-traditional marks on the basis of functionality. Presently, the TMA contains a functionality limitation,\(^9\) which for purposes of initial examination is directed only at “distinguishing guises.” Distinguishing guises are defined specifically in the Act to mean (i) a shaping of wares or their containers or (ii) a mode of wrapping or packaging wares. Section 13 of the TMA effectively prevents the registration of a distinguishing guise unless “it is not likely unreasonably to limit the development of any art or industry.” Moreover, the registration of a distinguishing guise cannot interfere with the use of any utilitarian feature embodied in the distinguishing guise.\(^10\) While jurisprudence has also held that registered marks which are functional are invalid, there is presently no provision in the TMA which would permit an Examiner from raising an objection to a trademark, other than a distinguishing guise, on the basis of functionality. While such a situation is not typically problematic in the context of traditional marks, it may be more problematic for certain non-traditional marks. INTA recommends that consideration be given to providing a similar functionality restriction specific to certain non-traditional marks, such as sound and smell, as was done with respect to distinguishing guises.

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\(^8\) (1987), 16 CPR (3d) 517 (FCTD)
\(^9\) Section 13 of the Trade-marks Act.
\(^10\) Section 13(2) of the Act.
(d) Moving Images

Rule 24 of the TMR has been interpreted to deny protection to moving marks by classifying them as more than one mark. The section states that “A separate application shall be filed for the registration of each trade-mark....” INTA recommends that consideration be given to amending that regulation to suitably account for the application and registration of moving marks, such as holograms or animations, so as to ensure that they are not characterized as more than one mark and denied registrability.

IV. Other Issues

Having regard to CIPO’s stated commitment “to improving the Intellectual Property administrative framework” and the fact that it has invited comments from others to assist in its assessment of Canada’s current trademark regime, INTA suggests some possible improvements (outlined below) to Canadian trademark law and practice. Some of these suggestions were made by INTA in the response to CIPO’s request for proposals for comment relating to the modernization of Canada’s Trade-marks Act in 2005. However, since the current consultation has been embarked upon by CIPO with a view to amending “the Trade-marks Act to more closely align it with modern business practices and international standards,” INTA considers that it would be appropriate to re-state certain of its recommendations and to offer some additional comments in this current forum.

(1) Provide for Division of Applications

INTA recommends that applicants be permitted to divide applications at any stage of prosecution. Once divided, each divided application should be treated as a separate application at examination, opposition and post-allowance. Post-allowance, the ability of an applicant to divide applications will permit the applicant to obtain registration in respect of wares/services already in use while enabling a divided application to remain pending in respect of wares/services in association with which the trademark has not yet been used.

(2) Remove Limitations on the Transfer of Associated Trademarks

INTA recommends the removal of restrictions of the transfer of “associated” trademarks and believes that the ability to assign and record the assignment of a mark should be decided by the owner – not dictated by statute. INTA supports retention of ss. 48(2) of the TMA which provides that a trademark may be held to be non-distinctive if as a result of a transfer of a trademark there subsisted rights in two or more persons to the use of confusing trademarks and the rights were exercised by those persons. INTA also supports the retention of the provisions of the TMA which provide that confusing trademarks are registrable if the applicant is the owner of all such trademarks. This provision is consistent with INTA’s recommendations under the INTA Examination Guidelines with respect to an examination system which takes into account the likelihood of confusion with prior marks held by different owners. (See Section 8 of INTA Examination Guidelines which are attached).
Effect of Consents in Overcoming Office Objections Based on Confusion

INTA supports the view that the provision of consent from the owner of the registered trademark should be considered by the court or the Registrar, as the case may be, as one of the surrounding circumstances in assessing the likelihood of confusion between trademarks. INTA has identified some factors which may be included in such a consent (See Section 10.1.3 of INTA’s Examination Guidelines which are attached).

While under current Canadian practice, consent from the owner of the cited mark is indeed considered by examiners as one of the surrounding circumstances when assessing the likelihood of confusion, it is INTA’s view that where the trademark owner and the applicant have come to an agreement, an examiner should be prepared to give deference to the parties’ wishes in all but the most extreme situations, given that it is the parties who are best placed to know the marketplace and their customers. Nevertheless, the Registrar must exercise discretion in making the assessment of confusion.

Newfoundland Registration Reform

Trademarks registered pursuant to the laws of Newfoundland that existed prior to April 1, 1949 should be subject to the same provisions respecting renewal and expungement as are other trademarks.

Statutory Definitions of “trade-mark” and “proposed trade-mark”

The statutory definition of “trade-mark” should be updated to ensure that non-traditional marks such as colors, sounds, moving images, smells and tastes are capable of protection as trademarks. INTA supports the registration of any signs that are visually perceptible, or capable of being depicted or described by written notation, diagrams or other sufficiently certain visual means, as long as they are sufficiently distinctive and function as an indicator of source. Such signs will include non-traditional marks such as color (whether alone or in combination), sounds, smells, moving images and holograms, in appropriate circumstances. (See our detailed comments in Part IV Non-Traditional Trade-marks, below.) Also, detailed recommendations on the representation and registrability of non-traditional marks are contained in INTA’s Examination Guidelines (Sections 6.1 and 7.1).

INTA also supports the review and updating of the definition of “proposed trade-mark” to include proposed certification marks and distinguishing guises. Any additional legislative changes should also be made as necessary to permit the filing of applications for registration for certification marks and distinguishing guises on the basis of proposed use.

Statutory Definition of Making Known

The statutory definition of when a trademark is deemed to have been made known should be updated to include modern means of communication by which the advertisements for wares and services will come to the attention of potential dealers in, purchasers or users of the wares or services. INTA believes that the ‘making known’ provision does not reflect Canadian modern
commercial communication realities as there are several options by which wares and services are advertised and become well known in Canada other than printed publications and radio broadcasts. Therefore, INTA suggests that the TMA should be revised to include some additional options in which wares and services are advertised in Canada.

(7) **Invalidity of Registrations due to Fraud**

INTA recommends that Canadian legislation provide that a trademark registration may be invalidated by reason of either a fraudulent misrepresentation or a material false statement fundamental to registration.

(8) **Applications based on Foreign Application/Registration**

Legislative clarity is required on the issue of whether use in a foreign jurisdiction must have occurred prior to the filing of the Canadian application to support valid claim based on ss 16(2). INTA recommends that the TMA specifically provide that the foreign application must have been filed or the foreign registration secured prior to the date of filing of the Canadian application, but that the use abroad need only have occurred at some point prior to the advertisement of the Canadian application.

(9) **Priority Claims**

Canadian legislation should be amended to remove the requirement that the applicant’s country of origin be the same as the country of the Union where the applicant’s priority application was filed and to explicitly provide that the date of filing of the application in or for the other country is not deemed to be the date of filing of the application in Canada for certain purposes.

(10) **Summary Cancellation**

The legislation should confer on the Registrar the authority to issue a notice restricted to certain specified wares/services.

(11) **Statutory Damages**

INTA understands that Canadian law lacks any provision dealing with the provision of statutory damages in actions for infringement of registered trademarks and recommends introducing a new provision in the legislation to this effect. INTA would be pleased to consult with CIPO and to suggest specific wording for such a provision.

(12) **Increased Protection for Well-Known Marks in Canada**

As per our previous submissions to CIPO regarding legislative reform, INTA generally supports increasing protection for well-known marks in Canada.

INTA notes Canada’s lack of specific legislative provisions for protecting well-known marks and takes this opportunity to recommend that Canada adopt provisions:
(1) acknowledging that if a mark is well-known, there is a greater risk of confusion; and

(2) protecting against dilution.

Because of their attributes, well-known marks are especially vulnerable to being copied or emulated.

The “Joint Recommendation Concerning Provisions on the Protection of Well-Known Marks” adopted by the Assembly of the Paris Union for the Protection of Intellectual Property and the General Assembly of the World Intellectual Property Organization provides member states, such as Canada, with guidelines for implementing the well-known mark provisions of international agreements. INTA supports the Joint Recommendation and recommends to the government of Canada that well-known marks be protected in accordance with its provisions.

Well-known marks often fall victim to unauthorized use by third parties, who frequently adopt such marks for their own goods and services, not necessarily to confuse, but rather for the positive associations that such marks carry. Unfortunately, there does not appear to be a useful mechanism in the TMA to address this type of activity. In view of the above, INTA recommends the adoption of the following two types of provisions:

(1) A provision acknowledging that, when assessing the likelihood of confusion with a well-known mark, there is an increased risk of confusion, whether or not the goods and services of the parties are identical or similar. This acknowledgment should apply to marks that are well known by the public at large as well as marks that are only well known in relevant sectors of the public.

(2) A narrow, clear, and focused dilution provision.

The dilution provision should:

• provide a clear definition for what constitutes a well-known mark, namely a mark that is “widely recognized by the general consuming public of Canada.”

• protect well-known marks regardless of the presence or absence of a likelihood of confusion between the well-known mark and the junior use.

• specifically protect well-known marks from junior uses that are likely to dilute the well-known mark.

INTA further recommends that dilution of a well-known mark should be a ground for opposing a trademark application or canceling a trademark registration.

For both infringement and dilution cases, there should be an acknowledgement that well-known marks need not be registered to benefit from the provisions. INTA would be pleased to work with the government of Canada on specific language for these provisions.
Section 9 Reform

INTA supports the reform of the provisions of Section 9 of the TMA, and in particular those provisions which deal with Her Majesty’s Forces, universities and, especially, public authorities (paragraphs 9(1)(n)) are necessary and should be part of CIPO’s efforts to modernize the TMA.

In our letter of February 17, 1999, to Ms. Danielle Bouvet, then Director of the Intellectual Property Policy Directorate of Industry Canada, INTA proposed that the TMA be amended by wholly deleting sub-paragraphs 9(1)(n)(ii) and (iii), and introducing a sunset clause, as follows:

9. (1) No person shall adopt in connection with a business, as a trade-mark or otherwise, any mark consisting of, or so nearly resembling as to be likely to be mistaken for, (n) any badge, crest, emblem or mark adopted or used by any of Her Majesty’s Forces as defined in the National Defence Act in respect of which the Registrar has, at the request of Her Majesty, given public notice of its adoption and use.

(n.l) Any public notice of adoption and use of any badge, crest, emblem or mark made in favour of a “public authority” as an official mark or in favour of a “university” before _____ has the same force and effect as it had before ______ and all rights and privileges acquired under or by virtue of the provision then existing in this regard may continue to be exercised or enjoyed in Canada until _____________. On ____________, these rights and privileges will cease to have effect.

However, if CIPO is not prepared at this time to entertain the deletion of sub-paragraphs 9(1)(n)(ii) and (iii) from the TMA, INTA submits that - in view of the foregoing concerns – reform of Section 9 is nonetheless required. Since paragraphs, 9(1)(e) and 9(1)(n.1) also provide for the Registrar to give public notice of various prohibited marks it is logical that at least some of the reforms extend to those paragraphs as well. INTA therefore submits that the following proposals relating to the reform of Section 9 should be seriously considered:

a. Use and Adoption of Official Marks and Statement of Wares and Services

In INTA’s view, there is some overreaching by public authorities with respect to statements that official marks have been “adopted and used” on “wares and services.” This problem may be curtailed if the requesting party had to show that by the relevant date it had “used and adopted” the official mark (something akin to a Section 45 test). At a minimum, a list of wares and services in association with which the official mark is said to have been used and adopted should be required to be set out in the request for public notice, in the same manner as required in a trade-mark application (Section 30(a)).

b. Inspection Prior to Public Notice

We see no rationale in not permitting requests for a public notice under paragraph 9(1)(n) to be open for public inspection prior to public notice being given in the Trade-marks Journal. INTA submits that Section 28(1) of the TMA should be amended to mandate that the Registrar keep an index of arms, flags, badges, crests, emblems, marks and armorial bearings for which requests
for protection under paragraphs 9(1)(e), s.9(1)(n) and s.9(1)(n.1) are received as well as an index of arms, flags, badges, crests, emblems, marks and armorial bearings for which the Registrar has given public notice of adoption and use under paragraphs 9(1)(e) and s.9(1)(n) or public notice of the grant, recording or approval under paragraphs 9(1)(n.1). Section 29(1) would then operate to permit the public inspection and searching of paragraph 9(1)(e), 9(1)(n) and 9(1)(n.1) requests prior to the advertisement of the public notice of their adoption and use/grant, recording or approval, as the case may be. This would permit searchers to provide a more complete registrability report and allow trademark owners to make more informed decisions.

c. Renewal, Abandonment, Cancellation and Opposition

For ease of reference in the following discussion, the owners of arms, flags, badges, crests, emblems, marks and armorial bearings (collectively referred to hereafter as “Section 9 Marks”) subject to protection under s.9 will be referred to as Section 9 Owners. INTA supports the view that the TMA should be amended to include specific provisions:

• providing for a term of protection, extendable by renewal terms of equal length, of not longer than 10 years for Section 9 Marks

• permitting Section 9 Owners to abandon their Section 9 Marks and requiring the Registrar to give public notice of that abandonment. Further in respect of Section 9 Marks arising from paragraph 9(1)(n.1) the Registrar should be required to give public notice in any change in status of the grant, recording or approval in respect of a recipient’s right to use such Section 9 Marks.

• providing for a section 45-type proceeding obliging Section 9 Owners (at the very least those claiming under paragraphs 9(1)(e) and 9(1)(n)) to prove continued use of their Section 9 Marks. Surely, the same rationale that applies to deadwood trademark registrations applies equally well to Section 9 Marks.

• providing for an opposition-type procedure in order that the entitlement of the Section 9 Owner to the protection afforded by the relevant provisions of the TMA may be challenged by interested persons in an administrative framework rather than through the process of judicial review in the courts.

d. Uniformity in Entitlement to Rights

The words “adoption and use” appear in the last line of paragraph 9(1)(n). This is consistent with the words “adopted and used” appearing in sub-paragraph 9(1)(n)(iii); however, it is inconsistent with the words “adopted or used” appearing in 9(1)(n)(i). Moreover, none of these words appear in 9(1)(n)(ii). There does not appear to be any justifiable reason for the discrepancy and it is submitted that badges, crests, emblems and marks of Her Majesty’s forces, universities, and public authorities be treated in the same manner, i.e., the words “adopted and used by” should
replace the words “adopted or used by” in 9(1)(n)(i) and the word “of” in 9(1)(n)(ii). This is also consistent with the wording appearing in paragraph 9(1)(e).

(14) Territorial Registrations

The TMA appears to permit territorially restricted registrations in only a limited set of circumstances, for example in situations where an applicant's evidence submitted under s.12(2) or s.13 and 32(1) has failed to prove that the trademark has acquired distinctiveness across all of Canada. Also, the Federal Court can, under s.21(1), order that a party's long term concurrent use of a confusing trademark (which use predates the filing of an application for registration of a pertinent registered mark) may continue within a defined territorial area with an adequate specified distinction from the registered mark; s.21(2) provides for that order to be registered against the pertinent registered trademark thereby effectively limiting the territorial scope of the registration as against the concurrent user. In both of these instances, the territorial limitation is imposed not by the applicant or registrant, but by the Registrar or the Federal Court. INTA urges CIPO to consider whether it would be appropriate for an applicant to self limit the scope of its territorial protection at any stage of prosecution. This approach would appear to provide applicants/trademark owners with a means of avoiding/settling disputes in a manner that permits both parties to obtain a registration which reflects the commercial reality of the marketplace. Of course, such territorial limitations/restrictions would need to be clearly set out in the application/registration particulars so that the scope of the limitation/restriction is apparent to third parties, for example, as is presently the case in respect of restrictions under s.32(2).

(15) Reform of Application Amendment Provisions

INTA supports the view that the TMR should be amended to facilitate the amendment of applications where applicants wish to amend the basis for entitlement (and relevant dates thereunder) prior to advertisement. Presently, it is not possible to amend a proposed use application to one alleging use (see s.31(d) TMR), and it can be very difficult to amend a use based application to claim an earlier date of first use (see s.31(c) TMR).

There is no logical reason why applicants should not be permitted to amend their bases for entitlement pre-advertisement. Any unsubstantiated claims will be sorted out on opposition or in invalidity proceedings. Moreover, the specific practice of the TMO to deny applicants the ability to amend applications from a proposed use basis to one claiming use since at least as early as the filing date (which amendment would not in itself appear to be contrary to the relevant regulations given that the present prohibition is against an amendment claiming use before the filing date) is illustrative of the relative harshness of TMO general policy concerning amendments to claims of entitlement.

In Canada applicants often have to go through the expense of filing new applications when the solution is often a relatively minor amendment in other jurisdictions. The time appears to be right to amend the TMR to permit applicants to more efficiently obtain supportable applications/registrations and to remove seemingly illogical roadblocks which appear to serve no administrative or public good.
C. CONCLUSION

INTA thanks CIPO for the opportunity to respond to the proposals for comment relating to the alignment of the Canadian Trade-Marks Regime with Modern Business Practices. In conclusion, we want to emphasize the important role that trademarks play in the domestic economy of Canada and in the global marketplace. INTA believes that by more fully integrating itself with the other major industrialized countries of the world, Canada will be much better positioned to realize the full potential that trademarks bring to the economic prosperity of a nation. Canada’s adherence to the Singapore Treaty, and in particular the Madrid Protocol, will enable Canadians increased options to more actively participate in the global economy and will likewise enable and encourage foreign trademark owners to more actively participate in the Canadian marketplace.

Further, recognition of non-traditional marks in Canada will allow Canada’s business protections to be aligned and harmonized with the processes of other trademark offices. Ultimately, Canadians must decide what approach is best for Canada’s business community and public. However, INTA, as always, offers to work closely with CIPO on the issues of Canada’s proposed adherence to the Madrid Protocol, the Singapore Treaty and recognition of non-traditional marks.
Disclaimer

All information provided by the International Trademark Association in this document is provided to the public as a source of general information on trademark and related intellectual property issues. In legal matters, no publication whether in written or electronic form can take the place of professional advice given with full knowledge of the specific circumstances of each case and proficiency in the laws of the relevant country. While efforts have been made to ensure the accuracy of the information in this document, it should not be treated as the basis for formulating business decisions without professional advice. We emphasize that trademark and related intellectual property laws vary from country to country, and between jurisdictions within some countries. The information included in this document will not be relevant or accurate for all countries or states.
GUIDELINES FOR TRADEMARK EXAMINATION

Examination Guidelines Subcommittee
Trademark Office Practices Committee
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INTA GUIDELINES FOR TRADEMARK EXAMINATION

1. INTRODUCTION
   1.1 Purpose
   The purpose of this document is to provide general guidelines on a full range of issues related to examination of applications for trademark registration. These Guidelines are not intended to be limited to the trademark law of any specific territory; rather, they follow generalized conceptual lines. The Guidelines are meant to reflect various international systems in an effort to harmonize trademark law. The intention is that these guidelines be available as a reference document, particularly for Trademark Registration Offices.

   1.2 Referenced Agreements and Treaties
   • The Agreement on Trade-Related Aspects of Intellectual Property Rights, 1994 (TRIPs)
   • The Model Law for Developing Countries on Marks, Trade Names and Acts of Unfair Competition of 1967 (produced by the World Intellectual Property Organization)
   • The Trademark Law Treaty of 1994
   • The Singapore Treaty on the Law of Trademarks, adopted by WIPO in March 2006
   • The European Community First Council Directive of 21 December 1988 to approximate the laws of member states relating to trademarks
   • The United States Trademark Act of 1946 (the Lanham Act)
   • The Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks, adopted at Madrid on June 27, 1989 (Madrid Protocol)
   • Paris Union and WIPO Joint Recommendation Concerning Provisions of Well Known Marks, adopted in 1999
   • Canadian Trade-Marks Act, 1985

2. PRE-APPLICATION
   2.1 Third Party Searching
   Trademark Offices should provide access to records of existing marks so that an applicant may search the records to identify existing marks that may pose a conflict to a proposed mark. The records, which may be paper, microfilm, or electronic, should be organized to allow for ease in discovering potential conflicting marks.
2.2 **Classification Systems**
For providing harmonization across jurisdictions, generally accepted classification systems, such as the International Classification of Goods and Services for the Purposes of the Registration of Marks (Nice Classification) should be used to classify an application’s goods and services, and the International Classification of the Figurative Elements of Marks (Vienna Classification), should be used to classify design marks.

3. **APPLICATION**

3.1 **Filing**
Trademark Offices should allow for the receipt of applications and prosecution documents by hand, by post, by facsimile, and/or by electronic transmission. Payment of fees should be allowed by cash, check, credit card, EFT, and/or deposit account. The Trademark Office should issue confirmation of receipt of the application in a similar transmission means as that of the application filing.

3.2 **Response Time**
Trademark Offices should examine the application and issue a notification of objections to registration within a reasonable period after the filing date, i.e., within three to six months after the filing, as the latest period for issuance of the first official action. The applicant should be provided a reasonable time period within which to respond to any objections issued by the Trademark Office. In that more than one response to an official action may be required, the recommended deadline for an applicant’s response to each official action is within three to six months after issuance of the official action.

4. **MULTI-NATIONAL APPLICATIONS**
Existing mechanisms that allow for the submission of a single application resulting in registrations that provide protection in multiple territories is encouraged. Multi-national applications are currently available to applicants in certain countries that are members of multilateral agreements. Such mechanisms include:

- The Madrid System for the International Registration of Marks
- The “Organisation de la Propriété Intellectuelle” (OAPI)
- The Banjul Protocol on Marks
- The European Community Trade Mark (CTM)
- The Benelux Trademark

4.1 **National Examination**
INTA supports the Madrid Protocol and harmonization efforts under multilateral treaties and can provide assistance to countries in their consideration of adherence to the applicable systems. The Madrid Protocol provides initial formalities examination
by WIPO and substantive examination is carried out by national member registries, based on applicable national law. Protection in the first five years is dependent upon the basic trademark registration issued in the country of origin.

The CTM is a single registration effective in all the current and future member nations of the European Union. The Uniform Benelux Trademark Law provides for a single registration for Belgium, the Netherlands and Luxembourg.

5. SCOPE OF EXAMINATION

5.1 Determined by Trademark Office

In all cases, the scope of examination, as well as the criteria by reference to which the examination is conducted, will be determined by the substantive law under which a Trademark Office operates. Each Trademark Office should publish its requirements and make them available to the public.

Although the wording of a given territory’s trademark law may vary widely, there generally are three main areas of examination:

- Formalities
- Absolute Grounds (inherent registerability of a mark)
- Relative Grounds (conflict with prior trademark rights)

A formalities examination should be conducted prior to registration; however, the extent of absolute and relative examination may vary widely. In many countries there is no examination on relative grounds, though frequently a search is carried out to make the applicant aware of possible relative objections. As an alternative, or in addition to relative grounds examination, some Trademark Offices provide for an opposition procedure in which the Trademark Office will examine relative grounds specifically raised by the opponent. The guidelines presented here incorporate a discussion of oppositions. Cancellation of marks is noted, but in that cancellation actions are taken post-registration, they are not discussed in detail in this Examination Guidelines document.

By way of example, the following table provides a non-exhaustive survey, current as of late 2007, of the examination policies adopted by the identified Trademark Offices. These policies are subject to change.
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\(^1\) Refusal based on prior rights.
\(^2\) In addition to an OHIM search of CTM registrations, searches are conducted by each national country (except France, Germany, and Italy, which are currently not providing search reports). Search reports are provided in the language of the country that conducted the search. Search reports are prepared according to the principles of each country, rather than according to the principles of the CTM system. Moreover, in certain cases, (typically due to the absence of a sufficiently sophisticated automated search program) phonetic comparisons are not made.
\(^3\) Effective October 2007, the Office will conduct a search, and if a conflicting mark is identified, both parties will be notified and the owner of the identified mark then must oppose. The Office will not issue an objection on relative grounds
\(^4\) As of 10/07.
5.2 INTA Recommendation on Examination
INTA supports full pre-registration examination, but accepts that this may not be practicable for Trademark Offices with limited resources or those having a low turnover of applications. In such cases INTA encourages Trademark Offices to provide resources to the public to allow an ex parte search and opposition procedure.

INTA supports the availability of low cost, accessible opposition procedures, and that an opposition may be filed within three months after publication. A three month time limit is consistent with notification requirements of certain multi-territorial agreements, such as the Madrid Protocol and Agreement.

6. FORMALITIES EXAMINATION
All Trademark Offices should examine applications to confirm that they contain the essential minimum data specified by the local trademark law. These data include:

- Applicant Details
- Representation of the Mark
- Specification of Goods and/or Services, including classification

In some cases, examination may be required of Paris Convention or other priority claims; however applications made according to the Madrid Agreement that claim priority should receive priority “without requiring compliance with the formalities prescribed” in Article 4D of the Paris Convention.\(^5\)

If the applicable trademark law requires a “use” or “intent-to-use” basis for filing, examination of this formality is required.

There are also certain additional formalities requirements for special types of marks. For a discussion of requirements for Collective and Certification marks, see Sections 6.3.1 and 6.3.2.

6.1 Representation of the Mark
It is recommended that Trademark Offices not require that a mark must be “visually perceptible.” Instead, graphical representation depicting marks should be permitted. Where “paperless” applications are available, such as via the Internet, digital representations should be permitted.

The types of marks shown below are among those that are deemed registerable as of the date of this revision, and for which the suggested means of their representation in an application is provided. As technological advances and marketing customs develop, additional types of marks should be considered for registration:

\(^5\) Madrid Agreement, Article 4 (2).
6.1.1 Device (Design) Marks
A graphical representation of the device should be included in the application, including a design classification as specified in the Vienna Agreement Establishing an International Classification of the Figurative Elements of Marks (1973, as amended).

6.1.2 Three-Dimensional Form Marks
The representation should include sufficient views for the shape to be clearly identified. Any non-distinctive portion of an otherwise distinctive three-dimensional mark should not be included in the official representation of the mark. If a non-distinctive portion must be included for reference, such as for placement or orientation, the scope of the trademark and the non-distinctive portion should be clearly indicated. For example, the distinctive shape of a tool is depicted in a three-dimensional drawing, while the non-distinctive handle might be shown in two-dimensional dashed line. In a photographic specimen, the non-distinctive portion may be obliterated, or identified by a written disclaimer in the application.

6.1.3 Color Marks
A literal description of the color in a mark generally should be accepted unless words do not adequately describe the color with sufficient particularity. In that case, reference to accepted color definition standards, such as RAL, the RGB color numbering system, the Pantone® system, or other similar identification systems, should be accepted and may be required if the Trademark Office does not publish applications in color.

6.1.4 Sound Marks
Either the musical notation or a written description of the sound should be accepted and should be required if the Trademark Office cannot include digital representations, such as sound files. Where the sound may be only partially represented by visual notation, a clarifying description in words of the sound in the application should be included. The following are suggested representation forms for sound marks:

- Musical notation and/or description of the sound in words
- The instrument(s) on which the music is played should be included if it forms part of the mark (the title of the piece of music is not precise enough)
- Graphic (electronic) measurement of the volume and character of the sound
- Digital representation
- Computer representations (tones)
- A combination of any of the above

6.1.5 Scent Marks
Representation should consist of a written description that conveys the identity of the scent clearly and unambiguously and permits its differentiation from other scents. Additional representations might include submitting a sample of the scent
(scratch and sniff) or a chemical formula of the compound that creates the scent. However, these should not substitute for the written description, as the scent sample may dissipate and the chemical formula may not be readily understood by the general public.

6.1.6 Flavor Marks
Representation should consist of a written description that conveys the identity of the flavor clearly and unambiguously and permits its differentiation from other flavors. Additional representations might include submitting a sample of the flavor or a chemical formula of the compound that creates the flavor. However, these should not substitute for the written description, as the flavor sample may dissipate and the chemical formula may not be readily understood by the general public.

6.1.7 Touch Marks
Representation should consist of a written description that conveys the identity of the touch characteristic clearly and unambiguously and permits its differentiation from other touch characteristics. Additionally, the representation should be “clear, precise, self-contained, easily accessible, intelligible, durable and objective.”

6.1.8 Moving Image Marks
The mark may be represented by a series of pictures that represents the motion with written description of movement. Alternatively, moving images, such as video, may be provided to a Trademark Office in physical or electronic means where the Office allows access to such formats.

6.1.9 Gesture Marks
Gesture marks are moving image marks but sometimes are identified separately. As with moving image marks, gesture marks may be represented by a series of pictures that represents the motion with written description of movement or by moving images provided in physical or electronic means.

6.1.10 Hologram Marks
Holograms are marks that appear to change when viewed from different angles. A single drawing or series of drawings generally cannot accurately represent a hologram; therefore, holograms are typically identified by a description of the mark.

It should be noted that registration of a hologram may be refused if the drawing shows more than one image, in that the application would seek protection for two separate marks.

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6 European Court of Justice C-273/00; Sieckmann, 2002.
6.2 Classification
The Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks (1957, as amended) provides a widely accepted system of classification of goods and services and its adoption is recommended.

6.2.1 Description of the Goods
The goods and/or services in an application should be described clearly, with specificity, so it can be readily discerned what goods/services are sought to be protected. The description of goods/services selected and utilized by the applicant should be accepted unless:

- It would be unclear to the public what the goods/services in the registration protects; or
- Goods or services clearly are misclassified according to the applicable governing classification system, in which case a proper reclassification should be proposed by the examiner.

6.2.2 Use of Class Headings Discouraged
While some Trademark Offices accept as a listing of goods and services the “class heading” of the International Nice Agreement, this practice is not generally accepted at this time. Many territories that are party to multi-territorial application procedures, such as the Madrid Protocol/Agreement, require that the list of goods/services be identical to or narrower than the goods/services in the basic application or registration.

6.2.3 Use of “All Goods In Class” Discouraged
INTA discourages use of the phrase “all goods in the class” as a permitted definition of goods or services in applications, because, among other things, classifications may change over time, thereby creating ambiguity as to the scope of protected goods. INTA recommends that the specific goods or services be defined in any application for registration.

6.2.4 Retailing of Goods
It is recommended that the use of a mark as the name of a trading establishment, such as a retail store or in a catalog name, should be recognized both as use of that mark in relation to the sale of goods or services offered by that establishment as well as in relation to the service of retailing and ancillary advisory and other services. Such services may be classified consistently in either class 35 or 42 according to the preference of the Trademark Office pending clarification of the Nice classification. INTA supports the classification of retail services in class 35.
6.3 Other Types of Marks

6.3.1 Collective Marks

A collective mark is one used or intended to be used by members of a cooperative, an association, or other collective group or organization. The mark is owned by the collective entity even though the members use it individually. The collective entity itself may advertise or promote under the mark the goods or services of its members and may use it itself if it is used at the same time by the members in accordance with the regulations governing the use of the collective mark.

An example of a collective mark that may be instructive is the FTD mark used by member florists of the Florists’ Transworld Delivery Association. In general, collective marks are examined in the same manner as other trademark and service mark applications with particular attention to commonly used words that might be disclaimed under the particular practice, such as “member” or “association”.

6.3.1.1 Application for a Collective Mark

In addition to the usual filing particulars, the applicant should state that the application is for a collective mark and submit a copy of the regulations governing the collective mark’s use. The application should also include the following:

- A statement of what class of persons is entitled to use the mark, and their relationship to the applicant. If proof of use is required, the first use dates of the mark and whether the first use was by a member of the applicant should be indicated.
- A statement that the applicant is exercising or will exercise legitimate control over use of the mark by its members.
- A document setting forth the precise manner in which the applicant intends to control use of the mark by its members; specifically, who is authorized to use the mark, how members qualify for membership in the group.

Where required, specimens in a use-based application for a collective mark should be examined to show use of the mark by a member on the member’s goods or in the sale or advertising of the member’s services. [Note that a collective mark is different from a collective membership mark. A specimen for a collective membership mark should readily identify membership, such as a membership card.]

6.3.2 Certification Marks

Certification marks are marks owned by one person and used by others in connection with their goods or services to certify characteristics of their goods or services. Because a certification mark serves to certify characteristics rather than
identify the individual source of the goods or services, an owner should not be permitted to use a certification mark in the course of trade. Where recognized, a certification mark may be used to designate geographic origin, quality, or other origin. Examples of certification marks are “AKC” and “CFP CERTIFIED FINANCIAL PLANNER OF AUSTRALIA”. In general, certification marks are examined in the same manner as other trademark and service mark applications. INTA supports the recognition of certification mark applications.

6.3.2.1 Application for a Certification Mark
If a Trademark Office permits the filing of certification marks, an application to register a certification mark should include, in addition to the general information required in all trademark or service mark applications, statements that support the issuance of a mark to act as a symbol of guarantee or certification and not as an indicator of source or origin of goods and services. For example only, the U.S. requires the following:

- A statement that the mark will be used by a party (parties) other than the applicant, and that the applicant does not or will not engage in the marketing or production of any goods/services to which the mark is applied.

- A statement that the mark will certify the qualities or characteristics of the goods/services and not indicate the individual source of the goods/services.

- At some point during the examination, documentation setting forth the standards or criteria used by the applicant to control use of the mark and to demonstrate that the applicant is engaged in a certified program.

- A certification statement that identifies the characteristics of the goods/services certified or to be certified.

- A statement that the applicant does not and will not engage in discriminatory practices which would bar use of the mark by third parties who meet the standards established by the owner (special attention should be paid to non-governmental entities seeking registration of a mark to certify geographic origin).

6.3.2.2 Requirements for Use-based Certification Marks. A use-based application should provide dates of first use of the mark and a statement that the first use was by the applicant (or a party or parties other than the applicant).

6.3.2.3 Examination of Application for Certification Marks. Specimens should be examined to ensure that the mark certifies a region or other
origin, material, mode of manufacture, quality, accuracy, or other characteristics of such goods or services or that the work or labor on the goods or services was performed by members of a union or other organization.

Specimens must be examined to ensure that the mark functions in a way such that the buyers are likely to recognize the mark as a symbol of guarantee or certification.

6.4 Amendment to Application

Applicants should be permitted to amend the formalities data for the purpose of:

- Correcting Errors
- Overcoming Objections

An amendment is a formal change or correction made by an applicant or registrant to any aspect of a pending application or a registration. It may be administrative or substantive in nature, and in the form of a change, an addition, or a deletion. An amendment may also be filed to overcome an objection by the Trademark Office or help resolve a dispute with a third party. Examples include a change of address, a change of ownership, a restriction to the specification of goods or services, and an amendment to the trademark itself.

Unless an amendment expands the scope of the application coverage (e.g., by adding a class of goods or services) an official fee should not be imposed if the amendment is made in response to a requirement issued by, or an error made by the Trademark Office. Trademark Offices often impose an administrative fee if a Registrant submits a voluntary amendment after registration issues.

Depending upon the circumstances, an amendment may be requested in writing, by telephone, or electronically, such as online or by e-mail. In some instances, a Declaration or Affidavit to support the written amendment might be required, for example, if registration is being allowed on an amended basis relating to acquired distinctiveness. However, following the Trademark Law Treaty, formalities such as notarization and legalization should not be required.

Generally, if an amendment is required to correct an administrative error made by the Trademark Office, it should be allowed at any time. Examples include amendment to the applicant’s address, amendment to the classification or specification of goods, or correction of the filing date.

6.4.1 Amendments to the Mark

An amendment to the mark in an application should not be allowed at any time if it would materially alter the character of the mark as originally filed. The general test of whether an amendment is a material alteration is whether the mark would have to be re-advertised in order to fairly give notice to the public for purposes of
opposition or cancellation. Also, in countries where searches are conducted, the addition of an element to a mark that would require an additional search of the office records would constitute a material alteration and should not be allowed. Deletion from the drawing page of informational matter, which is not a component of the mark itself, such as the size, alcoholic content, volume and weight of the product, should be allowed.

6.4.2 Amendments to the Specification
Additions or changes to the specification of goods that broaden the scope of goods as originally filed should be prohibited at all times during prosecution and after registration. Additions or deletions as to words in the specification of goods which do not broaden the original scope should be allowed at all times because it does not prejudice the rights of others.

6.4.3 Amendments to the Classification
If a post-publication amendment to classification is permitted, the mark may be republished at the discretion of the Trademark Office to give formal and proper notice to the public.

6.4.4 Amendments to the Dates of Use
In applications where dates of first use of a mark are required, amendments should be permitted, but if such amendment is made after publication, the mark should be republished to give notice to third parties.

6.4.5 Amendments Affecting Disclaimer
If disclaimers are either required or permitted under the applicable substantive law, a pre-publication amendment submitting a disclaimer, that otherwise complies with local law, should be freely permitted. If an applicant desires to submit a disclaimer after the mark has been advertised, either voluntarily or in response to a requirement by certain Trademark Offices and the amendment is otherwise proper, the amendment should be allowed. If the applicant desires to delete a disclaimer after advertisement (but before registration) either due to clerical error or erroneous requirement by the Examiner, the amendment should be permitted if otherwise acceptable and if the Examiner has jurisdiction, and the mark should be republished. If the Trademark Office allows the amendment, it may either issue a Certificate of Correction or a new Registration Certificate.

6.5 Divisional Applications
INTA supports allowing applicants to divide applications at any stage of prosecution. Once divided, each divisional should be treated as a separate application at examination.

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7 Not all Trademark Offices call for disclaimers. In the UK, for example, an applicant can volunteer a disclaimer or limitation, but the Registry cannot require the disclaimer.
7. ABSOLUTE GROUNDS EXAMINATION
Distinctiveness and functionality are the two primary considerations in absolute examination of an application to register a mark.

7.1 Distinctive Character
Trademark law exposes a fundamental tension between the need for a trademark to be capable of distinguishing the goods or services of the owner from those of others and the need of all traders to describe their goods or services.

Distinctiveness is needed for registration of any sign as a trademark. Marks that are essentially descriptive, should not be capable of being monopolized by one trader (see Section 7.3.2 below). However, a mark which, rather than being descriptive of the goods, is suggestive (i.e. use of a consumer’s cognitive facilities is required to make an association between the mark and the goods or services concerned) should be considered inherently distinctive.

Distinctiveness may be inherent or acquired.

7.2 Functionality
If a proposed mark consists entirely of an essential feature of a product, it should be unregistrable. A single functional element of a combination of elements, however, should not necessarily defeat an application. The application should be denied only if the functional elements dominate the mark.

7.2.1 Word Marks
7.2.1.1 Distinctiveness. Word marks that merely describe the related goods or services do not meet the required level of distinctiveness to be registrable. The following is a discussion of distinctiveness issues related to certain types of word marks:

7.2.1.1-1 Letters and Numerals
Provided that they function to identify source or origin of goods and services, and subject to the following requirements, letters and numerals should be registrable as trademarks. Distinctiveness, and not the total number of letters/numerals in the mark, should be determinative. Such distinctiveness may be inherent or acquired. Alphanumeric marks do not have to be pronounceable to be protected. Letters or numerals should not be registrable if they are either nondistinctive, or deceptively misdescriptive of the nature or quality of the respective goods or services.

The overall distinctiveness of marks incorporating letters and numerals may be enhanced by the addition of stylized font and/or design features. However, where the letters or numerals that form part of a design are nondistinctive or merely descriptive or lack distinctiveness,
a requirement for a disclaimer\textsuperscript{8} of the exclusive use of those letters or numerals apart from the trademark as a whole may be required.

Model designations or code numbers should not be registerable unless they also function as trademarks.

7.2.1.1-2 Laudatory Marks
Laudatory marks contain an expression about the quality of the product or service. Laudatory marks should not be registered absent a showing of acquired distinctiveness.

7.2.1.1-3 Names of Colors
Word marks that consist solely of the name of a single color are likely to lack the required inherent distinctiveness for registerability unless the particular color is unusual or unlikely to be needed for use by competitors for the goods concerned. Generally, if the color itself is needed in the trade, the word should not be registerable even if acquired distinctiveness can be shown.

EXAMPLE OF A WORD MARK FOR THE NAME OF A COLOR FOUND TO BE DISTINCTIVE:

- PEA-GREEN for travel services.

7.2.1.2 Functionality. Word marks are typically not “functional.”

7.2.2 Device (Design) Marks
Absolute grounds are the same as letters and numbers (above) and three-dimensional marks (described below).

7.2.3 Three-Dimensional Marks
7.2.3.1 Distinctiveness. Distinctiveness should be a required element for registration of a three-dimensional mark, just as it is for other types of trademarks. The required distinctiveness can be inherent, i.e. the shape is clearly distinctive, and immediately recognized by the public as a mark, and/or such distinctiveness may be acquired through use.

If a three-dimensional mark is initially rejected as non-distinctive in the examination process, provision should be made for allowing submission by the applicant of arguments and evidence in favor of registration. Where the Examiner determines that the mark, while not inherently distinctive, has acquired distinctiveness, the resulting registration of the mark should provide the same scope of protection as if the mark had been determined to be inherently distinctive.

\textsuperscript{8} Where allowed.
7.2.3.2 **Functionality.** Many shapes have some utilitarian quality in relation to the goods. However, utilitarianism should not *per se* disqualify a shape from registration as “functional.”

If an objection on the basis of functionality is entered, the applicant should have the opportunity to present evidence, for example, of multiple alternative suitable designs in use in the marketplace, which can be produced at comparable cost. This would tend to rebut the claim that the design in question must be kept available for use by competitors.

7.2.4 **Holograms**

7.2.4.1 **Distinctiveness.** As with three-dimensional marks, distinctiveness should be a required element for registration of hologram marks. Distinctiveness can be inherent where the public immediately recognizes the use as a mark, and/or such distinctiveness may be acquired through use.

In addition, if a hologram has two or more views, registration may be refused on the basis that the application consists of more than one mark.

7.2.4.2 **Functionality.** Holograms that are used for non-trademark purposes prevent the hologram from functioning as an indicator of source. If similar holograms are used on products as anti-counterfeiting devices, consumers may be less likely to perceive use of a hologram as a trademark.

**EXAMPLES OF HOLOGRAM MARKS FOUND TO BE NON-FUNCTIONAL:**

- sticker on credit card (American Express)
- label on electronic media (VF - VIDEO FUTUR)

7.2.5 **Color Marks**

7.2.5.1 **Distinctiveness.** In order to constitute a trademark, a color or combination of colors must be capable of distinguishing the goods of the applicant, and must be perceived by the purchasing public as identifying and distinguishing the goods on which it is used and indicating their source.

Although it is not impossible for a single color to be fanciful in connection with goods or services, a single color ordinarily will lack sufficient distinctiveness to be registerable, unless a substantial acquired distinctiveness through past use prior to the filing date is demonstrated. Color combinations may be inherently distinctive, or they may gain distinctiveness through use.

Determining if sufficient distinctiveness exists for registration will depend on the appearance of a mark, including color. For example, a device mark consisting of a circle divided into two colors may possess sufficient
distinctiveness without a showing of acquired distinctiveness. On the other hand, the same two colors individually, apart from the design, would not have the same trademark impact, and would need support from the past use to be registerable.

7.2.4.1 Functionality. For marks consisting of a single overall color the applicant must satisfy the Examiner that the overall color is not functional or generic for the goods/services, such as those colors needed by competitors providing the same goods/services as those of the application.

7.2.6 Sound Marks
7.2.6.1 Distinctiveness. Sound marks are registerable if they are not the only sound made by the operation of the product (i.e., a running motorcycle). Where the operation of a product produces more than one sound, the mark may be registerable if the applicant can clearly show that the sound, although it may be nondistinctive, has acquired distinctiveness. An example would be a toilet flushing sound for plumbing services, which has acquired distinctiveness through use.

7.2.6.2 Functionality. It is recommended that the sound made by goods during their use, and which arises purely as a function of that use, should not be accepted for registration, for example, the sound of a siren does not serve as a trademark for a siren.

EXAMPLE OF A SOUND MARK FOUND TO BE DISTINCTIVE:

- The giggle of a cartoon dough figure for baking goods

7.2.7 Scent Marks
7.2.7.1 Distinctiveness. A scent that is capable of distinguishing the goods or services of the owner from those of others should be capable of registration. A scent mark that is not directly associated with a product or service should be considered distinctive. A scent mark may be registerable if it is inherently distinctive or upon a showing of acquired distinctiveness.

7.2.7.2 Functionality. Many products have scents intended to enhance their attractiveness. Such goods range from cleaning products to perfumes. Potential purchasers are unlikely to regard such fragrances as an indication of origin, and thus it may be difficult to establish adequate distinctiveness. Furthermore, scents that arise from the goods or services specified should not be accepted for registration.

For a scent mark to be registerable, assuming that the mark can be represented properly, an applicant must establish:

- That the scent is used or intended to be used as a trademark.
That the scent does not arise from the goods or services, but is added or is a combination created by the applicant.

That the public associates, or will associate, the scent exclusively with the applicant for the goods or services specified.

EXAMPLES OF SCENT MARKS FOUND TO BE DISTINCTIVE AND NON-FUNCTIONAL:

- the scent of a rose as applied to car tires
- the scent of bubblegum for an oil based metal cutting fluid

7.2.8 Flavor Marks

7.2.8.1 Distinctiveness. Distinctiveness requirements for flavor marks are similar to those for scent marks.

7.2.8.2 Functionality. Flavors that arise from the goods or services specified should not be accepted for registration. If a product employs a flavor to mask an unpleasant taste, the flavor is functional and is not protectable as a mark. For a flavor mark to be registerable, assuming that the mark can be represented properly, an applicant must establish that:

- the flavor is used or intended to be used as a trademark
- the flavor does not arise from the goods or services, but is added or is a combination created by the applicant
- the public associates, or will associate, the flavor exclusively with the applicant for the goods or services specified

EXAMPLE OF A FLAVOR MARK FOUND TO BE DISTINCTIVE AND NON-FUNCTIONAL:

- Taste of liquorice for paper goods.

7.2.9 Touch Marks

7.2.9.1 Distinctiveness. While a touch mark may possibly be inherently distinctive (i.e., where the touch characteristic, properly defined, is unusual and unexpected in the context of the goods or services involved), it is more likely that evidence of distinctiveness acquired through use will have to be provided before a touch mark is registerable as a trademark or service mark.

7.2.9.2 Functionality. Where a texture is essential to the use and purpose of the article or which inherently affects its cost or quality, it is not protectable.
Functional touch characteristics are subject to the same exclusions or limitations as functional product configurations or generic word marks.

EXAMPLE OF A TOUCH MARK FOUND TO BE DISTINCTIVE AND NON-FUNCTIONAL:

- velvet textured covering on the surface of a bottle of wine

7.2.10 Moving Image Marks

7.2.10.1 Distinctiveness. Moving image marks (including gesture marks) are treated as device marks and may be registerable if inherently distinctive or offer a showing of acquired distinctiveness. Moving images that are distinctive, and not functional or ornamental should be eligible for registration.

7.2.10.2 Functionality. Moving image marks, provided they function as indicators of source or origin, should be evaluated for registerability under the same criteria as design marks. However, a distinction must be made between a moving image that does not function as an indication of source of origin, i.e., one that comprises a copyrightable work (such as a motion picture) and a moving image which functions as an indication of source or origin and is therefore eligible for registration as a trademark. Where separate pictures are submitted, the specimens cannot depict more than one mark.

EXAMPLES OF MOVING IMAGE MARKS FOUND TO BE DISTINCTIVE AND NON-FUNCTIONAL:

- A television station’s moving logo
- a man tapping the side of his nose in a knowing way

7.3 Distinctiveness Issues

7.3.1 Generic Terms

Terms which are generic should not be considered the subject of a trademark and should never be registered. For purposes of examination, a generic “mark” is a common descriptive term for a particular good or service. Such generic terms can include former trademarks (such as ESCALATOR) that are in common use as the name of a type of product by multiple sources. Such terms do not function as source identifiers, and should be left free for use by competitors. Examiners should not consider marks to be generic if an applicant can prove that the mark covers merely the preferred “brand” of a particular type of service, i.e., there is still recognition by consumers of the mark as a particular source of goods or services. This will allow for preservation of well-known marks, which are in danger of becoming generic. Where an applied-for mark is well known through extensive use, but has never been registered, consideration can be given to
policing efforts by the applicant as relevant in an evaluation as to whether the mark is presently generic, or is still functioning as a trademark to identify source.

### 7.3.2 Descriptive Terms

**7.3.2.1 Definition.** Descriptive terms are those which (i) specify the name of the goods or services, or (ii) describe an ingredient, quality, characteristic, feature, purpose, function or use of the specified goods or services. The reason for assessing whether a term is descriptive for purposes of registration is that, in the course of trade, anyone should be able to use words which describe a product or service.

**7.3.2.2 The Mark Must be Examined as a Whole.** The mark cannot be dissected and its individual parts be examined separately for descriptiveness. The mark will be considered descriptive if, as a whole, it describes an ingredient, quality, characteristic feature, purpose or use of the specified goods or services. Certain elements of the mark may be disclaimed (where allowed), but it is the overall level of distinctiveness, which must determine whether the mark is registrable.

**7.3.2.3 No Imagination.** The Examiner should not need to exercise his/her imagination to determine the type of goods or a characteristic of the goods described by the trademark. If such thinking is needed to generate a descriptive meaning, it is likely that the mark has enough distinctiveness to be registrable.

**7.3.2.4 Test.** The test to be applied is: *Does the average consumer understand the term to describe an ingredient, quality, characteristic, feature, purpose, function or use of the goods or services of the applicant?*

**7.3.2.5 Examination of Goods or Services.** The Examiner should examine the goods or services for which registration is sought and consider the manner in which the mark is used or intended to be used to establish a determination of descriptiveness. Also of relevance is the actual or likely effect of use of the mark on the average purchaser of the goods or services. Sources used in examining for descriptiveness will include dictionaries, databases, Internet searches, industry literature, surveys, and other such sources to show general understanding of the words/designs of the mark.

**7.3.2.6 Acquired Distinctiveness.** A descriptive term can acquire distinctiveness through use; evidence of acquired distinctiveness must be shown in order for a descriptive term to be registrable. A generic term is never registrable because it is incapable of being or becoming distinctive of the goods or services of one person or business. The test for determining if a term is generic involves assessing its primary significance to the relevant public (see Section 7.3.1 above).
7.3.3 Surnames
A surname should be capable of registration and protection as a trademark provided it functions primarily as an indicator of source or origin with respect to the relevant goods/services, and therefore, is not considered primarily merely a surname.

If a word that is a surname also has another meaning in the applicable language, the mark is not primarily merely a surname and thus a surname objection should not be raised by the Examiner.

7.3.3.1 The Surname Alone. In evaluating whether the primary significance of a term is a surname, rather than a source indicator, reference resources such as telephone directories, census data, Internet searches, etc., should be taken into account.

The same considerations should be applied when the mark under consideration appears with grammatical elements, such as plurals or possessives. Once evidence of surname significance is produced by the Examiner, the burden should shift to the applicant to prove that the surname has acquired distinctiveness, such that the surname significance is not the primary significance of the term. Such proof could take the form of consumer surveys or affidavits, sales and advertising evidence, and so forth, which demonstrates that the consuming public views the term as a trademark.

7.3.3.2 Combinations. When a surname appears in combination with other elements, overall distinctiveness should be assessed. The commonness of the surname should still be a factor.

7.3.3.2-1 The Surname Together With Other Elements of a Name, Including Multiple Surnames, and Personal Names. The presence of elements of a name other than the surname itself could serve to make the mark more distinctive. The more unusual the accompanying element, the more likely the surname is a mark and will be registerable. The test remains whether the primary significance of the mark as a whole is a surname, or functions as a source identifier.

7.3.3.3 Phonetic Equivalents. A deviant spelling of a surname should be regarded as having more distinctiveness than the surname itself. If the word happens to be, at the same time, a deviant spelling of a surname and a dictionary word, and it is likely to be primarily understood in the actual context as the dictionary word, a surname objection should not be raised.

7.3.3.4 Surname Combined With Other Elements. An additional element will affect the primary significance of the combination to an extent
depending on its own distinctiveness. Mere addition of a description of the goods or services on or in connection with which the mark is applied should not be considered to add distinctiveness. A design or description of some inventiveness with regard to the goods or services may increase the trademark significance and decrease the surname significance. As the added element moves towards something that would be registerable in its own right, and would be viewed by the public as the dominant portion of the mark, a surname objection ceases to be applicable.

7.3.4 Geographical Marks
INTA supports the protection of geographical indications as an intellectual property right, but INTA also firmly advocates that such protection must not prejudice other existing intellectual property rights, including trademarks. Harmonious co-existence of geographical indications and trademarks is possible as long as conflicts between these rights continue to be resolved pursuant to the well-established intellectual property principles of territoriality, exclusivity and priority. The priority principle espoused by INTA means that a validly registered prior mark should prevail against a later geographical indication and vice versa.

In evaluating whether to register a term demonstrably having geographical significance, the Examiner must initially evaluate whether the average consumer would connect the term with the geographical origin of the goods/services claimed in the application. In this evaluation, the Examiner should consult appropriate geographical dictionaries, atlases, and databases related to the goods to determine if there is an association between the goods and the geographical location.

7.3.4.1 Geographical Terms that do not Indicate Geographical Origin of Goods and are Arbitrary in Relation to the Claimed Goods/Services. Many marks are geographical terms but do not serve as an indication of the geographical origin of the goods, or relate to the goods in any way. In such cases, registration should be allowed without proof of acquired distinctiveness.

EXAMPLE - NORTH POLE for Bananas

Here the mark, although it is well known as a geographical place does not serve to relate the goods to the place in the mind of the consumer, and therefore does not serve as an indication of geographical origin of the goods. Therefore, the mark should be treated as an arbitrary designation, which should be registered without proof of acquired distinctiveness, because any geographical meaning is clearly not related to the goods. Additionally, this category includes other such marks where any geographical connection between the goods and the place is not perceived by the average consumer.
Also illustrative of this category of marks are names of rivers, seas, lakes, bays, oceans, mountain ranges, streets, roads, towns, etc., which are registerable without proof of acquired distinctiveness unless viewed by the average consumer as indicative of the geographical origin of the claimed goods or services. Where the river, sea, lake, etc., has a reputation for a particular good, or where a region is known by the river, sea, lake, etc., of the region, an applicant should either: 1) not be granted rights to that name, or, 2) should be required to include a disclaimer (where applicable) for the geographic place.

7.3.4.2 Geographical Terms that do not Primarily Indicate Geographical Origin, but Suggest a Desirable Quality of the Claimed Goods/Services. Other geographical terms suggest, for example, that the product is stylish or of high quality, but do not serve primarily to indicate the geographical origin of the goods. In such cases, registration is allowed without proof of acquired distinctiveness.

EXAMPLE - HYDE PARK for Men’s Suits

7.3.4.3 Geographical Terms that Primarily Describe the Geographical Origin of the Goods. Where a mark serves primarily to indicate geographical origin of the goods, and in any case where the term is needed by multiple producers of goods in the region to indicate origin due to a reputation in the region for producing goods of a particular character or quality, registration should not be allowed, even if some acquired distinctiveness could be demonstrated. In addition to current needs, consideration should be provided prior to granting rights where there is a strong likelihood of others needing to use the name of the geographic place in the future or as the region develops.

EXAMPLE - FLORIDA for Oranges

Particular care in this regard should be taken where the goods claimed in the application are natural produce.

7.3.4.4 Geographical Terms that Primarily Describe or Misdescribe the Source or Origin of the Goods, But May Not Be Needed For Use By Multiple Producers. Where the term may not be needed by multiple producers in the area but serves primarily to describe the geographical origin of the goods, OR the term is a place which has a reputation in the goods or services claimed, registration should be allowed only with proof of acquired distinctiveness. The larger the population of the place concerned and/or the stronger the connection between the goods and the geographical location, the more acquired distinctiveness will have to be demonstrated.
EXAMPLE - PARIS for Jeans

Because Paris is known as a center for fashion and style, the mark PARIS for clothing or related services is likely to primarily describe (or misdescribe, if not originating in Paris) the origin of the goods to the average consumer. Therefore, a showing of a high degree of acquired distinctiveness should be required before registration is allowed, in order that the mark primarily indicates to the average consumer the source of the goods, rather than the geographical location, i.e., functions as a trademark.

7.3.4.5 Additional Protection for Geographical Indications for Wines and Spirits. When the claimed goods include wines or spirits, Article 23 of the TRIPs Agreement requires that registration be refused for trademarks that comprise or consist of a “geographical indication.” This rule applies even if the trademark does not, in the Examiner’s judgment, deceive the purchasing public as to the place of origin of the goods. Further, the rule applies even though the geographic indication may not be recognized in the examining Trademark Office, provided the geographic indication is recognized in its country of origin.

This rule applies only to terms that are comprised of or contain geographical indications. It does not disqualify a trademark for wines or spirits from registration simply because it has a geographical component.

A “geographical indication” is a term designated under the laws of its country of origin to identify goods (including wines or spirits) from which “a given quality, reputation or other characteristic...is essentially attributable to its geographic origin.” (TRIPs Article 22).

TRIPs exempts from this rule trademarks applied for, or where rights have been acquired through use in good faith, either before the date of TRIPs or before the geographical indication was protected in its country of origin. (TRIPs Article 24 (5)).

EXAMPLE: LAKE NIAGARA for wine would not be affected by this rule because the registration issued in 1987.

EXAMPLE: BOUNTIFUL BORDEAUX for wine not originating in the Bordeaux region of France would not be registerable because the term “Bordeaux” is a geographical indication for wine.

7.3.5 Family Marks
A family of marks should be recognized. In order to constitute a family of marks, a group of marks must have a recognizable common characteristic and be used in such a way that the public associates not only the individual marks, but also the common characteristic of the family of marks, with the trademark owner. Simply
using a series of similar marks does not of itself establish the existence of a family; there must be a recognition among the purchasing public that the common characteristic is indicative of a common origin of the goods.

A family of marks should be recognized when the pattern of usage of the common element is sufficient to be indicative of the origin of the family.

In order to claim a family of marks, an owner must demonstrate that the mark(s) asserted to comprise the family has been used and advertised in promotional material or used in everyday sales activities in such a manner as to create common exposure and thereafter recognition of common ownership based upon a feature common to each mark.

7.4 **Modification by Disclaimer**

7.4.1 **The Purpose of Disclaimer**

In territories where disclaimers are permitted or required, disclaimers may serve as a means of preventing one party from obtaining exclusive rights in certain nondistinctive components of a mark that otherwise would be distinctive and registerable as a whole. Examples of such nondistinctive components that may be incorporated in an otherwise distinctive mark include descriptive or generic matter, terms common to the trade, and geographical terms or surnames not having trademark significance.

7.4.2 **Voluntary and Mandatory Disclaimers**

Disclaimers may be given voluntarily by the applicant in its application to register the mark, provided the mark, as a whole is not disclaimer. Also, Examiners, in some territories, may ask for the disclaimer of any component of a trademark which is not independently registerable, for example, due to its descriptiveness or its being generic (see Section 7.1).

7.4.3 **The Effect of Disclaimers**

Disclaimers are ineffective in overcoming objections that: (i) the whole of a mark is descriptive or generic; or that (ii) the mark is scandalous, deceptive, or confusing.

Disclaimers do not prejudice or affect the right of a registrant (a) to defend its mark through passing off or other common law remedies or unfair competition or (b) to seek registration, without disclaimer, of a previously disclaimed component.

A disclaimer is a concession that the disclaimed component is not *per se* distinctive, and is one factor to be weighed in determining confusion. However, in an infringement analysis, it is the totalities of the components of a mark that must be considered, including any disclaimed components.
7.4.4 Disclaimer of Descriptive or Generic Terms

7.4.4.1 Form of Disclaimer. Disclaimers can be entered in the form:

“The applicant disclaims the right to exclusive use of [disclaimed component] apart from the mark as a whole.”

Each descriptive or generic unit, of however many components, should be separately disclaimed.

EXAMPLE: TOFFEE and CRISP should be separately disclaimed in the mark TOFFEE CRISP, but the words RED WINE should be disclaimed as a phrase in the mark JUMBO'S RED WINE.

An example of a disclaimer involving a representation is:

The applicant disclaims the right to exclusive use of the representation of wine bottles per se apart from the mark as a whole (where the application covers wine and wine bottles appear in the mark).

7.4.5 Use of Hyphenated and Compound Words and Disclaimers

A disclaimer of a descriptive or generic portion of a mark may be considered more appropriate where the term is separated from the remainder of the mark.

EXAMPLE - Disclaimer may not be required for WINTERWINE or WINTER-WINE, although WINE must be disclaimed for WINTER WINE (all for wine).

7.4.6 The Extent of a Disclaimer

Any or all components of a mark may be disclaimed separately, provided there is something distinctive about the mark as a whole.

EXAMPLE: TOFFEE CRISP for a candy bar (each word disclaimed separately).

To avoid cluttering the Register, but subject to context, disclaimers should not be requested for insignificant words, prepositions, articles, conjunctions, and the like, for example, “brand”, “product”, “in”, “and”, “a”, “company”, “Ltd.”, “Inc.” and “the”.

7.4.7 Disclaimers and Proof of Acquired Distinctiveness

Disclaimers are not required for components that have been registered independently upon proof of distinctiveness by the same applicant (or its predecessor-in-title) for the same goods or services.

Disclaimers may be suggested by the applicant when all the words of the trademarks are non distinctive and the trademark as a whole is non distinctive.
7.4.8 Trends in Disclaimer Practice
The practice of requiring disclaimers has been abolished by certain countries (such as Australia). As of the publication date of these Guidelines, INTA is reviewing recommendations as to voluntary and required use of disclaimers.

7.5 Assessment of Acquired Distinctiveness
Distinctiveness is required for registration of any word or design as a trademark. If the mark is not inherently distinctive, in many cases, it can be registered upon a showing of acquired distinctiveness. A mark, which, rather than being descriptive of the goods, is suggestive (i.e., use of a consumer's cognitive facilities is required to associate the mark with the nature of particular type of goods or services), should be considered inherently distinctive. Registration of suggestive marks should be allowed without a showing of acquired distinctiveness. A claim of acquired distinctiveness may apply to a portion of a mark. The standards for establishing acquired distinctiveness are the same whether the claim of distinctiveness pertains to the entire mark or to a portion of it.

Examiners may consider the following as criteria of acceptance of a claim of acquired distinctiveness by the applicant:

- Sales, volume, or revenue from services;
- Length and scope of use prior to filing (for example, in the U.S., proof of five years of substantially exclusive and continuous use of the word as a mark may be accepted as prima facie evidence that the mark has acquired distinctiveness);
- Geographical area of sales of goods or provision of services;
- Extent of advertisement featuring the mark;
- Degrees of popular awareness among the consuming public that the mark mandates from the applicant (by submission of a survey(s), statements by customers including retailers, etc.); and
- Ownership of prior registrations for the same mark in connection with the same or similar goods or services.

7.6 Scandalous Marks
Provided the “scandalous” term is capable of functioning as a trademark, the test for registrability should be whether a substantial body of the population would understand the mark applied for to consist of scandalous, immoral or offensive matter in relation to the respective goods or services.

If the Examiner believes that the mark falls within the above definition, an objection should be raised and the burden of proof shifted to the applicant to provide satisfactory evidence to the contrary.
7.7 **Misdescriptive Marks**

The expression “misdescriptiveness” is to be construed to exclude from registration trademarks that (i) misrepresent the character or nature of the goods/services AND (ii) where from the facts of the application (trademark/goods), it is likely that purchasers of the goods/users of the services will be deceived. Such trademarks are termed “deceptively misdescriptive.”

An important criterion is whether there is any real potential for deception of the public. The test is whether there is a real prospect of a purchaser of the goods/user of the service would be misled as to the characteristics and or nature of the goods/services. This would include a false association with a well-known product, which is not connected, to the product in question.

In order to determine whether a trademark is misdescriptive, it is first necessary to determine whether the term is descriptive of some goods/services. The test may be whether the trademark (or a term within the trademark) conveys an immediate idea of, for example, an ingredient, quality, characteristic, function or feature of the goods or services. If the term immediately conveys such an idea, but the idea is false, although plausible, then the trademark is deceptively misdescriptive and is unregisterable.

It is important to consider whether the idea is plausible. Arbitrary or fanciful trademarks should not be excluded from registerability by the application of this test.

A trademark may be misdescriptive without being deceptively misdescriptive. The trademark will only be deceptively misdescriptive if purchasers of the goods/users of the services are likely to take literally the misdescription.

A more detailed test may involve establishing:

- Whether the trademark misdescribes the goods; and if so,

- Whether a reasonable prospective purchaser is likely to take literally the misdescription.

Assessing this may involve establishing whether the misdescription would materially affect the decision to purchase the goods or utilize the services.

Where the trademark explicitly or implicitly misdescribes:

(a) Place names or devices of a geographical nature where the place has a reputation for the goods or services,

or
(b) A particular kind, quality, quantity, intended purpose or other characteristic, and the goods are not restricted to the goods of that origin or characteristic, then, subject to a proviso that there must be real potential for deception of the public, an objection should be raised.

Where an objection is raised on (a), the registration should be refused for the goods or services having their reputation in the place name or devices of a geographical nature. Where an objection is raised on (b), acceptance may be obtained after suitable restriction of the goods (subject to the distinctiveness of the trademark as a whole).

7.8 Flags, Coats of Arms, Emblems, Official Signs, Abbreviations, and Names of International Intergovernmental Organizations

There are provisions in the Paris Convention Article 6ter regarding the registerability of flags, coats of arms, emblems and official signs, etc. as trademarks or elements of trademarks. Article 6ter concerns trademarks, but its purpose is not to regulate their protection as subjects of industrial property but rather to exclude them from becoming such subjects in certain circumstances. The member states of the Paris Convention are free to apply these provisions also to service marks.

A trademark may not be registered if it includes coats of arms, flags or other official emblems, abbreviations, names or symbols of intergovernmental or international organizations, official seals, signs or hallmarks, the use of which is forbidden by law without authorization by the competent authority. Examples of abbreviations of such names are EFTA, UNESCO and WHO.

The competent authority referred to here is that of the country or state whose emblems, official signs and hallmarks are involved. These authorities may allow the use of such emblems, signs or hallmarks in certain trademarks, probably of their own citizens.

8. RELATIVE GROUNDS EXAMINATION

If a Trademark Office conducts a relative examination for similar prior marks, it is recommended that, rather than determining likelihood of confusion based solely upon classification of goods/services, the examination of marks should include an analysis of the actual conditions under which the purchasing public encounters the goods/services, under the respective marks in the marketplace.

8.1 Search - Compiling a Group of Similar Marks

If a mark ("claimed mark") meets registerability requirements following absolute examination, a search should be undertaken to determine the existence of similar marks in respect of goods/services identical or related to those of the application of the claimed mark. Similarity of marks should be determined according to the factors listed below. This search should include marks which are (i) currently registered in that country, or (ii) the subject of prior applications for registration in that country. Further, any similar well-known marks, which are known to the Examiner, whether or not registered, or the subject of a prior trademark application(s), may be included
with the marks located in the search, and conflict can extend beyond the goods/services for which the mark is well known.

If a similar mark is located by the search (“located mark(s)”), the Examiner must, considering all marks in their entireties, evaluate whether the goods to be sold or services to be provided under the claimed mark are likely to be confused as authorized by the owner of the located mark(s) or originating from the same source as the goods sold or services provided under the located mark(s). If in the Examiner’s judgment, confusion of the relevant segment of the purchasing public is likely to occur according to the standards listed below, the located mark(s) should be cited to the applicant in a written statement as a bar to the registration of the claimed mark.

8.2 Examination - Factors Involved in Assessing Likelihood of Confusion

The suggested factors to be included in an evaluation of likelihood of confusion are as follows:

8.2.1 Comparison of the Appearance, Sound, Connotation and Commercial Impression of the Marks

Marks should be compared in their entirety, and not dissected into elements unless these elements are likely to cause confusion as to the source of the goods/services associated with the respective marks. For example, similarities in the beginnings of the marks, and differences of only one or two letters between the marks should be taken into account.

It is proper to take into consideration the relative strength of a prior mark in assessing whether registration of a later applied-for mark is likely to cause confusion with the prior mark. The existence of an identical or closely similar distinctive mark should normally bar registration of a subsequently applied-for mark, unless other factors, such as, but not limited to, the nature of the pertinent goods or services, channels of trade, and sophistication of the consumer, are such that confusion would be unlikely.

If a located mark shows additional matter, including but not limited to a house mark, or matter which is descriptive or suggestive of the goods or services, it should not automatically lead to a finding of non-confusion. The same thoughtful analysis should apply where a country has adopted a likelihood of association provision concerning prior marks.

When comparing composite marks composed of both words and devices, either portion may generally be considered to be dominant, and there should be no definite rule on this issue. The strength or attractiveness (i.e., comparative size of the device element and meanings) of the word and the device portions of the particular mark(s) in relation to the goods or services must be evaluated. In some cases, a distinctive design may clearly function as the dominant portion of a mark, barring registration of all marks containing a confusingly similar design, even if the word portions of the marks are clearly different.
8.2.2 Fame of the Earlier Mark
It is highly recommended that, in the spirit of Article 6bis of the Paris Convention, well-known or famous marks of domestic or foreign third parties known to the Examiner even if not registered, should be included in the confusion analysis. Further, in the spirit of TRIPs Article 16(3), a very well known or famous similar mark, whether or not registered in the country of examination, should be cited against any claimed mark covering goods/services in all classes, in order to prevent confusion, as well as dilution of such well-known or famous marks.9

8.2.3 Comparison of Goods and Services
Another factor in determining whether granting the registration of similar marks is likely to lead to confusion among the purchasing public is a comparison of the similarity or dissimilarity and type of goods or services described in a located mark.

However, there should be no per se refusal to register because two similar marks are to be used on or in connection with goods/services which are similar or are in the same or related classes. In a fair evaluation of all relevant confusion factors, including actual conditions in the marketplace, the factor of similar or related goods/services may not be dispositive.

Additionally, where the goods of the claimed mark and located mark(s) are dissimilar, the Examiner should consider in the confusion analysis that in some cases (for example, clothing and fragrance), goods emanating from a single source are sold commonly to the same purchaser group in a complementary or pre-packaged way.

8.2.4 Comparison of Trade Channels
This factor should measure the likelihood of whether confusion is likely when the same purchasers will encounter the goods/services of the claimed mark and the located mark. The facts of each case should be evaluated concerning confusion. No specific formula of products meeting in the trade, manufacturing, wholesaling or retailing market should per se prohibit concurrent registration of the similar marks, whether or not the goods upon which the marks being used, are related. For example, in very sophisticated markets or for very expensive items, goods may generally be sold under somewhat similar marks without consumer confusion, as compared with inexpensive goods, which are more likely to be purchased on impulse, without careful examination by the purchaser as to source or origin.

8.2.5 Status of the Register and Concurrent Use

9 Because dilution is not generally considered to be an issue related to examination for registerability, these Guidelines do not discuss dilution. INTA has additional publications on the subject of dilution which may be helpful and of interest in this regard.
Clearly, if multiple marks containing a similar word or design element can and have co-existed on the Register in the name of different proprietors without apparent confusion among the relevant purchasers, such evidence is in favor of an applicant for registration of an additional such mark. In countries having provisions for opposition proceedings, the owners/users having earlier rights than the applicant will have an opportunity to object to additional registrations.

It is recommended in jurisdictions where no search of the Register is conducted during examination, and no opposition is allowed, that notice of the mark to be approved for registration be forwarded to the earlier owner(s), or made available publicly, prior to approval for registration. Earlier owners would thereby have notice of a potentially confusing mark, which could be objected to according to the provisions within the jurisdiction, or could later be the subject of a suit for injunctive relief in a court proceeding.

8.2.6 The Variety of Goods on Which a Mark is or is not Used (House Mark, “Family” Mark, Product Mark)

The owner of a house mark used on a wide variety of products, or of a family of marks used on goods sold and advertised together, may be considered as having more latitude to exclude second comers from the registration of similar marks than the owner of an ordinary mark which is not well known. This is especially true if the applied for mark has not already become well known through use at the time of the application.

8.2.7 Any Other Established Fact Probative on the Issue of Whether the Claimed Mark is Likely to be Confused with the Cited Mark(s)

The mark may be examined for any other fact probative issue to determine a likelihood of confusion with cited marks.

9. OBSERVATIONS PROCEDURE / LETTER OF PROTEST

9.1 General

Third parties may bring to the Trademark Office’s attention facts that would support a refusal of registration on absolute grounds, through certain mechanisms, such as the observations procedure of the CTM or letter-of-protest practice in the United States (“Protest”). The third party does not become a party to the action.

With the advent of online search capabilities, an administrative procedure for lodging of Protests from third parties who object to the registration of marks in pending applications should be available. A Protest should not be used to delay registration or to present purely adversarial arguments. A Protest should not be used as a means to present arguments more appropriately presented in an opposition proceeding.

A Protest is necessary to permit third parties to bring to the attention of the registry facts which could affect or prevent registration of the mark. A Protest should contain proof and support of the information regarding the facts set forth as to non-registerability.
Acceptable reasons on which to base a Protest include:

- The term is generic
- The term would cause a likelihood of confusion with a registered mark
- Pending litigation relevant to the registerability of the mark is underway

If the administrative body denies the Protest, the protester should be able to pursue remedies otherwise available, such as an opposition proceeding. A Protest should not stay the time period for filing an opposition.

A procedure should be available for petitioning the denial of a Protest.

9.2 **CTM System**

Article 41 of the Council Regulation (EC) No 40/941 of 20 December 1993 on the Community trade mark, foresees the possibility for any third party to file observations also known in other countries as a letter of protest.

*Article 41: Observations by third parties*

1. Following the publication of the Community trade mark application, any natural or legal person and any group or body representing manufacturers, producers, suppliers of services, traders or consumers may submit to the Office written observations, explaining on which grounds under Article 7, in particular, the trade mark shall not be registered ex officio. They shall not be parties to the proceedings before the Office.

2. The observations referred to in paragraph 1 shall be communicated to the applicant who may comment on them.

If a third party believes that a trademark should not have been accepted in regard to absolute grounds, it can file observations to the OHIM by means of a simple letter. The OHIM will review the letter and determine whether it raises serious doubts as to the registerability of the trademark. If it considers that it raises serious doubts then it will reopen examination of the trademark.

Important remarks:

- the deadline to file the observations by third party is fixed and the observations must be filed prior to the opposition deadline.
- Once the third party has filed the observations it is not a party anymore to the proceedings. If serious doubts have been raised the proceedings will only be between the CTM Applicant and the OHIM.
- As the proceedings will only be between the CTM Applicant and the OHIM, even if the Applicant obtains from the third party a declaration stating that the trademark does not raise serious doubts anymore, this letter will not stop the proceedings.
10. CONDUCT OF THE DIALOGUE BETWEEN TRADEMARK OFFICE AND APPLICANT

10.1 Applicant’s Opportunity to Overcome the Examiner's Citation of Similar Marks

After the submission by the Examiner of marks believed to be confusingly similar, the applicant for registration of the claimed mark must then be given an opportunity to rebut the Examiner’s determination of the non-registerability of the claimed mark, by submitting to the Trademark Office evidence that no likelihood of confusion exists. Doubt in the Examiner’s mind should be resolved against the second comer applicant, which has a duty to avoid confusion in its choice of marks.

10.1.1 Amendment

If local law allows, there should be provision prior to publication for the applicant to amend the form of the claimed mark, if, in the Examiner’s view, such amendment would decrease or eliminate any likelihood of confusion. However, no amendment should be allowed which materially alters the character of the mark. This would provide for elimination of any likelihood of confusion without need for the applicant to lose its current priority date, or go to the expense of filing a new application. (See Section 6.4 above).

10.1.2 Argument

The applicant should have an opportunity to submit specific written arguments that the factors and evidence considered in a confusion evaluation have not been properly evaluated by the Examiner, and that confusion is therefore not likely.

Also, provision should be made for a telephone or personal interview with the Examiner wherein it is possible to present oral arguments on non-confusion.

Additionally, provision should be made for submission of physical or documentary evidence, including affidavits of persons with actual knowledge of the goods/services concerned. Such evidence may not have been initially available to the Examiner, but may demonstrate that under a fair evaluation of the factors to be considered, confusion is not likely to occur.

10.1.3 Consent

A Trademark Office may decide, if local legislation permits, to accept a straightforward letter of consent for registration of a claimed mark from the owner of a cited mark.

Alternatively, where the applicant and the owner of the cited mark agree that no confusion is likely to occur, provision should be made for evidence in the form of a written consent by the owner(s) of the cited mark(s) which illustrates that, in spite of a fair evaluation of the confusion factors on the basis of evidence available to the Examiner, the applicant's mark should be registered. Such consent may include the following factors, where applicable, in each case:
• That a significant period of concurrent use has passed with no evidence of actual confusion among the relevant purchasing public;

• That the applicant’s goods/services are distinct from the goods/services of the cited marks;

• That the trade channels and/or the purchaser groups are different;

• That the applicant and the owners of the cited marks agree not to use the mark of the other on their own goods/services, and agree not to use their own mark on the goods/service of the other;

• That if confusion should occur, the owners of the respective marks will work together and take reasonable action(s) to promptly obviate such confusion;

Inclusion of any other relevant factors illustrating that in this specific case, confusion is not likely to occur.

10.1.4 Provision for Appeal
Where the applicant has presented all of its arguments and evidence against likelihood of confusion, but the Examiner issues a final refusal to register the claimed mark, an appeal to a higher authority should be available to the applicant, at which appeal the evidence on likelihood of confusion is evaluated de novo, where permitted by law.

11. PUBLICATION
Once an Examiner approves an application, arrangements should be made for publication of the application for opposition purposes.

11.1 Details to be Included
The publication should include:

• A representation of the mark
• Full details of the applicant
• A full list of goods and/or services specified
• Details of any disclaimer, limitation or condition of registration
• The date of application
• The date of first use, if applicable
• Any convention priority claim
• An indication, if applicable, that the application was approved on the basis of distinctiveness acquired through use

12. EXAMINATION OF OPPOSITIONS
In addition to the recommendation that marks can be examined for inherent registrability and conflict with prior marks before publication, it is also recommended that a period exist for inter partes opposition proceedings. The Table in Section 5. provides examples of
opposition policies adopted by Trademark Offices as of 2007. These policies are subject to change.

12.1 Opposition Proceedings
Prior to registration of a trademark, there should be an opposition period of at least one to three months either as of right, for good cause or on consent, with the possibility of extending the period on consent for a limited period not to exceed two additional months (in some countries, a “cooling off period”), to permit the parties to settle without the necessity of proceeding with an opposition.

12.2 Standing/Entitlement
Any person or entity having a genuine interest, i.e. having rights in:

- a mark which is potentially conflicting or may be damaged by registration of the published mark;
- a mark which has already been used and is considered to have caused actual confusion with the goods or services of the opposer’s mark.

Additionally, persons who show that they would be damaged by registration of a published mark on the basis of inherent non-registrability, (i.e., genericness, mere functionality, mere descriptiveness, etc.) or on the basis of fraud or dilution, should also have standing to oppose. Payment of a uniform fee (without discriminating between national and non-national opposers) should be required to deter frivolous oppositions.

Alternatively, Trademark Offices could decline to require a showing of standing in the interest of preserving the integrity of the Register.

12.3 Notice/Proceedings
The nature of the Notice of Opposition will be a function of how a Trademark Office decides oppositions. In many jurisdictions, an opposition is similar to a civil trial, with various filings due over the course of time, with a decision being rendered by a board of judges (referred to in this Section as a Board Opposition). In other jurisdictions, an opposition is similar to a response to a formal refusal to register a mark, with a decision being rendered by an examining attorney (referred to in this Section as an Examiner Opposition). The proceedings should be available to the public.

For Board Oppositions, the Notice of Opposition should be filed with the Trademark Office and consist of a short and plain written statement signed by the potential opposer or its legal representative. The Notice of Opposition should disclose the name and address of the opposer, the serial number or registration number of the mark being opposed, and the ground(s) for opposition. The opposing party should pay the fee to institute the proceeding, but each party should pay its own costs thereafter.
For an Examiner Opposition, the Notice of Opposition should be a more comprehensive written statement, which includes all of the information one would find in an Board Opposition plus any evidence the opposing party wishes to put on the record.

12.4 **Service**
The Notice of Opposition should be promptly served on the applicant. All filings submitted to the Trademark Office thereafter should be promptly served on the other party. The fact that an opposition has been filed against a mark should be published by the Trademark Office so as to notify any interested third parties.

12.5 **Answer**
Upon receipt of the Notice of Opposition, the applicant should be given a minimum period of time, such as 30 or 60 days, in which to answer or seek dismissal, with the possibility of extending such time period on consent, and on approval by the Trademark Office, so as to permit the parties to attempt a settlement.

As with the Notice of Opposition, the nature of the answer will be a function of how the Trademark Office decides oppositions. For Board Oppositions, an answer should state in short and plain terms the applicant’s defenses to each claim asserted and admit or deny the averments upon which the opposer relies. If the applicant is without knowledge or information sufficient to form a belief as to the truth of an averment, applicant should so state, which will serve as a denial. An answer should contain any affirmative defenses.

In an Examiner Opposition, an answer should include all of the information one would find in an answer in a Board Opposition plus any evidence the defending party wishes to put on the record. The opposing party should be allowed a period of time, such as 20 days, within which to file a surreply, which should include evidence in support of the arguments presented in the surreply.

12.6 **Default**
If the applicant fails to respond, this should be viewed as a possible lack of interest on the part of the applicant to proceed with the application. Procedurally, when an applicant fails to answer, INTA recommends that the Trademark Office either: 1) mail a notice of default to the applicant or publish a notice for a period of 30 to 60 days; or 2) mail notice of the projected date of decision for the case and render a decision in the matter. Absent a showing of good cause for the lack of a timely response, the opposition should be sustained.

12.7 **Amendment of Opposition Pleadings**
There should be a procedure for amending opposition pleadings. Such amendment should be initially as of right, with a provision for amendment pursuant to motion later in the proceedings.
12.8 Procedure
Except as otherwise provided, and wherever applicable and appropriate, procedure and practice in *inter partes* proceedings shall be governed by the civil rules that apply in the jurisdiction in which the Trademark Office resides.

12.9 Consolidation of Proceedings
Consolidation of proceedings should be permissible only where the cases to be consolidated involve the same or related parties and the issues are the same or virtually identical. For example, consolidation may be appropriate where a word mark and a composite mark (including the word mark) of the same applicant are published together. We do not recommend consolidation of multiple party oppositions where several unrelated entities have opposed the same application, although it may be preferable to have oppositions against the same application heard by the same examiner or board of examiners.

12.10 Suspension
There should be a procedure for suspension of the opposition with consent of the parties. Suspension should be available if (i) a party or parties to a pending case are engaged in a civil action or another trademark appeal proceeding before the same Trademark Office which may have a bearing on the case; (ii) there is pending before the Trademark Office a motion which is potentially dispositive of the case; or (iii) there is good cause, upon motion or a stipulation of the parties approved by the Trademark Office.

12.11 Evidence
In an Examiner Opposition, evidence should be submitted in conjunction with the Notice of Opposition, the answer, and the surreply.

In Board Oppositions, the submission of evidence shall be as follows:

12.11.1 Timing of Submission
Offering of evidence into the opposition proceeding should be subject to time limits of 180 days. If the opposer/opponent fails to enter evidence within the set limit or any permitted extension, the opposition should be deemed abandoned. Entry of evidence on the part of the applicant should be optional, as the burden in opposing a published mark is on the opposer. The applicant must confirm continued interest in the application after the filing of the opponent's evidence in order to avoid abandonment of the application.

Alternatively, the Trademark Office may choose to render a decision in the matter whether the applicant chooses to respond or not.

12.11.2 Evidence from Other Proceedings
There should be a provision for determining admissibility of, and procedures for entering applicable evidence from other related proceedings, for example, a determination of the fame of either the opposer’s or the applicant's mark.
**12.11.3 Forms of Evidence**
There should be a provision enabling each party to obtain (i) documents in the possession of the other party, (ii) written responses to a limited number of interrogatories, (iii) written responses to requests for admissions, and (iv) the testimony of its own witnesses and of witnesses of the other party.

**12.12 Protective Order**
Upon motion by a party from whom discovery is sought, and for good cause, the Trademark Office may make any order, which justice requires, to protect a party from annoyance, embarrassment, oppression, or undue burden or expense.

**12.13 Sanction; Termination**
Failure to respond to discovery requests should be subject to sanction by the Trademark Office. Repeated failure to respond to discovery requests should result in termination of the proceedings in a manner adverse to the offending party.

**12.14 Motions and Briefs; Hearing**

**12.14.1 Interlocutory Hearings/Motions**
There should be a procedure for resolving interlocutory matters, including provision for dismissal after submission of an answer, or summary judgment after the close of evidence taking, either by way of motion or hearing.

**12.14.2 Final Brief and Hearing**
Opposition proceedings should be resolved by written brief and/or oral hearing, and a reasoned opinion by at least three members of the Trademark Office. The Office should communicate to the parties the date by which it will render a decision, and it should render its decision by that date. If the Office is unable to render a decision by the noted date, it should communicate to both parties the new date by which it intends to render its decision.

**12.15 Appeal**
There should be provision for appeal within a given time limit (20 days) of the date of the written decision. In an Examiner Opposition, such appeals should be to either a board of examiners or judges within the Trademark Office, or to a civil court of competent jurisdiction. In a Board Opposition, such appeals should be to a civil court of competent jurisdiction.

**12.16 Status of Application on Termination of Proceeding**
On termination of a proceeding involving an application, the application, if the judgment is not adverse, returns to the status it had before the institution of the proceedings. If the judgment is adverse to the applicant, the application stands refused without further action and all proceedings thereon are considered terminated.
13. CANCELLATIONS

13.1 Cancellation Procedures

A mechanism should be offered to third parties to cancel an existing registration. In that these Guidelines deal with examination, please refer to other INTA documents for guidance.